

Decision for dispute CAC-UDRP-103643

Case number CAC-UDRP-103643

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Domain names ENIPOINT.COM

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization ENI S.p.A.

Complainant representative

Organization De Simone & Partners Srl

Respondent

Organization BALKAN EUROPE BUSINESS SpA

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 various trade mark registrations worldwide for its ENI trade mark including in particular EUTM 009093683 for ENI registered on 27 April 2010.

The disputed domain name was registered on 11 November 2020.

FACTUAL BACKGROUND

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

The Complainant is a global energy group based in Italy. It is active in the major markets around the world including in the USA and throughout the European Community with more than 40 controlled companies and hundreds of points of sale in the fuels and lubricants sector. It operates in around 70 countries with a staff of approximately 73.000 employees.

The Respondent, based in Bulgaria, also operates in the energy sector and according to the Complainant has had prior commercial dealings with it. The disputed domain name was registered on 11 November 2020 and prior to the Complainant sending a cease and desist letter in February 2021, the disputed domain name <www.enipoint.com> resolved to a site that

the Respondent says is identical or very similar to its own main website and the version of the disputed domain name that is <ENIPOINT.COM> resolves to a Go Daddy parking page on which one of the Complainant's group companies is listed at a pay per click link together with other pay per click links to competing companies in the energy sector.

The Respondent

On the contrary the real Respondent seems to be, from Complainant's previous investigations, a Bulgarian Company called Balkan Energy Business that is already known to the Complainant having had previous commercial contact with Eni Spa. In fact, the Complainant came across the web site connected to the disputed domain name and from the investigation the Bulgarian company seems to be the real proprietor of the disputed domain name.

On February 17, 2021 the Complainant sent a warning letter in order to request the immediate assignment free of cost of the disputed domain name but no reply was ever received from the "real" Registrant or from the Proxy's email address.

There are two web sites related to the disputed domain name: one is related to the address www.enipoint.com that opens on a site that is identical or very similar to that one of Eni (see the two site in comparison, the second is related to <ENIPOINT.COM> and opens up to a web parking page in which Eni gas e Luce (Eni's controlled Company) is cited together with all other search suggested keys all related to the energy sector.

LEGAL ARGUMENTS

1. Confusingly similarity

In assessing confusingly similarity the top-level suffix .com has to be disregarded.

As stated in many WIPO decisions "The addition of the gTLDs ".biz", ".info" and ".org" is not of legal significance from the standpoint of comparing the disputed domain names to the trademark. Such use is required of domain name registrants and do not serve to identify a specific enterprise as a source of goods or services" WIPO Case No. D2001-0602, SBC Communications v. Fred BellakaBellInternet.

Furthermore, also the addition of generic descriptive terms to a trademark in a domain name such as POINT, is insufficient to avoid a finding of confusing similarities. In many WIPO cases panels have usually found the distinctive part of the trademark to constitute the dominant or principal component of the domain name. See WIPO cases D2001-0110 on <ansellcondoms.com>; D2005-0587 on <naturelle.com>; D2006-1307 on <ebaymoving.com>; D2007-0768 on <playboyturkey.com ..

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Therefore, the comparison has to be made between ENI POINT on one side and ENI and all the other trademarks of the relevant trademark families of ENI.

It does not matter if the trademarks comprised figurative elements. "Figurative elements are generally be incapable of representation in a domain name and therefore such elements are typically disregarded for the purpose of assessing identity of confusing similarity" WIPO outlook 2011. See WIPO cases on this point such as D2001-0031 on <sweeps.com> D2003-0645 on <britishmeat.com>, D2008-1637 on <whichar.com>; D2010-0509 on <islamicbank.com>.

Finally, the risk of confusion in the case at issue is also increased by the fact that the Complainant's trademarks are well and widely known in the motor racing sector and the Respondent's domain names and related web site concern motor sport events.

2. The Respondent has no rights or legitimate interests in respect of the domain name (Policy, Paragraph 4 (a) (ii); Rules, Paragraph 3 (b) (ix) (2)).

The Complainant claims that the Respondent has no right or legitimate interests in respect of the disputed domain name.

