

## **ADMINISTRATIVE PANEL DECISION**

TÜV NORD AG v. David Czinczenheim, KIAS TUV, and Mocuba Platform  
Case No. D2022-4667

### **1. The Parties**

The Complainant is TÜV NORD AG, Germany, represented by TÜV Markenverbund e.V., Germany.

The Respondents are David Czinczenheim, France (the “First Respondent”); KIAS TUV, Saudi Arabia (the “Second Respondent”); and Mocuba Platform, Egypt (the “Third Respondent”).

### **2. The Domain Name and Registrar**

The disputed domain name <kiassafetyinspectiontuv.com> is registered with SNAPNAMES 19, LLC.

The disputed domain name <kiassafetyinspectiontuv.net> is registered with NameCheap, Inc.

The disputed domain name <kiassafetyinspectiontuv.org> is registered with eNom, LLC.

These three registrars are jointly referred to as the “Registrars”.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 6, 2022, the Center transmitted by email to the Registrars a request for registrars’ verification in connection with the disputed domain names. On December 6 and December 8, 2022, the Registrars transmitted by emails to the Center their verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 2022 providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amended Complaint. The Complainant filed two amended Complaints on December 13, 2022.

The Center verified that the Complaint together with the amended Complaints 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 Respondents of the Complaint, and the proceedings commenced on December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondents did not submit any formal response. Accordingly, the Center notified the Respondents' default on January 4, 2023. The Respondent, Mocuba Platform, sent an informal email communication on January 10, 2023, in reply to the notification of the Respondents' default.

The Center appointed Assen Alexiev as the sole panelist in this matter on January 12, 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 an internationally active independent technology service company based in Germany, which provides testing, inspection, certification, engineering, and consulting services.

The Complainant is the owner of the following trademark registrations for the signs TÜV and TUV (the "TÜV and TUV trademarks"):

- the German trademark TÜV with registration No. 1005638, registered on July 28, 1980 for services in International Classes 41 and 42; and
- the United Kingdom trademark TUV with registration No. UK00001317937, registered on March 15, 1991 for services in International Class 42.

The ".com" disputed domain name was registered on July 8, 2022. It resolves to a website that offered it for sale. The ".net" disputed domain name was registered on May 25, 2022. It resolves to an inactive site. The ".org" disputed domain name was registered on August 28, 2022. At the time of filing of the Complaint, it directed to an Arabic language website, which identified the provider of the website as Kias Inspection and Testing. It currently resolves to a similar website with some slight modifications.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain names are confusingly similar to their TÜV and TUV trademarks. It submits that the dominating element in the disputed domain names is the word "tuv" because it has distinctiveness, while the words "safetyinspection" have descriptive character for the offered services for safety inspections. The Complainant points out that the website at the ".org" disputed domain name offers verification and certification services, which services are identical to the services included in the scope of protection of the TÜV and TUV trademarks.

According to the Complainant, the Respondents have no rights or legitimate interests in respect of the disputed domain names, because they have not used them in connection with a *bona fide* offering of goods or services, are not commonly known by them. The Complainant adds that it has never granted to the Respondents authorization to use its trademarks, and there is no affiliation between the Parties. The Complainant adds that the Respondents are not making any legitimate noncommercial or fair use of the disputed domain names, because the associated websites are operated for commercial gain. The Complainant points out that the TÜV trademark was registered many years before the disputed domain names.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. According to it, the predominating element “tuv” was chosen and included intentionally in the disputed domain names to fake a connection with the TÜV brand and the Complainant.

The Complainant points out that it is a world-famous leading technical and verification service provider and the TÜV trademark is worldwide well-known, particularly with regard to testing and certification services. The Complainant maintains that the TÜV and TUV trademarks enjoy an extensive reputation throughout Europe.

According to the Complainant, the intention of the Respondents is to transfer the high reputation of the Complainant towards their own verification and certification services. According to the Complainant, the Respondents intentionally try to attract Internet users to their websites by creating a likelihood of confusion between the TÜV and TUV trademarks and the disputed domain names so that the target public assumes that the websites at the disputed domain names belong or are linked to the Complainant.

