



# INDIA NON JUDICIAL

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Unique Doc. Reference : SUBIN-DLDL-SELF53959074949584U  
Purchased by : SANJEEV CHASWAL  
Description of Document : Article 12 Award - Movable  
Property Description : ARBITRATION AWRD FOR TATAPLAY.IN  
Consideration Price (Rs.) : 100  
(One Hundred only)  
First Party : SANJEEV CHASWAL  
Second Party : NA  
Stamp Duty Paid By : SANJEEV CHASWAL  
Stamp Duty Amount(Rs.) : 100  
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IN THE MATTER OF  
ARBITRAL REFERENCE  
OF TATA PLAY. IN.

#### Statutory Alert

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**INDRP ARBITRATION  
UNDER THE NATIONAL INTERNET EXCHANGE OF INDIA [NIXI]  
ADMINISTRATIVE PANEL PROCEEDING  
SOLE ARBITRATOR: SANJEEV KUMAR CHASWAL**

In the matter of Arbitration Proceeding for the Domain name  
"TATAPLAY.IN"

AND IN THE MATTER OF INDRP CASE NO : 1478

Tata Sons Private Limited  
Bombay House  
24 Homi Mody Street  
Mumbai - 400001,

... Complainant

Vs.

Privacy Guardian  
PrivacyGuardian.org  
1928 E. Highland Ave. Ste F104  
PMB# 255 Phoenix  
AZ Zip Code 85016

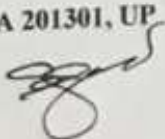
..... Respondent

**ARBITRATION AWARD**

Disputed Domain Name: *www.tataplay.in*

**1. The Parties:**

1.1 The Complainant in this arbitration proceeding is Tata Sons Private Limited Bombay House 24 Homi Mody Street Mumbai - 400001, Maharashtra to the National Internet Exchange of India (NIXI) the Complainant; represented by the Complainant's authorized representative Ms. Divya Balasundaram having its address at C 1/8 Sector 36, NOIDA 201301, UP



1.2 The Complainant has invoked this arbitration proceedings against the Registrant/ Respondent by raising plea of that the registration of the domain name <tataplay.in> in the name of the Registrant/ Respondent is contrary to and in violation of paragraph 4 of the INDRP rules and further transferring disputed domain name <tataplay.in> that was registered in the name of Registrant/ Respondent Privacy Guardian Privacy Guardian.org, 1928 E. Highland Ave. Ste F104 PMB# 255, Phoenix, AZ Zip Code 85016 to the Complainant.

## 2. The Domain Name and Registrar:

2.1 The disputed domain "www.tataplay.in" is registered by Registrant/ Respondent Privacy Guardian Privacy Guardian.org, 1928 E. Highland Ave. Ste F104 PMB# 255, Phoenix AZ Zip Code 85016 and the said disputed domain name is registered as "tataplay.in" through the registrar based in USA having its address M/s. NameSilo, LLC of 8825,N. 23rd Ave Suite 100, Phoenix, Arizona - 85021 USA, email: [support@namesilo.com](mailto:support@namesilo.com) who had registered the this disputed domain name for the registrant/ respondent herein.

## 3. Arbitration Proceedings Procedural History:

3.1 This is a arbitration proceeding initiated in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India ["NIXI"]. In accordance to the INDRP Rules of Procedure [the Rules] as approved by NIXI and the Indian Arbitration and Conciliation Act, 1996 has mandate to look in to disputes for registering the disputed domain name with the NIXI's accredited Registrar, the Complainant agreed to the resolution of the disputes pursuant to the IN Dispute Resolution Policy and Rules framed thereunder.

According to the information provided by the National Internet Exchange of India ["NIXI"], the history of this proceeding is as follows:





3.2 In accordance with the Rules, 2(a) and 4(a), NIXI formally notified the Respondent and the Complainant, and appointed the undersigned as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed and rules of .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder.

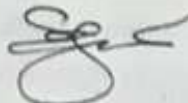
3.3 The Arbitrator has also submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI. As such NIXI on satisfaction of impartiality and independence of the arbitrator thus has allocated the matter as above to the arbitrator herein.

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

3.3 Present Arbitral Proceedings have commenced on 25<sup>th</sup> December 2021 against unknown Registrant/ Respondent who had registered domain name "*tataplay.in*" through the registrar based in USA having its address M/s. NameSilo, LLC of 8825, N. 23rd Ave Suite 100, Phoenix, Arizona – 85021 USA, email: support@namesilo.com, as the details of the Registrant/ Respondent were not made available in public domain by the registrar due to invoking of **REDACTED FOR PRIVACY** directions by the registrant/ respondent.

3.4 The complainant have submitted in their complaint that the complainant do not have the name, address details of the Registrant/ Respondent in their record, as the Registrar of the domain .IN registry has not uploaded the details with regard to the address of the Registrant/ Respondent more so even it is not available in WHOIS database too..

3.5 As such the undersigned being sole arbitrator had issued the directions to the complainant to serve the copies of the complaint to the the Registrant/ Respondent through Registrar of the domain name M/s. NameSilo, LLC Registrar based in USA, on 25th of December 2021 in the time bound manner, as prescribed under the INDRP ARBITRATION rules and Procedures.



