

## **ADMINISTRATIVE PANEL DECISION**

**PIRELLI & C. S.P.A. v. Domain Name Privacy Inc.**

**Case No. D2024-3155**

### **1. The Parties**

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

The Respondent is Domain Name Privacy Inc., Cyprus.

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

The disputed domain name <pirelli.online> is registered with Communigal Communications Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 31, 2024. On August 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 7, 2024, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 7, 2024, 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 amendment to the Complaint on August 8, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 30, 2024.

The Center appointed Dawn Osborne as the sole panelist in this matter on September 12, 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**

The Complainant's core operations span the engineering and production of rubber-based components, including tires for motorcycles, bicycles, and automobiles. However, the Complainant has been engaged in a wide array of industrial sectors, such as the clothing industry and real estate.

The Complainant is the owner of the well known trademark PIRELLI registered, inter alia, as European Union trademark No. 009483173 PIRELLI, for a wide variety of goods and services, including tires, clothing and real estate services, since May 12, 2011.

The disputed domain name was registered on March 26, 2024, and it has been pointed to a website comprising pay-per-click ("PPC") links to products that compete with the Complainant's goods.

#### **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 contends that the disputed domain name registered in 2024 is identical to the Complainant's mark for the purposes of the Policy merely adding the generic Top-Level Domain ("gTLD") ".online".

The Respondent does not have any rights or legitimate interests in the disputed domain name, is not commonly known by it and is not authorised by the Complainant. The disputed domain name has been used for competing commercial PPC links, which is not a bona fide offering of goods or services or a legitimate noncommercial fair use.

The disputed domain name has been registered and used in bad faith, with full knowledge of the Complainant's rights to confuse Internet users for commercial gain and disrupt the Complainant's business.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test 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.

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 entirety of the PIRELLI mark is reproduced within the disputed domain name. The addition of a gTLD such as “.online” is viewed as a standard registration requirement and as such is disregarded under the first element test. [WIPO Overview 3.0](#), section 1.11. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

The closeness of the disputed domain name to the Complainant’s PIRELLI trademark creates the false impression that the disputed domain name is owned by or is affiliated with the Complainant, when this is not the case and is confusing. The Complainant has not authorized the use or registration of this disputed domain name by the Respondent and the Respondent is not commonly known by the disputed domain name. [WIPO Overview 3.0](#), section 2.5.1

The use of the disputed domain name is being used for commercial gain so the Respondent is not making a legitimate noncommercial or fair use. The disputed domain name has been used to generate revenue by competing PPC links which does not constitute a bona fide use of the disputed domain name. [WIPO Overview 3.0](#), section 2.9.

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. 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 name such as those enumerated in the Policy or otherwise.

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.

In the present case, the Panel notes that the Respondent has used the disputed domain name which is identical for the purposes of the Policy to the Complainant’s well known mark for competing PPC links. Such conduct has widely been held by Panels to be intentionally causing confusion with the Complainant’s trademark for commercial gain and disrupting the Complainant’s business. [WIPO Overview 3.0](#), sections 3.1.3 and 3.1.4.

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 <pirelli.online> be transferred to the Complainant.

*/Dawn Osborne/*

**Dawn Osborne**

Sole Panelist

Date: September 23, 2024