

ADMINISTRATIVE PANEL DECISION

TÜV Nord AG v. Mahdi Ghanaei

Case No. DIR2022-0024

1. The Parties

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

The Respondent is Mahdi Ghanaei, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain names <arian-tuv-pasargad.ir> and <tuv-intercert.ir> are registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 12, 2022. On December 12, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain names. A copy of the amended Complaint was received by the Center on December 13, 2022. On December 20, 2022, IRNIC 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 and the amended Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 4, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was January 24, 2023. On January 26, 2023, the Center notified the Respondent’s default.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on January 30, 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 operates in the field of management system testing and certification. The Complainant owns many trademark registrations for TUV and TÜV such as:

1. German trademark registration No. 1005638 for TÜV registered on July 28, 1980;
2. United Kingdom trademark registration No. 1317937 for TUV registered on March 15, 1991.

The disputed domain names were registered on June 21, 2007. The disputed domain names resolve to web pages which seem to offer testing and certification services.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant owns the trademarks TUV and TÜV. In determining confusing similarity there should be an assessment of the overall impression created and bearing in mind the services offered through the disputed domain names, which in this case are verification and certification services that are services identical to those covered by the Complainant's trademarks. In the first disputed domain name, the Complainant's trademark TUV is used in conjunction with the term "arian" and the name of the archeological Persian site "Pasargad". In the second disputed domain name, the Complainant's trademark TUV is used together with the term "intercert", which is a combination of a geographical term and the abbreviation of "certification". The predominant element is the Complainant's trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent is not authorized or licensed by the Complainant to use its trademarks nor is it affiliated with the Complainant. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent is not commonly known by the disputed domain names. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names. The registration of the trademarks by the Complainant precedes the registration of the disputed domain names.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. The TUV companies were founded in the 1860s and are now leading technical and verification services providers and the sign TUV is well-known. It is known throughout Europe and is registered in the Middle East including Iran. Through the second disputed domain name, the Respondent is trying to create the impression that the disputed domain name is the Complainant's international certification site. The disputed domain names were registered with the intent to mislead consumers by creating confusion with the Complainant's trademark and lead consumers to believe that the advertised services are offered by one of the Complainant's companies or subsidiaries.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for TUV. The Panel is satisfied that the Complainant has established its ownership of the trademark TUV.

It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other words are added as part of the disputed domain name. *E.g., Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*").¹

The first disputed domain name incorporates the Complainant's trademark TUV in its entirety. The word "arian" when used as a noun means believer, advocate or producer. The word "pasargad" is a historical site. Either of these words do not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark as it remains clearly recognizable.

The second disputed domain name incorporates the Complainant's trademark TUV in its entirety. The word "intercert" is a combination of abbreviation of the words "international" and "certification". Here again, the combination of the two words does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark as it remains clearly recognizable.

The country code Top-Level Domain ".ir" should generally be ignored when assessing confusing similarity as established by prior decisions.

Consequently, the Panel finds that the disputed domain names are confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not affiliated with nor authorized by the Complainant to use its trademark. The Respondent should demonstrate that it has rights or legitimate interests.

The Panel finds it necessary to assess whether there is a *bona fide* offering of goods or services as the disputed domain names resolve to websites through which certification services are being advertised. In this respect, the Panel notes a prior UDRP decision which explains that "The use of a domain name which is identical or confusingly similar to the complainant's trademark with an intention of deriving advantage from user confusion and diverting Internet users to other commercial sites does not confer legitimate rights on the Respondent". See *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). The Panel is of the view that the use of the Complainant's trademark in order to offer competing services confirms an intention to derive advantage from the confusion that may be caused to consumers. As such, this does not constitute a *bona fide* offering of goods or services.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

¹ The Panel follows prior decisions under the irDRP and, given the similarities between the irDRP and UDRP, finds it appropriate to refer to UDRP jurisprudence, including by way of reference to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). See *Inter IKEA Systems BV (IISBV) v. Mohammadreza Mohammadian*, WIPO Case No. [DIR2018-0003](#).

C. Registered and Used in Bad Faith

The Respondent must have known about the Complainant's business and trademark as the Complainant's trademarks have been registered decades before the registration of the disputed domain names which clearly incorporate the Complainant's mark as their dominant recognizable element. Also, the disputed domain names resolve to websites offering certification services, which is identical to the Complainant's services. Therefore, it is highly likely that the Respondent would be very much aware of the Complainant's trademark.

The websites of the Respondent show the trademark of the Complainant, which indicates that the Respondent is trying to pass off as being connected with the Complainant or at minimum to derive traffic from the Complainant's mark being in the disputed domain names. The Panel finds that more likely than not that the Respondent registered the disputed domain names in the knowledge of the Complainant's trademark and business with the intention of taking unfair advantage of the Complainant's goodwill attaching to that trademark. It is the Panel's view that the Respondent has used the Complainant's trademark in order to create confusion in the minds of consumers for the purpose of attracting Internet traffic for commercial gain.

Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

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 <arian-tuv-pasargad.ir> and <tuv-intercert.ir> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: February 6, 2023