

ADMINISTRATIVE PANEL DECISION

Mahindra and Mahindra Limited v. avneet setia, X
Case No. D2024-4951

1. The Parties

The Complainant is Mahindra and Mahindra Limited, India, represented by Saikrishna & Associates, India.

The Respondent is Avneet Setia, X, India, represented by NSG Law, India.

2. The Domain Name and Registrar

The disputed domain name <tharroxx.com> 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 November 30, 2024. On December 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 3, 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 amended Complaint on December 6, 2024.

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 December 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 29, 2024. The Response was filed with the Center on December 29, 2024.

The Center appointed Vinod K. Agarwal as the sole panelist in this matter on January 13, 2025. 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 vehicle manufacturing corporation and part of the Mahindra Group, a multinational conglomerate incorporated in 1945. The Complainant's automotive business is a full-range mobility player, and its portfolio includes world class SUVs, premium luxury UVs, sedans, pick-ups, light, medium and heavy commercial vehicles to three-wheelers. The Complainant is also the leading tractor company by volume in the world. A United States of America multi-billion global federation of companies, the Mahindra Group has a presence in more than 100 countries and employs over 2,50,000 people in over 150 companies.

On October 4, 2010, the Complainant launched a unique model in Compact off road 4x4 Sport-Utility Vehicle ("SUV") range in India under the distinct brand name THAR. The brand name THAR was conceived and adopted by the Complainant in 2010 when no other similar mark was present in the market. The Complainant's vehicles under the THAR brand became an instant sensation and soon became a successful brand of the Complainant. Further, on August 15, 2024, the Complainant launched an SUV under the trademark THARROXX.

The Complainant also owns the website "www.mahindrathar.com". The details of the Complainant's businesses are available on its website "www.mahindrathar.com". Screenshots from the Complainant's website are annexed as Annexure 4.

The Complainant owns, among others, Indian trademark registration No. 2654045 for THAR, registered on January 3, 2014, and citing use since December 21, 2010.

The Complainant also holds trademark applications/ registrations for the mark THAR and its formatives in various international jurisdictions such as Bhutan, Algeria, New Zealand, Morocco, European Union Intellectual Property Office, Indonesia, Nepal, New Zealand, Peru, South Africa, Chile, Kenya, Mozambique, Saudi Arabia, United Arab Emirates, Guatemala, and Japan in respect of automobiles and its parts and accessories. The trademark THAR attached along with different words, such as, "THARARMADA", "THARCULT", etc., are registered under Classes 12 and 41. The Complainant has stated that on November 11, 2023, they have filed a trademark application No. 6184133 for the mark THAR ROXX in India.

According to the Respondent, the Thar Desert, located in India, is one of the largest deserts in the world and is also known as the Great India Desert spanning an area of about 200,000 kms. The Respondent has stated that he has undertaken an initiative aimed at promoting the traditional handicrafts of Rajasthan (an Indian State) specifically from the Thar Desert on a global scale. The primary objective of "Thar Roxx" is to elevate and showcase the extraordinary crafts to an international audience. According to the Respondent, the word "Roxx" signifies the geological strength of the desert and the solid and timeless nature of the handicrafts.

The disputed domain name was registered on July 20, 2024, and has been used to resolve to a website with general pay-per-click ("PPC") links.

5. Parties' Contentions

A. Complainant

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

In relation to element (i), the Complainant contends that the Complainant is the proprietor of the trademark THAR by virtue of propriety in adoption, continuous and exclusive use, wide spread advertising, and the tremendous reputation accruing thereto in the course of trade. The earliest registration for the mark THAR in India dates back to December 21, 2010. The trademark THAR has acquired substantial goodwill and is an extremely valuable commercial asset of the Complainant.

According to the Complaint, the Complainant adopted the trademark THAR in 2010 and the trademark THAR ROXX in 2023 and accordingly is the rightful proprietor of the trademark THAR and its variants, including THAR ROXX, by virtue of its trademark registrations, continuous and extensive use, and the tremendous reputation accruing in the course of trade.

The disputed domain name subsumes the Complainant's registered trademark THAR and is identical with Complainant's trademark THAR ROXX. Given the glaring identity between the disputed domain name and the Complainant's trademark, an Internet user may be misled when coming across the disputed domain name.

