

ADMINISTRATIVE PANEL DECISION

Italo - Nuovo Trasporto Viaggiatori S.p.A. v. Mike Fullerh
Case No. D2022-5026

1. The Parties

The Complainant is Italo - Nuovo Trasporto Viaggiatori S.p.A., Italy, represented by Jacobacci & Associati, Italy.

The Respondent is Mike Fuller, United States of America (“United States”), represented by Gunderson Dettmer Stough Villeneuve Franklin & Hachigian, LLP, United States.

2. The Domain Name and Registrar

The disputed domain name <italotreno.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 29, 2022. On January 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 4, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 9, 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 January 13, 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 January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. The Response was filed with the Center February 4, 2023.

The Center appointed Adam Taylor, Angelica Lodigiani and Christopher S. Gibson as panelists in this matter on March 3, 2023. The Panel finds that it was properly constituted. Each member of 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.

The Panel issued Procedural Order (“PO”) Nos. 1 and 2 on March 17 and 27, 2023, respectively. The Complainant requested clarification of PO1 on March 21, 2023. Each party filed PO responses on March 24 and 29, 2023. The PO’s and responses thereto are referred to below insofar as the Panel considers them relevant.

4. Factual Background

The Complainant, which was incorporated in 2006, is Italy’s first private high-speed rail operator. It trades under the mark .ITALO.

The Complainant owns many trade marks for .ITALO including figurative European Union trade mark No. 7066699, filed on July 15, 2008, registered on March 18, 2009, in classes 16, 39, 42, and 43. The Complainant also owns figurative European Union trade mark No. 10569606 for ITALO TRENO, filed on January 18, 2012, registered on June 15, 2012, in classes 16, 39, 42, and 43.

The Complainant operates a website at the domain name <italotreno.it>, which it registered on September 13, 2010.

The Complainant conducted its maiden train journey on April 28, 2012.

By 2022, the Complainant had served over 100 million passengers. The Complainant currently operates a network of 55 stations, with 116 daily trips and over 1,400 employees.

The Respondent operates and controls InterRail, LLC, a Massachusetts company (and included in references to “the Respondent” hereafter unless stated otherwise). The Respondent states that since 1996, he has engaged in the business of selling European train travel online, primarily to customers located in the United States. The Respondent registered <italiarail.com> in 2004, and has used it to sell Italian train tickets to English-speaking travellers visiting Italy.

The Respondent has registered many other rail- and travel-related domain names that include the terms “italia” and “italiano”, including <italiatours.com> (2001), <trainitalia.com> (2002), <italiatrain.com>, <italiatrains.com>, <italianotrain.com>, <italianotrains.com> (all 2009), and <italiatreno.com> and <italiatreni.com> (both 2015).

On January 3, 2010, the Respondent registered <italotrain.com>, <italorail.com>, <italoticket.com> and <italotickets.com>.

The Respondent registered the disputed domain name on April 11, 2010, along with <italotrains.com>.

Between 2011 and 2018, the Respondent registered another nine domain names consisting of “italo” plus the terms “travel”, “tours”, “hotel(s)”, “holiday(s)”, “vacation(s)” and “pass”.

The Respondent’s company, InterRail, LLC, owns the following trade mark applications and applications amongst others:

- United States trade mark No. 4217573 for INTERRAIL, filed on February 27, 2012;
- European Union trade mark No. 012887592 and United States trade mark No. 5629875 for ITALIAPASS, filed on May 20, 2014, and June 27, 2018, respectively;

- United States trade mark No. 5629876 for ITALIARAIL, filed on June 27, 2018; and
- United States trade mark application Serial No. 97156083 for ITALIAPACK, filed on December 3, 2021.

As of October 25, 2022, the disputed domain name resolved to a Registrar landing page with the subject headings: “Treni Italia”, “ItaloTreno” and “Italo Treno Biglietti”. These led to pay-per-click (“PPC”) links to the website of the Complainant’s competitor, “Trenitalia”, as well as to the Complainant’s own website.

5. Parties’ Contentions

A. Complainant – primary filing

The following is a summary of the Complainant’s contentions in the Complaint.

