Decision for dispute CAC-UDRP-101103

Case number	CAC-UDRP-101103
Time of filing	2015-11-19 14:21:35
Domain names	AYAZOTOMOTIVPIRELLI.COM, FNBPIRELLI.COM, GUNMARLASBURSAPIRELLI.COM, ILHANDIREKCIPIRELLI.COM, JANT1PIRELLI.COM, KARAOGLUPIRELLI.COM, LEVENTROTBALANSPIRELLI.COM, MASLAKPIRELLI.COM, NADIRAVCANPIRELLI.COM, PIRELLIBAYI.NET, TURKPIRELLI.COM, ULUSOYPIRELLITRABZON.COM, YIGITLERPIRELLI.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Domain Admin Domain Admin whoisprotection biz

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings that would relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant gives evidence it has rights on trademarks, trade names and domain names. The Panel will only mention the former, as the UDRP rules apply to trademarks only.

Pirelli is owner of numerous registrations and/or applications for trademarks, comprising the keyword “PIRELLI”. Trademarks of the Complainant are registered in Italy and in many other countries all over the world. Pirelli has used its trademarks for many, many years in connection with:

- power cables and systems sector (classes 9 and 38 of the International Classification System of Goods and Services);
- telecommunications cables and systems sector (classes 9 and 38 of the International Classification System of Goods and Services);
- tyre sector (class 12 of the International Classification System of Goods and Services);
- real estate sector (class 36 of the International Classification System of Goods and Services).

Furthermore, products and services of classes 7, 14, 17, 18, 25, 28, 35, 41 and 42 belong to many trademark registrations of Pirelli.

In particular, the Complainant owns the following trademarks valid also in Turkey under:

- national word trademark “PIRELLI” no. 24696 registered on May 6, 1960 in classes 1, 2, 7, 8, 9, 10, 11, 12, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28 and 34;
- international figurative trademark “PIRELLI” no. 592485 registered on October 16, 1992 in classes 11, 17, 20 and 24;
- international figurative trademark “PIRELLI” no. 873853 registered on November 3, 2005 in classes 9 and 12;
- international figurative trademark “PIRELLI” no. 983473 registered on August 5, 2008 in classes 9 and 28;
- international figurative trademark “PIRELLI” no. 944476 registered on September 14, 2007 in classes 12, 37 and 39.

as certified by the extracts from the WIPO Romarin database and certificates of registration attached hereto.

Pirelli 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.

FACTUAL BACKGROUND

The Complainant describes the context as follows [references to annexes omitted].

“Pirelli & C. S.p.A. (hereinafter referred to as “Pirelli”) is a well-known multinational company. With sales of 6.15 billion Euros in 2013, it is the fifth largest global tyre manufacturer and leader in the high-end segments with high technological content. Today, Pirelli has 21 plants located in 13 countries throughout the world (Italy, U.K., Germany, Russia, Turkey, Romania, China, Egypt, Argentina, Brazil, Venezuela, Mexico, U.S.A.) and a commercial network that covers over 160 countries.

Founded in 1872 and listed on Milan Stock Exchange since 1922, Pirelli is distinguished for its long industrial tradition, which has always been combined with capacity for innovation, product quality and brand strength. A strength supported since 2002 by PZero fashion and high-tech project and further enhanced by Formula 1, for which Pirelli is the exclusive tyre supplier since 2011.

In line with its “green performance” strategy, Pirelli - always focused on research and development - operates with ever increasing attention to products and services of high quality and technology and low environmental impact.
Over the years, further to its core business, namely the tyre manufacturing, identified as Pirelli Tyre, Pirelli has created new businesses in other segments: Pirelli Ambiente, engaged in the renewable energy sector; Pirelli & C. Eco Technology, dedicated to developing technologies to control pollutant emissions; Pirelli Labs, a centre of technological excellence and engine of innovation.

Pirelli is distinguished for its long industrial tradition, which has always been combined with capacity for innovation, product quality and brand strength. Thanks to the success and leader position achieved by Pirelli in relation with all segments in which it operates, its trademarks are well-known worldwide.

In 2008 Pirelli was ranked among the 10 most valuable Italian global brands. According to Interbrand valuation made in 2011, Pirelli’s brand has a value of 2.27 billion Euros, with an increase of 26% compared vs 1.8 billion Euros in 2010. Pirelli’s presence in Formula 1 contributed for 200 million Euros to this growth.

Pirelli aims to use the advantage of its trademark as a driver to favor growth in the premium segment. According to the Interbrand figures, the Pirelli brand is 15% more effective than other brands in the choice of tyre purchases mainly due to the consumer's perception of a premium brand particularly appreciated for its sporting, glamorous and prestigious image. Marketing expenditure is forecast to double in future to increase the brand’s fame in all key premium markets, by optimizing the allocation between advertising and digital marketing and creating strong synergies between tires (Pirelli), Fashion (P Zero), the Pirelli Calendar and Formula 1.

