

## **ADMINISTRATIVE PANEL DECISION**

Enel S.p.A. v. Domain Admin, Whois Privacy Corp. / roberto vaccarella  
Case No. D2022-2022

### **1. The Parties**

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

The Respondent is Domain Admin, Whois Privacy Corp., Bahamas / roberto vaccarella, Italy.

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

The disputed domain name <enelpay.com> is registered with Internet Domain Service BS Corp (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 3, 2022. On June 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 8, 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 June 9, 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 June 13, 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 June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. The Center received an email communication from the Respondent on June 14, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on July 5, 2022.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on July 8, 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**

Enel S.p.A (hereinafter referred to as “Enel” or the “Complainant”) is one of the largest Italian companies in the energy market. It manages the greater part of the Italian electricity and gas distribution network, serving more than 26 million Italian customers. The Complainant is the parent company of the Enel Group, which operates through its subsidiaries in more than 32 countries across four continents and brings energy to around 64 million customers.

Today the Complainant supplies energy worldwide, with an extensive presence in Europe. The Complainant is also one of the largest energy companies in the Americas, with 71 power generation plants of all types with a managed capacity of around 6.03 GW across 18 states in the United States of America (“United States”) and Canada, and in South America up to the central Andes.

The Complainant is the owner of more than 100 domain names containing the trademark ENEL, including <enel.it> and <enel.com>, both of which have been registered in the name of the Complainant since 1996.

The Complainant owns the ENEL mark, which enjoys thorough protection through many registrations thereof worldwide, including in Italy.

The Complainant is, *inter alia*, the owner of:

Italian trademark registration number 0001299011 for the ENEL device trademark, registered on June 1, 2010; and European Union Trade Mark registration number 000756338 for the ENEL device trademark, registered on June 25, 1999.

The disputed domain name was registered on March 21, 2022.

The disputed domain name does not lead to an active website. In fact, it redirects Internet users to the website of a domain name broker, where a message announcing that the disputed domain name is for sale is displayed.

#### **5. Parties’ Contentions**

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

The Complainant claims that:

- (a) the disputed domain name is confusingly similar to the Complainant’s trademark;
- (b) the Respondent lacks any rights or legitimate interests in the disputed domain name; and
- (c) the Respondent has registered and is using the disputed domain name in bad faith.

##### **B. Respondent**

The Respondent did not formally reply to the Complainant’s contentions.

In fact, the Respondent sent only an informal communication to the Center on June 14, 2022, basically affirming that: he did not understand why the Center had contacted him; that he never made any claim to the disputed domain name; and that he did not know anything about the case at issue.

## 6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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 has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The disputed domain name <enelpay.com> consists of a variation of the Complainant's trademark. Specifically, this consists of the addition of the term "pay" at the end of the wording "enel".

The addition of the term "pay" to the Complainant's trademark in the disputed domain name <enelpay.com> does not avoid a finding of confusing similarity under the first element of the UDRP. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

The Panel considers that the generic Top-Level Domain ("gTLD") ".com" is irrelevant in assessing the confusing similarity between the Complainant's trademarks and the disputed domain name. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

It appears that the section dealing with the Respondent's rights or legitimate interests is missing from the Complaint (the related pages are not enclosed, possibly owing to a technical error). Nevertheless, owing to the Complainant's assertions made in other parts of the Complaint, and having evaluated the Respondent's assertion that he has no claim to the disputed domain name, the Panel finds that there are sufficient elements to assess this point, *i.e.* whether or not the Respondent has rights to or legitimate interests in the disputed domain name.

In fact, the Respondent does not appear to be commonly known by the name "enel" or by any similar name. The Respondent has no connection to or affiliation with the Complainant and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademarks. The Respondent does not appear to make any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services. In fact, the disputed domain name redirects to the website of a domain name broker where the disputed domain name is offered for sale. In addition, the Respondent has not replied to the Complainant's contentions claiming any rights to or legitimate interests in the disputed domain name. On the contrary, the Respondent has affirmed that he has no claim to the disputed domain name.

Moreover, the fact that the disputed domain name is so confusingly similar to the Complainant's ENEL trademark carries with it a high risk of implied affiliation. Section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy

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

The Panel, based on the evidence presented, accepts and agrees with the Complainant's contentions that the disputed domain name was registered and has been used in bad faith.

Indeed, the Complainant gives several bases for its contention that the disputed domain name was registered and is being used in bad faith.

"Enel" is not a common or descriptive term, but a renowned trademark, especially in Italy where the Respondent resides.

The disputed domain name reproduces, without any authorization or approval, the Complainant's registered ENEL trademarks, and this is the only distinctive component of the disputed domain name. The fact that the disputed domain name is so confusingly similar to the Complainant's ENEL trademark carries with it a high risk of implied affiliation.

The disputed domain name was registered many years after the Complainant's renowned trademarks were registered. In addition, owing to the substantial presence established worldwide and particularly in Italy – where the Respondent resides – and on the Internet by the Complainant, who has registered more than 100 domain names in gTLDs and country code Top-Level Domains ("ccTLDs") worldwide which incorporate the trademark ENEL as a domain name, it is at the least very unlikely that the Respondent was not aware of the existence of the Complainant's trademarks when registering the disputed domain name.

Therefore, it is more likely than not that the Respondent, when registering the disputed domain name, had knowledge of the Complainant's earlier rights to the ENEL trademark and trade name.

Furthermore, the Panel finds that the passive holding of the disputed domain name in the circumstances of the case does not prevent a finding of bad faith registration and use. On the contrary, this Panel agrees with previous panelists' assertion that in the case of domain names containing well-known earlier marks, passive holding can constitute an indication of bad faith.

Here the Panel finds that the Respondent's passive holding of the disputed domain name constitutes bad faith use and registration (see section 3.3 of the [WIPO Overview 3.0](#)) as well as a disruption of the Complainant's business.

The bad faith registration and use of the disputed domain name are also affirmed by the fact that the Respondent has not denied the assertions of bad faith made by the Complainant in this proceeding.

Finally, in the Panel's view, the Respondent's assertion in its informal email that he has no claim to the disputed domain name amounts to a recognition of the Complainant's prior rights and claims.

Accordingly, the Panel finds, based on the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Complainant has satisfied paragraph 4(a)(iii) 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, <enelpay.com>, be transferred to the Complainant.

*/Fabrizio Bedarida/*

**Fabrizio Bedarida**

Sole Panelist

Date: July 15, 2022