



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

**Tata Sons Ltd. v. Ramadasoft**

**Case No. D2000-1713**

### **1. The Parties**

The Complainant in this proceeding is Tata Sons Ltd., a company duly incorporated under Indian Laws, having its registered office at Bombay House, 24, Homi Mody Street, Mumbai-400 001 India and its principal place of business is at Mumbai, India.

The Respondent in this proceeding is Ramadasoft. The address of Respondent as contained in the domain names registration is Gardenviewlane Stno4, Rajivnagar, Hyderabad, Andhra Pradesh-500076 India. The Administrative and billing contact provided for the domain names registration is Manu Kosuri, 34, Street # 4, Garden View Lane, Nacharam, Hyderabad, A.P.-501507 India. The Technical Contact is Hostmaster, TABNet 5, Financial Plaza, Napa, CA 94558.

### **2. The Domain Names and Registrar**

The domain names at issue are:

- (i) "tatapowerco.com"
- (ii) "tatahydro.com"
- (iii) "tatawestside.com"
- (iv) "tatahoneywell.com"
- (v) "tatayodogawa.com"

(vi) "tatateleservices.com"

(vii) "tatassl.com"

(viii) "tatatimken.com"

(ix) "jrdtata.com"

(x) "ratantata.com"

These domain names are registered with Network Solutions Inc. P. O. Box 525, Herndon, Virginia 20170, United States of America.

### **3. Procedural History**

The WIPO Arbitration and Mediation Center (the "Center") received the Complaint of the Complainant, Tata Sons Ltd., on December 8, 2000, by e-mail and on December 11, 2000, in hardcopy.

On December 11, 2000, the Center sent an acknowledgement of the receipt of the Complaint to the Complainant. On December 12, 2000, the Center sent to the Registrar, Network Solutions Inc., a request for verification of registration data. On December 14, 2000, the Registrar confirmed, inter alia that it is the Registrar of the domain names in dispute and that all the disputed domain names are registered in the name of the Respondent.

Having verified that the complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("the Supplemental Rules"), the Center on December 16, 2000, sent to the Respondent in accordance with paragraph 2(a) of the Rules a notification of the administrative proceedings together with a copy of the Complaint. The Administrative panel finds that the WIPO Center has satisfied its notification obligation under paragraph 2(a) of the Rules. Respondent was given an opportunity to submit its Response. The last date for sending a response by the Respondent was January 4, 2001.

The Center did not receive any response from the Respondent. Consequently, the Center, on January 8, 2001, notified the Respondent of its default and informed the Respondent that the Center would appoint an Administrative Panel and inform the Panel of the Respondent's default in responding to the Complaint.

On January 17, 2001, the Center appointed the Administrative Panel consisting of a single member. The date for the decision was fixed as January 31, 2001.

Till this date, no response has been received from the Respondent. The Panel therefore rules that the Respondent has forfeited its right to file a response.

The Respondent is proceeded ex-parte. Rule 5 (e) governs this situation which reads as under:

"5(e) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based on the Complaint".

The Panel finds that in the present case there are no exceptional circumstances that exist and therefore the present dispute is being decided on the basis of the Complaint and documents on record of the Panel.

#### **4. Factual Background**

The Complainant is an Indian company incorporated under Indian Laws, which had adopted the name TATA.

The Complainant is the registered proprietor of the trademark **TATA** in relation to various goods in various classes. Some of the trademark registration certificates are annexed as **Annexure E**. These certificates were issued by the Registrar of Trade Marks in class 2 on October 2, 1942, in class 3 on July 23, 1947, in class 4 on August 18, 1946, in class 6 on June 18, 1946, in class 12 on April 4, 1950, and in class 31 on April 13, 1945.

The domain name "tatapowerco.com" incorporates the name of a TATA company involved in the power sector, i.e., Tata Power Co. Ltd.

The domain name "tatahydro.com" incorporates the name of a TATA company involved in the power sector, i.e., Tata Hydro Electric Power Supply Co. Ltd.

The domain name "tatawestside.com" incorporates the name of a chain of departmental stores operating in various metro cities of India, called WESTSIDE, owned by Trent Ltd., which is a TATA Enterprise. The trademark 'WESTSIDE' has been applied for trademark registration in India in classes 4, 8, 11, 14, 16, 18, 20, 21, 24, 25 and 28.

The domain name "tatahoneywell.com" incorporates the name of Tata Honeywell Ltd., which is a joint venture between TATAS and the Honeywell Group involved in the telecommunications sector.

