

ADMINISTRATIVE PANEL DECISION

Pirelli Tyre S.P.A. v. Internet Services Consulting Pty. Ltd.
Case No. DAU2023-0042

1. The Parties

The Complainant is Pirelli Tyre S.P.A., Italy, represented by Bugnion S.p.A., Italy.

The Respondent is Internet Services Consulting Pty. Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <metzeler.com.au> is registered with Domain Directors Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2023. On the following day, the Center transmitted by email to Domain Directors Pty Ltd a request for registrar verification in connection with the disputed domain name. On September 22, 2023, Domain Directors Pty Ltd. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 22, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was October 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 13, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 18, 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

The Complainant is part of the Pirelli & C. SpA group, which produces tires for cars, motorcycles, and bicycles. The Complainant acquired the assets of Metzeler Reifen GmbH, including the METZELER tire brand, in 1986. According to evidence provided by the Complainant, METZELER brand motorcycle tires have been used in races in Australia since at least 1970 and are offered for sale in Australia.

The Complainant holds trademark registrations in various jurisdictions, including the following Australian trademark registrations:

- Number 605039 for METZELER, registered on March 15, 1996, specifying goods in class 12, including tires and wheelrims;
- Number 605045 for METZELER and elephant device, registered on April 19, 1996, specifying goods in class 7; and
- Number 678037 for METZELER and elephant device, registered on February 25, 1997, specifying goods in class 9.

The above trademark registrations remain current.

The Respondent is an Australian company. According to evidence provided by the Complainant, a panel in a prior proceeding under the auDRP found that the Respondent had registered and was using four domain names in bad faith. See *QSA Brands Pty Ltd. v. Domain Administrator, Internet Service Consultants Pty Ltd.*, WIPO Case No. [DAU2022-0008](#).

The disputed domain name was registered on May 13, 2022. It resolves to a website for “Metzeler Rims Australia” or “MetzelerRims” that provides information about tires, wheels, and other car equipment, including a guide to where to buy tires online. The tire brands presented compete with those of the Complainant. The website provides information and videos about car-racing slot games, and information about betting on motorsports, with embedded links to a betting website. The Contact page does not provide any contact details for the website operator.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical to the Complainant's METZELER trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant is completely unaware of the entity or individual responsible for the disputed domain name. The Complainant has not provided authorization to register or employ the trademark in a domain name. No authorization was granted regarding the contents of the website associated with the disputed domain name, which the Respondent has flagrantly employed to take advantage of the notoriety of the METZELER brand in the vehicle sector to attract Internet users for commercial gain and to make publicity for some of the Complainant's competitors.

The disputed domain name has been registered or subsequently used in bad faith. The disputed domain name is a “blocking” registration. The Respondent has used the disputed domain name exclusively to reroute Internet users to its website, which conspicuously promotes competing products and services. The disputed domain name was selected specifically due to its potential to attract individuals who are, in fact, searching for the Complainant. Moreover, the Respondent is concurrently promoting online betting platforms and gambling-related YouTube videos by engaging Internet users through the disputed domain name.

The Respondent blatantly exploits the METZELER trademark's considerable cachet within the automotive industry, thus reaping undue benefits from the esteemed reputation and significant goodwill attached to the mark.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a name, 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 or subsequently used in bad faith.

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the METZELER mark.

The disputed domain name wholly incorporates the METZELER mark. Its only additional element is a Second-Level Domain ("2LD") extension ".com.au" which, as a standard requirement of domain name registration, may be disregarded in the comparison between the disputed domain name and the Complainant's mark. See *BT Financial Group Pty Limited v. Basketball Times Pty Ltd*, WIPO Case No. [DAU2004-0001](#).

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the auDRP sets out circumstances which, without limitation, if found by the Panel to be proven based on its evaluation of all evidence presented, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the auDRP:

- (i) before any notice to [the respondent] of the subject matter of the dispute, [the respondent's] *bona fide* use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with an offering of goods or services (not being the offering of domain names that [the respondent has] acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, the disputed domain name is identical to the METZELER trademark and resolves to a website for “Metzeler Rims Australia” or “MetzelerRims” that provides information about tires, wheels, and other car equipment, including tire brands that compete with those of the Complainant. The Complainant submits that it does not know the Respondent and that it has not provided authorization to register or employ the METZELER trademark in a domain name. Although the website is presented as a blog, it displays a guide to websites that sell tires as well as links to betting websites. The links presumably operate for the commercial gain of the Respondent, if it is paid to direct traffic to the betting websites, or for the commercial gain of the operators of the betting websites, or both. In the Panel’s view, these circumstances indicate that the Respondent is not making a *bona fide* use of the disputed domain name in connection with an offering of goods or services, nor that it is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers.

As regards the second circumstance set out above, the Respondent is named “Internet Services Consulting Pty. Ltd”. Nothing besides the website associated with the disputed domain name indicates that the Respondent is known as “Metzeler Rims Australia” or “MetzelerRims”. Nothing indicates that the Respondent has been commonly known by the disputed domain name within the terms of paragraph 4(c)(ii) of the auDRP.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that case because it did not respond to the Complainant’s contentions.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has satisfied the second element in paragraph 4(a) of the auDRP.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(b) of the auDRP provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, although it is not an exhaustive list of such circumstances. The fourth circumstance is as follows:

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant’s name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.

With respect to registration, the disputed domain name was registered in 2022, decades after the registration of the Complainant’s METZELER trademark in Australia, where the Respondent is located. METZELER is not a dictionary word, it is a family name, yet the disputed domain name is identical to it, adding only a 2LD extension. The disputed domain name resolves to a website that provides information about tires, among other things, which is the same type of product that the Complainant produces, even though the website relates to car tires and the Complainant uses the METZELER brand with motorcycle tires. These circumstances do not appear to be a coincidence but rather indicate an awareness of the Complainant and its METZELER mark. Accordingly, the Panel finds that the Respondent had the Complainant’s METZELER mark in mind when it registered the disputed domain name.

With respect to use, the disputed domain name resolves to a website for “Metzeler Rims Australia” or “MetzelerRims” that provides information about tires, wheels, and other car equipment, including tire brands that compete with those of the Complainant, as well as a guide to where to buy tires online. The website also displays links to a betting website for commercial gain. In view of these circumstances and the findings in Section 6.B above, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or of a product on that website, within the terms of paragraph 4(b)(iv) of the auDRP.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the auDRP.

7. Decision

For all 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 <metzeler.com.au> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: October 26, 2023