(...)

The domain names AYAZOTOMOTIVPIRELLI.COM, FNBPIRELLI.COM, GUNMARLASBURSAPIRELLI.COM, ILHANDIREKCIPIRELLI.COM, JANT1PIRELLI.COM, KARAOGLUPIRELLI.COM, LEVENTROTBALANSPIRELLI.COM, NADIRAVCANPIRELLI.COM, ULUSOYPIRELLITRABZON.COM, YIGITLERPIRELLI.COM were registered on December 25, 2014, MASLAKPIRELLI.COM was registered on December 18, 2014, PIRELLIBAYI.NET was registered on December 16, 2014, TURKPIRELLI.COM was registered on April 9, 2014, i.e. well after PIRELLI Marks.

The disputed domain names involve a privacy or proxy registration service. As certified by the attached printout of the relevant WHOIS records at the time of filing of the Complaint, Domain Admin Domain Admin, whoisprotection biz was shown as registrant."

The Complainant contends these domain names should be transferred to Pirelli, because they constitute usurpation and violation of the rights of the Complainant with regard to its trademarks, trade name and domain names for the following reasons.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Panel addresses this question below.

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel does not need to address this question.

BAD FAITH

The Panel does not need to address this question.

PROCEDURAL FACTORS

THE PROCEEDINGS SHALL BE CONDUCTED IN TURKISH, NOT IN ENGLISH

Under paragraph 11 of the Rules for Uniform Domain Name Dispute Resolution Policy, “the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. In this case the registrar informed the CAC that “[t]he specific language of the registration agreement is made in Turkish language used by the registrant for the specified domain name”.

The Panel also makes the following observations:

- The Registrar is based in Turkey
- The Respondent provided an address in Turkey and the Complainant does not contend that this would be a phony address
- The Complainant contends the disputed domain names combine its mark with names that have a meaning in the (sole) Turkish language, with names of Turkish cities, or with a common Turkish surname
- Screenshots show webpages apparently written in Turkish (and for sure not in English)
- The notification of commencement of administrative proceedings on December 7, 2015 was sent in English and Turkish, the response expiration reminder on December 21, 2015 was sent just in English. The Panel asked the Center to communicate copies of e-mails that were sent to the Respondent in both languages. The analysis of their structure shows that (1) the subject of the mail is in English only, (2) the mail begins in English and there is no mention that a Turkish translation follows (3) the text in English is long – 419 words, 410 if one does not count the details of the sender, (4) after the sender signature, there is a gap of several lines. The respondent has not replied at all. On December 29 the CAC issued a communication where it wrote: “be aware that neither the written notice of the Complaint nor the advice of delivery thereof

was returned to the Czech Arbitration Court. The CAC is therefore unaware if the written notice was received by the Respondents or not." This may be an indication of bad faith as a well as a negative evidence that he does not understand English at all (see CAC Case No. 100903 "arcelormittal-hq.com": "the Respondent should have a fair opportunity to reply to the Complaint which did not happen in this case as the Complainant failed to prove the Respondent can understand language in which the Complaint was filled").

These undisputed facts show that there is a strong nexus to Turkey and its language and no nexus at all to the English language. Still, after the Registrar communicated that the language of the disputed names registration agreement is Turkish, the Complainant requested to conduct the proceedings in English. It provided the following supporting arguments and evidence [references to annexes omitted].

"The Complainant is a well-known Milan-based multinational company with 21 plants located in 13 countries throughout the world, including Turkey, and a commercial network that covers over 160 countries. Complainant is owner of numerous trademark registrations worldwide, comprising Turkey.

Such trademarks are well-known internationally thanks to the vast and widespread advertising campaigns carried out by Pirelli and recently to the participation of Pirelli in Formula 1 as exclusive tyre supplier since 2011.

Respondents have registered and/or used the disputed domain names which are confusingly similar to Complainant's trademarks since they wholly comprise such well-known marks. Moreover, most of the disputed domain names resolve to websites, containing the identical design and the well-known trademark of the Complainant, misleading the Internet users to believe that the sites are connected to the Complainant and its business.

Hence, Respondents are likely to be well aware of the Complainant's international business and its marks. Considering that the Complainant is a one of the major global tyre manufacturer company and that the Complainant's marks are registered in numerous countries all over the world, comprising Turkey, and recognized by a great number of consumers worldwide, English is retained to be the most appropriate language for these proceedings."

