Decision for dispute CAC-UDRP-100289

Case number	CAC-UDRP-100289
Time of filing	2011-08-08 14:24:36
Domain names	PIRELLIMEDIA.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	PIRELLI & C. S.p.a.

Complainant representative

Organization	PORTA CHECCACCI & ASSOCIATI Spa

Respondent

Name	DACS DESIGN

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings of which the Panel is aware and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has submitted extensive evidence, which the Panel accepts, showing that it is the registered owner of many trademarks for PIRELLI and that it has owned those trademarks for many years.

FACTUAL BACKGROUND

The PIRELLI Group is a well known Italian and international company that has operated for more than a century in many areas of industry and principally in the manufacture of tyres, although it also operates in other fields such as power cables and systems, telecommunications cables and systems and real estate. It is ranked among the world's leaders in many sections of industry . As part of its activities it operates a media and communications division.

The Respondent is a United Kingdom design agency and was at one time contracted to the Complainant to design a web portal that could be used by the Complainant's independent clients in the United Kingdom.

The disputed domain name was registered by the Respondent on December 13, 2007in the course of performing those services for the Complainant.

Various exchanges have taken place between the parties since the filing of the Response and are set out below in the contentions of the parties. They show that both parties are of the view that the disputed domain name should be transferred by consent from the Respondent to the Complainant.

The opinion of the Panel is that it should make an order that the disputed domain name should be transferred from the Respondent to the Complainant without making findings under the provisions of paragraph 4 of the Policy.

PARTIES CONTENTIONS

THE PARTIES' CONTENTIONS

COMPLAINANT

The Complainant has submitted that

(a) the disputed domain name is identical or confusingly similar to the PIRELLI mark;

(b) the Respondent has no rights or legitimate interests in the disputed domain name;and

(c) the Respondent registered and used the disputed domain name in bad faith.

RESPONDENT

The Respondent made the following submissions in the Response.

The Respondent has rights and/or legitimate interest in the domain name(s)
Categories of issues involved:
Legitimate noncommercial or fair use of the domain name, without intent for commercial gain
Other legitimate non-commercial or fair use of the domain name:

As their below the line design agency, we were asked by Patricia Stone of Pirelli UK Tyres Ltd to create a "web portal" that could be used by their UK independant clients in order to securely download high-resolution images of their Tyres and other associated media (such as logos). This media was intended to be accessible purely through a password protected site and should only be used in their own promotional material and not to be redistributed. The domain name was registered for this purpose only and has never been, and never will be, used for any other purpose. An initial design of this portal is visible here: http://beta.pirellimedia.com/
ADDITIONAL EXPLANATIONS:
This complaint may have arisen due to the fact that DACS Design changed it's trading name to Insight Design Group Ltd after this domain name was registered,and upon checking connections between the two companies, a search for IDGL may have been more fruitful! IDGL (formerly DACS Design) has been working for Pirelli UK Tyres Ltd for over 17 years.

The domain name(s) has not been registered and used in bad faith

Categories of issues involved:

Complainant’s failure to meet standard of proof

Other:

We feel that the complainant has not done all due diligence checks before filing this complaint. As the domain name was registered in good faith that it would be used solely for it's originally intended purpose (as a tool for use by the Pirelli UK Tyres Ltd marketing department) and never "with the sole purpose of exploiting the reputation of the complainant and draw on its website users."

EVIDENCE TENDERED IN SUPPORT OF THE RESPONSE

Attached to the Response was the following email:

From: "Marc Henson :: Insight Design Group" <marc@idgl.co.uk>
Subject: Web Portal
Date: 23 January 2008 09:30:07 GMT
To: GB Stone Tricia <patricia.stone@pirelli.com>
Hi Tricia,
Please click on the link below to go to the Download portal. This is only a starting point and as yet hasnt got all the info in.. but I thought it was close enough for you to have a look at to see if we are going down the right lines. The Corporate Guidleines section I was going to fill with the basics of how to use the logo etc...
http://beta.pirellimedia.com
I look forward to your comments.
Kindest Regards
Marc
Marc Henson | Creative
_____
Insight Design Group Ltd

PROCEDURAL ORDER NO 1

By Procedural Order No.1 dated August 11, 2001 the Panel requested the Complainant to provide a further statement or document setting out any matters it wished to put to the Panel in reply to the Response and to do so by August 17, 2011.

