

Decision for dispute CAC-UDRP-100215

Case number **CAC-UDRP-100215**

Time of filing **2010-12-20 11:42:02**

Domain names **Preliosagency.com**

Case administrator

Name **Tereza Bartošková (Case admin)**

Complainant

Organization **PIRELLI & C. S.p.A.**

Complainant representative

Organization **PORTA, CHECCACCI & ASSOCIATI S.p.A.**

Respondent

Organization **L.S.A. SERVIZI SRL**

Respondent representative

Organization **avv. Angelo Crimi (Studio Legale Crimi)**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of the existence of other proceedings concerning the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark PRELIOS, with registrations in Italy and in several other countries.

FACTUAL BACKGROUND

The Complainant PIRELLI & C. S.p.A. is a multinational company based in Italy and is among the largest tyre manufacturers in the world.

The Complainant's associated company PIRELLI & C. Real Estate (in short, PIRELLI RE) is one of the top managers in the real

estate sector in Europe and modified its name into PRELIOS S.p.A. following a company Extraordinary General Meeting on July 15, 2010.

The name change of the company PIRELLI RE was publicly announced some months before, on May 28, 2010. Attached to the Complaint are, amongst others, a press release from PIRELLI RE press office dated May 28, 2010, announcing that the new name of the company would be PRELIOS S.p.A., and a printout of the web site www.it.pirelli.com, where a similar announcement was published on the same date. The news was anticipated by a short article published on the site www.ilgiornale.it the day before, on May 27, 2010.

The Complainant is the owner of the following trademark registrations for PRELIOS:

- Italian Trademark Registration No. 1332456 for PRELIOS (word mark), filed on May 4, 2010 and registered on September 14, 2010, in classes 35, 36, 37, 42, 43, 44 and 45;
- Community Trademark Registration No. 9075979 for PRELIOS (word mark) filed on May 4, 2010 and registered on January 11, 2011, in classes 35, 36, 37, 42, 43, 44 and 45;
- Community Trademark Registration No. 9370677 for PRELIOS (figurative mark) filed on September 13, 2010 and registered on January 28, 2011, in classes 35, 36, 37, 42 and 43;
- International Trademark registration No. 1042648 for PRELIOS (word mark), registered on May 5, 2010, in classes 35, 26, 37 and 42;
- Canadian Trademark Application No.1483891 (word mark), filed on June 4, 2010.

The Complainant is also the holder of the following domain names:

<prelios.eu>, <prelios.net> and <prelios.biz>, registered on May 4, 2010; <prelios.it>, registered on May 5, 2010; and <prelios.com>, registered on July 28, 2010.

The disputed domain name <preliosagency.com> was registered on May 28, 2010.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name <preliosagency.com> is confusingly similar to the name of its associated company PRELIOS S.p.A. and to the trademarks and domain names in which the Complainant has rights, as the "hearth" of the disputed domain name is constituted by the mark PRELIOS.

The Complainant states that the Respondent has no right or legitimate interest in the disputed domain name as the Respondent is not commonly known by the disputed domain name and the registration was made with the sole purpose of causing confusion among Internet users as to the source of the corresponding web site.

As to the circumstances evidencing bad faith, the Complainant points out that the disputed domain name was registered by the Respondent the same day the Complainant announced, through a strong media and advertising campaigns, the change of name of the company PIRELLI & C. Real Estate S.p.A. into PRELIOS S.p.A. The Complainant states that the Respondent's purpose is to exploit the Complainant's reputation and divert users to its site.

As additional circumstances highlighting bad faith, the Complainant states that the Respondent is also the owner of the domain name <preliosagency.it> and that the Respondent registered the disputed domain name with the primary purpose to sell it to the Complainant for an amount in excess of the out-of-pocket costs directly related to the domain name. The Complainant, in fact, informs the Panel that the Respondent refused its offer of a reimbursement of Euro 500 for the two domain names, stating that such offer was highly unsatisfactory and far from its standards. In such correspondence (attached to the Complaint and not contested by the Respondent), the Respondent also stated that its higher expectations were due to the value of domain names

which correspond to the designation of an asset of a company quoted on the Italian Stock Exchange and that such expectations were not reflected in the Complainant's offer.

