Decision for dispute CAC-UDRP-100411

Case number	CAC-UDRP-100411
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Domain names	pirellireagenzy.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Above.com Domain Privacy

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

Complainant is, inter alia, proprietor of the registered Community trademark PIRELLI RE, CTM 006083158 with a priority of July 9, 2007 in classes 35 and 36, inter alia for real estate services

FACTUAL BACKGROUND

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

I. FACTUAL GROUNDS

Complainant is a well-known company founded in 1872 and based in Milan, Italy. The Company’s core business is identified as 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, Complainant 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). Pirelli RE Agency is the network in franchising of Pirelli RE.
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, Complainant, as a result of the desire to focus exclusively on core industrial activities in the tyre sector, concluded the spin-off the real estate business and renamed Pirelli RE into Prelios.

The Complainant's protected rights

Trademarks:

Complainant is owner of numerous registrations and/or applications for trademarks, comprising the keyword "PIRELLI". 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

Complainant has used such trademarks for 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, Complainant enjoys extensive rights in such trademarks which are internationally well-known.

Domain names:

Complainant is also owner of numerous domain names listed. In this dispute the Complainant relies in particularly on its primary domain name, "pirelli.com", created on January 11, 1995 as well as on the following domain names:
a) pirellireagency.com, created on July 30, 2003;
b) pirellire.com, created on March 12, 2003;
c) pirellire.net, created on March 12, 2003;
d) pirellire.org, created on March 12, 2003;
e) pirelliagency.com, created on October 14, 2001.

Company name:

Complainant 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 and company by laws .
During its century-old history Complainant has changed its company name, leaving always unchanged the dominant part of it, namely "PIRELLI" .

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

* * * *

The domain name “pirellireagenzy.com” was registered on November 18, 2011, i.e. well after Complainant’s trademarks. As certified by the attached printout of the relevant WHOIS records at the time of filing of the Complaint, due to a privacy or proxy service, Above.com Domain Privacy is shown as registrant.
Soon after CAC's Request for registrar verification, the Registrar disclosed the data of the underlying registrant of the diputed domain name:
Host Master
Transure Enterprise Ltd
Mill Mall Suite 6 PO Box 3085 Wickhams Cay 1 Road Town
Tortola
3085
British Virgin Islands
+1.5016482820
hostmaster@transureent.com.
Being now aware of the identity of the "true" domain name holder, the Complainant adds Host Master - Transure Enterprise Ltd as Co-respondent to the dispute.

II. LEGAL GROUNDS

A. PROCEDURAL ISSUES

The Complainant requests that this dispute be allowed to proceed against Above.com Domain Privacy as well as Host Master - Transure Enterprise Ltd.
See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, paragraph 4.9.
See also CAC Decision in Case no. 100221 (nationalrentelcar.com, interpisecarrental.com).

B. MERITS

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 and in numerous other countries worldwide, its domain names and its company name for the following reasons.

The disputed domain name is confusingly similar to the trademarks, company name and domain names of Pirelli (hereinafter together “PIRELLI Marks”), because it fully incorporates the dominant part of PIRELLI Marks, namely the wording “PIRELLI”.
Regarding the Pirelli RE trademarks, the word “agenzy” has been added which is the typo of the generic word “agency”.
Furthermore, comparing the disputed domain name and Pirelli’s domain name “pirellireagency.com” the difference is only the letter “z” instead of the letter “c”.
It is well-founded that adding a generic/descriptive term or adding, deleting or substituting letters neither affect the attractive power of the dominant part of PIRELLI Marks, e.g. “PIRELLI”, nor is sufficient to negate the confusingly similarity between the disputed domain name and PIRELLI Marks.
The domain name “pirellireagenzy.com” can be inter alia confused with the trademark registrations and/or applications of Pirelli valid in Italy and worldwide and the domain names registered by Pirelli, in particular, with pirelli.com, pirellireagency.com, pirellire.com, pirellire.net, pirellire.org and pirelliagency.com as well as with the company name of Pirelli.
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/D2000-1409 (Sony Kabashiki Kaisha v. Inja, Kil - finding that “[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 trademark SONY”); NAF/FA141825 (chemyahoo.com and others - "it is also well-established under the Policy that a domain name composed of a trademark coupled with a generic term still is confusingly similar to the trademark"); WIPO/D2002-0367 (experianautomotive.com – finding that addition of the generic term, “automotive”, does not distinguish

