Decision for dispute CAC-UDRP-108774

Case number	CAC-UDRP-108774
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Domain names	enicafe.com

Case administrator

Name	Olga Dvořáková (Case admin)

Complainant

Organization	Eni S.p.A.

Complainant representative

Organization	DE SIMONE & PARTNERS

Respondent

Organization	Mauro Merciari e Fabbri Carolina e C.

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 filed on December 5, 2007, registered on April 27, 2010 and duly renewed for goods and services included in 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.

FACTUAL BACKGROUND

Eni S.p.A., established in 1953 as a public economic entity on the initiative of the Italian State and under the leadership of Enrico Mattei, who served as its chairman until 1962, was subsequently transformed into a joint-stock company in 1992.
The company is now one of the leading multinational groups operating in the global energy sector. Eni currently operates in over 60 countries and, as of 2025, employs more than 32,000 people. The Group is universally recognized by its well-known “six-legged dog” logo, an iconic symbol with a high level of market recognition.
The Group’s activities span the entire energy value chain and include the oil and natural gas sectors, the chemical and biochemical sectors, as well as the generation and sale of electricity, both from fossil fuels and from cogeneration and renewable sources.
From an economic and industrial perspective, Eni has long been Italy’s leading company by turnover, particularly during the period 2003–2013, as well as in 2018 and again in the three-year period 2023–2025, confirming its position of absolute prominence at both the national and international level.

The Respondent is a company engaged in the retail sale of fuels and lubricants since 1973. Said company entered into a business relationship with the Complainant. Said relationship is regulated by:
(i) a Business Lease Agreement dated November 7, 2005, under which the Complainant granted the Respondent the lease of the business unit consisting of the café and bar premises located within a service station situated in San Giuseppe (Ferrara) - Italy.
(ii) a Loan for Use Agreement dated December 30, 2009, under which the Complainant granted the Respondent the use of the assets comprising the fuel distribution station for a period of six years. The agreement was subsequently renewed until 2021 and, most recently, until December 29, 2027.
(iii) a Business Lease Agreement for roadside service areas with commercial affiliation dated May 13, 2016, under which the Complainant renewed, for a further six-year term, the lease of the business unit forming part of the ENI Café & Shop system. The leased business included the operation of a café, the sale of food and beverages, and a retail market offering regional food products under a franchising system forming part of ENI's nationwide network of service station outlets.

On November 4, 2017, the Respondent registered the disputed domain name <enicafe.com>.

PARTIES CONTENTIONS

COMPLAINANT:
The Complainant submits sufficient evidence in order to prove its trademark rights on the term ENI.

Furthermore, the Complainant contends, in relevant part, as follows:

- The disputed domain name <enicafe.com> is confusingly similar to the Complainant trademarks as the trademark ENI is identically reproduced and the addition of the generic term CAFE is not sufficient to avoid the likelihood of confusion.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name <enicafe.com> because:
(i) the Respondent does not own any trademark corresponding to the sign ENI or ENICAFE, nor is it commonly known by those names;
(ii) neither license nor authorization has been granted to the Respondent to make any use of the Complainant trademarks or apply for registration of the disputed domain name by the Complainant; on the contrary, the contractual relationship between the parties clearly indicates that the license of use in that contractual relationship cannot be intended as a transfer of rights or as the grant of an independent licence to use the trademarks.

- The disputed domain name has been registered and used in bad faith because the Respondent registered the disputed domain name with actual knowledge of the Complainant´s trademark, which enjoys an extremely high reputation, as it is a well-known trademark, and since the Respondent demanded the exorbitant amount of EUR 10 million for the transfer of the disputed domain name.

RESPONDENT:
The Respondent contends, in relevant part, as follows:

- The disputed domain name <enicafe.com> was never registered in order to appropriate the ENI trademark, nor to resell it, mislead Internet users, host competing advertising, or divert customers. On the contrary, the domain name was created and has always been used solely and exclusively to promote a genuine ENI service station, namely the one operated by the Respondent.

