

**IN THE MATTER OF A COMPLAINT PURSUANT TO
THE CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Dispute Number: DCA-1610-CIRA

Domain Names: <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca>.

Complainant: Pirelli & C.S.p.a.

Registrant: The Registrant/ Pneus a Rabais/ Robin Meany

Registrar: Go Daddy Domains Canada, Inc

Panel: The Honourable Neil Anthony Brown QC

Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant in this proceeding is Pirelli & C.S.p.a., Viale Piero e Alberto Pirelli 25, 20126 Milan, Italy ("Pirelli").
2. The Registrants are The Registrant, Pneus a Rabais of 221 Boulevards Maisonneuve, St-Jerome, QC, J5L OA1, Canada and Robin Meany of 661 Ch.Kilkenny, St-Hippolyte, QC, JPA 3P3 ("the Registrants").

THE DOMAIN NAME AND REGISTRAR

3. The Domain Names in issue in this proceeding are <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca> ("the disputed domain names").
4. The Registrar is n Go Daddy Domains Canada, Inc. The disputed domain names were registered by or on behalf of the Registrants on October 8, 2013.

PROCEDURAL HISTORY

5. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy ("the Policy") of the Canadian Internet Registration Authority ("CIRA").
6. According to the information provided by the BCICAC :
 - (a) The Complainant filed a Complaint with respect to the disputed domain names in accordance with the Policy on September 23, 2014.

(b) The Complaint was reviewed and found to be compliant. By letter dated September 25, 2014, the BCICAC as service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process on that date.

(c) The Complaint together with the schedules thereto was sent by BCICAC as service provider to the Registrant electronically by email on September 25, 2014 and delivered on that date; a successful mail delivery report was Subsequently furnished, enabling the Panel to conclude that the Complaint and its schedules were duly delivered to the Registrant. By the same communication the Registrant was informed that it could file a Response in the proceeding on or before October 15, 2014.

(d) The Registrant did not reply to that communication and did not provide a Response.

(e) Under Rule 6.5 of CIRA Domain Name Dispute Resolution Rules ("the Rules") the Complainant was entitled to elect to convert from a panel of three to a single arbitrator which it did.

(f) On October 21, 2014, BCICAC named The Honourable Neil Anthony Brown QC as the Panel. The Panel has signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(g) The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules.

(h) In accordance with Rule 5.8, where, as here, no Response is submitted, the Panel shall decide the Proceeding on the basis of the Complaint.

FACTS

7. The facts set out below are taken from the Complaint.

8. The Complainant is a famous Italian company founded in 1872 operating in the field of the manufacture of tires and also in renewable energy and other industrial and commercial fields in Italy, Canada and internationally and has done so for many years.

9. It operates under its PIRELLI trademark which is registered in Italy, Canada and internationally.

10. Without the permission of the Complainant, the Registrants registered the Disputed Domain Names on October 8, 2013. It is apparent that the domain names were registered and used for the purpose of exploiting them for commercial gain which is presently done by causing them to resolve to parking pages some of which contain links to websites of Pirelli's competitors in the field of tires permitting the Registrant to earn pay-per-click revenue. Of the disputed domain names, <pirelli-tire.ca> currently resolves to a website displaying links to general products, one link of which advertises tires, <pirelli-tires.ca> does the same, <pirellitire.ca> does the same but there are two links to tires, <pneupirelli.ca> also promotes general products and so does <pneuspirelli.ca>.

CONTENTIONS OF THE PARTIES

A.COMPLAINANT

11. The Complainant submits as follows:

1. Canadian Presence Requirements

Pursuant to paragraph 1.4 of the Policy, and paragraph 3.2 (f) of the Rules, the Complainant is required to satisfy CIRA's Canadian Presence Requirements for Registrants. The Complainant submits that the Complainant is an Italian company and is an eligible complainant within the meaning of paragraph 2 (q) (Trademark registered in Canada) of CIRA's Canadian Presence Requirements for Registrants, version 1.3.

2. The Complainant & Trade-marks Upon Which the Complaint Is Based

The Complainant is an international manufacturer of automotive tyres and is also engaged in a range of other industrial and commercial activities. It has been in business since 1872 and is a successful enterprise with a well established brand and reputation.