The disputed domain name is confusingly similar to the Complainant’s ITALO trade mark, as it simply adds the word “treno”, meaning “train”, to the name of the Complainant’s internationally well-known trade mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

There is no evidence of the Respondent’s use, or demonstrable preparations to use, the disputed domain name for a *bona fide* offering of goods or services.

The Respondent has not been commonly known by the disputed domain name in the normal course of business.

The Respondent has not made any noncommercial fair use of the disputed domain name.

The disputed domain name was registered and is being used in bad faith.

The Respondent must have registered the disputed domain name in bad faith as it is impossible that the Respondent was unaware that the name “italotreno” was associated with the Complainant. The Respondent was guilty of opportunistic bad faith given that the disputed domain name is so obviously connected with the Complainant’s well-known trade mark.

A cursory Google search would easily have revealed that the name “italotreno” brings up search results relating to the sale of high-speed train tickets in Italy.

While the disputed domain name is currently inactive, because it is identical to the Complainant’s trade mark it is reasonable to think that the Respondent intends to use it in future in a commercial manner that would be detrimental to the Complainant’s interests.

If the Respondent had simply held the disputed domain name passively, that of itself would amount to bad faith in the circumstances of this case, but in fact the use of a parking page with PPC links to the Complainant’s competitor goes beyond passive holding. And further content may be added at any time.

Its communications with the Respondent have convinced the Complainant that the Respondent was well aware of the Complainant’s activities and rights when he registered the disputed domain name. Attempts to persuade the Respondent to transfer the disputed domain name to the Complainant, including by proposing business cooperation, have proved inconclusive.

B. Respondent – primary filing

The following is a summary of the Respondent’s contentions in the Response.

The disputed domain name is not identical or confusingly similar to a trade mark in which the Complainant has rights.

The word portions of the Complainant's ITALO and ITALOTRENO trade mark are generic. Merriam-Webster defines "italo" as "indicating Italy or Italian", and "treno" means "train".

Even if the Panel does not find sufficient evidentiary support of genericness to meet the standard required to disallow registered trade marks, the genericness should nonetheless detract from a finding of confusing similarity.

The disputed domain name simply means "Italian train". Visitors to the disputed domain name would not be confused by any association with the Complainant as the term itself does not inherently evoke the Complainant.

The Respondent possesses rights or legitimate interests in respect of the disputed domain name.

The Respondent's prior and *bona fide* registration and use of a related domain name, namely <italiarail.com>, is clear evidence of the Respondent's legitimate interests in the disputed domain name. The Respondent's Italian rail travel business, which is the largest seller of Italian train tickets outside Italy that is primarily focused on the United States market, has operated for nearly twenty-five years, more than a decade before the Complainant conducted its maiden train voyage.

The registration and filing of the Respondent trade marks (listed in section 4 above) supports the Respondent's contentions regarding its use of the disputed domain name and related domain names in connection with a *bona fide* offering of goods or services.

Furthermore, the trade marks themselves constitute legitimate interests because they correspond to the disputed domain name, they have actually been used in the Respondent's business, they predate this dispute by a number of years and the Complainant has provided no evidence that they were pretextual.

The disputed domain name is not in active use. As with the Respondent's other domain names similar to <italiarail.com> registered over the past 22 years, the disputed domain name was intended as a legitimate and noncommercial defensive registration designed to protect the Respondent's legitimate interest in its Italian travel business.

Defensive registration of a large number of domain names similar to a party's own domain name which might be used (if registered by others) to divert its customers or otherwise to damage its business has been recognised as a legitimate interest by UDRP panels. Relevant factors include whether a respondent has registered a swatch of similar domain names defensively and whether a respondent was aware of the complainant when it registered such domain names. Here, the Respondent has registered a number of other similar domain names defensively and the Respondent was not aware of the Complainant when it registered the disputed domain name in 2010.

The disputed domain name was not registered and is not being used in bad faith.

The Complainant's Google search does not address the question of the Respondent's knowledge at the time that the disputed domain name was registered. The Respondent was unaware of the Complainant, which started offering services to the public, and applied to register its ITALO TRENO trade mark, only in 2012, some two years later. And the Complainant only registered its own domain name, <italotreno.it>, some five months after the Respondent registered the disputed domain name.

