

ADMINISTRATIVE PANEL DECISION

Wartsila Technology Oy Ab v. John Wayne
Case No. D2024-0605

1. The Parties

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

The Respondent is John Wayne, United States of America ("United States").

2. The Domain Names and Registrar

The disputed domain names <wartsiln.com> and <wartsilo.com> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar 1"). The disputed domain name <wwartsila.com> is registered PSI-USA, Inc. dba Domain Robot (the "Registrar 2").

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 Registrars the requests for registrar verification in connection with the disputed domain names. On February 10 and 12, 2024, respectively, the Registrars transmitted their verification responses by email to the Center confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 February 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 12, 2024.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on March 14, 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 which operates in the field of smart technologies and complete lifecycle solutions for the marine and energy markets. As of 2021, the Complainant had net sales of EUR 4.8 billion with over 17,000 employees. The Complainant has a strong international presence with operations in over 200 locations across 68 countries. The Complainant's main website is "www.wartsila.com".

The Complainant's activities are centered around two businesses: "Wärtsilä Marine" and "Wärtsilä Energy". The Complainant was established in and has been operating continually since 1834.

The Complainant has numerous registrations for the WÄRTSILÄ and WARTSILA trademark around the world.

The Complainant is, inter alia, the owner of:

European Union Trade Mark WÄRTSILÄ (word) registration number 008304149, registered on November 25, 2011;

European Union Trade Mark WARTSILA (word) registration number 011765294, registered on September 18, 2013;

International Trademark WÄRTSILÄ (word) registration number 1005789, registered on May 22, 2009;

United States Trademark WÄRTSILÄ (word) registration number 2078313, registered on July 15, 1997;

The Complainant operates from its main domain name, <wartsila.com> (created on January 5, 1996), which it uses to advertise its products and services, in addition to promoting its WÄRTSILÄ and WARTSILA trademark globally. The Complainant holds numerous domain names incorporating the Complainant's WARTSILA trademark with country-code Top-Level Domain ("ccTLD") extensions, e.g., <wartsila.cm>, as well as registrations with generic Top-Level Domain ("gTLD") extensions, e.g., <wartsila.careers>.

The Complainant has also established a social media presence and uses the WÄRTSILÄ and WARTSILA trademark to promote its services under this name, in particular on:

- Facebook: "www.facebook.com/wartsila/"
- X (f.k.a. Twitter): "www.twitter.com/wartsilacorp"
- Instagram: "www.instagram.com/wartsilacorp/"
- LinkedIn: "www.linkedin.com/company/wartsila"
- YouTube: "www.youtube.com/user/wartsilacorp"

The disputed domain names <warsilin.com>, <wartsilo.com>, and <wwartsila.com> were registered on September 18, September 27, and October 24, 2023, respectively, and are not linked to any active websites.

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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the WARTSILA trademark, because the disputed domain names match the WARTSILA trademark, except for the addition or replacement of a single letter, and that this constitutes "typosquatting"; that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and particularly that the

Respondent is targeting the Complainant in hopes of catching Internet users that misspell or misread the Complainant's main platform at the domain name <wartsila.com>, and that such tactics indicate bad faith registration. The Complainant further claims and documents that the disputed domain name <wartsilo.com> has been used to carry out phishing activities by way of scam emails using the email address "[...]"@wartsilo.com" to impersonate an employee of the Complainant, and also using the Complainant's logo and company signature in order to solicit money transfers from customers of the Complainant.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain names, paragraph 4(a) of the Policy requires that the Complainant must demonstrate to the Panel that:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are 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 names. In fact, the disputed domain names match the WARTSILA trademark, except for the addition or replacement of a single letter. There is a consensus view among UDRP panels that a domain name which contains a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 names. 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 names such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity here, claimed as impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

While only one disputed domain name was evidenced to be in use for a fraudulent email scheme, the other two have not resolved to any active websites and are inherently misleading as regards the fact they are one-letter variations of the Complainant's distinctive trademark and such composition cannot constitute fair use.

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 Respondent intentionally targeted the Complainant and its trademark in an attempt to mislead, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark and by illegally trying to impersonate one of the Complainant's employees.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

UDRP 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, particularly the typosquatting nature of the disputed domain names, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Moreover, given the use of one of the disputed domain names for a fraudulent email scheme, the Panel cannot credibly believe in any good faith use to which the other two typosquatting disputed domain names could be put.

UDRP panels have held that the use of a domain name for illegal activity, here claimed to be used for impersonating an employee of the Complainant for the purposes of fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes 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 names <wartsiln.com>, <wartsilo.com>, and <wwartsila.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: March 26, 2024