Decision for dispute CAC-UDRP-102780

Case number	CAC-UDRP-102780
Time of filing	2021-03-17 10:55:54
Domain names	INFRAENISERVICESCORPORATION.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Eni S.p.A.

Complainant representative

Organization	De Simone & Partners Srl

Respondent

Name	DENNIS DILDAY

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 is the owner of a variety of registered trademarks for the word and figurative mark ENI including, for example:-

- United States Registered Trademark no. 4730039 for the stylized word mark ENI, registered on May 5, 2015 in international classes 1, 4, 6, 17, 36, 37, 39, 40 and 42;

- European Union Registered Trademark no. 9093683 for the word mark ENI, registered on April 27, 2010 in international classes 1, 2, 3, 4, 6, 7, 9, 11, 14, 16, 17, 18, 19, 22, 35, 36, 37, 39, 40, 41, 42, 43, 44 and 45; and

- European Union Registered Trademark no. 9428061 for the figurative mark ENI, featuring a black six-legged dog with red flame tongue superimposed on a yellow background above the stylized word “eni” in black, registered on February 21, 2011 in international classes 1, 4, 11, 19, 25, 35, 37, 39, 40, 41, 42 and 43.

FACTUAL BACKGROUND

Established in 1953, the Complainant is a worldwide energy group that is active in around 70 countries, including the major markets around the world, such as the United States of America and throughout the European Union. The Complainant has more than 40 controlled companies and hundreds of points of sale in the fuels and lubricants sector, and has a staff complement of 73,000 employees. In the media, the Complainant has been ranked as one of the world's largest corporations and a top ten oil company. The Complainant's ENI formative trademarks are extensively registered around the world in more than 100 countries with more than 1000 trademarks.

The Respondent is not known and lies behind a WhoIs proxy shield. The website associated with the disputed domain name resolves to an active page mimicking the official website of the Complainant and containing numerous references to ENI. Said site claims copyright protection in the name of Infra E.N.I. Services Corporation, which induces Internet users to believe that it is genuinely connected to or associated with the Complainant.

In assessing confusing similarity the top level suffix ".com" has to be disregarded. The addition of generic or descriptive terms such as "infra", "services" or "corporation" to a trademark in a domain name is insufficient to avoid a finding of confusing similarity. In UDRP cases, panels have usually found the distinctive part of the trademark to constitute the dominant or principal component of the domain name. It does not matter if the trademarks comprise figurative elements as these are generally incapable of representation in a domain name and are typically disregarded for the purpose of assessing identity or confusing similarity. The risk of confusion in this case is also increased by the fact that the Complainant's trademarks are well and widely known in the energy sector and the Respondent's domain name and related web site concerns the identical sector.

Panels have categorically held that the use of a domain name for illegal activity (including impersonation and passing off) can never confer rights or legitimate interests on a respondent. The Respondent's use of the disputed domain name is in no way a bona fide offering of goods and services and this only emphasizes the fact that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The Respondent has no registered trademark rights in the word ENI and there is no evidence at all that the Respondent is commonly known by the disputed domain name. On the contrary, the Respondent has set up a web site identical or very similar to the original one in order to take advantage of the reputation and longstanding history of the Complainant's trademarks. The Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks or any domain name incorporating such trademarks. In similar circumstances, panels have considered that no bona fide or legitimate use of a domain name could be claimed by the respondent.

The Respondent has created a web site on a parallel and connected domain name with a blatant imitation of the Complainant's web site which represents the Infraeniservices Corporation as a real associate or linked company to the Complainant in order to attract consumers and probably to take advantage of such wrongful representation. Said site constitutes the Respondent's preparation for such activities even if there is no evidence arising from its use.

When registering the disputed domain name, the Respondent was necessarily aware of the Complainant's well-known business and widespread reputation in its ENI trademarks. Such a maneuver would not have been generated if the Respondent did not know of the Complainant's activities. The Respondent has intentionally sought to use the Complainant's marks in the disputed domain name to attract Internet users to websites and other on-line locations for commercial gain by confusing consumers as to sponsorship of the website. This constitutes bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Following the Complainant's warning letter, said website was modified and became a parked site which refers to "Eni Gas e Luce" and to search indications connected to the energy sector.