The domain name "tatayodogawa.com" incorporates the name of Tata Yodogawa Limited, which is a TATA Company involved in the metal industry. This company is a joint venture by Tata Steel Ltd. in collaboration with Yodogawa Steel Works Ltd. and Nishho Iwai Corporation, Japan.

The domain name "tatateleservices.com" incorporates the name of Tata Teleservices Ltd., which is a TATA Company involved in the telecommunications sector.

The domain name "tatassl.com" incorporates the name of Tata SSL Ltd., which is a TATA Company involved in the Metal industry.

The domain name "tatatimken.com" incorporates the name of Tata Timken Limited, which is an erstwhile TATA company. Tata Timken Limited was until recently, a company jointly promoted by Tata Steel, (a TATA company) and The Timken Company of USA to manufacture bearings in India under the joint brand name of TATA TIMKEN. Upon the acquisition of an additional equity holding in Tata Timken Limited by the Timken Company of USA, the company became a subsidiary of The Timken Company of USA and was re-named Timken India Limited.

Incorporation certificates of the above mentioned companies are annexed as **Annexure M** with the complaint.

Apart from registering domain names incorporating the names of various Tata companies, the Respondent has also registered the domain names "jrdata.com" and "ratantata.com" which, apart from containing the trademark TATA of the Complainant also incorporates the personal names of the Complainant's former chairman Mr. J.R.D. Tata and present chairman Mr. Ratan Tata, both of whom are internationally renowned Indian industrialists.

Respondent is the current registrant of all the domain names in issue. E-mail dated December 14, 2000, from Network Solutions, Inc. confirmed to Center that Respondent is the Registrant of the domain names in issue. The dates of registration of the impugned domain names are as follows:

"tatapowerco.com" November 22, 1998

"tatahydro.com" November 22, 1998

"tatawestside.com" December 13, 1998

"tatahoneywell.com" November 22, 1998

"tatayodogawa.com" November 22, 1998

"tatateleservices.com" December 13, 1998

"tatassl.com" November 22, 1998

"tatatimken.com" November 22, 1998

"jrdata.com" November 22, 1998

"ratantata.com" November 22, 1998

## **5. Parties' Contentions**

Complainant

The Complainant's contentions in brief are as under.

That the Complainant is the exclusive owner of the trademark /name TATA.

- That the Respondent in the present dispute has registered the domain names "tatapowerco.com", "tatahydro.com", "tatawestside.com", "tatahoneywell.com", "tatayodogawa.com", "tatateleservices.com", "tatassl.com" and "tatatimken.com", which are the corporate names of companies promoted by Tatas, thereby misappropriating illegally and without authority the trade mark **TATA** which is the exclusive property of the Complainant. The Respondent has also registered the domain names "jrdata.com" and "ratantata.com", which are the personal names of the former chairman of the Complainant Company, Mr. J.R.D.Tata, and the present chairman Mr. Ratan Tata, both of whom are world-renowned industrialists.

- That the Complainant has not authorized the Respondent to use its trademark. Further, neither is the Respondent known commonly by the name TATA nor has he made any demonstrable preparations to use the impugned domain names in connection with a bona fide offering of goods/ services.

- That the Complainant's trademark and name TATA is highly reputed and distinctive and if anyone proceeds to operate a websites under the impugned domain names, the same would result in confusion and users are likely to assume some nexus, affiliation or endorsement by the Complainant with such websites.

- That the Internet users are likely to subscribe to the services of the impugned websites or to deal with the Respondent under the belief that these are the authorized websites of the Complainant.

- That the Respondent's use of the impugned domain names, all of which contain the famous name / trade mark TATA is aimed at cashing in on the image and status acquired by the Complainant and its Trademark TATA, which would consequently and irreparably damage the reputation and goodwill of the Complainant in the trademark TATA.

- That the unlawful adoption of the impugned domain names by the Respondent would result in the dilution of the Complainant's trademark TATA. The illegal adoption of the above mentioned domain names has caused irreparable damage and injury to the Complainant's reputation and goodwill which is unascertainable due to the intangible nature of goodwill.

- That the impugned domain names have been registered and are being used in bad faith becomes all the more evident in the light of the fact that it is not one domain name but several of them (incorporating the corporate names of the Complainant's group companies as well as the names of two of the most famous leaders of the Complainant's group) that the Respondent has registered.