3.6 That after completion 1<sup>st</sup> notice period of 15 days, the track report submitted by the complainant has indicated that the said courier has been delivered on 3rd of January 2022 to the Registrar of the domain name M/s. NameSilo, LLC who has registered domain name *"tataplay.in"* for the *present Registrant/ Respondent*. But even after receipt of the notice the registrar domain record doesn't show the address details of the Registrant/ Respondent *who has intently invoked the reference of REDACTED FOR PRIVACY* for domain name as such the information in relation to the Registrant/ Respondent, could not be served individually.

3.7 During the course of proceeding's the Registry.IN under NIXI had provided WHOIS record maintained by its Registrar based in USA the address of the Registrant/ Respondent who has registered domain name *"tataplay.in"* and the same was brought on record.

3.8 The Arbitrator is of the view that pursuing of the arbitral reference cannot be carried out without service to the Registrant/ Respondent herein and in view of availability of address of the Registrant/ Respondent based in USA through WHOIS record. As such keeping in view of current pandemic scenario as well as in the interest of justice the Complainant was again directed to serve the notice of this proceeding to the Registrant/ Respondent M/s Privacy Guardian, Privacy Guardian.org, 1928 E. Highland Ave. Ste F104, PMB# 255 Phoenix AZ Zip Code 85016 thereby granting one more opportunity of 10 days' through notice Dated 13<sup>th</sup> of January 2022, to submit their reply or detailed statement if any to sole arbitrator panel by 22nd of January 2022, it was also made clear that no further extension of extending the time period for submitting reply, statement will be acceded and in case of any default in filing reply or statement the right for the same shall be foreclosed. The Complainant was also directed to furnish proof of service and proof of delivery of the said courier / post that contains the said domain complaint to the Arbitrator with postal receipts/ courier receipts information if any as well as email online confirmation of receipt of notice by the respondent to the office of the arbitrator.

3.9 That despite of again issuance of notice to the registrant/ respondent, the registrant/ respondent had failed to submit its reply or detailed statement to the sole arbitrator panel office within prescribed time period after issuance of second notice dated 13<sup>th</sup> January 2022,



but the registrant/ respondent had failed to comply with the said 2<sup>nd</sup> notice dated 13<sup>th</sup> January 2022 as well.

**3.10** As per the record submitted by the complainant, it clearly shows that the Registrant / Respondent has been served through email and delivered to address mentioned in WHOIS record and even after receipt of second notice of 13<sup>th</sup> January 2022 as well as to 1<sup>st</sup> notice of 25<sup>th</sup> of December 2021 which was sent through its registrar and directly under rule 5(c) of INDRP Rules and procedure.

**3.11** The Arbitrator is of the opinion that the Registrant / Respondent herein despite of received electronic communication still the Respondent had failed to submit its reply or detailed statement to the sole arbitrator within 10 days of the second notice. Further the Registrant/ Respondent, who had intently invoked privacy reference of REDACTED FOR PRIVACY there by intently concealing material facts of the illegally registered domain name and address of the registrant from the public at large including the complainant herein in relation to registration of domain name, as such the information in relation to the Registrant/ Respondent was never made public by the registrar M/s. NameSilo, LLC as such the sole arbitrator is of the opinion that the conduct of the Registrant/ Respondent is shady.

**3.12** The Arbitrator is of the considered opinion and has come to conclusion that the Registrant / Respondent has intently and knowingly firstly adopted the domain name "*tataplay.in*" of third party Secondly, the present Registrant/ Respondent has intently invoked the privacy reference of **REDACTED FOR PRIVACY** and directed to registrar M/s. NameSilo, LLC to conceal the name of the present Registrant/ Respondent from domain record, hence the arbitrator is of the view that the Registrant/ Respondent is fully aware that he has adopted the domain name "*tataplay.in*" unauthorisedly despite of very much well aware of reputation attached to the domain name that belongs to third party.

**3.13** Keeping in view of the circumstances as stated above the arbitrator is of considered opinion that the Registrant/ Respondent is not interested in pursuing the present arbitration proceedings as such the sole arbitrator forecloses the opportunity of filing of reply or statement granted to the respondent to the unknown Registrant/ Respondent through its registrar and kept the complaint case for final orders on merits.



#### **4. Factual Background:**

**4.1** The Complainant, Founded by Jamsetji Tata in 1868, the Tata group is a global enterprise, headquartered in India, comprising over 100 independent operating companies across 100 countries spread over six continents, in various business sectors ranging from computers and computer software, electronics, chemicals, telecommunications, financial services, insurance, mutual funds, beverages, technology, retail, engineering, housing and real estate development, infrastructure, consulting, aviation etc. The Complainant herein includes its predecessors-in-interest, licensees, affiliates and associates.

**4.2** The counsel for the complainant submits that the Complainant is the promoter and principal investment holding company of the House of Tatas which is India's oldest, largest, most trusted and best-known business conglomerate. 66% (Sixty-six) of the equity share capital of the Complainant is held by philanthropic trusts, which support education, health, livelihood generation and art, culture and sports.

