

## **ADMINISTRATIVE PANEL DECISION**

Wartsila Technology Oy Ab v. David Larson  
Case No. D2023-3074

### **1. The Parties**

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

The Respondent is David Larson, United States of America (“United States”).

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

The disputed domain name <wartsila-com.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 19, 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 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 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 15, 2023.

Due to an administrative oversight, the Center’s notification emails were not copied to the Respondent at muhammad.appleseed1@mail.ru. The center re-notified the Respondent of the Complaint on August 22, 2023. The due date for Response was August 27, 2023. The Respondent did not submit any response. Accordingly, the Center re-notified the Respondent’s default on August 28, 2023.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on August 31, 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 in this administrative proceeding is Warsila Tecnonology, a Finnish corporation established in 1834. Currently operates in the field of smart technologies and complete lifecycle solutions for the marine an energy markets. With more than 17 000 employees, the Complainant has a strong international presence with operation in 68 countries.

The Complainant owns WÄRTSILÄ and WARTSILA trademarks in number of jurisdictions. As such:

- United States Trademark Registration for WÄRTSILÄ with registration number 2078212 and registration date July 15, 1997
- European Union Trademark Registration for WÄRTSILÄ with registration number 000838466 and registration date February 21, 2000.
- European Union Trademark Registration for WARTSILA with registration number 011765294 and registration date September 18, 2013.

The Complainant owns a portfolio of domain names in connection to the above mentioned mark. As such: <wartsila.com> registered on January 5, 1996 or <wartsila.carreers> registered February 24, 2014.

The disputed domain name was registered on March 5, 2023 and is inactive. The Complainant sent a cease and desist letter on April 12, 2023 to the Respondent who did not answer.

#### **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 in reference to the third element that the Respondent has engaged in a pattern of abusive conduct by registering other domain names that include third-party trademarks that satisfies the requirements set in paragraph 4(b)(ii) of the Policy against the Respondent.

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

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

#### **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel 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 respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a substantive Response. This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

### **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 mark WARTSILA is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, hyphen plus the term "com" may bear on assessment of the second and third elements, the Panel finds the addition of such term do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Likewise, the Panel refers to the [WIPO Overview 3.0](#), section 1.11.1: "The applicable Top Level Domain ('TLD') in a domain name [...] is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test".

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.

While 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 often impossible 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. 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 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.

Indeed, none of the examples of the respondent rights enumerated in the Policy apply in the present case. 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.

In the present case, the Panel notes that the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct as set out in paragraph 4(b)(ii) of the Policy. See *Safran v. David Larson*, WIPO Case No. [D2023-2258](#); or *Accor v. David Larson*, WIPO case No. [D2020-1680](#).

Further, 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 record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While 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, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, the failure of the Respondent to submit a response, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name do not prevent a finding of bad faith under the Policy.

Besides, the Panel notes section 3.1.4 of [WIPO Overview 3.0](#) where: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or, widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith”.

Based on the available record, the Panel finds the third element of the Policy has been established.

### **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 <wartsila-com.com> be transferred to the Complainant.

*/Manuel Moreno-Torres/*

**Manuel Moreno-Torres**

Sole Panelist

Date: September 14, 2023