As WIPO summarized its case law on this point as follows "Preliminarily, although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the Respondent."

Thus, the consensus view is that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the disputed domain name, once the Complainant has made a prima facie showing indicating the absence of such rights or interests WIPO Case No. D2000-0270, Document Technologies, Inc. v. International Electronic Communications Inc. Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455, <croatiaairlines.com>.

Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods replicas or reproduction of sites, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

Previous UDRP panels have held that Respondent's use of a domain name, which incorporates a third party's trademark in connection with an Internet web site that merely lists links to third party web sites is not a bona fide offering of services and is not a legitimate non-commercial or fair use of the disputed domain name WIPO Case No. D2007-1499, E.J. McKernan Co. v. Texas International Property Associates, WIPO Case No. D2010-1437, Lardi Ltd v. Belize Domain WHOIS Service Lt Inc, WIPO Case No. D2007-1415, Asian World of Martial Arts Inc. v. Texas International Property Associates.

Respondent's use of the domain is in no way a bona fide offering of goods and services and this only emphasizes the fact that Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. The Respondent has no registered trademark rights in the words ENI or and there is no evidence at all that the Respondent is commonly known by the disputed domain name. On the contrary, as herein already mentioned, The Respondent has set up two web sites that take advantage of the reputation and long standing history of the two trademarks of ENI also with regard to motor races. The Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks or to apply for or use any domain name incorporating such trademarks. In similar circumstances, panels considered that no bona fide or legitimate use of the disputed domain name could be claimed by the Respondent WIPO Case D2000-0055, Guerlain SA v. Peikang, WIPO Case D2008-0488, BHP Billiton Innovation Pty Ltd. v. OS Domain Holdings IV LLC, WIPO Case D2009-0258, Mpire Corporation v. Michael Frey.

3. The domain name has been registered and is being used in bad faith (Policy, paragraphs 4 (a) (iii), 4(b); Rules, paragraph 3 (b) (ix) (3)).

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

Panels have always held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, the respondent may host a copycat version of the complainant's website.)

In the case at issue the Respondent's has created a web site on a parallel and connected domain name similar a copy of ENI's web site and represent itself or herself as the real associate or linked company to Eni (as it was indicated in the web pages that after our warning letter were cancelled). This in order to attract consumers and probably to take advantage from this undue representation. At least is a good preparation of these activities even if we did not have any evidence that that happened. In this case bad faith is even more blatant by the fact that ENIPOINT.COM opens to a web parking while WWW.ENIPOINT.COM reproduces a replica of Eni web site. Two level both of them based on the more or less blatant infringement of the Eni trademarks.

As to bad faith registration, when registering the disputed domain name, the Respondent was necessary aware of the Complainant's well-known business and widespread reputation in its ENI trademarks.

Clearly, such maneuver would not have been generated if the Respondent did not know the Complainant's activities (WIPO Case D2010-1290, Meilleurtaux v. Domain Manager of Bondi Junction).

In the case at hand the Respondent has intentionally sought to use 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. (WIPO Case No. D2000-1495, America Online, Inc. v. John Zuccarini, also known as Cupcake Message, Cupcake Messenger, The Cupcake Secret, Cupcake Patrol, Cupcake City, and The Cupcake Incident). Even after Complainant's warning letter the web parking resulted from this modifications still refers to Eni Gas e Luce and to search indications connected to the Energy sector.

The 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" (WIPO Case No. D2000-0226, Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net - Annex 36, WIPO Case No. D2000-0163, Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., net, WIPO Case No. D2001-0781, Fortuneo v. Johann Guinebert).

Web parking is an indication also of bad faith considering the above circumstances. Some panels have also found that the concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" by a third party of a domain name (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals). Complainant refers to relevant decisions:

- Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Transfer;
 - Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com> inter alia, Transfer;
 - Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com> inter alia, Transfer;
 - Westdev Limited v. Private Data, WIPO Case No. D2007-1903, <numberone.com>, Transfer;
 - Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO Case No. D2008-1393, <maybank.com>, Transfer;
- and
- Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273, <pentiumgroup.net>, Transfer.

