Decision for dispute CAC-UDRP-101904

Case number	CAC-UDRP-101904
Time of filing	2019-06-24 10:39:34
Domain names	ENIEXPLORATION.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	ENI S.p.A.

Complainant representative

Organization	desimone & partners

Respondent

Organization	Eni Geotechnics and Exploration services Limited

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns an extensive portfolio of ENI and ENI formative word and word/device trademarks and domain names, comprising of approximately 2,000 trademarks and 500 domain names. The Complainant's trademarks are registered around the world, including by the USPTO, EUIPO, and as WIPO international trademarks (including coverage of Nigeria). The name ENI was registered as a European Trade Mark with registration number 009093683 in international classes 1, 2, 3, 4, 6, 7, 9, 11, 14, 16, 17, 18, 19, 22, 35, 36, 37, 39, 40, 41, and 42 on 27.4.2010. The Complainant further uses the domain name <ENI.com>, which is connected to the official website of the Complainant.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, ENI (Ente Nazionale Idrocarburi) was established in 1953. Formerly a public corporation, ENI has recently been converted into a joint stock company. In 2011, ENI was ranked 23rd by CNN Money.com in its list of “GLOBAL 500 of the world largest corporations” and was one of the top 10 listed oil companies. It has operations in 79 countries, including in Nigeria, where it has been present since 1962, and where it has extensive interests in onshore and offshore exploration and

production but also promotes other economic, educational and environmental projects.

The Respondent, ENI Geotechnics and Exploration Services Limited, is a company incorporated on under the laws of Nigeria and holds official accreditations to provide certain geotechnical and environmental solutions services to oil and gas companies in Nigeria. It was established on 15 April 2011. The Respondent is not connected with the Complainant. The Respondent is now the registrant of the disputed domain name <eniexploration.com>, which was registered on 25 May 2011. The disputed domain name is linked to the Respondent's active website, on which it presents and promotes its business and services.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant alleges that the Respondent is linked to another company, Clairgold Oil and Gas Engineering Ltd ("Clairgold"), with which it shares its address and telephone number. The Respondent's website acknowledges that: "ENI emerged from Clairgold oil and gas engineering [sic] Ltd a major player in the oil and gas industry". The Complainant believes that Clairgold is the de facto owner of the disputed domain name, and that it created the Respondent as a shadow company, whose name corresponds to the well-known brand name ENI owned by the Complainant, in order to hide its real identity. The Complainant's case is that there is an overlap between the Respondent's and the Complainant's activities because the Complainant carries out exploration activities in Nigeria; and that Clairgold set up the website linked to the disputed domain name in order to misleadingly divert consumers and take advantage of the reputation and long-standing tradition of the ENI trademarks.

Furthermore, the Complainant states that Clairgold previously attempted in 2015 and 2016 to register the trademark ENI in class 04 and class 16 in Nigeria in its own name but failed to succeed with its applications after the Complainant commenced opposition proceedings. Nevertheless, the Respondent still uses the trade mark ENI on the website accessed through the disputed domain name.

With regard to confusing similarity, the Complainant argues that the disputed domain name <eniexploration.com> is confusingly similar to, and completely includes, the Complainant's protected trademark ENI. The addition of generic descriptive terms, such as "exploration", is insufficient in the Complainant's view to avoid a finding of confusing similarity, in particular, because exploration is one of the sectors in which the Complainant is active in Nigeria. The Complainant refers to WIPO case law in support of the proposition that the distinctive trademark ENI forms the dominant or principal component of the disputed domain name. The Complainant further asserts that the trade mark ENI is well-known both internationally and in Nigeria.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no registered trademark rights in the word ENI and, indeed, failed in its attempts to register that name as a trademark in Nigeria. Given the overlap in the activities of the Respondent and the Complainant, the use of the disputed domain name by the Respondent will mislead consumers who may erroneously believe that the Respondent is affiliated with the Complainant when this is not in fact the case. The Respondent's use of the disputed domain name also cannot be construed as constituting legitimate fair use in circumstances where it wrongly suggests an association with the trademark owner for commercial gain. The Complainant believes that the Respondent has set up the website accessed through the disputed domain name in order misleadingly to divert consumers and to take unfair advantage of the reputation and long-standing history of the ENI trademark in the geotechnics and exploration sector.

Furthermore, the Respondent has not been licensed or otherwise authorised to use any of the Complainant’s trade marks, or to apply for or use any domain name incorporating such trade marks.

