

ADMINISTRATIVE PANEL DECISION

Wärtsilä Technology Oy Ab. v. reinespsi reinespsi, RT MOTORS
Case No. D2023-3073

1. The Parties

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

The Respondent is reinespsi reinespsi, RT MOTORS, Italy.

2. The Domain Name and Registrar

The disputed domain name <wartsilra.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 July 18, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 2023, 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 (GDPR Masked) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 21, 2023 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 21, 2023.

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 August 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 23, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on September 1, 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 is a Finnish technology corporation operating in the marine and energy markets. The Complainant owns many registered WÄRTSILÄ/WARTSILA trademarks in multiple jurisdictions, including WÄRTSILÄ registered in the United States, Reg No 2078313 registered on July 15, 1997 for goods in class 7; WÄRTSILÄ registered in the European Union with Reg No 000838466 on February 21, 2000 for goods in classes 7, 12, 37; WARTSILA registered in the European Union Trademark with Reg No 011765294, registered on September 18, 2013, in classes 7, 9, 11, 12, 35, 37, 41, and 42; and International registration for WÄRTSILÄ with Reg No 1005789 registered on May 22, 2009 for goods in classes 7, 9, 11, 12, 35, 37, 41, 42.

The Complainant's main website is located at <wartsila.com>, and the Complainant holds a portfolio of a further 400 active domain name registrations. They include domain names that incorporate the Complainant's WARTSILA trademark with ccTLD extensions (e.g., <wartsila.cm>) and registrations with gTLD extensions (e.g., <wartsila.careers>). The Complainant also has an extensive social media presence.

The disputed domain name was registered on February 13, 2023 and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

As of 2021, the Complainant had net sales of EUR4.8 billion with over 17,000 employees. The Complainant started operating in 1834 and now has a strong international presence with operations in over 200 locations across 68 countries. The Complainant's activities concern marine industries and energy and are centered around two businesses: "Wärtsilä Marine" and "Wärtsilä Energy". The Complainant points out that it services marine, and oil and gas business clients with innovative and environmentally sustainable technologies. It provides energy management and storage solutions as well as services to improve the efficiency of power plants.

The Complainant says that due to its marketing and promotion, the WÄRTSILÄ/WARTSILA mark has acquired distinctiveness worldwide with customers that rely on the brand's name and quality. It also uses that term as a prominent part of its logo, which contains a device element.

The Complainant contends that by virtue of its trademark registrations for the WARTSILA mark it has satisfied the requirement under the Policy of holding a right in the WÄRTSILÄ/WARTSILA term.

The Complainant maintains that the test of "identical or confusingly similarity" for the purposes of paragraph 4(a)(i) should be adjudicated by utilizing a side-by-side comparison to decide "whether the alphanumeric string comprising the challenged domain name[s] [are] identical ... or sufficiently approximate [the trademark]" (quoting from *Advanced Magazine Publishers Inc. d/b/a Conde Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. [D2007-1743](#)). The Complainant points out that the disputed domain name matches its WARTSILA trademark but for the addition of an "r", and amounts to a typical example of typosquatting. It says that the Respondent deliberately chose to mistype the Complainant's mark and that the addition of the letter 'r' is not sufficient to distinguish the disputed domain name from the Complainant's trademark. The generic top-level domain (gTLD) should be discarded for the sake of comparison, in line with established Panel practice, the Complainant says.

The Complainant also contends that the Respondent lacks rights or legitimate interests in the disputed domain name as he does not have registered or unregistered trademark rights in WARTSILA or WARTSILRA or any other part of the disputed domain name. The Respondent has not received any authority from the Complainant to use the WARTSILA trademark and is not offering goods or services from the disputed domain name. The made-up term “wartsila” is not a phrase a trader would legitimately choose unless seeking to create an impression of association with the Complainant, the latter maintains, and it also says that it has evidence that the disputed domain name has been used to carry out phishing activity by way of scam emails using the email addresses: [...]@wartsilra.com; [...]@wartsilra.com; [...]@wartsilra.com, and [...]@wartsilra.com in which the Respondent was pretending to be employees of the Complainant in order to solicit money transfers from customers of the Complainant. According to the Complainant, the Registrar suspended the disputed domain name as a result, and it maintains that this type of illegal activity can never vest rights or legitimate interests in its perpetrator. To the best of the Complainant’s knowledge, the Respondent is not commonly known by the distinctive term WÄRTSILÄ/WARTSILA, “wartsilra”, nor any similar term. Therefore, the Complainant says, there is no plausible reason for the registration and use of the disputed domain name, other than to take advantage of the goodwill and reputation attached to the WÄRTSILÄ/WARTSILA mark.

