

## DISPUTE RESOLUTION SERVICE

**D00016069**

### Decision of Independent Expert

Pirelli & C. S.p.a.

and

Tyrettech

**1. The Parties:**

Lead Complainant: Pirelli & C. S.p.a.  
Viale Piero e Alberto Pirelli 25  
Milan  
Lombardy  
20126  
Italy

Respondent: Tyrettech  
Linstock Road End  
Carlisle  
Cumbria  
CA64QD  
United Kingdom

**2. The Domain Name:**

pirelliracing.co.uk

**3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

The dispute was received by the Dispute Resolution Service (DRS) on June 12, 2015. The Complaint was validated on June 12, 2015 and notification of the Complaint was sent to the Parties on the same date.

The Response was received on July 3, 2015 and notified to the Parties on the same date. A Reply to the Response was received on July 10, 2015 and notified to the parties on the same date. Mediation failed on July 28, 2015 and the Expert decision payment was received on July 30, 2015.

#### **4. Factual Background**

The factual background of the Complainant is taken from the Complaint. The Complainant, based in Milan, Italy, is a major manufacturer of tyres, cables, fashion items, optical and other technological products with 21 plants located in 13 countries world-wide. The Pirelli brand receives high profile exposure through events including Formula 1 racing, the Superbike World Championship, the Supersport World Championship, through its PZero sports fashion goods and the Pirelli Calendar.

The Complainant owns an extensive portfolio, provided in a list running to some 66 pages, of trademarks comprising or incorporating the word PIRELLI or its equivalent in foreign scripts. The Complainant's trademarks apply in the fields of power cables, telecommunications cables and other sectors as well as tyres. Representative trademarks pertaining to tyres include:

PIRELLI, word mark, European Community trademark, registered June 7, 2005, registration number 3733136, international classes 1-45;

PIRELLI, design, United Kingdom Intellectual Property Office, registered April 8, 1965, registration number 877984, international class 12.

The Complainant uses the domain name [pirelli.com](http://pirelli.com), created on January 11, 1995 as its primary domain name, and has also registered numerous other domain names including [pirelli.co.uk](http://pirelli.co.uk).

The factual background of the Respondent is taken from the Response. The only information of substance provided by the Respondent is that it was a service provider to Pirelli Motorsport UK and Pirelli Italy from 1999 to 2012.

The disputed Domain Name was registered on August 21, 2012.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has extensive rights in the PIRELLI trademarks, having invested substantial effort and expenditure in them over many years. The Complainant has used the trade name PIRELLI since 1872 and has a United Kingdom subsidiary named Pirelli Tyres Ltd., with registered office in Derby Road, Burton-on-Trent, Staffordshire.

The Complainant contends that the Domain Name fully incorporates the trademark word PIRELLI and is to be considered identical or similar to the trademark. The Complainant submits that the suffix ".co.uk" should be disregarded in the determination of identity or

similarity. The addition of the word “racing” after PIRELLI is insufficient to negate such identity or similarity. Moreover, given the Complainant’s association with car and motorcycle racing, the incorporation of the word “racing” in the Domain Name increases the likelihood of confusion with the Complainant’s trademark.

The Complainant further contends that the Domain Name constitutes an Abusive Registration in the hands of the Respondent. The Complainant has no relationship whatsoever with the Respondent and has never authorised or licensed the Respondent to register or to use the Domain Name.

The Complainant contends that in the light of the extensive advertising of the PIRELLI trademark, it is unlikely that the Respondent was unaware of the Complainant or its trademark or that the Respondent chose the word PIRELLI by chance.

The Complainant states that the Domain Name resolves to a parking page with sponsored links permitting the Respondent to earn pay-per-click revenue. This constitutes use to attract, for commercial gain, Internet users to the Respondent’s website by confusion with the Complainant’s trademark.

Referring to the domain name [pirellicalendar.co.uk](http://pirellicalendar.co.uk), which may be in mistake for [pirelliracing.co.uk](http://pirelliracing.co.uk), the Complainant also contends that the Respondent has acquired it primarily for the purpose of selling, renting or otherwise transferring it to the Complainant or a competitor of the Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring it; or as a blocking registration; or for the purpose of unfairly disrupting the business of the Complainant.

The Complainant contends there is no evidence that the Respondent, before being aware of the Complainant’s cause for complaint, has used or made demonstrable preparations to use the Domain Name or a similar domain name in connection with a genuine offering of goods or services; or been commonly known by the name or legitimately connected with a mark similar to the Domain Name; or made a legitimate non-commercial or fair use of the Domain Name.

The Complainant says that the Domain Name is not generic or descriptive and the Respondent is not making fair use of it. The Respondent’s holding of the Domain Name is not consistent with any express term of any written agreement between the Respondent and the Complainant.

The Complainant states that it sent a cease and desist letter to the Respondent on January 24, 2014. There was no reply.

The Complainant has made references to certain previous decisions under the DRS that it considers may support its position.

The Complainant requests the transfer to itself of the Domain Name.

## **B. Respondent**

The Respondent’s answer to the question “Why should the complaint not succeed?” is too brief to summarise and therefore is reproduced *verbatim*:

“Tyretech was a service provider to pirelli Motorsport UK & pirelli Italy from 1999-2012  
Registered pirelli racing as there was no trade mark

Was purchased as investment as pirelli UK at the time had very little racing background

As never been used or advertised in any form to date”

### **C. Complainant’s Reply to the Response**

The Complainant’s reply reiterates its position and adds that:

The Respondent has not submitted any documental proof to support its assertions.

