

ADMINISTRATIVE PANEL DECISION

Wartsila Technology Oy Ab v. mark zuga, Donna Bruzzone Case No. D2024-3029

1. The Parties

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

The Respondents are mark zuga, the United States of America ("United States"), Donna Bruzzone, United States.

2. The Domain Names and Registrar

The disputed domain names <wartslla.co> and <wartsllla.com> (collectively, the "Disputed Domain Names") are registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 25, 2024. On July 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On July 25, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondents (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 28, 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 July 30, 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").

On August 1, 2024, the Center received an email from the email address of one of the Respondents, Donna Bruzzone. On August 1, 2024, the Complainant's representative subsequently replied to the Respondents by email regarding possible settlement arrangements. On August 6, 2024, the Center received another email from the email address of Donna Bruzzone. In accordance with the Rules, paragraphs 2 and 4, the

Center formally notified the Respondents of the Complaint, and the proceedings commenced on August 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 3, 2024.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on September 13, 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 that has operated its businesses since 1834. It operates in the field of smart technologies and complete lifecycle solutions for the marine and energy markets. The Complainant has operations across the world, including power plant locations including, *inter alia*, Hungary, Texas, the United Kingdom, and Indonesia.

The Complainant owns various trademarks for “WÄRTSILÄ” in various countries and classes, including, *inter alia*, the United States Trademark Registration No. 2,078,313 for “WÄRTSILÄ” registered on July 15, 1997 in Class 7, the European Union Trademark Registration No. 008304149 for “WÄRTSILÄ” registered on November 25, 2009 in Classes 7, 9, 11, 12, 35, 37, 41, 42, International Trademark Registration No. 1005789 for “WÄRTSILÄ” registered on May 22, 2009 in Classes 7, 9, 11, 12, 35, 37, 41, 42 designating, *inter alia*, Australia, China, and Japan (the “Complainant’s Trademark”).

The Complainant’s Trademark is also fully incorporated in the Complainant’s domain names including, *inter alia*, <wartsila.com> (the “Complainant’s Domain Name”) and resolves to the Complainant’s primary website (the Complainant’s Website”).

The Disputed Domain Names were both registered on May 13, 2024, many years after the Complainant registered the Complainant’s Trademark. According to the Complainant, before the filing of the Complaint, one of the Disputed Domain Name, <wartsilla.com>, purportedly resolved to a website that display “Pay-Per-Click” (PPC) links which redirected users to third-party websites unrelated to the Complainant. The Complainant also claimed that at the time of the filing of the Complaint, the other Disputed Domain Name, <wartsilla.co> also purportedly resolved to a website that display PPC links which redirected users to third-party websites unrelated to the Complainant. At the time of rendering this Decision, the Panel noted that both Disputed Domain Names resolve to inactive websites (the “Respondents’ 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:

(a) The Disputed Domain Names are confusingly similar to the Complainant’s Trademark. The Disputed Domain Names reproduce the Complainant’s Trademark except that for <wartsilla.com>, the letter “i” is replaced with the letter “l”, and the additional letter “l”, followed by the term “.com”; for <wartsilla.co>, the letter “i” is replaced with the letter “l”, followed by the term “.co”. The presence of intentional typo-squatting and the addition of a Top-Level Domain (“TLD”) “.com” and “.co” do not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant’s Trademark.

(b) The Respondents have no rights or legitimate interests in the Disputed Domain Names. The Respondents are not affiliated with the Complainant in any way, and the Respondents have not obtained any authorization from the Complainant to use the Complainant’s Trademark as part of a domain name or

otherwise. There is also no evidence that the Respondents are commonly known by the Disputed Domain Names or the Complainant's Trademark. Furthermore, as the Disputed Domain Names displayed PPC advertisement links that redirected Internet users to third-party websites which offer unrelated services to the Complainant before and at the time of the Complaint respectively, it cannot be inferred that the Respondents are making a bona fide offering of goods or services, nor a legitimate non-commercial or fair use of the Disputed Domain Names. The Registrar purportedly suspended <wartsllla.com> as the relevant Respondent was allegedly carrying out phishing activities by way of impersonating the Complainant to solicit payments and to steal sensitive information from the Complainant's clients. These findings further suggest that the Disputed Domain Names were not being used for any bona fide offering of goods or services or legitimate non-commercial or fair use of the Disputed Domain Names.

