

ADMINISTRATIVE PANEL DECISION

Tüv Nord AG v. ahsan rahman, tuvpak
Case No. D2022-4649

1. The Parties

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

The Respondent is ahsan rahman, tuvpak, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <tuvpak.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 5, 2022. On December 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 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 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 12, 2023. The Respondent sent an informal communication to the Center on January 13, 2023.

The Center appointed Adam Taylor as the sole panelist in this matter on February 2, 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 Respondent sent a further informal communication to the Center on February 14, 2023.

On February 16, 2023, the Panel issued Procedural Order No.1 (“the Order”) inviting both parties to comment on certain matters. This order is summarised in section 6B below. Neither party responded to the Order.

4. Factual Background

The Complainant and its predecessors have provided independent testing and verification services under the mark TÜV since the 1860s.

Today there are six main companies in the Complainant’s group which bear suffixes corresponding to their original geographical origin: TÜV SÜD, TÜV Rheinland, TÜV Nord, TÜV Austria, TÜV Saarland and TÜV Thüringen.

The Complainant owns German trade mark No. 1005638 for TÜV, filed on October 29, 1979, registered on July 28, 1980, in classes 41 and 42, as well as United Kingdom trade mark No. 1317937 for TUV, filed on August 4, 1987, registered on March 15, 1991, in class 42.

The disputed domain name was registered on January 5, 2021.

The disputed domain name has been used to resolve to a website entitled “TUV PAK Inspection Services” with a logo including the words “TUV PAKINSPEC INSPECTION SERVICES”. The following strapline appeared prominently at the top of the home page: “TUVPAK INSPEC. Technical Unique venture Pakistan inspection & certification.”

The homepage included photographs of three people described as “Our Expert Team”, as well as the following text:

“Welcome to the TUVPAK

Where We Build Your Visions

TUV PAKISTAN is established on April 2015. This is for Inspection and testing is one of the companies of TUV PAK Group that specialized in inspection, testing and calibration through providing inspection and testing services in different fields and industries in accordance with international standards, codes and client specification. We provide our services in both new construction plants and in-service plants to ensure integrity, reliability and fitness for service.”

The homepage also provided the following alleged statistics: “6,820 CLIENTS. 4,000 PROJECTS. 3,568 REPAIRING. 1,530 AWARDS.”

5. Parties’ Contentions

A. Complainant

The following is a summary of the Complainant’s contentions.

The disputed domain name is confusingly similar to the Complainant’s trade marks.

The disputed domain name is visually, phonetically and conceptually similar to the disputed domain name and is being used for the same services as those of the Complainant.

The disputed domain name is dominated by the Complainant's mark as the suffix "pak" is purely a geographical indication for Pakistan.

The Respondent lacks rights or legitimate interests in the disputed domain name.

There is no evidence that the Respondent has used the disputed domain name for a *bona fide* offering of goods or services.

The Respondent is not commonly known by the disputed domain name and uses a privacy service.

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, because its use is commercial.

The Complainant has not authorised the Respondent to use its trade marks.

The Complainant's trade marks long predate the disputed domain name.

The disputed domain name was registered and is being used in bad faith.

The Complainant's group and its distinctive trade marks are well-known in Europe and worldwide arising from the substantial investment and widespread success of the Complainant's services. A 2018 survey shows that the Complainant's mark had acquired a high degree of public awareness in Germany.

The Complainant owns registered trade marks for TÜV in the Middle East, including in Bahrain, Qatar and Saudi Arabia.

The dominant element of the disputed domain name - "tuv" - was chosen by the Respondent in order to create a fake connection with the Complainant.

The use of a geographical suffix reinforces the false impression of a connection with the Complainant.

The Respondent has intentionally sought to create a likelihood of confusion with the Complainant's mark. The Respondent's activity is damaging the Complainant's reputation and disrupting its activities.

B. Respondent

The Respondent did not submit a formal response by the due date. However, the Respondent sent an informal communication to the Center on January 13, 2023, stating as follows:

"Greetings from Technical Unique Venture Pakistan (TUVPAK)

This is for your kind information and record that M/S TUVPAK is registered in Pakistan with the name of Technical Unique Venture Pakistan as well as being taxpayer registered in Pakistan.

Our logo and web is totally different and registered with us. We have nothing to do with your TUV and we have no affiliation with TUV which is mentioned in your email.

Regards,

[Name redacted]

Operations Manager"

On February 15, 2023, the Respondent sent a further email communication to the Center, reiterating some of the above assertions and complaining that "[a]s our domain has been deleted from the system causing us great loss and all our clients['] information and emails have been deleted from the system".

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established registered rights in the marks TÜV and TUV, as well as unregistered trade mark rights deriving from the Complainant's longstanding use thereof.

Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that, where the relevant trade mark is recognisable 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.

Here, the disputed domain name consists of the Complainant's trade mark, which remains readily recognisable within the disputed domain name, plus the additional term "pak", which does not prevent a finding of confusing similarity as explained above.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As regards paragraphs 4(c)(i) and 4(c)(ii) of the Policy - making a *bona fide* offering of goods or services and being commonly known by the disputed domain name, respectively - the Panel initially noted that, as discussed in section 4 above, the website at the disputed domain name claimed that the Respondent had been providing inspection services under the mark TUVPAK since April 2015, and indicated that this was an acronym for "Technical Unique Venture Pakistan", an assertion reiterated in the Respondent's email of January 13, 2023.