The Complainant maintains that the illegitimate use of the disputed domain names is causing damage to its goodwill and reputation and is disrupting its activities. Besides losing business, the Complainant points out that he has no control over the quality of the services being offered from the websites under the disputed domain names, and therefore its goodwill and reputation are vulnerable.

## **B. Respondent**

The Respondents did not formally reply to the Complainant’s contentions. The Respondent Mocuba Platform, registrant of the “.net” disputed domain name, made the following informal statement:

“There is no restriction as to who may purchase this domain. It is considered a commodity on the market, and anyone may purchase it. If this matter was of such importance, it should have been purchased before anyone like me could have purchased it. I may be able to resolve this matter by offering this domain for sale if this solves the issue.”

## **6. Discussion and Findings**

### **6.1. Procedural issue – Consolidation of Respondents**

The Complainant requests the consolidation of the proceedings in respect of the disputed domain names, maintaining that all of them are under common control. The Complainant points out that the registrants of the disputed domain names took active steps to conceal their identity by using privacy services, and that the disputed domain names are identical apart from their Top-Level Domains (“TLDs”). According to the Complainant, this shows that the Respondents, if not one and the same, are carrying out their activities jointly.

The Center has discharged its duties to notify the persons listed as registrants of the disputed domain names. None of the listed registrants of the disputed domain names has submitted a formal Response or objected to the consolidation request of the Complainant. The informal email communication sent by one of the Respondents does not deny the statements made by the Complainant in relation to the consolidation of the dispute in respect of the disputed domain names.

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes, and paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. As discussed in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where a complaint is filed against multiple respondents, UDRP panels look at whether the domain names or corresponding websites are subject to common control, and whether the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. UDRP panels have considered a range of factors, typically present in some

combination, as useful to determining whether such consolidation is appropriate, such as the naming patterns in the disputed domain names, or other arguments made by the complainant.

The Panel is satisfied that the Complainant has shown good reasons why the consolidation of the Respondents and disputes related to the disputed domain names in a single proceeding is justified and appropriate in the circumstances. The disputed domain names were registered within a short period of time, and, apart from their TLDs, are identical. None of the Respondents has denied its relationship to the other Respondents or objected to the Complainant's consolidation request. Moreover, the Panel notes that website resolving from the ".org" disputed domain name previously provided a contact email address associated with the ".com" disputed domain name (and that at some point after the filing of the Complaint this email was changed to show the disputed domain name – i.e., from ".com" to ".org"). These circumstances point to a conclusion that the disputed domain names are likely under common control.

None of the Respondents has advanced any reasons why it may not be equitable to allow the consolidation of the disputes in respect of the three disputed domain names. It appears that the consolidation would lead to greater procedural efficiency, and the Panel is not aware of any reasons why the consolidation would not be fair and equitable to all parties.

Therefore, the Panel decides to allow the consolidation of the disputes in relation to all of the disputed domain names in the present proceeding.

## **6.2. Substantive issues**

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain names:

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

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]."

None of the Respondents has however submitted a formal Response or disputed the Complainant's contentions and evidence in this proceeding.

### **A. Identical or Confusingly Similar**

The Complainant has filed evidence that it holds rights in the TÜV and TUV trademarks and has thus established its rights in these trademarks for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain ("TLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the [WIPO Overview 3.0](#). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com", ".net", and ".org" gTLDs of the disputed domain names for the purposes of their comparison to the Complainant's trademarks.

The disputed domain names all incorporate the TUV trademark in combination with the elements "kias", "safety" and "inspection". The TUV trademark is easily recognizable in the disputed domain name. As discussed in sections 1.7 and 1.8 of the [WIPO Overview 3.0](#), in cases where the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that

mark for purposes of UDRP standing, and the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

The same considerations also apply to the confusing similarity between the disputed domain names and the TÜV trademark. The only difference is that the disputed domain names do not incorporate the letter “ü”, but replace it with “u”. Such replacement is common practice since the letter “ü” is not included in the standard QWERTY keyboard, and the TÜV trademark remains recognizable in the disputed domain names.

Therefore, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s TUV and TÜV trademarks.

