Decision for dispute CAC-UDRP-100413

Case number	CAC-UDRP-100413
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Domain names	pirellirecinisello.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Anpoer

OTHER LEGAL PROCEEDINGS

No other legal proceedings concerning the disputed domain names are currently pending.

IDENTIFICATION OF RIGHTS

The Complainant invokes the following marks:

Trademark Country Owner Application no. Application date Registration no. Registration date Class
PIRELLI RE (word) EU Pirelli & C. S.p.A. 006083158 09/07/2007 006083158 06/06/2008 35, 36
PIRELLI RE (word) Italy Pirelli & C. S.p.A. MI2007C007195 05/07/2007 1276670 23/04/2010 35, 36
PIRELLI RE (device) EU Pirelli & C. S.p.A. 003218476 19/06/2003 003218476 04/08/2004 35, 36
PIRELLI RE (device) WIPO (designated China, Croatia, Russia, Turkey) Pirelli & C. S.p.A. 11639 D/2007 27/07/2007 946106 27/07/2007 35, 36
PIRELLI RE (device) EU Pirelli & C. S.p.A. 006754154 14/03/2008 006754154 14/01/2009 35, 36
PIRELLI RE (device) Italy Pirelli & C. S.p.A. MI2007C012565 05/12/2007 1281571 10/05/2010 35, 36

FACTUAL BACKGROUND

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

The Complainant – Pirelli at a glance

Pirelli & C. S.p.A. (hereinafter referred to as “Pirelli” or the “Company”) is a well-known company founded in 1872 and based in Milan, Italy (ANNEX 1 – “Brochure Pirelli”). For more than a century it has developed as a truly international enterprise, deeply rooted in the different markets. In its strategy to the top of the range, the Pirelli has focused its activities in a selected number of high margin businesses of high margin profit, with segmentation towards high range products. Pirelli has always been combined with capacity for innovation, product quality and brand strength. Pirelli is synonymous with quality and the ultimate in performance. And it is in the high tech and superior performance segment of the high-end market that Pirelli has, over the years, built its leadership.
The Company’s core business is identified as Pirelli Tyre (ANNEX 2 – “Brochure Pirelli Tyre”), the fifth largest global tyre manufacturar with 20 plants in 11 countries throughout the world (Argentina, Brazil, China, Egypt, Germany, United Kingdom, Italy, Romania, Turkey, United States and Venezuela), and a commercial network that covers over 160 countries.
Over the years, further to its core business, Pirelli has created new businesses in other segments, thanks to its continual focus on research and innovation in products and services: Pirelli Ambiente S.p.A., engaged in the renewable energy sector; Pirelli & C. Eco Technology S.p.A., dedicated to developing technologies to control pollutant emissions; Pirelli Labs, a centre of technological excellence and engine of innovation and Pirelli Real Estate S.p.A. (shortly Pirelli RE) leader in the real estate sector in Italy and in the rest of Europe, with operations in Italy, Germany and Poland.
Pirelli RE, listed on the Milan Stock Exchange since 2002, is a fund and asset manager that enhances and manages real estate portfolios on behalf of third party investors through a distinctive pattern based on the integration of specialized services (agency and property management) functional to its management activities (fund and asset management).
The total assets under management by Pirelli RE is approximately 13,6 billion Euros, with a property portfolio worth 12,3 billion Euros and the residual amount (approximately 1,3 billion Euros) in non-performing loans (management and out of court recovery of bad debts for banks and investors).
In 2010, Pirelli, as a result of the desire to focus exclusively on core industrial activities in the tyre sector, concluded the spin-off of the real estate business and renamed Pirelli RE into Prelios.

The Complainant’s protected rights

Trademarks:
Pirelli is owner of numerous registrations and/or applications for trademarks, comprising the keyword “PIRELLI”, as per the trademark list hereto enclosed (ANNEX 3 - “Trademark list”). In this dispute, among such trademarks, the Complainant relies on the following marks:

