

## **ADMINISTRATIVE PANEL DECISION**

### **TATA Sons Private Limited, TATAFintech Private Limited v. Sourabh Soni Case No. D2023-2753**

#### **1. The Parties**

The Complainant is TATA Sons Private Limited, TATA Fintech Private Limited, India, self-represented.

The Respondent is Sourabh Soni, India.

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

The disputed domain name <tatafintech.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 June 28, 2023. On June 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 30, 2023 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 July 5, 2023.

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 July 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on August 15, 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 Complainants are companies incorporated under the laws of India and are part of the TATA group of companies. The first Complainant, TATA Sons Private Limited, was incorporated on November 8, 1917. It is the principal investment holding company of the Complainants' group. The group can trace its history back to 1868 when the mark TATA was adopted by its founder, Jamsetji Tata. The Complainant's TATA mark is a household name in India and has been recognized by the High Court of Delhi as having acquired the status of a well-known mark.<sup>1</sup> The second Complainant, TATA Fintech Private Limited, was incorporated on November 1, 2021.

The first Complainant is the owner of a large number of registered trademarks for the mark TATA in several countries around the world. For example, it is the owner of Indian Registered Trademark Number 92651 for the word mark TATA, registered on February 16, 1944 in Class 5. The first Complainant has applied for an Indian registered trademark for the word mark TATA FINTECH but this mark has not yet proceeded to grant.

The disputed domain name was registered on January 12, 2022. Nothing is known of the Respondent other than that it appears to be a private individual with an address in Madhya Pradesh, India. The disputed domain name was registered on the same day that the Complainants issued a press release announcing the launch of a financial marketplace offering financial services and a retail payments gateway to be named "Tata Fintech"<sup>2</sup>. The disputed domain name has been offered for sale on an auctions page provided by the Registrar, at a "buy it now" price of USD 7,500. The website to which the disputed domain name points is a page provided by the Registrar advertising the fact that the disputed domain name is available for sale at the said auctions page.

#### 5. Parties' Contentions

##### A. Complainant

In summary, the Complainant contends as follows:

##### Identical or confusingly similar

The disputed domain name incorporates the Complainant's TATA and TATA FINTECH trademarks and the second Complainant's trading name. The generic Top-Level Domain ("gTLD") ".com" is not considered when determining confusing similarity.

##### Rights or legitimate interests

The Complainants seek to establish a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent is not making a *bona fide* offering of goods or services with the disputed domain name. The trademark TATA FINTECH has not been used by anyone other than the Complainants or their licensees. The well-known stature of the Complainant's TATA trademark has motivated the Respondent to register the disputed domain name and no use by the Respondent could be said to be *bona fide*. The Complainants have not authorized or licensed the Respondent to use any of their trademarks in any way.

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<sup>1</sup> *Tata Sons Limited v. Ram Niwas & Ors*, 2016 SCC OnLine Del 6376.

<sup>2</sup> The Complainant made a corresponding assertion but did not evidence this directly. The Panel considered that it would be straightforward to verify the Complainant's assertion by performing an Internet search for the announcement and was able to verify this from several publicly available news reports. Likewise, the Panel verified the date of incorporation of the second Complainant from an official source, and visited the website associated with the disputed domain name (on the subject of the Panel conducting such limited factual research by consulting publicly available material, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Such unlicensed and unauthorized use of the disputed domain name incorporating the Complainants' TATA FINTECH trademark and tradename is solely with a view to diverting consumers and tarnishing the trademarks of the Complainants.

### **Registered and used in bad faith**

The registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant's TATA trademark has been declared to be well-known. It can be presumed that the Respondent's conduct of registering and using the disputed domain name is in bad faith.

The primary aim of the Respondent is to earn profit by selling the domain at a higher value. The Respondent's intent is to extract some commercial advantage from the Complainants' goodwill. The Complainants' marks have immense goodwill and reputation that precedes the registration of the disputed domain name. Hence, the Respondent is bound to have knowledge of the Complainant's marks.

### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

To succeed, the Complainants 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 Complainants have 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. Preliminary matter: Consolidation of Complainants**

The Complaint listed two entities as the Complainant in this case. The Complainants did not specifically request consolidation of their respective complaints against the Respondent. Nevertheless, the Complaint explains the Complainants' respective rights and their roles within the Complainants' corporate group.

Section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") deals with the issue of multiple complainants filing a single complaint against a respondent and notes that, in examining this issue, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

In the present case, the Panel is content to consolidate the complaints of both of the Complainants against the Respondent. The Respondent is alleged to have registered and used a domain name that is confusingly similar to the first Complainant's TATA trademark and to the second Complainant's corporate name. The Panel is satisfied that this constitutes a specific common grievance and that the Respondent's actions sufficiently target the commercial interests of both of the Complainants. The registration and use of the disputed domain name constitutes common conduct that affects the Complainants in a similar fashion.

The Respondent has not participated in the proceeding and has not objected to consolidation of the Complainants' respective complaints. In conclusion, the Panel considers that it would be equitable and procedurally efficient to permit consolidation in this particular case.

## **B. Preliminary matter – apparent inaccuracies or irrelevancies in the Amended Complaint**

The Panel notes that there are several aspects of the Complainants' submissions which appear to the Panel to be irrelevant, factually incorrect, and inconsistent with or unsupported by the evidence provided. For example, the Complainants assert that the disputed domain name is used for a betting website and that it offers Internet users a chance to win money and a cruise ship. No evidence has been produced to this effect and the only screenshot available shows a parking page of the Registrar. The Complainants also state that the disputed domain name was registered nearly a decade after the adoption of the TATA FINTECH mark by the Complainants, which is inconsistent with both the first Complainant's announcement of this brand on January 12, 2022, and the fact that the corresponding trademark is still under application.

