

ADMINISTRATIVE PANEL DECISION

Wärtsilä Technology Oy Ab v. Newkey Product
Case No. D2022-2336

1. The Parties

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

The Respondent is Newkey Product, United States of America.

2. The Domain Name and Registrar

The disputed domain name <wartsinla.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 June 28, 2022. On June 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 2022, the Registrar transmitted by email to the Center its verification response 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 29, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on August 16, 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 is a Finnish corporation which has been founded in 1834. It today operates in the field of smart technologies and complete lifecycle solutions for the marine and energy markets. Within this sector, the Complainant emphasizes on sustainable innovation, efficiency, and data analytics to maximize the environmental and economic performance of its customers' vessels and power plants. The Complainant has a strong international presence with several operations worldwide.

The Complainant registered the trademarks WÄRTSILÄ and WARTSILA in many countries. It notably has been the owner since 1997 of trademark rights in WÄRTSILÄ in the United States of America (see, e.g., Reg. No. 2,078,313) and since 2013 in WARTSILA in the European Union (see, e.g., Reg. No. 011765294).

The Complainant operates online from its main website "www.wartsila.com" which it uses to advertise its products and services. The Complainant hold a wide portfolio of domain names comprising WARTSILA and is present in social media.

The disputed domain name was registered on August 31, 2021, and is currently inactive. It was previously hosting a website advertising the services of the Centos computer operating system.

The Complainant sent a warning letter to the Respondent on September 20, 2021, which remained unanswered.

5. Parties' Contentions

A. Complainant

The Complainant claims to be the owner of trademarks for WÄRTSILÄ and WARTSILA and submits that the disputed domain name is confusingly similar to its marks. The disputed domain name matches the Complainant's WARTSILA trademark except for an additional "n" which is an example of typo squatting. In this context, the Complainant refers to the fact that Internet users would easily mistype its trademark and would thus be likely lead to the Respondent's disputed domain name rather than the website of the Complainant.

The Complainant further submits that the Respondent lacks rights or legitimate interests in the disputed domain name. Indeed, the Respondent does not have any trademark rights in WÄRTSILÄ, WARTSILA, and/or WARTSINLA. The Respondent is not offering any goods or services as the disputed domain name is held passively. It was previously linked to a webpage advertising the services of the Centos computer operating system which has been used as a placeholder by other respondents in UDRP proceedings. The redirection of users to an unrelated webpage is not indicative of rights or legitimate interests. To the best of the Complainant's knowledge, the Respondent is not known by WÄRTSILÄ, WARTSILA, and/or WARTSINLA, having in mind that WÄRTSILÄ and WARTSILA are fanciful terms which represent the Complainant's goods and services.

The Complainant contends that its trademark registrations predate the creation date of the disputed domain name whereby it is underlined that WÄRTSILÄ and WARTSILA have become well known for energy and marine services. Furthermore, the Respondent did not respond to the Complainant's warning letter. Typo squatting was chosen by the Respondent in order to catch Internet users, which is a bad faith tactic. Additionally, the disputed domain name is inactive and four-part test developed in the "Telstra" UDRP decision fully applies presently (see, e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). The Complainant also notes that Mail Exchange records are present on the disputed domain name which means that it is set up to be used as an email address. Therefore, there is a risk that the disputed domain name be used for misleading emails. All these elements are indications of bad faith registration and use by the Respondent.

B. Respondent

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

6. Discussion and Findings

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) that the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant showed to have trademark rights in WÄRTSILÄ and/or WARTSILA through several registrations in several countries, including in the United States of America where the Respondent is based.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The disputed domain name contains the WARTSILA trademark in entirety. The addition of the letter "n" in the middle of the disputed domain name is an example of potential typosquatting and does in any event not prevent confusing similarity, as the WARTSILA trademark, which is an original and distinctive trademark, remains recognizable in the disputed domain name (see section 1.9 of the [WIPO Overview 3.0](#)).

Under these circumstances, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights to or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production on this element shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made some submissions in order to demonstrate that the Respondent has no rights to or legitimate interests in the disputed domain name, in particular that the Respondent does not have trademark rights in WÄRTSILÄ, WARTSILA, and/or WARTSINLA and that the Respondent is not known by said names.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case and the burden of production shifts to the Respondent who seems to have chosen not to reply.

The Panel notes that the Respondent can indeed not be known by the disputed domain name as it is inactive and that the case file does not evidence that it would once have been used to identify the Respondent and/or his business.

Furthermore, the Complainant has shown that its WÄRTSILÄ and WARTSILA are original marks which have acquired a notoriety in the fields in which they are used for.

Considering that Internet users might thus be misled as to the origin of the disputed domain name and in the absence of any response by the Respondent, the Panels finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant has shown to have trademark rights in WÄRTSILÄ and WARTSILA since decades and for having widely used the said mark notably on the Internet through its official website “www.wartsila.com”.

The Respondent must thus have known about the WÄRTSILÄ and WARTSILA trademarks and business when registering the disputed domain name. See section 3.2.2 of the [WIPO Overview 3.0](#).

It is highly likely that the present case is a typosquatting case which means that the disputed domain name was chosen by the Respondent in order to catch Internet users and create a confusion with the Complainant’s trademarks, which is a bad faith tactic. Indeed, WÄRTSILÄ and WARTSILA are original trademarks which have been used since decades to identify the Complainant and WARTSINLA which has been registered as the disputed domain name reproduces the main characteristics of the Complainant’s trademark. The case file does not contain information which would explain why WARTSINLA would have been chosen by the Respondent other than for unduly leaning on the Complainant’s marks.

The Complainant also noted that Mail Exchange records are present on the disputed domain name which means that it is set up to be used as an email address. Therefore, there is a risk that the disputed domain name be used for misleading emails.

Furthermore, the Respondent did not respond to the Complainant’s warning letter and the absence of response in the present proceedings is an additional element of bad faith.

Considering the totality of circumstances above, the passive holding of the disputed domain name does not prevent a finding of bad faith. See section 3.3 of the [WIPO Overview 3.0](#).

In light of the above, the Panel finds that the Complainant has established its case under 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 disputed domain name, <wartsinla.com> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: September 9, 2022