

ADMINISTRATIVE PANEL DECISION

Tüv Nord AG v. Mohd Yasir Arafat
Case No. D2022-4650

1. The Parties

The Complainant is Tüv Nord AG, Germany, represented by Tüv Markenverbund e.V., Germany.

The Respondent is Mohd Yasir Arafat, Saudi Arabia.

2. The Domain Name and Registrar

The disputed domain name <tuv-training.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 5, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 6, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint (Registration Private, Domains By Proxy, LLC).

The Center sent an email communication to the Complainant on December 12, 2022 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 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 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2023. Aside from two informal communications, the Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on January 4, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on January 10, 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 is a German company that offers certification and various training courses in all security issues. The Complainant owns several trademark registrations for the TÜV and TUV trademarks, such as:

- The German trademark TÜV, No. 1005638 registered on July 28, 1980;
- The Bahrain trademark TÜV, No. 937, registered on May 30, 2001;
- The Qatar trademark TÜV, No. 8413, registered November 1, 2000;
- The United Kingdom trademark TUV, No. 00001317937, registered March 15, 1991.

The Complainant's trademark is well-known in Germany.

The Domain Name was registered on June 17, 2021. The Domain Name used to direct to a website in English that offered paid subscriptions to various educational courses. After the Respondent was notified about this proceeding, the Domain Name has been resolving to an inactive site.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarized as follows:

The Domain Name is confusingly similar to the Complainant's TÜV and TUV trademarks, registered in Germany and other countries because the Complainant's trademarks constitute the dominant element of the Domain Name. The difference between the trademarks and the Domain Name is not sufficient to overcome the confusing similarities.

The Respondent has no rights or legitimate interests in the Domain Name because there is no evidence that the Respondent used the Domain Name in connection with a *bona fide* offering of goods or services. The Respondent is not commonly known by the Domain Name. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name because the website under the Domain Name is used for commercial gain. The Complainant has never granted the Respondent a right to use the Domain Name, nor is it affiliated with the Respondent.

The Domain Name was registered and is being used in bad faith because the Respondent chose the Domain Name to create an appearance of association with the Complainant. The TÜV and TUV trademarks are well-known worldwide and in the Middle East, where the Respondent is apparently located. The Respondent intentionally tries to attract Internet users to its website by creating a likelihood of confusion between the Domain Name and the Complainant's trademarks. The Domain Name and the website under the Domain Name are designed to trick users into believing that the training courses offered on the website are offered by an affiliate of the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Respondent, however, sent two informal email communications to the Center. On December 14, 2022, the Center received an email stating:

"Hi, I don't understand what's going on here. Could you please help me understand what you want from me. It seems like you guys just telling me to do as you want. Regards, Yasir"

Later the same day, the Center received another email that read:

“Dear,

We don't know anything about Uniform Domain Name policy and this domain (tuv-training) is used for Technical Undergraduate Vocational trainings. Which is also officially registered locally in our region however [sic] our domain has stopped working since 2 days unknowingly [sic] and caused us financial loss [sic]

Now that we are understanding and planning to change our domain to something else in order to prevent such breakthrough.

Let me know what else I can do for you.

Regards”.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns several trademark registrations for the TÜV and TUV trademarks. Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (section 1.8, [WIPO Overview 3.0](#)).

It is well-established that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement. Section 1.11.1, [WIPO Overview 3.0](#).

The Domain Name consists of the Complainant's TUV trademark in its entirety, a hyphen, the word “training” and the gTLD “.com”. Because the Complainant's TÜV and TUV trademarks are recognizable within the Domain Name, neither the addition of the word “training”, nor the addition of the hyphen, prevents a finding of confusing similarity. The gTLD “.com” is disregarded as a standard registration requirement. Therefore, the Domain Name is confusingly similar to the Complainant's TÜV and TUV trademarks.

The Complainant has satisfied the first element of the UDRP.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on the evidence, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy:

(i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the 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 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

To prove the second UDRP element, the Complainant must make out a *prima facie* case¹ in respect of the lack of rights or legitimate interests of the Respondent.