The panel finds that in the arguments above the Complainant almost exclusively speaks of itself and its trademarks, where it was first expected to give evidence that the Respondent was able to defend himself in English language proceedings. The sole fact that the Respondent is likely to be aware of the existence of the Complainant's trademark is not a conclusive factor that can in itself lead to the requested change of language. The Panel would have been more interested in knowing, for example, whether the Whois privacy service the Respondent used was available just in English or was also offered in Turkish language.

The Complainant cites the 10 WIPO decisions that are listed in the second edition of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions at paragraph 4.3 ("4.3 What is the proper language of the proceeding and what are the relevant considerations in this regard?"). These decisions merely state that a provider may accept the language of the complaint, but that such acceptance is subject to the panel's authority to determine the appropriate language of the proceeding on appointment.

The Complainant also cited decisions of the CAC where the Panels accepted the change of language.
It first referred to CAC Case No. 100967 "trianglerental.com". This case is not relevant here as facts show that the respondent in that dispute was already very well acquainted with UDRP proceedings ("There are numerous UDRP proceedings in which the real owner of the disputed domain name (…) has been involved"). The Complainant does not argue that the Respondent in the present dispute would be familiar with UDRP.

Complainant then referred to CAC Case No. 100955 "hapaglloydcargos.com". In that case the Panel accepted to conduct proceedings in English after the Complainant argued that this language was appropriate because the Respondent's address was in London and the entire website accessible through the disputed domain name was in English. In the present dispute, the Respondent's address is in Turkey and none of the screenshots that were submitted show that the disputed names would be used in English. In all of them, without exception, the language is apparently Turkish.

Complainant cited CAC Case No. 100956 "aribnb.com" where the Panelist took note that the webpage to which the Respondent had pointed the disputed domain name was a US based website in English language. It also noted that this name comprised the English acronym “bnb” (for "bed & breakfast") and a common typo variation of the English word "air". Again, the domain names are not used in English, and the Complainant does not contend they would contain an English word. This case thus has no precedential value for the present dispute.

Lastly Complainant cited CAC Case No. 100934 "enterprisecarshre.com" where the Complainant claimed (and submitted evidence thereof) that the Respondent appeared to be very familiar with the English language since the disputed domain names resolved to websites which appeared to have exclusively English content and all of the links on the web pages to which the disputed domain names resolved were in English. This case is not relevant here for the same reasons as above.

The Panel finds that the present dispute has too loose connections with English to accept that the proceedings are conducted in this language. The Panel finds it is even more important to exercise the discretionary power not to accept the requested change in light of the difficulty inherent to assessing whether the disputed domain names can be confusingly similar to the Complainant’s marks. The Panel will briefly address this point to show how important is the linguistic issue in the present proceedings.

UNDERSTANDING OF THE TURKISH LANGUAGE IS KEY TO DETERMINING WHETHER THE DISPUTED DOMAIN NAMES ARE CONFUSINGLY SIMILAR TO THE COMPLAINANT’S MARKS

The Complainant contends as follows [references to annexes omitted].

“The disputed domain names are confusingly similar to the PIRELLI Marks, because they wholly incorporate the dominant part of such marks, namely the wording “PIRELLI”. Slight differences, as the addition of letters or numbers (e.g. 1) or generic/descriptive terms (e.g. ayaz meaning frosty in Turkish; otomotiv meaning automotive in Turkish; jant meaning tyre rim in Turkish; balans meaning balance in Turkish; bayi meaning dealers in Turkish; turk meaning Turkish) or geographic terms (e.g. Bursa a city in Turkey; Maslak a district of Istanbul; Trabzon a city in Turkey; Yigitler a village in Turkey) or names (Direkci, Karaoglu, Ulusoy) to the Complainant’s trademarks, neither affects the attractive power of the dominant part of such trademarks, i.e. “PIRELLI”, nor is sufficient to negate the confusingly similarity between the disputed domain names and Complainant’s trademarks.

The domain names so nearly resemble the marks of the Complainant in appearance, sound or the ideas suggested by such marks as to be likely to be mistaken for the PIRELLI Marks.

See decisions: CAC Case no. 100373 "tyreclubpirelli.com"; CAC Case no. 100392 "pneuspirelli.net"; CAC Case no. 100398 "pirelliwinterreifen.info"; CAC Case no. 100422 "pirellireifen.info"; CAC Case no. 100425 "pirellireimmobiliare.com"; CAC Case no. 100413 “pirellirecinisello.com”; NAF no. FA1403001547895 “metzelerchina.com”; CAC Case no. 100877 “pirellimexico.com”.

