

ADMINISTRATIVE PANEL DECISION

TATA Sons Private Limited and TATA Digital Private Limited v. Hardik Dabhi Case No. DIO2024-0002

1. The Parties

The Complainants are TATA Sons Private Limited (the “First Complainant”) and TATA Digital Private Limited (the “Second Complainant”), India, internally represented.

The Respondent is Hardik Dabhi, India, self-represented.

2. The Domain Name and Registrar

The disputed domain name <tatadigital.io> 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 January 30, 2024. On February 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 6, 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 February 7, 2024.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent sent informal email communications to the Center on February 13, 2024, and March 2, 2024. On March 1, 2024, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Harini Narayanswamy as the sole panelist in this matter on March 8, 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 part of the Tata Group of companies, a leading business conglomerate of India with business interests in various products and services. The First Complainant, Tata Sons Private Limited was incorporated in 1917 and is the principle holding company of the Tata Group which has 29 public listed companies with a combined market capitalization of USD 300 billion as of July 31, 2023.

The First Complainant owns a large portfolio of trademark registrations for the TATA marks in many jurisdictions. Some of the earliest Indian trademark registrations for the TATA mark include, TATA word mark bearing trademark number 6089, registered on October 2, 1942 and TATA device mark bearing trademark number 109360, registered on April 12, 1945. The First Complainant owns Indian trademark registrations for the TATA DIGITAL word mark 4347419 for classes 35, 36, and 42, registered on November 14, 2019.. The First Complainant owns a number of domain names including the domain names <tata.com>, registered on October 15, 1996, and <tatadigital.com> registered on May 26, 2015.

The disputed domain name was registered by the Respondent on October 28, 2023. The Respondent was using the disputed domain name to post articles and blogs about the Tata Group of companies, such as information about Indian Premier League (“IPL”) cricket which is sponsored by the Tata Group, investment information about the Tata companies such as stock prices. The title of some of some of the articles posted by the Respondent are “IPL 2024 Auction A Closer Look at the Players and Expectations”, “Unveiling the Excitement: IPL 2024 Schedule Revealed”, “Tata Motors Share Price: A Comprehensive Analysis”. Presently the Respondent has taken down the disputed domain name and it is not reachable.

5. Parties’ Contentions

A. Complainant

Both the Complainants in these proceedings are collectively referred to as “the Complainant”. The Complainant contends that it has used the TATA mark extensively for several decades due to which it has acquired the reputation of a well-known mark. The Complainant further contends that the well-known nature of its mark has been recognized by several courts and in administrative proceedings and has supported its contentions with copies of some of the orders.

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name. These are: (i) The disputed domain name is identical or confusingly similar to its marks TATA and TATA DIGITAL and that “Tata Digital” is also a dominant part of the trade name of the Second Complainant. (ii) The Respondent lacks rights or legitimate interest in the disputed domain name and is not connected with the Complainant or authorized to use its mark. (iii) The disputed domain name is registered and used in bad faith, as Internet users are being misled and diverted to the Respondent’s site based on its well-known mark.

B. Respondent

The Respondent did not file a formal response but sent two email communications to the Center. In the first email communication dated February 13, 2024, the Respondent contends that he is a fan of the Tata group since childhood, and that he has registered the disputed domain name with the intention of using it as a noncommercial fan site. The Respondent claims that he looked for domain names related to “.ai” Top-Level-Domains (“TLDs”) and found the domain name <tatadigital.ai> and also the disputed domain name and he registered both.

The Respondent states that he has used the disputed domain name to post news, articles, and blogs related to the Tata group and does not use it for any commercial business purposes. He states that he has not yet developed or used the domain name <tatadigital.ai> due to lack of funds. He alleges that he does not intend damaging or defaming the TATA group and has invested his time and money to promote the Tata group and states that he has not done “any illegal activities”. The Respondent requests to continue using the disputed domain name.