The Complainant has not submitted any evidence demonstrating the Respondent's knowledge of the Complainant at the time of registration of the disputed domain name, other than a vague reference to the Complainant's communications with the Respondent.

The Respondent's business has always been located in the United States and geared towards English-speaking consumers visiting Italy. The Respondent has never intended to expand into the domestic Italian consumer market.

Given the period included in the Complainant's mark (*i.e.*, ".italo"), a trade mark search of "italo" on the European Union Intellectual Property Office trade mark database does not return the Complainant's registered trade mark. This further demonstrates the improbability of a claim that the Respondent was aware of the Complainant in 2010.

Even if the Respondent had knowledge of the Complainant's mark at the time of registration of the disputed domain name, the Complainant must also prove bad faith intent at that time. That was not the case here as the Respondent is not a professional domainer and he registered the disputed domain name defensively rather than for the purpose of active or commercial use.

The Respondent had no knowledge of, and received no compensation in respect of, the PPC links to the Complainant's competitor, which were independently posted by the Registrar. In any case, the Complainant's screenshots are dated 2022, and do not demonstrate the Respondent's bad faith in 2010.

The factors evidencing passive holding in bad faith do not apply in the circumstances of this case. The Complainant's mark is not distinctive; rather it is descriptive of the Complainant's service. Even if it is distinctive to some degree, the factor is at best "even" between the parties. The Respondent has submitted a Response and has provided substantial evidence of actual good faith use of the disputed domain name including his active Italian travel business and registered trade marks and domain names. There is no evidence that the Respondent concealed his identity or used false contact details.

The Respondent has never requested money from the Complainant. In response to the Complainant's initial demand, the Respondent agreed to meet the Complainant in an effort to assuage its concerns. The Respondent specifically informed the Complainant that he has no intention or desire to sell the disputed domain name and would prefer to keep it, defensively, to protect the Respondent's own brand from ill-intentioned third parties, but eventually to use more actively in the Respondent's business. Prior panels have considered that a refusal to sell, if motivated by a desire to use a disputed domain name in a respondent's business, indicates a lack of bad faith.

While UDRP panels have declined to adopt the defence of laches under the Policy, the Complainant's significant 13-year delay should be taken into account in considering whether the Complainant has met its burden of proof under the third element, including when considering any evidence submitted by the Complainant that is solely focused on each party's activities today rather than at the time of registration of the disputed domain name. Public reports indicate that the Complainant is being sold, raising questions as to the impetus behind the timing of this Complaint after such a long period.

C. Complainant – PO responses

The following is a summary of the Complainant's contentions in response to PO1 and PO2.

The term "Italo" would be understood by the average Italian as a Christian name (*e.g.*, Italo Calvino, the famous writer), and it means "Italian" only in rare literary use or in composite words, *e.g.*, "italo-francese". Any tool used by the Respondent would have translated "Italian train" as "treno italiano" and not "italo treno".

From 2008 until January 3, 2010, there have been extensive references in both the specialised and general media, including all four largest circulation Italian newspapers and even The Times and The New York Times (the latter in an article that also referred to the Respondent), to a very large high speed railway project in Italy known as "Italo".

At the very least, these references demonstrate that a highly specialised operator, which sold tickets for Italian trains including for Trenitalia, the Complainant's main competitor, was likely to have been aware of the

Complainant. The Respondent registered the disputed domain name to mislead consumers before the Complainant's launch with a view to misleading consumers into thinking that this led to the Complainant's official site, or to promote its own Trenitalia business, or to induce the Complainant to do business with him.

Due to the existence of a non-disclosure agreement ("NDA") with the Respondent, the Complainant declines to produce evidence of communications with the Respondent allegedly indicating that the Respondent was a highly skilled and professional specialist in the sale of European and Italian train tickets who was likely to have been aware of the Complainant's Italo project well before registering the disputed domain name. The Panel can derive its own conclusions from the fact that the Respondent was only willing to communicate about the disputed domain name under the shield of the NDA.

D. Respondent – PO responses

The following is a summary of the Respondent's contentions in response to PO1 and PO2.