It is further submitted that the Complainant has established its rights in the trademark THAR on account of its extensive use and trademark registrations/ applications in India and internationally. Additionally, the Respondent registered the disputed domain on July 20, 2024, which is much subsequent to the date of adoption and use of the trademark THAR by the Complainant, i.e., 2010 and the trademark THAR ROXX in 2023. Any consumer when reading the disputed domain name be confused with the Complainant's trademark THAR and THAR ROXX as it consists solely of the Complainant's trademarks. In light of the above, owing to the disputed domain name subsuming the Complainant's registered trademark THAR and the prior adopted trademark THAR ROXX, the relevant members of public visiting the disputed domain name will associate the disputed domain name with the Complainant alone.

The Complainant has further submitted that the disputed domain name consists of links leading to third party websites selling the Complainant's and its competitor's goods in the same industry i.e., automobiles, causing a very high chance of association of the disputed domain name with the Complainant's trademark THAR and THAR ROXX.

In relation to element (ii), the Complainant contends that the Respondent has no proprietary or contractual rights in the Complainant's trademarks THAR and THAR ROXX in whole or in part. The Respondent could have no possible justification for registering the disputed domain name which comprises solely of the Complainant's trademarks THAR and THAR ROXX. The Respondent is, therefore, using a domain name that is identical to the Complainant's well-known trademark THAR and prior adopted trademark THAR ROXX, without the Complainant's consent or authorization and with no rights or legitimate interests with respect to the disputed domain name.

Furthermore, the Respondent is not commonly known by the disputed domain name nor does the Respondent engage in any business or commerce under the trademark and/or the trade name THAR and THAR ROXX. The Complainant has no relationship with the Respondent. Also, the Respondent's lack of rights and legitimate interest is further substantiated by the fact that the Respondent has not made any legitimate use of the disputed domain name in connection with a bona fide offering of goods and/or services since its registration in July 2024. To the contrary, the Respondent almost certainly registered the disputed domain name to divert Internet users to the Respondent's pay-per-click parking page. It appears that under the attendant circumstances, the Respondent's use of the disputed domain name for a pay-per-click parking

page does not constitute use of the disputed domain name in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(iii) of the Policy.

Further the Respondent is not even making legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain as it is evidently misleading and diverting consumers.

The Complainant is the prior adopter of the trademark THAR ROXX and registered proprietor of the trademark THAR, in several jurisdictions as mentioned above. As such, the trademark THAR and its formatives comprising of the trademark THAR has become highly distinctive of the Complainant's goods and is well-known.

Accordingly, the third-party PPC links leading directly to websites of third parties also engaged in the same industry, i.e., automobiles, violate the Complainant's rights in its registered trademarks THAR and THAR ROXX. This further substantiates the Respondent has no rights or legitimate interest in the disputed domain name.

At this stage, it may be stated that the Respondent has not submitted any evidence in support of his contentions in respect of element (ii).

In relation to element (iii), the Complainant contends that the Respondent has registered the disputed domain name solely with an ulterior motive to make monetary profits by providing a space for advertisement of third-party websites listing the Complainant's products to disrupt the legitimate business of the Complainant set up through its authorized channels of distribution and sale.

Further, the disputed domain name is not only registered in bad faith but is also being used by the Respondent in bad faith, as it has never been used in relation to any active website but simply lists pay-per-click advertisement links. Moreover, the disputed domain name also indicates that the domain name is available for purchase. As such, the Respondent has no intention to use the disputed domain name and is unlawfully monetizing the Complainant's goodwill and reputation by providing pay-per-links on the disputed domain name.

As the Respondent was evidently aware of Complainant's presence, popularity and stature, there can be no legitimate ground or reason for which the Respondent would register a domain name with the trademark of another company (i.e., the Complainant) to attract internet users to its website.

Thus, the Respondent has registered the domain name primarily for the purpose of disrupting the business of the Complainant and has registered it using the disputed domain name in bad faith.

Further that, the Respondent has not submitted any evidence in support of his contentions in respect of element (iii).

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. The contention of the Respondent is that "Thar Roxx" is not a registered trademark of the Complainant and the Complainant has failed to disclose this fact in their Complaint. Further that, the application of the Complainant for the registration of the said trademark has been objected to by the relevant authorities. This fact has also not been disclosed by the Complainant in the Complaint. However, the Respondent has not submitted any evidence in support thereof.

As reported above, the Respondent claims to have derived the disputed domain name from the Thar Desert, located in India. The Respondent claims an intention to use the disputed domain name to promote the traditional handicrafts of Rajasthan from the Thar Desert. According to the Respondent, the word "Roxx" signifies the geological strength of the desert and the solid and timeless nature of the handicrafts. However, the Respondent has not submitted any evidence in support thereof.

