

## **ADMINISTRATIVE PANEL DECISION**

Elkem ASA v. Peter Wu

Case No. D2023-4924

### **1. The Parties**

The Complainant is Elkem ASA, Norway, represented by Zacco Norway AS, Norway.

The Respondent is Peter Wu of China.

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

The disputed domain name <elkkem.com> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 27, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 7, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 7, 2023, 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 amendment to the Complaint on December 8, 2023.

The Center verified that the Complaint together with the amendment to the 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 Respondent of the Complaint, and the proceedings commenced on December 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 22, 2024.

The Center appointed Andrew J. Park as the sole panelist in this matter on January 30, 2024. 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, Elkem ASA, is a Norwegian company group founded in 1904. According to the Complainant, it is a provider of advanced silicon-based materials used in connection with electric mobility, digital communications, health and personal care, as well as smarter and more sustainable cities. The Complainant has offices and facilities located across five continents, and more than 7,300 employees worldwide. The Complainant is included in the OBX ESG index, a selection of 40 blue-chip companies in Norway that demonstrates the best Environmental, Social and Governance (ESG) practices.

The Complainant has a registered trademark ELKEM in the United States and has been granted trademark protection in a large number of jurisdictions, including China, the European Union, and the Republic of Korea, among others. The Complainant has its official website with the domain name <elkem.com>.

The Complainant has obtained the following trademark registrations:

Jurisdiction	Trademark	Registration No.	Registration Date
United States Trademark	ELKEM	5797376	July 9, 2019
United States Trademark	 Elkem	5639353	December 25, 2018
United States Trademark	ELKEM MICROSILICA	2411847	February 10, 2000
Republic of Korea Trademark	 Elkem	4002010820000	September 20, 1990
European Union Trademark	ELKEM	017901616	October 30, 2018
China Trademark	ELKEM	31606984	March 14, 2019

The Respondent, Peter Wu, registered the disputed domain name <elkkem.com> on October 4, 2023. According to the Complaint, the disputed domain name was used to send fraudulent emails to third parties and currently it resolves to an inactive website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name because:

(a) The disputed domain name is almost identical or at least very similar to the Complainant's trademark ELKEM in which the Complainant has rights. The Complainant owns several domain names that incorporate its ELKEM trademark, such as <elkem.com>.

The disputed domain name consists of the term “elkkem” which features a minor intentional misspelling of the Complainant’s trademark. However, the trademark ELKEM is still quite recognizable in the disputed domain name. The Respondent’s intentional misspelling of the Complainant’s trademark and the addition of the generic Top-Level Domain (“gTLD”) “.com” would not have any impact on the overall impression of the dominant portion of the disputed domain name and, therefore, it is irrelevant when determining the confusing similarity between the Complainant’s trademark and the disputed domain name. Consequently, the Respondent’s use of the Complainant’s trademark in the disputed domain name leads the public to perceive the disputed domain name either as a domain name owned by the Complainant or that there is some commercial relationship with the Complainant, given the Complainant’s long-standing use and recognition of the ELKEM trademark in various countries, including in China, the European Union, the Republic of Korea, and the United States.

(b) the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant claims that the Respondent lacks any right or legitimate interest in the disputed domain name because the Complainant has not licensed or authorized the use of its registered trademark ELKEM or variations thereof to the Respondent, and there is no information that the Respondent is trading under a name corresponding to the disputed domain name. Furthermore, there is no indication of the Respondent’s use of the disputed domain name in connection with a bona fide offering of goods and services. The Respondent used the disputed domain name to send fraudulent and illicit emails to third parties for financial gain by impersonating the Complainant, all of which demonstrates that the Respondent had no intention to use the disputed domain name in connection with a bona fide offering goods or services. Rather, such conduct by the Respondent must be considered as improper and can never amount to legitimate rights or interests in the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith. First, the Complainant contends that the Respondent must have had actual knowledge of the Complainant, its trademarks, and its business activities when it registered the disputed domain name. The Respondent’s registration date of the disputed domain name is subsequent to when the Complainant obtained its trademark right for ELKEM by many years, both in the Respondent’s jurisdiction and elsewhere, and the incorporation of the Complainant’s well-known trademark in the disputed domain name clearly demonstrates that the Respondent targeted the Complainant’s highly distinctive trademark and was also fully aware of the Complainant’s well-known business and the ELKEM trademark at the time of registration, all of which amount to bad faith use.

Second, the Respondent used the disputed domain name to attempt to impersonate the Complainant by falsely claiming to be or to at least represent the Complainant, thereby deceiving Internet users and misappropriating the Complainant’s trademark and business for commercial gain.

Further, the Complainant sent a cease-and-desist letter to the Respondent, requesting that the disputed domain name be transferred to the Complainant. The Respondent chose not to respond further indicating its disregard for the rights of the Complainant.

Thus, the Complainant argues that the Respondent is using the disputed domain name in order to intentionally attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion between the Complainant’s trademark and the disputed domain name as to the source, sponsorship, affiliation, or endorsement of the Respondent, and thereby unfairly capitalizing on the reputation and goodwill of the Complainant and its ELKEM trademark.

