

ADMINISTRATIVE PANEL DECISION

NV5 Global Inc. v. NV4 Geospatial Consulting Private Limited
Case No. D2022-3689

1. The Parties

The Complainant is NV5 Global Inc., United States of America (“United States”), represented internally.

The Respondent is NV4 Geospatial Consulting Private Limited, India, represented by Cylaw Solutions, India.

2. The Domain Name and Registrar

The disputed domain name <nv4geospatial.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2022. On October 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 for the disputed domain name.

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 October 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2022. On October 26, 2022, the Respondent’s Representative requested an extension of 13 days to respond to the Complaint. After confirming that the Complainant did not object to the requested extension, the Respondent’s request was granted, and the response date was extended to November 15, 2022. The Response was filed with the Center on November 13, 2022.

The Center appointed Steven A. Maier as the sole panelist in this matter on November 17, 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 corporation organized under the laws of Florida, United States.

The Complainant claims to be the owner of United States trademark registration number 4304381 for the word mark NV5, registered on March 19, 2013 for goods and services including engineering services, geological services and consulting in the field of structural and geotechnical engineering in International Class 42¹.

The disputed domain name was registered on January 29, 2022.

On June 6, 2022 the Complainant filed a United States trademark application number 97444076 for a word mark NV5 GEOSPATIAL.

The disputed domain name has resolved to a website operated by the Respondent offering services including “terrestrial laser scanning”, “photogrammetry and orthophotography” and “total station and DGPS survey”.

5. Parties' Contentions

A. Complainant

The Complainant submits that it has used the mark NV5 GEOSPATIAL since at least February 2021 through a wholly-owned subsidiary named Quantum Spatial, Inc., which is a company registered in Wisconsin, United States. It states that its has used the mark in connection with geospatial data collection and related services and that it registered the domain name <nv5geospatial.com> on February 22, 2021.

The Complainant exhibits evidence of its website and social media accounts. Archived news items on the website suggest that the Complainant has used the name “NV5 Geospatial” in connection with its business activities since at least January 27, 2021.

The Complainant claims to have acquired common law service mark rights in the mark NV5 GEOSPATIAL.

The Complainant submits that the disputed domain name is confusingly similar to its NV5 GEOSPATIAL mark, both containing the letters “NV” together with a singular number and the term “geospatial”.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that the Respondent is not commonly known by the disputed domain name and that it registered the disputed domain name primarily for the purpose of attracting Internet users to its website by creating a likelihood of confusion with the Complainant's NV5 GEOSPATIAL mark.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent was aware of the Complainant and its use of the NV5 GEOSPATIAL mark since both parties have offices in Bangalore, India and offer identical services.

¹ While the trademark in question is registered in the name of NV5 Holdings, Inc. the Panel will proceed for the purposes of this Decision on the basis that the Complainant is duly authorized to use the trademark.

The Complainant repeats its submission that the Respondent registered the disputed domain name primarily for the purpose of attracting Internet users to its website by creating a likelihood of confusion with the Complainant's NV5 GEOSPATIAL mark.

The Complainant states that it contacted the Respondent in connection with this matter and that the Respondent "verbally offered to change the name" for a payment of USD 13,000. The Complainant submits that this sum exceeds the Respondent's out-of-pocket costs directly related to the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent denies the Complainant's allegations and submits that it is carrying on a legitimate business under the name "NV4 Geospatial Consulting Pvt. Ltd."

The Respondent states that it originally intended to trade as "V4 Geospatial Consulting Pvt. Ltd" and registered the domain name <v4geospatial> on January 9, 2022 for that purpose. It provides evidence of that domain name registration. It also produces what it states to be a communication from the Indian Ministry of Corporate Affairs, stating that the company name "V4" could not be registered owing to a conflict with existing trademark rights. It provides evidence that an alternative name, "NV4 Geospatial Consulting Private Limited", was however approved on January 29, 2022 and that it registered the disputed domain name on the same day.

The Respondent explains its choice of the disputed domain name as follows. It states that the originally-chosen term "V4" was intended to represent the term "we four", referring to the founders and directors of the Respondent's business. That name having been refused, the Respondent states that it added the prefix "N", which stands for the Hindi word "naveen", which both translates as "new" and is also the "official" first name of Mr Naveen Kumar Muninarayanappa, who is one of the four founder directors of the Respondent. The Respondent submits that using the term "new" as part of a company name is highly common in India.

The Respondent provides evidence that it was incorporated on March 9, 2022 and states that it actively conducts the business of geospatial consulting under the various methodologies specifically mentioned on its website. It states that two of its directors have more than 10 years' prior experience in the geospatial field and provides evidence of their LinkedIn profiles together with the names of their previous employers.

