

ADMINISTRATIVE PANEL DECISION

Technoarete Research and Development Association, Institute for Engineering Research & Publication v. Technoarete International and IFERP World

Case No. D2022-0937

1. The Parties

The Complainants are Technoarete Research and Development Association, and Institute for Engineering Research & Publication, India, represented by Cyber Law Consulting, Mumbai, India.

The Respondents are Technoarete International and IFERP World, India, represented by Archer Softech, New Delhi, India.

2. The Domain Names and Registrar

The disputed domain names <iferp.org> and <technoarete.com> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 17, 2022. On March 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 18, 2022 and March 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 23, 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 amendment to the Complaint on March 25, 2022 and an amended Complaint on March 28, 2022.

The Center verified that the Complaint together with the amendment to the Complaint and 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 March 29, 2022. In accordance with the Rules, paragraph

5, the due date for Response was April 28, 2022. The Response was filed with the Center on April 28, 2022.

The Center appointed Harini Narayanswamy as the sole panelist in this matter on May 4, 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 the Rules, paragraph 7. The Panel issued two procedural orders on June 10 and June 29, 2022 and the Parties submitted replies thereto as well as a number of supplemental filings, which the Panel allows in its discretion.

4. Factual Background

The Complainants, Technoarete Research and Development Association and Institute for Engineering Research & Publication, are Chennai based entities engaged in conference management and publishing research papers. The First Complainant owns Indian trademark registrations for TECHNOARETE (figurative mark), in Class 41, with registration number 3069379, date of application October 1, 2015, and date of use from July 22, 2014 and for trademark IFERP (figurative mark), in Class 41, registration number 3241340, date of application April 24, 2016 and date of use from March 23, 2014.

The Respondents are Technoarete International and IFERP World, located in Odisha, India. The Respondents registered the disputed domain names <technoarete.com> and <iferp.org> on October 24, 2014, and on January 25, 2016 respectively. The disputed domain names are being used and operated by the Respondents in connection with their business of conference hosting and publication of papers. The registration record for the disputed domain name <technoarete.com> shows the registrant location is Chennai, India, with an unserviceable address, or a non-existent, incomplete address. For the disputed domain name <iferp.org>, the Respondents used privacy services of "Domains by Proxy LLC" to mask registrant information.

5. Parties' Contentions

A. Complainant

The Complainants state that they had registered the disputed domain name <technoarete.com> on June 26, 2013 with Go Daddy.com. Due to non-renewal, the domain name registration lapsed, and the Respondents purchased the disputed domain name in October 2014. The Complainants state that they registered the domain name <technoarete.org> in 2015, to continue offering their services. The Complainants describe themselves as one of the largest non-profit professional associations in research and academic journals for scholars. The Complainants contend that they registered the domain name <iferp.in> on February 24, 2014 and the Respondents registered the disputed domain name <iferp.org> on January 25, 2016.

The Complainants allege that due to extensive use, publicity and advertisement, their marks TECHNOARETE and IFERP are exclusively associated with its business and that the marks are popular and are well-known marks under the Trade Marks Act 1999. The Complainants claim that during the last six to eight years of use of their domain names <iferp.in> and <technoarete.org>, they have received more than 15,000 hits every month and has over 50,000 users. The Complainants submit that the Respondents are trying to pass-off their services as those of the Complainants by using their well-known marks in the disputed domain names.

The Complainants request for transfer of the disputed domain names on the grounds that they are identical or confusing similar to trademarks in which they have rights, the Respondents lack rights or legitimate interests in the disputed domain names and the disputed domain names are registered and are being used in bad faith by the Respondents.

B. Respondent

The Respondents request for denial of the Complaint and for a finding of Reverse Domain Name Hijacking (RDNH). The Respondents have also objected to the consolidation of the Complainants, arguing that the Second Complainant has no *locus standi* as a party to the present dispute, because the trademark rights are being held by the First Complainant.