**4.3** The Tata group functions cast it in a rather unique position which is capitalistic by definition but socialistic by character and collectively employs over 800000 people. In 2020-21, the revenue of Tata companies, taken together, was \$103 billion (INR 7.7 trillion). There are 29 publicly-listed Tata enterprises with a combined market capitalisation of \$242 billion (INR 17.8 trillion) as on March 31, 2021. These companies include Tata Consultancy Services, Tata Motors, Tata Steel, Tata Chemicals, Tata Consumer Products, Titan, Tata Capital, Tata Power, Tata Advanced Systems, Indian Hotels and Tata Communications

**4.4** The Complainant and the Tata companies promoted by it and their subsidiaries and associates have always believed in returning wealth to the society they serve. Two-thirds of the equity share capital of the Complainant is held by philanthropic trusts that have created national institutions for science and technology, medical research, social studies and the performing arts. The trusts also provide aid and assistance to non-government organizations working in the areas of education, healthcare and livelihoods.

**4.5** . The Complainant's earliest registration for the trademark TATA dates back to the year 1942. Since then, it has obtained several registrations for the TATA marks in several

classes for different products. Particulars of a few of such notable registrations details were submitted by the complainant in the form list with several annexures and the same is part of the arbitral proceedings record.

4.6 The Complainant is the owner of the trade and corporate name and the well-known trademark TATA and variants thereof including **TATA** (the TATA marks). TATA is used not only as principal part of the corporate name of the Complainant, but is also the principal part of the corporate name of the various Tata companies. Use of TATA goes back to over 100 years.

4.5 The Complainant has also obtained many domain registrations with the TATA designation. A few of them are <tata.com>, <tatapowerco.com>, <tatahydro.com>, <tatawestside.com>, <tatahoneywell.com>, <tatateleservices.com>, <tatassl.com>, <tatatimken.com>, <jrdtata.com>, <ratantata.com>, <tata-groups.com>, <tata.org>. The domain <tata.com> was registered by the Complainant on October 15, 1996. Besides obtaining statutory rights in India, the Complainant has applied for and registered the TATA marks in different classes in jurisdictions outside India including in USA, Singapore, EU, Australia, Denmark, Indonesia and Ukraine.

4.7 The Complainant mark is well known world over but still place the fact that the complainant also owns hundreds of trademarks registrations having TATA word per se as well as with artistic work in India and worldwide and place one copyright in the artistic work



**TATA** and it is protected as such under the Copyright Act, 1957 vide Registration No. A-58314/2001. The Complainant has rigorously enforced its rights in the TATA name and mark through available means and has received favourable results as well. In fact, various judgments of the Hon'ble Courts and decisions of the WIPO Arbitration and Mediation Centre have recognized TATA as a household name and well-known trademark. Further, the TATA name and mark has been recognized as well-known by the Indian Trade Marks Office as well.



4.8 The Complainant submits in its complaint that the TATA name and mark is representative of its brand identity, business reputation and public identification not just in India but throughout the world. The Complainant and the Tata Companies have invested years of time, capital, effort and resources to attain the enormous and unparalleled goodwill and reputation that the TATA brand enjoys. As a matter of fact, TATA is among the world's most widely recognized brands and it has consistently held and retained the title of India's most valuable brand. In 2021, it is valued at US\$ 21.3 billion in 2021, up from US\$ 13.1 billion in 2017.

4.9 The Complainant's further submits in its complaint that the Complainant's exclusive proprietary rights in the TATA brand to the exclusion of all others stand well established. These rights are matters of public knowledge in India and abroad and the TATA brand can only be deemed famous and well-known throughout the world.

**5. Parties Contentions:**

The complainant has raised three pertinent grounds as per INDRP Rules of Procedure for seeking relief is stated as under:

**A. Complainant Grounds for proceedings**

- I. The Complainant counsel states that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has statutory/common law rights.*
- II. The Complainant counsel states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.*
- III. The Complainant counsel states that the disputed domain name has been registered or is/are being used in bad faith.*



**I) Background of the Complainant and its statutory and common law rights related prior adoption and use:**

The Complainant submits its contentions in its complaint that are described in details as under:

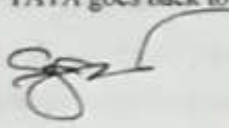
**5.1** The Complainant, Founded by Jamsetji Tata in 1868, the Tata group is a global enterprise, headquartered in India, comprising over 100 independent operating companies across 100 countries spread over six continents, in various business sectors ranging from computers and computer software, electronics, chemicals, telecommunications, financial services, insurance, mutual funds, beverages, technology, retail, engineering, housing and real estate development, infrastructure, consulting, aviation etc. The Complainant herein includes its predecessors-in-interest, licensees, affiliates and associates.


**5.2** The counsel for the complainant submits that the Complainant is the promoter and principal investment holding company of the House of TATA which is India's oldest, largest, most trusted and best-known business conglomerate. 66% (Sixty-six) of the equity share capital of the Complainant is held by philanthropic trusts, which support education, health, livelihood generation and art, culture and sports.

**5.3** The Complainant's earliest registration for the trademark TATA dates back to the year 1942. Since then, it has obtained several registrations for the TATA marks in several classes for different products. Particulars of a few of such notable registrations details were submitted by the complainant in the form list with several annexures and the same is part of the arbitral proceedings record.

**5.4** The Complainant is the owner of the trade and corporate name and the well-known trademark TATA and variants thereof including (the TATA marks). TATA is used not only as principal part of the corporate name of the Complainant, but is also the principal part of the corporate name of the various Tata companies. Use of TATA goes back to over 100 years.


