

ADMINISTRATIVE PANEL DECISION

Italo - Nuovo Trasporto Viaggiatori S.P.A. v. Mike Fuller
Case No. D2024-5225

1. The Parties

The Complainant is Italo - Nuovo Trasporto Viaggiatori S.P.A., Italy, represented by GriffeShield S.r.l., Italy.

The Respondent is Mike Fuller, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <italotrain.com> and <italotrains.com> are 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 19, 2024. On December 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 20, 2024, 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 December 23, 2024.

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 December 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 12, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 13, 2025.

The Center appointed Assen Alexiev, Angelica Lodigiani, and Lawrence K. Nodine as panelists in this matter on January 27, 2025. 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.

4. Factual Background

The Complainant was incorporated in 2006. It is Italy's first private high-speed rail operator and operates under the brand .ITALO. The Complainant offers 120 daily trips through a network of 58 stations and a team of over 1,400 employees. By 2024, the Complainant had served over 150 million passengers.

The Complainant is the owner of a number of trademark registrations for the sign “.ITALO” (the “.ITALO trademark”), including the following:

- the European Union trademark .ITALO (figurative) with registration No. 007066699, registered on March 18, 2009 for goods and services in International Classes 16, 39, 42, and 43; and
- the Italian trademark .ITALO (figurative) with registration No. 0001350123, applied for on July 24, 2008 and registered on September 29, 2010 for goods and services in International Classes 16, 39, 42, and 43.

The Complainant is also the owner of the domain name <italotreno.it>, which was registered on September 13, 2010 and resolves to its official website.

The Respondent operates the website at the domain name <italiarail.com>, where it offers for sale train tickets of the Italian rail company “Trenitalia”, which is the Complainant's main competitor, and of other European rail transportation companies. According to the information on the Respondent's website, its business was launched in 2004 and has offices in Australia, Canada, the United Kingdom and the United States, and offers tickets for more than 80,000 high-speed and regional train routes in Europe, including Eurostar, Frecciarossa, Frecciargento, Frecciabianca InterCity & Eurocity, TGV, InterCity Express, Elipsos, Lyria and Eurail & Interrail Passes.

The disputed domain name <italotrain.com> was registered on January 3, 2010, and the disputed domain name <italotrains.com> was registered on April 11, 2010. They both resolve to parking webpages of the Registrar. At the time of the filing of the Complaint, the disputed domain name <italotrain.com> resolved to a parking webpage containing pay-per-click (“PPC”) links redirecting to third-party websites offering train tickets, and the disputed domain name <italotrains.com> resolved to a parking webpage containing PPC links redirecting to a website offering train models.

This is not the first dispute under the Policy between the Parties. In 2022, they were involved in the proceeding in *Italo - Nuovo Trasporto Viaggiatori S.p.A. v. Mike Fullerrh*, WIPO Case No. [D2022-5026](#) (the “Prior Proceeding”), in which the Complainant prevailed and obtained the transfer of the domain name <italotreno.com>, which now redirects to the Complainant's official website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

The Complainant submits that the disputed domain names are confusingly similar to its .ITALO trademark, because they incorporate it with the addition of the dictionary words “train” and “trains”, which are the English translation of the Italian word “treno”, and do not affect the confusing similarity with the trademark. According

to the Complainant, the combination of its .ITALO trademark with these terms could improperly suggest to consumers that the disputed domain names and the associated websites might be controlled or authorized by the Complainant.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain names, because it is not an authorized agent or distributor of the Complainant, and the Complainant has not authorized it to use the .ITALO trademark in the disputed domain names or otherwise. The Complainant adds that the Respondent is not commonly known by the disputed domain names and has no relevant trademark rights. According to the Complainant, the Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services and is not making any noncommercial or fair use of them.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, it is unlikely that the Respondent didn't know about the Complainant when registering the disputed domain names, considering its business selling train tickets for the major Italian rail company Trenitalia, which is the Complainant's main competitor.

