

ADMINISTRATIVE PANEL DECISION

Nalli Chinnasami Chetty v. Agni Guruparan, Nalli motors
Case No. D2023-0789

1. The Parties

The Complainant is Nalli Chinnasami Chetty, India, represented by DePenning & DePenning, India.

The Respondent is Agni Guruparan, Nalli Motors, India.

2. The Domain Name and Registrar

The disputed domain name <nallimotors.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2023. On February 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2023, the Registrar transmitted its verification response by email to the Center, disclosing the registrant and contact information for the disputed domain name which differed from the named Respondent (Contact Privacy Inc) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 23, 2023, 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 amended Complaint on February 27, 2023.

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 March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response by the due date. Accordingly, the Center notified the Respondent’s default on March 23, 2023.

The Center appointed Ashwinie Kumar Bansal as the sole panelist in this matter on March 28, 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 a manufacturer and merchant of silk sarees as well as other clothing, readymade garments, fashion accessories, textile goods etc. which was established in 1928. The Complainant runs an international business from its headquarters at Chennai, India and currently serves a global market through various showrooms around the world as well as its website "www.nalli.com" registered on April 28, 1998, and launched in the same year.

The Complainant has furnished evidence of registration of the Trademark NALLI including Indian Trademark No. 472754 dated May 27, 1987, and Trademark No. 903811 dated February, 16, 2000, as well as provided the details of registrations of the Trademark NALLI in United States of America, European Union, United Kingdom, Mauritius, Canada, Australia, Singapore, Sri Lanka, and New Zealand. The Complainant has further shown that it holds more than 300 other domain name registrations to its credit which include the Trademark NALLI.

The disputed domain name <nallimotors.com> was registered by the Respondent on July 05, 2022. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant in its Complaint has, *inter alia*, raised the following contentions:

The Complainant has adopted and used the Trademark NALLI for its products since 1935. By virtue of its adoption nearly nine decades back and owing to the Complainant's long, continuous, uninterrupted, and extensive usage thereof, the Trademark NALLI has fetched itself a reputation and global association with the Complainant, in the eyes of the consumers. The Trademark NALLI has developed a loyal customer base, which is associated with the service levels of the Complainant and the high-quality goods emanating therefrom.

The Complainant also has a back office consisting of about 70 people possessing the technical knowledge and are working on the online sales from the Complainant's website on domain name <nalli.com> and is looking to increase their sales target considerably in this year. The Complainant submits that considerable time, money and concerted efforts have been expended in building the brand value associated with the Trademark NALLI.

The Complainant's Trademark NALLI and its products thereunder have continued to gather a lot of media attention and have been covered by renowned media houses/newspapers. A search over the Internet with the keyword "nalli" in any leading search engine throws up the web pages of the Complainant among the leading hits.

The disputed domain name incorporates the Complainant's Trademark NALLI, in which the Complainant has statutory as well as common law rights by virtue of its long and continuous use and being the registered proprietor thereof in several jurisdictions. Hence, the Complainant contends that allowing a third party to use the Trademark NALLI would cause a great deal of confusion and deception amongst the Complainant's patrons, members of trade, consumers, and public at large.

The Respondent has adopted and acquired the well-known Trademark NALLI of the Complainant in its entirety with *mala fide* intention. The disputed domain name wholly contains the Complainant's Trademark

NALLI with a mere suffix “motors” and is therefore, confusingly similar to the Complainant’s Trademark NALLI. The Complainant has also contended that NALLI is a well-known Trademark, as acknowledged in prior UDRP proceedings.

The purpose of the Respondent’s registration of the disputed domain name is to misappropriate the reputation of the Complainant’s Trademark NALLI. The Respondent’s use of Trademark NALLI in the disputed domain name is bound to induce members of the public and the trade to believe that either the Complainant has ventured into motor business or that the Respondent has a trade connection, association, relationship or approval with/of the Complainant, when in reality it is not so.

The Respondent has no connection or affiliation with the Complainant and has not been licenced or otherwise authorized by the Complainant to use or register any domain name incorporating any of the Complainant’s trademarks. Such unlicensed and unauthorized use of the disputed domain name incorporating the Trademark NALLI is solely with a view to hoard the disputed domain name, to mislead and divert the consumers, and to tarnish the Trademark NALLI of the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name since it does not fall under any of the circumstances provided for under Paragraph 4(c) of the Policy. The disputed domain name is not being used by the Respondent for *bona fide* offering of goods, rather at present, the Respondent appears to be squatting on the disputed domain name, with no operational website. The Respondent registered the disputed domain name for commercial gain to try to create confusion / association with the Complainant. Thus, the use of the disputed domain name by the Respondent does not qualify for fair use.

The fame and unique qualities of the Trademark NALLI, which was adopted and applied for by the Complainant well prior to the registration of the disputed domain name, make it extremely unlikely that the Respondent created the disputed domain name independently without any knowledge of the Complainant’s Trademark NALLI. Even constructive knowledge of a famous trademark like the Trademark NALLI is sufficient to establish registration in bad faith.

The Respondent ought to be aware of the extensive reputation and goodwill of the Complainant’s Trademark NALLI especially since the Respondent too hails from the same state of Tamil Nadu in India. Hence, the Respondent is only attempting to usurp the reputation and goodwill of the complainant’s Trademark NALLI through the disputed domain name.

The Complainant pleads that the disputed domain name <nallimotors.com> be transferred to the Complainant.