**II) Complainant's Claim of Statutory Rights:**



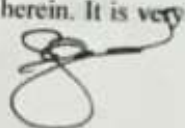
5.5 The Complainant also owns copyright in the artistic work  and it is protected as such under the Copyright Act, 1957 vide Registration No. A - 58314/2001. The Complainant has rigorously enforced its rights in the TATA name and mark through available means and has received favourable results as well. In fact, various judgments of the Hon'ble Courts and decisions of the WIPO Arbitration and Mediation Centre have recognized TATA as a household name and well-known trademark. Further, the TATA name and mark has been recognized as well-known by the Indian Trade Marks Office as well

5.6 The Complainant submits in its complaint that the TATA name and mark is representative of its brand identity, business reputation and public identification not just in India but throughout the world. The Complainant and the Tata Companies have invested years of time, capital, effort and resources to attain the enormous and unparalleled goodwill and reputation that the TATA brand enjoys. As a matter of fact, TATA is among the world's most widely recognized brands and it has consistently held and retained the title of India's most valuable brand. In 2021, it is valued at US\$21.3 billion in 2021, up from US\$13.1 billion in 2017.

5.7 The Complainant's further submits in its complaint that the Complainant's exclusive proprietary rights in the TATA brand to the exclusion of all others stand well established. These rights are matters of public knowledge in India and abroad and the TATA brand can only be deemed famous and well-known throughout the world.

5.8 The Complainant further submits that much of reputation and valuable goodwill have accrued to the Complainant and the TATA and its  due to its prior and continuous use. The Complainant's prominence in the global marketplace, including the Indian market, as well as its reputation for quality, has grown through the years all over the world.

5.9 The Complainant further submits that the disputed domain name *tataplay.in* and corresponding website of the Registrant / Respondent after registering the similar domain incorporating the word TATA has also tried to open up a website to claim and pass off the goodwill and reputation of the complainant herein. It is very much clear that the Registrant/





Respondent intentionally had registered and obtained registration of similar domain name having incorporated the word TATA in the said domain; as such this disputed domain is registered to the Registrant / Respondent and does not resolve to an active website. Rather, its landing page shows error under "Error 525 SSL handshake failed".


5.10 The Complainant further submits that the "overall impression" left by the domain name suggests that this domain name belongs to the Complainant in relation to its business in India and consumer confusion will inevitably result. The disputed domain name is meant to suggest an ownership by the Complainant and anyone coming across the disputed domain name or any website corresponding thereto will naturally assume that this name is owned or affiliated with the Complainant. It is thus in violation of the Complainant's rights

***1. The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.***

5.11 The Complainant complaint is based solely on the premise as being prior adopter and user of trademark TATA and its domain "*tataplay.in*" in worldwide of the said trademark for many years, submitted that it is the sole proprietor of and has sole and exclusive rights to use, the said trademarks, which includes the trademark 'Star Bucks' and '*www.tataplay.in*'.

5.12 The Complaint is the registered proprietor of the many marks having word per se and with logo TATA world over. The Complainant submits that as the disputed domain name is '*www.tataplay.in*' the disputed domain name is clearly identical/confusingly similar to the Complainant's trademark in which the Complainant has exclusive rights and legitimate interest.

5.13 That the Complainant has exclusive statutory and common law rights in the TATA brand and the TATA marks. It has been continuously and exclusively using the TATA brand in relation to its business since more than 100 years. The Complainant has made substantial expenditures incurred in promotion and advertising worldwide of the TATA brand and is exclusively associated with the Complainant and is an established 'well known' and India's most valuable brand. Accordingly, TATA is entitled to be protected against any misuse



whatsoever including that by the Respondent, who has registered the disputed domain name only in April 2021 i.e., over 150 years after the establishment of the House of Tata and over 100 years after TATA was used as a trademark.

5.14 The disputed domain is identical or at the very least confusingly similar to the Complainant's TATA brand. It wholly incorporates the Complainant's brand and registered mark TATA and couples it with the word PLAY, a generic term which is not sufficient to escape a finding of confusing similarity under the first element. PLAY does not serve to distinguish the disputed domain name from the Complainant's TATA brand in any way. Rather, PLAY is indicative of the Complainant's interest and contribution in sports and increases the element of confusion. The Complainant submits that it is also a settled principle that the mere addition of a descriptive term or a non-significant element does not prevent a finding of confusing similarity.

5.15 The Complainant further submits that the "overall impression" left by the domain name suggests that this domain name belongs to the Complainant in relation to its business in India and consumer confusion will inevitably result. The disputed domain name is meant to suggest an ownership by the Complainant and anyone coming across the disputed domain name or any website corresponding thereto will naturally assume that this name is owned or affiliated with the Complainant. It is thus in violation of the Complainant's rights.

II) The Respondent has no rights or legitimate interests in respect of the disputed domain name

5.16 The Respondent appears to be an individual / entity based in Arizona, USA. It is submitted that the individual/ entity is not connected with the Complainant in any manner and the Complainant has no knowledge of any business conducted by the Respondent under TATAPLAY. The Complainant has not authorized or licensed the Respondent to apply for, register, use or offer for sale the disputed domain name or the TATA trademark forming part thereof

5.17 There is no evidence that the Respondent is conducting any legitimate business

under TATAPLAY to warrant registration of the disputed domain name in his / its own name; to the best of the Complainant's knowledge, the Respondent is not known by the disputed domain name and there is no evidence that he / it has any trademark rights in TATAPLAY. The Respondent has also not made any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services; the disputed domain name leads to a page with an error under Error 525. It is not and cannot be regarded as legitimate or fair use of the disputed domain name by the Respondent.