The Respondents state that they own and operate both the disputed domain names under the “People Empowerment Trust” which was formed in 2012 by Mr. Rasnanada Barik and Mr. Bijan Kumar Barik. The Respondents further state that their business involves organizing conferences, research and publication, in the field of Information Technology. The Respondents have provided a link to their You Tube channel and a list of other domain names that they own, including their domain names under the “.org” generic Top-Level Domain (“gTLD”).

The Respondents contend that the disputed domain names did not correspond to any trademark at the time they were registered, and therefore no explanations need to be given for the registrations. The Respondents argue that domain name registrations follow a “first come first served” system, absent preexisting rights. The Respondents allege that the disputed domain name <technoarete.com> is a combination of two common words “techno” and “arete”, and the composite term means “excellence in technology” and it was registered for its descriptive value to run its center of excellent in education, research and training. The Respondents also argue that ARETE is used as a mark by a number of other businesses.

The Respondents refute the Complainants’ statement that the disputed domain name <technoarete.com> was registered by the Complainants in 2013. The Respondents also argue that no evidence has been provided to show that the Respondents ought to have known of the Complainants’ mark and adds that the UDRP does not protect expired domain names.

The Respondents state that it is common practice to use similar acronyms in the field of research and academic journals and therefore justifies the registration and use of the disputed domain name <iferp.org>. The Respondents have given a tabulated comparison showing various acronyms and corresponding domain names such as <iraj.com> and <iraj.co.in>, and <asar.org.in> and <asar.net.in> with registration dates and names of owners. The Respondents state that the acronym IRAJ is used by the Complainants, when the Respondents have been running a website from the domain name <iraj.in> since 2013.

The Respondents allege that the Complaint is vague and misleading, and it does not provide the document of incorporation of the First Complainant. The Respondents further state that no evidence of the previous ownership of the disputed domain name <technoarete.com> is provided and no proper reasons for its non-renewal has been given and argues lack of evidence of the Second Complainant’s alleged popularity and reputation.

The Respondents refute the Complainants’ claims that its marks are “well-known”, as the marks do not appear on the “Well-known Trademark List” maintained by the Government of India Trademark Registry. The Respondents argue that the disputed domain names were registered and put to use before the Complainants’ trademark applications. The Respondents also state there is delay in bringing the Complaint and the disputed domain names are being used “legitimately” for six to seven years. The Respondents also argue that the Complaint should fail on grounds that only the textual content of the figurative marks is comparable for finding confusing similarity. The Respondents conclude by stating that the UDRP is only a summary proceeding, and its scope is narrow and argues that it is not suitable for the present dispute.

6. Discussion and Findings

Preliminary Issues

Consolidation of Complaint / Complainants

The issue about the joinder of Parties and consolidation of the Complaint is addressed here. When there is a request for consolidation of multiple complainants, a panel needs to assess whether (i) the complainants have a common grievance against the respondents or the respondents have engaged in common conduct that has affected the complainants in a similar fashion (ii) would it be equitable and procedurally efficient to permit the consolidation. See section 1.4 WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Complainants have demonstrated that they have a common grievance against the Respondents concerning the disputed domain names. The Respondents' objection that the Second Complainant is not a proper party to the dispute as the First Complainant holds the trademarks, is not sustainable, as the Second Complainant is an institute run by the Complainants.

It is common and accepted practice for a group of entities or companies to assign one entity to hold the ownership of its trademarks, while another uses the trademark. Such an arrangement, does not preclude the entities from taking action jointly against a respondent. For the reasons mentioned, the Panel holds that it is procedurally efficient for the Complainants in the present dispute, to proceed with a single consolidated complaint filed against the Respondents.

Consolidation of Respondents

Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. See section 4.11.2, [WIPO Overview 3.0](#).

The Panel notes the Respondents state that the disputed domain names are owned and operated by the two Respondents respectively in accordance with the objectives of "PEOPLES EMPOWERMENT TRUST", formed on December 5, 2012 at Bhubaneswar, Odisha, India. The disputed domain names are thus subject to the control of closely related entities. The Panel finds it procedurally efficient and equitable for both Parties to permit the consolidation of Respondents.