The Respondent tenders various documents as evidence that it is operating a *bona fide* business venture. These include its company and tax registration documents; what appear to be invoices issued to customers (although with the customer names redacted); a rental agreement for premises for the period of 11 months from January 1, 2022 (which is notarized); an electricity bill (although the name of the customer is unclear); a third-party invoice addressed to the Respondent for IT equipment; and what appear to be letters of offers of employment issued to, and countersigned by, several employees of the company. The Respondent also produces photographs stated to be of the company's employees, although those photographs contain nothing to identify the Respondent.

The Respondent disputes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. It points out that the mark NV5 is not registered under the Complainant's name and that the Complainant's application for the mark NV5 GEOSPATIAL is merely a pending application. With regard to the Complainant's claim to have obtained unregistered trademark rights in that name, the Respondent submits that the Complainant has provided no evidence of matters such as its business, reputation, sales volume, advertising, marketing or other matters to establish that the name had established a "secondary meaning" distinctive of the Complainant, particularly in India.

The Respondent submits that the Complainant has never used its domain name <nv5geospatial.com>, which it says has redirected to "www.nv5.com". It also disputes that the Complainant has used the name NV5 GEOSPATIAL in India or anywhere outside the United States. It asserts that the Complainant's claimed

presence in India was based on its acquisition of a Bangalore company named Quantum Spatial Pvt. Ltd. and that any Bangalore office that the Complainant may have had is now closed.

The Respondent submits that it has rights or legitimate interests in respect of the disputed domain name by virtue of its trading under the name "NV4 Geospatial Pvt. Ltd.". It states that it has therefore been commonly known by that trade name. It refers again to its evidence of active trading and states that all of this evidence shows that it had made demonstrable preparations to use the disputed domain name before receiving any notice of this proceeding.

The Respondent asserts that the Complainant must show that the Respondent has a total lack of any rights or legitimate interests in the disputed domain name, not merely that the Complainant has a purported "better" right.

The Respondent denies that it registered or has used the disputed domain name in bad faith. With regard to registration, it states that it has explained its choice of the disputed domain name and that it did not have actual knowledge of the Complainant's use of the name NV5 GEOSPATIAL at the relevant time. It reiterates that the Complainant has not used that name in India and that it has closed its Bangalore office, which was in any event operated by a company named Quantum Spatial India Pvt. Ltd.

The Respondent denies have sought misleadingly to attract Internet users to its website. It adds that its website is substantially different in appearance from the Complainant's and that the two websites could not be confused.

The Respondent denies having registered the disputed domain name primarily for the purpose of selling it to the Complainant for a sum in excess of its out-of-pocket costs. Its evidence is that someone from Quantum Spatial India Pvt. Ltd. contacted an (unnamed) member of its staff several months before the date of the Complaint and that there was a discussion about the company name and a United States company named "NV5". The Respondent says it cannot now remember details of that call, but believes the discussion must have related to the entirety of the Respondent's trading under the name "NV4 Geospatial" and not only to the disputed domain name. The Respondent does not expressly dispute that a figure of USD 13,000 may have been discussed, but says that its overall investment in its business exceeds that figure. The Respondent points out that, on the Complainant's own case, it was the Complainant who contacted the Respondent in connection with the disputed domain name and not *vice versa*.

The Complainant adds that the UDRP does not provide a forum for determining what is in fact a complex business or trademark dispute, as opposed to cases purely of "cybersquatting".

The Respondent requests a finding of Reverse Domain Name Hijacking ("RDNH") against the Complainant. It submits that the Complainant knew or should have known that its claim could not succeed and that it should be held to a higher standard of conduct as it is represented by intellectual property counsel. The Respondent says that the Complainant should have known from the Respondent's website that it was operating a *bona fide* business and that there is no evidence of the Respondent targeting the Complainant's trademark.

The Respondent's evidence is supported by a notarized affidavit sworn by Mr Naveen Kumar Muninarayanappa.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- (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 Complainant relies on registered trademark rights in the mark NV5 and claims to have obtained unregistered trademark rights in the mark NV5 GEOSPATIAL. With regard to the latter mark, the Respondent is correct to observe that the Complainant has failed to provide evidence of its commercial activities such as would lead to the mark NV5 GEOSPATIAL having become a distinctive identifier of the Complainant and its services. However, the Panel accepts that the Complainant has used the name “NV5 Geospatial” in various news items on its website since at least January 2021. Also bearing in mind that the purpose of paragraph 4(a)(i) is merely to establish that a complainant has sufficient standing to pursue its complaint, the Panel finds that the Complainant has attained some level of unregistered trademark rights in the mark NV5 GEOSPATIAL. The disputed domain name differing from that mark only by the digit “4” and opposed to “5”, the Panel finds that the disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c)(i) of the Policy, a respondent may establish that it has rights or legitimate interests in respect of a disputed domain name by demonstrating:

“... before any notice to you 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.”

