

ADMINISTRATIVE PANEL DECISION

Pirelli & C S.p.A. v. Mehmet Bir

Case No. D2023-1339

1. The Parties

The Complainant is Pirelli & C S.p.A., Italy, represented by TALIENS Partnerschaft von Rechtsanwälten mbB, Germany.

The Respondent is Mehmet Bir, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <pirelli.net> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2023. On March 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 29, 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 March 30, 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 amendment to the Complaint on March 31, 2023.

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 April 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2023. On April 17, 2023, the Complainant requested suspension of the proceedings to explore settlement options. On April 18, 2023, the Center suspended the proceedings until May 18, 2023. Upon request of the Complainant, the Center reinstated the proceeding on April 26, 2023.

On May 10, 2023, the Center sent an email communication regarding the language of the proceeding in English and Turkish, accepting the Complaint as filed in English and granting the Respondent ten days until May 20, 2023, to file a Response. The Respondent sent an email communication to the Center on May 20, 2023 in Turkish.

The Center appointed Kaya Köklü as the sole panelist in this matter on May 26, 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 a widely known tire manufacturer established in Italy about 150 years ago.

It is the owner of the PIRELLI trademark, which is registered in a large number of jurisdictions, including in Türkiye, where the Respondent is reportedly located. Among others, the Complainant is the owner of the European Union Trademark Registration No. 009483389 for PIRELLI, registered on May 12, 2011, for a large variety of goods and services (Annex 10 to the Complaint).

The Complainant further owns and operates its main website at <pirelli.com>.

The disputed domain name was first registered by the Respondent on October 22, 2017. Since then, the disputed domain name was apparently not actively used and does not resolve to an active website.

On March 17, 2023, the Complainant sent a letter to the Respondent requesting a transfer of the disputed domain name at no costs (Annex 9 to the Complaint). This approach remained unsuccessful.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name.

The Complainant is of the opinion that the disputed domain name is identical or at least confusingly similar to its PIRELLI trademark.

It further argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In addition, the Complainant is convinced that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

The Respondent did not submit any formal response. However, the Center received informal email communications in English and Turkish language on April 13 and 24, as well as on May 20, 2023. The identity of the sender of these email communications was not disclosed, but the email address used to send these communications is the same email address of the Respondent, as per the information obtained from the Registrar.

The sender of these informal communications mainly stated that he or she has never abusively used the disputed domain name and has no intention to do so in future. Further, the sender of the email communications agreed to a deletion of the disputed domain name, but explicitly disagreed to a transfer of the disputed domain name.

6. Discussion and Findings

6.1. Language of the Proceeding

The Panel determines in accordance with the Complainant's request and the Rules, paragraph 11(a), that the language of this administrative proceeding shall be English.

Although the language of the registration agreement is Turkish, the Panel finds that it would be inappropriate, given the circumstances of this case, to conduct the proceedings in Turkish and request a Turkish translation of the Complaint noting that the Respondent has failed to raise any objection in regards to English being the language of the proceedings. The Panel further takes into account that the Respondent has sent informal email communications in English, and considers that the Respondent is able to read, write and understand English.

6.2. Substantive Issues

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions.

Stanworth Development Limited v. E Net Marketing Ltd., WIPO Case No. [D2007-1228](#).

For the evaluation of this case, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views stated therein.

A. Identical or Confusingly Similar

To begin with, the Panel confirms that the Complainant has satisfied the threshold requirement of having relevant trademark rights. As evidenced in the Complaint, the Complainant is the owner of the PIRELLI trademark, which is widely known and registered in various jurisdictions, including in Türkiye, where the Respondent is reportedly located.

The Panel finds that the disputed domain name is, in view of the Panel, identical to the Complainant's PIRELLI trademark as it incorporates the Complainant's trademark in its entirety without any additions or amendments.

In this regard, the Panel notes that the generic Top-Level Domain (".net" in this case) may, as a general principle, be disregarded when assessing identity or confusing similarity between a domain name and a trademark, see [WIPO Overview 3.0](#), section 1.11.1.

In view of the finding above, the Panel is satisfied that the Complainant has met the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of proving a negative, in particular as the evidence needed to show the Respondent's rights or legitimate interests is primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production of evidence shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy. *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

With its Complaint, the Complainant has provided *prima facie* evidence that the Respondent has no rights or legitimate interests, particularly no license or alike to use the Complainant's PIRELLI trademark within the disputed domain name.

There is also no indication in the current record that the Respondent is commonly known by the disputed domain name, not least because the disputed domain name has yet not been actively used by the Respondent. In the absence of a substantive Response to the Complainant's contentions, the Respondent has also failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or other evidence of rights or legitimate interests in the disputed domain name. Rather, the Panel notes that the disputed domain name is identical to the Complainant's widely known PIRELLI trademark, and hence, causes a high risk of implied affiliation.

Consequently, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel is convinced that the Respondent was aware of the Complainant's widely-known PIRELLI trademark when registering the disputed domain name in October 2017. At the date of registration, the Complainant's PIRELLI trademark was already registered, used, and widely known. UDRP panels have consistently found that the registration of a domain name that is identical to a famous or widely-known trademark by an unaffiliated person or entity can by itself create a presumption of bad faith, see [WIPO Overview 3.0](#), section 3.1.4. Consequently, the Panel has no doubt that the Respondent has registered the disputed domain name in bad faith.

With respect to the use of the disputed domain name in bad faith, as already indicated before, the disputed domain name has apparently yet not been linked by the Respondent to any active website. Nonetheless, and in line with the previous UDRP decisions (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)) and section 3.3 of the [WIPO Overview 3.0](#), the Panel believes that the non-use of a domain name does not prevent a finding of bad faith use.

Applying the passive holding doctrine as summarized in section 3.3 of the [WIPO Overview 3.0](#), the Panel assesses the Complainant's widely-known trademark PIRELLI as sufficiently distinctive, so that any good-faith use of the Complainant's trademark in the inherently misleading disputed domain name by the Respondent appears to be inconceivable, except with an authorization of the Complainant. Particularly, as the disputed domain name is identical to the Complainant's widely known PIRELLI trademark, the Panel is of the opinion that any active website linked to the disputed domain name would likely cause the false impression that it is operated or at least endorsed or authorized by the Complainant.

Taking all circumstances of this case into consideration, the Panel finds that in the present case the passive holding of the disputed domain name sufficiently indicates bad faith use by the Respondent.

Consequently, the Panel is convinced that the disputed domain name was registered and is being used in bad faith and that the Complainant consequently has also satisfied the third element of the Policy, namely, paragraph 4(a)(iii) 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.net>, be transferred to the Complainant.

/Kaya Köklü/

Kaya Köklü

Sole Panelist

Date: June 8, 2023