Finally, with regard to bad faith, the Complainant asserts that the Respondent must not only have necessarily been aware of the Complainant's business and well-known trademarks but refers to the subsequent attempts by Clairgold to register the

name ENI as a trademark in Nigeria as further evidence of the Respondent's attempts to exploit the Complainant's reputation in bad faith. The Complainant alleges that the Respondent intentionally sought to use the Complainant's trademark as part of the disputed domain name in order to attract internet users to its website for commercial gain by creating confusion as to the existence of an affiliation or relationship between the parties.

Finally, the Complainant points to the fact that, in response to a warning letter sent by the Complainant in May 2018, the Respondent offered to sell the disputed domain name to the Respondent for a very substantial sum of money.

RESPONDENT:

The Respondent asks the Panel in limine to reject the complaint on procedural grounds, namely, on the grounds that it discloses no cause of action against the Respondent of record. The Respondent points to the fact that much of the complaint is concerned with allegations as to the conduct and actions of Clairgold, which the Complainant alleges to be the true owner of the disputed domain name, but which is not a party to these administrative proceedings. The acts complained of by the Complainant are not the acts of the Respondent but those of Clairgold. It is not sufficient for the complaint to succeed that there is simply a connection between the Respondent and Clairgold if they are two separate legal entities. Indeed, the Respondent regards the amended complaint and supporting evidence as being "frivolous and vexatious".

As to the substance of the Complainant's case, the Respondent states that the disputed domain name and the associated website have been used consistently since 2011 in connection with the bona fide offering of services by the Respondent. The Respondent is duly incorporated under the laws of Nigeria, has over the years established itself as a leader in the provision of services to the oil and gas industry in Nigeria, and counts an array of blue chip companies amongst its clientele. The Respondent refers to a list of projects executed for major clients in support of these submissions.

The Respondent further states that it has in its years of existence developed a well established business and has built enormous goodwill in the Nigerian oil service sector. The Respondent has also scrupulously maintained regulatory compliance with industry regulators and has obtained all necessary approvals, permits, licences and accreditations required for the lawful operation of its business.

The Respondent concludes from these facts that it has demonstrated rights or legitimate interests in the disputed domain name as linked to the website of a bona fide business.

The Respondent further asserts that it has been widely and commonly known by, and has acquired unsurpassed reputation and goodwill in, the disputed domain name. The disputed domain name is therefore associated by the public exclusively with the Respondent. The Respondent has been developing consumer recognition and goodwill in its domain name for a period of more than 8 years, during which the Complainant did nothing to stop the Respondent. The Complainant should therefore be barred by laches, acquiescence and estoppel from disputing the domain name now.

As to bad faith, the Respondent denies that there is any likelihood of confusion, mistake, or deception because the disputed domain name and the Complainant's trademarks are not confusingly similar. The Complainant has not shown any trademark registration with which the disputed domain name is either identical or confusingly similar. The prefix "Eni" in the Respondent's company name and the disputed domain name is an abbreviated form of the family name of the founder of the Respondent, Mr Asek Enilama, who used a short version of his family name in good faith. The Respondent further states that the pre-fix "Eni" is widely and commonly used in Nigeria, as it corresponds to the names of individuals, families and communities. The Respondent then refers in its submissions to a list of third party businesses using "Eni" formative company names. According to the respondent, the font of the name ENI and logo displayed on the Respondent's website further distinguish the Respondent's use of the name ENI from the Complainant's trademarks.

With regard to the attempts by Clairegold to register the name ENI as a trademark in Nigeria, the Respondent states that the opposition proceedings are ongoing and that it is in fact the Complainant, who abandoned its opposition to these applications. Also, in response to the Complainant's warning letter, the Respondent initially asserted its rights in the disputed domain name before making an offer to sell the domain name as part of settlement negotiations initiated by the

Complainant. It is therefore incorrect of the Complainant to assert that the Respondent acquired the domain name for the purpose of selling it to the Complainant.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1 Procedural Matters

These administrative proceedings have given rise to a number of complex procedural issues, in respect of which the Panel gave procedural directions and made procedural orders in the course of the proceedings with the overall objectives, first, of providing both parties with a fair opportunity to present their cases; and, secondly, of arriving at a substantive decision on the real issues between the correct parties to the dispute rather than simply to dispose of these proceedings on formal or procedural grounds. For the purposes of this decision, the Panel summarises key aspects of these procedural issues that have arisen in these proceedings as follows.

