

## **ADMINISTRATIVE PANEL DECISION**

Enel S.p.A. v. Airton Seidel, Brworks  
Case No. D2022-2536

### **1. The Parties**

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

The Respondent is Airton Seidel, Brworks Projects Ltd , Brazil, internally represented.

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

The disputed domain name <enel2via.net> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 12, 2022. On July 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 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 July 21, 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 amended Complaint on July 26, 2022.

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 July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. The Response was filed with the Center on July 28, 2022.

The Center appointed Steven A. Maier as the sole panelist in this matter on August 9, 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 a company registered in Italy. It is a multinational operator in the energy sector and is a major distributor of electricity and gas in regions including Europe and Latin America.

The Complainant is the owner of various trademark registrations comprising or include the mark ENEL. Those registrations include, for example:

- Italian trademark registration number 825734 for a stylized word mark ENEL, registered on October 4, 2000 in numerous International Classes;
- European Union Trade Mark registration number 756338 for a figurative mark comprising a “flame” device and the stylized word ENEL, registered on June 25, 1999 in numerous International Classes; and
- Brazilian trademark registration number 828354553 for a mark comprising the stylized word ENEL, registered on April 29, 2008 in International Class 37.

The disputed domain name was registered on August 18, 2020.

According to evidence submitted by the Complainant, on July 12, 2022, the disputed domain name resolved to a website at “www.enel2via.net”. The website was headed “enel 2 VIA” and appeared to offer “remote support” and to provide a facility to obtain duplicate copies of the Complainant’s invoices. It also included a “Blog” which appeared to contain information about the Complainant’s Brazilian website. The website also included advertising for an online clothing retailer named OVS, including individual product images and prices.

At the date of this Decision, the disputed domain name continues to resolve to a website at “www.enel2via.net”. However the website is now headed “ENEL 2a VIA”. It provides information about ways to obtain duplicate copies of the Complainant’s invoices and to pay such invoices, but also includes on its home page a prominent link to download “Wave Browser”. The website concludes with links to various advertisers offering a range of goods and services which have no apparent connection to the Complainant.

#### **5. Parties’ Contentions**

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

The Complainant submits that it is the largest Italian company in the energy market, managing the majority of the Italian electricity and gas distribution network and serving over 26 million Italian customers. It states that it has operated internationally since 2001 and now operates through subsidiaries in 32 countries across four continents, bringing energy to around 64 million customers. The Complainant states that its South American operations include the supply to energy to Rio de Janeiro.

The Complainant claims revenues of approximately EUR 76 billion in 2018 and provides evidence of media and industry recognition by way of global rankings and other awards. The Complainant also points to its sponsorship of significant sporting events, including events in motor racing, motorcycling and cycling.

The Complainant refers to its trademark portfolio, including registrations for ENEL ENERGIA in addition to ENEL, and also to websites which it operates at “www.enel.it” and “www.enel.com”.

The Complainant submits that the disputed domain name is confusingly similar to its trademark ENEL and contends that the incorporation of the whole of that trademark into the disputed domain name is sufficient to establish such confusing similarity.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has never authorized the Respondent to use its ENEL trademark and that the Respondent is making neither *bona fide* commercial use nor legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. It contends that the disputed domain name fully reproduces the Complainant's trademark and trading name ENEL and is used for the purpose of a website that refers to the Complainant's services without any authorization from the Complainant. The Complainant submits that the Respondent is taking unfair advantage of the distinctiveness of the ENEL trademark to create a likelihood of confusion between the disputed domain name and that trademark and misleadingly to attract Internet users to that website.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

The Respondent submits that it is a private digital marketing company and that it operates several websites and Internet blogs. It states that, where it cites the names of brands or companies on its websites, it always does so with the aim of providing information, education and learning.

The Respondent does not deny that the disputed domain name and its website refer to the Complainant. However, it states that it is one of several companies that provide information to readers about the Complainant's services and provides the URLs of three other websites. It states that, like these other companies, it has no intention of impersonating the Complainant, but only of providing information about services, invoices and company news.

The Respondent submits that, under Brazilian trademark law, there is no prohibition against citing a trademark for the purposes of speech, scientific or literary work or any other publication, provided that such citation does not have commercial connotations or prejudice the distinctive character of the trademark. The Respondent states that its use of the Complainant's trademark has been guided by this principle as "we have no intention of commercial connotation" or to prejudice the distinctive character of the mark.

The Respondent submits that its use of the disputed domain name is not liable to confuse customers of the Complainant.

