

ADMINISTRATIVE PANEL DECISION

PIRELLI & C. S.P.A. v. Lilly Davey, Finlay Elliott, Sophie Wade, Hannah Walsh, Oliver Lees, and Maya Robinson
Case No. D2024-1588

1. The Parties

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

The First Respondent is Lilly Davey, Italy.

The Second Respondent is Finlay Elliott, Italy.

The Third Respondent is Sophie Wade, Italy.

The Fourth Respondent is Hannah Walsh, Italy.

The Fifth Respondent is Oliver Lees, Italy.

The Sixth Respondent is Maya Robinson, Italy.

Together, collectively, “the Respondents”.

2. The Domain Names and Registrar

The disputed domain names <pirelliargentina.com>, <pirelliaustralia.com>, <pirelliaustria.com>, <pirellibelgie.com>, <pirellibelgique.com>, <pirellibrasil.com>, <pirellibulgaria.com>, <pirellicanada.com>, <pirellichile.com>, <pirellicolombia.com>, <pirellicz.com>, <pirellidanmark.com>, <pirellideutschland.com>, <pirellieesti.com>, <pirellifrance.com>, <pirelligreece.com>, <pirellihrvatska.com>, <pirellihungary.com>, <pirelliireland.com>, <pirelliisrael.com>, <pirelliitalia.com>, <pirellijapan.com>, <pirellikuwait.com>, <pirellilatvija.com>, <pirellilietuva.com>, <pirellimexico.net>, <pirellinederland.com>, <pirellinorge.com>, <pirellinz.com>, <pirelliperu.com>, <pirellipolska.com>, <pirelliportugal.com>, <pirelliromania.com>, <pirellischweiz.com>, <pirellislovenija.com>, <pirellislovensko.com>, <pirellisouthafrica.com>, <pirellispain.com>, <pirellisrbija.com>, <pirellisuisse.com>, <pirellisuomi.com>, <pirellisverige.com>, <pirelliturkey.com>, <pirellityresuk.com>, <pirelliuae.com>, and <pirelliuruguay.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 16, 2024. On April 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 19, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 22, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all of the disputed domain names are under common control. The Complainant filed an amended Complaint on April 24, 2024.

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 Respondents of the Complaint, and the proceedings commenced on May 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on May 22, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on May 29, 2024. 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

Established in Italy in 1872, the Complainant is a globally operating corporation engaged in the engineering and production of rubber-based components under the brand name PIRELLI. It has a diversified geographical presence worldwide, owing 18 production plants in 12 countries and a commercial presence in 160 countries around the world, with a total of 31,000 employees.

The Complainant is one of the market leaders worldwide in the production and marketing of rubber tires, which has been the Complainant’s core competency since its establishment.

The Complainant frequently serves as the exclusive tire supplier for high profile car sports competitions, including Formula 1 car races, and as main sponsor of distinguished Italian sport teams, including the Team Luna Rossa one of contender in the America’s Cup sailing competition.

The Complainant is the owner of numerous trademark registrations worldwide consisting of or encompassing the PIRELLI designation in both word and figurative forms, including the following:

- European Union trademark registration No. 009483173, filed on October 29, 2010 and registered on May 12, 2011;
- International trademark registration No. 944476, registered since September 14, 2007 based upon Italian trademark registration No. 1061314;
- International trademark registration No. 873853, registered since November 3, 2005 based upon Italian trademark registration No. 981814.

The disputed domain names were all registered on November 9, 2023. The evidence in the Complaint is that each of them resolves to an active website seemingly offering several models of PIRELLI trademarked tires and prominently featuring the Complainant's PIRELLI trademark and logo; each website also displays a photograph (likely captured during an America's Cup regatta) depicting a sailboat displaying the PIRELLI trademark and logo on the hull and sails.

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 names.