## **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the trademark ELKEM and that the disputed domain name is confusingly similar to the Complainant's trademark. The Complainant has created its trademark ELKEM to refer to its company and its products since the 1990s. The term "elkem" is not a common word and it is neither descriptive of the Complainant's products nor of any other products, companies or places. The Complainant argues that the Complainant's trademark ELKEM is nearly identical with the main element in the disputed domain name and the only difference between the disputed domain name and the Complainant's trademark is that the disputed domain name has one additional letter "k," when compared with the Complainant's ELKEM mark.

By misspelling the trademarks, the Respondent is clearly trying to take advantage of typographical errors to benefit from the likelihood of confusion between the disputed domain name and the Complainant's trademark. There is nothing in the record to prevent a finding of confusing similarity to the Complainant's trademark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Further, the addition of the generic gTLD ".com" is a standard registration requirement and as such may be disregarded when assessing confusing similarity under the first element of the Policy. [WIPO Overview 3.0](#), section 1.11.1 and *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the Complainant has shown rights in respect of the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Panel also finds that the disputed domain name is confusingly similar to the Complainant's trademark.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a prima facie case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. [WIPO Overview 3.0](#), section 2.1.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish its rights or legitimate interests in the disputed domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed 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 (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, the Panel finds that the Complainant has made out a prima facie case.

The Complainant has asserted that the Respondent has no relationship with or authorization from the Complainant to use its trademarks. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name. The Complainant also argues that the Respondent used the disputed domain name to disseminate deceitful and illicit emails to Internet users by impersonating the Complainant, all without the Complainant's permission or authorization. This conduct by the Respondent demonstrates that the Respondent never had an intention to use the disputed domain name in connection with a bona fide offering of goods and or services.

The Panel finds that the Respondent is improperly using the disputed domain name to create a false impression that the Respondent is affiliated with the Complainant and the Respondent's use of a domain name for illegal activity such as phishing, impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on the Respondent (see [WIPO Overview 3.0](#), section 2.13.1).

The Panel concludes that these facts may be taken as true in the circumstances of this case and in view of the use of the disputed domain name. Further, the Panel is unable to find any reasonable basis upon which the Respondent could be said to have any rights or legitimate interests in respect of the disputed domain name, and the Respondent has not filed a formal Response.

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of 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 the 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 has 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 its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent violated the Policy, paragraph 4(b)(ii) and (iv) by registering the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name. The Complainant also argues that the Respondent has engaged in a pattern of such conduct and attempts to attract, for commercial gain, Internet users to the Respondent's website to which the disputed domain name resolves by creating a likelihood of confusion with the Complainant's trademark.

As stated previously, the Respondent did not file any response to the Complaint, failing thereby to rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain name.

Nevertheless, the Panel still has the responsibility of determining which of the Complainant's assertions are established as facts and whether the conclusions asserted by the Complainant can be drawn from the established facts (*Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

First, the Panel finds the Respondent intentionally registered the disputed domain name in bad faith. The Respondent registered the disputed domain name, which is confusingly similar to the Complainant's trademark ELKEM, while aware of the Complainant's business and its trademarks. The Complainant holds numerous registrations of the trademark ELKEM in various jurisdictions worldwide including in the United States and in China, where the Respondent is from, since the 1990s. The Respondent registered the disputed domain name in 2023 which is almost three decades after the Complainant's earliest registrations of its trademark ELKEM. Based on the facts-of-record, the Respondent must have targeted the Complainant's highly distinctive and well-known trademark in an effort to show a business relationship between the Respondent and the Complainant and to thereby benefit from the likelihood of confusion with the Complainant's trademark.

Secondly, the Panel finds that the Respondent has been using the disputed domain name in bad faith. The Complainant submitted evidence that the disputed domain name was being used by the Respondent in connection with a phishing attempt to perpetrate a fraud by sending deceitful and illicit emails to third parties while impersonating the Complainant. The Panel holds that the Respondent's use of the disputed domain name for illegal activity such as the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, or impersonation/passing off can never confer rights or legitimate interests on the Respondent and that such behavior is manifestly considered evidence of bad faith (see [WIPO Overview 3.0](#), section 2.13).

Third, the Complainant sent a cease-and-desist letter to the Respondent and the Respondent did not respond. This is further indicia of the Respondent's bad faith use of the disputed domain name. In addition, the disputed domain name was registered with a privacy shield service, PrivacyGuardian.org LLC in an effort to hide the Respondent's identity. The Respondent's concealment of the disputed domain names holder's identity through the use of a privacy shield constitutes a further indication of bad faith (*Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#)).

As the conduct described above falls squarely within paragraph 4(b)(iv) of the Policy, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy, paragraph 4(a)(iii).

## 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 disputed domain name <elkkem.com> be transferred to the Complainant.

/Andrew J. Park/

**Andrew J. Park**

Sole Panelist

Date: February 13, 2024