

## **ADMINISTRATIVE PANEL DECISION**

Tata Sons Private Ltd. and Tata Teleservice Limited v. Private Registration, NameBrightPrivacy.com / PebbleBridge Tech, PebbleBridge Technologies  
Case No. D2022-1038

### **1. The Parties**

The Complainants are Tata Sons Private Ltd., India (the First Complainant) and Tata Teleservice Limited, India (the Second Complainant), represented by Anand & Anand, India.

The Respondent is Private Registration, NameBrightPrivacy.com, United States of America / PebbleBridge Tech, PebbleBridge Technologies, India.

### **2. The Domain Name and Registrar**

The disputed domain name <tataphoton.com> is registered with DropCatch.com LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 25, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 28, 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 April 4, 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 April 5, 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 April 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2022. Aside from an informal communication, the Respondent did not submit any formal response. Accordingly, the Center notified the parties of the Panel Appointment process on May 6, 2022.

The Center appointed Harini Narayanswamy as the sole panelist in this matter on May 11, 2022. 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 paragraph 7 of the Rules.

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

The First Complainant was established in 1917 and is the registered proprietor of the TATA trademarks in India and internationally. The Second Complainant is a subsidiary of the First Complainant and is engaged in the business of providing communication services for businesses in India and hosts a website at "www.tatateleservices.com". The Second Complainant was earlier engaged in the business of providing mobile and Internet services under the business name "Tata Docomo", using the trademark TATA PHOTON and the disputed domain name in connection with its business.

The Complainants own trademark registrations for the TATA PHOTON mark and its variants. For instance, the First Complainant holds trademark registration TATA INDICOM'S I-PHOTON number 1683000, with a filing date of May 2, 2008; TATA INDICOM'S PHOTON trademark registration number 1683001 with a filing date of May 2, 2008; TATA PHOTON + trademark registration number 1945085, with a filing date of April 1, 2010; and TATA PHOTON TV trademark registration number 1945087, with a filing date of May 11, 1989. The Second Complainant owns several trademark registrations for PHOTON and its formative marks such as trademark PHOTON + registration number 2949735, with a filing date of April 24, 2015; and PHOTON MAX registration numbers 2949738, with a filing date of April 24, 2015; and trademark PHOTON WIZ registration number 2949741, with a filing date of April 24, 2015..

The disputed domain name was registered by the Respondent on October 13, 2020. According to the information in the Case File, the website to which the disputed domain name resolved, displayed content that was previous used by the Second Complainant on their website at "tataphoton.com". Currently, the disputed domain name resolves to an inactive website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainants state that its group is India's oldest, largest and best-known business conglomerate with a turnover exceeding USD 100 billion in 2016-17, and 64 percent of its revenue is from its business outside India. The Complainants contend that it is the largest private sector employer and consists of over 100 companies, 29 of which are listed in stock exchanges and a UK based consultancy has valued it at over USD 14.24 billion in 2018. The First Complainant is the promoter and principle investment holding company of the "House of Tata".

The Complainants state that in 2019, the Second Complainant sold its business of Internet and mobile services to Bharti Airtel Limited. The Complainants state that it stopped using the disputed domain name and website after the business was sold. In October 2020 the Respondent registered the disputed domain name. The Complainants state that the Respondent has displayed the website content that the Second Complainant had previously used, which is its copyrighted material. According to the Complainants, the Respondent is trying to impersonate the Second Complainant with the intention of cheating the public to extort money. The Complainants argue that the Respondent is misleading the public.

The Complainants further argue that the TATA trademark and the TATA PHOTON marks are well-known due to its extensive use, and the marks have been recognized by several courts. The Complainants have provided evidence of numerous court decisions and various forum decisions, including UDRP WIPO decisions, upholding its rights in the TATA formative marks. The Complainants state that its group owns numerous domain names and has a large Internet presence.