If there had been any relationship between the Complainant and the Respondent, the Respondent would not have been authorized to register any domain name identical or confusingly similar to the Complainant’s trademarks.

The Respondent’s assertions that there was no Pirelli racing trademark registered and Pirelli UK had very little racing background are neither true nor relevant, it being sufficient that the Complainant owns the trademark PIRELLI.

## **6. Discussions and Findings**

Paragraph 2(a) of the Policy requires the Complainant to prove, on the balance of probabilities, that:

- “i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

### **Complainant’s Rights**

The Complainant has produced copies of numerous registration documents for the trademark PIRELLI that satisfy the Expert as to the Complainant’s rights in the trademark for the purposes of the Policy.

### **Identity or Similarity**

The Domain Name is [pirelliracing.co.uk](http://pirelliracing.co.uk), of which the country code and second level domain designations are a technical necessity that may be disregarded in the determination of confusing similarity. What remains is “pirelliracing”, which is easily read as “PIRELLI racing”. On the evidence produced, PIRELLI is a strong trademark well known internationally and dating back to 1872, whilst the association of that trademark with motor and motorcycle racing is well publicised. The Respondent’s assertion that no trademark existed in the form “Pirelli racing” is of no consequence because the Domain Name prominently features the trademark PIRELLI. In the Expert’s finding the Domain Name, by reproducing the trademark PIRELLI, is confusingly similar to that trademark and the incorporation of the word “racing”, in the circumstances of the Complainant’s well-known association with racing, exacerbates the confusing similarity. The Expert finds for the Complainant in the terms of paragraph 2(a)(i) of the Policy.

### **Abusive Registration**

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Paragraph 3 of the Policy, Evidence of Abusive Registration, reads in part:

"a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. for the purpose of unfairly disrupting the business of the Complainant;
- ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- iii.
- iv.
- v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
  - A. has been using the Domain Name registration exclusively; and
  - B. paid for the registration and/or renewal of the Domain Name registration.

b. Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

(.....)"

According to the Respondent, the Domain Name has "... never been used or advertised ...". Notwithstanding the provision under paragraph 3(b) of the Policy that non-use of the Domain Name is not, in itself, evidence of an Abusive Registration, in this case there is more.

On the evidence, the trademark PIRELLI is world-famous. The Respondent makes plain that it was well aware of the PIRELLI trademark through its dealings with Pirelli Motorsport UK

and Pirelli Italy. Furthermore the Domain Name was, by the Respondent's own admission, "... purchased as investment ...". An investment may be defined as, for example, the employment of money for the purpose of gain. Thus it may reasonably be deduced that the Respondent was in possession of the Domain Name comprising a world-famous trademark without good reason and for the purpose of gain. The Respondent may not necessarily have decided how it might capitalise on its investment, for instance by profitable sale to the Complainant or a competitor, or for the attraction of traffic for commercial purposes, or for some other purpose. It is sufficient that the Respondent's potential gain on its investment would inevitably be founded in its appropriation of the Complainant's trademark without permission, thereby taking unfair advantage of the Complainant's Rights within the meaning of paragraph 1(i) of the Policy. Accordingly, on the balance of probabilities, the Expert finds Abusive Registration in the non-exclusive terms of paragraph 3(a) of the Policy.

A specific ground on which the Complainant asserts Abusive Registration is governed by paragraph 3(a)(ii) of the Policy. The screen capture of the Domain Name parking page displays self-described "sponsored links" such as "Unlimited Bandwidth" and "Multi-site hosting". The earnings of sponsored links (not necessarily accruing to the Respondent) would derive from the potential for some visitors to the Domain Name to be confused, at least initially, into thinking they would be visiting a website of the Complainant. The Expert further finds Abusive Registration under paragraph 3(a)(ii) of the Policy.

Paragraph 3(a)(ii) of the Policy incorporates the words "... using or threatening to use the Domain Name ...". In the context, a threat need not be overtly expressed. The holding of the Domain Name even passively amounts to an on-going threat that it may at any time be brought into active use by the Respondent or be transferred to another for some nefarious purpose, constituting additional grounds for a finding of Abusive Registration.

The Complainant's assertions that the Respondent has made an Abusive Registration under the provisions of paragraphs 3(a)(i)(A), 3(a)(i)(B) and 3(a)(i)(C) of the Policy (profitable sale, blocking registration and disruption respectively) appear to refer to a complaint about [pirellicalendar.co.uk](http://pirellicalendar.co.uk) and cannot proceed.

Paragraph 4 of the Policy provides for the Respondent to seek to demonstrate that the Domain Name is not an Abusive Registration. The Respondent has not realistically made any showing under this provision and did not reply to the Complainant's cease and desist letter.

In summary, on the evidence and on the balance of probabilities, the Expert finds Abusive Registration of the Domain Name by the Respondent in the terms of paragraph 3(a) of the Policy.

## **7. Decision**

The Expert finds that the Complainant has Rights in respect of the trademark PIRELLI; that the disputed Domain Name [pirelliracing.co.uk](http://pirelliracing.co.uk) is confusingly similar to the Complainant's trademark; and that the disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name [pirelliracing.co.uk](http://pirelliracing.co.uk) is ordered to be transferred to the Complainant.

**Signed** Clive Trotman

**Dated** August 13, 2015