Trademark Country Owner Application no. Application date Registration no. Registration date Class
PIRELLI RE (word) EU Pirelli & C. S.p.A. 006083158 09/07/2007 006083158 06/06/2008 35, 36
PIRELLI RE (word) Italy Pirelli & C. S.p.A. MI2007C007195 05/07/2007 1276670 23/04/2010 35, 36
PIRELLI RE (device) EU Pirelli & C. S.p.A. 003218476 19/06/2003 003218476 04/08/2004 35, 36
PIRELLI RE (device) WIPO (designated China, Croatia, Russia, Turkey) Pirelli & C. S.p.A. 11639 D/2007 27/07/2007 946106 27/07/2007 35, 36
PIRELLI RE (device) EU Pirelli & C. S.p.A. 006754154 14/03/2008 006754154 14/01/2009 35, 36
PIRELLI RE (device) Italy Pirelli & C. S.p.A. MI2007C012565 05/12/2007 1281571 10/05/2010 35, 36

Abstracts of the databases of Italian Patent and Trademark Office (UIBM), EU’s Office of Harmonization for the Internal Market (OHIM) and WIPO regarding the above mentioned trademarks are enclosed as ANNEXES 4.1-4.6 - “PIRELLI RE trademarks”.
Trademarks included in the ANNEXES 4.1-4.6, registered in Italy, in the EU, in China, Croatia, Russia and Turkey, have been used by Pirelli in connection with the following products and services:
a) apartment house management, renting of real; estate, housing agency, real estate management, real estate appraisal, real estate appraisal services, real estate affairs; insurance; financial affairs; monetary affairs, leasing of real estate and offices (Class 36 of International Classification System of Goods and Service);
b) franchising services; business advisory services relating to franchising; commercial management assistance in relation to franchises; advertising; business management; business administration; office functions (Class 35 of International

Classification System of Goods and Service).
Pirelli has used such trademarks for many, many years and has invested substantial effort over a period of time, including the expenditure of substantial amounts, to develop good will in its trade name and trademarks to cause consumers throughout the world to recognize its marks as distinctly designating products and services that originate with Pirelli.
Hence, Pirelli enjoys extensive rights in such trademarks which are internationally well-known.

Domain names:
Pirelli is owner of numerous domain names listed on ANNEX 5 – "Domain name list". In particular, the Complainant relies on its primary domain name, "pirelli.com", created on January 11, 1995, as well as on the following domain names (hereinafter referred to as "PIRELLI RE domain names"):
a) pirellire.com, created on March 12, 2003;
b) pirellire.net, created on March 12, 2003;
c) pirellire.org, created on March 12, 2003.

Company name:
Pirelli is a joint stock company incorporated under the laws of Italy, as per abstract certificate issued by the Chamber of Commerce of Milano - Registrar of Companies (ANNEXES 6 – "Company certificate" and 7 - "English translation of company certificate") and company by laws (ANNEX 8 – "Company by laws").
During its century-old history Pirelli has changed its company name, leaving always unchanged the dominant part of it, namely "PIRELLI" (ANNEX 9 – "Certificate of changes in company name").

The Complainant's above-mentioned trademarks, domain names and company name together are hereinafter referred to as "PIRELLI Marks".

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The domain name "pirellirecinisello.com" was registered on January 11, 2012, i.e. well after Complainant's trademarks. As certified by the attached printout of the relevant WHOIS records at the time of filing of this Complaint, Anpoer is shown as registrant (ANNEX 10 – "WHOIS records").
The disputed domain name should be transferred to Pirelli, because it constitutes usurpation and violation of the rights of the Complainant with regard to its trademarks registered in Italy, in the EU, in China and in numerous other countries worldwide, its domain names and its company name for the following reasons.

ICANN Rules 3(b)(ix)(1); ICANN Policy 4(a)(i)
> Confusing similarity of the disputed domain name with the trademarks, company name and domain names of the Complainant
The disputed domain name is confusingly similar to PIRELLI Marks, because it wholly incorporates the dominant part of PIRELLI Marks, namely the wording "PIRELLI".
In respect to PIRELLI RE trademarks (see ANNEXES 4.1-4.6) and PIRELLI RE domain names (see ANNEX 5), the Respondent added the word "cinisello", which is a municipality in the Province of Milan in the Italian region of Lombardy.
It is well-founded that adding a geographical term neither affects the attractive power of the dominant part of PIRELLI Marks, namely "PIRELLI", nor is sufficient to negate the confusingly similarity between the disputed domain name and PIRELLI Marks.
The domain name "pirellirecinisello.com" can be confused with:
a) the trademark registrations and/or applications of Pirelli valid in Italy and worldwide (see ANNEX ES 3-4.1-4.6);
b) the domain names registered by Pirelli (see ANNEX 5), in particular, with:
pirelli.com;
pirellire.com;
pirellire.net;
pirellire.org.
c) the company name of Pirelli (see ANNEXES 6-7).
The similarity of the disputed domain name to PIRELLI Marks, is likely to lead to confusion and/or association for the