- That none of the domain names registered by the Respondent resolve to active websites and all these registrations were made in the year 1998, and despite the efflux of almost 2 years, the websites have not been activated.

## **6. Discussions and Findings**

Paragraph 15(a) of the Rules instructs this Panelist as to the principles the Panelist is to use in rendering its decision: "A panelist shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Applied to this case, Paragraph 4 (a) of the Policy directs that the complainant must prove each of the following:

(i) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) that the domain name has been registered and used in bad faith.

### **A. Identity or confusing similarity**

In order to determine whether a trademark is deceptively or confusingly similar to another trademark, the mark must be looked at from the first impression of a person of average intelligence with imperfect recollection. The degree of similarity is therefore related to the extent to which an imperfect recollection of the mark would cause the customer to become confused between this mark and another.

The complainant has produced copies of eight incorporation certificates of the companies in Tata group as Annexure M to the complaint. Seven Companies namely- TATA Power Company Limited, TATA Hydro-Electric Power Supply Company Limited, TRENT Limited, TATA Honeywell Limited, TATA-Yodogawa Limited, TATA Teleservices Limited and TATA SSL Limited have given certificates that they belong to TATA group of Companies and TATA Sons Limited is the promoter company of the group, and they have authorized TATA Sons Limited to file the complaint.

Timken India Limited has certified that the domain name "tatatimken.com" contains the former trade name of the Company. The name of the Company has been changed from TATA Timken Limited to Timken India Limited. It has also authorized TATA Sons Limited to file the complaint as per Annexure P to the complaint.

As per complaint other two domain names i.e. jrdata. ".com" and "ratantata.com", which apart from containing the trademark TATA of the complainant also incorporates respectively the personal names of the former and present chairman of the complainants. Mr. Ratan Tata and Dr. J.J. Bhabha the executor of the estate of the late Mr. J.R.D Tata, have authorized TATA Sons Limited to file the complaint as per Annexure P to the complaint.

The six domain names ("tatapowerco.com", "tatahydro.com", "tatahoneywell.com", "tatayodogawa.com", "tatateleservices.com", and "tatassl.com") have the word Tata as the prefix and the rest of the words indicate one of the respective names or part of names of the companies under the TATA group. The domain name

"tatawestside.com" incorporates the name of a chain of departmental stores operating in Mumbai, Bangalore, Hyderabad and Chennai, called Westside store owned by Trent Limited as per particulars given in the complaint, and Annexures C & D to the complaint. The complainant has also produced copies of trademark applications for the mark Westside under various classes as Annexure L to the complaint.

The Complainant has submitted multiple certificates of registration for the mark TATA in its favor (Annexure E to the complainant). The Registrar i.e. The Network Solution, Inc. has already confirmed vide e-mail dated December 14, 2000, that the Respondent is the current registrant of the all domain names at issue.

These domain names are confusingly similar to the complainant's mark TATA, and are otherwise identical to complainant's mark TATA except for the use of suffix in the first eight names and prefix in the last two names. The use of suffix or prefix does not change the likelihood for confusion in the facts of this complaint.

The Administrative Panel finds that all the domain names are confusingly similar to the trademark TATA.

## **B. Rights or legitimate interests**

The word Tata was adopted very early by the complainant. The complainant is the registered proprietor of the trademark TATA in relation to various goods in various classes and such trademarks are licensed through registered user agreements to other Tata companies which manufacture the goods and sell them under the said trademark. The word Tata has got reputation and popularity in India and in some other countries. The complainant has produced the trademark registration certificates in India under various classes of goods such as class 2, class 3, class 4, etc. as **Annexure E**. The Complainant has also registered its trademarks in various other countries, besides India in various classes.

The Complainant has not given or agreed to give to the Respondent any authority, permission, license, consent or right to use the trademark 'TATA'. The Respondent has not contested this assertion. In the absence of any license from the Complainant to use the mark TATA or use any domain names incorporating the said trademark, no actual or bona fide use of the domain names could be made by the Respondent.

The Respondent has failed to present any defense or evidence that would tend to establish that Respondent has no legitimate interest in respect of the domain names in issue. From particulars in the complaint, it seems that the respondent is not commonly known by the name TATA.

The Administrative Panel finds that the Respondent has the intention to use the impugned domain names for taking benefit from complainant's image and status. Thus, unauthorized adoption of the domain name has resulted in the respondent deriving or attempting to derive monetary benefit by trading on the reputation and goodwill of the complainant.

