

தமிழ்நாடு தமில்நாடு TAMILNADU

33116  
28/12/2017

Dr. Sudhir Raja Ravindran

BN 375187

V. BEDHARAJAN  
Stamp Vendor  
No:12144/B1/9c  
Chakkattuthangal, Ch-3.  
Mobile No: 9710019475

BEFORE THE SOLE ARBITRATOR, DR. SUDHIR RAJA RAVINDRAN

.IN REGISTRY

(NATIONAL INTERNET EXCHANGE OF INDIA)

.IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

ARBITRATION AWARD

DATED: DECEMBER 28, 2017

IN THE MATTER OF:

Tata Motors Limited  
24 HomiModY Street,  
Fort, Mumbai - 400 001  
State of Maharashtra  
INDIA

COMPLAINANT

VERSUS

7/2017

**Mr. Shay Rahman**

Open Create  
Cornwall Road  
South bank  
London SE1 9PU  
GB

RESPONDENT/ REGISTRANT

**DISPUTED DOMAIN NAME: "WWW.TAMO.IN"**

**1. The Parties:**

- 1.1.** The Complainant in this arbitration proceeding is represented by Ms. Malavika.T.Vikram, M/s DePenning & DePenning, 120 Velachery Main Road, Guindy, Chennai 600 032.
- 1.2.** The Respondent in this arbitration proceeding, according to the WHOIS database accessed via the .IN Registry's website, is Mr. Shay Rahman.

**2. The disputed Domain Name:**

- 2.1.** The disputed domain name **www.tamo.in**. According to the WHOIS search utility of the .IN Registry, the Registrar of the disputed domain name is Netlynx Technologies Private Limited.

**3. Calendar of Major Events:**

S. No	PARTICULARS	DATE
1.	Date on which NIXI'S letter was received for appointment as Arbitrator	7/11/2017
2.	Date on which consent was given to act as an Arbitrator	7/11/2017
3.	Date of appointment of Arbitrator	22/11/2017
4.	Date on which the Hard copy of the complaint was received by Arbitrator	24/11/2017
5.	Date on which notice was issued to the Respondent	24/11/2017
6.	Due date for filing of Counter Statement by the Respondent	01/12/2017

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7.	Date on which Email was received from NIXI regarding non delivery of Hard copy of the complaint to the Respondent	29/11/2017
8.	Date on which Arbitrator sent reply to NIXI	29/11/2017
9.	Date on which Email was received from Respondent requesting time to file Counter	29/11/2017
10.	Date on which Email was sent by Respondent filing his counter without any Legal Representation	01/12/2017
11.	Date on which Arbitrator sent reply to Respondent extending time to file his counter.	02/12/2017
12.	Extension due to file Counter by Respondent	17/12/2017

#### 4. Procedural History:

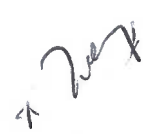
- 4.1. This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India ("NIXI"). The INDRP Rules of Procedure ("Rules") were approved by NIXI on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.
- 4.2. In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the complaint and appointed Dr. Sudhir Raja Ravindran as the sole arbitrator for adjudicating upon the dispute in accordance with the .IN Domain Name Dispute Resolution Policy and the Rules framed thereunder and the Indian Arbitration and Conciliation Act, 1996 and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the NIXI.
- 4.3. The Complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution Policy (INDRP).

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- 4.4. On November 24, 2017, the Arbitrator issued a notice to the Respondent intimating the Respondent of the appointment of the Arbitrator and calling upon the Respondent to submit his response within seven (7) days, i.e. on or before December 1, 2017.
- 4.5. On November 29, 2017, the Respondent had requested for an extension of time to submit his response to the complaint filed by the Complainant. Further, the Respondent had sent his reply to the Complaint filed against him on December 01, 2017, mentioning that the same was without a formal legal Representative.
- 4.6. On December 02, 2017, the Arbitrator had accepted the Respondent's request and extended the time for the Respondent to file his reply if required through a legal representative, on or before December 17, 2017. It was also intimated to the Respondent that in the absence of any response on or before December 17, 2017, the Arbitrator will decide the matter based on the response submitted by the Respondent vide email dated December 01, 2017.
- 4.7. No response was received from the Respondent on or before the extended due date of December 17, 2017.

## 5. Factual Background

- 5.1. The complainant is India's largest automobile company, with consolidated revenues of Rs 2,75,561 Crores (USD 41.6 billion) in 2015-16. The complainant is among the top five commercial vehicle manufacturers, in the world. The complainant is the India's market leader in commercial vehicles and among the top three in passenger vehicles. The complainant is also the world's fourth-largest truck and bus manufacturer. The complainant belongs to the well known Tata Group of Companies.
- 5.2. The Respondent registered the disputed name <www.tamo.in> on September 04, 2016.





