

## **ADMINISTRATIVE PANEL DECISION**

Enel S.p.A. v. aaa, bbb ccc  
Case No. D2022-1741

### **1. The Parties**

The Complainant is Enel S.p.A., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is aaa, bbb ccc, United States of America.

### **2. The Domain Name and Registrar**

The Disputed Domain Name <kekuatan-enel.com> (the “Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 13, 2022. On May 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 13, 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 May 16, 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 amendment to the Complaint on May 17, 2022.

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 May 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2022. The Center received an email communication from the Respondent on May 24, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on June 9, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on June 17, 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.

The Center received an email communication from the Complainant on June 15, 2022, requesting the inclusion of further domain names <enelnurhijau.com>, <enelpk.com>, and <enelmy.com> in the Complaint.

#### **4. Factual Background**

The Complainant, Enel S.p.A, is a renowned Italian company in the energy market, operates through its subsidiaries in more than 32 countries across 4 continents, and brings energy to around 64 million customers. Since its incorporation, the Complainant has expanded its business to highly diversified sectors of hydroelectric, wind, geothermal, solar, thermoelectric, nuclear, and other renewable power sources. In 2020, Enel was ranked 87th in the list of the world's largest companies based on turnover by Fortune Global 500.

The Complainant is the owner of numerous trademark registrations for ENEL in a variety of jurisdictions, including, but not limited to the European Union Trade Mark No. 756338, ENEL (figurative), registered on June 25, 1999; Italian trademark registration No. 1299011, ENEL (figurative), registered on June 1, 2010; International trademark registration No. 1322301, ENEL (figurative), registered on February 4, 2016 designating, *inter alia*, the United States of America, where the Respondent resides; and Indonesian trademark registration No. IDM000384656, ENEL (figurative), registered on June 14, 2021.

In addition, the Complainant is the owner of more than 100 domain names containing the ENEL trademarks, notably the domain name <enel.com> registered on May 3, 1996.

The Disputed Domain Name was registered on March 18, 2022. As of the date of this Decision, the Disputed Domain Name is resolving to a website that advertises a platform for possible investments for the project of power generation in Indonesia under the mark PT. Energi Hijau. However, according to the evidence submitted by the Complainant, the Disputed Domain Name was used to resolve to a similar website bearing the Complainant's trademarks ENEL.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

First, the Complainant contends that it owns a variety of trademark registration for ENEL in many jurisdictions, including Indonesia and the United States of America. These trademark registrations predate the registration date of the Disputed Domain Name. In addition, the Complainant registered a number of domain names containing the ENEL trademarks associated with various top-level domains.

Second, the Complainant asserts that the Disputed Domain Name is confusingly similar to its trademarks because the Complainant's ENEL trademarks were wholly incorporated in the Disputed Domain Name. Moreover, the Complainant argues that the Disputed Domain Name is conceptually identical to its registered ENEL ENERGIA trademark and the domain name <energiaenel.cl>. Besides, the addition of the hyphen in the Disputed Domain Name makes the consumer immediately separate the Disputed Domain Name into the components of "enel" and "kekuatan" (which means "energy" in Indonesian).

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant contends that it has neither authorized nor given consent for the Respondent to register and use the Disputed Domain Name.

Second, the Complainant submits that there is no evidence demonstrating the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods and services. In contrast, the Disputed Domain Name has been registered and it is being used for exploiting the reputation of the Complainant's trademarks ENEL to attract current and potential Complainant's clients.

Third, the Complainant argues that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain, supported by the fact that the Disputed Domain Name resolves to a website incorporating the trademarks ENEL for advertisement of unauthorized activities of possible investments in ENEL.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Complainant contends that the Respondent had knowledge or exercised willful blindness of the Complainant's earlier rights in and to the ENEL trademarks. It is argued by the Complainant that the Disputed Domain Name reproduces, without the Complainant's authorization or approval, the ENEL trademarks, which are the most distinctive component of the Disputed Domain Name; while the ENEL trademarks are not common or descriptive terms, and they obtain recognition as well-known trademarks thanks to the intensive use made by the Complainant.