The disputed domain name is so obviously connected with the Complainant's trademarks and its services that their very use by someone with no connection with the Complainant suggests "opportunistic bad faith". The relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the disputed domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. It is self-evident that the disputed domain name was registered and used in bad faith by the Respondent as owner of the copycat website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

The Panel accepts that the Complainant has demonstrated rights in its ENI registered trademark. This is fully recognizable within the disputed domain name, the second level of which may be split into the components “infra”, “eni”, “services” and “corporation”. The additional words are descriptive and non-distinctive, and they do nothing to distinguish the disputed domain name from the Complainant’s distinctive ENI mark. Disregarding the generic Top-Level Domain, in this case “.com”, for the purposes of the comparison exercise, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark. It should also be noted on this topic that the Respondent has built a website which incorporates the Complainant’s figurative trademark and makes frequent references to the Complainant’s ENI mark, thus effectively impersonating the Complainant. This further fortifies the Panel in its finding of confusing similarity as it is clear that the Respondent intentionally set out to create a confusingly similar domain name for use with the associated website, which is designed to impersonate the Complainant.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Complainant asserts that the Respondent is using the disputed domain name to impersonate it and that such impersonation cannot confer rights or legitimate interests upon the Respondent. The Complainant also submits that the Respondent’s use of the disputed domain name is in no way a bona fide offering of goods and services, nor is it a legitimate noncommercial or fair use of the disputed domain name. The Complainant contends that the Respondent has no registered trademark rights in the word ENI and that there is no evidence at all that the Respondent is commonly known by the disputed domain name. Furthermore, the Complainant notes that the Respondent has not been licensed or otherwise authorized to use any of the Complainant’s trademarks or any domain name incorporating such trademarks.

The Respondent has failed to reply to the Complainant’s contentions in this case. The Complainant notes that the Respondent also did not reply to the Complainant’s cease and desist notice. Consequently, the Respondent has failed to bring forth any alleged rights or legitimate interests which it might have asserted in the disputed domain name and there are no submissions or evidence on the present record which might act to rebut the prima facie case which the Complainant has established. In all of these circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant provides evidence that prior to the service of its cease and desist letter, the website associated with the disputed domain name was being used for an entity allegedly named Infra E.N.I. Services Corporation. Said website reproduced the Complainant’s distinctive figurative mark and made numerous references to the Complainant’s ENI mark. It is abundantly

clear to the Panel that the Respondent knew of the Complainant's rights when it registered the disputed domain name and had intent to target these by way of the website which impersonates the Complainant (and/or potentially suggests that it is operated by one of the Complainant's group companies). In these circumstances, the Panel considers that the Complainant has established registration and use in bad faith in terms of paragraph 4(b)(iv) of the Policy, in that the Respondent has used the Complainant's marks in the disputed domain name to attract Internet users to its website for commercial gain by confusing consumers as to sponsorship of the website. The fact that the use of the website might have changed upon the Respondent's receipt of the cease and desist letter does not alter the finding as to the Respondent's abusive intent, nor does it cure the Respondent's bad faith use of the disputed domain name. The Panel is informed that the replacement website was a parking page which targeted the Complainant's line of business, although no screenshot was provided of this and the Panel makes no reliance upon that matter in terms of its findings.

As there is no Response from the Respondent, the Panel notes that it has failed to take the opportunity to contest the Complainant's allegations of bad faith registration and use. There is no apparent explanation for the registration and use of the disputed domain name on the present record which might be suggestive of any good faith motivation on the Respondent's part.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **INFRAENISERVICESCORPORATION.COM**: Transferred

PANELLISTS

Name	**Andrew Lothian**

DATE OF PANEL DECISION 2021-04-15

Publish the Decision