

## **ADMINISTRATIVE PANEL DECISION**

Jotun A/S v. Alexey Navalny, Rospil  
Case No. DWS2023-0001

### **1. The Parties**

The Complainant is Jotun A/S, Norway, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Alexey Navalny, Rospil, Russian Federation.

### **2. The Domain Name and Registrar**

The disputed domain name <jotun.ws> is registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2023. On October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 27, 2023, 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 November 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2023. A third party communication was received by the Center on December 8, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on December 8, 2023. 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, established in 1926 in Norway, was initially selling marine paints to shipowners and whaling fleets. Currently the Complainant operates four segments: decorative paints, marine coatings, protective coatings, and powder coatings, and has a strong international presence, with over 10,000 employees across 23 countries, and is present in over 100 countries across six continents.

The Complainant owns worldwide trademark registrations for JOTUN, such as the following:

- the Norwegian Trademark registration No. 59783 for the word mark JOTUN, filed on August 15, 1961, registered on July 5, 1962, covering goods in Nice classes 1, 2, 3, 4, and 5;
- the International Mark registration No. 937270 for the word mark JOTUN, registered on July 23, 2007, covering goods in Nice class 2 and designating numerous jurisdictions worldwide, including Russian Federation; and
- the International trademark registration No. 1083462 for the word mark JOTUN with device element, registered on May 5, 2011, covering goods in Nice classes 1, and 2 and designating numerous jurisdictions worldwide, including Russian Federation.

The Complainant holds and operates the domain name <jotun.com> registered on October 2, 1996.

The disputed domain name was registered on April 1, 2016, and, at the time of filing of the Complaint, it resolved to a website promoting and selling goods and services that compete with the Complainant's offerings, both under the Complainant's trademark, as well as third parties' trademarks. The website under the disputed domain name also depicted the Complainant's JOTUN trademark and logo and had no disclaimer.

#### **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 identical to its trademark; that the Respondent has no rights or legitimate interests in the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith; the Respondent seeks to impersonate the Complainant in a bid to sell products and services that compete with the Complainant's offerings, and which also constitutes a disruption of the Complainant's business and qualifies as bad faith registration and use.

The Respondent is likely using false information in the disputed domain name Whois information, since the pertinent Whois data identifies the Respondent as "Alexey Navalny" and its organization as "Rospil", whereas such names correspond to a public Russian opposition leader and one of its projects.

##### **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions. On December 8, 2023, the Center received a third party communication, including an attachment that contained an excel table in Russian, disclosing the account information for 2023 for "Industrial Coatings LLC". Despite the Center's reply requesting clarification as to the sender's relationship to the disclosed Respondent and the disputed domain name, no further communications were received.

## 6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

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

Based on the available record, the Panel finds 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 entirety of the JOTUN mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, 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. Even if the third party's communication was viewed as being connected to the Respondent, there is nothing in said communication to support any claim of the Respondent's (or the third party's) use of the disputed domain name for *bona fide* offering. Rather, it would seem such communication contained evidence of potential profit that an unrelated, and seemingly competing, third party ("Industrial Coatings LLC") may be earning as a result of the commercial use of the disputed domain name, which does not confer onto the Respondent (or the third party) rights or legitimate interests.

At the time of filing the Complaint, the disputed domain name was used in relation to a website resolving to an online store, promoting various goods, including alleged JOTUN branded goods, as well as third parties' similar goods, reproducing the Complainant's trademark and logo, without providing any disclaimer. Panels have held that the use of a domain name for illegal activity, such as claimed sale of unauthorized or counterfeit goods, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Further, the composition of the disputed domain name, which is identical to the Complainant's trademark, carries a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, 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.

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.

In the present case, the Panel notes that the disputed domain name was registered in bad faith, with knowledge of the Complainant and its trademark particularly because the Complainant's JOTUN trademark and domain name were registered starting at least 1996, and the composition of the disputed domain name which reproduces exactly the Complainant's mark. Furthermore, the use of the disputed domain name enforces such finding.

The Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant's mark.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's distinctive trademark registered and used since at least 1996, the website operated under the disputed domain name displayed the Complainant's trademark, logo, purportedly sells JOTUN branded goods, as well as third parties' competing goods and had no disclaimer, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website was held, controlled by, or somehow affiliated with or related to the Complainant, presumably for the Respondent's commercial gain. Such activities may also disrupt the Complainant's business and tarnish its trademark.

The Respondent has not participated in the present proceeding and provided, very likely, false contact information in the Whois. Such facts, together with all the other elements in this case, supports, in the eyes of this Panel, a finding of bad faith behavior.

Based on the available record, 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 <jotun.ws> be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: December 22, 2023