Furthermore, the Complainant asserts that the Disputed Domain Name is not used in good faith to offer goods and services to the public, nor used for legitimate commercial or noncommercial use without the intention of misleading the Complainant's customers or infringing the registered ENEL trademarks. In contrast, the Complainant contends that the Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the ENEL trademarks to attract Internet users to the website related to the Disputed Domain Name, creating a likelihood of confusion with the Complainant's ENEL trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

In addition, the registration of the Disputed Domain Name deprived the Complainant of the possibility to register the Disputed Domain Name in which it might have a legitimate interest.

Therefore, the Complainant considers that the Respondent registered and is using the Disputed Domain Name in bad faith under Policy 4(b).

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

## **B. Respondent**

The Respondent did not formally reply to the Complaint, except for the email dated May 24, 2022, in the Indonesian language. By a Google translation, it is understood that this communication is merely a receipt confirmation of the emails by the Center and an apology by the Respondent, but does not include any response to the substantive issues of the case.

## **6. Discussion and Findings**

### **A. Procedural Issue**

#### **(I) Consolidation and/or addition of further domain names**

The Center received an email from the Complainant on June 15, 2022, requesting the inclusion of further domain names <enelnurhijau.com>, <enelpk.com>, and <enelmy.com> to the current proceeding. The Center responded by noting that the Rules do not explicitly provide for an amendment of a Complaint for the purpose of adding further domain names after commencement of the proceeding.

Paragraph 10(e) of the Rules provides the UDRP panels with authority to order the consolidation of multiple domain names. The consolidation of complaints against multiple respondents is further guided under section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Besides, according to section 4.12.2 of the [WIPO Overview 3.0](#), a request for adding domain names to a Complaint after it has been notified to the respondent and the proceedings have formally commenced would be addressed by the appointed panel. Moreover, panels are generally reluctant to accept such requests because the addition of further domain names would delay the proceedings (which are expected to take place with due expedition).

In this case, the Panel notes that the Complainant has failed to provide clear evidence that the further domain names are registered by the same person as the Registrant of the Disputed Domain Name, or the further domain names or corresponding websites are subject to common control. In particular, the Complainant, in its email communication dated June 15, 2022, stated that the further domain names could be related to either the Disputed Domain Name or the registrant, but such a statement was made without any convincing evidence. Notably, according to the Whois information provided by the Complainant on June 15, 2022, the registrant of the domain name <enelmy.com> was a privacy service, which was different from the one that appears to have been used in connection to the Disputed Domain Name, while no information on the registrant of the domain names <enelnurhijau.com> and <enelpk.com> was disclosed. Moreover, the further domain names were registered with different registrars, *i.e.*, Mat Bao Corporation (for <enelnurhijau.com>), GoDaddy.com, LLC (for <enelmy.com>), and Web Commerce Communications Limited dba WebNic.cc (for <enelpk.com>), as compared to the Registrar of the Disputed Domain Name, *i.e.*, NameSilo, LLC.

From the foregoing, the Panel finds that facts and circumstances for the consolidation and/or addition of the further domain names into the subject case are insufficient at this stage of the proceeding, and there is insufficient basis to justify seeking further information and delaying the present proceeding. Further, the Panel also notes that declining the mentioned request by the Complainant would not prevent the Complainant from filing a separate complaint concerning these domain names.

Therefore, the Panel rejects the request for consolidation and/or addition of the further domain names to the current proceeding.

### **B. Identical or Confusingly Similar**

The Complainant is required to establish the two following elements: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Panel acknowledges that the Complainant had registered trademark rights to ENEL in the United States of America, where the Respondent apparently resides, and Indonesia where the website under the Disputed Domain Name targets its visitors, and many jurisdictions worldwide before the Disputed Domain Name was registered.

