

ADMINISTRATIVE PANEL DECISION

Infiniti Retail Limited v. Domains By Proxy, LLC / DigiSajilo India Pvt. Ltd.,
Digisajilo India Pvt. Ltd.
Case No. D2022-2796

1. The Parties

The Complainant is Infiniti Retail Limited, India, represented by Ira Law Firm, India.

The Respondent is Domains By Proxy, LLC, United States of America / DigiSajilo India Pvt. Ltd., Digisajilo India Pvt. Ltd., India.

2. The Domain Name and Registrar

The disputed domain name <cromaclub.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 29, 2022. On July 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 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 August 1, 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 August 12, 2022.

The Center verified that the Complaint together with the amendment to the 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 August 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2022. The Respondent sent an informal email communication on August 1, 2022. The Center informed the Parties about its commencement of Panel appointment process on September 5, 2022.

The Center appointed Harini Narayanswamy as the sole panelist in this matter on September 12, 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.

4. Factual Background

The Complainant owns and operates a retail chain that sells consumer electronics and durables. The Complainant is part of the Tata Group, a large business conglomerate in India. The Complainant owns the trademark CROMA and has about 130 trademark registrations for the mark and its variants. Some of these are, Indian trademark, CROMA word mark bearing number 1556411 in class 1, registered on May 8, 2007; Indian trademark CROMA ZIP device mark bearing number 1745891 in class 1, registered on October 21, 2008; Indian trademark CROMA EDGE mark bearing number 2464724 in class 37, registered on January 22, 2015; and CROMA ZIP mark bearing number 1563637 in class 42, registered on May 30, 2007.

The Respondent, who is located in India, registered the disputed domain name on January 19, 2021. The disputed domain name currently resolves to a website that offers and promotes services like website development, digital marketing, e-commerce development, mobile applications, graphics design, and other services. The website mentions the name of the business is DigiSajilo and its offices are located in Delhi and Noida, India. Previously, the website had displayed content that offered consumer electronic goods and other products such as herbicides and pesticides among others for sale.

5. Parties' Contentions

A. Complainant

The Complainant states that the first CROMA store was opened in the year 2006 and currently it has about 260 stores that employs 8,100 people. The Complainant states that its stores offer a wide variety of electronic goods and household appliances such as televisions, home appliances, kitchen appliances, phones, computers, audio and video products, cameras, grooming and wellness products, gaming products and accessories. The Complainant alleges that the CROMA trademark is extensively use by its numerous stores including its stores located at the airports in Delhi, Mumbai and Hyderabad, where consumers and travelers have availed products and services under the mark. The Complainant contends that their mark is widely known to its customers in India and also its international customers.

In addition to its business from its physical stores and distribution networks, the Complainant states that it has significant e-commerce business from its website at "www.croma.com". The traffic to its website has steadily increased over the years states the Complainant and has provided figures of its website traffic from the years 2013 to 2021. The Complainant states it has extensively used and promoted the CROMA mark since 2006 and has provided figures for the promotion of its mark from the year 2010 to 2021. The Complainant has also provided figures of its revenue growth from the year 2007 to 2018. The Complainant has also given figures for the initial conceptualizing of its CROMA mark in 2006 and also figures for designing and adopting CROMA sub-brands and designing new logos for the mark.

The Complainant states the CROMA mark is a coined mark and has been declared a "well-known mark" under section 2(1)(zg) of the Indian Trademarks Act, 1999. The Complainant asserts that its mark has acquired considerable reputation and has received several awards over the period 2007 to 2019 for its services and activities and has submitted a list of its awards. The Complainant states that there are write ups and articles referencing its mark, and that its mark is also being extensively promoted through social media.

The Complainant requests for the transfer of the disputed domain name on the grounds that it is identical or confusing 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 in these proceedings but sent an informal email communication to the Center on August 1, 2022. The contents of the email are reproduced here;

“We only booked this domain but this company not belongs to us. One of our Client booked this domain and we have just done our job. We will contact that client and revert you back. We are IT based company and Cromas club is our client.”

There were no further communications from the Respondent. No other details about the Respondent or its business agreement with its alleged client, on whose behalf the disputed domain name is said to be registered has been provided, or any reasons given by the Respondent for continuing to hold the disputed domain name on behalf of the said client.

6. Discussion and Findings

The Policy under paragraph 4 (a), requires the Complainant 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 requirement under paragraph 4(a) of the Policy needs the Complainant to establish the disputed domain name is confusingly similar to a trademark or a service mark in which it has rights.

The Complainant has provided evidence of its trademark registrations, which meets the threshold requirement of demonstrating trademark rights. See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel finds that the Complainant accordingly has established its rights in the CROMA mark.

The disputed domain name has the word “club” along with the trademark. A word added with a trademark or service mark does not prevent a finding of confusing similarity under the first element of the UDRP. See section 1.8 of the [WIPO Overview 3.0](#). The word “club” does not have any effect to render the Complainant’s trademark not recognizable in the disputed domain name. It has been found by previous panels, such as in *Orix Kabushiki Kaisha v. Noldc Inc.*, WIPO Case No. [D2006-0422](#), and *Kirkbi AG v. Michele Dinoia*, WIPO Case No. [D2003-0038](#), that merely adding the word “club” to the mark in the domain name does not render it from the trademark no longer recognizable, as the trademark is the distinctive part of the domain name.

