Panel Decision for dispute CAC-ADREU-006516

Case number	CAC-ADREU-006516
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Domain names	tuvinternational.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	TÜV Markenverbund e.V.

Respondent

Organization	Navilive Private Limited

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

Nil

FACTUAL BACKGROUND

The Complainant TÜV Markenverbund e.V. is an association founded to manage the trade mark rights of all the TÜV companies and acts as their representative in all trade mark matters. The TÜV group of companies operates among other things as a monitoring, validating and certifying agency in the safety and environmental sectors.

The Complainant is the registered proprietor of Community Trade Mark No. 000233403 for the word mark TÜV.

The Disputed Domain Name <tuvinternational.eu> was registered on August 7, 2010.

A. COMPLAINANT

The Complainant submits that the Disputed Domain Name is confusingly similar to its TÜV registered trade mark. It further contends that the use of the generic term 'international' does not distinguish the Disputed Domain Name from its trade mark. The Complainant notes that its business and trade mark are very well reputed in Germany in the area of verification and certification.

The Complainant submits that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant further states that the Respondent has not been authorised to use the TÜV mark by the Complainant or any of the TÜV companies.

The Complainant submits that the Disputed Domain Name has been registered and is being used in bad faith. It notes that the Respondent name and contact details contain no reference to "TÜV" or to similar words or names. The Complainant states that the TÜV mark is used by it in the field of verification and certification and has an international reputation within that field. As such, the Complainant contends that the Respondent, which is providing similar services, could not have been unaware that the name TÜV was already used in this field.

The Complainant submits that the Disputed Domain Name was registered in bad faith in order to mislead visitors to its website. The Complainant further submits that the Respondent's use of the colour blue on its website, which is the same colour used by most of the TÜV companies, together with the fact that the Respondent's website also reproduces full pages from different websites owned by third party companies including the TÜV companies' websites, supports its contention that the Respondent registered the Disputed Domain Name in order to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's well known mark.

B. RESPONDENT

The Respondent did not reply to the Complainants' contentions.

DISCUSSION AND FINDINGS

What needs to be shown

In order to succeed in a Complaint, the Complainant must show that the requirements of Article 21(1) of Commission Regulation (EC) No 874/2004 have been complied with. That paragraph states that:
"A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:
(a) has been registered by its holder without rights or legitimate interest in the name; or
(b) has been registered or is being used in bad faith."

Article 21(2) and (3) contains a non-exhaustive list of examples of circumstances which may demonstrate the existence of a legitimate interest within the meaning of Article 21(1)(a) and of bad faith within the meaning of Article 21(1)(b).

A. Identical or Confusingly Similar

The Complainant has demonstrated that at the date of the filing of the Complaint it owned the word mark TÜV, under Community Trade Mark 000233403. The Disputed Domain Name combines the Complainant's TÜV trade mark with the generic term 'international'. The Panel also notes that the Disputed Domain Name does not include an umlaut over the "u" in "TÜV". In the Panel's view the use of the word 'international' and the omission of the umlaut over the "u" are not sufficient to differentiate it from the Complainant's mark and thus avoid confusion. Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's TÜV word mark, and that the Complainant has established the requirement of Article 21 of the Regulation.

Article 21 of Commission Regulation (EC) No 874/2004 states that the Complainant must show that the Disputed Domain Name was registered without legitimate rights or interests, or that it has been registered or is being used in bad faith. Notwithstanding this, the Panel will address both Article 21(1)(a) and Article 21 (1)(b) in turn.

B. Registered without Rights or Legitimate Interests

There has been no evidence put before the Panel to suggest that the Complainant has ever authorised the Respondent's use of the Disputed Domain Name or had any prior relationship or contact with the Respondent. There is no evidence to demonstrate that the Respondent is or was commonly known by the Disputed Domain Name and neither is there anything to suggest that the Respondent is making a fair use of the Disputed Domain Name. In addition and for the reasons set out under Section C below the Panel considers that the Respondent's use is illegitimate and is not consistent with it having registered the Disputed Domain Name validly or with a legitimate interest.

