

## **ADMINISTRATIVE PANEL DECISION**

Enel S.p.A. v. Domain Admin and Domain Admin, and Domain Sales -  
(Expired domain caught by auction winner)

Case No. D2022-0637

### **1. The Parties**

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

The Respondents are domain admin and Domain Admin, Domain Sales - (Expired domain caught by auction winner), Hong Kong.

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

The disputed domain names <enelxway.com> and <enerxway.com> (the “Domain Names”) are registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 23, 2022. On February 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On February 24, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 11, 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 March 16, 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 Respondents of the Complaint, and the proceedings commenced on March 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on April 27, 2022.

The Center appointed Jeremy Speres as the sole panelist in this matter on May 5, 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, trading under its ENEL mark, is the largest Italian company in the energy market, managing most of the Italian electricity and gas distribution network and serving more than 26 million Italian customers. The Complainant operates internationally in more than 32 countries, bringing energy to around 64 million customers. Its ENEL mark has been recognised as well known by numerous UDRP panels.

The Complainant has registered its ENEL and ENEL X marks in numerous jurisdictions, including European Union ("EU") Trade Mark Registration No. 000756338 ENEL AND DEVICE in Classes 9, 11, 16, 19, 25, 35, 36, 37, 38, 39, and 42, registered on June 25, 1999; and EU Trade Mark Registration No. 017548322 ENEL X in Classes 7, 9, 11, 12, 35, 36, 37, 38, 39, 40, 41, and 42, registered on March 27, 2018. The Complainant also owns the following relevant, pending trade mark applications: EU Trade Mark Application No. 018657480 ENEL X WAY in Classes 9, 37, and 42, applied for on February 17, 2022; and EU Trade Mark Application No. 018657839 ENERXWAY in Classes 9, 37 and 42, applied for on February 18, 2022.

The Domain Name <enelxway.com> was registered on February 17, 2022 and the Domain Name<enerxway.com> was registered on February 18, 2022. Both Domain Names redirect to websites offering them each for sale for USD 995.

#### **5. Parties' Contentions**

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

The Complainant contends that the Domain Names are confusingly similar to its ENEL, ENEL X, ENEL X WAY, and ENERXWAY trade marks, that the Respondents have no rights or legitimate interests in the Domain Names, and the Domain Names were registered and used in bad faith given that they take advantage of the Complainant's well-known marks to attract users for the Respondents' commercial gain via listing the Domain Names for sale.

##### **B. Respondents**

The Respondents did not reply to the Complainant's contentions.

#### **6. Discussion and Findings**

##### **6.1. Preliminary Matter: Consolidation of the Complaint against Multiple Respondents**

The Panel concludes that the Domain Names are subject to common control for the following reasons:

- a) The registrant email address listed in the Whois records for both Domain Names is identical;
- b) The registrant physical addresses listed in the Whois records for both Domain Names refer to the same street and city;
- c) The Domain Names share the same registrar and were registered within one day of each other; and
- d) The Domain Names both redirect to an identical sales website and are listed for sale for the same price.

The Panel considers consolidation fair and equitable as the Respondents have been given a chance to reply to the Complaint and to the Complainant's request for consolidation, and procedural efficiency justifies consolidation (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.11.2). Therefore, the Panel accepts the Complainant's request for consolidation.

## **6.2. Substantive Matters**

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

The Complainant's evidence establishes that it has registered rights in its ENEL and ENEL X marks and that they are well known. The Complainant's ENEL X WAY and ENERXWAY marks are not yet registered and there is no evidence in the record that they enjoy common law rights. A pending trademark application does not by itself establish trademark rights for purposes of the Policy. (WIPO Overview section 1.1.4).

The Complainant's ENEL and ENEL X marks are wholly contained within Domain Name <enelxway.com>. Where a trade mark is recognisable within the disputed domain name (as in this case), the addition of other terms does not prevent a finding of confusing similarity (WIPO Overview section 1.8).

