Decision for dispute CAC-UDRP-100398

Case number	**CAC-UDRP-100398**
Time of filing	**2012-03-01 13:45:11**
Domain names	**pirelliwinterreifen.info**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

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

Complainant representative

Organization	**FASANO-Avvocati**

Respondent

Organization	**Domains By Proxy, LLC**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant Pirelli & C. S.p.A. owns a number of trademarks, including:
USA Trademark 4120086 for a word and device mark for "PIRELLI", registered foor goods in Class 9;
Community Trademark 3733136 for a word mark for "PIRELLI", registered for goods and services in all Classes;
Italian Trademark 170400 for a word and device mark for "PIRELLI", registered for goods and services in all Classes except 3-6, 13-15, 29-33 and 35-45;
International Trademark 657502 for a word and device mark for "PIRELLI", registered for goods in Classes 9 and 12.

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 worldwide owner of many trademark registrations and applications, comprising the term PIRELLI.

PIRELLI has used its trademarks for many years in connection with, inter alia,goods and service in the tyre sector. The Companant's PIRELLI marks are well-known and the name PIRELLI is renowned in connection with tyres.

The disputed domain name <pirelliwinterreifen.info> (the "Domain Name") was registered on November 7, 2011 by using a privacy shield service "Domains by Proxy, LLC". Following a request for registrar verification, the Registrar revealed the identity of the underlying registrant of the disputed domain name as Cas Rudi, Jin Jeruk Raya, Blok L4 No 1 Rt 05 Rw 15 Kel Sukatani Kec Tapos Depok, JawaBarat 16454, Indonesia. The Complainant added Cas Rudi as an additional Respondent to the Complaint and has been allowed to proceed against Domains by Proxy, LLC and Cas Rudi.

The disputed domain name is not currently used for an active website, but has been used to offer winter tyres of a number of companies which are in direct competition with Pirelli.

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

1. The Domain Name includes the entire well-known PIRELLI trademark of the Complainant with the addition of only "winterreifen", which is German for "winter tyres", for whichn the PIRELLI trademarks were registered. According to standard case law under the UDRP an additon of a generic term to a trademark does not take away the similarity between domain name and trademark. The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's PIRELLI trademarks.

2. The Panel finds the Complainant has established that the Respondent was not licenced or authorised to use the Complainant's trademark in the disputed domain name. Furthermore, the Panel finds the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. The Panel therefore finds the Respondent has no rights or legitimate interests in respect of the Domain Name.

3. In the absence of a Response, the Panel infers that the Respondent chose the Domain Name to invoke the Complainant and its products and that the Respondent sought to mislead internet users into believing that the Domain Name was a domain name of the Complainant or authorized by the Complainant, while the website under the Domain Name in fact resolved to a website where products were offered by competitors of the Complainant. Furthermore, the use of a privacy

shield service is in the circumstances of the case a factor indicating bad faith. Accordingly, the Respondent registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIWINTERREIFEN.INFO**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2012-04-05

Publish the Decision