Judging by the manner in which these submissions have been put forward, it is possible that they may have simply been retained in error from a previous pleading in another case. They should not have been made in the present proceeding, at least without evidence to support them, and the Panel trusts that the Complainant, which is self-represented, will take suitable care to ensure that any such submissions do not find their way into other complaints which it may make under the Policy. The Panel has excised the submissions concerned from the Complainants' contentions summarized above. Nevertheless, despite the irrelevancies or anomalies in the Complaint, the Panel considers that the Complainants have provided sufficient relevant submissions and evidence to support their case, as outlined in the Parties' contentions section above, and as will be discussed in the analysis below.

## **C. Identical or Confusingly Similar**

This element is normally assessed by way of a two-part test. First, the Complainant must demonstrate that it has UDRP-relevant rights in a trademark, whether registered or unregistered. Secondly, any such trademark is compared to the disputed domain name, usually on a straightforward side-by-side basis, typically excluding the gTLD on the ground that this is required for technical reasons only. In terms of the comparison, if the Second-Level Domain of the disputed domain name is alphanumerically identical to the disputed domain name, identity will usually be found. However, if the trademark is otherwise recognizable in the disputed domain name, whether or not accompanied by other terms, confusing similarity will usually be found.

In the present case, the Panel is satisfied that the first Complainant has rights in the TATA mark. The second Complainant does not have registered rights in the TATA FINTECH mark as the mark is still under application. On the assumption that the second Complainant has been trading as "TATA Fintech" since its incorporation in November 2021, it is possible that it may have unregistered trademark rights in that term but it is unnecessary for the Panel to examine this issue given the establishment of the first Complainant's rights in the TATA trademark alone.

Comparing the disputed domain name to the first Complainant's TATA trademark, it may be seen that the mark is the first element of the disputed domain name and is fully incorporated and recognizable therein. The second element is the word "fintech" which the Panel understands to be an abbreviation for "finance" and "technology". Such additional terms, if accompanying a complainant's mark in a domain name (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the [WIPO Overview 3.0](#)).

In all of these circumstances, the Panel finds that the disputed domain name is confusingly similar to the first Complainant's TATA trademark and accordingly that the Complainants have carried their burden with regard to paragraph 4(a)(i) of the Policy.

## **D. 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 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 Panel finds that the Complainants have established the requisite *prima facie* case based on their submissions that the Respondent is not making a *bona fide* offering of goods or services with the disputed domain name, that the term “TATA Fintech” has not been used by anyone other than the Complainants or their licensees, that the TATA trademark is well-known and no use by the Respondent in a domain name could be said to be *bona fide*, and that the Complainants have not authorized or licensed the Respondent to use any of their trademarks in any way. The Complainants also note that the disputed domain name was registered by the Respondent immediately upon the announcement of the second Complainant’s “TATA Fintech” venture with the intention of exploiting this for its own commercial gain. This could not confer any rights or legitimate interests upon the Respondent.

In these circumstances, the burden of production shifts to the Respondent to set forth evidence of any rights or legitimate interests which it might have in the disputed domain name. The Respondent has chosen not to engage with the administrative proceeding and has remained silent. It has not attempted to refute the Complainant’s allegations and evidence in any way. There are no submissions or evidence on the present record which appear to support any claim that the Respondent might have made on this particular topic, and the Panel cannot conceive of any potential rights or legitimate interests that the Respondent might have put forward if it had participated in this proceeding.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainants’ *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name, and accordingly that the Complainants have carried their burden in terms of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have 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 that complainant, for valuable consideration in excess of your documented out of pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

In the present matter, the Complainants focus their case predominantly upon the registration of the disputed domain name on the same day that the Complainants announced their "TATA Fintech" venture and upon the fact that the disputed domain name was then offered for sale for an amount exceeding the Respondent's likely out of pocket costs. Effectively, this is a submission in terms of paragraph 4(b)(i) of the Policy.

The Panel accepts the Complainants' submissions and evidence supporting the notion that the TATA trademark is a well-known mark of a very longstanding nature, and is a household name in India, where the Respondent is based. This suggests that the disputed domain name was registered by the Respondent in the knowledge of the first Complainant's trademark. The fact that the disputed domain name was registered on the same day that the Complainants announced a new venture to be named "TATA Fintech" and that the disputed domain name is an exact match for that name (which also matches the second Complainant's trading name) suggests that the disputed domain name was registered with intent to target the Complainants' rights in the TATA mark for commercial gain. The disputed domain name has been offered for sale on the Registrar's auction page for an amount exceeding the Respondent's likely out of pocket costs. In the Panel's opinion, this is prototypical cybersquatting and constitutes registration and use in bad faith in terms of paragraph 4(b)(i) of the Policy.

The Respondent has failed to provide a substantive response to the Complainants' case. There is no evidence of any actual, probable, or contemplated good faith use of the disputed domain name before the Panel. In the absence of such, the Panel has been unable to identify any factors in the present record suggesting any possible good faith motivation on the Respondent's part in connection with the registration and use of the disputed domain name.

In all of the above circumstances, the Panel finds that the disputed domain name has been registered and is being used in bad faith and therefore that the Complainants have carried their burden in terms of paragraph 4(a)(iii) of the Policy.

## **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 <tatafintech.com> be transferred to the second Complainant.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Sole Panelist

Date: August 29, 2023