Respondent’s domain name from Complainant's mark because the domain contains Complainant's EXPERIAN mark in its entirety); WIPO/2002-0835 (unitedairline.com); NAF/FA94730 (statfarm.com); NAF/FA94737 (marriot.com); WIPO/2002-0762 (abeds.com); WIPO/D2000-0130(chromalin.com); WIPO/D2000-0999 (telstraa.com); WIPO/D2000-0588 (gameb0y.com); NAF/FA94370 (replacing an "u" by an "o" in sunglasshot.com); WIPO/D2000-0039 (budgetsaver.com).

The Complainant shall make a prima facie showing that the Respondents have 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).
Complainant has no relationship with Above.com Domain Privacy and/or Host Master - Transure Enterprise Ltd whatsoever. Complainant has never authorized Above.com Domain Privacy and/or Host Master - Transure Enterprise Ltd to use the domain name “pirellireagenzy.com” or any other domain name. Additionally, there is no indication that Above.com Domain Privacy and/or Host Master - Transure Enterprise Ltd have 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 “pirellireagenzy.com” in the address bar of an internet browser resolves to a web site containing third parties’ links to further web sites. Hence, there is no evidence that the use of “pirellireagenzy.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 Above.com Domain Privacy and/or Host Master - Transure Enterprise Ltd have been commonly known by the domain name “pirellireagenzy.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).

The disputed domain name has been registered and is being used in bad faith considering, from one side, that the “true” registrant hid behind a privacy shield. Above.com Domain Privacy is a privacy or proxy registration service operated by registrar Above.com Pty. Ltd..
The manner in which such a service is used may constitute a factor indicating bad faith. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, paragraph 3.9.
Furthermore, this disputes concerns a typical case of typosquatting. As mentioned previously the disputed domain name wholly incorporates the dominant part of the well-known PIRELLI Marks, namely the wording “PIRELLI”. With reference to the Complainant’s Pirelli RE trademarks the descriptive word “agenzy”, typoing of “agency”, has been added. With reference to the Complainant domain name “pirellireagency.com” the difference is the substitution of the letter “c” with “z”.
A review of the contents of the web site to which “pirellireagenzy.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).
The registration and the use in bad faith of the domain name "pirellireagenzy.com" is clearly evident from the fact that the domain name is 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. The domain name "pirellireagenzy.com", confusingly similar to PIRELLI Marks, is deliberately used 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 "pirellireagenzy.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); Case N. 100221 (nationalcarrentel.com; interpisecarrental.com).
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 "pirellireagenzy.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 Above.com Domain Privacy and/or Host Master - Transure Enterprise Ltd in the disputed domain name; 4) the bad faith of the Above.com Domain Privacy and/or Host Master - Transure Enterprise Ltd in the registration and use of the disputed domain name, the undersigned authorized representative of the Complainant requests that the domain name "pirellireagenzy.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 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 against the two Respondents as requested by the Complainant, in particular since the initial Respondent disclosed only after filing of the Complaint an identity of another Respondent.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name “pirellireagenzy.com “ is confusingly similar to the Complainant’s “PIRELLI RE” trademarks since the element “agenzy” is not distinctive for a website advertising goods. The Complainant contends that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name, and is not commonly known under the disputed domain names.
In lack of any Response from the Respondents, or any other information indicating the contrary, the Panel concludes that the Respondents have no rights or legitimate interests in respect of “ pirellireagenzy.com”.
The Complainant also proved that the Respondents, inter alia, is using the disputed domain on a website advertising goods covered by Complainant´s trademarks and is therefore intentionally attempting to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with Complainant´s trademark.

The Panel accordingly finds that the disputed domain name was registered and is used in bad faith in accordance with 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. **PIRELLIREAGENZY.COM**: Transferred

PANELLISTS

Name	**Dietrich Beier**

DATE OF PANEL DECISION 2012-04-30

Publish the Decision