The Complainant points out that at the time of filing of the Complaint, the disputed domain names resolved to a parking webpage containing PPC links to websites offering train tickets of the Complainant's competitors or train models. According to the Complainant, the Respondent thus attempts to gain an unfair advantage by using the Complainant's .ITALO trademark for commercial gain. The Complainant submits that the disputed domain names are not being actively used, but if the Respondent starts using them, that use would be commercial and would be detrimental to the Complainant's business.

The Complainant submits that it became aware that the Respondent had registered the disputed domain names in the course of the Prior Proceeding. In order to solve the matter amicably without commencing a second UDRP proceeding to recover the ownership of the disputed domain names, on September 23, 2024, the Complainant's counsel contacted the Respondent to request the transfer of the disputed domain names to the Complainant, which was rejected by the Respondent.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Panel notes that the Complaint was duly notified to the Respondent by the Center. It is notable that the Respondent actively defended its position in the Prior Proceeding, raising various arguments on the issues of rights and legitimate interests and bad faith.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of the .ITALO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the .ITALO trademark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the .ITALO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “train” or “trains”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the .ITALO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The disputed domain names are confusingly similar to the Complainant’s .ITALO trademark and may attract Internet users looking for the Complainant’s train transportation services. The evidence in the case shows that they have been used for webpages containing PPC links, including to third-party websites offering train tickets or train models. This may confuse Internet users to believe that the disputed domain names, the associated webpages and the PPC links on them are somehow associated to or endorsed by the Complainant. Such use of the disputed domain names cannot be regarded as giving rise to rights or legitimate interests in the disputed domain names, especially considering that the Respondent’s business is the sale of train tickets for the Complainant’s competitors.

The Panel is aware that the Respondent has raised various arguments in the Prior Proceeding on the issues of rights and legitimate interests and bad faith. However, it has refrained from raising these arguments in the present proceeding, so the Panel does not consider it necessary or appropriate to address them here. In his reply of September 23, 2024 to the Complainant’s cease-and-desist letter of the same day, the Respondent stated that the decision in the Prior Proceeding was wrong, but then did not submit a Response in which he could have explained why he believed this was so.

Considering all the above, the Panel reaches the conclusion that the prima facie case made by the Complainant has remained unrebutted, and finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Respondent sells tickets for the Complainant's competitors, which makes it likely that it knew of the Complainant when registering the disputed domain names, which are combinations of the Complainant's .ITALO trademark with the dictionary words "train" and "trains", which directly refer to the Complainant's business. The Respondent has then associated the disputed domain names to parking webpages containing PPC links to websites that offer train tickets or train models. Such use may confuse Internet users that the disputed domain names and the online content associated to them are somehow associated with or endorsed by the Complainant.

The Respondent has not submitted a Response and has not brought forward any arguments in its defense. As mentioned in the section on rights and legitimate interests, the Panel is aware that the Respondent has raised numerous arguments in the Prior Proceeding, but has refrained from doing so in the present proceeding, so there is no basis to assume that the Respondent still maintains them. Considering this, the Panel concludes that it is not necessary or appropriate to take into account and consider here the arguments raised by the Respondent in the Prior Proceeding.

In view of all the above, the Panel finds that by registering and using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the online content associated to them by creating a likelihood of confusion with the Complainant's .ITALO trademark as to the affiliation or endorsement of the disputed domain names and of the online content associated to them. This supports a finding of bad faith registration and use of the disputed domain names under paragraph 4(b)(iv) of the Policy.

The Panel therefore finds that the Complainant has established the third element 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 names, <italotrain.com> and <italotrains.com>, be transferred to the Complainant.

/Assen Alexiev/
Assen Alexiev
Presiding Panelist

/Angelica Lodigiani/
Angelica Lodigiani
Panelist

/Lawrence K. Nodine/
Lawrence K. Nodine
Panelist
Date: February 10, 2025