Second, the Disputed Domain Name consists of the Complainant's trademark ENEL combined with the term "kekuatan" ("energy, power" in Indonesian), which refers to the Complainant's main field of activity and a hyphen "-", which is a punctuation mark. The Panel is satisfied that ENEL remains clearly recognizable in the Disputed Domain Name. It is well established that adding a term (such as "kekuatan") and a hyphen mark to a trademark does not prevent a finding of confusing similarity between the Complainant's trademark and the Disputed Domain Name. Thus, in the Panel's view, it is well established that wholly incorporating the Complainant's distinctive ENEL trademarks with the addition of the said elements does nothing to prevent the trademark from being recognizable in the Disputed Domain Name, nor to prevent confusing similarity, as it was found in previous UDRP decisions (See, e.g., *Royal Canin SAS v. Ong Pham Duc Thang*, WIPO Case No. [D2017-2567](#)).

Third, the Panel finds, similarly to other UDRP panels, that the addition of the generic Top-Level Domain ("gTLD") ".com" to the Disputed Domain Name does not constitute an element to avoid confusing similarity for the Policy purposes (See, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. D2012-2066; *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Based on the foregoing findings, the Panel finds that the Disputed Domain Name is confusingly similar to the ENEL trademarks, and paragraph 4(a)(i) of the Policy is established.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists circumstances, in particular, but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- "(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."

The Panel finds that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent's informal communications are insufficient to refute the Complainant's contentions, as discussed further below.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no official response was submitted with evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel acknowledges that the Complainant has no business relationship with the Respondent and neither authorized nor consented to the Respondent to use the ENEL trademarks. There is no evidence in the record suggesting that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel is satisfied that the Respondent has no rights in the ENEL trademarks.

In addition, it is proven and evidenced by the Complainant that the Disputed Domain Name was used to resolve to a webpage where the Complainant's trademarks ENEL was incorporated for advertising a platform for possible investments for the project of power generation in Indonesia. These unauthorized uses of ENEL trademarks may mislead visitors into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality. The Panel therefore finds that the Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of goods or services (See, e.g., *Ustream.TV, Inc. v. Vertical Axis, Inc.*, WIPO Case No. [D2008-0598](#); *Boris Johnson v. Belize Domain Whols Service Lt*, WIPO Case No. [D2010-1954](#)). Hence, under the attendant circumstances, the Panel believes that paragraph 4(c)(i) is not met.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds no evidence would suggest that the Respondent, as an individual, business, or other organization, has at any point been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. After reviewing the facts and circumstances in the record, the Panel is satisfied that the Respondent had full knowledge of the ENEL trademarks and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests regarding the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy, is established.

#### **D. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy identifies, in particular, but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The above four circumstances are not exhaustive, and the Panel may find bad faith alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Names in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's bad faith registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's ENEL trademarks have been registered in a variety of jurisdictions around the world. In addition, the Complainant's ENEL trademarks have been put in use for a number of years and have gained certain reputation in the sector of energy. The Complainant's registrations of the ENEL trademarks predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the Complainant's ENEL trademarks in its entirety, with the addition of the descriptive term "kekuatan" ("energy, power" in Indonesian) and a hyphen "-". Given the extensive use of the ENEL trademarks by the Complainant, which occurs in numerous countries, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its ENEL trademarks when it registered the Disputed Domain Name. The Panel considers the registration of the Disputed Domain Name is an attempt by the Respondent as to take unfair advantage of the Complainant's goodwill, and the reputation of the Complainant's ENEL trademarks.

In addition, it is well proven and evidenced by the Complainant that the Respondent used the Complainant's trademarks and logo on the website under the Disputed Domain Name for advertising a platform for possible investments for the project of power generation in Indonesia. In the absence of any reply by the Respondent, the Panel considers such use indicates the Respondent was intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of service on the Respondent's website. In contrast, no such connection exists in fact. Hence, under the attendant circumstances, the Panel is of the view that paragraph 4(b)(iv) is established.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith, and the third element under paragraph 4(a)(iii) of the Policy is established.

## **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 <kekuatan-enel.com> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: July 1, 2022