- The disputed domain name <enicafe.com> was registered since the service station operated by the Respondent was difficult to identify because, due to ENI's negligence and prolonged inaction, there was no adequately visible "ENI Café" sign, neither on the fuel station canopy nor on the café itself. The sole purpose of said registration was to enable motorists to find the service station through Google, and certainly not to speculate on the sale of the domain names or, even less, to prevent ENI from using its own trademarks or distinctive signs, particularly the ENICAFÉ trademark, which the Complainant itself has not registered until 2025.

- Contrary to the Complainant’s view concerning the Respondent's alleged lack of any right to use the trademarks of the Complainant, the Complainant itself, refers to the Franchise Agreements (reproduced in the Business Lease Agreement), which specifically regulate the use of ENI's distinctive signs and expressly provide that the franchisor grants the franchisee a limited and non-exclusive right to use those signs strictly for the purposes of performing the contractual relationship.

- According to the Respondent, the trademark is not used to obtain an unfair advantage from any likelihood of association between different undertakings, since a genuine commercial relationship already exists between the trademark owner and the holder of the domain name incorporating that trademark.

- In addition, in the Respondent's view it does not prejudice the value of the trademark or unfairly exploit its distinctive character or reputation, particularly considering that the right to use the trademark was granted free of charge under the loan-for-use agreement and the business lease agreements executed within the franchising relationship.

- The Respondent notes that the disputed domain name does not discredit or tarnish the ENI trademark. On the contrary, the ENICAFÉ Service Station in San Giuseppe di Comacchio recently received an official recognition from the Mayor of Comacchio for its business activity, as demonstrated by the publicly available award ceremony video.

- The Respondent also insists that there was never any attempt to negotiate. The valuation report, in itself, does not demonstrate that the domain name was registered in 2017 for speculative purposes. It merely represents a subsequent economic assessment. A valuation prepared years after registration cannot retroactively transform a lawful registration into one made in bad faith.

- Finally, the Respondent outlines that the Complainant was fully aware of the existence of the disputed domain name from the very beginning since, during March 2018, immediately after the website had been completed, the Respondent sent the website link connected with the domain name in dispute, directly to ENI's area manager.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(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.

1) The Complainant has demonstrated its rights in its registered trademark ENI. The Complainant has also registered numerous domain names including ENI. The disputed domain name <enicafe.com> incorporates the Complainant's very well-known trademark in its entirety and adds the term CAFE. Concerning the addition of the term "cafe", the Panel agrees with the Complainant that the use of its marks with a generic word does not reduce confusing similarity. In the present case the word CAFE in the disputed domain name, along with ENI, appears to be intentionally chosen and used by the Respondent to create a likelihood of confusion with the Complainant´s trademarks and business. Given the fame of the Complainant’s mark, the Panel finds the addition of the word CAFE does not distinguish the Respondent’s disputed domain name from the Complainant´s marks. Rather, the generic term CAFE increases the risk of confusion as it is associated with the Complainant’s services. Panels, in previous cases have held that the word CAFE does not by itself distinguish the disputed domain name in dispute from the Complainant’s mark (See for instance, Luigi Lavazza S.p.A. v. wang ying bao, WIPO Case No. D2025-3407). Finally, in accordance with the consensus view of past UDRP panels, the Panel finds that the Top-Level domain (".COM" in this case) is not sufficient to exclude the likelihood of confusion since it is a mere technical requirement included in all domain names. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name <enicafe.com> and that the Respondent is not linked to the Complainant by any corporate relationship. According to the Respondent, it has rights and/or legitimate interests since the Respondent itself has operated the ENI service station located on State Road No. 309 Romea, in the Municipality of Comacchio, for more than fifty-three years. The Respondent is therefore neither a stranger to the ENI network, nor a competitor, nor an abusive operator seeking to exploit ENI's reputation. Rather, the Respondent is a long-standing service station operator and a loyal member of ENI's official distribution network. Therefore, the Respondent

considers that its legitimate interest in the disputed domain name stems from its previous contractual relationship with the Complainant. In consideration of the above, the Panel has carefully considered the agreements signed by the parties and verified:

A) point 34.1 of Loan for Use Agreement dated December 30, 2009, according to which "The Borrower acknowledges Eni's exclusive ownership of all rights relating to the use of Eni's trademarks. The Borrower is expressly prohibited from:
(i) incorporating the trademarks, or any part thereof, into its own trademarks, logos or designs; (ii) applying for the registration of domain names containing the trademarks".