The disputed domain name incorporates the Complainant’s trademark in its entirety. The trademark CROMA is found to be the core recognizable part of the disputed domain name. This is sufficient to establish confusing similarity. For the reasons discussed, the Panel finds that the disputed domain name is confusingly similar to the CROMA mark in which the Complainant has trademark rights.

The Panel finds that the Complainant has successfully established the first requirement under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The second element under paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant establishes a *prima facie* case that the Respondent lacks rights or legitimate interests, the Respondent can rebut the Complainant's allegations with relevant submissions and supporting evidence to establish rights or legitimate interest in the disputed domain name. If the Respondent fails to make relevant submissions with supporting evidence, the Complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has argued that the Respondent lacks rights or legitimate interests in the disputed domain name and is not commonly known by the disputed domain name. The Complainant has further submitted that the Respondent's use of the disputed domain name does not constitute use in connection with a *bona fide* offering of products and the Complainant has not authorized use of the mark to the Respondent. The Complainant further argues that the Respondent seeks to derive mileage by misleading and diverting consumers to its website by using the Complainant's unique and coined mark (and such use is likely to tarnish its mark).

The Respondent did not file a formal response or rebutt the allegations made by the Complainant. The Respondent's above-mentioned informal email does not provide any details of the Respondent's agreement with its client, the entity for whom the disputed domain name has allegedly been registered. Furthermore, the Respondent's statements are not supported with any evidence, such as an agreement or communications with its client to establish the fact that the disputed domain name was registered on behalf of a third party.

The Complainant's submission shows that the Respondent has attempted to target the Complainant's business and derive mileage by using the Complainant's mark to promote and sell consumer electronic goods on its website. The Complainant has submitted that the Respondent has changed the website content after a cease and desist notice was sent to the Respondent in May 2022. The Complainant has provided evidence of the Respondent's previous website content, which shows that consumer electronic products were being offered for sale on the website. The Panel notes that the current website content does not offer consumer electronic products but other services. The Respondent's reaction after being put on notice, of changing the website content, does not indicate that the Respondent has any rights or legitimate interests in the disputed domain name, but instead reinforces the lack of rights or legitimate interests.

The Complainant has established in these proceeding that its mark is reputed and known in the area of consumer electronics retail business. The use of the Complainant's mark in the disputed domain name for selling electronic products in competition with the Complainant without authorization for use of the mark, does not indicate the Respondent has any rights or legitimate interests in the disputed domain name. The Respondent did not place a disclaimer or accurately disclose its relationship or the lack of it with the Complainant, but instead the Respondent used the Complainant's mark in a manner that is likely to mislead consumers. The Respondent's use of the mark therefore cannot be seen as legitimate use by an unauthorized reseller as discussed under section 2.3 of the [WIPO Overview 3.0](#).

The Panel is of the view that under the facts and circumstances in the present case, the Respondent's unauthorized use of the Complainant's mark is made with an intention to target and mislead consumers looking for the Complainant, which does not meet conditions of legitimate or *bona fide* use. The Complainant is found to have successfully put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which the Respondent has not rebutted. The Panel finds the Complainant has established the second element under paragraph 4 (a) of the Policy.

C. Registered and Used in Bad Faith

The third element under paragraph 4(a) of the Policy requires the Complainant to establish the disputed domain name has been registered in bad faith 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 from use of the mark. See section 3.1 of the [WIPO Overview 3.0](#).

The Complainant has submitted arguments with supporting evidence that the Respondent has registered and used the disputed domain name in bad faith. The Complainant has provided evidence to establish its prior and extensive use of the CROMA mark that demonstrates both common law rights and registered statutory rights in the mark. The Complainant has also provided evidence that shows the website associated with the disputed domain name was being used by the Respondent to promote consumer electronic products in competition with the Complainant. This clearly indicates that the Respondent ought to be aware of the Complainant's reputation under the CROMA mark in the area of consumer electronic goods where the Complainant has established rights.

In the Respondent's email dated August 1, 2022 to the Center, the Respondent has stated that the disputed domain name was registered on behalf of its client. Under paragraph 2 of the Policy, the registrant of a domain name has the obligation to determine whether the domain name infringes the rights of another person or entity. As a general principal the registrant of a domain name may be held responsible for the content found on the associated website of a client for whom a domain name is registered and is being used, See *Rynat Trading Ltd v. Fahad al Mafuz Tamim Fahad al Mafuz Tamim, Alpha Tech IT*, WIPO Case No. [D2022-0076](#). The Respondent is not absolved of liabilities under the Policy by merely stating that the registration was done behalf of a client (assuming this is true), who is the alleged beneficial user of the disputed domain name.

A person who comes across the disputed domain name is likely to be misled that there is an implied affiliation with the Complainant's business. The Panel finds, on the basis of the evidence, that the Respondent has used the disputed domain name to derive unfair advantage of the Complainant's mark and to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to affiliation or endorsement of the Respondent's website. The use of the disputed domain name that creates confusion with the Complainant's trademark with the intention of taking unfair advantage of the Complainant's reputation and goodwill for deriving commercial gain and thereby misleads consumers, constitutes bad faith registration and use of the disputed domain name as described under the Policy.

The Panel concludes on the basis of the foregoing discussions and findings, that the disputed domain name was registered and used with the intention of taking advantage of the Complainant's mark. The Complainant has successfully established the third element under paragraph 4 (a) of the Policy, that the disputed domain name was registered and is being used in bad faith.

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 <cromaclub.com> be transferred to the Complainant.

/Harini Narayanswamy/

Harini Narayanswamy

Sole Panelist

Date: September 26, 2022