

ADMINISTRATIVE PANEL DECISION

Nalli Chinnasami Chetty v. Brian Nally, IT Smart (ABN 51 225 934 240)
Case No. D2022-4768

1. The Parties

The Complainant is Nalli Chinnasami Chetty, India, represented by De Penning & De Penning, India.

The Respondent is Brian Nally, IT Smart (ABN 51 225 934 240), Australia.

2. The Domain Name and Registrar

The disputed domain name <nally.store> is registered with Dreamscape Networks International Pte Ltd (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 13, 2022. On December 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 19, 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 (IT SMART) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 December 20, 2022. The Center sent a Complaint deficiency notification to the Complainant on December 20, 2022, inviting the Complainant to fix the deficiency. The Complainant filed a second amended Complaint on December 21, 2022.

The Center verified that the Complaint together with the amended Complaints 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 December 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2023. The Respondent did not submit any formal Response, although it sent informal communication emails on December 21, 23, and 26, 2022. Accordingly, the Center notified the commencement of panel appointment process on January 12, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on January 19, 2023. 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 is a registered partnership firm established in 1928 which is in the business of manufacturing and marketing clothing and readymade garments, fashion accessories, and textile goods under the NALLI trademark. Said mark has been in use since 1935.

The Complainant is the owner of various registered trademarks for the mark NALLI, the earliest of which appears to be Indian Registered Trademark no. 472754 for a device mark, consisting of the word "Nalli" in a stylized script typeface written in an upward angle of about 45 degrees, filed on May 27, 1987, and registered on February 15, 1993 in Class 24. The Complainant also owns United States of America ("United States") Registered Trademark no. 2444608 for the word mark NALLI, registered on April 17, 2001 in Classes 24 and 25.

The Complainant does business over the domain name <nalli.com>, which it registered on April 28, 1998, the associated website for which was launched in 1998. Said website offers online sales worldwide, including to Australia, where the Respondent is based. The Complainant is the owner of many other domain names featuring its trademark, and claims a dedicated online following for its goods.

The disputed domain name was registered on September 14, 2022. According to a screenshot produced by the Complainant, the disputed domain name points to a holding page provided by the Registrar, which does not appear to contain any advertising material other than in respect of the Registrar's services. The Respondent contends that Nally is its surname.

The Respondent is listed in the Registrar-verified data as IT Smart (ABN 51 225 934 240) / Brian Nally with an address in Kalinga, Queensland, Australia. The following information has been disclosed from freely available Australian public records following brief research conducted by the Panel.¹ The ABN Lookup feature of the Australian Government Business Register notes that ABN 51 225 934 240 corresponds to The Nally NO2 Family Trust, a Discretionary Trading Trust with its main business location in Queensland, Australia, which has been active since March 31, 2000. A company named IT Smart Pty Ltd is listed as a trustee and trading name of said trust. Another current trading name of said trust is Classic Events Music & Stage. According to the Australian Securities & Investments Commission's ASIC database, IT Smart Pty Ltd, ACN 010 756 322, is a registered corporate entity with a registration date of October 19, 1987. Said corporate entity's registered office locality corresponds to the contact address in the Registrar-verified data for the disputed domain name, and one of its former names is listed as Classic Events Pty Ltd.

The Respondent also claimed to be the registrant of <nally.com.au>. Both current and historic Whois lookups on this domain name dating back to 2008 establish that the registrant is the Nally NO2 Family Trust. According to the ABN Lookup on ABN 51 225 934 240, this name was the former name of The Nally NO2 Family Trust from March 31, 2000 to January 10, 2002. The contact name on this domain name is given as Brian Nally.

¹ With regard to the Panel conducting limited factual research into matters of public record, such as consulting relevant publicly available websites, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The Complainant has overwhelming common law and statutory rights in its NALLI trademark in India and elsewhere. The Complainant is the sole legitimate owner of said mark. The Respondent has merely replaced the letter "i" in said mark with the phonetically similar "y", amounting to typosquatting with intent to divert the general public by misrepresenting an association with the Complainant. The disputed domain name is bound to induce members of the public and trade to believe that the Respondent has a trade connection, association, relationship or approval with/of the Complainant, when it does not.

Rights or legitimate interests

The Complainant has not licensed or otherwise permitted the Respondent to use a deceptively similar trademark to that of NALLI or to apply for any domain name incorporating the said mark. The Respondent's intent appears to be to undertake retail activity or to sell the disputed domain name for a premium price thereby misusing the legitimate rights of the Complainant over the NALLI trademark. It is apparent that the adoption of the disputed domain name is not legitimate and is solely to ride on the goodwill and repute of NALLI.

