Decision for dispute CAC-UDRP-106576

Case number	CAC-UDRP-106576
Time of filing	2024-06-04 08:29:22
Domain names	pinarello.buzz

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Cicli Pinarello S.r.l.

Complainant representative

Organization	Convey srl

Respondent

Name	ce shi

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 is an Italian racing-bike producer founded in 1952 in Treviso, Italy, by Giovanni Pinarello, a famous professional bike racer and his brother, Carlo Pinarello. Famous professionals' cyclists use the Complainant's bikes for relevant international races.

The Complainant owns the following trademarks:

- International Trademark PINARELLO (word mark), Reg. No. 479435, in International Classes ("ICs") 12, 18 and 25, registered on September 19, 1983, and in force until September 19, 2033;
- International Trademark P PINARELLO AND DESIGN, Reg. No. 1513828, in ICs 12, 18 and 25, registered on October 17, 2019, and in force until October 17, 2029;
- International Trademark P AND DESIGN, Reg. No. 1117694, in ICs 9, 12, 18, 25, registered in October 20, 2011, and in force until October 20, 2031.

FACTUAL BACKGROUND

The Complainant founded in 1952 as a bike shop in Treviso, Italy, by Giovanni Pinarello, a famous professional bike racer and his brother, Carlo Pinarello; originally the Complainant produced city bikes, but, over the years, the production shifted towards sport bikes, accessories and apparel. In 1957, the Complainant started to supply Padovani, a local bike team. Popularity of the manufacturer grew, and in the sixties, it sponsored many national and international professional teams, included Team Telekom, Bnesto, Del Tongo, Team Sky.

Famous professional cyclists competed using Pinarello bikes over the years, like Fauso Bertoglio, Pedro Delgado, Miguel Indurain, Franco Chioccioli, Bradely Wiggins, and Chris Froome among others. In 2022, Filippo Ganna beat the world Hour record using a Pinarello bike.

The Complainant has distinguished itself in the cycling industry for the innovation and the search for new materials and cutting-edge technology to make its bicycles fastest.

The Complainant's bikes have been sold in over 50 countries around the world; counts with a worldwide distributors network. The Complainant is a favorite of Tour de France riders and has provided bikes to 12 Tour winners.

By today, the Complainant produces many bicycles for the road, track, E-bikes (NYTRO), mountain bikes and cyclo-cross, and even an in-house component brand – MOST.

Ahead of the Paris 2024 Olympic games, the Complainant rolled out new 3D printed models of bikes, that will be used by the Italian team to compete in the upcoming games.

The Complainant also owns the following domain names, which includes the Trademark PINARELLO, being: <pinarello.it>, registered on July 12, 1996; <pinarello.com> registered on May 29, 2014, and the following ones: <ciclipinarello.com>, <ladiespinarello.com>, <lapinarello.com>, <lapinarello.it>, <pinarello.org>, <pinarello.ski>, <pinarellogroup.it>, <pinarellotravel.com>, <pinarellotravel.it>, <teamgfpinarello.com>, <teampinarello.com>, and <teampinarello.it>.

The Complainant is also active on the main Social Media, as Facebook, Instagram, YouTube, Twitter and Strava.

The disputed domain name <**pinarello.buzz**> was registered on April 19, 2024, and resolves to an inactive website.

PARTIES CONTENTIONS

Complainant Contentions:

- Regarding the first element of the Policy, in summary, the Complainant contends that the disputed domain name <pinarello.buzz> is identical to the famous Trademark PINARELLO, which it is reproduced in the disputed domain name.

- Regarding the second element of the Policy, in summary, the Complainant contends that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks; that the Respondent is not an authorized reseller of the Complainant and has not been authorized to the registration and use of the disputed domain name; that upon the Complainant's information and belief, the Respondent is not commonly known by the disputed domain name as individual, business or other organization and its family name does not correspond to PINARELLO or the disputed domain name; that the Respondent was indeed using the disputed domain name's website in connection with the sale of counterfeit products bearing the Complainant's trademarks, which cannot be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name; that the disputed domain name carries a high risk of implied affiliation.

- Regarding the third element of the Policy, in summary, the Complainant contends that the disputed domain name was registered in bad faith, since the trademark PINARELLO has a strong reputation and is widely known in the sector of the cycling industry; that given the Complainant's trademark registration and intensive use of the sign PINARELLO since 1952, the Respondent could not have possibly ignored the existence of the Complainant's trademark; that the disputed domain name's website, where the Respondent offered counterfeit products bearing the Complainant's trademark, there was no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant, creating the impression that it was authorized by the Complainant; that the disputed domain name is being used in bad faith, since the Respondent used it to offer counterfeit product based in the Complainant; that on May 10, 2024, the Complainant sent a Cease and Desist Letter to the Respondent which was never replied, but after such date, the disputed domain name resolves to a website displaying solely the following text: "P***8 This store is under construction.", with it, implicitly demonstrating that the Respondent has recognized to be infringing upon the Complainant's rights.