Internet users.
See decisions: WIPO/D2000-0150 (walmartcanada.com); WIPO/D2000-0255 (nycbs.com); WIPO/D2000-0305 (armaniinternational.net); WIPO/D2000-0437 (ikea-korea.com); WIPO/D2000-0927 (altavistausa.com); WIPO/D2000-0713 (aolfrance.com, aolgermany.com, aolireland.com and aolspain.com finding that: “The addition of the name of a place to a service mark, such as the addition of 'France' to 'AOL', is a common method for specifying the location of business services provided under the service mark. The addition of a place name generally does not alter the underlying mark to which it is added”).

ICANN Rules 3(b)(ix)(2); ICANN Policy 4(a)(ii)
> Lack of rights or legitimate interests of Respondent in respect of the domain name “pirellirecinisello.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).
Pirelli has no relationship with the Respondent whatsoever. Pirelli has never authorized the Respondent to use the domain name “pirellirecinisello.com” or any other domain name. Additionally, there is no indication that the Respondent has any legitimate interest in PIRELLI Marks according the searches done on the web sites of the Italian Patent and Trademark Office (UIBM), the EU’s Office of Harmonization for the Internal Market (OHIM) and WIPO.
Further, entering “pirellirecinisello.com” in the address bar of an internet browser resolves to a web site containing third parties’ links to further web sites (ANNEX 11 – “Printout of pirellirecinisello.com of March 3, 2012”). Hence, there is no evidence that the Respondent’s use of “pirellirecinisello.com” is either a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain. Finally, there is no evidence that the Respondent has been commonly known by the domain name “pirellirecinisello.com”.
See decisions: NAF/FA190644 (nicklausgolf.com - “Respondent’s use of a domain name confusingly similar to Complainant’s mark(s) to divert Internet users to websites unrelated to Complainant’s business does not represent a bonafide offering of goods or services under Policy 4(c)(i) or a legitimate noncommercial or fair use under Policy 4(c)(iii)”); NAF/FA93554 (bigdog.com – finding no legitimate use when respondent was diverting consumers to its own web site by using complainant’s trademark(s)); WIPO/D2000-1204 (msnbc.org – finding no rights or legitimate interest in the famous MSNBC mark where respondent attempted to profit using complainant’s mark by redirecting Internet traffic to its own website); NAF/FA96356 (broadcom2000.com - finding no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use); NAF/FA96209 (galluppll.com - finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); NAF/FA740335 (cigaraficionada.com - finding that the respondent was not commonly known by the “cigaraficionada.com” domain name); NAF/FA881234 (stlawu.com - concluding that the respondent has no rights or legitimate interests in a disputed domain name where there is no evidence in the record indicating that the respondent is commonly known by the disputed domain name); WIPO/D2000-0020 (saint-gobain.net – finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); WIPO/D2000-0403 (charlesjourdan.com – finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant’s prior rights in the domain name precede the respondent’s registration; (3) the respondent is not commonly known by the domain name in question).

ICANN Rules 3(b)(ix)(3); ICANN Policy 4(a)(iii)
> Registration and use of “pirellirecinisello.com” in bad faith
The disputed domain name has been registered and is being used in bad faith considering that the disputed domain name wholly incorporates the dominant part of the well-known PIRELLI Marks, namely the wording “PIRELLI”. In respect to PIRELLI RE trademarks (see ANNEXES 4.1-4.6) and PIRELLI RE domain names (see ANNEX 5), the Respondent added a geographical term, the word “cinisello”.
Furthermore, a review of the contents of the web site to which “pirellirecinisello.com” resolves makes it clear that the domain name has been registered and is being used with a view of commercial gain (pay-per-click links) (see ANNEX 11).
Respondent’s bad faith is clearly evident from the fact that it has registered and has been using a domain name confusingly similar to the trademarks, company name, domain names of Pirelli. This evidences a clear intent to trade upon the reputation and good will associated with PIRELLI Marks. Respondent has been deliberately using the domain name confusingly similar

