

ADMINISTRATIVE PANEL DECISION

Godrej and Boyce MFG Co Ltd. v. huang jun wei
Case No. D2023-5378

1. The Parties

The Complainant is Godrej and Boyce MFG Co Ltd., India, represented by DePenning & DePenning, India.

The Respondent is huang jun wei, China.

2. The Domain Name and Registrar

The disputed domain name <godrejvietnam.com> is registered with Gname 069 Inc (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 28, 2023. 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 December 30, 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 (NIL) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 3, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. The Complainant filed an amended Complaint in Chinese on January 5, 2024, including its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 January 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 31, 2024.

The Center appointed Rachel Tan as the sole panelist in this matter on February 20, 2024. 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 company based in India which specializes in engineering, manufacturing, and dealing with consumer and industrial products/services. The Complainant was incorporated in 1932 but its history can be traced back to 1897. The Complainant established its presence in India with 28 office establishments across 20 branch locations and 71 showrooms. It also set up representative offices and subsidiaries worldwide, including in China and Viet Nam.

The Complainant is the owner of the GODREJ mark in different jurisdictions. For example, Indian Registration No. 193155 for GODREJ, registered on November 4, 1959 in Class 11, Indian Registration Nos. 336745 and 336746 for GODREJ, both registered on May 20, 1978 in Class 6. The trademark GODREJ has been held to be a well-known mark and is included in the list of well-known trademarks by the Indian Trade Marks Registry.

The Complainant is the registrant of various domain names relating to or consisting of its trademark GODREJ, including <godrej.com>, <godrej.co>, <godrej.in>, <godrejsingapore.com>. The Complainant was the registrant of the disputed domain name and has used the same for its business in Viet Nam at least since 2005. Copies of the Complainant's catalogues including one marked with year "2005" are attached to the Complaint which displays the disputed domain name along with the address and the communication details about the Complainant's company in Viet Nam.

The Complainant's registration of the disputed domain name expired around July 2023. The Complainant had inadvertently missed renewing the disputed domain name. The Complainant later realized the disputed domain name was registered under the Respondent's name.

The disputed domain name was registered on November 20, 2023. At the time of the Complaint and at the time of Decision, it does not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's GODREJ marks as it incorporates the entirety of the mark along with the word "vietnam". The additional suffix only refers to the location of trade and the Complainant's mark remains the most distinctive element in the disputed domain name.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use its GODREJ mark or to apply any domain name incorporating the mark. The Respondent has not made any legitimate offering of goods or services. There is no plausible explanation for the Respondent to register the disputed domain name.

Finally, the Complainant asserts that the Respondent has registered and used the disputed domain name in bad faith. The Respondent should have known of the Complainant's marks given its well-known status and wide use on the Internet. Previous decisions held that the passive holding of a domain name and use of a

domain name by someone with no connection with the Complainant constitutes bad faith. The Respondent's registration of the disputed domain name is to usurp the reputation and goodwill of the Complainant's GODREJ mark and is an opportunistic bad faith to benefit from the Complainant's inadvertent failure to renew the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was initially filed in English. Although the Complainant filed the amended Complaint in Chinese, the Complainant maintained to request that the language of the proceeding be English for several reasons, including the fact that (i) the disputed domain name resolves to a page in English; (ii) the Registrar's name "Gname 069 Inc" and referral URL "www.gname.com" are in English.

The Respondent did not make any specific submissions with respect to the language of the proceeding nor did the Respondent choose to file any response despite the fact that the Center notified the amended Complaint translated into Chinese to the Respondent.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term "vietnam" may bear on assessment of the second and third elements, the Panel finds the addition of this geographical term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Lastly, it is permissible for the Panel to ignore the generic Top-Level Domain (“gTLD”), in this case “.com”, under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to the choice of the term “godrej” in the disputed domain name. There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. Moreover, the Complainant has not granted the Respondent any license or authorization to use the Complainant’s GODREJ mark or register the disputed domain name.

None of the circumstances in paragraph 4(c) of the Policy are present in this case. Further, the Panel considers that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name decades after the Complainant registered its GODREJ mark. Through use and advertising, the Complainant’s GODREJ mark is known throughout the world, including in Viet Nam which is the geographical term in the disputed domain name. Search results using the term “godrej” on the Internet search engines direct Internet users to the Complainant and its business, which indicates that an exclusive connection between the GODREJ mark and the Complainant has been established. As such, the Respondent should have known of the Complainant’s GODREJ mark when registering the disputed domain name.

The Panel also notes that the Respondent acquired the disputed domain name in around four months after the Complainant's failure to renew it. Evidence shows that the Complainant has used the disputed domain name for almost 20 years (at least since 2005). The Respondent does not provide any explanation to the registration of the disputed domain name. There is also no legitimate use of the disputed domain name since it currently resolves to an inactive page. It has been held that a respondent acquired a domain name shortly after expiration and does not appear to have made legitimate use of the domain name is evidence of bad faith. See *John Hutton International v. Whois Privacy Protection Service by Value Domain / Axelight co.,Ltd., Yasutaka Sakatani*, WIPO Case No. [D2015-0318](#).

Section 3.1.4 of the [WIPO Overview 3.0](#) states that the "mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". In this case, the disputed domain name incorporates the Complainant's widely-known GODREJ mark with a geographic term (i.e., "vietnam"), and was registered by the Respondent who has no relationship with the Complainant, thus creating a presumption of bad faith.

Panels have found that the non-use of a domain name (including a page displaying message "This site can't be reached") would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <godrejvietnam.com> be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: March 5, 2024