B. Respondent

The Respondent did not submit reply to the Complainant’s contentions.

6. Discussion and Findings

As per paragraph 5(f) of the Rules, where a respondent does not submit a substantive response, in the absence of exceptional circumstances, the panel shall decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a substantive response. As per paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the Panel is to draw such inferences therefrom as it considers appropriate.

The Complainant is required to make out its case in all respects under paragraph 4(a) of the Policy, which sets out the three elements that must be present for the proceeding to be brought against the Respondent, which the Complainant must prove to obtain a requested remedy. It provides as follows:

“Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that:

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.”

The Panel will address all the three aspects of the Policy listed above hereunder:

A. Identical or Confusingly Similar

The Complainant has furnished evidence of its rights in the Trademark NALLI through details of their registrations and common law rights accrued to it due to long and substantial use of the Trademark NALLI. The Panel has considered and examined all the documents submitted by the Complainant in support of its claim that the Complainant has been using and has registrations in its favour for the Trademark NALLI. There is no doubt that the Complainant has the rights in the Trademark NALLI.

The disputed domain name incorporates the entire Trademark NALLI of the Complainant. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7 provides the consensus view of panelists: “While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark for purposes of UDRP standing.”

The mere addition of the suffix “motors” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s Trademark NALLI. The absence of a connection between the different classes of goods for which the Complainant and the Respondent are using the trademark does not rule out the possibility of deception or confusion amongst the consumers of the Complainant’s products. The Panel also considers it useful to refer to [WIPO Overview 3.0](#), section 1.8: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”

[WIPO Overview 3.0](#), section 1.11.1 states that the applicable Top-Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such may be disregarded under the first element confusing similarity test.

Therefore, the Panel finds that the Complainant has successfully established the first element of paragraph 4(a) of the Policy that there is a confusing similarity between the disputed domain name and the Complainant’s Trademark NALLI.

B. Rights or Legitimate Interests

The Complaint is based on the Trademark NALLI registered in favor of the Complainant and used in connection with the goods offered by the Complainant. The term “Nalli” has come to be uniquely associated with the famous Nalli Silk manufactured and sold by the Complainant owing to its trademark rights in the term NALLI as well as due to the long and consistent usage of the said term by the Complainant on all its products since 1928.

The Panel finds that in consideration of the status and fame of the Complainant's Trademark NALLI, the Respondent cannot claim any rights or legitimate interests in the disputed domain name which incorporates the Complainant's Trademark NALLI entirely.

Paragraph 4(c) of the Policy lists circumstances, but without limitation, which, if found by the Panel to be proved, may demonstrate the Respondent's rights or legitimate interests in a disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy.

The Panel considers it is relevant to consider [WIPO Overview 3.0](#), section 2.5, which provides that, "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry". The Respondent is in no way related to the Complainant; neither is the Respondent an agent of the Complainant, nor does it in any way or manner carry out activities for or on behalf of the Complainant. The Trademark NALLI indisputably vests in the Complainant as evidenced by the statutory registrations secured by the Complainant and its continuous usage of the Trademark NALLI since 1928.

Paragraph 4(c) of the Policy lists circumstances, but without limitation, which, if found by the Panel to be proved, may demonstrate the Respondent's rights or legitimate interests in a disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy. [WIPO Overview 3.0](#), section 2.1 states that: "While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Respondent has failed to file a Response to rebut the Complainant's *prima facie* case or to explain his rights or legitimate interests. There is no evidence before the Panel that the Respondent has any trademark rights associated with the disputed domain name or has actually been commonly known by the disputed domain name, apart from registration of the disputed domain name. Therefore, the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name as per paragraph 4(c) of the Policy or otherwise. Considering the evidence submitted by the Complainant, the Panel finds that the Complainant has satisfied its burden to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel is satisfied that the second element of the Policy has been met.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be the evidence of the registration and use of the disputed domain name in bad faith. The Complainant is required to prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith. Hence, circumstances at the time of registration and thereafter have to be considered by the Panel.

At present the disputed domain name is passively held by the Respondent. The non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3 states that "From the inception of UDRP, panelist have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding".

[WIPO Overview 3.0](#), section 3.2.2 states "Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including

in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark". The Complainant's Trademark NALLI has acquired significant uniqueness and repute due to its long and continuous usage by the Complainant, particularly in India where the Respondent is reportedly located. There is virtually no possibility, noting *inter alia* the well-known nature of the Complainant's Trademark NALLI and the well-established reputation and goodwill associated with it that the Respondent was unaware of the existence of the Trademark NALLI.

The Complainant has produced evidence of registration of the Trademark NALLI since at least 1987 and contends that it has been using the Trademark extensively since 1928. The Respondent registered the disputed domain name on July 5, 2022, incorporating in its entirety the Trademark NALLI of the Complainant. The Complainant has not granted the Respondent permission or a license of any kind to use its Trademark NALLI and register the disputed domain name. Such unauthorized registration by the Respondent suggests opportunistic bad faith in these circumstances.

In view of the above, the Panel concludes that the third and last condition provided for by paragraph 4(a)(iii) of the Policy is met. The Panel therefore, finds that the disputed domain name has been registered and is being used by the Respondent in bad faith.

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 <nallimotors.com> be transferred to the Complainant.

/Ashwinie Kumar Bansal/

Ashwinie Kumar Bansal

Sole Panelist

Date: April 11, 2023