The proceedings were commenced originally identifying the Complainant's authorised representative, rather than the Complainant itself, as the Complainant. Furthermore, the Respondent was initially Mr Oluwaseye Taiwo, who was then the registrant of record of the disputed domain name. Mr Taiwo, having been notified by the Case Administrator of the proceedings, and having received a reminder notice via the online platform, initially failed to submit a response within the applicable time period. Accordingly, the Case Administrator filed a notification of Respondent's default. Following the appointment of the Panellist, Mr Taiwo belatedly filed a non-standard communication, seeking to explain that he had only then received notice of the administrative proceedings and was proposing to file a response within 20 days. The Complainant having subsequently objected to a delayed response, Mr Taiwo then formally applied for an extension of time. Following an indication from the case Administrator to that effect, Mr Taiwo submitted his delayed response by way of non-standard communication without awaiting any further directions from the Panel.

A number of further 'tit-for-tat' exchanges then followed between the parties by way of non-standard communication. Against this background, on 1 August 2019, the Panel directed inter alia (i) the Complainant to submit full details of the correct Complainant so as to enable the Case Administrator to amend the case record accordingly; (ii) without having to decide whether it was the Respondent's responsibility to monitor e-mails received by him, but noting that paragraph 10(b) of the UDRP Rules requires the Panel to ensure that each party is given a fair opportunity to present its case, admitted the Respondent's non-standard communications dated 26 and 27 July to stand in lieu of a response; (iii) reminded the parties that the mechanism of non-standard communications was not intended as a tool for further argument or submissions that were not provided for by the UDRP Rules or invited by the Panel. Accordingly, the name and address of the Complainant were subsequently changed to the present Complainant. However, the Panel must take the opportunity (in line with the decisions of numerous panels in other UDRP proceedings) again expressly to discourage the practice of parties to make unsolicited submissions outside of the complaint and response in administrative proceedings where such submissions are neither

envisaged by the UDRP Rules nor invited by the Panel.

On 16 August 2019, the Panel gave further procedural directions seeking to establish the correct Respondent to these proceedings on the grounds that the Complainant in its complaint appeared to make a case against ENI Geotechnics and Exploration Services Ltd, but not against Mr Taiwo, who was then the registrant of record; and mutatis mutandis the Respondent sought to demonstrate rights and a legitimate interest by reference to the position and activities of ENI Geotechnics and Exploration Services Ltd but not on his own behalf. The Panel's directions prompted the Respondent to file a further unsolicited non-standard communication, accompanied by an affidavit, in which he stated that the holder of the disputed domain name, and the owner of the website to which it linked, was in fact ENI Geotechnics and Exploration Services Ltd, that the disputed domain name had been transferred into Mr Taiwo's name when the IT matters of that company were outsourced to him, and that it had always been intended that the original status was going to be restored.

A Whois search conducted by the Panel on 21 August disclosed that the identity of the registrant of the disputed domain name had at that point been changed from Mr Taiwo to ENI Geotechnics and Exploration Services Ltd in apparent breach of paragraph 8(a)(i) of the UDRP Policy, which clearly states that the registrant must not transfer the domain name registration to another holder during a pending administrative proceeding. It is and remains unclear to the Panel how and why the Respondent was able to change the registrant details of the disputed domain name in circumstances where the latter was meant to be under registrar lock-down, but clearly the applicable procedures and practices where not sufficiently robust to prevent a transfer of the disputed domain name in the course of these proceedings.

Against this background, the Panel observed In a further procedural order dated 21 August, that there was no evidence before the Panel that (i) the change of registrant was authorised by ENI Geotechnics and Exploration Services Ltd; or (ii) the Respondent was authorised to represent that entity or to make submissions on its behalf in these proceedings; or (iii) that ENI Geotechnics and Exploration Services Ltd wished to be substituted as the respondent in these proceedings.

On 22 August, the Respondent submitted a letter from ENI Geotechnics and Exploration Services Ltd confirming (i) that the company was at all material times the de facto owner of the disputed domain name and the website to which it links; (ii) that Mr Taiwo acted as its representative in these proceedings and that the company had directed Mr Taiwo to change the registrant details of the disputed domain name to itself; and (iii) that the company wished to be substituted for Mr Taiwo as the respondent in these proceedings in order to bring the proper parties before the Panel.

The Complainant's response to the change of registrant was to point out again that the true owner of the disputed domain name was in fact Clairgold and that ENI Geotechnics and Exploration Services Ltd had been set up as a shadow company for the purpose of misleading consumers. However the Complainant appeared to agree that Mr Taiwo was not the correct respondent in these administrative proceedings.

