

ADMINISTRATIVE PANEL DECISION

Wartsila Technology Oy Ab v. grasso salvatore, Z.R.E. S.r.l
Case No. D2024-0602

1. The Parties

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

The Respondent is grasso salvatore, Z.R.E. S.r.l, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <wartslic.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 9, 2024. On February 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 12, 2024, 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 February 12, 2024.

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 February 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 4, 2024. The Center received an informal email communication from a third party on March 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 14, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on March 21, 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

It results from the Complainant's undisputed allegations that it is a Finnish corporation which operates in the field of smart technologies and complete lifecycle solutions for the marine and energy markets. It has a strong international presence with operations in over 200 locations across 68 countries with over 17,000 employees. It operates its services internationally, with power plants in locations including but not limited to, Hungary, the United States of America, Indonesia, Kenya, the United Kingdom, and the Caribbean. It was established and has been operating continually since 1834.

The Complainant is the registered owner of many trademarks worldwide for WARTSILA, including European Union trademark registration no. 011765294, registered on September 18, 2013, for goods and services in classes 7, 9, 11, 12, 35, 37, 41, and 42.

In addition, the Complainant uses the following domain name <wartsila.com> for its main website which it uses to advertise its products and services.

The disputed domain name was registered on September 10, 2023, and resolves to an inactive webpage.

Finally, the Complainant sent a cease-and-desist letter to the Respondent on September 21, 2023. The Respondent did not reply to it.

On March 11, 2024, the Center received an email communication from a third party alleging that the disputed domain name had been registered making unauthorized use of third-party personal contact information.

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 contends that the disputed domain name is confusingly similar to the Complainant's trademark since it matches the WARTSILA mark, except for the replacement of the letter "a" at the end of the disputed domain name with "c", and the letters "i" and "l" have been swapped. The disputed domain name constitutes an example of typosquatting.

The Complainant contends that its trademark is distinctive and has acquired reputation.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent does not have any trademark rights to any term used in the disputed domain name. There is also no evidence that the Respondent retains any unregistered trademark rights to any term used in the disputed domain name. Neither has the Respondent received any license from the Complainant to use a domain name featuring its trademark. The Respondent is not offering any goods or services from the disputed domain name. Instead, the Respondent has deliberately registered a domain name that is confusingly similar to the distinctive WARTSILA mark. This made-up term is not a phrase a trader would legitimately choose unless seeking to create an impression of association with the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and was being used in bad faith. According to the Complainant, the Respondent has engaged in typosquatting, targeting the Complainant in hopes of catching Internet users that misspell or misread the Complainant's main platform at <wartsila.com>. The Respondent registered the disputed domain name in bad faith, with the primary intention of taking advantage of the Complainant's brand. Even though the disputed domain name does not currently resolve to a functional webpage, it has been established by panels that "passive use" does not preclude a finding of bad faith use, especially because the Complainant has a strong reputation with the trademark WARTSILA within its sector.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to 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 has been registered and is being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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.

In addition, it is the view of this Panel that the replacement of the vocal "a" at the end of the disputed domain name with "c", and the fact that the letters "i" and "l" have been swapped in the disputed domain name result to be a common, obvious, or intentional misspelling of the Complainant's trademark, and cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the disputed domain name contains sufficiently recognizable aspects of the relevant mark (see [WIPO Overview 3.0](#) at section 1.9).

Finally, the generic Top-Level Domain ("gTLD"), ".com" of the disputed domain name, may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11).

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.

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.

Moreover, the Panel notes that the disputed domain name consists of a common, obvious, or intentional misspelling of the Complainant’s registered trademark WARTSILA, so that this Panel finds it most likely that employing a misspelling in this way signals an intention on the part of the Respondent to confuse users seeking or expecting the Complainant. The trademark WARTSILA is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain name with the intention to take advantage of the Complainant’s reputation by registering a domain name containing the Complainant’s trademark with the intent to mislead Internet users.

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 the present case, the Panel notes that the Complainant’s trademarks have existed for many years. Therefore, this Panel has no doubt that the Respondent positively knew or should have known that the disputed domain name consisted of the Complainant’s trademarks when the Respondent registered the disputed domain name.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, and the composition of the disputed domain name, being a

typosquatting, and the respondent's concealing his identity and making unauthorized use of the personal contact information of an unrelated third party to register the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <wartslic.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: April 4, 2024