

ADMINISTRATIVE PANEL DECISION

Stora Enso Oyj v. Sail Gener, Gener
Case No. D2024-0482

1. The Parties

The Complainant is Stora Enso Oyj, Finland, represented by CSC Digital Brand Services AB, Sweden.

The Respondent is Sail Gener, Gener, Germany.

2. The Domain Name and Registrar

The disputed domain name <storaenso.site> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2024. On February 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 1, 2024, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 2024, 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 February 5, 2024.

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 February 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 6, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on March 14, 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 develops and produces solutions based on wood and biomass for a range of industries and applications worldwide, leading in the bioeconomy and supporting customers in meeting demand for renewable eco-friendly products.

The Complainant was formed by the merger of Swedish mining and forestry products company Stora and Finnish forestry products company Enso Oyj in 1998.

The Complainant currently has approximately 21,000 employees and reported revenues of EUR 11.7 billion in 2022. The Complainant's shares are listed on Nasdaq Helsinki Oy (STEAV, STERV) and Nasdaq Stockholm AB (STE A, STE R). In addition, the shares are traded in the United States of America ("United States") as ADRs and Ordinary Shares (SEOAY, SEOFF, SEOJF).

The Complainant maintains a strong online presence through the use of its primary domain name <storaenso.com> created on March 29, 1999.

The Complainant is the owner of trademark registrations across various jurisdictions, including the following:

- European Union Trademark Registration No. 001210640 for STORA ENSO, registered on September 20, 2009, for goods in International Classes 1, 16, and 19;
- European Union Trademark Registration No. 007576036 for STORA ENSO, registered on December 22, 2009 for goods and services in International Classes 2, 3, 4, 5, 17, 40, and 42;
- United States Trademark Registration No. 5838504 for STORA ENSO, registered on August 20, 2019 for goods and services in International Classes 1, 16, 19, 40, and 42.

On December 14, 2023, the Complainant sent the first cease and desist letter to the Respondent with further two reminders, which cease and desist letter remained unanswered.

The disputed domain name was created on October 9, 2023, in the name of a privacy service and resolves to an inactive page.

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.

Identical or Confusingly Similar

The Complainant contends that the disputed domain name and the STORA ENSO trademark are identical or confusingly similar.

According to the Complainant's contentions, the disputed domain name incorporates the Complainant's STORA ENSO trademark in full followed by the generic Top-Level Domain ("gTLD") ".site", which is of no relevance for the confusion similarity test.

No Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

According to the Complainant's contentions, the Respondent is not commonly known by the disputed domain name, has not used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name.

The Complainant asserts that the Respondent has failed to make use of the disputed domain name and has not demonstrated any attempt to make legitimate use of the disputed domain name and website, which evinces a lack of rights or legitimate interests in the disputed domain name.

The Complainant further submits that the disputed domain name has been registered long after registration of the Complainant's STORA ENSO trademark.

Registered and Used in Bad Faith

The Complainant claims that the disputed domain name has been registered and used to cause confusion among Internet users as to the source of the disputed domain name.

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith. The Respondent must have been aware of the Complainant's STORA ENSO trademark when it registered the disputed domain name.

The Complainant further asserts that the passive holding of the disputed domain name demonstrates the Respondent's bad faith.

The Complainant contends that using the privacy service, non-submission of the response to the cease and desist letters shall be considered factors supporting bad faith registration and use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- i. that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. that the disputed domain name has been registered and is being used in bad faith.

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted and in accordance with the Policy and the Rules.

Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

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.

Ownership of a nationally or regionally registered trademark serves as prima facie evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the [WIPO Overview 3.0](#). The Complainant submitted evidence that the STORA ENSO trademark enjoys protection under national, regional, and international trademark registrations. Thus, the Panel finds that the Complainant’s rights in the STORA ENSO trademark have been established pursuant to the first element of the Policy.

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 entirety of the 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.

Section 1.11.1 of [WIPO Overview 3.0](#) states: “The applicable TLD in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”. The gTLD “.site” will therefore be discounted in the Panel’s consideration of confusing similarity.

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.

Based on the case filing, the Panel establishes that there is no evidence that the Respondent is a licensee of, or otherwise affiliated with, the Complainant, and apparently, it has not been authorized by the Complainant to use its STORA ENSO trademark.

Based on the present case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

At the time of filing the Complaint, the Respondent was using a privacy Whois service, which past panels have also found to equate to a lack of legitimate interest. See *Jackson National Life Insurance Company v. Private Whois www.jacksonnationallife.com N4892*, WIPO Case No. [D2011-1855](#) (“The Panel concludes that the Respondent possesses no entitlement to use the name or the words in the Complainant’s marks and infers [...] from the “Private Whois” registration that it is not known by such name. There is no evidence of the Respondent ever being commonly known by the name or words now included in the disputed domain name.”).

There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial fair use or a bona fide offering of goods or services.

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 disputed domain name does not resolve to an active website. Prior UDRP panels have found that the passive holding of a disputed domain name is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#); *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#) “The passive holding of the disputed domain name does not amount to use or preparations to use it in connection with a bona fide offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.”.

The Panel agrees and holds the passive holding of the disputed domain name by the Respondent in this case as evidence that the Respondent has not registered the disputed domain name in connection with any bona fide offering of goods or services.

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.

The Complainant has produced evidence showing that it owns registrations for the STORA ENSO trademark, of which registration date significantly precedes the registration date of the disputed domain name.

In addition, the Complainant has credibly submitted that over the years it has developed substantial goodwill in the STORA ENSO trademark.

Taking the above facts into consideration, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

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 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 available 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. Although 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, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, 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 does not prevent a finding of bad faith under the Policy.

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 <storaenso.site> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: April 3, 2024