

## **ADMINISTRATIVE PANEL DECISION**

Pirelli & C S.P.A. v. raiger maag

Case No. D2023-2184

### **1. The Parties**

Complainant is Pirelli & C S.P.A., Italy, represented by TALIENS Partnerschaft von Rechtsanwälten mbB, Germany.

Respondent is raiger maag, Finland.

### **2. The Domain Name and Registrar**

The disputed domain name <pirelli-montblanc.com> (the “Domain Name”) is registered with Hostinger, UAB (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 18, 2023. On May 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from named Respondent (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to Complainant on May 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 24, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 20, 2023.

The Center appointed Clive L. Elliott, K.C., as the sole panelist in this matter on June 27, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

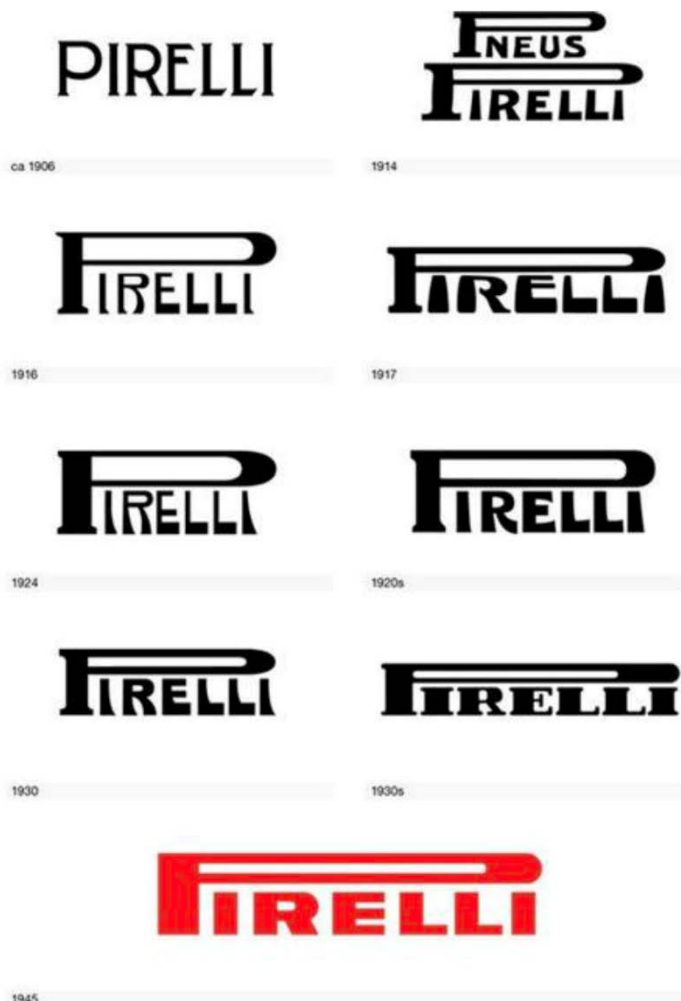
Complainant is a large, internationally well-known, tyre manufacturer established in Italy 150 years ago. It has 30,700 employees, 18 production facilities in 12 countries, and a commercial footprint of around 18,000 points of sale in more than 160 countries including the United States of America ("United States"), where the business is conducted by its affiliate Pirelli Tire LLC.

Complainant belongs to the famous Pirelli Group, one of the market leaders worldwide in the production and commercialization of tyres. Pirelli also supplies tyres to the Formula One™ World Championship.

Complainant has operated its business under the company name PIRELLI since 1872 and it operates its main website under "www.pirelli.com".

Complainant is the owner of numerous registrations for trade marks around the world comprising the keyword "PIRELLI" ("Complainant's Mark"), such as, *inter alia*, International Registration 592485 registered on October 16, 1992, and United States word mark 893585 registered on June 30, 1970.

The "elongated capital P" used by PIRELLI as Complainant's Mark since the early 20th century has become an acknowledged emblem of the company and of its products, with minor changes to its graphics over the years as follows:



To celebrate Complainant's 150th anniversary, Montblanc created a special edition of its famous pen the Meisterstuck ("masterpiece" in German), designed to underline the common pursuit of excellence shared by the two companies, blending the luxury and elegance of Montblanc with the fame of Pirelli. These pens are the Meisterstuck Great Masters Pirelli Limited Edition 72 and the Montblanc Meisterstuck Pirelli Limited Edition 1872.

According to the publicly available Whois, the Domain Name was registered on April 3, 2023, and at the time of the Complaint the Domain Name resolved to a website replicating almost identically Complainant's webpage dedicated to the co-operation with Montblanc, including the use of Complainant's Mark, logo and copyrighted images for the relevant Montblanc Meisterstuck pens. In addition, it offers for sale 72NFT, allegedly entitling the holder to receive one of the depictive handmade 72 pens by the clicking of a link, which opens a WalletConnect popup containing a QR code to be scanned by a compatible cryptocurrency wallet app.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant states that the Domain Name is confusingly similar to Complainant's Mark as it contains Complainant's Mark in its entirety, with the addition of a hyphen and the trade mark MONTBLANC, which belongs to a third party, namely Montblanc-Simplo GmbH. This addition of a third-party mark and the hyphen, Complainant asserts, does not avoid the confusing similarity between the Domain Name and Complainant's Mark.

