

ADMINISTRATIVE PANEL DECISION

TATA Sons Private Limited, TATA Digital Private Limited v. Miiraj shah
Case No. D2024-2155

1. The Parties

The Complainants are (1) TATA Sons Private Limited, India, and (2) TATA Digital Private Limited, India, internally represented.

The Respondent is Miiraj shah, India.

2. The Domain Name and Registrar

The disputed domain name <tatadigitalmarketing.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 30, 2024. On May 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 2024, 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 May 31, 2024, 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 June 4, 2024.

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 June 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 28, 2024. The Respondent sent an email communication to the Center on June 29, 2024.

The Center appointed Vinod K. Agarwal as the sole panelist in this matter on July 5, 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 Complainants are members of TATA group of companies (hereinafter, “the Complainant Group”) which also includes service companies and companies selling TATA products to franchisees in certain markets. TATA group of companies are very popular and famous in India and in many countries of the world. The Complainant Group is engaged in various kinds of businesses which includes companies providing consultancy services, selling, and manufacturing vehicles, steel products, chemicals products, consumer products, watches, electricity, hospitality services, communications, television channels, financial and electronics. There are 29 publicly listed TATA enterprises with a combined market capitalization of USD 300 billion as of July 2023. Relevant extracts from the Complainant Group website “www.tata.com” showing use of the trademark TATA in relation to a variety of products and services are enclosed as Annexure B.

The Complainant No. 1 was incorporated on November 8, 1917. Extracts from records of the Ministry of Corporate Affairs, Government of India in support of this are enclosed as Annexure D to the Complaint. The Complainant No. 1 owns several trademark registrations, inter alia, Indian trademark registration No. 6089 for TATA, registered on October 2, 1942, and Indian trademark registration No. 4347419 for TATA DIGITAL, registered on August 16, 2020. The Complainant No. 2 is authorized, via trademark and trade name agreements, the contents, and terms of which are confidential, to use and enforce the trademark and trade name TATA and to do business under the said trademark and trade name in India. The Complainants are collectively hereinafter referred to as the “Complainant”.

The disputed domain name was registered on March 28, 2024, and resolves to a website prominently displaying “tatadigitalmarketing”, and purportedly offering digital marketing services. The bottom page of the webpage displays a copy right notice that reads “© 2024 tatadigitalmarketing”.

5. Parties’ Contentions

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (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. Complainant

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

In relation to element (1), the Complainant contends that the word TATA and TATA DIGITAL are the registered trademarks of the Complainant. The Complainant Group registered the trademark TATA as early as in the year 1942. The trademark TATA is inherently distinctive and is a strong identifier of source for the Complainant Group and its goods and services. The expression TATA has no dictionary meaning and does not otherwise exist in the English language. The said trademark has been used by the Complainant extensively making it distinctive and synonymous to the Complainant and its services provided under the said mark/name. The trademarks TATA and TATA DIGITAL enjoy great reputation and immense goodwill

worldwide. The trademark TATA is the subject of a large number of trademark registrations in several countries around the world.

According to the Complaint, the Complainant also owns several domain names, which contain its registered trademark/name TATA and TATA DIGITAL. By virtue of prior adoption, long and continuous use and extensive publicity and promotion, the trade name and trademarks TATA and TATA DIGITAL have acquired goodwill amongst the public in general. Thus, it is associated by the public exclusively with the Complainant and their services and products.

In view thereof, the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

In relation to element (ii), the Complainant contends that the Complainant's trademarks TATA and TATA DIGITAL have become highly distinctive of the services of the Complainant on account of extensive use, viewer ship and promotion. The registration of the disputed domain name amounts to taking unfair advantage of the Complainant's reputation and goodwill. It is completely detrimental to the distinctive character of the Complainant's trademark TATA and TATA DIGITAL.

Further, the Respondent is in no way related to the Complainant. The Complainant has not licensed or otherwise permitted or granted to the Respondent an authorization or a right to use their trademark or to apply for or use the disputed domain name incorporating the trademark and that nobody would use the words "tata" and "tata digital" unless seeking to create an impression of an association with the Complainant.

The act of the Respondent constitutes infringement and passing off of the trademark rights of the Complainant. The Respondent registered the disputed domain name for the sole purpose of creating confusion and misleading the public and the customers of the Complainant. Thus, it is contended that there were no rights or legitimate interests of the Respondent in the disputed domain name.

The Respondent registered the disputed domain name nearly after a period of nearly five years from the adoption of the mark TATA DIGITAL and almost nine years after the Complainant No. 1 registered the domain name <tatadigital.com>. Furthermore, the trademark TATA DIGITAL has not been used by anyone other than the Complainant or their licensees. It is obvious that the well-known stature of the Complainant No. 1's trademark TATA, has motivated the Respondent to register the disputed domain name. Hence, any use of the disputed domain name cannot be said to be bona fide.

The Complainant has not authorized or licensed the Respondent to use any of their trademarks or trade name in any way. Such unlicensed and unauthorized use of the disputed domain name incorporating the Complainant's TATA DIGITAL trademark and tradename is solely with a view to misleadingly and maliciously divert consumers and to tarnish the trademark of the Complainant.

Further that, the bottom page of the Respondent's webpage displays a copy right notice that reads "© 2024 tatadigitalmarketing" which is a deceptive copyright notice which deceives users that the webpage is hosted by the Complainant. Reliance is placed on a similar deceptive practice performed in *TATA Sons Private Limited and TATA Digital Private Limited v. Hardik Dabhi*, WIPO case No. [DIO2024-0002](#), wherein the panel found the same as misleading and held that the Respondent lacks right or legitimate interest in the disputed domain name.