In view of the close similarity between the disputed domain name and the Complainant's trademark, the Complainant has a strong reason to believe that the purpose of the Respondent's registration of the disputed domain name is to misappropriate the reputation of the Complainant's said mark.

Registered and used in bad faith

Given the widespread reputation and goodwill, incessant use and registration of the Complainant's NALLI mark in India and elsewhere, the Respondent ought to have had constructive notice of the Complainant's rights in said mark. Previous cases under the Policy show that a respondent should have known of a complainant's trademark if it is shown to be well known or in wide use on the Internet or otherwise; such knowledge of the respondent is an indicator of its bad faith; the passive holding of a domain name has been held to be the use of the domain name in bad faith; and the very use of a domain name by someone with no connection with the complainant suggests opportunistic bad faith.

In view of the extensive reputation and goodwill of the Complainant's mark, the Respondent would definitely be aware of it. The Respondent's intent appears to be to gain unfairly by selling the disputed domain name at a premium price to third parties, and the Respondent is only attempting to usurp the reputation and goodwill of the Complainant's mark through the disputed domain name. Precedents show that domain names are fast emerging corporate assets, and business transactions are primarily carried out only through Internet addresses, so that it becomes critical that unscrupulous individuals are not allowed to usurp well-known trademarks and domain names to benefit unfairly.

B. Respondent

The Respondent did not submit any formal Response. However, it sent informal communication emails on December 21, 23, and 26, 2022. The first of these asserted that the Respondent was indeed the registrant of the disputed domain name and attested to its claim over it, noting that the Respondent did not know the Complainant. The second submitted that the Respondent was not typosquatting but that "Nally" was its name, and that it had been running the Australian country code domain name <nally.com.au> for more years than it could recall. The Respondent added that the Complainant's entitlement to NALLI did not give it title to everything similar, including misspellings such as the Respondent's name. The third such email stated that

the Respondent had never heard of the Complainant and had asked its 14 guests at Christmas lunch whether they had heard of the Complainant but that none had. The Respondent added that <nally.com.au> is owned by the Nally NO2 Family Trust, adding that this is a registered government entity in Australia. The Respondent asserted that it is this connection and the Respondent's surname that entitles it to claim the disputed domain name. The Respondent also noted that IT Smart is the trustee of the Nally NO2 Family Trust, hence its registration of the disputed domain name.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

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

A. Identical or Confusingly Similar

The first element inquiry under the Policy is usually conducted in two parts. First, the Panel considers whether the Complainant has UDRP-relevant rights in a trademark, whether registered or unregistered. Secondly, any such trademark is compared to the domain name concerned, typically by way of a straightforward side-by-side comparison, usually disregarding the Top-Level-Domain as this is mainly required for technical reasons. If, on such comparison, the domain name concerned is alphanumerically identical to the trademark, identity will generally be found. Equally, if the trademark is not so identical but is otherwise recognizable in the domain name concerned, confusing similarity will generally be found.

In the present case, the Panel finds that the Complainant has UDRP-relevant rights in its NALLI registered trademark cited in the factual background section above. This mark is figurative in nature, consisting of a design incorporating a word and stylized elements. The stylized elements may usually be disregarded for the purpose of the comparison exercise under the Policy unless they comprise the dominant portion of the relevant mark, such that they effectively overtake the textual elements in prominence (see section 1.10 of the [WIPO Overview 3.0](#)). Here, the word element is capable of being separated from the stylized elements, which merely consist of the typeface and color of the word.

Comparing the word NALLI to the Second-Level-Domain of the disputed domain name, it may be seen that these are virtually identical, with the only difference being the substitution of the letter "y" for the letter "i". Such substitution is not of any particular significance, given that the words are identical on an aural comparison and would be pronounced identically.

In all of these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that the Complainant has carried its burden with regard to the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The consensus of previous UDRP decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. Where the panel finds that a complainant has made out such a *prima facie* case, the burden of production shifts to the respondent to bring forward evidence of such rights or legitimate interests.

In the present case, the Complainant seeks to establish such *prima facie* case by reference to its submissions that the disputed domain name bears a close similarity to its trademark, that it has not licensed or otherwise permitted the Respondent to use said trademark, that the Respondent's intent appears to be to undertake retail activity, and/or to sell the disputed domain name for a premium price, and that its intention is solely to ride on the goodwill and repute of said mark. In the Panel's opinion, these submissions would normally be sufficient to establish the requisite *prima facie* case. Accordingly, the Panel turns to the Respondent's case as contained in its various emails narrated above.

