Decision for dispute CAC-UDRP-101524

Case number	CAC-UDRP-101524
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Domain names	PIRELI.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Site Admin - Center for Ban on Drugs

OTHER LEGAL PROCEEDINGS

The panel is not aware of other legal proceedings concerning this domain name.

IDENTIFICATION OF RIGHTS

Apart from the name PIRELLI being the company name of the Complainant, that company is also the proprietor of numerous PIRELLI trademarks around the world, such as e.g. International Registration 592485 PIRELLI, registered since October 16th 1992 and protected inter alia in the USA, US word mark 893585 PIRELLI, registered on June 30th, 1970.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

A. FACTUAL GROUNDS

I. Pirelli at a glance

Pirelli & C. S.p.A. (hereinafter referred to as “Pirelli”) is a well-known multinational company based in Milan, Italy. With sales of 6.30 billion Euros in 2015, it is the fifth largest global tyre manufacturer and leader in the high-end segments with high technological content. Pirelli produces car, motorcycle, truck, bus and agricultural tyres. Today, Pirelli has plants located in 14 countries throughout the world (Italy, U.K., Germany, Russia, Turkey, Romania, China, Egypt, Argentina, Brazil, Venezuela,

Mexico, Indonesia, U.S.A.) and a commercial network that covers over 160 countries.

Founded in 1872, Pirelli is distinguished for its long industrial tradition, which has always been combined with capacity for innovation, product quality and brand strength. A strength supported since 2002 by PZero fashion and high-tech project and further enhanced by Formula 1, for which Pirelli is the exclusive tyre supplier since 2011.

Thanks to the success and leader position achieved by Pirelli in relation with the segments in which it operates, its trademarks are well-known worldwide. In 2008 Pirelli was ranked among the 10 most valuable Italian global brands. According to Interbrand valuation made in 2011, Pirelli's brand had a value of 2.27 billion Euros, with an increase of 26% compared vs 1.8 billion Euros in 2010. Pirelli's presence in Formula 1 contributed for 200 million Euros to this growth. Pirelli aims to use the advantage of its trademark as a driver to favor growth in the premium segment. According to the Interbrand figures, the Pirelli brand is 15% more effective than other brands in the choice of tyre purchases mainly due to the consumer's perception of a premium brand particularly appreciated for its sporting, glamorous and prestigious image. Marketing expenditure is forecast to double in future to increase the brand's fame in all key premium markets, by optimizing the allocation between advertising and digital marketing and creating strong synergies between tyres (Pirelli Tyre), fashion and industrial design (PZero), the Pirelli calendar and Formula 1.

II. The Complainant's protected rights

Trademarks:

Pirelli is owner of numerous registrations and/or applications for trademarks, comprising the keyword "PIRELLI". Trademarks are registered in Italy, the EU, the US, and in many other countries all over the world. Pirelli has used its trademarks for many, many years in connection with its core businesses:
- power cables and systems sector (classes 9 and 38 of the International Classification System of Goods and Services);
- telecommunications cables and systems sector (classes 9 and 38 of the International Classification System of Goods and Services);
- tyre sector (class 12 of the International Classification System of Goods and Services).

Furthermore, related to other segments in which Pirelli has been active, products and services of nearly all classes of the International Classification of Goods and Services (Nice Classification) belong to many trademark registrations of the Complainant.

In particular, Pirelli is owner of the following trademarks valid also in the United States, where the Respondent is located and prior to the registration of the disputed domain name:
- PIRELLI International device mark no. 592485, registered on 16.10.1992 in classes 11, 17, 20, 24;
- PIRELLI US word mark no. 893585, filed on January 22, 1969, registered on June 30, 1970 in classes 9, 12, 17;
- PIRELLI US device mark no. 908451, filed on January 22, 1969, registered on February 22, 1971 in classes 9, 12, 17;
- PIRELLI US word mark no. 1452137, filed on September 12, 1986, registered on August 11, 1987 in class 18;
- PIRELLI US word mark no. 1869653, filed on November 27, 1991, registered on December 27, 1994 in class 25;
- PIRELLI US device mark no. 2559925, filed on November 19, 1998, registered on April 9, 2002 in class 25.