5.18 The Respondent's registration of the disputed domain name is much subsequent to the Complainant's use and registration of the TATA name and mark. It is also settled that mere registration of a domain name does not give rise to a 'legitimate interest'.

5.19 For last over 80 years the Tata group made a specific commitment to backing sports and sportspeople in an India and set up the Tata Sports Club in 1937. Companies such as Tata Steel, Tata Power, Tata Motors and Indian Hotels employed emerging sporting talents to provide a stage from where they could display their ability and maximise their potential. Tata Sports Club supplemented such backing by putting together squads that went on to dominate their respective sports such as hockey, football, cricket, athletics and more on the national stage.

5.20 The Respondent's registration of the disputed domain name is much subsequent to the Complainant's use and registration of the TATA name and mark. It is also settled that mere registration of a domain name does not give rise to a 'legitimate interest'.

*III) The Respondent's disputed domain name has been registered or is being used in bad faith.*

5.21 The Complainant counsel has stated in their complaint that the Respondent's adoption and registration of the disputed domain name "[www.tataplay.in](http://www.tataplay.in)" is dishonest and malafide. The Respondent had no previous connection with the disputed domain name [www.tataplay.in](http://www.tataplay.in) and has clearly registered the disputed domain name in order to prevent the Complainant to



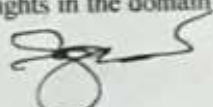


own this domain, who is the owner of the said trademark from reflecting the said trademark in a corresponding domain name "*www.tataplay.in*".

5.22 The Complainant counsel has stated in their complaint that the Respondent has constructive notice of the name and mark TATA and was or should have been aware of the Complainant's prior rights in the TATA name and mark at the time of registering the disputed domain name. The Complainant has been using the TATA brand since more than 100 years in India and at least since 1945 in USA and it has worldwide reputation and has substantial presence on the Internet. The bad faith of the Respondent in registering the disputed domain name is established from the fact he/it has registered the disputed domain name by adopting the well-known TATA name and mark.

5.23 It was further submitted that the intention of obtaining the registration of the disputed domain name *tataplay.in* by the Registrant / Respondent disrupts the business and other interests of the Complainant as it may want to adopt TATAPLAY for any of its businesses or philanthropic activities but is not be able to. Further, the disputed domain name causes a false association with the Complainant's TATA brand and will lead the average Internet user to believe that the disputed domain name is owned by the Complainant and could relate to genuine TATA goods and services. As such, when consumers see the disputed domain name, they will believe that the Complainant owns the disputed domain name. Any realistic use of the disputed domain name will automatically misrepresent an association between the Registrant / Respondent and the Complainant leading the members of the public to believe that the Complainant has licensed the use of the domain name to the Registrant / Respondent or has authorized the Registrant / Respondent to register the same, resulting in unfair trade competition/passing off and trademark infringement, at a minimum, under Indian law.

5.24 It was further submitted that the Registrant / Respondent has concealed complete and authentic contact details intently through Registrar and so the complainant may not be able to know or carry out the communications with the Registrant / Respondent. It is therefore clear that the Registrant / Respondent has no legitimate rights in the domain name and is acting in bad faith.



## B. Contention of the Complainant

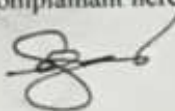
5.25 The the Registrant / Respondent has concealed complete and authentic contact details intently through Registrar and so the complainant may not be able to know or carry out the communications with the Registrant / Respondent. Further Registrant / Respondent has not filed any response to the Complaint though they were given an opportunity to do so. Thus the Complaint had to be decided solely on merit and based on submissions made on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 4 of the policy and rules thereunder.

5.26 The Arbitrator is of the considered opinion that the Registrant/ Respondent herein despite of received electronic communication still the Respondent had failed to submit its reply or detailed statement to the sole arbitrator within 10 days of the second notice. Further the Registrant/ Respondent, who had intently invoked privacy reference of **REDACTED FOR PRIVACY** there by intently concealing material facts of the illegally registered domain name and address of the registrant from the public at large including the complainant herein in relation to registration of domain name, as such the information in relation to the Registrant/ Respondent was never made public by the registrar M/s. NameSilo, LLC as such the conduct of the Registrant/ Respondent of the domain name *tataplay.in* is shady.

## 6. Discussion and Findings:

6.1 As per the pleadings placed before me by the complainant that the Registrant / Respondent does not have any business relationship with the business of the Complainant or with any of its subsidiaries or any legitimate interest in the mark / brand *tataplay.in*. Moreover, the Complainant has neither given any license nor authorized the Registrant/ Respondent to use the Complainant's domain *tataplay.in*. The Registrant / Respondent has nothing to do even remotely with the business of the Complainant. The Respondent has never been commonly known by the domain name in question.

6.2 After going through the pleadings of the complainant herein, it clearly shows that the



Registrant / Respondent has register the domain name to just to squat on it without any legitimate interest and is trying to use goodwill of third party by making a unfair use of the domain name. It is apparent that use of a mark must be a bona fide one, and not a token or colourable one, merely to gain protection under trade mark law, in order for it to enjoy protection under the US trade mark law regime.