Complainant also outlines the manner in which it has collaborated with the well-known luxury goods manufacturer Montblanc. In particular, reference is made to the collaboration entered into to mark Complainant's 150th anniversary, whereby Montblanc created a special edition of its famous pen the Meisterstuck. Complainant indicates that the purpose of this exercise was to celebrate the common pursuit of excellence shared by the two companies. That is, in effect, a blend of the luxury and elegance of Montblanc with the fame of Pirelli. Furthermore, Complainant secured the written consent of the owner of the MONTBLANC trade mark contained in the Domain Name to pursue and request the transfer of the Domain Name through this UDRP proceeding (Annex 12 to the Complaint).

Complainant also contends that it has not licensed or otherwise permitted Respondent to use Complainant's Mark in connection with the Domain Name or otherwise, and furthermore to the best of Complainant's knowledge, Respondent is not using the Domain Name in connection with a *bona fide* offering of goods and services, but rather Respondent is using Complainant's Mark and copyrighted images on the Domain Name to create the impression that the Domain Name is linked to Complainant, suggesting an affiliation with Complainant, which is not the case.

Complainant suggests that this is evidence that the Domain Name has been registered and is being used in bad faith, as Respondent is attempting to attract for commercial gain Internet users to its website by creating a likelihood of confusion.

### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

For the reasons set out below the Panel finds for Complainant.

### **A. Identical or Confusingly Similar**

Complainant asserts it is a large, well-known, tyre manufacturer that has operated for approximately 150 years and has an international footprint and reputation. It identifies certain of its registered trade marks and refers to its goodwill in such trade marks by virtue of its international use of Complaints Mark. Complainant has therefore established it is the owner of Complainant's Mark.

It is plain that the Domain Name reproduces Complainant's Mark, containing the word "Pirelli" in its entirety. The Domain Name also includes the word "Montblanc". Here, the inclusion or addition of this word does not prevent a finding of confusing similarity, regardless of its status as a third party trade mark or even a geographic term. See sections 1.8 and 1.12 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, Complainant's Mark is clearly recognizable in the Domain Name notwithstanding the addition of the word "Montblanc". See section 1.7 of [WIPO Overview 3.0](#).

The Domain Name is therefore confusingly similar to Complainant's Mark.

The first ground under the Policy is made out.

### **B. Rights or Legitimate Interests**

Absent any response, Respondent provides no basis upon which the Panel might conclude that it has some rights or legitimate interests in the Domain Name. Complainant on the other hand asserts that Respondent has no authority to use the Domain Name and has no connection with Complainant.

Complainant submits that Complainant and Montblanc have collaborated together, as described above. The Panel accepts that through this collaboration, the two named parties have created an outlet for luxury goods and an associated goodwill and reputation in those goods, which effectively resides in or is associated with the two entities together. In other words, that there is a shared goodwill and reputation in the combined term "Pirelli Montblanc", as showcased by the use of the name "Montblanc Meisterstück Pirelli Limited Edition 1872" for one of the collaboration's pens.

In addition, Complainant asserts that Respondent is using Complainant's Mark and copyrighted images on the Domain Name to create the impression that the Domain Name is somehow linked to Complainant, suggesting an affiliation with Complainant, contrary to the fact. In particular, given the collaboration mentioned above, the construction of the Domain Name was a deliberate attempt to infer an association. The Panel is satisfied that such use of the Domain Name is likely to cause confusion amongst Internet users who visit Respondent's site.

The Panel finds that Respondent's conduct is likely to mislead members of the public and such conduct is therefore not legitimate and Respondent cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. Accordingly, Respondent has no rights or legitimate interests in respect of the Domain Name.

Complainant has established the second ground under the Policy.

### **C. Registered and Used in Bad Faith**

Complainant submits that the Domain Name has been registered and is being used in bad faith, as Respondent is attempting to attract for commercial gain Internet users to its website by creating a likelihood of confusion. That argument has merit.

Clearly, Complainant has significant goodwill and reputation in Complainant's Mark, and given the publicized collaboration with the famous brand MONTBLANC, Respondent's construction and use of the Domain

Name combining these marks was intentionally done to mislead. The Panel accepts that Respondent has registered and used the Domain Name in a manner that is likely to confuse customers, and that this is indicative of bad faith conduct on Respondent's part.

Accordingly, the Panel finds that the Domain Name was registered and used in bad faith.

Complainant has therefore established the third ground under the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <pirelli-montblanc.com>, be transferred to the Complainant.

*/Clive L. Elliott, K.C./*

**Clive L. Elliott, K.C.**

Sole Panelist

Date: July 11, 2023