## 6. Parties Contentions:

### 6.1. Complainant's Submission:

- 6.1.1. The Complainant claims that it has launched its new sub-brand TAMO, an incubating center of innovation working towards new technologies, business models and partnerships in order to define future mobility solutions. TAMO operates as an agile, ring-fenced vertical, in a low volume, low investment model to provide fast tracked proves of technologies and concepts. The sub-brand TAMO is our crucible for new technologies, business models and partnerships.
- 6.1.2. The Complainant claims that RACEMO a 2-seater concept is the first innovation from TAMO and an emotional, unexpected leap to the future symbolizing the change that is taking place at Tata Motors 'The TAMO family of vehicles will drive the future of India's connected generation' From styling and design to driver experience and technology, TAMO vehicles will be an extension of customers' personality, as part of their digital ecosystem and will break the ice with a radical new presence and pique the interest in the parent brand. The name TAMO is an abbreviation to the complainant's name as found in business papers and financial markets.
- 6.1.3. The Complainant claims that it has registered its trademark TAMO and its variants which is distinctive and has an established reputation both in India and Internationally.
- 6.1.4. The complainant claims that in India, the Complainant has registered with the Indian Trademark Registry for its trademark "TAMO-FLEX", "TAMO!GO", "TAMO!AIR", "TAMO!PLAY", "TAMO!STORE" in Class 12 under trademark Application numbers 3388435, 3388436, 3388437, 3388438 and 3388440 respectively.

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- 6.1.5.** The complainant claims that it has advertised the mark TAMO in mass media such as print, electronic media and also through participation in the Motor shows etc, The TAMO has had extensive reviews on various on-line platforms such as Quikr since 2016.
- 6.1.6.** The complainant claims that the TAMO showcased the best technology at the Geneva Motor Show 2017. The Complainant launched, at the motor show, the first car under the TAMO brand, a sports car featuring 1.2 liter engine that makes 136 bhp and 210 NM or torques and also features butterfly doors that open upwards and a completely digital console that also features two side mounted and adjustable touch screens. The TAMO Racemo cars have received rave acclaim from Indian and Global media. It is stated that the use of the keyword TAMO in any leading search engine throws up the web pages of the complainant among the leading hits.
- 6.1.7.** The Complainant claims that, the Respondent has no rights or legitimate interests in respect to the domain name **www.tamo.in**. The Complainant further claims that the Respondent illegally and wrongfully adopted the trade mark TAMO of the complainant with the intention to create an impression of an association with the Complainant.
- 6.1.8.** The Complainant claims that, the Respondent has wrongfully and fraudulently adopted and registered the impugned domain name **www.tamo.in** in order to utilize the name and reputation without having any rights thereto and in spite of having full knowledge of the complainant's iconic stature in India and Internationally.
- 6.1.9.** The Complainant claims that the respondent is trying to en-cash on the goodwill and reputation associated with the trade mark TAMO, although the respondent has no connection with the complainant and the other Tata Group of Companies.
- 6.1.10.** The Complainant further claims that the complainant and/or any entity belonging to the Tata Group of Companies has not licensed or otherwise permitted the respondent to use

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its TAMO, nor has it permitted the Respondent to apply for or use any 'Domain Name' incorporating the mark TAMO .

**6.1.11.** The Complainant claims that, they have an enormous presence on internet and possess the ownership of www.tamo.co.in and various other domain names.

**6.1.12.** The Complainant claims that 'inaction' in the use of Domain name is within the concept of 'bad faith' is supported by the actual provisions of the uniform Policy. The complainant also claims that the Paragraph 4(b) of the uniform Policy identifies, without limitation, circumstances that shall be evidence of registration and use of a domain name in bad faith, for the purpose of paragraph 4(a) (iii)' Only one of these circumstances [4(b) (iv)], by necessity; involves a positive action post-registration undertaken in relation to the domain name (using the name to attract customers to a web site or some other online location)' The other three circumstances contemplate either a positive action or inaction in relation to the domain name. Further the Complainant Claims that the circumstances identified in paragraphs 4(b) (i) (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration.

**6.1.13.** The Complainant claims that the respondent's domain name was registered and is being used in bad faith. The Complainant further claims that, the Respondent exemplifies a habitual "Cyber Squatter" engaged in a pattern and practice of registering and using bad faith domain names. Moreover, the Respondent has offering the domain name for sale.