Pirelli has invested substantial effort over a period of time, including the expenditure of substantial amounts, to develop good will in its trademarks to cause consumers throughout the world to recognize its marks as distinctly designating products that originate with Pirelli. Hence, Pirelli enjoys extensive rights in such trademarks.

Trade / company name:

Pirelli operates under the PIRELLI trade name, which has been in use since 1872.

Domain names:

Pirelli also owns rights in the domain name “pirelli.com”, created on January 11, 1995, as its primary domain name, as well as numerous domain names.

The aforementioned trademarks, trade name and domain names are hereinafter referred to as “PIRELLI Marks”.

III. The domain name “pireli.com” was registered on December 7, 2000, i.e. well after the Complainant’s trademarks. As certified by the attached printout of the relevant WHOIS records at the time of filing of this Complaint, Site Admin - Center for Ban on Drugs is shown as registrant.

B. LEGAL GROUNDS

The disputed domain names should be transferred to Pirelli for the following reasons.

I. UDRP Policy 4(a)(i) - Confusing similarity of “pireli.com” to the PIRELLI Marks of the Complainant

The domain name “pireli.com” is confusingly similar to the Complainant’s PIRELLI Marks, because the Respondent has deleted one of the letters “l” composing the PIRELLI Marks’ dominant part, namely the wording “PIRELLI”.

It is a consensus view of UDRP Panels that a domain name which contains a common or obvious misspelling of a trademark normally is found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name. Hence, adding, deleting or substituting letters or numbers of the complainant’s registered marks does not preclude a finding of confusing similarity. See NAF/FA94788 (firstpage.com); WIPO/D2000-0588 (gameb0y); NAF/FA94370 (sunglasshot.com); WIPO/D2000-0039 (budgetsaver.com). See also NAF/FA94730 (statfarm.com); NAF/FA94737 (mariot.com); WIPO/D2000-0130 (chromalin.com); WIPO/D2000-0999 (telstraa.com); NAF/FA94384 (ethnicgrocery.com inter alia); WIPO/D2001-1469 (4unverferth.com); WIPO/D2002-0415 (1800okidata.com); WIPO/D2000-0664 (priceclub.com inter alia).

Therefore, a slight difference, as the deletion of one of letters “l” of Complainant’s marks, is insufficient to negate the confusingly similarity between the disputed domain name and PIRELLI Marks.

UDRP Panels also agree that the top-level suffix, in this case .com, is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the trademark of the complainant (as it is a technical requirement of registration).

Hence, the domain name “pireli.com” can be confused with:
a) the trademark registrations and/or applications of Pirelli valid worldwide and in particular in the US;
b) the trade / company name of Pirelli;
c) the domain names registered by Pirelli, in particular, with the Complainant’s primary domain name: pirelli.com.

The similarity of the disputed domain name to PIRELLI Marks, is likely to lead to confusion and/or association for the Internet users.

II. UDRP Policy 4(a)(ii) - Lack of rights or legitimate interests of the Respondent in respect of the domain name “pireli.com”

The Complainant shall make a prima facie showing that the Respondent has no rights and interests in the domain name; however, the burden of proof with respect to this element is light for the Complainant. See WIPO/DTV2002-0005 (deagostini.tv); WIPO/D2000-0648 (pivotalsoftware.com); WIPO/D2002-0503 (arroyocraftsman.com); WIPO/D2003-0455 (croatiaairlines.com).

As per the WHOIS records the Respondent is Site Admin - Center for Ban on Drugs.

Pirelli has no relationship with the Respondent whatsoever. The Respondent has never received any approval of the

Complainant, expressed or implied, to use the PIRELLI Marks or any other identical or confusingly similar marks, such as the wording “pireli”, in or as part of any domain name. There is no evidence that the Respondent has been commonly known by the domain name. Additionally, there is no indication that the Respondent has any legitimate interest in the PIRELLI Marks or in any other identical or confusingly similar marks, consisting for example in the wording “pireli” according the searches done on the web sites of the Italian Patent and Trademark Office (UIBM), the EUIPO, the WIPO or the USPTO.