It must be noted that the Respondent did not file a formal Response. Accordingly, the contentions in its various emails are not accompanied by the certification of completeness and accuracy in accordance with paragraph 5(c)(viii) of the Rules and therefore the Panel will treat any material statements of fact which arise exclusively from said emails with a degree of caution. Nevertheless, given that the Registrar-verified data for the disputed domain name itself contains the Respondent's Australian business number, only a modicum of research has been undertaken by the Panel, all from Australian public records that are freely available online, to confirm those matters regarding the Respondent that are narrated in the factual background section above.

Given that the Panel identified this evidence independently of the Parties, the Panel considered whether it was necessary to put these matters to the Parties by way of a procedural order. The Panel determined that this need not be done in this particular case, principally because the research is of a basic level and involved matters of a seemingly objective nature. The Panel also notes that the Complainant was free to take these matters into account, once it was provided the Registrar-verified information for the Respondent, before it proceeded with the amended Complaint. For the Respondent's part, these public records relate to it, such that it can be presumed to have full knowledge of them.

The Panel is satisfied that, according to government records, the Respondent has borne the name Nally as part of its Australian business name (in respect of which IT Smart Pty Ltd is a trading name) for almost 23 years, and for over 22 years before it registered the disputed domain name. It is not therefore necessary for the Panel to call upon the Respondent to produce evidence supporting the fact that the surname of the personal name also referred to in the Registrar-verified data for the disputed domain name, Brian Nally, is genuine. While it might not be unreasonable to make that assumption, it is clear in any event that "Nally" has been used as part of the name of the eponymous Discretionary Trading Trust for almost a quarter of a century. As far as the Panel is concerned, the evidence supports the sort of genuine connection to the name that needs to be demonstrated by a respondent who relies upon it (see, for example *Mathiesen S.A.C. v. Allan Mathiesen*, WIPO Case No. [D2009-0087](#) for personal names and, for corporate names, *Royal Bank of Canada v. RBC Bank*, WIPO Case No. [D2002-0672](#)). It should also be noted that in looking up the said Australian business name, the Panel was presented with information from the relevant register showing that there are multiple third parties named "Nally" in Australia, such that this does appear to be a surname-

derived name that has found its way into the name of multiple entities, including that of the Respondent.

While the evidence establishes the Respondent's name for the purposes of paragraph 4(c)(ii) of the Policy, it is important to note that for the purposes of the Policy there should be no countervailing evidence that such name, while genuinely connected to the Respondent, has merely been adopted opportunistically by it in order to give a spurious air of legitimacy to an otherwise questionable registration (see *G. A. Modefine S.A. v. A.R. Mani*, WIPO Case No. [D2001-0537](#)). Here, there is no sense that the disputed domain name has been registered to target the Complainant or indeed even in the knowledge of the Complainant, nor that the registrant contact details provided by the Respondent to the Registrar are in any manner pretextual (see *e.g., Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#)). There is no sense from the present use of the disputed domain name, being the Registrar's parking page, that it is in any sense questionable or that the Complainant's NALLI trademark is being targeted by it.

In all of these circumstances, the Panel finds that the evidence supports the Respondent's rebuttal (such as it is) of the Complainant's *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and accordingly the Complainant has failed to carry its burden in terms of paragraph 4(a)(ii) of the Policy. The Complaint therefore fails.

C. Registered and Used in Bad Faith

Given the failure of the Complaint on the basis of the second element assessment, it is not strictly necessary for the Panel to enter into a detailed discussion on the topic of registration and use in bad faith in this case. The Panel notes that there is no evidence presently before it suggesting that the Respondent was likely to have been aware of the Complainant's NALLI mark or that it had any intent to target such mark at the point of registration of the disputed domain name. Nevertheless, there is no website currently associated with the disputed domain name other than the Registrar's parking page and the Respondent should bear in mind that any future site which would target the Complainant's NALLI trademark in a way that would suggest pretextual or mere opportunistic use of the Respondent's name, or that otherwise renders the original registration questionable, as discussed in the preceding section may cause the Complainant to consider a refiling of the Complaint (see the discussion in section 4.18 of the [WIPO Overview 3.0](#)).

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: February 2, 2023