Procedural Orders

The Panel has the discretion to request the Parties to provide additional documents in support of its submissions. The Panel issued a first Procedural Order dated June 10, 2022 requesting the Complainants to provide evidence showing use of the TECHNOARETE trademark prior to registration of the disputed domain name <technoarete.com> by the Respondents and also requested for evidence that the Complainants' were the prior registrants of the disputed domain name <technoarete.com> in 2013. The Complainant in response to the procedural order, submitted documents of evidence to the Center on June 17, 2022.

The documents filed by the Complainants on June 17, 2022 are: PAN card of Technoarete, a copy of a Partnership Deed of Technoarete of the year 2013, bank statement for Technoarete from 2013 to 2015, Income Tax Returns for Technoarete for the years 2014-15 and 2015-16, screen shot of Gmail account opening in 2013, screenshot of email of Google Adwords dated September 26, 2013, screenshot of the use email info@technoarte.com, screen shot of email received regarding registration of disputed domain name <technoarete.com> June 26, 2013, domain name purchase email with invoice received on May 13, 2014 and invoice for the IFERP domain name. The Respondents in reply to the material filed by the Complainants, sent an email dated June 23, 2022 and reiterated its arguments that the Complainants did not provide sufficient material to show common law rights in the marks.

The Complainants, on June 28, 2022, filed an unsolicited submission as a reply to the Respondents' submissions to the first Procedural Order. The Panel issued a Second Procedural Order on June 29, 2022, allowing the Respondents five days to make a reply to the Complainants' unsolicited submissions. The Panel has reviewed submissions by both Parties and find that both Parties have merely repeated the arguments advanced earlier, but the allegations were more virulent attacks against each other.

Taking up the substantive issues of the case, the Complainants under paragraph 4 (a) of the Policy are required to establish three elements to obtain the remedy of transfer of the disputed domain names, these are:

- (i) The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (ii) The Respondents lack rights or legitimate interests in the disputed domain names; and
- (iii) The disputed domain names were registered and are being used in bad faith by the Respondents.

A. Identical or Confusingly Similar

The first element requires the Complainants to establish that the disputed domain names are identical or confusingly similar to trademarks or service marks in which it has rights.

The Complainants have filed evidence of their registered rights in the marks TECHNOARETE and IFERP. Registered trademarks *prima facie* satisfy the basic requirement of having trademark rights for purposes of demonstrating rights under the first element, see section 1.2.1 of [WIPO Overview 3.0](#). The date of filing, date of first use of the marks are not relevant to the first element. These factors are considered under the second and third element, see section 1.1.2 of [WIPO Overview 3.0](#). The Complainants merely needs to establish that it has rights in the mark at the time of filing the complaint under the first element.

The Complainants marks are figurative marks with design elements. Under the UDRP, trademarks with design elements would satisfy the requirement of a complainant showing rights in a mark if the textual portion displays the trademarks. The design or figurative elements and other smaller letters or words in the figurative mark would not typically affect a panel's assessment of standing or identity / confusing similarity, and only the prominent textual portions are compared. The comparison is therefore between the alpha-numeric domain name and the prominent textual components of the relevant marks (assuming they are not overtaken by other elements). See section 1.10, [WIPO Overview 3.0](#). When comparing the disputed domain name with a figurative mark, the word or text that features prominently in the registered figurative marks are compared with the alpha numeric string in the disputed domain name. See *Vifor (International) Ltd v. Oluwa Soft*, WIPO Case No. [D2021-0128](#).

The Panel finds the prominent part of the Complainants' figurative trademarks are the letters TECHNOARETE and IFERP. Comparing the prominent textual portions of the marks with the alpha-numeric string in the disputed domain names, the Panel finds the disputed domain names are identical to the corresponding trademarks. The Complainants have met the requirement under the first element.

