

ADMINISTRATIVE PANEL DECISION

Wartsila Technology Oy Ab v. tools tools
Case No. D2024-2578

1. The Parties

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

The Respondent is tools tools, United States of America (“US”).

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 25, 2024. On June 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 25, 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 June 26, 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 June 27, 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 July 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 21, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 22, 2024.

The Center appointed Ike Ehiribe as the sole panelist in this matter on August 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 a Finnish corporation which operates in the field of smart technologies and complete lifecycle solutions for the marine and energy markets. The Complainant had net sales of EUR 6 billion with over 17,000 employees in the year of 2023. The Complainant is said to have a strong international presence with operations in over 280 locations across 79 countries, with power plants in locations not limited to Hungary, US, Indonesia, Kenya, the United Kingdom, and the Caribbean. The Complainant it is also said has developed relationships with countries worldwide including the US, Republic of Korea, the United Arab Emirates, and Indonesia. The Complainant it is said was established since 1834 and in its early years operated as a sawmill and iron works company before moving into other fields and began producing commercial engines in 1959. By the year 2001 it is said that the Complainant expanded into bio power and was later deemed among the 1,000 most sustainable corporations in the world.

The Complainant, its affiliates, subsidiaries, and associated companies own trademarks for the WARTSILA mark across a number of jurisdictions. For instance: (i) US Trademark No. 2078313 in class 7 registered on July 15, 1997; (ii) European Union Trademark registration No. 008304149 in classes 7, 9, 11, 12, 35, 37, 41 and 42, registered on November 25, 2009; and (iii) International Trademark registration No. 1005789 in classes 7, 9, 11, 12, 35, 37, 41, and 42 registered on May 22, 2009. The Complainant operates from its main domain name <wartsila.com> which it uses to advertise its products and services and holds a portfolio of over 400 active domain name registrations. The Complainant has also established a social media presence and uses the WARTSILA mark to promote its services on Facebook, X, (formerly known as Twitter), Instagram, LinkedIn and YouTube.

The Respondent is said to be based in the US. The Disputed Domain Name was created on May 6, 2024, according to the Whois record.

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 submits that upon a visual comparison of the Disputed Domain Name with the Complainant's WARTSILA mark the Panel would find that the requirement of confusing similarity has been established for the purposes of paragraph 4(a)(i) of the UDRP policy. See *Advanced Magazine Publishers Inc. d/b/a Conde Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. [D2007-1743](#).

In addition, the Complainant contends that the Disputed Domain Name is confusingly similar to the Complainant's WARTSILA trademark considering that the Disputed Domain Name consists of a common, obvious and intentional misspelling of the Complainant's WARTSILA trademark. The Complainant asserts that the Respondent has simply registered a lookalike domain name by replacing the letter "r" with the letter "t" which is a practice known as "typosquatting". It is further asserted that the small changes made to the WARTSILA term are insufficient to distinguish the Disputed Domain Name from the Complainant's trademark as Internet users may easily mistype or misread the Disputed Domain Name as matching the Complainant's trademark by mistake. See *Sanofi v. Domains By Proxy, LLC/ domain admin*, WIPO Case No. [D2013-0368](#).

The Complainant further contends that the generic Top-Level Domain (“gTLD”) “.com” should be disregarded by the Panel when conducting a confusing similarity test as it is a standard registration requirement following previous UDRP decisions including *Facebook Inc. v. S. Demir Cilingir*, WIPO Case No. [D2018-2746](#).

The Complainant further contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name considering that in the first instance and to the Complainant’s knowledge the Respondent does not have any trademark or unregistered trademark rights in the term WARTSILA. Secondly, the Respondent has not received any license from the Complainant to use domain names featuring the WARTSILA trademark. Thirdly, the Complainant submits that the Respondent is not offering any goods or services from the Disputed Domain Name as the Disputed Domain Name does not resolve to a webpage and is therefore currently held passively. Fourthly, the Complainant contends that within 10 days of registering the Disputed Domain Name, the Respondent posed as one of the Complainant’s employees in order to send phishing emails to one of the Complainant’s clients in an attempt to obtain payment on an allegedly outstanding invoice. It is said that the Complainant’s actions in this regard spoofed the Complainant’s official domain name <wartsila.com>. Fifthly, to the best of the Complainant’s knowledge the Respondent is not commonly known by the distinctive term WARTSILA therefore, the Respondent’s motive for registering the Disputed Domain Name is to take advantage of the goodwill and reputation attached to the Complainant’s WARTSILA mark.

On the question of bad faith registration and use, the Complainant submits that the Respondent registered the Disputed Domain Name in bad faith and has continued to engage in bad faith use on the following grounds. In the first instance, it is submitted that the Complainant’s trademark registrations predate the creation of the Disputed Domain Name in May 2024 since the Complainant has been in the frontier of engineering innovations for 190 years. The Complainant argues further that given the long use and reputation of the Complainant’s trademark, the Respondent must have been aware of the Complainant’s rights as at the time of registration of the Disputed Domain Name. Secondly, it is submitted that the Respondent deliberately created the Disputed Domain Name so that the Respondent could engage in fraudulent activities as evidenced by the use of the Disputed Domain Name to host an email address designed to appear closely similar to the Complainant’s trademark. Thirdly, the Respondent has utilised the Disputed Domain Name for commercial gain by purporting to be the Complainant and misleading the recipient of the fraudulent email into believing that the email was legitimate. See in this regard *BHP Billiton Innovation Pty Ltd v. Domains By Proxy. LLC / Douglass Johnsons*, WIPO Case No. [D2016-0364](#).

B. Respondent

The Respondent did not reply to the Complainant’s contentions and therefore the Panel shall draw such adverse inferences from the Respondent’s failure to respond as may be deemed appropriate.

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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the Disputed Domain Name despite the inversion of the letters “t” and “r”. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. and 1.9 on misspellings.

It is permissible in the present circumstances to disregard the gTLD component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

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 such as phishing, impersonation, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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, the Panel notes that the Respondent *intentionally* attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant’s mark.

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 such as phishing, impersonation, or other types of fraud 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 Panel’s finding in this regard is further supported by the fact that following the Respondent’s phishing attack, the Complainant filed a phishing abuse complaint with the Registrar on May 16, 2024. The said complaint resulted in the Registrar placing the Disputed Domain Name in clientHold status.

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. [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 current 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 <watsrila.com> be transferred to the Complainant.

/Ike Ehiribe/

Ike Ehiribe

Sole Panelist

Date: August 16, 2024