Several UDRP panels have ruled on this issue, and it has been widely accepted that “the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith” (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; see also Polaroid Corporation v. Jay Strommen, WIPO Case No. D2005-1005, Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO Case No. 2008-1393). See also Case 2016-1073. However, we have proved beyond any reasonable doubt that the Register and Respondent have been using the disputed domain name in bad faith and disloyal attitude.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

RESPONDENT:

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 Complainant has demonstrated that it owns registered trade mark rights in the ENI mark, in particular EUTM 009093683 for ENI registered on 27 April 2010. The disputed domain name wholly incorporates the Complainant's ENI mark and is therefore confusingly similar to it. The fact that the disputed domain name also incorporates the common English word "point" does not prevent a finding of confusing similarity with the Complainant's registered trade mark. Accordingly, the Complainant succeeds under paragraph 4(a)(i) of the Policy.

The Complainant has submitted that the Respondent is in no way using the disputed domain name to make a bona fide offering of goods and services. It says that the Respondent has no registered trade mark rights in the words ENI or and there is no evidence at all that the Respondent is commonly known by the disputed domain name. It asserts that the two websites

to which the disputed domain name resolves take advantage of the Complainant's reputation and long standing history. It has also submitted that it has not licensed or authorised to use the ENI mark and that none of this amounts to a bona fide offering of goods or services at the disputed domain name

The Complainant has asserted that the disputed domain name has previously resolved to two websites and has provided evidence of each of these websites. One appears to be the website to which the disputed domain name currently resolves which appears to advertise light and gas services. Although the Complainant asserts that this website is identical or similar to its own website, the Panel does not agree with this analysis as the similarities seem limited and there is no apparent use of the Complainant's branding on the website at the disputed domain name.

However, this does not detract from the fact that the Complainant's ENI mark and its energy business are undoubtedly very well reputed and the use of its mark in the disputed domain name to lead Internet users to a website offering another energy sector player's products is undoubtedly not bona fide or legitimate conduct. In addition, the Complainant has provided evidence that the disputed domain name previously resolved to a GO Daddy parking page that featured a pay per click link to the Complainant and to certain competitors together with a message that the disputed domain name may be for sale through GO Daddy as well as featuring pay per click links to companies in the energy sector. This also is not consistent with bona fide or legitimate conduct and is neither a legitimate non-commercial use, nor a fair use of the disputed domain name. The Panel therefore finds that Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name which case has not been rebutted by the Respondent. As a result, the Complaint also succeeds under paragraph 4(a)(ii) of the Policy.

The disputed domain name was registered in November 2020, a decade after the Complainant registered its EUTM 009093683 for ENI on 27 April, 2010. Considering the very significant degree of renown attaching to the Complainant's ENI mark and business in Italy and elsewhere and that the website to which the disputed domain name resolves appears to be advertising energy products similar to those provided by the Complainant and also considering that the Respondent is based in Bulgaria which is also in the EU and that the Complainant says that it had prior commercial dealings with the Respondent, it seems most likely that the Respondent was well aware of the Complainant's mark and business when it registered the disputed domain name in late 2020.

Under paragraph 4(b)(iv) of the Policy the use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 a web site or location or of a product or service on the web site amounts to evidence of registration and use in bad faith. It is clear that in this case that the Respondent has used the disputed domain name to confuse Internet users looking for the Complainant to be diverted to the Respondent's website which advertises its own energy products. In the alternative, the disputed domain name at one time was diverted to a GO Daddy site that appears to have featured pay-per-click links to competitors of the Complainant which also amounts to conduct falling under paragraph 4(b)(iv) of the Policy.

That the Respondent permitted Go Daddy to advertise the disputed domain name as possibly being for sale and also the fact that the Respondent failed to respond to the Complainant's cease and desist letter further, reinforce the Panel's view of the Respondent's registration and use of the disputed domain name in bad faith. Accordingly, the Panel finds that the Complaint also succeeds under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. ENIPOINT.COM: Transferred

PANELLISTS

Name	Alistair Payne
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DATE OF PANEL DECISION 2021-04-15

Publish the Decision
