

हरियाणा HARYANA

P 612049

RACHNA BAKHRU

ARBITRATOR

Appointed by the .In Registry – National Internet Exchange of India

In the matter of:

Pirelli & C. S.p.A
Viale Piero e Alberto Pirelli no. 25
20126 Milan,
Italy

.....Complainant

Zhaxia
Phister Hotel
Milwaukee, WI 53214, 53202,
USA

..... Respondent

Disputed Domain Name: www.pirelli.co.in

AWARD

1) The Parties:

The Complainant in this arbitration proceeding is Pirelli & C. S.p.A. of Viale Piero e Alberto Pirelli no. 25, 20126, Milan, Italy. The Complainant is represented by its authorized representatives Gurpreet Singh Monga of Suite 404, Law Arcade, 18, Pusa Road, New Delhi – 110005 who have submitted the present Complaint.

The Respondent in this arbitration proceeding is Zhaxia, Phister Hotel, Milwaukee, WI 53214, 53202, USA as per the details available in the whois database maintained by National Internet Exchange of India (NIXI).

2) The Domain Name, Registrar & Registrant:

The disputed domain name is www.pirelli.co.in. The Registrar is Webiq Domains Solutions Pvt. Ltd.

The Registrant is Zhaxia, Phister Hotel, Milwaukee, WI 53214, 53202, USA

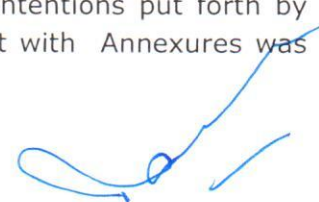
3) Procedural History:

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of Procedure (the Rules) were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

As per the information received from NIXI, the history of the proceedings is as follows.

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed Rachna Bakhru as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of impartiality and independence, as required by NIXI.

The complaint was produced before the Arbitrator on November 26, 2014 and the notice was issued to the Respondent on November 27, 2014 at his email address with a deadline of 10 days to submit his reply to the arbitration. The Respondent did not submit any response. On December 08, 2014 the Arbitrator granted further opportunity to the Respondent to submit its response on or before December 15, 2014. However, no response was submitted by the Respondent within the stipulated time. In the circumstances, the complaint is being decided based on materials submitted by the Complainant and contentions put forth by them. I may place it on record that the copy of Complaint with Annexures was



not only sent by courier but also emailed to the Respondent which has been confirmed by the Complainant vide his email of December 01, 2014.

Grounds for administrative proceedings:

- A. The disputed domain name is identical with or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- B. The Respondent has no rights or legitimate interests in respect of the impugned domain name;
- C. The impugned domain name was registered and is being used in bad faith.

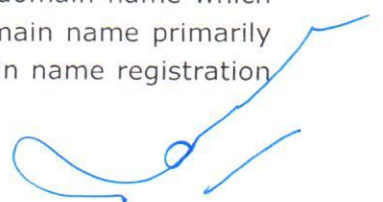
4) Summary of the Complainant's contentions:

The Complainant in support of its case has made the following submissions

- a) The Complainant Pirelli is a well-known multinational company with headquarters in Milan (Italy). It is the 5th largest global tyre manufacturer and leader in the high-end segments with high technological content.
- b) The Complainant submits that they operates under the name PIRELLI which has been in use since 1872 and listed on Milan Stock Exchange since 1922, Pirelli is distinguished for its long industrial tradition, which has always been combined with capacity for innovation, product quality and brand strength.
- c) The Complainant submitted that in line with its "green performance" Pirelli always focused on research and development – operates with ever increasing attention to products and services of high quality and technology and low environmental impact.
- d) In 2008 Pirelli was ranked among the 10 most valuable Italian global brands. According to Interbrand valuation made in 2011, Pirelli's brand has a value of 2.27 billion Euros, with an increase of 26% compared vs 1.8 billion Euros in 2010. According to Interbrand figures, the Pirelli brand is 15% more effective than other brands in the choice of tyre purchases.
- e) Pirelli has created business in other segments too: Pirelli Ambiente, engaged in the renewable energy sector; Pirelli Ambiente, engaged in the renewable energy sector; Pirelli & C. Eco Technology, dedicated to developing technologies to control pollutant emissions; Pirelli Labs, a centre of technological excellence and engine of innovation.
- f) The Complainant submits that in India also, the Complainant has enjoyed identical reputation and goodwill as it enjoys internationally particularly as an exclusive tyre supplier. It is further submitted that Pirelli is the owner of numerous registrations for trademarks, comprising of the mark "PIRELLI" in India and other countries all over the world.