**6.1.14.** The Complainant claims that the disputed domain name clearly incorporates the Complainant's trade mark TAMO in its entirety and such use of the disputed domain name is considered evidence of bad faith registration and use, under the 'UDRP'.

**6.1.15.** The complainant claims that the disputed domain name will give unwary visitors to the domain an impression that the disputed domain name has been authorized by the

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complainant. It is pertinent to mention that the complainant has no connection with the disputed domain name holder and the complainant has never permitted the respondent to create the disputed domain name.

**6.1.16.** In support of its contentions, the Complainant relied on the decisions in the cases of Hon'ble WIPO Arbitration and Mediation Centre passed in the case of Gulshan Khatri Vs Google Inc O.M.P(COMM)497/2016 *www.googlee.in*, *Tata Motors Limited Vs Vaidehi Jha case No. D 2014- 1244 tatanexon.com* and *F.Hoffmann-La Roche AG Vs P Martin D 2009-0323 <alli-xenical.com>*.

**6.1.17.** The Complainant requests for the following relief: "that the ownership in **www.tamo.in** is rightfully transferred to the complainant herein and pass any other appropriate favorable orders deemed fit".

## **6.2. Respondent's Submission:**

**6.2.1.** The Respondent claims that, the Domain name is acquired from a Dictionary word "**Tamo**" (examples can be found on this page: <http://www.dictionary.com/browse/tamo>) and it is also has a generic meaning in Buddhism. As well as, there are several companies around the world using this word in their domain name (*tamo.com / tamo.co.uk* two different companies). This is not a made-up word (as its being done when combining Tata and Motors). The Respondent further claims that the word "**Tamo**" is not commonly associated with the complainant's brand.

**6.2.2.** The Respondent claims that, the Domain name was created before the Trademark application date of the Complainant. Therefore this domain name was not registered in any form of "bad faith".

**6.2.3.** The Respondent claims that "undeveloped.com" is a passive sales page where anyone can hold a domain name when it is not yet developed. It allows the respondent to gauge the

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market, see visitor analytics and receive communications. Further, the Respondent claims that, it is unreasonable to accuse the Respondent for bad faith just because the Respondent is the owner and has no regulations / rules saying that he cannot sell a domain name for sale page that has no reference to anything related to the complainants brand.

**6.2.4.** The Respondent claims, in general that all Annexure are inappropriate. For example, Annexure D contains only screenshots of media published in 2017 which is post-registration of the Domain name. As these events are not foreseeable, it's not reasonable to be taken these annexure into account.

**6.2.5.** The Respondent further claims that the screenshots (Annexure E of the Complaint is also inappropriate) show Google search results that are geo-location based. It shows the Tata attorney's geo-location on the bottom of that Google search page. The Respondent also states that it would have been impossible to search this information before the registration of the domain name in 2016, because it would have been significantly different to what the complainant is now showing. And again, there most likely wouldn't have been anything relating to Tata Motors using the word **Tamo**, as is evident in complainants own evidence, the TM wasn't in use until after the registered of the domain.

**6.2.6.** The respondent claims that it was an easy manoeuvre by Complainant to file an INDRP rather than enquiring the Respondent about the availability of the domain name. The Respondent further states that if Complainant had proposed the intentions about the domain name, the Respondent may have transferred it to the Complainant if they really needed it and had a genuine use. But the complainant made no such effort to contact the Respondent, which shows bad faith on their part.

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**7. Discussion and findings:**

**7.1.** Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

**7.2.** The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

**7.2.1.** The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights, and

**7.2.2.** The Respondent has no rights or legitimate interests in respect of the domain name; and

**7.2.3.** The Respondent's domain name has been registered or is being used in bad faith.

**7.3. Identical or Confusingly Similar**

**7.3.1.** The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

**7.3.2.** It is well established that trademark registration is recognized as prima facie evidence of rights in a mark. The Complainant by filing documents of its registered trademarks has established that it has rights in the trademark "TAMO-FLEX", "TAMO!GO", "TAMO!AIR", "TAMO!PLAY", "TAMO!STORE" in India and possess the ownership of [www.tamo.co.in](http://www.tamo.co.in). The documents filed by the Complainant/s also show that it has used the mark extensively. Evidence of use of the mark by the Complainant undoubtedly shows its rights in the mark.

**7.3.3.** The disputed domain name incorporates the trademark in its entirety it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. A domain name that entirely incorporates a Complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark. This position was

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upheld in *Akshaya Pvt. Ltd. v. Mr. Prabhakar Jeyapathy*, (INDRP/277), *G.A Modefine S.A v. Naveen Tiwari*, (INDRP / 082 ) and *L'Oreal v. Zeng Wei <loreal-paris.in>*, ( INDRP/342).