## **B. Rights or Legitimate Interests**

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondents have no rights or legitimate interests in the disputed domain names, because it has not been affiliated to the Complainant or authorized by it to use the TUV and TÜV trademarks and is not known by the disputed domain names. According to the Complainant, the Respondents use one of the disputed domain names to offer verification and certification services, another is offered for sale, and the third one is inactive. The Complainant has thus established a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names.

The Respondents have not submitted a Response. They have not denied the contentions of the Complainant and have not submitted any contrary evidence.

The disputed domain names are confusingly similar to the Complainant’s TUV and TÜV trademarks, and as discussed in section 6.1 above, are likely under common control. The evidence shows that “.com” disputed domain name resolves to a website that offered it for sale and the “.net” version is inactive. Its owner, the Respondent Mocuba Platform, stated in this proceeding that it may agree to sell it in order to resolve the dispute. The “.org” disputed domain name (which is currently inactive), at the time of filing of the Complaint resolved to an Arabic language website that identified the provider of the website as Kias Inspection and Testing and featured the images of construction works and of a person in protective clothing prominently marked with what appears to be the TÜV trademark. There is no disclaimer for the lack of relationship with the Complainant.

While the Respondent “KIAS TUV” incorporates the element “kias” in addition to the TUV trademark in its registrant name and on the website resolving from the “.org” disputed domain name, the Panel does not consider the Respondent to be commonly known by the disputed domain names for the purposes of paragraph 4(c)(ii) of the Policy. In this regard, the Panel finds that the broader context of this dispute, including the three identical second level disputed domain names being used for an inactive website, offering the concerned disputed domain name for sale, and targeting of a trademark owner, as well as connections to the “.com” disputed domain name being previously found on the website of the “.org” disputed domain name (but modified after the filing of the Complaint to avoid association), suggests that the Respondents are connected and that the choice of the Respondent name is not pretextual. Moreover, in light of the consolidation finding, the registrant names of the Respondents David Czinczenheim or Mocuba Platform would clearly not support a finding that the Respondents are commonly known by the disputed domain names.

Taking the above into account, and in the absence of any contrary evidence, the Panel accepts as more likely than not that the Respondents, being aware of notoriety of the Complainant's business under the TUV and TÜV trademarks, have registered the disputed domain names seeking to obtain a commercial advantage (in the form of financial gain or attraction of potential clients) of a perceived connection with the Complainant and of the goodwill of its trademarks. The Panel does not regard such conduct as a legitimate activity that may give rise to rights or legitimate interests of the Respondents in the disputed domain names under the Policy.

Therefore, the Panel finds that the Respondents do not have rights or legitimate interests in the disputed domain names.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

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

The Panel notes that the Complainant has submitted evidence of its popularity among consumers, achieved as a result of its activities for many years, and the composition of the disputed domain names may confuse Internet users that they are affiliated to the Complainant. The Respondents have not provided any explanation why they have registered the disputed domain names, and do not deny the Complainant's contentions. The registrants of two of the disputed domain names have shown their willingness to sell them, and the website associated to the third disputed domain name appears to offer verification and certification services, which are similar to or coincide with the services offered by the Complainant. The disputed domain names are essentially identical domain names registered in the three popular TLDs, and are likely under common control (apparently attempting to avoid the perception of being connected through the use of, likely fictitious, different registrant details and different uses).

Taking the above into account, the Panel accepts that it is more likely than not that the Respondents have registered and used the disputed domain names with knowledge of the Complainant and targeting the TUV and TÜV trademarks, seeking to obtain a commercial advantage by creating a likelihood of confusion as to the affiliation or endorsement of the disputed domain names, the associated websites, and of the services offered on them.

The fact that two of disputed domain names are not actively used does not preclude a finding of bad faith. As discussed in section 3.3 of the [WIPO Overview 3.0](#), from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. While 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel considers that these factors are present here. The Complainant's TUV and TÜV trademarks are well-known, the Respondents have not replied to the Complainant's contentions or provided any evidence of good faith use, and the Panel is not aware of any good faith use to which the disputed domain names may be put without the authorization of the Complainant.

Therefore, the Panel finds that the disputed domain names were registered and are being used in bad faith.

## **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 names, <kiassafetyinspectiontuv.com>, <kiassafetyinspectiontuv.net>, and <kiassafetyinspectiontuv.org>, be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: January 26, 2023