Accepting the assertions made in the Complaint to be correct, the Administrative Panel finds that the Respondent has no rights or legitimate interests in all the Domain names in issue.

### **C. Bad faith**

The requirement in Paragraph 4 (a) (iii) of the Policy is that the domain name "has been registered and is being used in bad faith" would be satisfied if the complainant proves that the registration was undertaken in bad faith and the circumstances of the case are such that the Respondent is continuing to act in bad faith.

Paragraph 4(b) of the Policy provides that for the purposes of Paragraph 4(a)(iii), the following 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:

(i) circumstances indicating that the Respondent has registered or he has acquired the domain name primarily for the 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 the Complainant, for valuable consideration in excess of his 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 domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his website 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 his website or location or of a product or service on his website or location.

Network Solution Inc. WHOIS search made on November 29, 2000, enclosed as Annexure A with the complaint shows that the records in respect of the Domain names were created on November 22, 1998, or December 1998. None of the Domain names registered by the Respondent resolve to active website as per the Complainant. If someone has registered many domain names and after expiry of sufficient time i.e. even after two years, without giving any reason he is not using them, implies that he has registered the domain names in bad faith.

Complainant's name and trademark TATA is well known in India as revealed from Annexures D, G and H to the complaint and is very old trade mark registered as early as in 1942, as per Annexure E. The Respondent who is domiciled in India must have been aware of the Complainant's ownership and goodwill of the trademark at all times relevant to the disputes including during the times he registered the Domain names. The Respondent is not even known by name TATA whereas it is a part of name of the Complainant. All the Domain names have the common prefix or suffix TATA, which is a registered trademark of the Complainant. Registration of ten Domain names

incorporating a combination of the Complainant's trademark by the Respondent indicates a pattern of cyber squatting conduct and an attempt by him to foreclose the Complainant from using own Trademarks in cyber space. It follows that the Respondent has registered the Domain names in order to prevent the Complainant from reflecting the mark in corresponding Domain names and he is engaged in a pattern of cyber squatting. Such a conduct is covered by Paragraph 4(b) (ii) of the Policy.

The Respondent has failed to respond to the allegations made in the Complaint, and the panel is permitted to draw such inference therefrom as it consider appropriate, under paragraph 14(b) of the Rules. The Respondent's failure to present any evidence must be considered on the issue of bad faith. Failure of a party to submit evidence on facts in its control permits me to draw an adverse inference regarding those facts. Here, the potential evidence of good faith registration and use was in Respondent's control. Respondent's failure to present any such evidence or to deny Complainant's allegations leads to the inference that the evidence would not have been favorable to Respondent or the Respondent accepts the allegations of the Complainant.

The particular circumstances of this case which have led the Panel to the conclusion by the Panel are:

(i) the Complainant has substantially used the name and mark TATA since long and is the owner of the trademark TATA, covering various goods and services as given in the Complaint;

(ii) the Respondent has provided no defense or evidence whatsoever of any actual or contemplated good faith use by it of the domain names;

(iii) the Respondent is not commonly known by the domain names registered by it. The domain names at issue are not related with the Respondent;

(iv) the Respondent has not been licensed to use the trademark 'TATA' by the Complainant.

(v) the Respondent is inactive and there is no positive action being undertaken by the Respondent in relation to the domain names even after the expiry of two years from the date of the registration.

(vi) the Respondent has registered ten Domain names having TATA as prefix or suffix with other words or names related with Tata group companies or persons.

The Respondent's registration and holding of the domain names at issue amounts to an instance of bad faith and the Panel finds that the Respondent has registered and used the domain names in bad faith.

## **7. Decision**

This Panel concludes that the Respondent owns the domain names:

- (i) "tatapowerco.com"
- (ii) "tatahydro.com"
- (iii) "tatawestside.com"
- (iv) "tatahoneywell.com"
- (v) "tatayodogawa.com"
- (vi) "tatateleservices.com"
- (vii) "tatassl.com"
- (viii) "tatatimken.com"
- (ix) "jrdata.com"
- (x) "ratantata.com"

These domain names are confusingly similar to the Complainant's trademark TATA, and the Respondent has no rights or legitimate interests in respect of the domain names, and he has registered and used the domain names in bad faith. These facts entitle the Complainant to an order transferring the domain names from the Respondent. The Panel allows the Complaint and directs that the Respondent's domain names listed above be transferred in favor of the Complainant.

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Ashwanie Kumar Bansal  
Sole Panelist

Dated: February 8, 2001