

ADMINISTRATIVE PANEL DECISION

Automobile Club di Brescia v. Registration Private, Domains By Proxy, LLC /
Tarek Kirschen, Glozal, Inc.
Case No. D2022-2314

1. The Parties

The Complainant is Automobile Club di Brescia, Italy, represented by Barzanò & Zanardo Milano SpA, Italy.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America (“United States”) / Tarek Kirschen, Glozal, Inc., United States.

2. The Domain Name and Registrar

The disputed domain name <bitcoinmillemiglia.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 June 27, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 1, 2022 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 amended Complaint on July 1, 2022.

The Center verified that the Complaint together with the amended 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 29, 2022.

The Center appointed Elise Dufour as the sole panelist in this matter on August 3, 2022. 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, Automobile Club di Brescia, is an Italian Public Entity that organizes through its owned company 1000 Miglia S.r.l. the car race MILLE MIGLIA which takes place every May since 1927.

The car race MILLE MIGLIA is an open-road endurance race for production cars covering a distance of one thousand miles from Brescia to Rome round trip. Since 1977, the MILLE MIGLIA has been transformed into a regular race for classic and vintage cars, and the participation is limited to models produced no later than 1957.

The Complainant owns several trademark registrations in many countries including *inter alia* the following trademarks:

- International Trademark Registration No. 776355 for MILLE MIGLIA designating among the others the United States, registered on July 19, 2001, in classes 3, 9, 12, 14, 16, 18, 25, 28, 33, 36, 38, 41, and 42; and
- United States Trademark Registration No. 5450490 for MILLE MIGLIA, registered on April 24, 2018 in classes 3, 9, 12, 16, 18, 28, and 42; and
- European Union Trademark Registration No. 1519511 for MILLE MIGLIA, registered on April 2, 2001, in classes 9, 28, and 41.

The Complainant also owns over 80 domain names comprising the MILLE MIGLIA trademark under all different TLDs, including *inter alia* the following domain names:

- <millemiglia.com> registered on August, 31 1995;
- <millemiglia.us> registered on August 27 2004.

The disputed domain name <bitcoinmillemiglia.com> was registered on February 19, 2022 and resolves to a parked page displaying pay-per-click (“PPC”) advertisements.

5. Parties’ Contentions

A. Complainant

The Complainant contends that (i) the disputed domain name is confusingly similar to the Complainant’s trademarks; (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and (iii) the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name.

(i) The Complainant claims that the disputed domain name is entirely contained and clearly visible in the disputed domain name and the addition of the descriptive element “bitcoin” has no relevant impact in the confusing similarity assessment, since it has a mere descriptive meaning.

(ii) The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Complainant has not licensed or otherwise permitted the Respondent to use its trademark MILLE MIGLIA. The Respondent is not commonly known by the disputed domain name. The Respondent could not have ignored the trademark MILLE MIGLIA. Finally, the fact that the disputed domain name resolves to a webpage containing promotional links prevents any proof of *bona fide* or even fair use of the disputed domain name.

(iii) Due to the strong reputation of the trademarks MILLE MIGLIA, the Complainant considers that the Respondent could not have ignored the existence of the Complainant's trademarks at the time the disputed domain name was registered. The Complainant also claims that the Respondent's use of the disputed domain name is made in bad faith, as the Respondent acquired and is using the disputed domain name to capitalize on the reputation of the MILLE MIGLIA trademark in order to raise the visibility of the disputed domain name and consequently of the sponsored links.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In the absence of a formal Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent.

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- i) the disputed domain name is identical or confusingly similar to a trademark or service mark 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 was registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Complainant submitted evidence, which incontestably and conclusively establishes rights on the MILLE MIGLIA trademarks. The Complainant's MILLE MIGLIA trademarks have been registered and used in various countries in connection to the Complainant's organization of the Mille Miglia car race. Furthermore, the reputation of the MILLE MIGLIA trademarks has been established by numerous UDRP panel decisions.

The addition of the term "bitcoin" does not prevent confusingly similarity since the trademark remains recognizable within the disputed domain name. Indeed, where the relevant trademark is recognizable within the disputed domain name, the addition of other (descriptive) terms would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Thus, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and that the requirement of paragraph 4(a)(i) of the Policy is met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

(i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondent.

In that sense, the Complainant states that it has not licensed or otherwise permitted the Respondent to use the MILLE MIGLIA trademark in the disputed domain name, nor is there any sort of relationship between the Complainant and the Respondent.

Furthermore, the Complainant states that the Respondent is not 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 at issue.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition does not constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)).

In addition, previous UDRP panel decisions have found that the use of a domain name incorporating the entirety of a trademark to point to a parking PPC website containing links to financial activities could not be considered either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name since the respondent was benefiting by misleading Internet users to its website (see *Zions Bancorporation v. Domain Administrator, Fundacion Private Whois*, WIPO Case No. [D2014-0465](#)).

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Respondent's bad faith in registering the disputed domain name is made clear by the incorporation of the whole MILLE MIGLIA trademark.

Indeed, the Panel finds that it is inconceivable that the Respondent was unaware of the Complainant and its trademark rights when it registered the disputed domain name, as it includes the Complainant's trademark in its entirety.

In addition, the Complainant owns a significant number of longstanding trademark registrations for MILLE MIGLIA around the world and previous UDRP panels have recognized the reputation of the MILLE MIGLIA car race and related trademark.

Furthermore, the addition of the term "bitcoin" has a descriptive meaning (*i.e.* the famous cryptocurrency) that will not be perceived as a distinctive element and could be linked to a possible new crypto currency created by the Complainant.

The Panel therefore finds that the Respondent registered the disputed domain name in bad faith in order to take advantage of the Complainant's reputation.

As to the use that has been made of the disputed domain name, the Panel finds that the Respondent's use of the domain name for a parking page containing PPC commercial links is evidence that the Respondent was using the disputed domain name in bad faith.

The Panel finds that the Complainant successfully fulfilled the requirements of paragraph 4(a)(iii).

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, <bitcoinmille miglia.com>, be transferred to the Complainant.

/Elise Dufour/

Elise Dufour

Sole Panelist

Date: August 17, 2022