It is well founded that the disputed domain names are to be considered confusingly similar to the PIRELLI Marks since the generic top-level suffix “.com” and “.net” are to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the PIRELLI Marks (as it is a technical requirement of registration). See decisions: WIPO/DNU20140001 “pirelli.nu”; WIPO/DPW20140004 “pirelli.pw”.

The domain names “ayazotomotivpirelli.com”, “fnbpirelli.com”, “gunmarlasbursapirelli.com”, “ilhandirekcipirelli.com”, “jant1pirelli.com”, “karaoglupirelli.com”, “leventrotbalanspirelli.com”, “maslakpirelli.com”, nadiravcanpirelli.com”, “pirellibayi.com”, “turkpirelli.com”, ulusoypirellitrabzon.com” and “yigitlerpirelli.com” can be confused with:

a) the trademark registrations and/or applications of Pirelli valid in Italy, in Turkey and worldwide;
b) the trade name of Pirelli;
c) the domain names registered by Pirelli, in particular, with Complainant’s primary domain name: pirelli.com.

The confusing similarity of the disputed domain names to PIRELLI Marks, is likely to lead to confusion and/or association for the Internet users."

In multiple instances the Complainant refers to the meaning in Turkish language of the words that are combined with its mark in the disputed domain names. To argue there is a risk of confusion in this language the Complainant provides screenshots of an online translation tool (apparently set in Italian), where the Panel cannot always see what the source language is and what the target language is. The Panel also cannot know whether these words have one or several other meaning(s) in this language: the screenshots show just one equivalent in English for each word, but the Complainant does not explain the way this online dictionary works (does it always provide just one translation, or the most popular, or the most relevant, etc.) nor does it explain the method it used to reach this result.

For the words combined with its mark that are surnames or toponyms, the Complainant referred to Wikipedia articles. Since the Complainant submitted Wikipedia articles as evidence, the Panel would like to point out that collaborative websites with permissive edits have little probative value. "[A]nyone can alter the content of Wikipedia at any time, casting doubt on the validity of the information contained therein", the International Trademark Association wrote in 2006 (source: The TTABlog at thettablog.blogspot.com/2006/07/inta-writes-to-pto-wikipedia-and.html). A Wikipedia article cannot be seen as reliable information in proceedings, as it can be manipulated before the proceedings, to serve the interests of a party (see, for an example a harsh criticism of the reliance on Wikipedia articles, in a decision of the U.S. Court of Federal Claims: Campbell v. Secretary of Health and Human Services, 69 Fed.Cl. 775, No. 02-554 V, February 14, 2006).

These Wikipedia articles are of little help to a Panel who is not acquainted with the Turkish language, country or culture and thus cannot determine whether or not there is a risk of confusion. For example, annex 34 is a Wikipedia article on "Bursa" that begins as follows "This article is about the city. For bursas in the human body, see Synovial bursa. For other uses, see Bursa". In other words the evidence admits the word "Bursa" is ambiguous and can have several other meanings, rendering more complex the task of deciding whether this name can lead to confusion in the present proceedings.

There are also words for which no translation is provided. This is for example the case of LEVENTROTBALANSPIRELLI.COM, for which annex 31 shows the translation of "balans" would be "balance" but for which the Complainant does not mention the chain of characters "leventrot".

These are additional reasons why the Panel rejects the Complainant's request to conduct the proceedings in English.

PRINCIPAL REASONS FOR THE DECISION

Facts show the case has a strong nexus to Turkey and its language and no nexus at all to the English language. The Panel finds that the present dispute has too loose connections with English to accept that the proceedings are conducted in this language, and rejects the complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **AYAZOTOMOTIVPIRELLI.COM**: Remaining with the Respondent
2. **FNBPIRELLI.COM**: Remaining with the Respondent
3. **GUNMARLASBURSAPIRELLI.COM**: Remaining with the Respondent
4. **ILHANDIREKCIPIRELLI.COM**: Remaining with the Respondent
5. **JANT1PIRELLI.COM**: Remaining with the Respondent
6. **KARAOGLUPIRELLI.COM**: Remaining with the Respondent
7. **LEVENTROTBALANSPIRELLI.COM**: Remaining with the Respondent
8. **MASLAKPIRELLI.COM**: Remaining with the Respondent
9. **NADIRAVCANPIRELLI.COM**: Remaining with the Respondent
10. **PIRELLIBAYI.NET**: Remaining with the Respondent

11. **TURKPIRELLI.COM**: Remaining with the Respondent
12. **ULUSOYPIRELLITRABZON.COM**: Remaining with the Respondent
13. **YIGITLERPIRELLI.COM**: Remaining with the Respondent

PANELLISTS

Name	**Dr. Cédric Manara**

DATE OF PANEL DECISION 2016-01-09

Publish the Decision