Decision for dispute CAC-UDRP-101318

Case number	CAC-UDRP-101318
Time of filing	2016-10-24 15:00:11
Domain names	METZELERTIRE.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Pirelli Tyre S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Domain Hostmaster, Customer ID : 19322954182600, Whois Privacy Services Pty Ltd

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states that it "is owner of numerous registrations and/or applications for trademarks world-wide, comprising the keyword 'METZELER'," including, among many others cited and supported in the Complaint, U.S. Reg. No. 1,200,980 for METZELER for use in connection with "motorcycle tires; motorcycle accessories, namely saddlebags; motorcycle wheel rims and rim-bands; valves for motorcycle tires; tubes for motorcycle tires" (registered May 23, 2000); and WIPO Reg. No. 431,981 for METZELER for use in connection with "Wheel rims; tires for aircraft; tires and inner tubes for bicycles; inner tubes and pneumatic tires for motor cars, motorcycles and bicycles; vehicle wheels entirely of rubber; anti-skid casings for pneumatic tires; inner tube protectors (rubber strips for wheel rims); textile thread or steel wire layers for pneumatic tires; valves for pneumatic tires, rubber materials for repairing pneumatic tires" (registered October 3, 1978).

FACTUAL BACKGROUND

Complainant asserts the following facts, all of which are not contested by the Respondent:

"Metzeler is a well-known motorcycle tire company founded in 1863 in Munich, Germany by Robert Friedrich Metzeler" and "has been part of Pirelli Group since 1986". Further, "Metzeler has more than 115 years of experience in motorcycle tire

development and supply to the world's leading manufacturers," "is a well-known brand world-wide" and "operates in numerous countries all over the world... through its distributor network such as in Austria, Brasil, Canada, Germany, France, Italy, Japan, Spain, Switzerland, UK and in the United States".

Complainant contends, in relevant part, as follows:

"The domain name 'metzelertire.com' was registered on October 11, 2005, i.e. well after Complainant's trademarks" and "currently resolves to a website, which contains a disclaimer that 'this domain may be for sale. click here for more info'" but "[p]reviously the domain name resolved to a website containing the same disclaimer and third parties' (some of them are competitors of the Complainant) links to further websites related to tires, business in which the Complainant is involved".

"The disputed domain name is confusingly similar to the Complainant's trademarks, because it wholly incorporates the dominant part of such marks, namely the wording 'METZELER'" and "[s]light differences as the addition of a generic term 'tire' (related to the business in which the Complainant is involved) neither affects the attractive power of the dominant part of Complainant's trademarks, e.g. 'METZELER', nor is sufficient to negate the confusingly similarity between the disputed domain name and Complainant's trademarks".

Respondent lacks rights or legitimate interests in respect of the disputed domain name because, inter alia, neither the respondent initially named (Domain Hostmaster, Customer ID: 19322954182600, Whois Privacy Services Pty Ltd) nor the identified "underlying registrant" (D Pontiac) "has ever received any approval, expressed or implied, to use the Complainant's trademarks in or as part of any domain name and that the Complainant has no association, affiliation and/or dealings of any nature whatsoever with the Respondents and neither endorses nor promotes their services"; "there is no indication that the Respondents ha[ve] any legitimate interest in the trademarks 'METZELER' 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), WIPO [and] the United States Patent and Trademark Office (USPTO)"; "there is no evidence that the Respondents' use of 'metzelertire.com' is either a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain"; and there is no evidence that the Respondents... have been commonly known by the domain name 'metzeler.com'."

The disputed domain name has been registered and is being used in bad faith because, inter alia, "[t]aking into account the vast and widespread advertising campaigns carried out by the Complainant for the promotion of products covered by its marks, it is unlikely that the registration of the domain name in question may be attributed to a mere chance and not, as is, with a full awareness and intent to exploit the reputation and good will of the Complainant's trademarks"; "Respondents must have been aware of the Complainant's trademarks and intentionally attempted to use them for commercial gain"; and

"[b]y registering a well-known mark or by failing to check whether the registration would have infringed on the right of a third party, the Respondents" acted in bad faith.

