

**BEFORE ALOK KUMAR JAIN, SOLE ARBITRATOR
.IN REGISTRY
NATIONAL INTERNET EXCHANGE OF INDIA(NIXI)
INDRP ARBITRATION
INDRP Case No. 1876**

Disputed Domain Name: < TATADIGITALMARKETING.IN>

ARBITRATION AWARD

Dated 9.8.2024

IN THE MATTER OF:

1. Tata Digital Private Limited
Army & Navy Building
148, MG Road,
Opposite Kala Ghoda
Fort Mumbai-400001

2. Tata Sons Pvt Limited
Bombay House,
24, Homi Mody Street,
Mumbai, Maharashtra 400001
Versus

Complainants

Miiraj Miiraj ,
Zinmatt Private Limited
37/Ground Floor spectrum Commercial center no.1
Salapose road,
Spectrum commercial ,Ahmedabad, Gujrat, India

Respondent

1. The Parties

The Complainants in this administrative proceedings are Tata digital Private Limited and Tata Sons Private Limited at the addresses given above with emails address as legal@tatadigital.com.

Alok Kumar Jain

Respondent in these proceedings is Miiraj Miiraj Zinmatt Private limited with address as given above with email address as miiraj.tatadigitalmarketing.gmail.com

Domain Name and Registrar:-

The disputed domain name <tatadigitalmarketing in>, is registered with GoDaddy.com ,LLC

Procedure History

3.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (the "Policy") adopted by the National Internet Exchange of India ("NIXI") and the INDRP Rules of Procedure (the "Rules") which were approved in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the Disputed Domain Name with a NIXI accredited Registrar, the Respondent agreed to the resolution of disputes pursuant to the said Policy and the Rules.

As per the information received from NIXI, the history of the proceedings is as follows:

3.2. The Complaint was filed by the Complainant with NIXI against the Respondent . On 29.7.2024 I was appointed as Sole Arbitrator to decide the disputes between the parties. I submitted statement of Acceptance and Declaration of Impartiality and Independence as required by rules to ensure compliance with Paragraph 6 of the Rules. NIXI notified the Parties of my appointment as Arbitrator *via* email dated 29.7.2024 and served by email an electronic Copy of the Complainant with

Annexures on the Respondent at the email addresses of the Respondent.

- 3.3. On 29.7.2024 I issued notice to the parties vide email dated 29.7.2024 directing the Complainant to serve complete set of Complaint on the Respondent in soft copies as well as in physical via courier /Post. The Respondent was directed to file its response within 10 days from the date of notice. The Respondent sent a reply vide email dated 30.7.2024. In these circumstances I intimated the parties that now the matter will be decided on its own merit considering the material on record. Accordingly now the complaint is being decided on merit. No personal hearing was requested by any parties. Both the parties have been given sufficient opportunity to file their respective responses.
- 3.4. Clause 8(b) of the INDRP Rules requires that the Arbitrator shall at all times treat the Parties with equality and provide each one of them with a fair opportunity to present their case. The tribunal had given fair opportunity to both the parties to present their respective case.
- 3.5 Further Clause 13(a) of the Rules provides that an Arbitrator shall decide a Complaint on the basis of the pleadings submitted and in accordance with the Arbitration & Conciliation Act, 1996 amended as per the Arbitration and Conciliation (Amendment) Act, 2015 read

with the Arbitration & Conciliation Rules, Dispute Resolution Policy, the Rules of Procedure and any by-laws, and guidelines and any law that the Arbitrator deems to be applicable, as amended from time to time.

In these circumstances the Tribunal proceeds to decide the complaint on merit in accordance with said Act, Policy and Rules.

Discussions and findings:

The Complainant has invoked Clause 4 of the Policy to initiate the Arbitration Proceeding.

Clause 4 of the INDRP Policy provides as under:

4. Class of disputes:

Any Person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

- (a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Registrant has no rights or legitimate interests in respect of the domain name; and
- (c) the Registrant's domain name has been registered or is being used in bad faith.