6.2 Once a complainant makes a prima facie case showing that a respondent lacks rights to the domain name *tataplay.in* at issue in hand, the respondent must come forward with the proof that it has some legitimate interest in the domain name to rebut this presumption. As in the case of *Manish Vig Vs Indira Chugh*<sup>1</sup> AIR 2002 Del 243 the Delhi High court has defined cybersquatting as "an act of obtaining fraudulent registration of domain name with intent to sell it to the lawful owner of the name at a premium" in another case squatting in *Shields Vs Zuccarini* 254 F 3d 476(3dCir,2001) the court has defined as an expression that has come to mean the bad faith, abusive registration and use of the distinctive trademarks of others as internet domain names, with the intent to profit from the goodwill associated with those trademarks.

**[a] The Respondent's Default:**

6.3 As per INDRP Rules of Procedure, it require as defined under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. The above Rule 8(b) be read as follows

*"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case."*

6.4 Further the Rule 11(a) of INDRP Rules of Procedure, as it empowers the arbitrator to move on with an ex parte decision in case any party, that does not comply with the time limits or fails to reply against the complaint.

The Rule 11(a) of INDRP Rules of Procedure as defined as under:



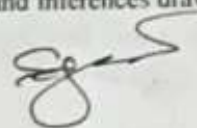


*" In the event that a Party, in the absence of exceptional circumstances as determined by the Arbitrator in its sole discretion, does not comply with any of the time periods established by these Rules of Procedure or the Arbitrator, the Arbitrator shall proceed to decide the Complaint in accordance with law."*

6.5 The Respondent was given notice of this administrative proceeding in accordance to above the Rules. The IN Registry discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Registrant / Respondent of the Complaint. It was further submitted that the Registrant / Respondent has concealed complete and authentic contact details intently through Registrar and so the complainant may not be able to know or carry out the communications with the Registrant / Respondent .

6.6 That after receipt of the email notice it clearly shows that the Registrant / Respondent was fully aware of this arbitral proceeding and intently has avoided of his participation in the same. Further the Registrant / Respondent has failed to file any reply to the Complaint and has not sought to answer nor presented the counter for assertions, evidence or contentions of the complainant in any manner. The arbitrator opined that the Registrant / Respondent had been given a fair opportunity to present his case, but on the basis of non-filing of the reply by the Registrant / Respondent, it clearly proved that the respondent is not interested in appearing in before the Arbitrator, as such the arbitrator has no alternative other than to proceed to decide on the Complaint of the complainant on to its merit and in accordance to laws..

6.7 The Rules paragraph 12(a) provides that the Arbitrator shall decide the Complaint on the basis of the statements and documents submitted in accordance with the INDRP and any law that the Arbitrator deems fit to be applicable. In accordance with the Rules paragraph as per 12, the Arbitrator may draw such inferences as are appropriate from the Registrant / Respondent's failure to reply to the Complainant's assertions and evidence or to otherwise contest the Complaint. In the circumstances, the Arbitrator's decision is based upon the Complainant's assertions and evidence and inferences drawn from the Registrant / Respondent's failure to reply.



**[b] The issues involved in the dispute:**

As per the complaint herein, the Complainant in its complaint has invoked paragraph 4 of the INDRP which read as under:

**"Brief of Disputes:**

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

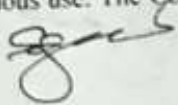
- (i) the Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;**
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and**
- (iii) the Respondent's domain name has been registered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

6.8 The Registrant / Respondent is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder."

6.9 According to paragraph 4 of the INDRP, there are 3 essential elements of a domain name dispute which are being discussed hereunder in the light of the facts and circumstances of this case.

- I. The Respondent's domain name is identical and confusingly similar to a name, trademark or service in which the Complainant has rights.**

6.10 It has been proved by the Complainant that it has intellectual property, particularly trademark, and other rights in the mark "TATA" by submitting substantial documents of its prior adoption and continuous use. The Complainant counsel states that the Complainant has



exclusive statutory and common law rights in the TATA brand and the TATA marks. It has been continuously and exclusively using the TATA brand in relation to its business since more than 100 years. The Complainant has made substantial expenditures incurred in promotion and advertising worldwide of the TATA brand and is exclusively associated with the Complainant and is an established 'well known' and India's most valuable brand. Accordingly, TATA is entitled to be protected against any misuse whatsoever including that by the Respondent, who has registered the disputed domain name only in April 2021 i.e., over 150 years after the establishment of the House of Tata and over 100 years after TATA was used as a trademark.

**Paragraph 3 of the INDRP is reproduced below:**

*"The Respondent's Representations:*

*By applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Respondent represents and warrants that:*


*the statements that the Respondent made in the Respondent's Application Form for Registration of Domain Name are complete and accurate; to the Respondent's knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; the Respondent is not registering the domain name for an unlawful purpose; and the Respondent will not knowingly use the domain name in violation of any applicable laws or regulations. It is the Respondent's responsibility to determine whether the Respondent's domain name registration infringes or violates someone else's rights."*

6.11 The Registrant / Respondent has failed in his responsibility as discussed above and in the light of the pleadings and documents filed by the Complainant, I have come to the conclusion that the disputed domain name **tataplay.in** is identical with or deceptively similar to the Complainant's "TATA" mark. Accordingly, I conclude that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP.