Similarly, the first and dominant feature of the Domain Name <enerxway.com>, "enerx", is reminiscent of the Complainant's ENEL X mark, differing by only one letter. Noting that the first element of the Policy entails a relatively low-threshold standing test, the Panel considers the Domain Name <enerxway.com> to be confusingly similar to the Complainant's ENEL X mark. The Panel draws support for this conclusion from the clear evidence of targeting of the Complainant discussed below. In specific limited instances, where a panel would benefit from affirmation as to confusing similarity, the broader case context may be considered, including a pattern of multiple respondent domain names targeting the complainant's mark within the same proceeding (as in this case), which may support a finding of confusing similarity ([WIPO Overview 3.0](#) at section 1.7).

The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

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

There is no evidence that any of the circumstances set out in paragraph 4(c) of the Policy, nor any others that would confer rights or legitimate interests, pertain. The Domain Names are confusingly similar to the Complainant's registered and well-known marks and the Complainant has certified that the Domain Names are unauthorised by it.

The only use of the Domain Names is to advertise them for sale. Trading in domain names can constitute a *bona fide* offering provided it is not undertaken with intent to profit from or abuse trade marks (*X6D Limited v. Telepathy, Inc.*, WIPO Case No. [D2010-1519](#)). The evidence discussed below clearly indicates that the Respondent's intention was to target the Complainant, thus the offering for sale of the Domain Names cannot constitute a *bona fide* offering of goods or services conferring rights or legitimate interests.

The Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

The Domain Names were both registered on the same days as the EU Trade Mark applications were filed by the Complainant for marks matching the Domain Names. Given that the Complainant's ENEL and ENEL X marks are well known, highly specific to the Complainant, and have no semantic meaning which the Respondent might in good faith have sought to adopt, this coincidence strongly suggests that the Respondent targeted the Complainant upon registration of the Domain Names.

It appears that a respondent with an identical email address as the Respondent has been previously found to have targeted various other trade mark holders using the very same *modus operandi* as the Respondent. See, e.g., *John Middleton Co. v. Domain Administrator, Domain is For Sale at Wwww.Dan.Com* ----, WIPO Case No. [D2021-1142](#); *DKH Retail Limited v. Domain Administrator, Domain Is For Sale At www.dan.com* ----, WIPO Case No. [D2021-0477](#); *DAZN Limited v. Domain administrator, Domain is for Sale at www.dan.com*, WIPO Case No. [D2021-1588](#).

In all of the cited cases, the same registrar was used (Dynadot LLC.), the domains were registered within days of corresponding trade mark applications having been filed by the complainants, and the domain names were listed for sale on the domain name marketplace Dan.com, details which match those in the present case. Additionally, the domain names were listed for sale for USD 990, which is very close to the USD 995 sale price at issue in the present case. Thus, it is quite likely that the Respondent is the same respondent in the cases listed above.

Thus, the Respondent appears to be a serial cybersquatter. This case is merely a continuation of a pattern of registering domain names that correspond to recently filed trade mark applications and using them to list the domain names for sale for the Respondent's commercial gain. The business model of the Respondent probably relies on complainants preferring to pay a purchase price lower than the costs of lodging a UDRP complaint, rather than lodging a UDRP complaint, hence the list prices at issue in this and the prior cited cases. The provisions of paragraphs 4(b)(ii) and (iv) of the Policy are eminently applicable here.

The Panel draws adverse inferences from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for ([WIPO Overview 3.0](#) at section 4.3), and the provision of false Whois details; the Center's courier could not deliver hardcopies of the Complaint to the Respondent's physical address ([WIPO Overview 3.0](#) at section 3.2.1).

The Complainant has satisfied paragraph 4(a)(iii) of the Policy.

## 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 Domain Names <enelxway.com> and <enerxway.com> be transferred to the Complainant.

*/Jeremy Speres/*

**Jeremy Speres**

Sole Panelist

Date: May 19, 2022