

Dispute Resolution Panel

For the Internet Society of Israel

Ellen B. Shankman, Adv., Panelist

In the matter between

**Pirelli & C.S.p.A.
(The “Petitioner”)**

**Represented by Pierfrancesco C. Fasano and Ivette Paulovics
Fasano Avvocati**

And

**Taavura Holdings Ltd.
(The “Respondent”)**

**Represented by DAVID TE’ENI
Vice President
TAMIG LTD.**

Regarding the domain name

**PIRELLI.co.il
(The “Domain Name”)**

DECISION

Procedural Background:

Pirelli & C.S.p.A. (hereinafter "Petitioners" or "Complainant") submitted a request for re-allocation of the domain name "Pirelli.co.il" ("disputed domain"), in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD by Dispute Resolution Panels ("IL-DRP Procedures").

The panel was established on 26 March 2012, in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD by Dispute Resolution Panels ("IL-DRP Procedures"), (http://www.isoc.org.il/domains/ildrp_rules.html)_ (in English) and http://www.isoc.org.il/domain_heb/ildrp_rules.html_ (in Hebrew), in order to address the Petitioner's request to cancel the allocation of the Domain Name (Pirelli.co.il) to Respondent and to reallocate the Domain Name to the Petitioner.

In light of the Passover holiday, in my discretion, I extended the deadline for response. The deadline for filing a response was extended to 19 April 2012.

Respondent was notified that a petition had been filed and both parties notified of the appointment of me as the Panelist. I specifically strongly encouraged Respondent to file a response, since even if no response to this petition is filed, I would make a decision on the information presented *ex parte*.

Per Section 8.2 of the IL-DRP Procedures, either party may request that the dispute be reviewed by an extended panel within 7 days of the notification. Further, per Section 8.4 of the IL-DRP Procedures, either party may request exclusion of the appointed Panelist on the grounds of any potential conflict of interests. No such requests were made.

Further, per Section H of the IL-DRP Procedures, either party may request Court Review.

“Section H. Right To Seek Court Review

20. Petition to the IL-DRP in no way precludes access or petition to an Israel Court of Law.
21. Notwithstanding, should a party, in parallel, institute Court proceedings regarding a Domain Name during the proceedings of the IL-DRP, such petition to the Court shall not affect or stay the IL-DRP proceedings under these Rules, unless a court order regarding such be served on ISOC-IL. ”

No such review was made that would affect or stay these IL-DPR proceedings.

I confirmed that the Petition and all correspondence thereto was posted by ISOC and e-mail sent to the address of the Holder in the records.

The Respondent, by way of e-mail to my direct e-mail address, respondent first requested that the decision be delayed so that he might resolve the matter directly with Petitioner.

I reiterated in an e-mail after Passover that I strongly encouraged the Respondent to file a response by the deadline, in parallel with whatever efforts the parties may be taking with one another, since I would be issuing my opinion based on the information before me at that time. A response was received by Respondent to the effect that he had filed the domain to keep other competitors from doing so and wanted to resolve this directly with Petitioner. Further, the Respondent agreed that as a distributor of Petitioner he did not wish to fight Respondent and would agree to reallocation of the domain name.

Petitioner's Arguments:

The Petitioner supplied ample evidence of the fame and its rights in the mark PIRELLI. In light of the non-contested nature of those rights, together with Respondent's concession regarding Petitioner's rights in the name PIRELLI, I believe it is not necessary to detail the evidence reiterate all arguments provided herein.

Grounds for Decision:

The IL-DRP Rules state:

"B. Grounds for IL-DRP

3. Disputes regarding allocation of a Domain Name by a Holder may be brought by a third party ("Petitioner") on the following grounds:

3.1. the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the Complainant; and

3.2 the Complainant has rights in the Name; and

3.3. the Holder has no rights in the Name; and

3.4. the application for allocation of the Domain Name was made or the Domain Name was used in bad faith. "

Thus, even if the matter is not disputed by Respondent, in order to prevail, the Petitioner must establish all four elements: confusing similarity to the Name, rights in the Name, that the Holder has no rights in the Name, and an element of bad faith.

Confusingly Similar

The first question is: Is the Domain Name the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the Petitioner?

I find the answer to this "yes". The Domain Name *pirelli.co.il* is confusingly similar to the registered trademark and key element of the company name of the company.

Petitioner's Rights in the Name

The second question is: Has Petitioner established that it has rights in the name?

I find the answer to this "yes". Petitioner has provided ample evidence of rights in the name.

Respondent's Rights in the Name

The third question is: Does the Respondent have rights in the Name?

I find the answer to this "no". Respondent has demonstrated no "rights" in the Name, and contends that he his intention for obtaining the domain name was holding the mark to prevent competitors of Petitioner from obtaining the domain name.

Bad Faith

The fourth question is whether there appears to be any evidence of bad faith in the allocation or use of the Domain Name. Upon review of the circumstances, I find that there is evidence of bad faith. While I appreciate Respondent's "goodwill" in offering to resolve the matter and **when challenged** to give back the

Domain Name to Petitioner, this does not undo a finding of “bad faith” in allocation in the first place or continued use of the Domain Name.

Since the Respondent has agree to reallocation of the Domain Name and since I find that the four factors of the IL-DRP have been met in this case, it is not necessary to provide a more detailed legal analysis of the additional arguments raised by either party.

Decision:

In light of the above, and upon detailed review of the evidence provided, I hold that the Domain Name shall be reallocated to the Petitioner within 45 days of the date of this decision.

Ellen B. Shankman, Adv.

Date: 25 April 2012