(c) The Respondents have registered the Disputed Domain Names and are using it in bad faith. Given the goodwill and reputation that the Complainant has acquired in the Complainant's Trademark, the Respondents must have been fully aware of the existence of the Complainant's rights in the Complainant's Trademark when the Respondents registered and used the Disputed Domain Names. The Respondents' deliberate misspellings of the Complainant's Trademark and the purported attempt to impersonate as the Complainant aim to create a likelihood of confusion with Complainant's Trademark and to divert business away from the Complainant. The Respondents also did not reply to the Complainant's cease-and-desist letter asking the Respondents to transfer the Disputed Domain Names to the Complainant. The Respondents are likely to have registered the Disputed Domain Names to intentionally mislead the Complainant's customers and divert Internet traffic away from the Complainant's Websites to webpages with commercial PPC links, thus generating revenue for the Respondents. Further, the Respondents were likely to be engaging in email fraud or a phishing scheme by impersonating as the Complainant and intercepting payments intended for the Complainant, such that the Registrar suspended the Disputed Domain Name, <wartsllla.com>. Therefore, the Respondents have registered and are using the Disputed Domain Names in bad faith.

B. Respondent

One of the Respondents sent email communications to the Complainant on August 1 and 6, 2024 respectively. In the email dated August 1, 2024, that Respondent asked if the Complainant would be interested in buying the Disputed Domain Name. In the email dated August 6, 2024, that Respondent stated that they wished to proceed with settlement and asked the Complainant to advise on a means for payment. Apart from the correspondence above, the Respondents did not file any formal response to the Complainant's contentions.

6. Discussion and Findings

6.1 Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the Registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple Registrants pursuant to paragraph 10(e) of the Rules.

The Respondents did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the Disputed Domain Names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that:

- (i) The Disputed Domain Names were registered on the same day and with the same Registrar.
- (ii) The Disputed Domain Names used to resolve to webpages with commercial PPC links that redirected visitors to third-party websites unrelated to the Complainant.
- (iii) The Disputed Domain Names share a very similar lexical composition, both involving the “WARTSILA” mark in the typo variation of replacing the letter “i” with the letter “l”.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

The Panel also notes that the Respondents did not provide any substantive Response to the Complaint. In light of the above, the Panel accepts the Complainant’s contentions and finds that the Complainant has established that the Disputed Domain Names are more likely than not under the common control of the Respondents, and it would be fair and equitable to all Parties and procedurally efficient to have the Complainant’s claims consolidated against all Respondents.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different Disputed Domain Names in a single proceeding.

6.2 Substantive Issues

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (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 Respondents have 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 by the Respondents in bad faith.

A. Respondent’s Consent to Remedy

As indicated above, the Respondent has unilaterally consented to the remedy requested by the Complainant. Further to the [WIPO Overview 3.0](#), section 4.10, “where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent”. However, panels may still find it appropriate to proceed with a substantive decision on the merits “(i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent’s consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights”.

Here, the Panel notes that the Complainant did not reply to the Respondent’s consent to remedy and further to the Panel’s findings below, the Panel believes the Respondent has acted in bad faith with regards the registration and use of the disputed domain name and thus believes there is a broader interest in recording a substantive decision on the merits.

B. 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 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 Disputed Domain Name <wartsllla.com> incorporate the Complainant's Trademark with the replacement of the letter "i" with letter "l" and an additional letter "l". The second Disputed Domain Name <wartslla.co> incorporate the Complainant's Trademark with the replacement of the letter "i" with letter "l". The intentional misspelling of the word "wartsila" does not alter the fact that the Disputed Domain Names are confusingly similar to the Complainant's Trademark. [WIPO Overview 3.0](#), section 1.9. The Panel finds the mark is recognizable within each of the Disputed Domain Names. Furthermore, it is well established that the TLD ".com" and ".co" in the Disputed Domain Names, may be disregarded for the purposes of assessing confusing similarity under the first element. See section 1.11.1 of the [WIPO Overview 3.0](#). Accordingly, the Disputed Domain Names are confusingly similar to the Complainant's Trademark 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.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondents 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 Respondents' failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)). The Panel considers that the Respondents' emails dated August 1 and 6, 2024 do not constitute a response to the Complainant's contentions and, in any case, do not satisfactorily address the Complainant's arguments under this element. Rather, such emails appear an admission that the relevant Respondent has no rights or legitimate interests in the Disputed Domain Name and was thus not using it for a bona fide offering.

The Panel agrees with the Complainant that there is no evidence to show that the Respondents have trademark rights corresponding to the Disputed Domain Names, or that the Respondents have become known by the Disputed Domain Names. The Panel further notes the distinctiveness and worldwide reputation of the Complainant's Trademark, and the fact that the Complainant has provided no licence or authorization of any kind to the Respondents to use the Complainant's Trademark or to apply for or use any domain name incorporating the Complainant's Trademark. The composition of the Disputed Domain Names carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. The Respondents would likely not have adopted the Complainant's Trademarks if not for the purpose of creating an impression that the Disputed Domain Names are associated with, or originate from, the Complainant.