Notably, the Complainant contends that:

- The conditions exist for consolidation of the multiple Respondents/disputed domain names since the circumstances of the case indicate that in all likelihood all of the Respondents are either the same entity or are operating under common control. In this connection, the Complainant refers to the consensus view of UDRP panels on the matter;
- The Complainant has established rights in the PIRELLI trademark by virtue of longstanding use worldwide and several registrations in various jurisdictions;
- The Complainant's PIRELLI trademark is distinctive and renowned, as consistently recognized in previous UDRP decisions. See *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](#); *Pirelli & C. s.p.a. v. Oleg Shmatko*, WIPO Case No. [D2010-0086](#);
- The disputed domain names are confusingly similar to a trademark in which the Complainant has rights, since they all consist of the Complainant's PIRELLI mark with the addition of a geographical element (e.g., "Argentina", "Australia", "Africa", "Spain", etc.) which does nothing to distinguish the disputed domain names from the Complainant's PIRELLI mark;
- The Respondents have no rights or legitimate interests in the disputed domain names since: (i) the Complainant has not authorized or somehow given consent to the Respondents to register and use the disputed domain names, and the Respondents' use of the disputed domain names is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use;
- The disputed domain names were registered and are being used in bad faith. The Respondents registered the disputed domain names having in mind the Complainant's PIRELLI trademark, with the clear intention to capitalize on the Complainant's market position and high reputation in the tire sector (of which the Respondents should have been fully aware before registration) for personal gain.

Based on the above the Complainant requests the disputed domain names be transferred to the Complainant.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, having reviewed the available record the Panel notes that:

- The disputed domain names were all registered on November 9, 2023, through the same Registrar;
- The hosting server for the disputed domain name is provided by the same company;
- All of the Respondents appear to be individuals purportedly based in Italy and their physical addresses only contain the information of "Bologna" and "Italy" with email addresses sharing the same pattern "name of the Respondent and number"@cxtmail.com;
- The disputed domain names all direct to a very similar website promoting tire sales and prominently displaying the PIRELLI trademark and logo;
- All of the disputed domain names have the same structure: specifically, the trademark PIRELLI followed by the designation of a geographical term, either in its fully articulated form or through its abbreviation (e.g.: "cz" for Czech Republic).

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

B. 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 3.0](#), section 1.7.

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 Complainant's registered trademark PIRELLI is reproduced and recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the generic Top-Level Domain, such as ".com" or ".net", is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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

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

C. 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 names. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Moreover, as noted in Section 6.B above, the disputed domain names incorporate the Complainant's PIRELLI mark in its entirety together with various geographical terms, which carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Indeed, as per the uncontested evidence submitted with the Complaint, the Respondent has used the disputed domain names to deliberately cause consumer confusion through operating a website which prominently displays the Complainant's mark PIRELLI and offers allegedly PIRELLI branded tire products. There is not any disclaimer on the website disclosing the (lack of) relationship between the Parties. This cannot constitute fair use.

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

D. 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.

In the present case, given the worldwide reputation of the Complainant's trademark PIRELLI, in the Panel's view it is difficult to believe that the Respondent did not have in mind the Complainant's mark when registering the disputed domain names. The fact that the Respondent has used the disputed domain names following registration, to resolve to a website which prominently features the Complainant's PIRELLI trademark, and allegedly offers PIRELLI branded tire products, establishes both the Respondent's actual knowledge of the Complainant's rights as at the date of registration of the disputed domain names and the Respondent's intention to take unfair advantage of those rights. Indeed, the Respondent has used the disputed domain names to capitalize on the goodwill of the Complainant's PIRELLI trademark, and has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites.

The above conduct constitutes bad faith registration and use of the disputed domain names under the Policy.

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 names <pirelliargentina.com>, <pirelliaustralia.com>, <pirelliaustria.com>, <pirellibelgie.com>, <pirellibelgique.com>, <pirellibrasil.com>, <pirellibulgaria.com>, <pirellicanada.com>, <pirellichile.com>, <pirellicolombia.com>, <pirellicz.com>, <pirellidanmark.com>, <pirellideutschland.com>, <pirellieesti.com>, <pirellifrance.com>, <pirelligreece.com>, <pirellihrvatska.com>, <pirellihungary.com>, <pirelliireland.com>, <pirelliisrael.com>, <pirelliitalia.com>, <pirellijapan.com>, <pirellikuwait.com>, <pirellilatvija.com>, <pirellilietuva.com>, <pirellimexico.net>, <pirellinederland.com>, <pirellinorge.com>, <pirellinz.com>, <pirelliperu.com>, <pirellipolska.com>, <pirelliportugal.com>, <pirelliromania.com>, <pirellischweiz.com>, <pirellislovenija.com>, <pirellislovensko.com>, <pirellisouthafrica.com>, <pirellispain.com>, <pirellisrbija.com>, <pirellisuisse.com>, <pirellisuomi.com>, <pirellisverige.com>, <pirelliturkey.com>, <pirellityresuk.com>, <pirelliuae.com>, and <pirelliuruguay.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: June 12, 2024