In the second email dated March 2, 2024, the Respondent states that he has closed the disputed domain name since February 12, 2024. No further communications were received from the Respondent.

6. Discussion and Findings

Three elements need to be established by the Complainant under paragraph 4 (a) of the Policy to obtain transfer of the disputed domain name, these are:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent lacks rights or legitimate interests in the disputed domain name; and
- (iii) The disputed domain name was registered and is being used in bad faith by the Respondent.

A. Identical or Confusingly Similar

The first element under paragraph 4(a) of the Policy requires the Complainant to establish the disputed domain name is confusingly similar to a trademark or a service mark in which it has rights.

The Complainant has provided evidence of its registered trademark rights in the TATA mark and the TATA DIGITAL mark. The Complainant’s trademark registration satisfies the threshold requirement of having rights in a mark. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)) section 1.2. The evidence provided by the Complainant also shows extensive use of the TATA mark by the Complainant’s group companies for a number of years in India and in other jurisdictions. Accordingly, the Complainant is found to have established its rights in respect of the trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#) section 1.2.1. The Respondent has not controverted the trademark rights of the Complainant.

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 TATA mark is reproduced within the disputed domain name and the Panel finds the addition of the term “digital” 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. Furthermore, the Complainant has registered trademark rights TATA DIGITAL and disputed domain name is found to be identical to the TATA DIGITAL mark.

The TLD “.io”, is a technical requirement, which can be disregarded under the first element of the confusing similarity test, unless the TLD extension itself is part of the trademark. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is identical to the mark TATA DIGITAL in which the Complainant has established rights. The first element of the Policy has been satisfied by the Complainant.

B. Rights or Legitimate Interests

The second element under paragraph 4(a) of the Policy requires the Complainant to make a prima facie case that the Respondent lacks rights and legitimate interests in the 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. 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. The Respondent has submitted that he intends using the disputed domain name as a non-commercial fan-site, essentially claiming the defense of noncommercial fair use of the disputed domain name under the provisions of paragraph 4 (c) (iii) of the Policy.

In order for a fan site to come under the ambit of paragraph 4(c)(iii), the consensus view of panels is that the disputed domain name must actually be used as a fan site, it should be distinctive from any official site of the complainant, and it should be noncommercial in nature, [WIPO Overview 3.0](#) section 2.7.1. See also *Bally Gaming, Inc. d/b/a bally technologies v. Dreamhost, LLC / Aaron. Stein*, WIPO Case No. [D2015-0757](#) and *Royal Multisport Private Limited v. Deepak Jawade*, WIPO Case No. [D2023-0048](#).

Regarding the use of an identical domain name by a respondent to host a fan site, the consensus among panels is that, the right to host a fan site, does not mean the respondent is entitled to use an identical domain name.

The rationale is that the registration of a domain name that is identical with a complainant’s mark would amount to intentional misrepresentation and trying to pose as the complainant. Therefore, a respondent claiming fair use for a fan site under paragraph 4(c)(iii) of the Policy, would lack rights or legitimate interests if the disputed domain name is identical to the mark. [WIPO Overview 3.0](#) section 2.7. See for instance *Bennett, Coleman and Company Limited, Worldwide Media Private Limited v. Mr. Hubert Louis*, WIPO Case No. [D2019-0221](#).

Panels are also of the view that the website associated with a domain name (assuming it is not identical to the relevant mark) should clearly state that it is a fan site and it is not associated with or endorsed by the complainant. Some panels are of the view that, despite the noncommercial nature of use, some limited automated advisements could be considered legitimate under some circumstances. [WIPO Overview 3.0](#) section 2.7.3.

The Panel has reviewed the evidence filed by the Complainant in the present case showing the Respondent’s website content and has also conducted independent research at “www.archive.org”, under the panel’s general discretion to conduct limited searches, WIPO 3.0 section 4.8. The snapshot of the Respondent’s web page dated December 14, 2023 on the Way Back Machine displays various articles about the TATA group. The bottom of the Respondent’s webpage displays TATA DIGITAL and a logo with the letters “TD” and a copyright notice that reads:

“© Tatadigital 2023. All rights reserved”.

