

ADMINISTRATIVE PANEL DECISION

TATA Sons Private Limited and TATA Digital Private Limited v. Hardik Dabhi Case No. DAI2024-0011

1. The Parties

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

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

2. The Domain Name and Registrar

The disputed domain name <tatadigital.ai> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 30, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 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 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 amended Complaint on February 9, 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 February 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 3, 2024. The Response was filed with the Center on February 13, 2024.

The Center appointed Harini Narayanswamy as the sole panelist in this matter on March 7, 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 device mark bearing trademark number 6089, dated October 2, 1942 and TATA device mark bearing trademark number 109360, dated April 12, 1945. The First Complainant owns Indian trademark registrations for the TATA DIGITAL word mark 4347419 under 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. At the time of filing the Complaint, the disputed domain name redirected to a webpage displaying Pay-Per-Click ("PPC") links and also displaying a post that invited interested parties to make offers for buying the disputed domain name. At the time of filing the decision, the Respondent has taken down the disputed domain name and it is inactive.

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 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 by it to use its mark. (iii) The disputed domain name was registered and used in bad faith, as Internet users are being misled and diverted to the Respondent's site based on the Complainant's 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 ("TLD") and found the disputed domain name and also the domain name <tatadigital.io> and he registered both.

The Respondent states that he has used one of the domain names 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 disputed domain name 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 that need to be established by the Complainant under paragraph 4 (a) of the Policy to obtain transfer of the disputed domain name 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 the 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 for TATA DIGITAL” and disputed domain name is found to be identical to the TATA DIGITAL mark.

The TLD, “.ai”, (the ccTLD for Anguilla), is a technical requirement for the disputed domain name. The TLD suffix can be disregarded under the first element of the confusing similarity test, unless the suffix 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 TATA DIGITAL mark 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 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. [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](#).

Having reviewed the available record in the present case the Panel finds that in any event the alleged fan site has not been put up by the Respondent. It remains merely a proposal and the disputed domain name is being passively held by the Respondent. The Panel finds that – putting aside the identical nature to the TATA DIGITAL mark, and looking at the TATA mark – under the circumstances where the Respondent has merely stated that he intends to set up a fan site and has provided no material to support his contentions of genuine noncommercial fair use is not a basis to find legitimate interests. On the contrary, the non-use of a disputed domain name that consists of a well-known mark, weights against the Respondent.

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 and 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 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 argued that the registration and use of the disputed domain name shows intent to benefit from the reputation associated with its well-known mark. In the present case, the Respondent has redirected the disputed domain name to a page displaying PPC links. Panels 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. This is particularly the case where the trademark in question is well-known and the facts and circumstances show that the respondent has shown no legitimate use for the disputed domain name.

Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this case. Although panelists will look at the totality of the circumstances in each case, factors that are considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

The Complainant has submitted sufficient evidence demonstrating the distinctiveness and reputation associated with its well-known TATA and TATA DIGITAL marks. On the other hand, the Respondent has not submitted any evidence to show contemplated legitimate use of the disputed domain name or any material or evidence that refutes the Complainant's submissions. Furthermore, the use of privacy service to conceal identity of the Respondent under the discussed circumstances, and the incorrect or incomplete contact address provided by the Respondent, together with the current passive holding of the disputed domain name by the Respondent, the entire facts and circumstances does not prevent a finding of bad faith under the Policy. In addition, the evidence of the disputed domain name being offered to interested buyers, PPC links on the landing page and the entire set of circumstances squarely comes under bad faith registration and use as envisaged under paragraph 4(a)(iii) 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.ai> be transferred to the Complainant.

/Harini Narayanswamy/

Harini Narayanswamy

Sole Panelist

Date: March 21, 2024