The Respondent contends that it has rights or legitimate interests in respect of the disputed domain name because it is used for an informative blog in which it disseminates helpful information to people who are looking for data on how to duplicate their electricity, telephone or water bills or for other information. It states that blogs have now become an important source of such information.

The Respondent says that: "By accessing our blog, it is possible to verify that we do not sell or offer any type of service, we only provide quality content that is relevant to our readers. Therefore, the use is non-commercial!" The Respondent attaches extracts from its website.

The Respondent denies that the disputed domain name has been registered or is being used in bad faith. It repeats that the citation of a brand name is permitted by the Brazilian legal system and that, like other website operators, it is using the disputed domain name for educational purposes. It states that it does not denigrate or otherwise take unfair advantage of the Complainant or its trademark.

## **6. Discussion and Findings**

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (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.

#### **A. Identical or Confusingly Similar**

The Complainant has established that it has registered trademark rights in respect of the mark ENEL. The disputed domain name wholly incorporates that trademark, together with the additional characters “2via”, which do not prevent the Complainant's trademark from being recognizable within the disputed domain name. The Panel finds therefore that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

#### **B. Rights or Legitimate Interests**

The Respondent does not deny that the disputed domain name refers to the Complainant's ENEL trademark and affirms that its website provides information relating to the Complainant and, in particular, methods of obtaining duplicates of the Complainant's invoices. It states that it is not selling any product on its website and refers to content on the website which states that it is not selling any product or seeking to obtain any personal information from visitors. The Respondent submits on several occasions that its use of the disputed domain name is noncommercial and contends that its citation of the Complainant's trademark for such noncommercial purposes is legally permitted.

While the trademark law of Brazil is not directly applicable to this proceeding, which must be decided under the terms of the Policy, paragraph 4(c)(iii) of the Policy provides that a registrant may be able to demonstrate rights or legitimate interests in a domain name where: “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 essential problem with the Respondent's case, however, is that its use of the disputed domain name does not appear to be noncommercial as it claims. It appears from the Complaint that the Respondent's website included advertising for an online clothing retailer, and from the Panel's own review that it included the facility to download a browser as well as significant third-party advertising. The Panel infers that the Respondent receives income from such advertising, whether by way of pay-per-click revenues or otherwise, and is therefore using the disputed domain name for financial gain. In the view of the Panel, this constitutes use of the disputed domain name unfairly to target the Complainant's trademark, which cannot give rise to rights or legitimate interests on the Respondent's part.

The Panel finds therefore that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

There can be no dispute that the Respondent registered the disputed domain name with the Complainant's ENEL trademark in mind and with the intention of using the disputed domain name to refer to the Complainant's trademark and its services.

The Panel finds that the Complainant's ENEL trademark is widely known, particularly among customers for electricity and gas services, and that the disputed domain name is likely to mislead Internet users into believing that it is owned or operated by, or otherwise legitimately connected with, the Complainant.

The Panel also finds the Respondent's website content to be confusing. It includes the early statement (in translation): “Needing to issue your second copy of Enel? Then you've come to the right place!” It also

includes sub-headings which include “ENEL APP” and “ENEL SERVICES”. It contains a section “Who is the Enel company?” where it provides information about the Complainant and its customer services. While the website includes a statement that it “[...]aims to help users of all ages to request invoices and services from the company over the Internet,” and that it does not sell any products or collect personal data, it does not appear to include any clear disclaimer making plain its relationship, or more particularly the lack thereof, with the Complainant. In the circumstances of such ambiguity, the Panel has sympathy with the Complainant’s concern that the website purports to provide information about the Complainant and its services without the Complainant’s consent.

Moreover, the Panel has considerable difficulty in understanding the reasons for the Respondent to operate a website of this nature on a wholly noncommercial basis as it claims. At no juncture is it adequately explained why issues including the ability to obtain duplicates of the Complainant’s invoices justifies the setting up of a not-for-profit informational website and, having reviewed the website content as a whole (albeit in translation), the Panel is far from convinced of its *bona fides*. Taking into account that the website offers significant third-party advertising, the Panel finds on balance that the Respondent’s website is a pretext for commercial activities which take unfair advantage of the Complainant’s trademark rights. The Panel finds specifically that, by using the disputed domain name, 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 a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel concludes in the circumstances that the disputed domain name has been registered and is being used in bad faith.

## 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, <enel2via.net>, be transferred to the Complainant.

*/Steven A. Maier/*

**Steven A. Maier**

Sole Panelist

Date: August 23, 2022