SUPPLEMENTARY SUBMISSION BY THE COMPLAINANT

On August 12, 2011 , in response to the Procedural Order , the Complainant made the following supplementary submission :

"Dear Sirs,
We have been contacted by the Respondent with email message of August 9, 2011 (attached) arguing that DACS Design were asked by Pirelli UK Tyres Ltd to create a "web portal" but, unfortunately, copy of the email message sent to Mrs. Patricia Stone was not attached. Accordingly the mail sent by Respondent was not considered sufficiently supported and for this reason we confirmed the Complaint.
In addition the contested domain name PIRELLIMEDIA.COM has been registered four years ago, the domain has a website online (even if still with one page), and the website display the PIRELLI logo since that date without any authorization.

It is Pirelli’s policy to try to prevent and/or to stop any non-authorized use/registration of the trademark PIRELLI as domain name. It is Pirelli’s policy to register any domain name in its own name.

Pirelli has a list of any authorization granted to the use of the trademark PIRELLI and DACS Design is not in such list.

Anyway, for the sake of economy of the proceeding, we agree to settle this dispute if Respondent agrees to assign the

domain name PIRELLIMEDIA.COM to Pirelli & C. S.p.A."

EVIDENCE TENDERED IN SUPPORT OF THE SUPPLEMENTARY SUBMISSION

The email referred to in that submission was attached to the submission and was in the following form:

"Cristina Cazzetta
Da: mail@pcapatlaw.it
Inviato: martedì 9 agosto 2011 15.38
A: cazzetta@pcapatlaw.it
Oggetto: I: Cristina Cazetta RE: PirelliMedia.com
-----Messaggio originale-----
Da: Marc Henson [mailto:marc@idgl.co.uk]
Inviato: martedì 9 agosto 2011 14:26
A: mail@pcapatlaw.it
Cc: Cristina.Cazetta@pcapatlaw.it; GB Stone Tricia
Oggetto: FAO: Cristina Cazetta RE: PirelliMedia.com
Hi Cristina,
I have just received notification from my domain registration provider that action has been commenced against us with reference to the registration of pirellimedia.com.
As I have received no official notification from ICANN with regards to this complaint, I have tried searching FORUM for a dispute notification, however none is present at the moment, however you personally have been linked with all previous complaints on Pirelli's behalf and so I thought it best to contact you directly.
The domain in question was registered by myself 4 years ago while discussing the possibility of creating an online image portal for Pirelli UK Tyres Ltd that could be accessed by Pirelli's UK based clients to obtain high resolution images to be used in their own media.
As we did not have any specific access to the main pirelli.com domain, I thought that it may be worthwhile getting a suitable domain name that could be used for this purpose. The pirellimedia.com domain was available and so was duly registered.
As such, it could be argued under rules 4(a)(ii) & 4(a)(iii) of the ICANN UDRP policy that we did in fact have legitimate interest in registering the domain name and that it has not been registered or used in bad faith, and so a UDRP resolution could possibly rule against you.
May I suggest that instead of pushing forward with the resolution procedure and incurring further cost (560€ isn't it?), that we settle this dispute directly. After having not used the domain for it's originally intended purpose in 4 years, I feel that it is probably never going to be used, and so would be willing to relinquish the domain with no further action if desired, after all, it has only cost us £40, and could possibly end up costing you a lot more for no reason!
Out of interest, could I ask you why there was never any attempt at direct contact before you issued these proceedings?
I look forward to hearing from you.
Kind regards
Marc"

PROCEDURAL ORDER NO.2

By Procedural Order NO.2, dated August 23, 2022 the Panel invited the Respondent to provide a further statement or document setting out any matters it wished to put to the Panel in response to the supplementary submission of the Complainant and to do so by August 26, 2008.

SUPPLEMENTARY SUBMISSION BY THE RESPONDENT

On August 24, 2011, in response to the Procedural Order, the Respondent made the following supplementary submission :

"Dear Sirs,

In confirmation, we did in fact make every effort to contact the Complainant before we were sent any access to the CAC website, as our Service Provider had issued us with a message stating that the domain had been locked due to impending complaints. As you will note from our initial email we did offer straight away to transfer the domain over to them, even though we had a perfectly valid reason for having registered it in the first place. (namely because we were asked to by a representative of Pirelli. Whether, internally, that was the correct thing to do remains open for discussion, but we, as a company, have not acted badly in any way shape or form.)