3. The Complainant has enjoyed success internationally, its business spanning activities in more than 160 countries including Canada.

4. The Complainant has also established an Internet presence which is significant to its business. It has registered the domain name <pirelli.com> and uses the website www.pirelli.com in the course of its business.

5. The Complainant is the owner of a Canadian trade-mark registration for PIRELLI registered on May 12, 1967 (TMA 150657) and many other PIRELLI trademarks, particulars of which are provided.

6. The PIRELLI trade-mark is one of the Complainant's most valuable assets. By virtue of extensive and continuous use in Italy, Canada, and around the world by, the PIRELLI trade-mark has become very valuable and well known and has attracted considerable reputation and goodwill.

7. The disputed domain names <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca> ("the disputed domain names") are confusingly similar to the Complainant's registered Canadian PIRELLI trade-mark. That is so because they all contain the PIRELLI mark, the first three contain the English word "tire" or "tires", indicating that they are domain names that relate to the Complainant's core business of manufacturing tires and will lead to a website dealing with that subject and because in the cases of the domain names <pneupirelli.ca> and <pneuspirelli.ca> they contain the French and Portugese words for tires, namely "pneu" and its plural and to the same effect.

7. The Registrants have no legitimate interest in the disputed domain names <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca>. The Registrants registered the disputed domain names without the knowledge or approval of the Complainant. There is no evidence that the Registrants have brought themselves within any of the criteria in the Policy, nor could they conceivably do so.

9. The disputed domain names <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca> have been registered in bad faith.

B. THE REGISTRANTS

The Registrants did not file a Response in this proceeding.

PRELIMINARY ISSUE: IDENTIFICATION OF THE PARTIES

10. The Registrant is a party to the proceeding by that description because, as the Complainant discloses, the name and address of the registrants of the disputed domain names are not available in the public WHOIS data base. The obligation is on the Complainant pursuant to paragraph 3.2 of the Rules (d) to “provide all Registration Information known to the Complainant (including the name of the Registrant and all postal and e-mail addresses and telephone and facsimile numbers where available) for contacting the Registrant or any representative of the Registrant...”. The Complainant has done this by additionally disclosing Pneus a Rabais, a website to which the disputed domain names have on occasions resolved and Robin Meany, the Registrant of the domain name <pneuarabais.com>. The Panel finds that this was the correct course for the Complainant to follow and the proceeding may therefore continue with the Registrants described in this manner. In addition, the evidence suggests that all of the disputed domain names were registered as part of the same *modus operandi*, at the same time and by the same person and that consequently the proceeding may proceed pursuant to Rule 3.4 against the Registrants so described.

DISCUSSION OF THE ISSUES

CANADIAN PRESENCE REQUIREMENTS

11. Pursuant to paragraph 1.4 of the Policy, and paragraph 3.2 (f) of the Rules, the Complainant is required to satisfy CIRA’s Canadian Presence Requirements for Registrants. The Complainant has submitted that it is an Italian company and is an eligible complainant within the meaning of paragraph 2 (q) (Trademark registered in Canada) of CIRA’s Canadian Presence Requirements for Registrants, version 1.3. The Panel agrees with that submission as the evidence is that the PIRELLI trademark is the subject of several trademark registrations with the Canadian Intellectual Property Office, thus bringing the Complainant within that provision and giving it Canadian Presence Requirements for Registrants.

CONFUSINGLY SIMILAR

12. The Panel finds that the disputed domain names are confusingly similar with a trademark in which the Complainant had rights prior to the date of registration of the domain name and continues to have such rights, namely the PIRELLI trade-mark. As the Registrant registered the disputed domain names on October 8, 2013 and as the PIRELLI trade-mark was registered in 1967 and re-registered on May 12, 2012, the Complainant’s rights in the PIRELLI trademark precede the domain name registration date. The Complainant’s registered PIRELLI trademark by itself satisfies the requirement of prior rights as it has been held by many panels that proof of registration of a trademark is ample evidence of the trademark rights that a complainant must establish.

13. Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection and the “dot-ca” suffix

should be excluded from consideration (see *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014). When those principles are applied, each of the disputed domain names is confusingly similar to the Complainant's PIRELLI mark.

14. In particular, the disputed domain names include the entirety of the PIRELLI mark and the Registrant cannot avoid confusion by incorporating the mark in the domain name. If the trademark is included in a disputed domain name as it is in the present case, a Registrant cannot avoid a finding of confusion by appropriating another's entire mark in a domain name: *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053; *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020.

15. The addition of a descriptive or non-distinctive term such as the product name "tires" in a domain name does not militate against a finding of confusion and it actually enhances the likelihood of confusion, as internet users would naturally assume that the domain name was referring to the activities of the trademark owner in the field specified by the addition, namely in the present case, of "tires" or the French and Portuguese language equivalent of tires, namely "pneus". As tires are the core product of the Complainant, consumers are likely to conclude that the domain names resolve to websites providing information about the Complainant's manufacture and sale of its brand of tires in Canada.

16. Accordingly, the disputed domain names are confusingly similar with the PIRELLI trade-mark as they so nearly resemble the PIRELLI trade-mark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for same.

17. The Panel therefore concludes that the disputed domain names are confusingly similar with the PIRELLI trade-mark in which the Complainant had rights prior to the registration date of the disputed domain names and continues to have such rights.

REGISTRATION IN BAD FAITH

18. The Panel now turns to consider whether the disputed domain names were registered in bad faith. The Panel finds that, on the ground relied on by the Complainant and generally, the Registrant registered the disputed domain names in bad faith.

19. The Panel finds that the Registrant has registered the disputed domain names in bad faith as described in paragraph 3.5 of the Policy. That is so for the following reasons.

20. Pattern of Unauthorized Domain Name Registrations - Paragraph 3.5(b)

The Panel finds that the Registrant has within the meaning of paragraph 3.5(b) of the Policy, engaged in a pattern of registering domain names that contain trade-marks to which he is not entitled, and has prevented the Complainant from registering the domain names as such.

21. The Registrant has registered 5 domain names to which he is clearly not entitled, namely <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca>. Those domain names include the famous trademark PIRELLI and that fact alone shows that the Registrant intended to register a pattern of domain names, the pattern being to register domain names that sound and look like genuine Pirelli domain names; see *Great Pacific Industries Inc. v. Ghalib Dhalla*, BCICAC Case No. 00009; *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, BCICAC Case No. 00006; *Allergan Inc. v. Hiebert Net Inc.*, BCICAC Case No. 00058).

22. The evidence also shows that the Registrant registered the domain names to trade off and exploit the Complainant's good name and to prevent the Complainant from registering the domain names.

Disrupt A Competitor - Paragraph 3.5(c)

23. The disputed Domain Names resolve to websites that are making unauthorized use of the PIRELLI trade-mark. The Registrant's misappropriation of the Complainant's intellectual property creates the overall commercial impression that it is affiliated with, or otherwise endorsed by the Complainant. This use of the Domain Name qualifies the Registrant as a competitor of the Complainant as its unauthorized website offers in some cases goods and services that compete directly with those of the Complainant. The Panel therefore finds that the Registrant registered the domain names primarily to disrupt the Complainant's business.

Intentionally Attract Traffic For Commercial Gain - Paragraph 3.5(d)

24. The Complainant also relies on paragraph 3.5(d) and submits that the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the PIRELLI trade-mark as to the source, sponsorship, affiliation or endorsement of the contents of Registrant's website. The Panel agrees with that submission.

25. The domain names incorporate the whole of the PIRELLI trade-mark. As a result, the use of the disputed domain names is likely to result in potential consumers being confused or misled into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant. This is particularly the case given the extensive goodwill associated with the PIRELLI trade-mark. As well, the offering of competing goods and services confuses or misleads end users as to source or sponsorship, as end users are likely to believe that the Domain Names also resolve to an authorized website of the Complainant.

Surrounding Circumstances

Actual or Constructive Knowledge of the PIRELLI trade-mark

26. A registrant's actual or constructive knowledge of a complainant's rights in a domain name at the time of registration has been found to reinforce a finding of bad faith registration.

