

ADMINISTRATIVE PANEL DECISION

TATA Sons Private Limited, TATA Digital Private Limited v. INDIAN MEMBERS BENEFIT FUND LIMITED

Case No. D2024-3506

1. The Parties

The Complainants are TATA Sons Private Limited (“Complainant No. 1”) and TATA Digital Private Limited (“Complainant No. 2”), India, internally represented.

The Respondent is INDIAN MEMBERS BENEFIT FUND LIMITED, India.

2. The Domain Name and Registrar

The disputed domain name <tatafindigital.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 28, 2024. On August 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 29, 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 Complainants on September 13, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on October 7, 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 October 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 28, 2024. On September 14, 2024, the Center received an email communication from an email address that, according to the Registrar verification, corresponded to the administrative/technical/billing contact of the disputed domain name. The proceeding has been suspended

to explore settlement discussions and reinstated. The Center informed the Parties that it would proceed with the panel appointment on October 29, 2024.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on November 4, 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 No. 1 & Complainant No. 2 are cumulatively referred to as the “Complainants”. The Complainants are part of TATA group of companies (“Complainant Group”) which includes service companies and companies selling TATA products to franchisees in certain markets. The Complainant Group is engaged in various kinds of business which includes companies providing consultancy services, selling and manufacturing vehicles, steel products, chemicals products, consumer products, watches, electricity, hospitality services, communications, financial. There are 26 publicly listed Tata enterprises with a combined market capitalization of more than USD 365 billion as on March 31, 2024. The Complainant No. 1 is principal investment holding company and promoter of Tata companies that was incorporated on November 8, 1917. The Complainant No. 2 was incorporated on March 11, 2019.

The Complainants’ trademark TATA was registered as early as 1942 by the Complainant Group. The Complainant No. 2 is authorized vide 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 thereunder in India. The Complainants trademark is also declared well-known by the Hon’ble High Court of Delhi. The Complainants also have several other registered trademarks for TATA, TATA DIGITAL and other variations in India. For instance, they own registrations bearing no. 92651 for TATA dated February 16, 1944; no. 111694, TATA (LABEL) (device) registered on July 13, 1945 and no. 4347419 for TATA DIGITAL dated November 14, 2019 inter alia, in class 35, 36, and 42.

The Complainant No. 1 owns the domain names <tata.com> registered since October 15, 1996, and <tatadigital.com> which was registered on May 26, 2015.

The disputed domain name <tatafindigital.com> was registered on June 13, 2024, and the Respondent’s website has a home page with the same name of Complainant No. 2 and identifies itself as a digital financial services provider “Tata Digital Private Limited - A leading Indian digital financial services provider committed to providing innovative financial solutions to Indian and global consumers”. The website of Respondent also advertises “Easy Bank Finder App in the google play store” followed with claims offering wide range of financial products and services such as “loan services, investment services, payment services and insurance services. Additionally, there is a “Career” tab which displays current openings and “how to apply” tab. Followed by another tab for “Contact” wherein the Complainant No. 2’s registered office address is mentioned along with an email id “[...]@tatafindigital.in” followed by two mobile numbers.

5. Parties’ Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that that the disputed domain name is confusingly similar to Complainants’ trademark and that it completely subsumes Complainant No.1’s trademarks TATA and TATA DIGITAL and the dominant part of Complainant No. 2’s tradename “TATA Digital”. The Respondent registered the disputed domain name on June 13, 2024, which is several years after the statutory and

common law rights acquired by the Complainants in their trademark and tradename “TATA” and “TATA Digital”.

The Complainants further state that it is a well-established principle that the generic Top-Level Domain extension (“gTLD”) are not to be considered while determining confusing similarity under the first element.

The Complainants also claim that the Respondent has no rights and legitimate interests with respect to the disputed domain name. The Respondent has used the disputed domain name, which is identical to the Complainants’ trademarks, to direct users to pages which have no relation to either of the Complainants or any of their group companies. The Complainants contend that the Respondent has secured the disputed domain name being motivated by the Complainants’ well-known stature of its mark TATA. The Complainants also highlighted that neither does the Respondent own any trademark corresponding to the disputed domain name nor have the Complainants licensed/authorized the Respondent to use its trademark or any domain name including the trademark TATA DIGITAL. The Complainants allege that there are high chances that potential customers would be induced to subscribe to the services of the impugned website or to deal in some manner with the Respondent believing them to be licensed or authorised by the Complainant No. 2. Moreover, potential customers would be induced into believing that the Respondent has some connection with the Complainants in terms of a direct nexus or affiliation with the Tata Group of Companies.

The Complainant has further alleged that the disputed domain name has been registered by the Respondent in bad faith. The Complainants claim that the mere registration of the disputed domain name by the Respondent, using the Complainant No.1’s well-known trademark TATA itself leads to a presumption of bad faith. They further contend that the primary aim of the Respondent is to mislead potential customers of the Complainants and to direct them to the website “www.tatafindigital.com”. They allege that the Respondent’s registration of the disputed domain name, which is identical to the Complainants’ trademark, and use of it to direct users to pages in a similar line of business as that of the Complainants’, demonstrates that the Respondent has registered the disputed domain name in bad faith. According to the Complainants, the Respondent intends to extract some commercial advantage from the Complainants. The Complainant No. 1’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 Complainants claim, the Respondent is bound to have had knowledge of the Complainant No. 1’s TATA and TATA DIGITAL trademarks prior to the registration of the disputed domain name.

B. Respondent

The Respondent did not submit a formal reply to the Complainant’s contentions; however, the Center received an email on September 14, 2024, from an email address confirmed by the Registrar as the administrative/technical/billing contact of the disputed domain name, indicating that they have registered the disputed domain name on behalf of a client and that they will delete the disputed domain name immediately.

No further emails were received, either from the administrative/technical/billing contact of the disputed domain name, or from the Respondent.

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“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 TATA is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the marks TATA and TATA DIGITAL are recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

It is a well-established principle that gTLD are not to be considered while determining confusing similarity under the first element.

Although the addition of other terms here, “fin” appearing between “tata” and “digital” in the disputed domain name may bear on assessment of the second and third elements, the Panel finds the addition of such 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.

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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ 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 used the disputed domain name, which is confusingly similar to the Complainants’ trademarks, to direct users to pages which have no relation to either of the Complainants or any of their group companies. Respondent’s use of the disputed domain name cannot be said to be in connection with any bona fide offering of goods or services.

The Complainants have not authorized or licensed the Respondent to use any of their trademarks or tradename in any way. Such unlicensed and unauthorized use of a domain name incorporating the Complainants’ TATA DIGITAL trademark and tradename is, in view of the Panel, misleading and intended to maliciously divert Internet users.

Panels have held that the use of a domain name for passing off including by way of impersonation, and other types of illegitimate use can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In this instance, the Respondent’s website has a homepage with the same name and contact details as that of the Complainant No. 2 and claimed to offer services that are legitimately offered by the Complainant. Clearly the Respondent has deliberately tried to pass off itself as the Complainants.

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 knew or at least should have known the existence of the Complainants' trademarks TATA and TATA DIGITAL. The Panel concurs with the Complainants contention that the Respondent's primary aim is to mislead potential customers of the Complainants and direct them to the disputed domain name. The facts involving the disputed domain name and the conduct of the Respondent indicate that the primary aim of the Respondent was to mislead Internet users with the intent to extract some commercial advantage from the Complainants' goodwill in the market.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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 <tatafindigital.com> be transferred to the Complainant.

/Meera Chature Sankhari/

Meera Chature Sankhari

Sole Panelist

Date: November 12, 2024