However, In relation to element (ii) and element (iii) the Respondent has made absolutely no submission.

6. Discussion and Findings

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. Jurisdiction of the Center

The Respondent has stated that, “the petitioner, despite being an Indian company, and the respondent, a permanent resident of India, has failed to provide adequate justification for selecting a foreign forum for resolving the present dispute. Furthermore, the registrar, an Indian company, is also part of the matter, making the selection of a foreign forum all the more questionable[...]. Therefore, under the principles of forum conveniences and considering the fact that all parties involved are domiciled in India, the appropriate forum for adjudicating this dispute should be an Indian court.” Further that, the doctrine non convenience also supports the notion that disputes should be resolved in the forum most closely connected to the dispute.

However, as a domain name registrant, the Respondent has a contractual obligation to submit to these proceedings. Paragraph 4 of the Policy, which is incorporated into the Respondent’s Registration Agreement with the Registrar, specifically states that the Registrant is “required to submit to a mandatory administrative proceeding” in the event of an applicable dispute under the Policy. This is also informed to the Respondent in the Center’s notification documents, which read, “The Policy is incorporated by reference into your Registration Agreement with the Registrar of your domain name, pursuant to which you are required to submit to and participate in a mandatory administrative proceeding in the event that a third party (the “Complainant”) submits a Complaint to an ICANN-approved dispute resolution service provider”, which the Center is. Further, the Panel notes that the Registrar has confirmed that the UDRP applies to this disputed domain name. As such, and as an ICANN accredited provider, the Center has jurisdiction to administer this case.

B. Identical or Confusingly Similar

According to the Complaint, in India, the Complainant has used the registered the trademark THAR since December 21, 2010. The trademark THAR has acquired substantial goodwill in the business community worldwide. In spite of the fact that THAR is a famous and wide desert in India, the competent authorities have granted registration of the trademark THAR to the Complainant and such registration is sufficient for purposes of standing under the Policy. The Panel finds the Complainant has established registered trademark or service mark rights for the purposes of the Policy.

The disputed domain names consists of the THAR trademark along with the term “roxx”. The aforesaid facts and evidence establish that the disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights. [WIPO Overview 3.0](#), section 1.7. The first element of the Policy has been established.

C. 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 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 domain name or a name corresponding to the 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 domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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 trade name THAR ROXX. Further the Respondent has not filed any application for the registration of the trademark THAR ROXX in India. The Complainant has not authorized the Respondent to use the name and their trademark THAR. While the Respondent claims an interest in the disputed domain name that is aligned with its apparent association with the Thar Desert, no evidence has been presented to corroborate this intention. Further to section 4.2 of the [WIPO Overview 3.0](#), "conclusory statements unsupported by evidence will normally be insufficient to prove a party's case".

Further, in contrast to the Respondent's statements, the disputed domain name is used by the Respondent for offering the same services as are offered by the Complainant. It does not amount to the bona fide offering of goods or services. Based on the evidence in the Complaint, the Panel finds that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

D. 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 or 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 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 web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on its web site or location.

The Complainant contends that the disputed domain name was registered or acquired by the Respondent primarily for the purpose of carrying on business competitive to the Complainant. The disputed domain name is being used for a parking page with PPC links with the intent to deceive Internet users deliberately and intentionally, with a view to trade upon or cash on the name, fame, reputation, image and goodwill acquired by the Complainant. This and the other evidence submitted by the Complainant leads to the presumption that the disputed domain name was registered and used by the Respondent in bad faith.

Moreover, the disputed domain name was registered after the Complainant trademark application for THAR ROXX was filed in India, where the Respondent has confirmed to be residing, suggesting that the Respondent sought to target and capitalizing on the Complainant's nascent (as of yet unregistered) trademark rights when registering the identical disputed domain name.

The Panel concludes that the registration of the disputed domain name amounts to the registration and use of the domain name in “bad faith”. Paragraph 4(a)(iii) of the Policy is satisfied.

In support of its contentions, the Complainant has relied on a number of cases filed before the Center and other institutions and which have been decided in their favour. The said cases have been duly taken into consideration.

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 <tharroxx.com> be transferred to the Complainant.

/Vinod K. Agarwal/

Vinod K. Agarwal

Sole Panelist

Date: January 27, 2025