

ADMINISTRATIVE PANEL DECISION

Tüv Nord AG v. Name Domain Administrator
Case No. D2022-4585

1. The Parties

The Complainant is TüvNord AG, Germany, internally represented.

The Respondent is Domain Administrator, Registrant of tuviran.com, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <tuviran.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2022. On December 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 2, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Center received an email communication from Atak Domain & Hosting on December 8, 2022. The Complainant filed the first amended Complaint on December 8, 2022 and the second amended Complaint on December 13, 2022.

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 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on January 23, 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 provides certification, safety and technology advisory services in more than 100 countries.

The Complainant, in addition to others, is the owner of the following trademark registrations:

- German trademark registration No. 1005638 for the word mark TÜV, filed on October 29, 1979, registered on July 28, 1980, subsequently renewed, in classes 41 and 42;
- United Kingdom trademark registration No. UK00001317937 for the word mark TUV, registered on March 15, 1991, subsequently renewed, in class 42; and
- International trademark registration No. 911593 for the word mark TÜV NORD, registered on November 24, 2005, subsequently renewed, in classes 16, 35, 36, 37, 38, 41, 42, 44, and 45.

The disputed domain name <tuviran.com> was registered on October 5, 2006. In the past, it resolved to a webpage offering competing verification and certification services. Presently, no active webpage resolves from the disputed domain name.

5. Parties' Contentions

A. Complainant

According to the Complainant, the original TÜV companies were independent testing and verification service providers founded as associations by the German steam engine and boiler owners in the 1860s so as to self-administer the inspection of steam boilers. Presently there are six TÜV companies authorized to provide technical and verification services: TÜV SUD, TÜV Rheinland, TÜV NORD, TÜV Austria, TÜV Saarland, and TÜV Thüringen.

Also according to the Complainant, as a result of the substantial investment and widespread commercial success of their services, the TÜV companies have developed a tremendous amount of goodwill, enjoying high fame and distinctiveness worldwide. As an example, a survey conducted by the Institut für Demoskopie Allensbach in September 2018 in Germany showed that 80% of the German population indicated TÜV as the first mark that comes to their minds in relation to safety inspections.

The Complainant asserts that the disputed domain name is confusingly similar to its registered TÜV, TUV and TÜV NORD trademarks, not being the addition of the geographical term "Iran" capable of adding any distinctiveness thereto. In addition to that, the Complainant contends that the use made of the disputed domain name to offer verification and certification services which are identical to those covered by the TÜV and TUV trademarks increase the likelihood of confusion and undue association by Internet users.

Moreover, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the Respondent is not commonly known by the disputed domain name;
- (ii) the Complainant has never granted the Respondent a right of utilization of its trademarks, neither there being any affiliation between the Respondent and the Complainant; and
- (iii) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name since the website that resolved from the disputed domain name offered competing services to those rendered by the Complainant.

Lastly, the Complainant submits that the Respondent both registered and is using the disputed domain name in bad faith in accordance with paragraph 4(a)(iii) of the Policy, having clearly registered the disputed domain name to trade on the reputation and goodwill of the Complainant and its TÜV and TUV trademarks for financial gain, having the Respondent utilized the disputed domain name to target Internet users that will assume that the disputed domain name is offering services that will be provided by the Complainant or one of its subsidiaries or related entities.

B. Respondent

The Center received an email communication from Atak Domain & Hosting on December 8, 2022 stating that “[t]he mentioned domain appears to be registered with a different company”. The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

A. Identical or Confusingly Similar

The Complainant has established its rights in the registered TÜV and TUV trademarks.

The Panel finds that the disputed domain name reproduces entirely the Complainant’s TUV trademark with the addition of the geographical term “Iran”. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), sections 1.7 and 1.9.

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent’s rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondent.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent that the Respondent has not been commonly known by the disputed domain name, and neither has the Complainant ever granted the Respondent a right of utilization of its trademarks, neither there being any affiliation between the Respondent and the Complainant.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the Complainant that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Furthermore, the past use made of the disputed domain name in connection with the offer of competing services and the present inactive use of the disputed domain name further corroborate a finding of the Respondent's lack of rights or legitimate interests.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

The second element of the Policy has therefore been established.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainants who are the owner of a trademark relating to the disputed domain name or to a competitor of the Complainants, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other location, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The registration and use of the disputed domain name in bad faith can be found in the present case in view of the following circumstances:

- (i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, not having submitted a response;
- (ii) the past use of the disputed domain name in connection with a webpage offering competing services and the present passive holding of the disputed domain name;
- (iii) the well-known status of the Complainant's trademark;
- (iv) the nature of the disputed domain name (consisting of the Complainant's trademark and the geographical term 'Iran'), and the Respondent's intention to unduly profit from the value of the Complainant's trademark, suggesting a clear indication of the Respondent's registration and holding of the disputed domain name in bad faith, with the implausibility of any good faith use to which the disputed domain name may be put; and
- (v) the Respondent's choice to retain a privacy protection service so as to conceal its true identity.

For the reasons stated above, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The third element of the Policy has therefore been established.

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, <tuviran.com>, be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: February 6, 2023