6.12 The impugned domain name **tataplay.in** is comprised of the Complainant's trademark TATA in toto. Therefore, the domain name **tataplay.in** is visually, phonetically, conceptually, deceptively and confusingly identical and similar to





Complainant's corporate and trade name TATA, trade mark TATA,  and also wholly similar to the Complainant's domains *tata.com* and *tata.co.in*.

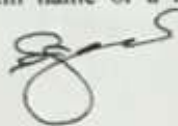
**II. The Respondent has no rights or legitimate interests in respect of the disputed domain name**

**6.13** The second element that the Complainant needs to prove and as is required by paragraph 4(ii) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

**6.14** The Registrant / Respondent has never used the disputed domain name or any trademark similar to the disputed domain name prior to the registration of the disputed domain name in its favour. The Registrant / Respondent has also not used the disputed domain name as a trademark or a service mark in connection with any goods or services after the registration of the disputed domain name *www.tataplay.in* in its favour. The Registrant / Respondent has also not have owner ship rights on the mark TATA trademark in its favour in India.

**6.15** Moreover, the Complainant has able to prove that the respondent is using the domain name without any legal authorization of the complainant and regarding this element in the domain name lies most directly within the Registrant / Respondent's knowledge and once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the evidentiary burden shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name.

**6.16** The Registrant / Respondent has failed to rebutt the contentions of the Complainant and has also failed to produce any documents or submissions to establish his interest in protecting his own legitimate right and interest in the impugned domain name "*www.tataplay.in*". It is very crystal clear that the respondent is very much well aware of reputation attached to the domain name "*tataplay.in*" and the Registrant / Respondent has not used the domain name or a name corresponding to the disputed domain name in



connection with a bonfide offer of goods or services. Further, the Registrant / Respondent is not commonly known by the disputed domain name and has not made any legitimate non-commercial or fair use of the disputed domain name. Thus, it is very much clear that the Respondent has no legitimate right or interest in respect of the disputed domain name **www.tataplay.in**

For these reasons, the Arbitrator opines that the Registrant / Respondent have no right or legitimate interest in the disputed domain name and the disputed domain name is being used unauthorizedly by the Registrant / Respondent herein.

**The disputed domain name has been registered or is being used in bad faith.**

6.17 It has been contended by the Complainant that the Registrant / Respondent has registered intently the disputed domain name in bad faith. The language of the INDRP paragraph 4(iii) is clear enough, and requires that either bad faith registration or bad faith use be proved.

6.18 The paragraph 6 of the INDRP Rules provides that the following circumstances are deemed to be evidence that a Respondent has registered and used a domain name in bad faith:

*"Circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or the Respondent 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 Respondent has engaged in a pattern of such conduct; or by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location."*



**6.19** From the circumstances of the case and from the evidences placed before me by the Complainant herein, I am of the considered opinion that the Registrant / Respondent had no previous connection with the disputed domain name and has clearly registered the disputed domain name as squatter, in order to prevent the Complainant, who is the owner of the said trademark from reflecting the said trademark in a corresponding domain name.

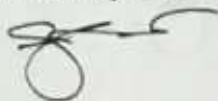
**6.20** Moreover, use of similar disputed domain name *www.tataplay.in* by the Respondent, would certainly result in to confusion and deception of the trade, consumers and public, who would assume a connection or association between the Complainant and the Respondent's website or other online locations of the Respondents or its product / services on the Respondent's website, due to the use by Respondent of the Complainant's said trademark in the disputed domain name, which trademarks have been widely used and advertised in India and all over the world by the Complainant and which trademarks are associated exclusively with the complainant, by the trade and public in India and all over the world.

**6.21** Further the Registrant / Respondent has prevented the Complainant, who is the owner of the service mark "TATA" from reflecting in the domain name and also that the domain name *tataplay.in* is deceptively similar to the trademark of the Complainant and will lead to confusion with the Complainant's mark "TATA" as to the source, sponsorship, affiliation or endorsement of the Registrant / Respondent's website or service. Moreover, the Registrant / Respondent has not given any proper contact details and has intently avoided to disclose the detail of address etc on the registrar records.

Thus, all the three conditions given in paragraph 6 of the Rules are proved in the circumstances of this case and thus the registration of the impugned domain name of the Registrant / Respondent is a registered in bad faith.

## **7. DECISION**

**7.1** Thus the Registrant / Respondent has failed to comply with Para 3 of the INDRP, which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by the Respondent that the domain name registration does





not infringe or violate someone else's rights other than the complainant herein.

7.2 The Complainant counsel has given sufficient evidence to prove trademark rights on the disputed domain name *www.tataplay.in*. Further; the Respondent's adoption and registration of the disputed domain name is dishonest and malafide. The Registrant / Respondent had no previous connection with the disputed domain name and have clearly registered the disputed domain name in order to prevent the Complainant who is the owner of the said trademark from reflecting the said trademark in a corresponding domain name.

7.3 The Registrant / Respondent has not given any reason to register the domain name *www.tataplay.in* rightfully owned by the Complainant and therefore it can be presumed that the Registrant / Respondent had registered the domain name only to make monetary benefit by selling the domain name to the rightful owner or his competitor.