This offer was unheeded and the complaint was issued regardless. I even asked the question as to why we were not contacted directly in the first place as we could easily have resolved this situation amicably and at no cost whatsoever.

Since this email, we have received a further email from the Complainant stating that:

"We confirm that you did not have any legitimate interest in registering the domain name www.pirellimedia and it has been registered or used in bad faith."

Something that we whole heartedly do not agree with, especially as these facts are in discussion with yourselves and a decision has not been made to this effect. The domain name was not registered OR used in bad faith at all, let alone registered AND used in bad faith as your rules stipulate. Frankly we feel offended and feel that there seems to be "bully-boy" tactics in play in order to force an issue that does not need forcing.

We have replied to the Complainant stating that we are still more than willing to transfer the domain name to them with no issue, but would like them, for the sake of our company's good name, to stop intimating that we have done ANYTHING in bad faith and withdraw the complaint so that the domain name can be unblocked by our registrar and we can then instigate the transfer through normal routes.

This offer again was declined and a non standard communication sent to yourselves stating our initial contact, but nothing of the further emails that they have sent to us, or our responses.

I enclose copies of their emails and our response. I am not really sure what more we can do?"

EVIDENCE TENDERED IN SUPPORT OF THE SUPPLEMENTARY SUBMISSION

The emails referred to in that submission , apart from formal parts that have been removed by the Panekl for reasons of space, are as follows :

"From: Marc Henson <marc@idgl.co.uk>
Subject: Re: PirelliMedia.com
Date: 11 August 2011 10:02:28 GMT+01:00
To: Anna Maria Bardone <bardone@pcapatlaw.it>
1 Attachment, 1.7 KB
Dear Anna,
We, infact, DID have legitimate interest in registering the domain name
www.pirellimedia.co.uk (as outlined in my previous email), and it has NOT been registered
OR used in bad faith (let alone registered AND used in bad faith!).
I feel offended that you should say otherwise. It appears that The Hon. Neil Brown, QC
doesn't see this as a straight forward decision either.
For future wellbeing, please acknowledge this fact and I will happily send you over the
AUTH code (and unlock the domain) as soon I am able. Unfortunately, as you are surely

aware, the Domain has been locked against any change or transfer until the CAC have made their decision or you have withdrawn your case.
Regards
Marc
IMPORTANT INFORMATION:
WE HAVE NOW MOVED INTO OUR NEW PURPOSE BUILT OFFICE.
OUR NEW ADDRESS AND TELEPHONE NUMBER ARE BELOW
Marc Henson // Studio Manager

On 11 Aug 2011, at 08:32, Anna Maria Bardone wrote:
Dear Mr. Henson,
we refer to your email sent to Mrs. Cazzetta of august 9, 2011.
We confirm that you did not have any legitimate interest in registering the domain name www.pirellimedia and it has been registered or used in bad faith.
We thank you for your availability to settle this dispute directly and in order to proceed in this way we would ask you to let us have the Auth Code of this domain name in order to proceed with the transfer of this domain name to Pirelli.
Best regards.
Anna Maria Bardone
PORTA, CHECCACCI & ASSOCIATI S.p.A.

-----Messaggio originale-----
Da: Marc Henson [mailto:marc@idgl.co.uk]
Inviato: martedì 9 agosto 2011 14:26
A: mail@pcapatlaw.it
Cc: Cristina.Cazetta@pcapatlaw.it; GB Stone Tricia
Oggetto: FAO: Cristina Cazetta RE: PirelliMedia.com
"
(The email of August 9,2011 has already been set out above.)

RIGHTS

In view of the decision of the Panel, it is not necessary for the Panel to make a specific finding under paragraph 4(a)(i)of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

In view of the decision of the Panel, it is not necessary for the Panel to make a specific finding under paragraph 4(a)(ii)of the Policy.

BAD FAITH

In view of the decision of the Panel, it is not necessary for the Panel to make a specific finding under 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

Sufficient of the facts have been set out above to enable the reader to understand how the disputed domain name came to be registered by the Respondent and the use to which it has been put.