C. Registered or Used in Bad Faith

Registration in bad faith

The Complainant has provided evidence that its TÜV mark has been registered since September 28, 1998, some 12 years prior to the creation of the Disputed Domain Name. The Complainant has also demonstrated that the TÜV mark is used by it in the field of verification and certification and has an international reputation within that field. In the absence of any explanation to the contrary, the Panel finds that on the balance of probabilities and in view of the Respondent's subsequent use of the Disputed Domain Name, as discussed below, it is unlikely that the Respondent selected the Disputed Domain Name by coincidence or without knowledge of the Complainant's mark and brand and therefore that it was registered in bad faith.

Use in bad faith

Overall the website operated by the Respondent at the Disputed Domain Name gives the impression that it is owned and operated by the Complainant. In particular it uses the colour blue which is also the colour used by the majority of the Complainant's websites, it is headed "Welcome to TÜV International" and includes information on the Complainant and links to its website pages. It seems to the Panel that this is a blatant attempt by the Respondent to divert Internet users and to confuse them into thinking that they were dealing

with the Complainant instead of the Respondent, in terms of Article 21(3)(d) of the Regulation and B11(f)(4) of the Rules.

In light of the above the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the Respondent has in this case both registered and used the Disputed Domain Name in bad faith. Accordingly, the Panel finds that the Complainant has satisfied the requirements of both Article 21(1)(a) and Article 21(1)(b) of the Regulation.

The Complainant, having satisfied the requirements of the first paragraph of Article 21(1) and of Article 21(1)(a) and 21(1)(b), is entitled to obtain revocation of the Disputed Domain Name.

Under Article 22(11) of the Regulation and Paragraph B11(b) of the ADR Rules, a panel may only order the transfer of a Disputed Domain Name to a successful complainant where that complainant satisfies at least one of the criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 regarding eligibility for a .eu TLD.

The first of those criteria is that the registrant is an "undertaking having its registered office, central administration or principal place of business within the Community". It is clear that the Complainant satisfies this criterion. As such, it is entitled to the transfer of the Disputed Domain Name.

DECISION

For all the foregoing reasons, in accordance with paragraphs B 12(b) and (c) of the Rules, the Panel orders that the domain name <tuvinternational.eu> be transferred to the Complainant within thirty calendar days of the notification of the decision to the Complainant and to the Respondent, unless the Respondent initiates court proceedings in a mutual jurisdiction as meant in Paragraph B 12(a) of the ADR Rules.

PANELISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2013-09-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed Domain Name: <tuvinternational.eu>

II. Country of the Complainant: Germany, country of the Respondent: United Kingdom

III. Date of registration of the domain name: 7 August 2010

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: word CTM, reg. No. 000233403, filed on 1 April 1996, registered on 28 September 1998 in respect of goods and services in classes 41 and 42.

V. Response submitted: No

VI. Domain Name is confusingly similar to the protected right of the Complainant.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: The Respondent did not file a Response to the Complaint. The Panel finds that the Complainant has established a prima facie case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and, in the absence of a response by the Respondent rebutting the Complainant's submissions, accepts the Complainant's submissions in that respect.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Panel finds that the Complainant has established that the TÜV mark has been registered since September 28, 1998, that it is used in the field of verification and certification and that it has an international reputation within that field. In the absence of any explanation to the contrary, the Panel finds that on the balance of probabilities it is unlikely that the Respondent selected the Disputed Domain Name by coincidence or without knowledge of the Complainant's mark and brand. In addition, the website operated by the Respondent at the Disputed Domain Name gives the impression that it is owned and operated by the Complainant. This is a blatant

attempt by the Respondent to divert Internet users and to confuse them into thinking that they are dealing with the Complainant instead of the Respondent, in terms of Article 21(3)(d) of the Regulation and B11(f)(4) of the Rules. Accordingly, the Panel finds that the Complainant has satisfied the requirements of both Article 21(1)(a) and Article 21(1)(b) of the Regulation.

IX. Other substantial facts the Panel considers relevant:
In the Panel's view the use of the word 'international' and the omission of the umlaut over the "u" are not sufficient to differentiate the Disputed Domain Name from the Complainant's mark and thus avoid confusion.

X. Dispute Result: Transfer of the Disputed Domain Name

XI. Procedural factors the Panel considers relevant: Nil

XII. [If transfer to Complainant] Is Complainant eligible? Yes.

The Complainant is an undertaking having its registered office in Germany. It therefore satisfies the eligibility criteria set out in Article 4(2)(b)(i) of the Regulation.