

ADMINISTRATIVE PANEL DECISION

Enel S.p.A. v. Neo Mngwevu
Case No. D2023-3495

1. The Parties

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

The Respondent is Neo Mngwevu, South Africa.

2. The Domain Name and Registrar

The disputed domain name <enelfinances.com> is registered with FastDomain, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2023. On August 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 17, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 18, 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 amended Complaint on August 21, 2023.

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 August 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2023.

The Center appointed Daniel Peña as the sole panelist in this matter on September 19, 2023. 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 is the largest Italian company in the energy market.

The Complainant owns the following trademark registrations:

- Italian trademark registration No. 000825764 for the ENEL figurative trademark, registered on October 4, 2000;
- Italian trademark registration No. 0001299011 for the ENEL figurative trademark, registered on June 1, 2010;
- Italian trademark registration No. 0000825734 for the ENEL trademark, registered on October 4, 2000;
- European Union trademark registration No. 000756338 for the ENEL device trademark, registered on June 25, 1999;
- European Union trademark registration No. 015052152 for the ENEL trademark, registered on May 13, 2016;
- International trademark registration No. 1322301 for the ENEL trademark, registered on February 4, 2016 - designated countries: China, Colombia, Algeria, Israel, Morocco, Mexico, Russian Federation, Turkey, United States of America.

The disputed domain name was registered on January 31, 2023 and it resolves to the webpage of a South African company named "Enel Finances" which apparently provides administrative services for businesses.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- i. The Complainant manages the majority of the Italian electricity and gas distribution network serving more than 26 million Italian customers;
- ii. The Complainant is the parent company of the Enel Group, which operates through its subsidiaries in more than 32 countries across 4 continents, with a net installed capacity of around 86 GW and networks covering about 2.2 million kilometers and brings energy to around 64 million customers;
- iii. The Complainant is active also through the subsidiary Endesa in Morocco and in South Africa, where in 2015 Enel won the award of "Investor of the year" for our various projects in the renewable energy sector;
- iv. The disputed domain name is confusingly similar to the Complainant's ENEL trademark with the only addition of the descriptive term "finances";
- v. The Respondent has no rights on the trademark ENEL or ENELFINANCES to which the disputed domain name refers;
- vi. The Complainant has never authorized, nor somehow given its consent to the Respondent to register and use the disputed domain name;
- vii. The disputed domain name has been registered and is being used in order to attract current and potential customers of the Complainant, exploiting the reputation of the Complainant's trademarks;
- viii. The disputed domain name resolves to the webpage of a South African company named Enel Finances which apparently provides administrative services for businesses. In this website, the Respondent reproduces without authorization the Complainant's trademark and uses a logo that recalls the Complainant's historical "tree" logo;

ix. The disputed domain name was registered and is being used by the Respondent in bad faith.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (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. Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademark ENEL on the basis of its multiple trademark registrations including its international and Italian trademark registrations as well as in the European Union. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1).

It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of the [WIPO Overview 3.0](#). The Respondent's incorporation of the Complainant's ENEL trademark in full in the disputed domain name is evidence that the disputed domain name is confusingly similar to the Complainant's mark.

The mere addition of the term "finances" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's ENEL trademark because the Complainant's ENEL trademark remains clearly recognizable in the disputed domain name. As noted in [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) does not prevent a finding of confusing similarity under the first element."

Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In accordance with paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the disputed domain name.

Panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademark in a domain name or in any other manner, also asserting that the Respondent is not commonly known by the disputed domain name. Furthermore, the disputed domain name directs to a commercial website that offers administrative services, without any disclaimer as to the relation with or authorization of the Complainant, exacerbating the user confusion as to the website's affiliation to the Complainant.

Such use for deliberately attracting Internet users to its website in the mistaken belief that it is a website of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain name.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name.

In view of all the relevant circumstances, the Panel accepts the Complainant's *prima facie* which has remained unrebutted by the Respondent. The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 6(a)(ii) of the Policy is satisfied.

The Panel concludes that the Respondent deliberately chose to include the Complainant's ENEL trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use.

Thus, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. WIPO Overview section 3.2.2. In this case, the Complainant submits that at the date of registration of the disputed domain name the Respondent knew or should have known of the Complainant's trademark ENEL considering the global renown of the Complainant's prior mark.

The Panel takes note of the construction of the disputed domain name, which combines the ENEL trademark with the term “finances” that is descriptive, as well as the fact that the disputed domain name directs to a website that contains a logo that recall’s the Complainant’s logo and allegedly offers administrative services.

The Panel is satisfied that by directing the disputed domain name to a commercial website allegedly offering administrative services, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

The Complainant points out that the Respondent is hiding its identity behind a Whois privacy service. It is well-established that this, too, can be a further indicator of bad faith in certain circumstances. Having considered the Complainant’s submissions and in the absence of a Response, the Panel accepts the Complainant’s submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register or use the inherently misleading disputed domain name.

Consequently, the Panel finds that the disputed domain name was registered and used by the Respondent in bad faith within 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, <enelfinances.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: October 3, 2023