The Panel finds that the Complainant satisfied its burden of proof for the following reasons. First, the evidence on file shows that the Respondent has not been commonly known by the Domain Name. Second, the Complainant contends and the Respondent does not deny that the Complainant did not authorize the Respondent's use of the Complainant's trademark in the Domain Name. Third, the Respondent's use of the Domain Name does not satisfy requirements of *bona fide* offering of goods and services. The Respondent used the Domain Name to point to a website in English, which used to offer paid subscription to various training programs. This is similar to the services that the Complainant offers under its TÜV and TUV marks. Based on the similarity between the Domain Name and the Complainant's trademark and the Complainant's and the Respondent's services, the Panel concludes that the Domain Name suggested affiliation between the Complainant and the Respondent, which did not amount to *bona fide* offering of services or to a legitimate fair use.

Once a complainant makes a *prima facie* case, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.² Here, the Respondent failed to satisfy the burden of production.

While the Respondent did not submit a formal response, he sent two emails to the Center. Neither of the Respondent's emails demonstrate his rights or legitimate interests in the Domain Name. While the Respondent contends that it was used for "Technical Undergraduate Vocational trainings", this is by no means a legitimate reason under the present circumstances. Furthermore, the evidence on file shows that the Respondent never used "Technical Undergraduate Vocational trainings" on the website under the Domain Name, for any potential legitimate reason. Instead, the Respondent used the "TUV training institute" phrase to offer paid subscriptions to various educational courses. Thus, the Panel finds the Respondent's arguments unpersuasive. Equally unpersuasive is the Respondent's explanation for its reasons to discontinue use of the Domain name.

Therefore, because the Respondent has failed to rebut the Complainant's *prima facie* showing and to demonstrate his rights or legitimate interests in the Domain Name, the Panel finds that the Complainant has satisfied the second element of the UDRP.

¹ Section 2.1, [WIPO Overview 3.0](#).

² Section 2.1, [WIPO Overview 3.0](#).

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must prove that the Domain Name was registered and is being used in bad faith.

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith”.³ The Complainant submitted survey evidence showing that its TÜV and TUV trademarks are well-known in Germany and unrefuted evidence that the Respondent is not affiliated with the Complainant. The Respondent is, therefore, presumed to have registered and used the Domain Name in bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), “bad faith” registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to 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. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found “the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark:… (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful, (iii) the lack of a respondent’s own rights to or legitimate interests in a domain name, … (vi) absence of any conceivable good faith use.”⁴

There is plethora of such evidence in this case. It is likely that the Respondent registered the Domain Name to trade on the goodwill of the Complainant’s trademark. The website at the Domain Name, which is similar to the Complainant’s mark, was used to offer paid training courses, which were similar to the Complainant’s training services. The evidence shows that the Respondent has no rights or legitimate interests in the Domain Name. Given the Respondent’s bad faith use of the Domain Name, there is in the Panel’s view no conceivable good faith use to which the Respondent can put the Domain Name.

Finally, the Panel notes that the Respondent’s current non-use or passive holding of the Domain Name constitutes further evidence of the Respondent’s bad faith. It is well-established that non-use of a domain name would not prevent finding of bad faith.⁵ The Respondent’s failure to submit a response, its registration of the Domain Name incorporating the distinctive Complainant’s trademark and the Respondent’s prior bad-faith use of the Domain Name that makes any good faith use of the Domain Name implausible have all been found to support finding of bad faith by prior panels. Therefore, the totality of circumstances of this case indicate that the Respondent is registered and is using the Domain Name in bad faith.⁶

The Complainant has satisfied the third element of the UDRP.

³ Section 3.1.4, [WIPO Overview 3.0](#).

⁴ Section 3.1.4, [WIPO Overview 3.0](#).

⁵ Section 3.3, [WIPO Overview 3.0](#).

⁶ *Id.*

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 Domain Name, <tuv-training.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: January 23, 2023