The domain name “pireli.com” currently resolves to a parking page containing links related to the Complainant and its core business, i.e. tyre, and links to third parties’ sites with competitive products. Hence, there is evidence that the Respondent’s use of “pireli.com” is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use, without intent for commercial gain.

UDRP Panels have generally recognized that use of a domain name to post parking and landing pages or pay-per-click links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services” or from "legitimate noncommercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder. If such links are based on trademark value, Panels have tended to consider such practices generally as unfair use resulting in misleading diversion (WIPO Overview 2.0).

III. UDRP Policy 4(a)(iii) - Registration and use of “pireli.com” in bad faith

The disputed domain name has been registered and is being used in bad faith considering the following cumulative circumstances.

The Respondent has deliberately registered and/or has been using the domain name confusingly similar with the well-known PIRELLI Marks widely advertised throughout the world, creating a likelihood of confusion with such marks. The usurpation of the Complainant’s marks is evident, since the Respondent has deleted one of the letters “l” of dominant part of the PIRELLI Marks, i.e. the wording “PIRELLI” when registering and using the disputed domain name, while on the website to which the domain name resolves the name of the Complainant and the wording “PIRELLI” appears correctly with double “l”.

Misspelling of complainant’s well-known mark (so-called typosquatting) is usually considered by UDRP Panels as an indicia of bad faith registration and/or use. See in particular decisions WIPO/D2001-0094 (plaboy.com); WIPO/D2000-1623 (pag3.com).

Moreover, the whole content of the website to which “pireli.com” resolves makes it clear that the Respondent has registered and used the Disputed domain name with a view of commercial gain. Such website is a parking page containing third parties’ links with competitive goods to this of the Complainant and/or directly related to the Complainant and its products.

Taking into account the vast and widespread advertising campaigns carried out by Pirelli for the promotion of products and/or services covered by PIRELLI Marks, it is unlikely that the registration of the domain name in question may be attributed to mere chance and not, as is, with a full awareness and intent to exploit the reputation and good will of the Complainant and the PIRELLI Marks. See decision: WIPO/DNU2014-0001 (pirelli.nu: “Given the distinctive nature of the Complainant’s PIRELLI mark and the reputation of the mark, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant or without intention of targeting the Complainant and the Complainant’s activities towards its customers”).

In the light of the foregoing, it is considered that the registration of the domain name “pireli.com” has been carried out with the sole purpose of exploiting the reputation and good will of Complainant’s marks and drawing on such domain name users for commercial gain (see UDRP Policy 4(b)(iv) “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”). See decisions: CAC/04316 (prada.eu); CAC/05650 (fratelliberetta.eu); CAC/05572 (kgindustries.eu); CAC/05468 (zott-sale.eu); NAF/FA95464 (statefarmnews.com); NAF/FA123933 (celebrex-drugstore.com);

NAF/FA126835 (barbiesgalleries.com); NAF/FA96356 (broadcom2000.com); NAF/FA96209 (galluppoll.com); NAF/FA740335 (cigaraficionada.com); NAFFA881234 (stlawu.com).

According to UDRP Policy 2, lett. b) c) and d) and to paragraph 7(c)(xiii) of the Registration Agreement, the Respondent warranted that the domain name registration would not infringe upon or otherwise violate the rights of any third party, had no unlawful purpose and it would not knowingly use the domain name is violation of any applicable laws or regulations. By registering and using the “pireli.com” as described above, the Respondent violated the mentioned provisions. See decisions: WIPO/D2000-0164 (embratel.com); NAF/FA93636 (sound-choice.com) and see also WIPO/D2000-0591 (younggenius.com); NAF/FA94895 (sunchronicle.com).

Therefore, having ascertained 1) the confusing similarity of the domain name “pireli.com” with the rights deriving from the trademarks, trade / company name and domain names in which Pirelli has exclusive rights; 2) the lack of rights and legitimate interests of the Respondent in the disputed domain name; 3) the bad faith of the Respondent in the registration and use of the disputed domain name, the undersigned authorized representative of the Complainant requests that the domain name “pireli.com” be transferred to Pirelli & C. S.p.A..

