

ADMINISTRATIVE PANEL DECISION

Wartsila Technology Oy Ab v. Jack Bauer, Allied Aerospace
Case No. D2023-5234

1. The Parties

The Complainant is Wartsila Technology Oy Ab, Finland, represented by SafeNames Ltd., United Kingdom.

The Respondent is Jack Bauer, Allied Aerospace, United States of America.

2. The Domain Name and Registrar

The disputed domain name <warlsila.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 15, 2023. On December 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 15, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 20, 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 amended Complaint on December 21, 2023.

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 Respondent of the Complaint, and the proceedings commenced on January 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 24, 2024.

The Center appointed Gustavo Patricio Giay as the sole panelist in this matter on January 26, 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 is a Finnish corporation – operating since 1834 – from the technology industry working towards smart technologies and complete lifecycle solutions for the marine and energy markets.

The Complainant claims to have had a long journey since 1834. In its early years it operated as a sawmill and iron works company. Towards 1959, the Complainant started producing its first commercial engines and then, in 2001, the Complainant expanded into biopower and was later deemed among the 100 most sustainable corporations in the world.

As of 2021, the Complainant explained that it had net sales of EUR 4.8 billion with over 17.000 employees and with international presence in over 200 locations across 68 countries including, Hungary, Texas, Indonesia, Kenya, the United Kingdom, the Caribbean, among others.

The Complainant is the owner of the trademark WÄRTSILÄ and WARSTILA (“WÄRTSILÄ/WARTSILA”) in many jurisdictions, including United States Patent and Trademark Office Reg no. 2078313, registered on July 15, 1997, for cl. 7; European Union Intellectual Property Office Reg no. 000838466, registered on February 21, 2000, for cl. 7, 12, and 37; International Registration No. 1005789, registered on May 22, 2009, for cl. 7, 9, 11, 12, 35, 37, 41, and 42; and European Union Intellectual Property Office Reg no. 011765294, registered on September 18, 2013, for cl. 7, 9, 11, 12, 35, 37, 41, and 42.

The Complainant has also established a social media presence and uses the WÄRTSILÄ/WARTSILA trademark to promote its services. Likewise, the Complainant claims to own an important domain name portfolio including, its primary website “www.wartsila.com” registered in 1996.

The Complainant states that they tried to resolve this dispute outside of this administrative proceeding by sending a cease-and-desist letter to the Respondent on September 21, 2023, but did not receive a reply. As to the latter, it is worth highlighting that the Complainant did not provide evidence of the delivery of the cease-and-desist letters submitted in the Complaint as Annex 14 but, as the Respondent did not file any objection to such evidence, this Panel will consider them as valid proof.

The disputed domain name was registered on September 8, 2023, and currently resolves to an inactive website with a DNS Failure. However, the Complainant has filed proof demonstrating that the disputed domain name was initially used for phishing attacks (as per Annex 10 to the Complaint).

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.

Notably, the Complainant claims that the disputed domain name is confusingly similar to its trademark WÄRTSILÄ/WARTSILA on which the Complainant has prior rights.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, nor is the Respondent related in any way to the Complainant. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark WÄRTSILÄ/WARTSILA or apply for registration of the disputed domain name.

More specifically, the Complainant alleged that the Respondent has not used and/or has no demonstrable intention to use the disputed domain name except to create a likelihood of confusion with the Complainant's trademark. In fact, the Complainant claims that the Respondent has selected the disputed domain name only to intentionally lead Internet users to believe they are accessing the Complainant's website and receiving Complainant's emails.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7. The typosquatting practice of replacing the letter "t" by the letter "l", does not prevent this Panel to conclude that the disputed domain name is confusingly similar to the Complainant's trademark under WIPO Overview, section 1.9.

Moreover, the ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of WIPO Overview 3.0.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with

relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. WIPO Overview 3.0, section 2.1.

The Complainant has claimed not to have authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the WÄRTSILÄ/WARTSILA trademark nor is there any other evidence in the file suggesting that the Respondent has or could have rights or legitimate interests in the disputed domain name.

Even more, it does not seem that the Respondent made nor is making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Respondent initially employed the disputed domain name for facilitating phishing attacks, as evidenced by the Complainant in Annex 10. The Respondent masqueraded as an employee of WARSTILA's Credit Controller, seeking payments of up to EUR 156,000. This type of use can never confer rights or legitimate interests as established by WIPO Overview 3.0, section 2.13.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In such connection, the Complainant has submitted evidence to support that the trademark WÄRTSILÄ/WARTSILA is widely known and was registered and used many years before the Respondent registered the disputed domain name. When registering the disputed domain name, the Respondent has targeted the Complainant's trademark WÄRTSILÄ/WARTSILA to generate confusion among Internet users and benefit from the Complainant's reputation under paragraph 4(b)(iv) of the Policy.

Moreover, it is clear that the Respondent registered a domain name containing a misspelled version of the Complainant's trademark WÄRTSILÄ/WARTSILA in what appears to be a typosquatting registration, to generate confusion among Internet users and benefit from the Complainant's reputation.

Also, the Respondent utilized the disputed domain name to execute phishing attacks, aiming to capitalize on the potential confusion of users receiving fraudulent emails regarding the origin of the disputed domain name. Previous panels have held that the use of a domain name for illegal activity here, claimed as phishing, constitutes bad faith. WIPO Overview 3.0, section 3.4.

Even more, the Respondent has ignored the cease-and-desist letter from the Complainant, which aimed at resolving this matter amicably outside of this administrative proceeding.

The Panel finds that the Complainant has established the third element 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 disputed domain name <warlsila.com> be transferred to the Complainant.

/Gustavo Patricio Giay/

Gustavo Patricio Giay

Sole Panelist

Date: February 9, 2024