The Complainant has, therefore, established a prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name.

Regarding the element (iii), the Complainant contends that the disputed domain name was registered and is being used in bad faith to obtain unfair commercial gain, at the expense of the Complainant.

The Complainant contends that the primary aim of the Respondent is to mislead potential customers of the Complainant and direct them to the website at the disputed domain name. The fact that the Respondent has registered the disputed domain name, which is identical to the Complainant's trademark, including to direct users to pages in a similar line of business as the Complainant demonstrates that the Respondent has registered the disputed domain name in bad faith. The Respondent's actions are with an intention to extract some commercial advantage from the Complainant's goodwill in the market. Therefore, The Complainant contends that the disputed domain name was registered or acquired by the Respondent primarily for the purpose of carrying on some business in competition to the Complainant.

Further that, the Complainant's TATA and TATA DIGITAL trademarks are well known prior to the registration of the disputed domain name. Hence, the Respondent is bound to have knowledge of the Complainant's TATA and TATA DIGITAL trademarks. In support of this contention, the Complainant places reliance on section 3.2.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Respondent registered the disputed domain name in full knowledge of the Complainant's trademark rights and, on balance, with the intention of taking advantage of such rights. Even constructive knowledge of famous trademarks like TATA and TATA DIGITAL is sufficient to establish registration in bad faith.

UDRP panels have consistently found that the mere 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. Reliance is placed on section 3.1.4 of [WIPO Overview 3.0](#). The Complainant's trademark TATA is declared to be a well-known trademark. Hence, it can be presumed that Respondent's conduct of registering and using the disputed domain name is in bad faith. The requirement under the third element is thus satisfied.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. On June 29, 2024, the Respondent sent an email to the Center stating that "[g]ive me a time of week my health is not good I will respond you soon...".

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove the following aspects:

A. Identical or Confusingly Similar

As has been mentioned above, according to paragraph 4(a) of the Policy, the Complainant must prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has provided sufficient evidence of its registration of the trademark TATA and TATA DIGITAL in several classes. There is therefore no ambiguity or doubt regarding the Complainant's rights in the said trademarks. The Panel finds the Complainant's trademarks are recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. The addition of the generic Top-Level Domain ("gTLD") "com" is a technical requirement, and is typically disregarded under the first element of the Policy. See [WIPO Overview 3.0](#), section 1.11.1. Thus, the disputed domain name is confusingly similar to the trademark of the Complainant.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the trademarks in which the Complainant has rights. Accordingly, the requirement under the first element of the Policy has been satisfied.

B. Rights or Legitimate Interests

According to paragraph 4(c) of the Policy, the Respondent may demonstrate its rights or legitimate interests in the disputed domain name by proving any of the following circumstances:

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

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. [WIPO Overview 3.0](#), section 2.1.

The Respondent has made an informal communication by email on June 29, 2024, stating "[g]ive me a time of week my health is not good I will respond you soon....," but has not filed a formal Response in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The Complainant has not authorized the Respondent to use the name and its trademark TATA DIGITAL.

Further, in view of the fact that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark or to apply for or use the disputed domain name incorporating the trademark of the Complainant, and that nobody would use the words "tata digital marketing" unless seeking to create an impression of an association with the Complainant. 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. Further, the Respondent's display of the webpage when considered in its entirety does not constitute bona fide offering of services.

Based on the default and the evidence provided in the Complaint, the Panel finds that the above circumstances in paragraph 4(c) of the Policy do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances in particular but without limitation, shall be considered evidence of the registration and use of the domain name in bad faith:

- (i) Circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) The Respondent has registered the disputed 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 it has engaged in a pattern of such conduct; or

- (iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

The Complainant contends that the primary aim of the Respondent is to mislead potential customers of the Complainants and direct them to the website at the disputed domain name. The fact that the Respondent has registered the disputed domain name, which is confusingly similar to Complainant's trademarks, is to direct users to pages in a similar line of business as the Complainant demonstrates that the Respondent has registered the disputed domain name in bad faith. The Respondent's actions are with an intention to extract some commercial advantage from the Complainant's goodwill in the market. Therefore, The Complainant contends that the disputed domain name was registered or acquired by the Respondent primarily for the purpose of carrying on some business in competition to the Complainant.

Further that, the Complainant's TATA and TATA DIGITAL trademarks have immense goodwill and reputation and are well-known prior to the registration of the disputed domain name. Hence, the Respondent knew or should have knowledge of Complainant's TATA and TATA DIGITAL trademarks. In support of this contention, the Complainant places reliance on section 3.2.2 of the [WIPO Overview 3.0](#). The Respondent registered the disputed domain name in full knowledge of the Complainant's trademark rights and, on balance, with the intention of taking advantage of such rights.

The disputed domain name resolves to a website prominently displaying "tatadigitalmarketing", and purportedly offering digital marketing services. It is an attempt by the Respondent to derive unfair advantage, wrongful commercial gains and to mislead the public. The Respondent is not making a noncommercial or fair use of the disputed domain name. This and the other evidence submitted by the Complainant leads to the finding that the disputed domain name was registered and used by the Respondent in bad faith, in accordance with the paragraph 4(b)(iv) of the Policy.

The Panel concludes that the paragraph 4(a)(iii) of the Policy is satisfied.

In support of the Complaint, the Complainant has relied on and referred certain number of earlier decisions delivered in their favor by different entities. The same have been carefully considered.

7. Decision

In the light of 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 <tatadigitalmarketing.com> be transferred to the Complainant.

/Vinod K. Agarwal/

Vinod K. Agarwal

Sole Panelist

Date: July 18, 2024