The Respondent generally agrees with the Panel's understanding that, both in English and Italian, the word "italo-" means "Italian" but it generally functions as a prefix in a compound word used in limited instances, usually coupled with another adjective referring to another country. While the word "italo" is often used as a compound word, the Respondent understands that "italo" can also be used as an adjective meaning "Italian" in a manner synonymous to "italiano". When it is used in this context, and combined with "treno", "italo treno" could only be understood to translate to "Italian train", even if not 100% accurate syntax in Italian, akin to the use of the word "italo" in the Italo crime genre of film and Italo disco genre of music. Two translation websites, Google and Systran, translate "italo treno" as "Italian train".

The Respondent acknowledges that, in 2013, he registered some eight domain names that include the word "trenitalia", which is the name of the primary train operator in Italy and derives from a play on the words "treni" and "Italia". The Respondent's current website at "www.italiarail.com" describes the Respondent as "an official partner of Trenitalia outside Italy". The Respondent registered the Trenitalia domain names for the collective benefit of the Respondent and Trenitalia, which engaged the Respondent in 2013, to provide certain services in connection with a "strategic, multimodal initiative", although the Trenitalia domain names did not end up actually being used. The Respondent cannot provide additional detail regarding the services due to confidentiality obligations. However, the connection between 2018 press releases relating to a Trenitalia alliance with an airline and certain of the Respondent's Trenitalia domain names, are evidence of the Respondent's connection with the initiative.

The Respondent disputes that it registered the disputed domain name to mislead consumers, promote its own business or induce the Complainant to do business. This is conjecture, unfounded by evidence. The Respondent reiterates that it has never actively used the disputed domain name including to redirect to the Respondent's other active domain names. Nor has the Respondent requested money or any other consideration from the Complainant. The Respondent has not manifested a modicum of bad faith intent over the thirteen years since registration of the disputed domain name.

None of the documents submitted by the Complainant in its PO response refer to the term "Italo Treno" or to the Complainant's intended use of this name in its business.

The Respondent disputes that it only agreed to interact with the "under the shield" of an NDA. The mutual NDA was entered into by the parties in connection with the Complainant's approach to the Respondent regarding a potential business transaction. Given the commercial sensitivity of the matters discussed, the Respondent is not comfortable revealing such correspondence as it could damage the Respondent's business. The Complainant drafted the NDA and must have understood its implications. The Complainant could have refrained from discussing the disputed domain name to avoid this result, especially since the disputed domain name was not the purpose of the discussion as the Respondent understood it. The Respondent would not have agreed to meet the Complainant if he had known that this was the Complainant's purpose. The fact that the Complainant provided and entered into an NDA with the

Respondent reinforces the fact that the Respondent has a legitimate, successful business, and is not in the business of trafficking in domain names.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant owns figurative registered trade marks for ITALO TRENO and for .ITALO.

As explained in section 1.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), assessment of confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. Here, disregarding the Top-Level Domain ("TLD") suffix, the disputed domain name is identical to the textual element of the Complainant's mark ITALO TRENO and confusingly similar to the Complainant's trade mark .ITALO.

The Respondent alleges that "italo treno" is simply a descriptive term meaning "Italian train" and that this fact should detract from a finding of confusing similarity on the basis that the term does not inherently evoke the Complainant and would not confuse visitors to the disputed domain name.

However, section 1.7 of [WIPO Overview 3.0](#) makes clear that the first element functions primarily as a standing/threshold requirement. The test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trade mark and the disputed domain name. Where at least a dominant feature of the relevant mark is recognisable in the disputed domain name, it will normally be considered confusingly similar to that mark for purposes of UDRP standing. Issues such as the composition of the complainant's mark and the nature of the domain name are decided under the second and third elements.

Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, the disputed domain name resolves to a Registrar landing page with PPC links to the website of the Complainant's competitor, "Trenitalia", as well as to the Complainant's own website, and therefore not being used for a *bona fide* offering of goods or services.

It is unnecessary for the Panel to consider whether the disputed domain name nonetheless constitutes a “defensive” registration that might constitute a legitimate interest under the second element because, for reasons explained in section 6C below, the Panel has not been persuaded that that was in fact the Respondent’s purpose in registering the disputed domain name.

Nor does the Panel consider that the Respondent’s trade marks listed in section 4 assist the Respondent in this context as they are all materially different from the disputed domain name. Neither of the words comprised in the disputed domain name features in any of these trade marks.

