

## **ADMINISTRATIVE PANEL DECISION**

Tesla, Inc. v. Tomasz Grochowski (PMOFFICE53500)  
Case No. D2023-5118

### **1. The Parties**

The Complainant is Tesla, Inc., United States of America (“United States”), represented by JWP Patent & Trademarks Attorneys, Poland.

The Respondent is Tomasz Grochowski (PMOFFICE53500), Poland.

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

The disputed domain name <teslawarszawa.com> is registered with Ascio Technologies Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 7, 2023. On December 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 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 (MOBIPROJECT Sp. z o.o.) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 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 December 14, 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 December 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2024.

The Center appointed Assen Alexiev as the sole panelist in this matter on February 2, 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 an automotive and clean energy company which designs, manufactures and sells electric vehicles, stationary battery energy storage devices, solar panels and related products and services.

The Complainant is the owner of numerous trademark registrations for the sign “TESLA” (the “TESLA trademark”), including the following:

- the United States Trademark TESLA (word) with registration No. 4443472, registered on December 3, 2013 for goods in International Class 12;
- the International Trade mark TESLA (word) with registration No. 1162462, registered on April 24, 2013 for goods and services in International Classes 9, 12, 36 and 37; and
- the European Union Trade Mark TESLA (figurative) with registration No. 014456917, registered on May 16, 2016 for goods and services in International Classes 9, 37 and 42.

The disputed domain name was registered on November 20, 2016. It redirects to the Polish language website at “www.teslawynajem.pl”, which promotes rental services for Tesla cars. That website describes the provider of the rental services as “Wyjątkowa wypożyczalnia Tesli – pierwsza w Polsce i jedyna, która oferuje Teslę z pakietem Performance” (translated in English as: “unique Tesla rental company – the first in Poland and the only one to offer a Tesla with a Performance package”). The Privacy Policy on the website at “https://teslawynajem.pl/polityka-prywatnosci/” states that “Administratorem danych osobowych zbieranych za pośrednictwem strony internetowej teslawynajem.pl. jest Tesla Polska sp. z o.o.” (in English: “The controller of personal data collected through the website teslawynajem.pl. is Tesla Polska sp. z o.o.”) There is no disclaimer on the website for the lack of relationship with the Complainant.

#### 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.

The Complainant states that the disputed domain name is confusingly similar to its TESLA trademark, because it consists of the trademark followed by the element “warszawa”, which indicates the city of Warsaw in Poland (its Polish name is “Warszawa”).

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because there is no relation between the Parties and the Respondent has not obtained an authorization to use the Complainant’s TESLA trademark and company name.

The Complainant submits that the Respondent is a shareholder and former President of the Management Board of MOBIPROJECT Sp. z o.o., the current registrant of the domain name <teslawynajem.pl>, to which the disputed domain name redirects. Until October 2023, the addresses of the Respondent and of MOBIPROJECT Sp. z o.o. were identical. The Complainant adds that MOBIPROJECT Sp. z o.o. is also affiliated with TESLA POLSKA Sp. z o.o. (formerly Redexperts Services Sp. z o.o.), on behalf of which a response was made to the cease-and-desist letter by the Complainant, which was addressed to these two companies in respect of the use of the disputed domain name and of the domain name <teslawynajem.pl>.

According to the Complainant, the above shows that there are links between the Respondent and these two companies, justifying the conclusion that the Respondent is responsible for the content of the website at “www.teslawynajem.pl”, which promotes rental services for Tesla cars.

According to the Complainant, the Respondent chose the disputed domain name to promote its own services and attract Internet users to the website to which the disputed domain name redirects by making them believe that they were visiting a website affiliated to the Complainant, thus exploiting the Complainant’s global recognition, while avoiding the necessary investment into its own promotion and marketing.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that the Respondent was likely aware that a domain name that is confusingly similar to the TESLA trademark would be more useful for this purpose. In the Complainant’s view, by registering and using the disputed domain name, the Respondent intentionally took advantage of its similarity with the Complainant’s TESLA trademark. According to the Complainant, the Respondent’s selection of the TESLA sign was made to intentionally attempt to attract, for commercial gain, Internet users to the website to which the disputed domain name redirects, by creating a likelihood of confusion with the Complainant’s TESLA trademark and company name as to the source, sponsorship, affiliation, or endorsement of that website and of the car rental services offered there.

## **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.

The Complainant has shown rights in respect of the TESLA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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

Although the addition of other terms (here, “Warszawa”, the Polish name of the city of Warsaw) 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 TESLA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel therefore 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.

The evidence shows that the disputed domain name redirects visitors to a website that promotes rental services for Tesla cars. Although not brought forward by the Respondent, this raises the question of whether the Respondent might be regarded as having a legitimate interest in the disputed domain name on the basis of the "Oki Data test". As discussed in section 2.8.1 of the [WIPO Overview 3.0](#), Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., "parts", "repairs", or "location"), whether at the second-level or the top-level.

Here, the disputed domain name's composition follows this exact format, as it includes the Complainant's TESLA trademark and the Polish name of the city of Warsaw.

Applying the requirements of the Oki Data test, the Panel finds that the website at "www.teslawynajem.pl", to which the disputed domain name redirects, does not properly disclose whether there is any relationship between the provider of the website and the Complainant. The website describes the provider of the services as a "unique Tesla rental company – the first in Poland and the only one to offer a Tesla with a Performance package", while the Privacy Policy published on the same website states that the controller of personal data collected through the website is the company Tesla Polska sp. z o.o. As noted by the Complainant, there is a link between the Respondent, the registrant of the domain name <teslawynajem.pl>, and the company Tesla Polska sp. z o.o., but neither of them is related to the Complainant. The website to which the disputed domain name redirects thus creates a misleading impression that the provider of the rental services promoted on it is related to the Complainant, and there is no disclaimer to inform otherwise. Considering this, the Panel finds that the Respondent has not taken steps to accurately and prominently disclose its lack of relationship with the Complainant, who is the holder of the TESLA trademark. Therefore, the Respondent's conduct does not comply with the requirements of the Oki Data test, and the Respondent cannot be regarded as having a legitimate interest in the disputed domain name on its basis.

The Panel therefore 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.

The Panel notes that the Respondent is using the disputed domain name to redirect to a website that offers rental services for Tesla cars. It is clear from this that the Respondent is well aware of the Complainant and of its TESLA trademark. As discussed in the Section 6B on rights and legitimate interests, the website to which the disputed domain name redirects creates a misleading appearance that the provider of the rental services is related to the Complainant, and does not contain any disclaimer for the lack of such relationship. In view of this, and in the lack of any arguments or evidence by the Respondent pointing to a different conclusion, the Panel accepts that it is more likely than not that by registering and using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name redirects, by creating a likelihood of confusion with the Complainant's TESLA trademark as to the source or affiliation of the rental services offered on this website. This supports a finding of bad faith registration and use of the disputed domain name under paragraph 4(b)(iv) of the Policy.

On this basis, 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 <teslawarszawa.com> be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: February 16, 2024