

ADMINISTRATIVE PANEL DECISION

Enel S.p.A. v. Contact Privacy Inc. Customer 12410359377 / Amanda Fidelis Campelo
Case No. D2022-0229

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 12410359377, Canada / Amanda Fidelis Campelo, Brazil.

2. The Domain Name and Registrar

The disputed domain name <enelxstore-energiasolar.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 21, 2022. On January 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details and informing that the language of the registration agreement is Portuguese. The Center sent an email communication to the Complainant on February 17, 2022 providing the information about the language of registration agreement. The Complainant filed an amendment to the Complaint on the same day, February 17, 2022, requesting English to be the language of proceeding.

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 February 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 24, 2022.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on April 4, 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 is one of the largest Italian companies in the energy market. It manages the majority 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 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 15 domain names consisting of the second-level domain "enelenergia" and 5 domain names consisting of the second-level domain "enelx" which redirect to the main corporate website "www.enel.it", which has been registered in the name of the Complainant since 1996 (Annex 13 of the Complaint).

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

Italian trademark registration number 0001299011 for the ENEL trademark, registered on June 1, 2010; and European Union trademark registration number 000756338 for the ENEL device trademark, registered on June 25, 1999. Italian trademark registration number 2017000132445 for the ENEL X trademark, registered on August 21, 2018; and European Union trademark registration number 18004526 for the ENEL X STORE trademark, registered on June 13, 2019, Italian trademark registration number 0001048726 for the ENEL ENERGIA trademark, registered on May 23, 2007.

The disputed domain name was registered on June 5, 2021, and at the time of filing the Complaint, the disputed domain resolves to a page with no contents. At the time of the Decision, the disputed domain name does not resolve to an active webpage.

5. Parties' Contentions

A. Complainant

The Complainant claims that:

a) the domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights since it i) incorporates the Complainant's whole name and trademark, ENEL and ii) is conceptually identical to, and confusingly similar from a visual/phonetic point of view to the Complainant's trademarks ENEL X, ENEL X STORE, and ENEL ENERGIA.

b) The Respondent has no rights or legitimate interests in respect of the domain name since i) the Complainant has not given authorisation to the Respondent or licensed the use of the disputed domain name, ii) the disputed domain name does not resolve to an active webpage and iii) the Respondent's use of the disputed domain name is not associated with a *bona fide* offering of goods or services nor with a legitimate noncommercial or fair use.

c) The domain name was registered and is being used in bad faith since the Complainant's trademark is distinctive and well known. The disputed domain name contains the distinctive trademark and indicates that the Respondent was well aware of the Complainant's trademark when registering the disputed domain name. The disputed domain name is also used in bad faith within the meaning of paragraph 4(a)(iii) and 4(b) of the Policy. In this connection, the Complainant highlights that the disputed domain name is not being used in relation to an active website and is therefore being passively held by the Respondent, thus also causing a likelihood of confusion as to the source, sponsorship and affiliation of its website.

B. Respondent

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

6. Discussion and Findings

6.A Preliminary Matter – Language of the Proceeding

The Complainant requests that the language of proceedings be English as neither the Complainant nor its representatives are familiar with the Portuguese language. The Complainant finds persuasive evidence in the present proceeding that the Respondent may have at least sufficient knowledge of English. In particular, based on the evidence that the disputed domain name includes the English word "store" and "solar". Although the word "solar" can also be a Portuguese word, the Panel notes that the Respondent did not reply to the Complainant's contentions or object to the Complainant's request that the language of the proceeding be English.

Moreover, the Panel notes that the Center's communications to the Parties have been transmitted in both English and Portuguese. The Panel would have accepted a response in either English or Portuguese, however, no response was received from the Respondent. Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English.

6.B Substantive Matters

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if prove by the Respondent, shall be evidence of the Respondent's rights to or legitimate interests in the disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The disputed domain name incorporates the Complainant's trademarks ENEL, ENEL X, ENEL X STORE, and ENEL ENERGIA in their entirety. The disputed domain name combines these four separate trademarks and adds the word "solar". As the trademarks are clearly recognizable within the disputed domain name, the addition of this word does not prevent a finding of confusing similarity.

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

B. Rights or Legitimate Interests

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. As highlighted in several previous UDRP decisions, in such a case the burden of production shifts to the Respondent to rebut the evidence (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1). The Respondent has no connection to or affiliation with the Complainant and the Complainant has not licensed nor given its consent to 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 service. In fact, the disputed domain name resolves to an unreachable webpage with no contents.

The Respondent did not submit a response and has failed to invoke any circumstance which could have demonstrated rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

The Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. 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.

It is clear for the Panel that the Respondent knowingly registered the disputed domain name that is confusingly similar to not one but four trademarks belonging to the Complainant. As stated in *Enel S.p.A. v. Contact Privacy Inc. Customer 1249186223 / Mario*, WIPO Case No. [D2021-2279](#), given the distinctiveness and well-established reputation of the Complainant's trademarks (also recognized in *Enel S.p.A. v. G.A.C. – Consulenza Informatica*, WIPO Case No. [D2021-0436](#) and in *Enel S.p.A. v. Lucky Graziano, enel.website*, WIPO Case No. [D2021-1014](#)) it is not conceivable that the Respondent did not have in mind the Complainant's trademarks when registering the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith (see [WIPO Overview 3.0](#), section 3.2.2) with a deliberate intent to create an impression of an association with the Complainant.

The Respondent also registered the disputed domain name many years after the Complainant first registered its trademarks. ENEL is a renowned trademark in and to which the Complainant has demonstrated that it has rights. Given the worldwide presence of the ENEL mark, the addition of the word "solar", which is a descriptive term in the energy field, is a further indication that the Respondent targeted the Complainant.

Moreover, the fact that the disputed domain name is confusingly similar to four of the Complainant's trademarks carries with it a high risk of implied affiliation.

In the circumstances, the passive holding of the disputed domain name does not prevent a finding of bad faith (see [WIPO Overview 3.0](#), section 3.3).

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 <enelxstore-energiasolar.com> be transferred to the Complainant.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: April 25, 2022