Furthermore, there is no evidence that paragraphs 4(c)(ii) or (iii) of the Policy are relevant in the circumstances of this case.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

In a nutshell, the Respondent’s position is that the disputed domain name reflects a descriptive term meaning “Italian train” in English and that he acquired it as a “defensive” registration in connection with his pre-existing business (dating from 1996) selling Italian train tickets outside Italy, principally to the United States market. The Respondent says that, when he registered the disputed domain name in 2010, he was unaware of the Complainant, which only conducted its maiden train journey on April 28, 2012.

The Panel has carefully considered the submissions by both parties, including in response to PO1 and PO2.

First, the Panel notes that the Complainant is the first private high-speed rail operator in Italy to operate in competition with the state-owned Trenitalia.

In response to PO1, the Complainant has produced a batch of articles in national and specialist media dated 2008 and 2009 referring to the proposed launch of the Complainant’s proposed new “Italo” service. While the publications are mainly in Italy, there is also some international coverage including an article in the New York Times of May 18, 2008, which begins as follows:

“Trenitalia, Italy’s national railway, which introduced high-speed rail service between Naples and Milan last December (www.italiarail.com), will soon be getting some competition. In 2011, a new privately owned high-speed train company, Nuovo Trasporto Viaggiatori, will introduce a stylish, candy-apple-red fleet of 25 trains collectively known as Italo. The trains’ interiors will be designed by the Italian car designer Giorgetto Giugiaro.”

Notably, the website referred to in the opening sentence is operated by the Respondent.

Given that the Respondent is not simply a domain name investor but a long-standing seller of Italian rail tickets outside Italy - the largest such business targeting the United States market according to the Respondent - the Panel considers it unlikely that, by 2010, the Respondent was unaware of this major new development in the Italian rail industry, namely the launch of the first new private high-speed rail service in Italy – not least in light of the 2008 reference to the Complainant in the above-mentioned New York Times article that also mentions the Respondent.

The Respondent observes that the 2008-2009 publicity refers to “Italo” rather than “Italo Treno” as the Complainant’s proposed name, but the Panel does not consider that this assists the Respondent. As shown in section 4 above, the Respondent registered a number of domain names in 2010 consisting of the word “italo” followed by various train-related and other descriptive terms. The key issue here is the likelihood or otherwise that the Respondent incorporated the word “italo” in the disputed domain name by reference to the Complainant.

As to the Respondent's assertion that it selected the disputed domain name based on its alleged descriptive meaning of "Italian train", in PO1 the Panel set out its understanding, based on the views of the Italian-speaking panellist, that, while in both English and Italian the word "italo-" means "Italian", it generally functions as a prefix in a compound word used in limited instances, usually coupled with another adjective referring to another country, such as say "italo-francese" in Italian or "Italo-Austrian" in English.

In response, the Respondent stated that he generally agreed with the foregoing statement but claimed that "italo" could also be used as an adjective meaning "Italian" in a manner synonymous with "italiano". The Respondent asserts that, when used in this context, and combined with "treno", "italo treno" could only be understood as a translation of "Italian train", even if it is not 100% accurate syntax in Italian "akin to the use of the word 'Italo' in the Italo crime genre of film and Italo disco genre of music". The Respondent invokes two translation websites, Google and Systran, which both translate "italo treno" as "Italian train".

However, the Panel does not agree with the Respondent's submission. The Panel's view, informed by the Italian-speaking panellist, is that it is highly unlikely that Italian speakers would understand "italo treno" as meaning "Italian train". The Respondent has provided no evidence that "italo" is remotely synonymous with "italiano" and/or that it is a natural descriptive-type term for the Respondent to have selected for the disputed domain name. For example, the Respondent has not submitted any English-Italian translation of "Italian train" as "italo treno". In the absence of convincing evidence from the Respondent in support of its contention, the Panel remains of the view that, in Italian, "italo" is a somewhat rare adjective that the Respondent was unlikely to have chosen independently of the Complainant in this context.

