

ADMINISTRATIVE PANEL DECISION

DNA Oyj v. IngramRacks, Maliah Ingram
Case No. D2023-4077

1. The Parties

The Complainant is DNA Oyj, Finland, represented by Castrén & Snellman, Finland.

The Respondent is IngramRacks, Maliah Ingram, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dna-palvelua.com> is registered with Nicenic International Group Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 28, 2023. On September 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 30, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 16, 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 amendment to the Complaint on October 19, 2023.

The Center verified that the Complaint together with the amendment to 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 October 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 10, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on December 18, 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 one of the leading telecom service providers and the largest cable TV operator in Finland, offering voice, data, and television services, as well as IT-related goods and services for consumer and corporate customers. Its 4G LTE network covers 99% of the population of Finland, and its 5G network covers 80% of the same population.

The Complainant is the owner of the following trademark registrations for the sign “DNA” (the “DNA trademark”):

- the European Union trademark DNA with registration No. 010326809, registered on April 24, 2012 for goods and services in International Classes 9, 16, 35, 38, 41 and 42. A cancellation proceeding against this trademark registration is currently pending before the European Union Intellectual Property Office; and
- the International trademark DNA with registration No. 1313766, registered on August 31, 2016 for services in International Class 38.

The Complainant is also the owner of the domain name <dna.fi> registered on September 12, 2008, which resolves to its official website.

The disputed domain name was registered on July 20, 2023. It is currently inactive. At the time of filing of the Complaint, the disputed domain name directed to a website that featured the Complainant’s figurative trademark DNA, included the same color schemes as the official website of the Complainant, and referred to services offered by the Complainant. The website also offered visitors the option to download certain software.

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.

It states that the disputed domain name is confusingly similar to the DNA trademark, because it contains the trademark connected by a hyphen to the Finnish word “palvelua”, which means “service” in English.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has no relations with the Complainant or with any of its business activities. The Complainant states that it has never given consent to the Respondent to use or register the disputed domain name or to use the DNA trademark. According to the Complainant, the Respondent has registered and used the disputed domain name to confuse and misleadingly divert Internet users to its own website.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It points out that the website at the disputed domain name refers to services supplied by the Complainant and protected with the DNA trademark which has reputation in Finland, and contains misleading references to mobile subscriptions, Internet, 5G, and data security. The Complainant also points out that the associated website encourages visitors to download a file by clicking a separate tab, whereby the downloaded file will spread malware on the device of the downloader. The Complainant maintains that the Respondent has mimicked the website of the Complainant and has used the figurative trademark DNA of the Complainant,

where its magenta pink color is also a trademark with a reputation in Finland. The Complainant adds that the color schemes and the drop-down menus on the website at the disputed domain name are identical to those used by the Complainant on its own website. According to the Complainant, the Respondent also misleadingly refers to the DNA stores operated by the group of the Complainant, thus creating a false impression of a business connection. The Complainant also points out that the website to which the disputed domain name leads is flagged as deceptive by Internet browsers.

B. Respondent

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

6. Discussion and Findings

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 the DNA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The fact that cancellation proceedings are pending in respect of some of the registrations of this trademark does not affect this finding, as these registrations currently remain valid.

The Panel finds the DNA trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the DNA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "palvelua", a Finnish word meaning "service" in English) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the DNA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation of the Complainant and distribution of malware) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The evidence shows that the website at the disputed domain name has indeed featured the Complainant's DNA trademark with its distinctive magenta color and that its design copied many of the features of the Complainant's website. These identical elements create a high risk of impersonation of the Complainant. The Respondent's website also offered visitors the option to download a file, which the Complainant states is malware. This has not been disputed by the Respondent, and when an attempt is made to access the Respondent's website, Internet browsers treat it as deceptive and block the access. This is sufficient for a finding that the website at the disputed domain name is unsafe and may indeed be distributing malware. The use of the disputed domain name in such manner cannot give rise to rights or legitimate interests of the Respondent in the disputed domain name.

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.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation and distribution of malware) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Respondent's website features the DNA trademark and copies the design of the Complainant's website, which increases the likelihood that Internet users may mistakenly believe that it belongs to the Complainant. At the same time, Internet browsers treat it as deceptive, and it likely attempts to distribute malware.

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 <dna-palvelua.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: January 1, 2024