In this case the Respondent claims to be carrying on a legitimate business in India under the name “NV4 Geospatial Pvt. Ltd.” and to have registered the disputed domain name in connection with that business. In the circumstances, the Panel must consider whether the disputed domain name does in fact reflect a legitimate business interest of the Respondent, or was instead registered in the knowledge of the Complainant’s use of the mark NV5 GEOSPATIAL and with the intention of taking unfair advantage of the reputation and goodwill attaching to that mark.

The Panel is unable in this case to form a definitive view upon the veracity of the Respondent’s submissions and evidence. Its explanation for the choice of the business name “NV4 Geospatial” appears to the Panel to be somewhat contrived and also to be remarkably coincidental with the Complainant’s mark NV5 GEOSPATIAL. Yet at the same time, the Respondent provides persuasive evidence that it originally intended to call its business “V4 Geospatial” and added the character “N” once the registration of this name was refused.

The Panel also accepts on the evidence that at least two of the founder directors of the Respondent company appear to have had previous experience and employment in the geospatial consulting sector.

As to the Respondent’s evidence of its actual business activities, the Panel finds items such as the incorporation and tax registration documents and the rental agreement to be persuasive, but can reach no firm conclusions concerning the Respondent’s (redacted) customer invoices, the third-party invoice for IT equipment and the offer of employment letters. As previously indicated, the Panel finds the photographs to be of no evidential value.

The Panel also has misgivings concerning the Respondent’s website. While listing specific services in the geospatial sector, the language of much of the website is highly generic in nature, e.g. “We are a person who has excessive thoughts or actions passionate about our business to help clients achieve success” and “We are built upon secure principal values. In keeping with these values, we are pledged to provide spectacular care and a standard of service to our clients and our community”. Furthermore, while the

website includes tabs for both “Projects” and “Case Studies” both of these resolve to a “Coming Soon” message. In addition, links to Facebook, Twitter and other social media do not appear to be operational.

The Panel’s difficulty with the evidence described above illustrates that this is not a suitable dispute for determination under the UDRP which, as the Respondent correctly observes, is a forum for resolving what are essentially “cybersquatting” cases and not for determining more complex business disputes. While a court of law could, for example, hear the parties’ oral evidence and comprehensively investigate the veracity of the Respondent’s evidence, these are matters beyond both the scope and the remit of the UDRP. In view of this, and based on the Respondent’s at least *prima facie* evidence of legitimate trading, the Panel finds it impossible to conclude, on the balance of probabilities, that the Respondent’s business is not genuine and is instead a sham or pretext aimed primarily at targeting the Complainant’s trademark.

In these circumstances, the Complainant cannot establish to the satisfaction of the Panel that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the Complainant must necessarily fail.

C. Registered and Used in Bad Faith

In the light of the Panel’s findings above, it is unnecessary for the Panel to make specific findings concerning the issues of registration and use of the disputed domain name in bad faith. The Panel comments, however, that for similar reasons as set out above, this is not a case in which the intentions of the Respondent could satisfactorily be determined from the evidence available to the Panel and within the scope of the UDRP procedure.

The Panel further comments that it would not find the discussion between the parties involving USD 13,000 (if such figure was in fact discussed) to be conclusive of the Respondent’s registration or use of the disputed domain name in bad faith. The Panel accepts in this regard that the Respondent had not advertised the disputed domain name for sale, that the Complainant (or its predecessor) contacted the Respondent about the disputed domain name and that the discussion may have concerned issues of business names and branding beyond the ownership of the disputed domain name itself.

D. Reverse Domain Name Hijacking

Under paragraph 15(e) of the Rules: “If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Panels will typically make a finding of RDNH in circumstances where a complainant knew or ought to have known that its complaint had no reasonable prospects of success. Furthermore, in a case such as this, where a complainant is legally represented, the complainant is held to a higher standard than an unrepresented party.

In this case, the Panel finds the Complainant’s rights in respect of the NV5 GEOSPATIAL trademark to be marginal. Furthermore, the Complainant was aware of the Respondent’s company name and website but provides little explanation for its contentions that the Respondent has not commonly been known by the disputed domain name and that the Respondent registered the disputed domain name primarily to target the Complainant’s trademark.

At the same time, the Panel has found the Respondent’s explanation for its choice of the disputed domain name to appear somewhat contrived and the disputed domain name to be remarkably coincidental with the Complainant’s NV5 GEOSPATIAL mark. The Panel has also found that this is not a case in which it can determine the veracity of the Respondent’s evidence within the scope of a proceeding under the UDRP.

In the circumstances, the Panel would find it inappropriate to conclude that the Complainant has brought the Complaint in bad faith and therefore declines to make a finding of RDNH pursuant to paragraph 15(e) of the Rules.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: November 25, 2022