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 Complaint as originally filed identified the Respondent as Domain Hostmaster, Customer ID : 19322954182600, Whois Privacy Services Pty Ltd. However, the registrar verification identified the domain name holder as D Pontiac. Accordingly, and following a deficiency notice, the Complainant filed an amended Complaint identifying both entities as Respondents.

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

Based upon the trademark registrations cited by the Complainant, it is apparent that the Complainant has rights in and to the METZELER trademark. This is consistent with previous decisions under the Policy. See, e.g., Pirelli Tyre S.p.A. v. PERFECT PRIVACY, LLC, CAC Case No. 101309 (transfer of <getmetzeler.com>).

As to whether the Disputed Domain Name is identical or confusingly similar to the METZELER trademark, the relevant comparison to be made is with the second-level portion of the domain name only (i.e., “metzelertire”), as it is well established that the Top-Level Domain (i.e., “.com”) may generally be disregarded for this purpose. See the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (hereinafter the “WIPO Overview 2.0”), paragraph 1.2 (“[t]he applicable top-level suffix in the domain name (e.g., ‘.com’) would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark.”).

The Disputed Domain Name contains the METZELER Trademark in its entirety, plus the word "tire". The Panel finds that “the dominant portion” of the disputed domain name contains the METZELER trademark and that the addition of the word “tire” is insufficient “to create a distinct domain name capable of overcoming a proper claim of confusingly similar”. F.M. Tarbell Co. dba Tarbell, Realtors v. Name Catcher/Mark Lichtenberger, WIPO Case No. D2007-0189. This is especially true because the word “tire” is associated with Complainant’s use of the METZELER trademark. Indeed, because the word “tire” “relate[s] to the Complainant’s business”, it actually “increases the likelihood of confusion between the Domain Name[] and the Complainant’s trademark”. See, e.g., Inter-Continental Hotels Corporation v. Hui Lian Yang/Yang Hui Lian; a/k/a Jian Ren Zhou/Zhou Jian Ren; a/k/a Jian Guo Liu/Liu Jian Guo, WIPO Case No. D2014-0272.

Accordingly, the Panel finds that the Complainant has proven the first element of the Policy.

Complainant has argued that Respondent lacks rights or legitimate interests in respect of the disputed domain name because, inter alia, neither the respondent initially named (Domain Hostmaster, Customer ID: 19322954182600, Whois Privacy Services Pty Ltd) nor the identified "underlying registrant" (D Pontiac) "has ever received any approval, expressed or implied, to use the Complainant’s trademarks in or as part of any domain name and that the Complainant has no association, affiliation and/or dealings of any nature whatsoever with the Respondents and neither endorses nor promotes their services"; "there is no indication that the Respondents ha[ve] any legitimate interest in the trademarks 'METZELER' 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), WIPO [and] the United States Patent and Trademark Office (USPTO)"; "there is no evidence that the Respondents’ use of 'metzelertire.com' is either a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain"; and there is no evidence that the Respondents... have been commonly known by the domain name 'metzeler.com'."

Under the Policy, “a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP”. WIPO Overview 2.0, paragraph 2.1.

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the respondent has registered or the respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 or location or of a product or service on the respondent's website or location. Policy, paragraph 4(b).

In this case, the Complainant in effect argues that bad faith exists pursuant to paragraph 4(b)(iv) of the Policy, for the reasons set forth above.

Numerous panels have found the registration and use of a domain name that is confusingly similar to a Complainant's trademark to constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy where, as here, the domain name is associated with monetized parking pages that contain links for goods or services related to the Complainant. See, e.g., Wal-Mart Stores, Inc. v. Whois Privacy, Inc., WIPO Case No. D2005-0850; Columbia Pictures Industries, Inc. v. North West Enterprise, Inc., WIPO Case No. D2006-0951; and Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753.

Accordingly, the Panel finds that the Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **METZELERTIRE.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2016-12-08

Publish the Decision