The Panel finds the entire look of the webpage, including the deceptive copyright notice on the Respondent’s webpage is highly misleading. To an unwary user, the content of the Respondent’s webpage is likely to be mistaken for a website being hosted by the Complainant. Further, there is no mention that the site is a fan

site and there is no disclaimer that the site is hosted by a third party who has no connection with the Complainant. In short, the material on record shows no evidence of non-deceptive use of either the disputed domain name or the website to which it resolves.

Deceptive impersonation here is operating on two levels. First, the use of the entire mark, and only the mark in the disputed domain name misleads the user. Second, the Respondent's webpage that displays the company name along with a misleading copyright notice, is suggestive of the webpage content being owned and endorsed by the Complainant. If an Internet user looking for the Complainant reaches the Respondent's website, the unwary user is likely to be misled that it is hosted by the Complainant. In the light of the evidence, and the circumstances discussed, the Panel is not convinced that the Respondent has used the disputed domain in a manner that would entitle him to claim the defense under paragraph 4 (c) (iii) of the Policy.

It was observed by the panel in *Spouting Rock Financial Partners, LLC v. Henry VERMONT*, WIPO Case No. [D2023-2270](#), concerning a criticism site: "regardless of the veracity of the content of the Respondent's website, the Domain Name creates an impermissible risk of user confusion through impersonation and hence Respondent's use of the Domain Name for the Respondent's website does not give rise to rights or legitimate interests." Similarly, in the present case, the Panel is of the view that even if the Respondent had intended to set up a fan site, irrespective of the content on the Respondent's site – and putting aside that the disputed domain name is identical to the relevant mark – the failure to clearly state the purpose of the website is a fan site and the lack of a disclaimer accurately stating the Respondent's connection with the Complainant or the lack of it, undermines the Respondent's case.

The Panel finds on the basis of the entire material, that the Complainant has made a prima facie case. The Respondent is not associated with the Complainant and is not authorized to use the mark. The Respondent is not commonly known by the disputed domain name and the Respondent has not made legitimate noncommercial fair use of the disputed domain name. The Respondent has not successfully rebutted the Complainant's prima facie showing or submitted relevant evidence that demonstrates rights or legitimate interests in the disputed domain name.

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 second element of the Policy has been established by the Complainant.

C. Registered or Used in Bad Faith

The third element under paragraph 4(a)(iii) of the Policy requires the Complainant to establish the disputed domain name has been registered and used in bad faith by the Respondent. The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy specifies circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

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 also 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.

(i) Circumstances indicate that the respondent has registered or acquired the domain name primarily for 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) The respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the 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 the respondent's 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 the respondent's website or location.

The Complainant has submitted sufficient evidence demonstrating the distinctiveness and reputation associated with its trademark. Given the composition of the disputed domain name, where the Complainant's trademark is used in its entirety and the circumstances discussed in the previous section where the Respondent is found to lack rights or legitimate interests in the disputed domain name, the entire facts and circumstances all cumulatively indicate that the Respondent has intentionally attempted to attract Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website.

Based on the material before the Panel, it is found that there is sufficient evidence to conclude that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its disputed domain name by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the disputed domain name. The Panel finds that the Respondent has targeted the Complainant's mark in bad faith, confusing and misleading users in the manner described, which is bad faith as described under paragraph 4 (b) (iv) of the Policy.

The Panel finds for the reasons discussed, that the Complainant has established the third element of the Policy that the disputed domain name has been registered in bad faith and is being used in bad faith.

The Complainant has satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

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, <tatadigital.io> be transferred to the Complainant.

/Harini Narayanswamy/

Harini Narayanswamy

Sole Panelist

Date: March 22, 2024