In PO1, the Panel invited the Respondent to explain and justify the eight "trenitalia" (air travel-related) domain names registered in 2013 that were included in the list of "defensive" domain names supplied by the Respondent and were referable only to the name of Trenitalia, the primary rail operator in Italy. The Panel is not entirely convinced by the Respondent's reply, which was to rely on a statement on its current website that it is an official Trenitalia partner and to claim that these ultimately-unused domain names were registered in connection with an alleged agreement with Trenitalia in 2013. The Respondent has provided no contemporaneous evidence thereof, instead referring somewhat obliquely to confidentiality obligations and a 2018 press release about a Trenitalia alliance with an airline that made no reference to the Respondent.

For all of the above reasons, and on the balance of probabilities, the Panel does not find the Respondent's denial of knowledge of the Complainant's intended rail service to be credible. The Panel instead considers that the disputed domain name was most likely registered with reference to the Complainant's brand and that it falls outside the pattern of the Respondent's legitimate descriptive domain names.

The Panel would add that, in reaching its above conclusion, the Panel has placed no reliance on the Complainant's assertion that "[c]ontacts with the previous registered owner, Mr. Fuller, persuaded Complainant that he was well aware of Complainant's activities and rights when he registered the domain name". In PO1 and PO2, the Panel invited both parties to disclose all of their pre-action communications but, ultimately, both parties declined to do so on the basis of the NDA that had been entered into between the parties, apparently drafted by the Complainant. The Panel has decided not to draw any inference from any of the foregoing, as the circumstances surrounding the NDA are somewhat unclear to the Panel.

The Respondent asserts that, even if the Respondent had knowledge of the Complainant's mark at the time of registration of the disputed domain name, the Complainant must also prove bad faith intent at that time. However, the fact that the Respondent has denied awareness of the Complainant in circumstances which the Panel has found to be implausible is of itself a strong indicator that the Respondent possessed bad faith intent at the time of registration.

While the Panel cannot be certain as to the Respondent's exact motive, for the above reasons, the Panel is satisfied that the Respondent intended to target the Complainant's mark in some way.

Furthermore, in the Panel's view the use of the disputed domain name in 2022 to host a parked page comprising PPC links that compete with, or capitalise on the reputation and goodwill of, the Complainant's

mark or mislead Internet users is evidence of use in bad faith. The Panel considers that the disputed domain name is thereby being used to attract Internet users by creating a likelihood of confusion with the Complainant's mark in accordance with paragraph 4(b)(iv) of the Policy. Furthermore, section 3.5 of [WIPO Overview 3.0](#) makes clear that respondents cannot disclaim responsibility for "automatically" generated pay-per-click links on their websites and that neither the fact that such links are generated by a third party such as a registrar, nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.

The Panel would add that, even if there had been no such PPC use, for the reasons given above the Panel would have found that the disputed domain name constituted a passive holding in bad faith in accordance with section 3.3 of [WIPO Overview 3.0](#).

In this context, the Panel notes the Respondent's assertion that he told the Complainant that he had no desire to sell the disputed domain name, and that he would prefer to keep it "defensively", but eventually to use it more actively in the Respondent's business. The Panel thinks it significant that the Respondent has not explained to the Panel exactly what that more active use would or might entail, and the Panel finds it difficult to conceive of any potential good faith use of the disputed domain name in the circumstances of this case.

The Panel further notes that, insofar as the Respondent directs ticket sales to the Complainant's competitor, the Respondent could be said to be a potential commercial competitor of, or at least acting in opposition to, the Complainant. The Policy operates robustly in areas where allegations of bad faith are made in the context of commercial competition.

Finally, as regards delay, the Respondent rightly says that the UDRP panels have declined to adopt concepts such as laches or its equivalent. Noting section 4.17 of [WIPO Overview 3.0](#), the Respondent has not sought to demonstrate detrimental reliance on the delay and the Panel does not consider that the delay has otherwise impeded the Complainant's case. While it is true that the original Complaint provided limited information regarding the Complainant's pre-2010 reputation, the Complainant has since provided such evidence in response to PO1, and the Respondent has had an opportunity to comment thereon. In the Panel's view, nothing turns on the fact, if true, that a potential sale of the Complainant has motivated its filing of this case.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) 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, <italotreno.com>, be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Presiding Panelist

/Angelica Lodigiani/

Angelica Lodigiani

Panelist

/Christopher S. Gibson/

Christopher S. Gibson

Panelist

Date: April 19, 2023