

ADMINISTRATIVE PANEL DECISION

TÜV Markenverbund e.V. v. Haroon Yousaf

Case No. D2023-0990

1. The Parties

The Complainant is TÜV Markenverbund e.V., Germany, internally represented.

The Respondent is Haroon Yousaf, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <tuvapex.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 6, 2023. On March 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 7, 2023, 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, PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 13, 2023, 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 March 13, 2023.

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 March 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2023. The Respondent sent two informal emails to the Center on March 31, 2023 and April 8, 2023. No formal Response was filed with the Center.

The Center appointed Edoardo Fano as the sole panelist in this matter on April 28, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to the Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a formal response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is TÜV Markenverbund e.V., a German association representing the TÜV companies in all their trademark related matter. The TÜV companies operate in the field of testing and certification services and own several trademark registrations for TÜV and TUV, among which:

- German Trademark Registration No. 1005638 for TÜV, registered on July 28, 1980;
- United Kingdom Trademark Registration No. 1317937 for TUV, registered on March 15, 1991;
- United Arab Emirates Trademark Registration No. 46664 for TÜV, registered on April 19, 2003;
- Bahrain Trademark Registration No. SM 937 for TÜV, registered on May 30, 2001;
- Saudi Arabia Trademark Registration No. 142107805 for TÜV, registered on June 22, 2003;
- Qatar Trademark Registration No. 8413 for TÜV, registered on November 1, 1990;
- Kuwait Trademark Registration No. 41375 for TÜV, registered on August 4, 2002;
- Oman Trademark Registration No. 23429 for TÜV, registered on November 29, 2004.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on February 2, 2021, and it resolves to a website in which accredited certification and training services are offered in GCC (Gulf Cooperation Council) countries, and the Complainant's trademark TÜV is reproduced.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its trademark TUV, as the disputed domain name wholly incorporates the Complainant's trademark with addition of the descriptive Latin word "apex", meaning "peak" or "top" in English.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name, and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name resolves to a website in which the same services as the Complainant, namely accredited certification and training services, are offered in GCC (Gulf Cooperation Council) countries.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademarks TÜV and TUV are well known in the field of testing and certification services. Therefore, the Respondent targeted the Complainant's trademarks at the time of registration of the disputed

domain name and the Complainant contends that the use of the disputed domain name with the purpose to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and unauthorized competing services, qualifies as bad faith registration and use.

B. Respondent

On March 31 and April 8, 2023, the Center received the following two informal email communications from the Respondent:

"Dear Sir, It is for your kind information that after receiving a complaint from your side regarding usage of TUV and your claim of trade mark rights, we are shifting our name from TUV apex to Apex SC, and will no more be using the name of TUV. Necessary amendments are under process, once completed it will be informed to you. Regards," (March 31, 2023);

"we had made necessary amendments and we are no more using name of tuv Regards" (April 8, 2023).

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademarks TÜV and TUV and that the disputed domain name is confusingly similar to the trademark TUV.

Regarding the addition of the term "apex", the Panel notes that it is now well established that the addition of other terms (whether descriptive, geographical terms, letters, or otherwise) to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark. The additional term does not therefore prevent the disputed domain name from being confusingly similar to the Complainant's trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

It is also well accepted that a generic Top-Level Domain ("gTLD"), in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you [respondent] of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is generally more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production to the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent, who is not associated with the Complainant in any way, is not using the disputed domain name for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services. The disputed domain name resolves to a website in which the same services as the Complainant, namely accredited certification and training services, are offered in GCC (Gulf Cooperation Council) countries, and the Complainant’s trademark TÜV is reproduced.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name.

The Panel therefore concludes that the disputed domain name is not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain name comprising the Complainant’s mark in its entirety together with the term “apex”, along with its use for a website offering for sale similar services, carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

Based on the facts of this case, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that “[f]or the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or [has] 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 the

complainant, for valuable consideration in excess of [its] documented out-of-pocket costs directly related to the domain name; or

- (ii) [the respondent has] 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 [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location".

Regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademarks TÜV and TUV in the field of testing and certification services is clearly established as evidenced by the TÜV and TUV trademark registrations. The Panel finds that the Respondent likely knew of the Complainant, and deliberately targeted the Complainant and its trademarks TÜV and TUV when registering the disputed domain name, especially because of the content of the website to which the disputed domain name resolves, reproducing the Complainant's trademark TÜV and offering for sale the same services as the Complainant in GCC (Gulf Cooperation Council) countries, namely the United Arab Emirates, Saudi Arabia, Kuwait, Bahrain, Qatar and Oman.

The Panel further notes that the disputed domain name is also being used in bad faith since the Respondent, by choosing a domain name confusingly similar to the Complainant's trademark and by providing the same or similar services as the Complainant in the website to which the disputed domain name is resolving, is intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the disputed domain name's source, sponsorship, affiliation or endorsement. Additionally, in its informal communications to the Center, the Respondent did not mention any good faith reasons regarding the registration and use of the disputed domain name.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order both to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

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

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: May 8, 2023