The Complainants assert that the Respondent's registration of the disputed domain name misappropriates its TATA, TATA PHOTON and PHOTON trademarks. The Complainants request for transfer of the disputed domain name on the grounds that it is identical or confusingly similar to a trademark in which it has rights, the Respondent lacks rights or legitimate interests in the disputed domain name and the disputed domain name has been registered and is being used in bad faith by the Respondent.

## **B. Respondent**

The Respondent did not file a formal response but sent an informal email communication to the Center on April 1, 2022. The email communication from the Respondent is reproduced here:

"Good Morning Team, Have I made any violations? We just bought a domain, which is available to register and we are not using it in anyway."

The Complainants' counsel replied to this email, enquiring whether the Respondent wished to settle the case but there were no further communications between the parties in this regard.

## **6. Discussion and Findings**

The Policy under paragraph 4 (a), requires the Complainants to establish three elements to obtain the remedy of transfer of the disputed domain name, these are:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent lacks rights or legitimate interests in the disputed domain name; and
- (iii) The disputed domain name was registered and is being used in bad faith by the Respondent.

### **A. Identical or Confusingly Similar**

The first element requires the Complainants to establish rights in the trademarks or service marks pertaining to this dispute, and that the disputed domain name is identical or confusingly similar to the trademarks or service marks in which it has rights.

The Complainants have filed evidence of its numerous registered trademarks for the TATA marks and TATA PHOTON marks and its variants. Under the UDRP, registered trademarks *prima facie* satisfies the threshold requirement of having trademark rights, for the purposes of demonstrating rights under the first element. See Section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([WIPO Overview 3.0](#)).

The Complainants have not made any explicit submission whether the TATA PHOTON brand or trademarks were transferred when the Second Complainant's business was sold to Bharti Airtel Limited in 2019. However, based on the trademark records, that show the Complainants continue to be named as the proprietors of the said marks, the Panel finds that the Complainants have proven their rights in the TATA PHOTON marks its variants. The TATA and TATA PHOTON trademarks are recognizable in the disputed domain name, which is found to be confusingly similar to the Complainants' marks.

The Panel finds that the Complainants have met the requirements under the first element of paragraph 4 (a) of the Policy.

### **B. Rights or Legitimate Interests**

The Complainants need to make a *prima facie* case that the Respondent lack rights or legitimate interests in the disputed domain name under the second element.

The Complainants have argued that the Respondent is not its affiliate and is not authorized to use its marks and has no rights or legitimate interests in the disputed domain name. The Complainants further argue that the Respondent's use of disputed domain name is not *bona fide* use, as the webpage replicates the content

that was previously used by the Second Complainant on its website, which suggests an affiliation with the Complainants, when no such affiliation exists. The Respondent did not formally respond or take part in these proceedings or rebut the Complainants' allegations.

The Complainants have established that the TATA mark has been used extensively by the First Complainant for a number of years, and the Second Complainant has used disputed domain name till 2019. The fact that the Respondent has registered the disputed domain name, almost immediately after the Second Complainant ceased using it, in the Panel's view, indicates opportunistic registration with an intention to draw web traffic based on the Second Complainant's prior use of its mark and the disputed domain name in connection with mobile and Internet services.

There is no evidence on record that shows the Respondent is known by a business name or a similar name to the disputed domain name. The Panel finds that the disputed domain name has been used by the Respondent for displaying content identical to what was earlier used by the Second Complainant. Such use of the disputed domain name by the Respondent does not constitute *bona fide* use, or legitimate noncommercial fair use, and does not indicate that the Respondent has any rights or legitimate interests in the disputed domain name.

The Complainants have made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name under the second element.

### **C. Registered and Used in Bad Faith**

The third element under paragraph 4(a) of the Policy requires the Complainants to establish the disputed domain name has been registered and is being used in bad faith by the Respondent. Bad faith is generally found when the preponderance of facts and circumstances of the case, indicate that a respondent has targeted a complainant's mark with a view to derive unfair advantage. See Section 3.1, [WIPO Overview 3.0](#).