27. Given the wholesale incorporation of the famous PIRELLI trade-mark in the disputed domain names, together with the nature of the Registrants' website at www.pneusarabais.com and the fact that it has been used to promote competing products, the only plausible conclusion is that the Registrants had actual knowledge of the PIRELLI trade-mark, thereby supporting a finding of bad faith. In any event, and at the very least, the Registrants had constructive knowledge of the PIRELLI trade-mark, given that it is the subject of a Canadian trade-mark registration. This also supports a finding of bad faith.

28. Moreover, apart from the specific provisions of the Policy and having regard to the manner on which the disputed domain names have been registered using the PIRELLI trademark and the manner in which they have been used, the Panel finds that the domain names were registered in bad faith within the generally accepted meaning of that expression.

29. The Complainant has verified the above matters by evidence and the Panel accepts that evidence. The Complainant's authorised representative has also certified that the information contained in the Complaint is to the best of the Complainant's knowledge complete and

accurate. The Registrants have filed no response to the Complaint and, accordingly, the Registrants have provided no evidence on the issue of bad faith.

NO LEGITIMATE INTEREST IN THE DOMAIN NAMES

30. Paragraph 4.1 of the Policy provides that the Complainant must provide some evidence that "... (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4." The Panel finds that the Complainant has provided evidence that the Registrants have no legitimate interest in any of the disputed domain names. The Complainant has provided the following evidence to that effect which in each case the Panel accepts.

(a) Paragraph 3.4(a)

31. The Complainant has shown that the disputed domain names were not acquired in good faith or for a *bona fide* purpose. The website www.pneusarabais.com is an infringing website operated by the Registrants designed to generate revenue by misappropriating the Complainant's PIRELLI trade-mark. This completely undermines any claim of good faith or legitimate interest.

(b) Paragraph 3.4(b)

32. The Complainant has shown that Registrants have not registered the disputed domain names in good faith.

(c) Paragraph 3.4(c)

33. The Complainant has shown that Registrants have not registered the disputed domain names in good faith.

(d) Paragraph 3.4(d)

34. The Complainant has shown that the Registrants have never used the Domain Name in association with a non-commercial activity, and therefore cannot invoke paragraph 3.4(d) of the Policy. In any event and as previously noted, the Domain Name has not been used in good faith. The Registrants' website is not a non-commercial fan or information website. Rather, it is a commercial website designed to generate revenue by misappropriating third party trade-marks.

(e) Paragraph 3.4(e)

35. It is apparent from the evidence that PIRELLI, <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca> are not legal names, surnames, or other references by which the Registrants are commonly identified, and accordingly, the Registrants cannot rely on paragraph 3.4(e) of the Policy.

(f) Paragraph 3.4(f)

36. The disputed domain names are not the geographical names of the location of the Registrants' non-commercial activity or place of business.

37. Moreover, the Registrants have not filed a response to the Complaint or sought to rebut the above evidence and have thus provided no evidence of legitimate use. If the Registrants had any evidence that he had any legitimate interest in the domain name, they could have brought that evidence forward but have not done so. In addition, in view of the facts set out above, it is inherently unlikely that the Registrants could establish a legitimate interest in the domain name when their whole *modus operandi* in this matter has been deceptive and misleading.

38. In light of the foregoing, the Panel finds that the Registrant does not have a legitimate interest in any of the disputed domain names, and that they are therefore removed from the application of paragraph 3.4 of the Policy.

CONCLUSION

39. The Panel finds that the constituent elements of the Policy have been made out, that the Complainant is entitled to the relief it seeks and that the Panel will order that the disputed domain names be transferred to the Complainant.

DECISION

40. The Panel finds that the Complainant has satisfied the requirements of Paragraph 4.1 of the Policy and that it is entitled to the remedy it seeks.

ORDER

41. The Panel directs that the registration of the Domain Names <pirelli-tire.ca>, <pirelli-tires.ca>, <pirellitire.ca>, <pneupirelli.ca> and <pneuspirelli.ca> be transferred from the Registrants to the Complainant.

Date: October 27, 2014

A handwritten signature in black ink, appearing to read 'Neil Anthony Brown', written in a cursive style.

The Honourable Neil Anthony Brown QC

Panelist