RESPONDENT:

The Respondent rebuts the Complainant's contentions stating that the announcement of the name change of the company PIRELLI & C. REAL ESTATE S.p.A. into PRELIOS S.p.A. was provided only via Internet and after the date of registration of the disputed domain name by the Respondent.

The Respondent also states that it is entitled to use the disputed domain name as it is engaged in different activities from the Complainant in the field of plant production, transport, distribution and use of energy, heating and air conditioning, execution and maintenance of power plants, heating and photovoltaic systems and alternative energy. The Respondent contends that "etymologically, therefore, prelios has undoubted relevance to the nature of the systems made by LSA Services Ltd an agency and the addition of the suffix features and adapts to the needs of the organization".

The Respondent states that it is making a legitimate commercial use of the disputed domain name without intent to divert the Complainant's customers, due to the difference between the products and services of the Complainant and the Respondent's ones.

With reference to the correspondence between the Respondent and the Complainant and the mentioned request of a sum over the reimbursement of Euro 500 offered by the Complainant, the Respondent states that such request was legitimate and understandable, also in light of the current economic crisis, and points out that the Complainant's offer was speculative.

The Respondent also informs the Panel that an arbitration proceeding was started by the Complainant in relation to the domain name <preliosagency.it> but it was declared extinct since the Respondent began a proceeding before an Italian Court in relation to such domain name.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A. Rights

The Complainant has provided evidence of ownership of valid trademark registrations for PRELIOS.

The Panel finds that the disputed domain name is confusingly similar to the trademark owned by the Complainant. Pursuant to a number of prior decisions rendered under the Policy, the addition of generic or descriptive terms to a trademark is not a

distinguishing feature.

The mere addition of the word “agency” does not exclude the likelihood of confusion between the disputed domain name and the Complainant’s trademark.

It is well established in prior decisions that the addition of descriptive terms to a trademark is not a distinguishing feature. See, inter alia, Barry D. Sears, Ph.D. v. YY / Yi Yanlin, WIPO Case No. D2007-0286 (“diet” added to ZONE mark); Fry’s Electronics, Inc. v. Whois ID Theft Protection, WIPO Case No. D2006-1435 (“electronics” added to FRY mark); Wal-Mart Stores, Inc. v. Henry Chan, WIPO Case No. D2004-0056 (“chase”, “girlsof”, “jobsat”, “sams”, “application”, “blackfriday”, “blitz”, “books”, “career(s)”, “check”, “flw”, “foundation”, “games”, “mart”, “photostudio”, “pictures”, “portrait”, “portraitstudio(s)”, “registry”, “retailink” and “wire” added to WALMART mark); PepsiCo, Inc. v. Henry Chan, WIPO Case No. D2004-0033 (“chart”, “miusic”, “arena”, “sweep”, “nfl” and “coliseum” added to PEPSI mark); International Organization for Standardization ISO v. Quality Practitioners Institute and Web site Pros, Inc. and Quality, WIPO Case No. D2005-1028 (“net” and “training” added to ISO mark); Banca Intesa S.p.A. v. Roshan Wickramaratna, WIPO Case No. D2006-0215 (“online” added to BANCAINTESA mark); Groupe Auchan v. Jakub Kamma, WIPO Case n° D 2007-0565 (addition of the term “software” to the trademark AUCHAN).

See also, along these lines, Cie Générale Des Établissements Michelin v. Oleg Shmatko, CAC Case No. 100074: “The Domain Name is confusingly similar to the MICHELIN marks, since the element “tyres” is purely descriptive and as such not being relevant to influence the overall impression of the designation in the Domain Name. The MICHELIN trademarks of the Complainant and the domain name in question <michelintires.info> only differ in the additional element “tires” in the domain name. The addition of the purely descriptive element “tires” in the domain name does not have a relevant influence on the distinctiveness of the Element MICHELIN which clearly carries the weight of the designation <michelintires.info>”.

In view of the above, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. No rights or legitimate interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

It is well-established that the burden of proof lies on the Complainant. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a) of the Policy is potentially quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one.