The Panel finds the Respondent has likely registered the disputed domain name through a drop catch service. Dropped domain names are basically expired domain names that are not renewed. Drop catch services use software to track such expired domain names and assist for registration of such dropped domain names. See *Discovery Holidays Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. [DAU2021-0027](#). Extracted here is a reference note about drop catching from this case:

"Drop catching involves the drop catching site hosting an auction of soon to be deleted domain names, which it then subsequently registers in the name of the winning bidder.... On the Registrar's website it is stated: A drop catching service allows a person to lodge a pre-application for a domain name before it is due to drop, and then uses a special software program to attempt to "catch" the domain name at the registry as soon as it drops."

Drop-catching registrations are to be distinguished from other domain name registrations, as the registrant is aware of the fact of a previous registrant and that the domain name that was dropped or not renewed, and depending on the specific circumstances thereby may be said to be on notice of the previous owner's trademark rights in the domain name. See *Supermac's (Holding) Limited v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2018-0540](#). Also see *Reflex Marketing, LLC v. Mars Nic / Fei Guo / Ming Guo*, WIPO Case No. [D2019-2621](#). Drop caught registrations may also have archived content displayed, and respondents may be said to be on notice of the significance of the domain name and its association with the previous owner, who may be a the trademark owner.

Although drop catching, involves the use of automated process and software to identify the dropped domain name, the overall objective leading to the Respondent's choice of registration of the disputed domain name here appears to be deliberate and with an intention to benefit from the web traffic the Complainant's mark has generated . The web traffic is then redirected to the Respondent's online location. The reasoning expressed by panels in previous cases, such as in *Mr. Hubert Barbier dit Barrere v. Kun Yang Liu*, WIPO Case No. [D2020-1506](#), where the respondent had used drop catch services, and the panel in that case found that the respondent had registered the domain name with prior knowledge of the complainant's rights,

yet acquired the disputed domain name “in reckless disregard” of the complainant rights is to gain web traffic from the registration and use of the disputed domain name in bad faith. The Panel finds that the Respondent in the present case has also targeted the disputed domain name in a similar fashion, for purposes of gaining web traffic associated with the Complainants’ marks and the previous use of the disputed domain name by the Complainants, without regard to the Complainants’ rights in the corresponding trademark.

The Complainants have provided evidence that establishes the reputation associated with the TATA mark. Given the prior use of the TATA PROTON mark by the Complainants in connection with their mobile and Internet business, the Respondent ought to have known of the amount of web traffic that the disputed domain name was generating prior to registration of the disputed domain name. The logical inference that can be drawn from these circumstances, is that the disputed domain name ought to have been registered and used for purposes of impersonating the Second Complainant to attract web traffic to the Respondent’s online location.

The Panel finds that the Respondent has intentionally attempted to attract Internet users to his website by creating a like hood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement and a logical extension of which is, the increased web traffic that the Respondent can expect from use of the Complainant’s mark, which is bad faith registration and use under paragraph 4(b)(iv) of the Policy. The overriding objective of the Policy is to curb abusive registration of domain names where the registrant seeks to gain from use of the trademark of another for deriving unfair advantage. See *Match.com LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#). Registering a dropped domain name and using it for attracting Internet users and generating web traffic, in the present case, is found to be abusive registration and use of the disputed domain name by the Respondent.

Finally, the fact that the disputed domain names currently resolves to an inactive does not prevent a finding of bad faith under the doctrine of passive holding, particularly in light of the documented previous use of the disputed domain name, as it was discussed above.

The Panel finds that the Complainant has satisfied the third element under paragraph 4(a) of the Policy, that the disputed domain name has been registered and is being used in bad faith by the Respondent.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <tataphoton.com> be transferred to the First Complainant.

*/Harini Narayanswamy/*

**Harini Narayanswamy**

Sole Panelist

Date: May 25, 2022