The Complainant also points out that its trademark is distinctive and has no common or generic use and there is no evidence that the Respondent intends to use the disputed domain name in any manner other than to target the Complainant. Phishing scams are not legitimate noncommercial or fair use.

Further, the Complainant points out that its trademark registrations predate the registration date of the disputed domain name by almost 25 years and substantial goodwill has accrued since the Complainant’s establishment. The Complainant maintains that the WÄRTSILÄ/WARTSILA trademark has become well-known for energy and marine services, and searching “wartsila” on popular Internet search engines produces the Complainant’s brand and services as the first result. Moreover, the Complainant says, an average Internet user has access to WÄRTSILÄ/WARTSILA trademark registrations, as they can be found on public trademark databases. The Complainant points out that the Respondent has engaged in “typosquatting”, targeting the Complainant in the hope of catching Internet users that misspell the Complainant’s main platform name at <wartsila.com>, tactics that indicate bad faith registration. Further, the disputed domain name was used to intentionally mislead the Complainant’s customers and make a commercial gain by purporting to be the Complainant and transmitting phishing emails as such. The Respondent is using the disputed domain name to impersonate employees of the Complainant and intercept payments that are intended for the Complainant. The Complainant also says that the disputed domain name resolving to an inactive website webpage has been recognised as resulting in a real risk of consumer confusion that could lead online users to believe that the Complainant’s services are inoperable, which would damage their trust in the Complainant.

In a final submission the Complainant points out that passive holding does not preclude a finding of bad faith use, as has been repeatedly held by past Panels. The Complainant says it has a strong reputation in the trademark WARTSILA within its sector, and that the WARTSILA term itself has no ordinary or dictionary meaning.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is not strictly speaking identical to the WARTSILA registered trademark of the Complainant but differs only by the almost unnoticeable addition of an “r”. The Complainant’s registered trademark is thus immediately recognizable in the disputed domain name, which is sufficient to satisfy the

first element of the Policy in terms of confusing similarity. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

Therefore, the Panel holds that the disputed domain name is confusingly similar to the WARTSILA registered trademark of the Complainant.

B. Rights or Legitimate Interests

The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the latter has not countered the Complainant’s contentions in this regard. The Respondent, is not known by the disputed domain name or the term “warsila” or anything remotely similar, and there is no evidence that he acquired any rights in that term by way of registration or legitimate use. The Complainant did not authorize the use of its registered mark by the Respondent or its incorporation in the disputed domain name. The Complainant points to evidence of phishing by impersonating officers of the Complainant and so attempting to obtain a financial advantage from unsuspecting consumers. This is a dishonest activity and therefore not one that results in a legitimate claim of rights or interests on the part of a party, such as the Respondent in this matter, that engages in it. See section 2.13 of the [WIPO Overview 3.0](#).

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant’s trademark is highly distinctive and had been in use and also registered for a very long time before the Respondent registered the disputed domain name. It is highly improbable that he stumbled on this term by chance and in any case a quick Google check or review of trademark registers would readily reveal the Complainant’s prior rights. The inclusion of a typosquatting type of variation, deliberately close and almost unnoticeable, further indicates that the Respondent was perfectly well aware of the Complainant’s rights and goodwill vested in the WARTSILA trademark, which has a worldwide presence and reputation. Further, according to evidence on record, the Respondent has taken advantage of his registration of the disputed domain name to impersonate officers of the Complainant and engage in a phishing exercise. The latter is fraudulent and dishonest and relies on deception of customers of the Complainant, and is thus clearly use in bad faith of the disputed domain name which includes that same Complainant’s distinctive trademark.

Therefore, the Panel holds that the disputed domain name was registered and used in bad faith.

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 <warsilra.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: September 15, 2023