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

(i) the Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

(iii) the Disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Disputed domain name is confusingly similar to the Complainant's trademarks and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

a) disregarding the top-level suffix in the domain name (i.e. ".com"), and

b) finding that the mere adding, deleting or substituting letters or numbers of the Complainant's registered marks does not in any way automatically preclude a finding of confusing similarity. See e.g. WIPO/D2000-0588 (gameb0y), WIPO/D2000-0999 (telstraa.com), CAC/101449 (boehringer-inqelheim.com), CAC/101436 (boehringer-ingl1heim.com) and CAC/101517 boehringeringelhein.com).

The Panel fully agrees with the Complainant that the omission of one letter "L" in the Disputed domain name "pireli.com" is not sufficient to prevent a likelihood of confusion from arising. The dominant element PIRELI is certainly visually confusingly similar and for all intents and purposes phonetically nearly identical to the Complainant's mark and company name PIRELLI.

A likelihood of confusion can therefore not be denied and the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the Disputed domain name. Neither does the Complainant have any kind of relationship with the Respondent. The Respondent has not been granted an authorization or license or any other approval from the Complainant whether express or implied to use the PIRELLI marks or identical or confusingly similar marks. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest in the Disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the Disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent is making use of the disputed domain name in such a way as to exploit the name PIRELLI for its own personal gain. The name resolves to a parking page making use of the name PIRELLI either for competitors of the Complainant and their products or in an unauthorized manner to the Complainant and its products.
Since there is widespread advertising carried out by Pirelli for the promotion of products and/or services covered by PIRELLI Marks, it is held that the registration of the domain name in question may not be attributed to mere chance but was carried out with full awareness of and the intention to exploit the reputation and goodwill of the Complainant and the PIRELLI Marks. See decision: WIPO/DNU2014-0001 (pirelli.nu): "Given the distinctive nature of the Complainant's PIRELLI mark and the

reputation of the mark, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant or without intention of targeting the Complainant and the Complainant's activities towards its customers".

The Panel therefore finds that the registration of the domain name "PIRELI.COM" has been carried out with the sole purpose of exploiting the reputation and good will of the Complainant's marks and company name and drawing on such domain name use for commercial gain (see UDRP Policy 4(b)(iv) "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location"). See decisions: CAC/04316 (prada.eu); CAC/05650 (fratelliberetta.eu); CAC/05572 (kgindustries.eu); CAC/05468 (zott-sale.eu); NAF/FA95464 (statefarmnews.com); NAF/FA123933 (celebrex-drugstore.com); NAF/FA126835 (barbiesgalleries.com); NAF/FA96356 (broadcom2000.com); NAF/FA96209 (galluppoll.com); NAF/FA740335 (cigaraficionada.com); NAFFA881234 (stlawu.com).

Under paragraph 2, lett. b) c) and d) UDRP and paragraph 7(c)(xiii) (Acceptable Use) of the Registration Agreement, the Respondent warranted that the domain name registration would not infringe upon or otherwise violate the rights of any third party, had no unlawful purpose and that the Respondent would not knowingly use the domain name in violation of any applicable laws or regulations and in particular not infringe rights in registered trademarks. The Respondent is in breach of these provisions through the registration and use of the Disputed domain name "pireli.com" as described above. See decisions: WIPO/D2000-0164 (embratel.com); NAF/FA93636 (sound-choice.com) and see also WIPO/D2000-0591 (younggenius.com); NAF/FA94895 (sunchronicle.com).

In the absence of a Response and given the reputation of the Complainant and its trademarks and company name as supported by the Complainant's evidence, the Panel must conclude that the Respondent was fully aware of the Complainant's trademarks and company name "PIRELLI" at the time of registering the Disputed domain name "pireli.com".

It has been established to the satisfaction of the Panel that the Disputed domain name was registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **PIRELI.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2017-06-12

Publish the Decision