The Panel also notes that the typo-squatting nature of the Disputed Domain Names highlights the Respondents' intention to confuse Internet users, which cannot constitute fair use.

There is also no evidence to suggest that the Respondents' use of the Disputed Domain Names is in connection with a bona fide offering of goods or services or be regarded as legitimate non-commercial or fair use. The Respondents' Websites, although have become inactive at the time of this decision, were purportedly used to generate revenue for commercial gain via PPC links on the Respondents' Websites. Panels have previously found that the use of a domain name cannot represent a bona fide offering where the sole purpose of the disputed domain name is to resolve to PPC advertising websites and collect click-through revenue from advertising links (see *VKR Holding A/S v. Wu Yu*, WIPO Case No. [D2022-0744](#); see also *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#); and *Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#)).

The Panel also considered the Complainant's contention as to the alleged phishing activities performed by one of the Respondents. The Complainant claimed that such Respondent has purportedly used one of the Disputed Domain Names, <wartsllla.com>, to register scam email addresses (the "Respondent's Email Addresses") and impersonate the Complainant to solicit payments using fake invoices and steal sensitive information from the Complainant's clients. The Panel notes that the purported registration of email addresses using one of the Disputed Domain Names by the Respondent, and the purported production and transmission of fake invoices of the Complainant using the Respondent's Email Addresses may support the Complainant's assertion that the Disputed Domain Name creates a risk that the Respondent is engaged in a phishing or fraudulent scheme by using email addresses impliedly associated with the Complainant (see *Dewberry Engineers Inc. v. WhoisGuard Protected, WhoisGuard Inc / Lindy James, Dreamline*, WIPO Case No. [D2020-2754](#)).

Panels have held that the use of a domain name for illegal activity such as in this case, phishing and impersonation or passing off as the Complainant can never confer rights or legitimate interests on a respondent. [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 Respondents lack rights or legitimate interests in the Disputed Domain Names. The Respondents have 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.

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

D. 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 it is difficult to conceive of any plausible use of the Disputed Domain Names that would amount to good faith use, given that they have incorporated the Complainant's Trademark with deliberate misspellings to create a lookalike domain. See paragraph 4(b)(vi) of the Policy and section 3.1 of the [WIPO Overview 3.0](#). Also, as discussed above, the Respondents lack any rights or legitimate interests in the Disputed Domain Names (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)). Further, the Respondents failed to respond to the Complainant's contentions and have provided no evidence of their actual or contemplated good faith use of the Disputed Domain Names. Panels have previously held that a finding of bad faith can be established where a complainant's trademark is shown to be well-known or in wide use at the time of registration of the disputed domain name (see *LEGO Juris A/S v. store24hour*, WIPO Case No. [D2013-0091](#)). The Respondents are likely to have been fully aware of the Complainant and the Complainant's Trademark when they registered the Disputed Domain Names, given the well-known nature of the Complainant's brand, evidenced by the various trademark

registrations for the Complainant's Trademark across the globe that was put into use well before the Respondents registered the Disputed Domain Names.

While the intention to earn commercial revenue from PPC links is not in and of itself evidence of bad faith, previous panels have found that the use of a domain name deceptively similar to a complainant's trademark to obtain click-through revenue supports a finding of bad faith use (see *VKR Holding A/S v. Wu Yu*, WIPO Case No. [D2022-0744](#)). Given that the Disputed Domain Names incorporate the Complainant's Trademark, the Panel therefore finds it difficult to conceive that the Respondents were not using the Disputed Domain Names to intentionally attract, for commercial gain, Internet users to the Respondent's Websites by creating a likelihood of confusion with Complainant's Trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's Website. The Panel also notes that the Respondents did not respond to the Complainant's cease-and-desist letter dated May 28, 2024, and did not transfer the Disputed Domain Names to the Complainant as requested in the letter.

The Panel notes that the Disputed Domain Names now resolve to inactive websites. Panels have found that the non-use of a domain name 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 Names do 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 Trademarks, the composition of the Disputed Domain Names, and the Respondents' failure to file a Response, and finds that in the circumstances of this case the passive holding of the Disputed Domain Names does not prevent a finding of bad faith under the Policy.

Panels have held that the use of a domain name for illegal activity such as in this case phishing and the impersonation or passing off as the Complainant constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondents' 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 <wartslla.co> and <wartsllla.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: September 27, 2024