
ADMINISTRATIVE PANEL DECISION

PIRELLI & C. S.p.A. v. Thibault Le Conte

Case No. D2023-4230

1. The Parties

The Complainant is PIRELLI & C. S.p.A., Italy, represented by Bugnion S.p.A., Italy.

The Respondent is Thibault Le Conte, United States of America.

2. The Domain Name and Registrar

The disputed domain name <pirellispeedboats.com> is registered with Squarespace Domains II LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 11, 2023. On October 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 18, 2023.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on October 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 12, 2023. The Respondent did not submit any formal response. However, in response to the Center's Notice of Registrant information, on October 17, 2023, the Center received an informal email from the Respondent from an email address different to the Registrar-confirmed email address. On November 15, 2023, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on November 28, 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.

Given that the Center received, on October 17, 2023, in response to the Center's Notice of Registrant information, an informal email from the Respondent from an email address different to the Registrar-confirmed email address and that this email address was not used in the formal notification sent by the Center on October 23, 2023, the Panel issued on December 28, 2023, the Procedural Order No 1, out of abundance of caution to instruct the Center to send the Procedural Order and Notification of Complaint and Commencement of Administrative Proceeding, originally sent on October 23, 2023, to the Respondent at its other email address, inviting the Respondent to indicate whether it wished to participate to the proceeding by January 2, 2024, and inviting the Complainant to comment on the Respondent's submissions, if any, by January 5, 2024, extending the decision date to January 7, 2024. No submission was made by the Respondent.

4. Factual Background

The Complainant belongs to the Pirelli group of companies, which originated in 1872 in Italy manufacturing rubber products. Presently, the PIRELLI trademark is used in connection with the production and offering of tyres, cables, sports and clothing items, mattresses, inflatable boats, real estate, and environmental protection services, having had a revenue of EUR 6.6 billion in the fiscal year of 2022.

In connection with the nautical sector, the Complainant conceptualised the Nautilus vessel and introduced the 'Laros' inflatable boat in 1963 as one of Italy's pioneering demountable models, followed by other models. Later, in 2005, the Complainant entered into a commercial alliance, renewed up to the present day, with the Italian nautical enterprise Sacs Tecnorib S.p.A. ("Tecnorib"), having licensed the PIRELLI trademark in connection with a line of rigid inflatable boats.

The Complainant is the owner of the following, amongst several others, trademark registrations:

- International trademark registration No. 873853 for the word and device mark PIRELLI, registered on November 3, 2005, successively renewed, in classes 9 and 12; and
- European Union trademark registration No. 009483173 for the word mark PIRELLI, filed on October 29, 2010 and registered on May 12, 2011, successively renewed, in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

The disputed domain name was registered on May 19, 2023, and presently does not resolve to an active webpage. Tecnorib contacted the Respondent through a third party in an attempt to acquire the disputed domain at a fair market price, which was offered for EUR 200,000.00 (Annex 23 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant asserts that its PIRELLI trademark is a globally celebrated trademark being recognized amongst global consumers as a result of its leadership in the tyre industry, as well as a result of being an official supplier and/or sponsor to some of the world's most followed motorsports and sporting events.

The Complainant quotes UDRP precedents that have recognized the reputation of the PIRELLI brand such as *Pirelli & C S.P.A. v. raiger maag*, WIPO Case No. [D2023-2184](#); *Pirelli & C. S.p.A. v. Mons Lundqvist*, WIPO Case No. [DNU2014-0001](#); *Pirelli & C. S.p.A. v. Gaoxiang*, WIPO Case No. [DPW2014-0004](#); and *PIRELLI & C. S.p.A. v. Oleg Shmatko*, WIPO Case No. [D2010-0086](#).

The Complainant further asserts that the PIRELLI trademark has achieved significant commercial acclaim as well as resounding endorsement of the intellectual and creative investment made by the Complainant in the nautical sector (Annex 17 to the Complaint).

The Complainant contends that the disputed domain name reproduces the entirety of the PIRELLI famous trademark with the addition of the term “speedboats” which does not prevent a finding of confusing similarity thereof and quite to the contrary is associated with the Complainant in view of the systematic use of the joint terms in Tecnorib’s official website.

In addition to that, the Complainant emphasizes that the Respondent does not hold rights or legitimate interests in the disputed domain name, not having the Complainant or its partner, Tecnorib, bestowed any form of authorisation to register or utilise the worldwide renown PIRELLI mark within a domain name or any other capacity.

As to the Respondent’s bad faith, the Complainant asserts that its PIRELLI trademark has global and historical recognition, being it implausible and legally unsound that such a mark could be co-opted without prior knowledge, having the Respondent purposefully registered the disputed domain name that incapsulates it with a descriptive term explicitly referring to the Complainant’s product line. In addition to that, under the Complainant’s view, the EUR 200,000.00 price suggested by the Respondent for the disputed domain name precludes the negation of bad faith as stipulated in the Policy.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. However, on October 17, 2023, the Respondent stated, among other things, that it is not familiar with this process, it had been contacted in June/July regarding the disputed domain name, and it had been working on a project related to the disputed domain name.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms “speedboats” may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. In addition to that, the Complainant indeed states that neither it, nor its partner, Tecnorib, bestowed any form of authorisation to register or utilise the worldwide renown PIRELLI mark within a domain name or any other capacity.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules. In its informal email communication, the Respondent alleges that it has been working on a project related to the disputed domain name, however the Respondent has not submitted any evidence to that effect. Moreover, the Panel finds that the disputed domain name is inherently misleading. See [WIPO Overview 3.0](#), section 2.5.1.

As noted above, there is no active use of the disputed domain name which consists of the reproduction in its entirety of the Complainant’s famous trademark with a term relating to one of the Complainant’s products. However, the Panel notes the Complainant’s un rebutted claim that the Respondent has offered the disputed domain name for EUR 200,000.00, which the Panel considers is an attempt by the Respondent to unduly profit from the Complainant’s valuable trademark.

Furthermore, the absence of any trademarks registered by the Respondent corresponding to the disputed domain name corroborates with the indication of the absence of a right or legitimate interest.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

As previously noted, the disputed domain name presently does not resolve to an active webpage. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The registration and use of the disputed domain name in bad faith can be found in the present case in view of the following circumstances:

- (i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name;
- (ii) the well-known status of the Complainant's trademark and the nature of the disputed domain name;
- (iii) the inactive use of the disputed domain name;
- (iv) the offer for sale of the disputed domain name for an amount that likely exceeds the Respondent's out-of-pocket expenses in registering it;
- (v) the Respondent's choice to retain a privacy protection service so as to conceal its true identity; and
- (vi) the indication of what appear to be false contact details, the Center not being able to deliver the Written notice to the Respondent.

Based on the available record, the Panel finds that the Complainant has established the third element of 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 disputed domain name <pirellispeedboats.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: January 9, 2024