*[Relevant WIPO decisions:*

*Uniroyal Engineered Products, Inc. v. Nauga Network Services* D2000-0503; *Thaigem Global Marketing Limited v. Sanchai Aree* D2002-0358; *Consorzio del Formaggio Parmigiano Reggiano v. La casa del Latte di Bibulic Adriano* D2003-06611

7.4 While the overall burden of proof rests with the Complainant, The panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Registrant / Respondent. Therefore a complainant is required to make out a *prima facie* case that the Registrant / Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, Registrant / Respondent carries the burden of demonstrating rights or legitimate interests in the domain name.

Thus it is very much clear that the Registrant / Respondent is using the disputed domain name in bad faith and 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.



*[Relevant WIPO decisions: Croatia Airlines d.d. v. Modern Empire Internet Ltd. D2003-0455; Belupo d.d. v. WACHEM d.o.o. D2004-01101]*

7.5 The Complainant counsel has submitted that given the identity of the impugned domain name <tataplay.in> with the Complainant's name and trade mark TATA, the same is bound to cause confusion and deception in the minds of the public that the Registrant / Respondent has some connection, association or affiliation with Complainant, when it is not so. It has been held by prior panels deciding under the INDRP that incorporating a trademark in its entirety (particularly a well-known trade mark such as TATA) is sufficient to establish that the domain is identical or confusingly similar to the Complainant's registered mark.

*(Reliance placed on TATA Corporation v. Aditya Khanna INDRP/614). Further, a TLD/ccTLD such as ".org.in" is an essential part of domain name. Therefore, it cannot be said to distinguish the Respondent's domain name <TATAPLAY.IN> from the Complainant's trademark TATA.*

7.6 The disputed domain is identical or at the very least confusingly similar to the Complainant's TATA brand. It wholly incorporates the Complainant's brand and registered mark TATA and couples it with the word PLAY, a generic term which is not sufficient to escape a finding of confusing similarity under the first element. PLAY does not serve to distinguish the disputed domain name from the Complainant's TATA brand in any way. Rather, PLAY is indicative of the Complainant's interest and contribution in sports and increases the element of confusion. The Complainant submits that it is also a settled principle that the mere addition of a descriptive term or a non-significant element does not prevent a finding of confusing similarity.

*Starbucks Corporation v.Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2019-1991.*

7.8 It has also well-settled and has been held by various Panels deciding under UDRP and INDRP that where the disputed domain name wholly incorporates the Complainant's



registered trademark, the same is sufficient to establish the first element.

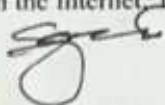
*Tata Sons Ltd v. mmt admin / Oktatabyehye.com (WIPO Decision Case No. D2009-0646), F. Hoffmann-La Roche AG v. Jason Barnes, ecnopt, WIPO Case No. D2015-1305, Swarovski Aktiengesellschaft v. mei xudong, WIPO Case No. D2013-0150, Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union, WIPO Case No. D2013-1304*

7.9 The Complainant counsel further placed his reliance on a prior decision of this Panel in M/s *Retail Royalty Company v. Mr. Folk Brook INDRP/705* wherein on the basis of the Complainant's registered trademark and domain names for "AMERICAN EAGLE", having been created by the Complainant much prior to the date of creation of the disputed domain name <americaneagle.co.in> by the Respondent, it was held that

*"The disputed domain name is very much similar to the name and trademark of the Complainant. The Hon'ble Supreme Court of India has recently held that the domain name has become the business identifier. A domain name helps identify the subject of trade or service that entity seeks to provide to its potential customers. Further that there is strong likelihood confusion that a web browser looking for AMERICAN EAGLE products in India or elsewhere would mistake the disputed domain name as of the Complainant. "*

7.10 It was observed that "it is the Registrant's responsibility to determine whether the Registrant's domain name registration infringes or violates someone else's rights" and since the Respondent failed to discharge such responsibility, it was held that the Complainant has satisfied the first element required by Paragraph 4 of the INDRP. In the present dispute as well, the Respondent, in registering the disputed domain name, has done so in clear violation of the exclusive rights of the Complainant in the TATA name and mark. In *Lockheed Martin Corporation v. Aslam Nadia (INDRP/947)*

7.11 The Complainant has been using the TATA brand since more than 100 years in India and at least since 1945 in USA and it has worldwide reputation and has substantial presence on the Internet. The bad faith of the Respondent in registering the disputed domain





name is established from the fact he/it has registered the disputed domain name by adopting the well-known TATA name and mark.

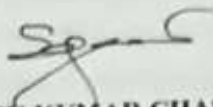
*The WIPO Administrative Panel in Veuve Clicquot Ponsardin, Maison Fondée en 1772 vs. The Polygenix Group Co., WIPO Case No.D2000-0163 has been held that registration of a domain name so obviously connected with a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith. The Respondent is also guilty of the same*

7.12 The Registrant / Respondent's registration and use of the Domain Name is abusive and in bad faith. The Registrant / Respondent have no rights or legitimate interests in respect of the domain name. In my view, the Complainant has satisfied all the three requisite conditions laid down in paragraph 4 of the INDRP policy.

In accordance to the INDRP defined Policy and Rules, the sole arbitrator directs that the disputed domain name [www.tataplay.in](http://www.tataplay.in) be transferred from the Registrant / Respondent to the Complainant herein with a request to NIXI to monitor the transfer of domain name in time bound manner.

NEW DELHI

DATE 27-01-2022

  
SANJEEV KUMAR CHASWAL  
SOLE ARBITRATOR  
INDRP ARBITRATION NIXI