- g) Pirelli has used its trademarks for many years in connection with power cables and systems sector, telecommunications cables and systems sector, tyre sector, real estate sector.
- h) Pirelli has invested substantial effort over a period of time, including the expenditure of substantial amounts, to develop goodwill in its trade name and trademarks to cause consumers throughout the world to recognize its marks as distinctly designating products and services that originate with Pirelli.
- i) The disputed domain name is identical or confusingly similar to the trademarks, company name and domain names of PIRELLI because it fully incorporates the dominant part of PIRELLI marks in which the Complainant has rights. The Registrant has no rights or legitimate interests in respect of the domain name.
- j) The disputed domain name is to be considered identical or confusingly similar since the suffix (.co.in) is not relevant as it is a technical requirement of the registration for the purpose of determination of the identity or confusingly similarity between the disputed domain name and the word PIRELLI.
- k) The Complainant submits that there has no relationship with Zhaxia or Phister Hotel whatsoever. Pirelli has never authorized the Registrant or anyone to register and / or use the disputed domain name or any other domain name. Additionally, there is no indication that the Registrant have any legitimate interest in PIRELLI marks, according to the searches conducted on the websites of the Italian Patent and Trademark Office (UIBM), the EU's office of Harmonization for the Internal Market (OHIM), the WIPO and the Indian Intellectual Property Office.
- l) By entering in the address bar of an internet browser resolves to a parking page containing third parties, links to further web sites permitting the Respondent to earn pay-per-click revenue which is clear that the Registrant is likely to derive commercial gain. Circumstances, indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name.
- m) The Complainant submits that taking into account the vast and widespread advertising campaigns carried out by Pirelli for the promotion of products and services covered by PIRELLI marks, it is unlikely that the Registrants did not have relevant knowledge of the Complainant or the PIRELLI marks.
- n) The Complainant had sent a cease and desist letter to the Respondent on February 18, 2014. The Registrant replied requesting an amount of Euro 1890 exceeding its out-of-pocket expenses directly related to the domain name which proves that the registrant has registered or acquired the domain name primarily for the purpose of selling or otherwise transferring the domain name registration to the Complainant or third party.



5) Respondent

The Respondent has not filed any response to the Complaint though they were given an opportunity to do so. Thus the complaint had to be decided based on submissions on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 3 of the policy.

6) Discussion and Findings:

The submissions and documents provided by Complainant in support of use and registration of the mark 'PIRELLI' leads to the conclusion that the Complainant has superior and prior rights in the mark 'PIRELLI'. Thus it can be said a) the web users are likely to associate the word 'PIRELLI' with the goods and services of the Complainant b) the web users would reasonably expect to find Complainant's products and services at the www.pirelli.co.in and c) they may believe it is an official website of the Complainant and the services being offered/ advertised are associated or licensed by the Complainant.

Based on the elaborate submission and documents, I'm satisfied that the Complainant has established the three conditions as per paragraph 4 of the policies which are listed below. Further the Respondent has not contested the claims therefore deemed to have admitted the contentions of the Complainant.

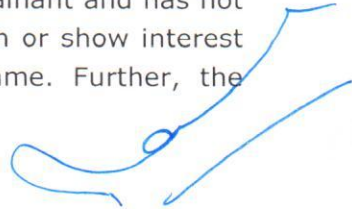
- (1) the Respondent's domain name is identical or confusingly similar to the trademark in which he has rights;

It has been established by the Complainant that it has trademark rights, and rights on account of prior and longstanding use of the mark 'PIRELLI'. The Complainant has in support submitted substantial documents. The disputed domain name contains or is identical to Complainant's 'PIRELLI' trademark in its entirety. The mark 'PIRELLI' which forms key part of the disputed domain name, and is being used by the Complainant to identify its services. The mark has been highly publicized by the Complainant and has earned a considerable reputation in the market.

- (2) the Respondent has no rights or legitimate interests in respect of the domain name;

The Complainant has not authorised the Respondent to register or use the 'www.pirelli.co.in' domain name. Further, the Respondent has never used the disputed domain name for legitimate business services and their purpose for registration appears to be purely for monetary gain.

The Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to explain its adoption or show interest in protecting his own rights and interest in the domain name. Further, the



Respondent has never used the disputed domain name for legitimate business services in connection with a bonafide offer of goods or services.

The above leads to the conclusion that Respondent has no rights or legitimate interest in respect of the disputed domain name 'www.pirelli.co.in'.

(3) the domain name has been registered in bad faith.

It may be mentioned that since the Respondent did not file any response and rebut the contentions of the Complainant, it is deemed to have admitted the contentions contained in the Complaint. As, the Respondent has not established its legitimate rights or interest in the domain name, an adverse inference as to their adoption of domain name has to be drawn.

Based on the documents filed by the Complainant, it can be concluded that the domain name/mark 'pirelli.co.in' is identified with the Complainant's products, therefore its adoption by the Respondent shows 'opportunistic bad faith'.

7. Decision:

In view of the foregoing, I am convinced that the Respondent's registration and use of the domain name www.pirelli.co.in is in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name. In accordance with the Policy and Rules, the arbitrator directs that the disputed domain name be www.pirelli.co.in transferred to the Complainant.



**RACHNA BAKHRU
SOLE ARBITRATOR
NIXI
INDIA**

19 December 2014