Therefore in order to succeed in the Complaint, the Complainant has to satisfy inter alia all the three conditions provided in clauses 4(a), 4(b) and 4(c) quoted above.

Alok Kerman Jain

CASE OF THE COMPLAINANT

4.1 The Complainant averred in the complaint that the trademark TATA was registered as early as 1942 by the Complainant. The trademark TATA is inherently distinctive and is a strong identifier of source for the Complainants Group and its goods and services. It has no dictionary meaning and does not otherwise exist in the English language. The Complainant no. 2 was incorporated on 8th November 1917. Extracts from records of the Ministry of Corporate Affairs in support of this are enclosed as Annexure E. The Complainant no.1 is authorized vide trademark and trade name agreements, the contents and terms of which are confidential, to use and enforce the trademark and trade name TATA and to do business under the said trademark and trade name in India.

The trademark TATA is the subject of a large number of trademark registrations in several countries around the world. In India, the trademark TATA is household name, and everyone in India relates the trademark TATA to the values of integrity, responsibility, excellence, pioneering, unity. The trademark TATA forms a part of the trade names of nearly all the companies under the Complainants Group. A list of the Complainants trademark applications and registrations for trademarks TATA and TATA DIGITAL in India is enclosed as Annexure F with the complaint.

It is stated that the Complainant No. 2 has obtained registration of its trademark 'TATA DIGITAL' (wordmark) in classes 35, 36 and 42 (Certificate No. 2453935 Dated: 16/08/2020). The Registration Certificate is enclosed as Annexure G. Further Complainant No. 2 has also obtained registration of its trade mark 'TATA DIGITAL' (including corporate logo) in class 9 (Certificate No.

3438148 Dated• 06/03/2024), class 16 (Certificate No. 3442527 Dated: 08/03/2024), class 35 (Certificate No. 3434809 Dated: 03/03/2024), class 36 (Certificate 3450570 Dated: 12/03/2024), class 42 (Certificate 3443220 Dated: 09/03/2024). The Registration Certificate is enclosed as Annexure H. The Complainants Group owns the domain name <tata.com> registered since 15th October 1996. The Complainant has referred to Decision of Hon'ble Delhi High Court namely "tata Sons Limited v. Ramniwas & ors., 2016 SCC OnLine Del 6376, wherein the Hon'ble Delhi High Court held that "It is evident that the mark TATA has been used by the plaintiff for a long period of time and enjoys reputation and good will and has acquired the status of a "well-known " mark". The copy of judgment is enclosed with the complaint.

The Complainant has referred to various judgements wherein order were passed in favour of the complainant up holding the rights of the Complainant in the Tata Trade mark as per details given in the complaint. It is further stated that the Respondent in the present dispute registered the disputed domain name on March 28th, 2024, decades after the Complainants Group established its rights in the well-known trademark TATA. It is pertinent to note that the disputed domain name was registered subsequent to the incorporation Complainant no. 1 with the tradename 'Tata Digital Private Limited'. It is stated that the disputed domain has merely been parked and no commercial use of the domain is being made. The Respondent registered the present domain name with a view to earn profit by selling the domain or defrauding the people using trade name of Complainant no.1 TATA DIGITAL and well-known nature of the trademark TATA has incorporated it in the disputed domain name.

In order to succeed in the case the Complainant has to satisfy inter alia all the three conditions provided in clauses 4(a),4(b) and 4(c) quoted above i.e.

i.e. (a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(b) the Registrant has no rights or legitimate interests in respect of the domain name; and

(c) the Registrant's domain name has been registered or is being used in bad faith.

(a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

I have gone through the complaint and have perused all the documents on record. It is evident from above and documents annexed with the complaint that the complainant has sufficiently established its rights in and to the ownership of the **TATA and TATA DIGITAL** Trademarks

A mere perusal of the disputed domain name 'TATADIGITALMARKETING.IN' of the Registrant/Respondent shows that the Respondent has used the Complainant's trade mark 'TATA AND TATADIGITAL' in its entirety. It is well established that the mere addition of the Country Code Top Level Domain

Alok Kumar Jain

'in' does not add any distinctive or distinguishing element.

