

ADMINISTRATIVE PANEL DECISION

Titan Company Limited v. The trustee for OM JEWELLERS TRUST
Case No. DAU2023-0050

1. The Parties

The Complainant is Titan Company Limited, India, represented by Anand & Anand, India.

The Respondent is The trustee for OM JEWELLERS TRUST, Australia.

2. The Domain Name and Registrar

The disputed domain name <tanishq.au> is registered with Web Address Registration Pty Ltd (the "Registrar").

3. Procedural History

The Complaint was initially filed on October 25, 2023, with the WIPO Arbitration and Mediation Center (the "Center"). On the same date the initial Complaint was filed, the Respondent contacted the Complainant offering to sell the disputed domain name. As a result, the Complainant added this information and submissions relating to it to the Complaint and filed the final version of its Complaint on November 7, 2023. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 10, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy" or ".auDRP"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 17, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was December 7, 2023. On November 27, 2023, the Center received an email from the Respondent. On November 27, 2023, the Center sent an email regarding possible settlement to the Parties. On November 28, 2023, the Complainant informed the Center by email that it does not wish to settle the dispute. The Respondent did not submit any formal response. Accordingly, the Center notified the commencement of panel appointment process on December 8, 2023.

The Center appointed Douglas Clark as the sole panelist in this matter on December 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 an Indian company engaged in the business of retail sales of jewellery under its commercial name "Tanishq". The Complainant owns numerous trade mark registrations for TANISHQ around the world, including but not limited to the following:

| Trade Mark | Registration Number | Registration Date | Jurisdiction |
|------------|---|--------------------|--------------------------|
| TANISHQ | Various, including but not limited to 729270, 729271, 729274 and 729278 | September 13, 1996 | India |
| TANISHQ | 869997 | March 21, 2001 | Australia |
| TANISHQ | 2323656 | February 29, 2000 | United States of America |

The Complainant owns and operates domain names comprising the mark TANISHQ in its entirety, such as <tanishq.com>.

The disputed domain name <tanishq.au> was registered on March 22, 2023. As of the date of this Complaint, the disputed domain name was inactive and could not be reached.

According to the disclosed registration details, the Respondent is acting as trustee for an Indian organization, OM JEWELLERS, also engaged in the jewellery business.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

(a) The disputed domain name is identical or confusingly similar to its trade mark. The disputed domain name incorporates the Complainant's trade mark, TANISHQ, in its entirety.

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use the Complainant's trade mark or register the disputed domain name. After sending the Complaint to the Center, the Respondent sent an email to the Complainant offering the disputed domain name for sale at AUD 5,000. This is a clear evidence of the fact that the Respondent is a domain name squatter and is making no legitimate commercial use of the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith. The Complainant's trade mark is well known and reputable both in India and internationally. Given that the Respondent is also engaged in the jewellery business, it is reasonable to infer that the Respondent had registered and used the disputed domain name knowing the existence of the Complainant's trade mark. The Respondent has intentionally attempted to ride upon the reputation of the TANISHQ trade mark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. On November 27, 2023, the Respondent sent an email to the Center:

"I just want to make everyone aware the domain name was available for sale so I purchased it and had no intention of opening any business in that name.

I purchase it as an asset and would happily sell it at a fair price.

I don't know what to do further from this.

I have no intention of extending this into unnecessarily long legal matter.

Tanishq and their representatives could have simply contacted myself to make this process simpler and more amicable.

I am genuinely proud of tanishq and the Tata group [sic] in general. What they have achieved is an inspiration to myself."

6. Discussion and Findings

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark 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 or subsequently used in bad faith.

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 identity or confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name. Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDRP Overview 2.0"), section 1.7.1.

The Panel finds that the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. auDRP Overview 2.0, section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. auDRP Overview 2.0, section 1.7.3.

The Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

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

The Complainant will usually make out a *prima facie* case by establishing none of the paragraph 4(c) circumstances are present. Once such a *prima facie* case is made, the burden of production shifts to the Respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such evidence, the Complainant is generally deemed to have satisfied the second element.

The Panel finds that 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* case and has not come forward with any evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that the composition of the disputed domain name carries a high risk of implied affiliation with the Complainant. auDRP Overview 2.0, section 2.5.1. Moreover, upon being informed of the Complaint, the Respondent offered the disputed domain name for sale, reflecting an intent for commercial gain. Considering the absence of substantial response by the Respondent and the fact that the Respondent was granted neither a license nor authorization to make use of the Complainant's trade mark, the Panel finds that the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name.

The Panel finds that the second element of the Policy has been established.

C. Registered or Subsequently 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.

The disputed domain name was registered long after the Complainant has registered the TANISHQ trade mark and the use of the Complainant's TANISHQ trade mark is clearly not a coincidence. The TANISHQ trade mark is used by the Complainant to conduct its business and the Complainant has used the trade mark for over 20 years. Moreover, the Respondent expressed awareness of the Complainant in its informal communication to the Center and also apparently serves as trustee to an organization operating in the same industry, and geographic area, as the Complainant. Accordingly, the Panel is satisfied that the Respondent was aware of the Complainant and its TANISHQ trade mark when it registered the disputed domain name.

Under the Policy it is sufficient to find either that there has been registration or use in bad faith. Nevertheless, according to the Respondent's emails to the Complainant and the Center offering to sell the disputed domain name, the Panel finds that the Respondent registered the disputed domain name in bad faith, pursuant to paragraph 4(b)(i) of the Policy. Accordingly, based on the totality of the circumstances, the passive holding of the disputed domain name does not prevent a finding of bad faith. auDRP Overview 2.0, section 3.3.

The Panel finds that the third element of the Policy has been established.

7. Decision

For all 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 <tanishq.au> be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: January 11, 2024