Although the parties hold different views on whether, in those circumstances, the Respondent has rights or legitimate interests in the disputed domain name and on whether it was registered and used in bad faith, it is clear that both parties now wish to achieve the same result, namely the transfer of the domain name from the Respondent to the Complainant.

Indeed, it is difficult to see why this could not have been done earlier.

Nevertheless, having regard to all of the circumstances, the Panel is of the view that it is better late than never and that the appropriate course to follow now is to order the domain name to be transferred without making findings on the various elements set out in the Policy and certainly without making judgments about the propriety of the conduct of either party.

Before doing that, it should first be shown that this is an appropriate course to take and that the Panel has power to do so.

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
(2) Respondent has no rights or legitimate interests in respect of the domain name; and
(3) the domain name has been registered and is being used in bad faith.

However, it is clear from the terms of the Response and the supplementary submissions made in response to the two Procedural Orders made by the Panel that this matter is a request for a consent order that the disputed domain name be transferred from Respondent to Complainant. That is so because, first, Complainant asks for an order that the domain name be transferred to it for the reasons summarized above.

Respondent explains how the domain name came to be registered and used and that, according to it, it acted with propriety

and that it would not stand in the way of the domain name being transferred to the Complainant.

Each party has contributed further to the debate , but, without going into the details of the exchange, which are set out above, the view of each party now is that they consent to the transfer.

Both parties are therefore asking for the same order and the question arises how the Panel should deal with that situation.

The same issue came before the panel as presently constituted in Digg Inc. v. Damien Overeem FA 836770 (Nat. Arb. Forum Dec. 20, 2006) and on that occasion the following opinion was expressed, which is adopted here:

“It is open to the Panel when faced with such a situation to forgo the usual UDRP analysis of the three issues set out above and simply make an order for the transfer of the domain name to Complainant. That course was followed in Boehringer Ingelheim Int’l GmbH v. modern Ltd-Cayman Web Dev., FA 133625 (Nat. Arb. Forum Jan. 9, 2003). It was also followed in PSC Management Limited Partnership v. PSC Management Limited Partnership (Nat. Arb. Forum June 6, 2005) and in Malev Hungarian Airlines, Ltd. v. Vertical Axis Inc., FA 212653 (Nat. Arb. Forum Jan. 13, 2004) (“In this case, the parties have both asked for the domain name to be transferred to the Complainant…Since the requests of the parties in this case are identical, the panel has no scope to do anything other than to recognize the common request, and it has no mandate to make findings of fact or of compliance (or not) with the Policy.”). The same course was followed recently by the panel as presently constituted in Norgren, Inc. v. Norgren, Inc. c/o Domain Administrator, FA 670051 (Nat. Arb. Forum May 23, 2006) and Diners Club International Ltd. v. Nokta Internet Technologies FA 720824 (Nat. Arb. Forum July 24, 2006) and also by the panel in The Body Shop International plc v. Agri, Lacus, and Caelum LLC, FA 679564 (Nat. Arb. Forum May 25, 2006). The Panel respectfully adopts the position as expressed in The Body Shop International plc v. Agri, Lacus, and Caelum LLC, supra:

Consistent with a general legal principle governing arbitrations as well as national court proceedings, this Panel holds that it cannot issue a decision that would be either less than requested, or more than requested by the parties.

Because both Complainant and Respondent request the transfer of the disputed domain name to Complainant, the Panel must recognize the common request of the two parties.

Indeed, as has often been said, it would be unwise to make any other findings in case the same issues were to arise in later proceedings. Accordingly, the Panel will not make any findings of fact or compliance or otherwise with respect to the detailed provisions of the Policy, but will make the only order that is appropriate in the circumstances, which is an order for the transfer of the domain name to Complainant.”

Similar views were expressed by the Panel as presently constituted in Victoria's Secret Stores Brand Management, Inc. v. Siarhei Leonau, FA 393866(Nat. Arb. Forum, June 28, 2011) and there are other decisions to the same effect.The cumulative effect of those decisions is that in an appropriate case, a Panel has power to and should make an order for transfer and not venture into making findings and judgments about the facts and the conduct of the parties.

For the foregoing reasons the Panel will not make any findings, but will make the only order that is appropriate in this case, which is an order transferring the disputed domain name to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIMEDIA.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION	2011-09-05

Publish the Decision