Response

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical 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 disputed 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 disputed 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

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will consider each of these requirements in turn.

Identical or Confusingly Similar

Having reviewed the available record, part of the Trademarks submitted by the Complainant are composed by figurative elements as well. The Panel notes that there are no disclaimers over its textual elements, being PINARELLO (e.g.: Reg. No. 1513828). The Panel concludes that the Complainant has sufficiently proved of having Trademark Rights over the word PINARELLO, i.e.: Reg. No. 479435 and that any of the figurative elements are disregarded. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 1.10.

The Panel finds that the Complainant's Trademark it is exactly reproduced in the disputed domain name, therefore, the disputed domain name is identical to Complainant's PINARELLO Trademark. See WIPO Overview 3.0, section 1.7.

In relation to the generic Top-Level Domain ".buzz", it may be ignored. See WIPO Overview 3.0., section 1.11.1.

The Panel finds the first element of the Policy has been established.

Rights or Legitimate Interests

According to the evidence submitted by the Complainant and considering the absence of any communication or administrative Response by the Respondent, this Panel determines that the Complainant has established its prima facie case in relation to the second element of the Policy. To this Panel, it is clear that:

(1) the Respondent purposely selected a widely known trademark as PINARELLO which has been registered in multiple jurisdictions, to build a website based on the Complainant's trademark, suggesting a false affiliation, to offer counterfeit products bearing the Complainant's trademarks, confusing the users who seeks or expects to find the Complainant on the Internet.

(2) the Respondent is not associated or affiliated to the Complainant.

(3) the Complainant has not granted any authorization to the Respondent to use the PINARELLO Trademark, whether as an official distributor or license to offer any of its products, or any rights to apply for the registration of the disputed domain name.

(4) there is no evidence that the Respondent has become commonly known by the disputed domain name.

(5) the fact that the disputed domain name has been used to build a website based on the Complainant's Trademark, in this Case, to offer counterfeit products, it is sufficient to this Panel to find that such use cannot constitute a bona fide offering of goods or services, and/or any legitimate non-commercial or fair use, as set out in paragraph 4.c.(i) and 4.c.(iii) of the Policy, and that the Respondent has incurred on illegal activity, with all of it, lacking of any rights or legitimate interests in respect of the disputed domain name. See WIPO Overview 3.0, section 2.13.1.

The Panel finds the second element of the Policy has been established.

Registered and Used in Bad Faith

a) Registration in Bad Faith:

Based on the submitted evidence, the Panel finds that the Complainant acquired its Trademark Rights over the word PINARELLO in 1983 (e.g.: Reg. No. 479435). The Complainant is a recognized racing-bike producer with international presence and a widely known and distinctive Trademark as PINARELLO, including on the Internet.

Given the nature of the disputed domain name, and the fact that the Respondent selected a widely-known Trademark, in this Case, PINARELLO, to build a website based on the Complainant's Trademark, with counterfeiting purposes, it is sufficient to this Panel to find that at the time of the registration of disputed domain name, the Respondent did it, with the Complainant's business and Trademark in mind, therefore, incurring in bad faith. See WIPO Overview 3.0, sections 3.2.1 and 3.2.2.

Furthermore, "the mere registration of a domain name that is identical or confusingly similar… to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith", see section 3.1.4 of the WIPO Overview 3.0.

Therefore, this Panel concludes that the disputed domain name has been registered in bad faith.

b) Bad Faith Use:

Given the fact that, by the time of this Decision, the disputed domain name points to an inactive website, this Panel, address such non-use, under the passive holding doctrine.

Accordingly, section 3.3 of the WIPO Overview 3.0 states that:

> "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.
>
> While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:
>
> (i) the degree of distinctiveness or reputation of the complainant's mark,
>
> (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,
>
> (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and
>
> (iv) the implausibility of any good faith use to which the domain name may be put."

In this Case, the Complainant has proved that:

(i) PINARELLO is a widely-known Trademark, which enjoys distinctiveness and a strong reputation in the sector of the cycling industry;

(ii) the Respondent failed to submit any communication and/or a Response;

(iii) the Respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), which under the present circumstances, this Panel perceives it as a clear attempt of avoiding any notification or causing delay concerning a domain name's dispute;

(iv) the disputed domain name has been used for illegal activity and currently it's passively held, which under any scenario can only contribute with the Complainant's Trademark abuse.

In relation to the change of the content of the website after the Complainant's sent the Cease-and-Desist Letter to the Respondent, in this Case, this Panel, finds it as an additional proof which emphasizes Respondent's knowledge in relation to the trademark infringement committed against the Complainant's PINARELLO Trademark.

Therefore, the disputed domain name is being used in faith as well.

The Panel finds that the Complainant has established the third element of the Policy.

Accepted

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

1. **pinarello.buzz**: Transferred

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2024-07-04

Publish the Decision