Accordingly, in line with the UDRP precedents, it is sufficient that the Complainant shows a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of evidence on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003 0455, Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004 0110; Met America Mortgage Bankers v. Whois ID Theft Protection, c/o Domain Admin, NAF Claim No. 852581).

In the case at hand, the Complainant has made a prima facie case and the Respondent has failed to raise any convincing circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel observes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks. Furthermore, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name.

The Panel notes that the disputed domain name was redirected, at the time of filing of the present Complaint, to a web page where it was indicated that the web site was under construction and were published two links www.preliosagency.com and www.preliosagency.it; both links currently do not redirect users to any other pages of the site or to any other on line locations.

The Respondent contends a legitimate interest in the disputed domain name stating that it is engaged in a different business from the Complainant and that the term "prelios" is inherent to its activity in the field of energy. However, beyond these statements, the Respondent has failed to provide any evidence of its use of or preparation to use of the domain name in connection with a bona fide offering of goods or services.

Moreover, in light of the circumstances evidencing bad faith described in the factual section and also highlighted in the following paragraphs, the Panel finds that the Respondent is not making a legitimate, non-commercial or fair use of the disputed domain name.

In view of the above, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name, in accordance with paragraph 4(a)(ii) of the Policy.

C. Bad faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

- (i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's website or location or of a product or service on the holder's website or location.

As to bad faith at the time of the registration, the Panel finds that the registration of the disputed domain name by the Respondent on May 28, 2010, the very same day of the Complainant's official announcement of the change of the name of its associated company PIRELLI RE S.p.A. into PRELIOS S.p.A. (which was, indeed, already announced through an on line newspaper the day before), is highly suspicious and cannot be ascribed to a mere coincidence.

The explanation provided by the Respondent as to the selection of a domain name containing the mark PRELIOS and the lack of convincing evidence showing the Respondent's effective use of "prelios agency" as a distinctive sign in connection with its activity, suggest, on the contrary, that the disputed domain name was registered having the Complainant's trademark in mind.

The Panel shares the view of a number of panel findings of "opportunistic bad faith" in the registration of renowned or even somewhat less famous trademarks, as found in *Gateway, Inc. v. Lorna Kang*, WIPO Case No. D2003-0257. Along the same lines *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163; *Expedia*,

Inc. v. European Travel Network, WIPO Case No. D2000-0137; Prada S.A. v. Mark O'Flynn, WIPO Case No. D2001-0368; Ferrari S.p.A. v. Inter-Mediate Ltd., WIPO Case No. D2003-0050 and The Nasdaq Stock Market, Inc. v. Act One Internet Solutions, WIPO Case No. D2003 0103. As stated inter alia in DHL Operations B.V v. Net Marketing Group, WIPO Case No. D2005-0868 "...it is obvious that the value and goodwill, of the Complainant's mark DHL which has an extensive world wide recognition, would have been known to the Respondent at the time of registration of the disputed domain name. The registration and use of the mark by an entity unconnected to the Complainant gives rise to the presumption of opportunistic bad faith".

Moreover, when the Complainant contacted the Respondent requesting to acquire the disputed domain name and <preliosagency.it>, the Respondent immediately confirmed its availability to transfer them to the Complainant but then rejected a reimbursement of Euro 500, indicating that such offer was highly unsatisfactory and far from its parameters. As mentioned in the narrative section, the Respondent indicated that its higher expectations were due to the value of domain names which correspond to the designation of an asset of a company quoted on the Italian Stock Exchange and that such expectations were not reflected in the Complainant's offer's expectations were.

The Panel deems that also paragraph 4(b)(i) of the Policy is applicable to the present case since, in light of the content of the correspondence attached to the Complaint, the disputed domain name was as well registered for the purpose of selling it to the Complainant for an amount well in excess of the documented out-of-pockets costs. See, i.a., Wal-Mart Stores, Inc. v. Brad Tauer, WIPO Case No. D2000-1076, where it was found "the amount sought, \$475, far exceeds the domain name registration fee and Respondent did not present any documentation as to any other "out-of-pocket costs directly related to the domain name".

In light of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. **PRELIOSAGENCY.COM**: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION 2011-03-23

Publish the Decision