B. Rights or Legitimate Interests

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

The Respondents have argued that the disputed domain name <technoarete.com> consists of a combination of two common words "techno" and "arete" and have also contended that the disputed domain name is being used consistent with the semantic meaning of these common words. The Panel is not convinced with the Respondents' arguments that the selection of the disputed domain name <technoarete.com> is based on common words or that the words are commonly used in the business that the Parties are engaged in. It is likely that the Respondents registered the disputed domain names with knowledge of the Complainants' marks, as discussed further in this section and the following section on bad faith registration and use.

The Panel notes that the First Respondent's business name is "Technoarete International" and it uses the acronym TAI, which is displayed on the website. The Second Respondent's name is "IFERP World". The Respondents did not register a domain name using "iferpworld", but instead registered <iferp.org>, which is identical to the prominent part of the Complainant's IFERP figurative mark. Similarly, although Respondents' use the name "Technoarete International" and the TAI acronym, the Respondents registered the disputed domain name <technoarete.com>, which again reflects the Complainant's TECHNOARETE mark. This demonstrates the Respondent's knowledge of and familiarity with the Complainants' marks, indicating that the choice of disputed domain names by the Respondents ought to have been inspired by the Complainants' trademarks.

The Respondents contentions about the adoption of a random selection of generic words could have been taken as a valid submission, if the registration of the first disputed domain name <technoarete.com> was just an isolated instance. However, with the registration of the second disputed domain name <iferp.org>, the Respondents have again registered in 2016 a domain name that is identical to the Complainants' mark IFERP.

In the following section, it is discussed that the trademark registration details show the Complainants are prior users of the trademarks.

Given that the Parties are competitors, the manner in which the disputed domain names are registered, reveals the Respondents' intent to unfairly capitalize on the Complainants' rights or their nascent trademark rights, which does not indicate *bona fide*, legitimate rights or interests in disputed domain names.

The Complainants have made a *prima facie* case under the second element that the Respondents lack rights and legitimate interests in the disputed domain names.

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 names have been registered and are being used in bad faith by the Respondents. Bad faith is generally found when the preponderance of evidence and facts, indicate that a respondent has targeted a complainant's mark with a view to derive unfair advantage from use of the mark. See Section 3.1, [WIPO Overview 3.0](#).

The Respondents have argued that the registration of the disputed domain names predate the Complainants' trademark registration dates. Trademark priority date or the date of first use of the marks in commerce is the date from which a trademark owners' rights accrue, and not from the date of filing the trademark application or grant of trademark registration as mistakenly argued by the Respondents. The trademark registration record for the TECHNOARETE mark shows date of use of the mark is from July 22, 2014, and this fact has been acknowledged by the Respondents in the Response. The trademark registration record for the mark IFERP shows date of use of the mark is from March 23, 2014, and the disputed domain name <iferp.org> was registered on January 25, 2016. This establishes the Complainants prior rights in the marks.

The other argument made by the Respondents is that the First Complainant was incorporated only in the year 2016, implying that the First Complainant came into existence after registration of the first disputed domain name and in the same year that the second disputed domain name was registered. The Panel finds that the Complainants have submitted evidence of a partnership deed that shows it was initially started as a partnership in 2013 before its incorporation. The Respondents have also contended that they are the prior users of the disputed domain names. In response to the Panel's procedural order of June 10, 2022, the Complainants have filed documents to show that they were the previous registrant of the disputed domain name <technoarete.com> in 2013.

The evidence on record, as discussed, shows the Complainants' prior adoption of the marks TECHNOARETE and IFERP and of the Complainants' prior registration of domain names

<technoarete.com> and <iferp.in> that correspond to their marks.

The Respondents have also stated that the Complainants have not filed evidence to show use of their mark prior to registration of the disputed domain names and there is delay in filing the Complaint. The Panel acknowledges that the Complainants have not filed sufficient evidence to show extensive use of their mark prior to registration of the disputed domain names and there is unexplained delay by the Complainants in taking action. Delay could undermine a complainants' case, but delay is not necessarily fatal to a UDRP complaint, as the remedy is injunctive. However, the overwhelming evidence, is in favor of the Complainants' case as discussed here.

