# Decision for dispute CAC-UDRP-100373

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| Case number | CAC-UDRP-100373 |
| Time of filing | 2012-02-14 11:44:50 |
| Domain names | tyreclubpirelli.com |

## Case administrator

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| Name | Tereza Bartošková (Case admin) |

## Complainant

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| Organization | Pirelli & C. S.p.A. |

## Complainant representative

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| Organization | FASANO-Avvocati |

## Respondent

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| Organization | Above.com Domain Privacy |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous trademarks in Italy, the EU and around the world for the name PIRELLI.

The Companiant is also the owner of the domain name "pirelli.com" registered 11 January 1995, which it uses as its primary domain name and owns numerous other domain names incorporating the key word "pirelli".

FACTUAL BACKGROUND

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

The Complainant, Pirelli & C. S.p.A. is a joint stock company incorporated under the laws of Italy, and has many Pirelli subsidiaries around the world.

The Complainant is owner of numerous registrations and/or applications for trademarks, comprising the keyword “pirelli” which are registered in Italy, the EU and around the world.

PIRELLI has used its trade marks for many years in connection with the tyre sector. The Companant's PIRELLI marks are

well- known trademarks worldwide and the name PIRELLI is renowned in connection with tyres.

PIRELLI owns and actively uses the domain name “pirelli.com”, registered on 11 January 1995, as its primary domain name, as well as numerous domain names using the key word "pirelli"

The disputed domain name "tyreclubpirelli.com" was registered on October 21, 2011.

The disputed domain name involves a privacy or proxy registration service. Following a request for registrar verification, the Registrar revealed the identity of the underlying registrant of the disputed domain name as John Terry, Belcanto Investment Group Limited, belcanto@hushmail.com, 1 869 469 2829, PO Box 598, Fort Charles, Charlestown Nevis, Saint Kitts and Nevis. The Complainant added John Terry as an additional Respondent to the Complaint and has been allowed to proceed against Above.com Domain Privacy and John Terry.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

Paragraph 15 of the Rules states that the Panel shall decide a complaint on the basis of the statements and documents submitted, in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

If a Party does not comply with a provision of, or requirement under the Rules, and in the absence of exceptional circumstances, the Panel shall draw such inferences as it considers appropriate (Paragraph 14 of the Rules).

The Respondent has failed to submit a response and consequently has not contested any of the submissions made by the Complainant. The Panel will therefore make its decision on the basis of the factual statement submitted and the documents made available by the Complainant to support its contentions.

Paragraph 4 a. of the Policy requires the Complainant to prove each of the following three elements:

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

(ii) the Respondent has no rights or legitimate interest in respect of the domain name; and
(iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of numerous trade mark registrations in the EU and around the world for the name PIRELLI. Most of these marks predate the registration of the disputed domain name "tyreclubpirelli.com".

It has been established in Panel decisions that the generic top level suffix.com may be disregarded when considering whether the disputed domain name is confusingly similar to the trade mark in which the Complainant has rights.

The disputed domain name "tyreclubpirelli.com" is comprised of the Complainant's mark PIRELLI and the generic words "tyre" and "club". As has been held in the case of Sony Kabashiki Kaisha v Inja, Kil (WIPO /D2000-149) "[n]either the addition of an ordinary descriptive word…nor the suffix ".com" detract from the overall impression of the dominant part of the name in each case, namely the trade mark SONY".

The distinctive word in the disputed domain name is the Complainant's mark PIRELLI. Adding generic or descriptive words to that well-known mark is unlikely to avoid confusion. This is especially so where the word "tyre" is one which is closely associated with the Complainant's business.

The Panel finds that the disputed domain name "tyreclubpirelli.com" is confusingly similar to the PIRELLI trade marks in which the Complainant has rights.

B. Rights or legitimate interests

The second element the Complainant must prove is that the Respondents have no rights or legitimate interests in respect of the domain name (Para 4 a.(ii) of the Policy).

In the absence of a Response, none of the grounds set out in Paragraph 4 c. of the Policy, by which a respondent may demonstrate rights or legitimate interests in the domain name, have been asserted.

The Complainant has long standing rights in the mark PIRELLI which predate the registration of the domain name.

The Panel finds that the Complainant has established that the Complainant has not licenced or authorised the Respondents to use any of its marks or incorporate its mark PIRELLI in the disputed domain name. The Respondents do not appear to be using the domain name in connection with a bona fide offering of goods and services, or a legitimate non-commercial or fair use, without intent for commercial gain.

Further, there is no evidence that Above .com Domain Privacy or John Terry have been commonly known by the domain name "tyreclubpirelli.com".

There appears to be no reason why the Respondents would use the Complainant's well known mark in the disputed domain name unless seeking to create the impression of an association with the Complainant.

On the basis of the evidence submitted and in the absence of a Response, the Panel finds that the Respondents have no rights or legitimate interest in the disputed domain name.

C. Registered and used in bad faith

The third element that the Complainant must prove is that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4 a.(iii)).

The use of a privacy service may be an indication of bad faith where the underlying registrant has hidden behind that privacy shield. No response has been filed to assert any legitimate reason for using the privacy shield.

Evidence of the registration and use of domain name in bad faith may be shown where "by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, internet users to [its] website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website..." (Policy paragraph 4 b.).

It appears from the evidence submitted that the disputed domain name has been used in connection with a website to attract Internet users for commercial gain. There appears to be no other explanation for the registration of the domain name other than to trade off the good will associated with the Complainant's well known PIRELLI mark.

On the basis of the uncontested evidence submitted by the Complainant the Panel finds that the domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TYRECLUBPIRELLI.COM**: Transferred

## PANELLISTS

| Name | **Mrs Veronica Marion Bailey** |
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DATE OF PANEL DECISION 2012-03-13

Publish the Decision