

ADMINISTRATIVE PANEL DECISION

Man Marken GmbH v. Gavinji
Case No. D2022-0973

1. The Parties

The Complainant is Man Marken GmbH, Germany, represented by RDP Roehl Dehm & Partner Rechtsanwaelte mbB, Germany.

The Respondent is Gavinji, China, represented by Man Energy LLC, United Arab Emirates (“UAE”).

2. The Domain Name and Registrar

The disputed domain name <man.energy> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 21, 2022. On March 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 23, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 March 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 13, 2022. The Response was filed with the Center on April 4, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 14, 2022. 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 company in the MAN multinational corporate group. The MAN group manufactures and distributes a wide range of commercial vehicles such as buses and trucks and engineering goods such as diesel engines, turbo engines, and marine propulsion systems. In broad terms, the Complainant's business is divided into five divisions: MAN Energy & Storage, MAN Marine, MAN Process Industry, MAN Oil & Gas, and MAN Services. Another arm of the MAN group is MAN Truck & Bus.

Various arms of the group's business operate a number of websites including from:

- (a) "www.man.eu";
- (b) "www.mantruckandbus.com"; and
- (c) "www.man-es.com", the website for the Complainant's business.

Information in the Complaint demonstrates that MAN Marken GmbH owns a number of registered trademarks including:

- (1) German Registered Trademark No. 1145272, MAN, which has been registered since 1989 in respect of a range of goods and services in International Classes 7, 12, and 37;
- (2) International Registration No. 542762B, MAN, based on the German registration and designating some 21 countries under the Madrid Protocol; and
- (3) International Registration No. 914360C, MAN, which has been registered since 2006 in respect of a wide range of goods and services in International Classes 7, 9, 12, 16, 25, 28, 35, 36, 37, 39, 41, and 42. This trademark designated some 38 jurisdictions.

In a 2019 decision of the European Union Intellectual Property Office (EUIPO) brought by the MAN group against an unrelated third party from Hong Kong, China, the First Board of Appeal acknowledged evidence indicating the group had been using the MAN mark for more than 100 years; the MAN group was the third largest truck manufacturer in Europe; a 2013 brand valuation valued the trademark MAN at EUR 1.6 billion and was very well-known.

Information submitted in the Response indicates that the Complainant was known as "MAN Diesel & Turbo" until 2018 and adopted its current name "Man Energy Solutions" around June 2018.

According to the Whois record, the disputed domain name was registered on September 14, 2016.

The disputed domain name resolves to a website promoting a company "Man Energy" based in the UAE providing services related to chemicals trading, green energy design, and engineering and project consultancy.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven the registered trademarks identified in section 4 above. It says it is the owner of these trademarks. As noted in section 4 above, however, the registration information provided shows that they are owned by MAN Marken GmbH. However, it is well-established that members of a corporate group have standing to bring proceedings in respect of the group's trademarks. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.4.

In undertaking the comparison of the disputed domain name to the trademark, it is permissible in the present circumstances to disregard the generic Top Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".energy" gTLD, therefore, the disputed domain name is identical to the Complainant's trademark.

The Respondent contends that "man" is an ordinary English word over which no rights can be claimed. That contention mistakes the nature of the inquiry at this stage.

First, the fact that a sign may be a dictionary word in one language or another does not necessarily preclude it from being registrable as a trademark. That may depend on whether the trademark is being claimed in respect of goods or services of which the term is descriptive. An example is given in the context of the second requirement under the Policy of the word "orange" in respect of the fruit or, say, telecommunications services (another example is "apple" for phones and computers). See *e.g.*, [WIPO Overview 3.0](#), section 2.10. It may also depend on other considerations.

Secondly, a proceeding under the Policy is not usually an appropriate forum to challenge the validity of a complainant's registered trademark.

Thirdly, this element under the Policy is essentially a standing requirement. As such, it simply requires a visual and aural comparison of the disputed domain name to the proven trademark. This test is narrower than and different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.*, [WIPO Overview 3.0](#), section 1.7.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] 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, even if [the Respondent] has acquired no 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name after the Complainant had registered its trademarks and also after the Complainant began using its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name.

First, however, the Response contends that the Respondent is, or was, the owner of a company incorporated and carrying on business in the UAE under the name Malik Al Nejoum General Trading LLC. The Response includes evidence that this company was granted a Trading Licence under its name by the UAE authorities on October 19, 2011. The Response also includes evidence of a contract, a packing list and a bill of lading in that company's name on dates in 2013 and 2015.

The packing list issued by the company also displays a logo consisting of the word "man" over a device element. This is the same logo used on the website to which the disputed domain name currently resolves.

In addition, the Response includes evidence that the company registered the domain name <manchemical.com> in September 2011.

Secondly, the Response includes evidence that the Respondent renamed another company, which had been operating since 2004, as Man Chemical LLC. This evidence includes the Trading Register Certificate issued by the Government of Sharjah and an invoice of a quantity of bulk chemicals ordered by the company under the name Man Chemical LLC in March 2019.

Thirdly, the Respondent contends he registered a third company in the UAE, Man Energy LLC, in 2016 to expand operations from the petrochemical sector in which Man Chemical LLC was operating into the energy sector more generally including in particular solar power projects and water treatment projects.

The Response includes evidence of the Commercial License issued to this company under this name in September 2016 by the Government of Dubai and evidence of two transactions in February and March 2018 undertaken by that company.

The Respondent points out that these events, including the registration of the domain names (including the disputed domain name) and the registration or licensing of the companies under their respective names and the use of the MAN logo all occurred before the Complainant adopted the name MAN Energy. As the Complainant adopted its current name in June 2018, therefore, it cannot be accepted that the Respondent registered the disputed domain name to take advantage of the Complainant's current name.

Obviously, the Complainant and its corporate group have been using the MAN trademark for many years prior to any of the Respondent's companies. Nonetheless, "man" is a dictionary term and, as the Respondent's first company illustrates, can be an acronym for many different things. In this case, the Respondent and his related entities appear to have been using the companies' version of a MAN logo and the <manchemical.com> domain name for 11 years. He also appears to have been using the disputed domain name for some six years. Moreover, the Respondent's companies appear to be using their domain names, including the disputed domain name, in different sectors of trade to the Complainant.¹

Bearing in mind that proceeding under the Policy are conducted on the papers, these materials provided in the Response are sufficient to establish the conditions specified in paragraphs 4(c)(i) and (ii) of the Policy.

Accordingly, the Panel finds the Complainant has not established the second requirement under the Policy. Therefore, the Complaint must fail.

C. Registered and Used in Bad Faith

As the Complaint must fail, no good purpose would be served by considering this ground.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 8, 2022

¹ The Respondent's licensed activities are: air-conditioning, ventilations & air filtration systems installation & maintenance; electrical fittings & fixtures repairing & maintenance; solar energy systems installation; solar energy systems rental; plumbing & sanitary installation; and electrical fitting contracting. In contrast, the Complainant describes its group's operations as lying in the fields of engines, commercial vehicles, marine propulsions systems and the like.