7.3.4. The Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

#### 7.4. Rights and Legitimate Interests

7.4.1. The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

7.4.2. Under Paragraph 7 of the Policy, a Respondent or a registrant can establish rights in the domain name, if,

- i. Before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a bonafide offering of goods or services or
- ii. The registrant (as an individual, business organization) has been commonly known by the domain name, or
- iii. The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

7.4.3. The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name and that the Respondent has registered the domain name "www.tamo.in" mala fide with the sole motive to en-cash upon the goodwill and reputation of the Complainant/s

7.4.4. The Respondent states that, if Complainant had proposed to Respondent their intentions about the domain name, the Respondent may have transferred it to the Complainant if they really needed it and had a genuine use and the fact that Respondent states that the Domain name is on "undeveloped.com" for sale, clearly prove that the Respondent has no legitimate interests in the Domain Name.

**7.4.5.** Furthermore, the Respondent whose Domain name is **www.tamo.in** has not provided any evidence to substantiate it is commonly known by the disputed domain name or the Respondent actually engages in any business or commerce under the name "Tamo", [Further justifies that the Respondent has no legitimate interest on the Domain name. A similar decision was upheld in *Morgan Stanley v. M/s Keep Guessing*, (INDRP/024).]

**7.4.6.** The Arbitrator finds that there are reasonable grounds to believe that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

**7.4.7.** The Arbitrator finds the Complainant has made a prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

#### **7.5. Bad Faith**

**7.5.1.** Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith. Proof of bad faith is a separate requirement. Information that is relevant to a consideration of the other ingredients of a claim can be relevant to bad faith inquiry, but it usually will not be sufficient to meet the Complainant's burden of proof.

**7.5.2.** The Respondent claims that, the Domain name was created on September 04, 2016 which is before the Trademark application date of the Complainant. Therefore this domain name was not registered in any form of "bad faith".

**7.5.3.** The Complainant states that 'inaction' is within the concept of 'bad faith' are supported by the actual provisions of the Uniform Domain Name Dispute Resolution Policy, Paragraph 4(b) identifies, without limitation, circumstances that shall be evidence of registration and use of a domain name in bad faith, for the purpose of paragraph 4(a) (iii)' Only one of

these circumstances [4(b) (iv)], by necessity, involves a positive action post-registration undertaken in relation to the domain name (using the name to attract customers to a web site or some other online location)' The other three circumstances contemplate either a positive action or inaction in relation to the domain name. The circumstances identified in paragraphs 4(b) (i), (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration. In the matter of *HSBC Holdings plc v Hooman Esmail Zadeh*, [INDRP Case No 032], it was held that non-use and passive holding are evidence of bad faith registration.

7.5.4. Furthermore, In, *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003] it was established that "inaction" can constitute bad faith use and the Telstra decision has since been cited for that proposition and followed by many subsequent Panels. In the matter of *Staples, Inc., Staples Contract & Commercial, Inc. v. Ryan Conrad* [WIPO Case No. D2003-0713] it was stated that, "It is true that Respondent's conduct cannot be said to come squarely within any of the examples of bad faith registration and use set out in paragraph 4(b) of the Policy. However, the examples in Paragraph 4(b) are intended to be illustrative, rather than exclusive."

7.5.5. The Complainant has provided evidence vide Annexure B of the Complaint is abundantly clear that the Respondent has purposely demanded an amount far more than its out-of-pocket costs for registration. Registering a domain name for the purpose of selling or transferring the domain name for excessive consideration is evidence of bad faith registration and use as held in *Aktiebolaget Electrolux v. Li Bing Yu* [WIPO Case No Case No. D2012-1106].

7.5.6. The case here is that the domain name was registered before the Trade Mark Application date of the Complainant, therefore, the domain name cannot be said to have been

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registered in bad faith. However, the use as discussed above has been in bad faith. Para 4 (iii) of the INDRP states that "the Registrant's domain name has been registered **OR** is being used in bad faith."

**7.5.7.** Accordingly, for the reasons discussed, the Arbitrator finds the disputed domain name has been registered and used in bad faith under the INDRP Policy.

**8. Decision:**

**8.1.** The Complainant has successfully established the three grounds required under the Policy to succeed in these proceedings.

**8.2.** For reasons discussed, the .IN Registry of the NIXI is hereby directed to transfer the domain name **www.tamo.in** to the Complainant without any cost.

**8.3.** The Award is accordingly passed on this day of 28<sup>th</sup> day of December, 2017.

Place: Chennai

Date: 28.12.2017

  
Dr. Sudhir Raja Ravindran

Sole Arbitrator