People accessing the disputed domain name, are likely to think that the disputed domain name is owned by the Complainants or is in some way connected with the Complainants. Complainant relies upon various panels decision as referred in the complaint.

In view of the above facts and submissions of the complainant, various panel decisions and on perusal of the documents annexed with the Complaint, I hold that the Disputed Domain Name <TATADIGITALMARKETING .IN> of the Registrant is identical or confusingly similar to the trademark TATA / TATADIGITAL of the Complainant.

Condition no.4 (b) the Registrant has no rights or legitimate interests in respect of the domain name:

A further perusal of the documents annexed with the complaint and perusal of averments made in the Complaint shows that the Registrant has no rights or legitimate interest in the disputed domain name. None of the ingredients of paragraph 6 of the policy are satisfied. Respondent is not commonly known by the disputed domain name. The Respondent has no rights over the trademark TATA or TATADIGITAL. The Respondent registered the disputed domain name in march 2024 decades after the use and trademark registrations of TATA by the Complainants Group. The Complainants Group has thus established rights in its trademark TATA dating back to 1968. The Complainants have establ Furthermore, the trademark TATA/TATA

DIGITAL has not been used by anyone other than the Complainants Group. It is obvious that it is the fame of the trademark that has motivated the Respondent to register the disputed domain name. The Complainant has not authorized the Respondent. Respondent's unlicensed and unauthorized use of domain name incorporating the Complainant's trademark will misleadingly divert consumers.

The Complainant has placed reliance on *Bruyerre S.A. v. Online Systems*, WIPO Case No. D2016-1686, where UDRP Panel found "Given that there is no active website associated with the Disputed Domain Name, the Panel does not find that the Respondent is making any use of the Disputed Domain Name within the meaning of paragraph 4(c) of the Policy, Rather, given that the Disputed Domain Name is identical to the Complainant's Trademark it gives the misimpression that the Respondent is the Complainant or is otherwise affiliated with the Complainant. Thus it is asserted that the Respondent's use of the disputed domain name is neither a bonafide offering of services, nor a legitimate non-commercial or fair use pursuant to Policy.

The Complainant has established that the Registrant has no rights or legitimate interest in respect of the Disputed Domain Name and has never been identified with the Disputed Domain Name or any variation thereof. The Registrant's use of the Disputed Domain Name will inevitably create a false association and affiliation with Complainant and its well-known trade mark .

Therefore, in view of the submissions made in the complaint and on perusal of the accompanying documents , I am of the opinion that the Respondent has

no rights or legitimate interests in respect of the domain name;

Accordingly I hold that the Registrant has no rights or legitimate interests in respect of the Disputed Domain Name.

Condition 4(C): the Registrant's domain name has been registered or is being used in bad faith

Clause 7 of INDRP Policy provides as under:

Clause 7. Evidence of Registration and use of Domain Name in Bad Faith

For the purposes of Clause 4(c), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

(a) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

(b) the Registrant 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 Registrant has engaged in a pattern of such conduct; or

AroK Kumar Jain

(c) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

It is stated that the disputed domain name completely incorporates the Complainants Group's trademark TATA and Complaint's tradename/trade mark TATA DIGITAL. Complainants Group's trademark TATA is a well-known trademark. The Respondent ought to have been aware of the fame, repute and goodwill of the Complainants since a simple trademark search at the time of the registration of the disputed domain name would have revealed the Complainants trademark rights. Also, TATA is household name in India and a simple search on the Internet would have revealed Complainant's presence and trademarks. Therefore the Respondent could not reasonably have been unaware of the fame of the TATA trademarks at the time of registration of the impugned domain name. The Respondent's bad faith is further evidenced from the fact that the Respondent registered the impugned domain name on 28h March 2024, years after the registration of the Complainants Group's trademark registrations in India. Also, the Respondent is bound to be aware of the incorporation of Complainant no. 1 as Tata Digital Private Limited' as use of the trademark TATA DIGITAL.