Under the Policy, a trademark can be protected even under circumstances when a respondent registers a domain name in anticipation of trademark rights or proposed trademark rights. In situations when the respondent is clearly aware of the complainant, and circumstances indicate that the aim of the registration was to take advantage of the confusion between the domain name and the complainants rights, bad faith can be found. Such a situation could arise when there is a merger or a proposed merger between two companies, before the new trademark can arise, or when the respondent is aware of a complainants' potential rights prior to registration of a trademark and registers a domain name to take advantage of any rights that may arise from the complainant's enterprise. See *St Andrews Links Ltd v. Refresh Design*, WIPO Case No. [D2009-0601](#). Also see *Kampachi Worldwide Holdings, LP v. Registration Private, Domains by Proxy, LLC/ Robin Coonen, Blue Ocean Mariculture, LLC*, WIPO Case No. [D2021-0371](#) and *BML Group Limited v. Rikard Beach, Proxy My Whois AB*, WIPO Case No. [D2015-1897](#), where it was found that even if the complainant had not applied for or obtained trademark registration, it would not prevent a finding of bad faith registration and use, under certain circumstances.

When parties are direct competitors, and the circumstances indicate that the respondents ought to have known of the complainant's mark and registered domain names to target the marks, bad faith can be found, such as in *537397 Ontario Inc. operating as Tech Sales Co. v. EXAIR Corporation*, WIPO Case No. [D2009-0567](#), where the respondents in that case had also argued that the disputed domain names were acquired when the trademarks were not yet registered.

While little supporting evidence had been filed by the complainants to show use of its trademarks prior to the registration of the disputed domain names, it is clear that the respondents would have never registered those domain names, were it not for the fact that it was about to be used as trademarks by the complainants. Also see *Pomadorro N.V. (Limited Liability Company) v. Volodymyr Pidubnyi, Pidubnyi Volodymyr*, WIPO Case No. [D2021-1247](#), where respondent was aware of an impending mark and promptly registered and used a disputed domain name that targeted the nascent trademark of its competitor in bad faith.

The Complainants' trademark registration details show their prior adoption of the marks, the manner in which the disputed domain names are registered by the Respondents that use the Complainants' marks in its entirety, the incomplete contact address, that mentions Chennai as the city in the domain name registration records for <technoarete.com>, use of privacy services for the dispute domain name <iferp.org> under the circumstances, all collectively indicate bad faith registration and use on the part of the Respondents.

The Panel finds based on the material that the Respondents clearly had knowledge of the Complainants.

The Panel further notes that the disputed domain names are an exact match of the Complainants' marks and this indicates that the Respondents have sought to register domain names targeting the then nascent and now established trademarks of the Complainants, who are their business competitors.

The Policy is meant for resolving disputes of abusive domain name registration and use, or cybersquatting. Under the Policy, bad faith can be found when the Respondents engage in a pattern of registering domain names for the purpose of preventing a trademark owner from registering them under paragraph 4 (b) (ii), disrupting the business of a competitor under paragraph 4 (b) (iii), and intentionally attracting Internet users by creating a likelihood of confusion with another's trademark, for commercial gain, under paragraph 4 (b) (iv). The evidence, facts and circumstances as discussed, all collectively show that the Respondents have

registered the disputed domain names to target the Complainants' marks and have used them in bad faith as described under the Policy.

The Panel finds that the Complainants have satisfied the third element under paragraph 4 (a) of the Policy, that the disputed domain names have been registered and are being used in bad faith.

Reverse Domain Name Hijacking

The Respondents have requested for a finding of Reverse Domain Name Hijacking. Under paragraph 15 (e) of the Rules, if it is found that the Complaint has been brought in bad faith in abuse of these administrative proceedings under the Policy, such a finding of RDNH can be made. The Panel finds that the Complaint was not brought in bad faith and declines the request for a finding of Reverse Domain Name Hijacking.

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 names <iferp.org> and <technoarete.com> be transferred to the First Complainant.

/Harini Narayanswamy/

Harini Narayanswamy

Sole Panelist

Date: July 11, 2022