In the circumstances of this case, the Panel construed the change of registrant details by the Respondent of record not as a case of cyberflight but rather as a belated and unilateral attempt by Mr Taiwo to reflect the position assumed in both parties' submissions as to who the correct parties to the dispute should be. On the invitation by the Panel, the Complainant indicated that it wished the Complaint to proceed against ENI Geotechnics and Exploration Services Ltd as the new registrant of the disputed domain name and the party against which its submissions had de facto been directed. At the request of the Complainant, the Case Administrator therefore proceeded to change the Respondent in these proceedings to be ENI Geotechnics and Exploration Services Ltd.

In consequence of the change of Respondent, and following further interchanges between the parties, the Panel gave the parties permission to file an amended Complaint and Response respectively on which the Panel's decision is based; the Panel was therefore not in the end required to consider which of the parties unsolicited communications should be admitted in these proceedings.

The Panel notes that the Complaint is based at least in part on, and the Complainant repeatedly refers in these proceedings to, the actions of Clairgold. The Panel therefore takes the opportunity to note that administrative proceedings pursuant to the UDRP Rules are not the appropriate instrument for resolving wider IP disputes between a Complainant and third parties

who are not the registrant of the disputed domain name and not therefore a proper party to administrative proceedings pursuant to the UDRP Policy and Rules. Rather, such administrative proceedings are concerned only with the specific question whether a Complainant has a claim for the transfer or cancellation of a disputed domain name against the registrant. Furthermore, while there is clearly a connection between Clairgold and ENI Geotechnics and Exploration Services Ltd, much of the Complainant's submissions as to Clairgold's role is unsupported by tangible evidence and appears extraneous to the questions which the Panel must determine.

Paragraph 15(a) of the UDRP Rules instructs the Panel on how it is to determine the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law it deems applicable".

Pursuant to paragraph 4(a) of the UDRP Policy, in order to succeed, a Complainant must prove that:
(i) the disputed domain name is identical or confusingly similar to a trademark in which the complainant has rights; and
(ii) the Respondent has no rights or legitimate interests in respect of the domain name; and
(iii) the domain name has been registered and is being used in bad faith.

2 The First Issue - Identical or Confusingly Similar

The Complainant has established that it has prior trademark rights in the mark ENI. The Panel accepts that the disputed domain name is identical or confusingly similar to the Complainant's trademark rights in the mark ENI. The Panel agrees with the Complainant's argument (i) that the disputed domain name completely includes the Complainant's trademark; and (ii) that the addition of the purely descriptive term "exploration" is insufficient to avoid a finding of confusing similarity, in particular, in circumstances where both the Complainant and the Respondent are active in the exploration business. This position is reflected in cases such as WIPO Cases No D2001-0110 <ansellcondoms.com>, D2006-1307 <ebaymoving.com>, and D2007-0768 <playboyturkey.com>.

The Panel therefore finds that the first requirement of paragraph 4(a) of the UDRP Policy is satisfied.

3 The Second Issue - Rights or Legitimate Interests

The now generally accepted position on the second issue is that the Complainant must make a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant points in this respect to the fact that the Respondent's Nigerian trademark application to register the mark ENI in its own name has so far been unsuccessful. The Panel notes in this regard that, while the parties appear to disagree about the status of the opposition proceedings in respect of the relevant applications, there is consensus between them that these opposition proceedings have not yet been formally concluded and that the Respondent's trademark application (or that of Clairgold) has not proceeded to registration.

Furthermore, the Respondent has no connection or affiliation with the Complainant and has not been licensed or otherwise authorised by the Respondent to use or apply for registration of a domain name incorporating the Complainant's trademark.

The Complainant having made a prima facie case, the Respondent may support its case establishing a right or legitimate interest in respect of the disputed domain name by demonstrating in accordance with paragraph 4(c) of the UDRP Policy that:
(i) before any notice of the dispute, the respondent used or made preparations to use the domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
(ii) the respondent is commonly known by the domain name even if he has not acquired any trademark rights; or
(iii) the respondent makes legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

The Respondent asserts that it has used the disputed domain name since 2011 to promote its services to the oil industry. The Panel does not however accept that the Respondent's offering is made bona fide, or in good faith, for the following

reasons. Both parties are active in the same industry and undertake exploration activities. The Respondent cannot demonstrate a good faith offering where its goods and services are not in a different class from those for which the Complainant's trade mark is protected, see WIPO Case No 2001-1021 <brucetrail.com>. It does not matter for these purposes that the Respondent had been using the disputed domain name for several years, see WIPO Case No D2013-0633 <iwebtechno.com> and D2009-0297 <unisap.com>. The overlap between the Complainant's and the Respondent's services, and the fact that the Complainant has been a major player in the oil industry in Nigeria since the 1960s, and is well-known in that field would otherwise strongly suggest an intent to exploit the Complainant's trademark for commercial gain.