A perusal of the complaint and the documents filed shows that the Respondent has registered or acquired the Disputed Domain Name with dishonest intention to mislead and divert the consumers and to tarnish the well-known trademark/ corporate name/e TATA /TATA DIGITAL of the Complainant. The Respondent has registered for commercial gain and to benefit from the goodwill and fame associated with the Complainant's mark TATA/TATADIGITAL. There is likelihood that internet users will mistakenly believe that the disputed domain name and its associated websites are connected to the Complainant and its products. A Consumer searching for information concerning Complainant is likely to be confused as to whether the Respondent's Disputed Domain Name is connected, affiliated or associated with or sponsored or endorsed by Complainant. Respondent's bad faith registration of the disputed domain name is established by the fact that the disputed domain name completely incorporates the Complainant's TATA / TATADIGITAL mark.

In the case of **Pentair Inc. v. Bai Xiqing INDRP 827 (decided on November 10, 2016)** the panel had accepted that "the complainant has established its prior adoption and rights in the trade mark PENTAIR. Further the complainant's trade mark *applications were clearly made before the disputed domain name PENTAIR.IN was registered. The evidence on record shows that the complainant's trade mark is well-known. Thus, the choice of the domain name does not appear to be a mere*

36.

coincidence, but is a deliberate use of a well-recognized mark to attract unsuspecting users to the respondent's website, such registration of a domain name, based on awareness of a trade mark is indicative of bad faith registration under the Policy"

In the decision of prior Panel in *M/s Merck KGaA v Zeng Wei 1NDRP/323* it was stated that:

"The choice of the domain name does not appear to be a mere coincidence, but a deliberate use of a well-recognized mark... such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration. "

The Respondent had no reason to adopt an identical name/mark with respect to the disputed domain name except to create a deliberate and false impression in the minds of consumers that the Respondent is somehow associated with or endorsed by the Complainant, with the sole intention to ride on the massive goodwill and reputation associated with the Complainant and to unjustly gain enrichment from the same.

The facts and contentions enumerated in the complaint establish that Respondent's domain name registration for **< TATADIGITALMARKETING.IN >** is clearly contrary to the provisions of paragraph 4(c) of the INDRP and is in bad faith.

It is shown by the complainant that the Complainant is a well known reputed and global entity with extensive operations around the world since many decades. The

Registrant was most certainly was aware of the repute and goodwill of the Complainant. Therefore adoption of the substantially identical Disputed Domain Name by the Registrant in 2024 is with the sole intention to trade upon and derive unlawful benefits from the goodwill accruing to the Complainant. The Registrant has in fact knowingly adopted the Disputed Domain Name which wholly contains the Complainant's prior trademark **TATA/ TATADIGITAL** to attract customers to the Disputed Domain Name by creating confusion with the Complainant's reputed trademark .

In view of above facts, submissions of the Complainant and on perusal of the documents annexed with the Complaint , I find that the Complaint has proved the circumstances referred in Clause 7(a)(b) and (c) of INDRP policy and has established that the registration of disputed domain name is in bad faith.

Accordingly I hold that the Registrant's Domain Name has been registered in bad faith.

The Respondent has sent an email dated 30.7.24 addressed to NIXI stating as under:

"Dear Legal team,

I am not intended to use this domain anymore it was purchased by me because it was available I, don not want to use and I am ready to surrender it to you.

If there is any process for surrender this domain then please let me know.

You can ask the complaintent for the same.

Thanks & Regards

Miiraj shah

7990906908"

In view of above discussion and in view of reply of the Respondent, the Complainant is entitled for transfer of the disputed domain name to the Complainant.

5.

Decision

In view of the foregoing, I hold that the Disputed Domain Name is identical and or confusingly similar to the Complainant's well-known '**TATA / TATADIGIATAL**' Trademarks and that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith.

In accordance with the INDRP Policy and Rules, I direct that the Disputed Domain Name registration be transferred to the Complainant.

Delhi
Dated 9.08.2024


Alok Kumar Jain
Sole Arbitrator