

DISPUTE RESOLUTION SERVICE

D00013109

Decision of Independent Expert

Tata Sons Limited

and

tatacommunication

1. The Parties:

Complainant: Tata Sons Limited
Bombay House
24, Homi Mody Street
Mumbai
400 001
India

Respondent: tatacommunication
Kazi Tower 7th loor
Koril Chowrasta
Oposit Jamuna Future Part 7th Floor
Moddo Badda
Dhaka
1217
Bangladesh

2. The Domain Name:

tatacommunication.co.uk (“the Domain Name”)

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

Here is the formal procedural history of this case:

23 July 2013 17:58 Dispute received
24 July 2013 08:59 Complaint validated
24 July 2013 09:05 Notification of Complaint sent to parties
12 August 2013 02:30 Response reminder sent
15 August 2013 08:03 No Response Received
15 August 2013 08:04 Notification of no Response sent to parties
27 August 2013 10:01 Expert decision payment received

4. Factual Background

The Complainant, incorporated in India in 1917, is the holding company of a well-known international group of companies known as “Tata” which operates in a wide range of industries. The group’s worldwide turnover in 2011-2012 was over \$100 billion.

The group’s leading international market is the UK, where it trades under its original name “Tata” as well as owning some well-known UK brands such as Jaguar and Land Rover. The group has a 50,000-strong UK workforce.

The Complainant owns a range of registered trade marks for “TATA” including Community Trade Mark No. 5719448 dated 27 February 2007 in classes 38, 41 and 42.

The Complainant also owns Community Trade Mark No. 6597272 for “TATA COMMUNICATIONS” dated 21 January 2008 in classes 37, 38 and 42. One of the companies in Complainant’s group trades under the name “Tata Communications” via a website at www.tatacommunications.com.

The Respondent registered the Domain Name on 4 September 2012. At some point thereafter, the Domain Name was redirected to the website of the Complainant’s group at www.tatacommunications.com.

As of 22 May 2013, there was a Facebook page branded with the Complainant’s logo and headed “Tata Communications UK. Let us pick up their payment. www.tatacommunication.co.uk”. The page also included a “Billing Details” section with a link to <http://billing.tatacommunication.co.uk/>.

Emails have also been sent to various third parties inviting them to make payment to “Tata Communications UK” via this link

5. Parties' Contentions

Complaint

A summary of the Complainant's contentions is as follows:

The Complainant has used its mark extensively for a long time, spanning a wide geographical area coupled with extensive promotion and publicity. The trade mark therefore enjoys an unparalleled reputation and goodwill and has acquired the status of a well-known trade mark.

The Domain Name is identical or confusingly similar to the Complainant's trade marks "Tata" and "Tata Communications".

The Domain Name is an abusive registration. The malicious intention of the Respondent is evident from its blatant misappropriation of the Complainant's trade mark "Tata". Visitors to the website are redirected to the Complainant's own website, thereby causing them to believe that the Domain Name is owned by the Complainant's group. The link to a payment page shows that the Respondent set out to extort money from unwary customers by posing as a member of the Complainant's group.

The Respondent was clearly well-aware of the Complainant and set out to take unfair advantage of or cause unfair detriment to the Complainant's rights.

Response

The Respondent did not file a Response.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the Policy in the following terms:

“Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”

The Complainant owns a registered trade mark for “Tata Communications”. This is similar to the Domain Name, which simply omits the final “s”.

I conclude therefore that the Complainant has established rights in a name or mark which is similar to the Domain Name (disregarding the domain name suffix).

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines “abusive registration” as a domain name which either:-

- “i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR***
- ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”***

It is clear from the facts outlined above that the Domain Name was registered, and has been used, for the purpose of a scam whereby users are encouraged to send payments to the Respondent in the mistaken belief that they are dealing with the Complainant or members of the Complainant's group.

In these circumstances, I have no difficulty in concluding that the Domain Name is an abusive registration in that it has been registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has rights in a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name be transferred to the Complainant.

Signed: Adam Taylor

Dated: 16 September 2013