In accordance with section 4.8 of [WIPO Overview 3.0](#), and with a view to eliciting some further information regarding the nature of the Respondent's apparent business and the original selection of its name, the Panel carried out some Google searches and found the following:

1. A Facebook page at "www.facebook.com/tuvpakistan" created in 2016, branded "TUV Pakistan Third Party Inspection" and bearing the same TUVPAK logo that was on the website at the disputed domain name. The page included many photographs of people in various industrial contexts apparently

providing inspection services and (in more recent photographs) wearing shirts with the TUVPAK logo plus the disputed domain name.

2. Websites of other businesses that referred to (a) “team” members with the same names as those shown on the Respondent’s site but with different photographs and (b) identical client/project statistics to those on the Respondent’s site.

The Panel duly issued the Order, annexing copies of screenshots illustrating the above findings and inviting the Respondent to supply dated evidence: justifying the photographs/statistics on its website; as to the Respondent’s claimed registration in Pakistan under the name “Technical Unique Venture Pakistan”; as to the adoption, age and extent of the Respondent’s use of that name; and as to the Respondent’s selection of the trading name “TUV PAK” by reference to “Technical Unique Venture Pakistan” and not by reference to the Complainant’s mark.

The Panel also invited the Complainant to respond to any submission by the Respondent and/or generally to the Panel’s findings in points 1 and 2 above.

Neither party responded to the Order. Accordingly, the Respondent did not take the opportunity to explain its selection of its name or to justify the claims on its website. Whereas the Complainant did not see fit to raise additional arguments under the second or third elements in light of the evidence of trading activity shown on the Respondent’s Facebook page.

In the absence of any explanation/denial from the Respondent, it is reasonably clear to the Panel that the Respondent’s website presents a somewhat misleading picture of the Respondent’s business, perhaps deriving from use of a standard website template which the Respondent did not take the trouble to properly adapt.

However, it is also apparent to the Panel that, albeit not on the massive scale claimed by its website, the Respondent seems to be carrying on a genuine industrial inspection business under the names “TUV PAKISTAN” and “TUVPAK” and that it has been doing so apparently since at least 2016. Given the volume and nature of the Respondent’s Facebook posts, together with associated photographs including personnel wearing merchandise branded with TUVPAK logo plus the disputed domain name, and despite the dubiousness of some of the claims on the Respondent’s website, it seems highly unlikely that the Facebook page was designed to project a fake business. In this regard, the Panel also notes that the logos used by the Parties are materially different.

In the Panel’s view, the fact that the disputed domain name reflects the name of an apparent genuine business that began trading at least four years or so before registration of the disputed domain name points towards the Respondent potentially having used the disputed domain name for a *bona fide* offering of goods and services under paragraph 4(c)(i) of the Policy and/or having been commonly known by the disputed domain name under 4(c)(ii) of the Policy.

Nonetheless, it might still be open to the Panel to reach a different conclusion if say there were clear evidence that the Respondent’s original adoption of its trading name was illegitimate, in that it was deliberately designed to target the Complainant’s mark, and that registration of the disputed domain name was part of such a wider illicit enterprise aimed directly at the Complainant.

On the one hand, “tuv” is distinctive term used by a business that appears to operate in broadly the same field as the Respondent, and the Respondent’s addition of “pak” echoes the Complainant’s use of its mark in combination with various geographical suffixes. (See section 4 above.). Furthermore, the Respondent’s failure to respond to the Panel’s invitation to justify its choice of name creates some doubt as to the veracity of the Respondent’s claim that “TUV” was selected as an acronym of “Technical Unique Venture”. Nor has the Respondent helped itself by operating a website that seems to exaggerate the scale of its business.

In addition, the Complainant claims to have its TUV trademark protected in the region, including in Bahrain, Qatar, and Saudi Arabia.

On the other hand, the Panel considers that the Complainant has not supplied sufficient evidence to establish that the Respondent registered the disputed domain to take unfair advantage of the Complainant's reputation or goodwill. For example, this case does not possess any clear indicators of targeting such as the Respondent's misuse of the Complainant's logo, branding or content.

Ultimately, having carefully weighed up the available evidence in this case, and notwithstanding the lack of information from the Respondent, the Panel does not consider that it is in a position to find that the Respondent's registration and use of the disputed domain name, and its adoption of its trading name some four years earlier, were part of a broad scheme designed to illegitimately target the Complainant's mark, and that the Respondent thereby lacked rights or legitimate interests in the disputed domain name.

The Panel is mindful that the UDRP is a limited process, without the benefit of cross-examination, discovery etc., and it is not intended to be a substitute for intellectual property infringement court proceedings. This decision does not of course prevent the Complainant from litigating in a competent court if it considers that it has grounds to do so.

For the above reasons, the Panel concludes that the Complainant has failed to establish the second element of the Policy.

C. Registered and Used in Bad Faith

It is unnecessary to consider this element in light of the Panel's conclusion under the second element above.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: March 7, 2023