B) point 28.4 of Business Lease Agreement for roadside service areas with commercial affiliation dated May 13, 2016, according to which "The Franchisee further undertakes: a) not to incorporate the Trademarks, or any part thereof, into its own trademarks or distinctive signs; b) not to apply for the registration of trademarks, distinctive signs or domain names identical or similar to, or containing, the Trademarks".

Now, the registration of the domain name in dispute is the result of gross breaches of contract to the detriment of the Complainant. The Panel is of the opinion that the Respondent cannot be recognized as having any rights or legitimate interests in a domain name registered in breach of contractual provisions which lay down a very clear prohibition in this regard. The Complainant therefore succeeds on the second element of the Policy.

3) The Panel’s view is that there is a high likelihood that the domain name was not only registered in bad faith but was also used in bad faith. Bad faith registration may be easily ascertained in the case at hand since it can always be found where a respondent “knew or should have known” of a complainant’s trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest (See Accor v. Kristen Hoerl, WIPO Case No. D2007-1722). As detailed above, the Respondent registered the domain name <enicafe.com> which is confusingly similar to the Complainant´s distinctive and very well-known mark being fully aware of the contractual prohibitions discussed in the previous paragraph. The Respondent denies all allegations of registration in bad faith in light of information allegedly provided in this regard to a representative of the Complainant during March 2018, immediately after the website had been completed. In consideration of the above, the Panel has carefully considered the communication dated March 25, 2018, and verified that:

A) the communication was sent by a simple email rather than via a certified email

B) the content of the communication is "http://www.enicafe.com/. The website is finished. Good night...P.S. Everyone here wants cappuccino!"

In the Panel's view this is not a request for an authorization to use the domain name in dispute, but a general communication bound to be completely ignored that has no legal validity whatsoever, either in form or in content.

Coming to the issue of the use of bad faith, the facts and documents submitted by the parties demonstrate that, over time, the domain name has been used in various ways.

It has been established that the domain name in dispute has been used to publicize the Respondent’s business. The Panel wishes to draw attention to the fact that such conduct appears to be far from lawful in light of a breach of contractual provisions (typical of franchising) designed to ensure that the trademark proprietor (the Complainant) has full freedom of choice and selection regarding the content to be included in domain names incorporating the trademark itself.

Furthermore, it transpired that the domain name had remained unused for a considerable period of time. In this perspective the Panel notes that, when the disputed domain name holds no Internet content, customers searching for information on the Complainant and the Complainant’s service may come to the conclusion that there are problems at the Complainant’s site, that the Complainant’s web information and services are no longer in active use. Such ‘non-use’ by the Respondent can have the same negative result on the Complainant as active use of a disputed domain name, and amounts to bad faith use” (FIL Limited v. George Dyle, WIPO Case No. D2014-1418).

Finally, and this aspect is extremely serious and crucial in determining whether there is bad faith use in the Panel's view, when the Complainant has legitimately requested the Respondent, by means of a cease-and-desist letter, to assign the disputed domain name to it, the Respondent has reacted by disclosing a valuation report commissioned by the same Respondent and provided to the Complainant in which it was clearly stated that the disputed domain name has a monetary value of EUR 10 million (of course this value, as correctly stated, depends upon the very widespread use of the Eni trademark by the Complainant).

According to the Panel the disclosure of the valuation report has been obviously made by the Respondent with the hope and the expectation to negotiate the sale of the disputed domain name, starting with an exorbitant sum.

Having regard to the specific circumstances of the case, the Panel considers that the Respondent may have intended, from the outset, to register the domain name in the hope of being able to sell it in the future to the Complainant for an exorbitant sum. Indeed, according to the Panel's opinion, there would have been no other reason for commissioning and disclosing the valuation report by the Respondent.

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **enicafe.com**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2026-07-27

Publish the Decision