

## ADMINISTRATIVE PANEL DECISION

Wartsila Technology Oy Ab v. Name Redacted  
Case No. D2024-1206

### 1. The Parties

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

The Respondent is Name Redacted.<sup>1</sup>

### 2. The Domain Name and Registrar

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

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 20, 2024. On March 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 21, 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 March 22, 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 March 22, 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”).

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<sup>1</sup> The Respondent appears to have used contact details of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this Decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this Decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Center received an email communication from a third party on April 5, 2024, indicating that the Written Notice was sent to its physical address but it had not registered the disputed domain name and it has nothing to do with the disputed domain name. On April 19, 2024, the Center informed the Parties that it would proceed with panel appointment.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on April 26, 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**

It results from the Complainant's undisputed allegations that it is a Finnish corporation which operates in the field of smart technologies and complete lifecycle solutions for the marine and energy markets. The Complainant was established and has been operating continually since 1834. It has a strong international presence with operations in over 280 locations across 79 countries, with power plants in locations including but not limited to "Hungary, Texas, Indonesia, Kenya, the United Kingdom, and the Caribbean". In addition, the Complainant has developed relationships with countries worldwide including the United States of America ("USA"), the Republic of Korea, the United Arab Emirates, and Indonesia. Specifically, the Complainant has a subsidiary in Italy named Wartsila Italia. It currently has over 1,000 employees in said Italian subsidiary with offices in Genoa, Naples, and Taranto.

It operates its main website at "www.wartsila.com" for advertising its products and services.

The Complainant is the registered owner of many trademarks consisting and/or containing the term "Wartsila", e.g. European Union trademark registration no. 011765294 WARTSILA, registered on September 18, 2013, for goods and services in classes 7, 9, 11, 12, 35, 37, 41, and 42; USA registration no. 2078313 WÄRTSILÄ registered on July 15, 1997, for goods in class 7.

The disputed domain name was registered on January 17, 2024. The undisputed evidence provided by the Complainant proves that the disputed domain name 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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its trademark since it encompasses the WARTSILA mark entirely with the addition of the geographical indicator "Italia" (Italian for Italy). The addition of the geographical indicator "Italia" is not sufficient to alleviate the likelihood of confusion between the Complainant's WARTSILA mark and the disputed domain name. On the contrary, it only reinforces the connection with the Complainant given its subsidiary Wartsila Italia. It further contents that its trademark is distinctive and well known.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent has not received any license from the Complainant to use a domain name featuring the WÄRTSILÄ/WARTSILA trademark. Currently, the disputed domain name resolves to an error webpage with no active content. As such, it is being passively held. The non-use of a domain name is considered by panels not to be a bona fide offering of goods or services. To

the best of the Complainant's knowledge, the Respondent is not commonly known by the distinctive term WÄRTSILÄ/WARTSILA. Therefore, there is no plausible reason for the registration and use of the disputed domain name, other than the motive of taking advantage of the goodwill and reputation attached to the WÄRTSILÄ/WARTSILA mark.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, its trademark registrations predate the creation date of the disputed domain name by many years. In addition, substantial goodwill has accrued since the Complainant's establishment; the WÄRTSILÄ/WARTSILA name has become well-known for energy and marine services. Thus, the Respondent registered the disputed domain name with the primary intention of taking advantage of the Complainant's brand. Finally, the Complainant notes the Respondent's activation of mail exchange (MX) records for the disputed domain name. The Complainant emphasizes the risk that could have been caused to unsuspected customers of the Complainant on receipt of emails from the disputed domain name.

## **B. Respondent**

Except for the email communication from a third party mentioned under section 3. above, the Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to "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 requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### **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 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 confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "italia", 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 mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Moreover, the Panel notes that the disputed domain name contains the Complainant’s registered trademark and a geographic term “italia” (corresponding to Italy in English). The nature of this disputed domain name carries a risk of implied affiliation: in fact, geographic terms are seen as tending to suggest sponsorship or endorsement by the trademark owner. This is particularly true in this case because the Complainant has a subsidiary in Italy named Wartsila Italia. [WIPO Overview 3.0](#) at section 2.5.1.

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, based on the evidence submitted by the Complainant, this Panel has no doubt that the Respondent knew or should have known that the disputed domain name consisted of the Complainant’s trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant’s registered trademark (plus a geographical term), and corresponds to the Complainant’s subsidiary’s name in Italy, and the Complainant’s trademarks have existed and been used for many years.

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.

The disputed domain name does not resolve to an active website. 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 the failure of the respondent to submit a response and the use of false contact details (given third party's communication received by the Center regarding the claimed unauthorized use of its contact details in relation to the disputed domain name in the present proceedings) 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.

In addition, the Panel finds that the presence of MX records related to the disputed domain name may be considered as further evidence of bad faith.

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 <wartsilaitalia.com> be transferred to the Complainant.

*/Tobias Malte Müller/*

**Tobias Malte Müller**

Sole Panelist

Date: May 10, 2024