There is no evidence before the Panel that the Respondent is commonly known by the disputed domain name. The Respondent's name is ENI Geotechnics and Exploration Services Ltd, and not ENI Exploration, and the documents submitted by the Respondent all indicate that it is being referred to by its full corporate name in commerce and for administrative purposes.

As to the third test for demonstrating rights or legitimate interests in the disputed domain name, the Panel does not accept that the Respondent makes fair use of the domain name without intent for commercial gain to misleadingly divert consumers. The Respondent clearly uses the website linked to the disputed domain name for commercial purposes. The fair use provision is intended to permit use of a third party's trade mark for purposes such as criticism, parody, or similar scenarios in limited circumstances. However, this is clearly not the type of use to which the Respondent is putting the disputed domain name and fair use would not cover use of a domain name that is confusingly similar to the Complainant's well-known protected trademark for commercial purposes and gives rise to a risk of confusion as to the origin of the Complainant's and the Respondent's services.

The Panel notes the Respondent's reliance on WIPO Case No D2018-1195 <avonhealthcare.com>, which it asserts is almost on all fours with the present case. The Panel disagrees with that view for a number of reasons, including that: (i) the respondent in that case was Avon Healthcare Limited and it was therefore actually known by the disputed domain name, whereas the disputed domain name in the present case does not reflect the Respondent's full company name; (ii) the term "Avon" was said by the panel in that case to be in wide use and to correspond to the name of several rivers, towns and communities, as well as businesses and brands which do not operate in the same field of activity of the Complainant whereas no such use could be demonstrated to the same extent in the present case; (iii) there was no direct overlap between the Complainant's and the Respondent's goods and services in that case, whereas there is such a direct overlap in the present case; and (iv) the Respondent in that case could make a credible argument that the letters AVON were the initials of the company founder's name.

The Panel therefore concludes that the Respondent does not have any rights or legitimate interests in the disputed domain name.

4 The Third Issue - Bad Faith

The final question which the Panel must answer is whether the domain name has been registered and is being used in bad faith. For the purposes of paragraph 4(a)(iii) of the UDRP Policy, the following circumstances set out in paragraph 4(b) of the UDRP Policy in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
(i) circumstances indicating that the respondent has registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
(ii) the Respondent 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; or
(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 his web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source,

sponsorship, affiliation, or endorsement of his web site or location or of a product or service on his web site or location.

The Panel finds that the principal reason why the Respondent chose the pre-fix ENI for its company name, namely, that this was an abbreviation of "Enilame", the family name of the company's founder, lacks credibility and is not supported by evidence. The Panel doubts that the Respondent would have used only half of its founder's surname in commerce or trade if this did not happen to coincide with the Complainant's well-known trademark, or that the name element ENI has established sufficient secondary meaning to distinguish it from the Complainant's well known trademark. It is not conceivable that the Respondent would not have been aware of the Complainant's trademark at the time of registration of the company and of the disputed domain name, given the Complainant's size, reputation and long-standing activities in the oil industry in Nigeria. The Panel follows cases such as WIPO Cases No D2000-0226 <christiandior.net> and D2000-1409 <sonyacademy.com> in finding that knowledge of Complainant's trademark and activities at the time of registration of the disputed domain name may be considered an inference of bad faith; it is inconceivable that the Respondent could make any active use of the disputed domain name without taking unfair advantage of the Complainant's trademark and creating a false impression of association with the Complainant. The Respondent asserts that it has built up goodwill in its company name and/or the disputed domain name but clearly no such goodwill can have existed at the time of registration, when the Respondent only started out in business. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark (particularly domain names incorporating the Complainant's trademark plus a descriptive term that corresponds to the Complainant's area of activity) by an unaffiliated entity can by itself create a presumption of bad faith.

In all the circumstances, the Panel therefore concludes that the Respondent registered and is using the domain name in bad faith within the meaning of paragraph 4(b)(iv) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ENIEXPLORATION.COM**: Transferred

PANELLISTS

Name	**Gregor Kleinknecht**

DATE OF PANEL DECISION 2020-01-03

Publish the Decision