to PIRELLI Marks to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with Pirelli's marks and products to the source, sponsorship, affiliation or endorsement of its web site or of a product or service on such web site.
Taking into account the vast and widespread advertising campaigns carried out by Pirelli for the promotion of products and 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 PIRELLI Marks. See decision CAC Case N. 05367 (Giorgio Armani s.p.a. v. Antares S.p.A., Germano Armani).
In the light of the foregoing, it is considered that the registration of the domain name "pirellirecinisello.com" has been carried out with the sole purpose of exploiting Pirelli's reputation and good will and drawing on such domain name users for commercial gain.
See decisions of the Czech Arbitration Court: Case N. 04316 (Prada SA v. Maurizio Lussetti); Case N. 05650 (Salumificio Fratelli Beretta S.p.A. v. Nico Maria Cavallo), Case N. 05572 (KG Industries LLC v. KG Industries, Gary Powell KG Industries); Case N. 05572 (Zott GmbH & Co. KG v. Victor Somov).
See also NAF/FA95464 (statefarmnews.com – finding that a respondent registered the domain name "statefarmnew.com" in bad faith because that respondent intended to use a complainant's marks to attract the public to the web site without the permission from that complainant); NAF/FA123933 (celebrex-drugstore.com – finding that respondent registered and used the domain name in bad faith pursuant to ICANN Policy 4(b)(iv) because respondent was using the confusingly similar domain to attract Internet users to its commercial website; NAF/FA126835 (barbiesgalleries.com – citing WIPO/D2000-1221 Pavillion Agency, Inc v. Greenhouse Agency Ltd finding that the "domain names are obviously connected with the complainant that use or registration by anyone other that complainant suggests "opportunistic bad faith""); NAF/FA96356 (broadcom2000.com); NAF/FA96209 (galluppll.com); NAF/FA740335 (cigaraficionada.com); NAF/FA881234 (stlawu.com).

* * * *

Therefore, having ascertained 1) the confusing similarity of the domain name "pirellirecinisello.com" with the rights deriving from the trademarks, company name and domain names in which Pirelli has exclusive rights; 2) the reputation and good will associated with Pirelli and its trademarks; 3) the lack of rights and legitimate interests of the Respondent in the disputed domain name; 4) 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 "pirellirecinisello.com" be transferred to Pirelli & C. S.p.A..

LIST OF ANNEXES

ANNEX 1 – "Brochure of Pirelli";
ANNEX 2 – "Brochure of Pirelli Tyre";
ANNEX 3 – "Trademark list";
ANNEXES 4.1-4.6 – "PIRELLI RE trademarks";
ANNEX 5 – "Domain name list";
ANNEX 6 – "Company certificate";
ANNEX 7 – "English translation of company certificate";
ANNEX 8 – "Company by laws";
ANNEX 9 – "Certificate of changes in company name";
ANNEX 10 – "WHOIS records";
ANNEX 11 – "Printout of pirellirecinisello.com of March 3, 2012".

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

Complainant owns the mentioned PIRELLI RE Trademark Registrations, and is broadly known by this name. Cinisello is a municipality in the Province of Milan in the Italian region of Lombardy.

Disputed domain name is confusingly similar to PIRELLI RE trademark, since the defendant simply added the geographical term Cinisello to the Complainant's trademark.

The Respondent has not submitted any reply. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain names in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

"As mentioned above in section 3, the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists. WIPO Case No. D2002-0273 <sachsen-anhalt>; WIPO Case No. D2002-0521 <volvovehicles.com>"

Respondent's use of the Disputed Domain Names to intentionally attract Internet users for commercial gain is further evidence of bad faith registration and use of the domain names under Policy 4(b)(iv). Indeed Respondent's domain name create a likelihood of confusion between the domain name and Complainant's mark, trying to obtain an unfair advantage of the reputation and good will associated with Pirelli and its PIRELLI RE trademarks. This practice can clearly be found to constitute evidence of bad faith registration and use under Policy 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIRECINISELLO.COM**: Transferred

PANELLISTS

Name	**Mr. Luis H. de Larramendi**

DATE OF PANEL DECISION 2012-04-10