

Exhibit # 2

to the Petition to Deny the
Application filed by Tata Telecom INC

September 25, 2010



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Tata Sons Limited v. TATA Telecom Inc/Tata-telecom.com, Mr. Singh

Case No. D2009-0671

1. The Parties

The Complainant is Tata Sons Limited, Mumbai, India, represented by Anand & Anand, India.

The Respondent is TATA Telecom Inc/Tata-telecom.com, Mr. Singh, Ontario, Canada, represented by Amarjit & Associates Advocates, India.

2. The Domain Name and Registrar

The disputed domain name <tata-telecom.com> is registered with eNom.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 21, 2009. On May 22, 2009, the Center transmitted by email to eNom a request for registrar verification in connection with the disputed domain name. On May 22, 2009, eNom 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 25, 2009 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 amendment to the Complaint on May 28, 2009. The Center verified that the Complaint together with the amendment to the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced June 3, 2009. In

accordance with the Rules, paragraph 5(a), the due date for Response June 23, 2009. The Response was filed with the Center July 17, 2009.

The Respondent requested the appointment of a three-member Panel, to which the Complainant objected on the grounds that the request was not timely and was not made in the manner provided for in the Rules. Noting the unusual nature of the circumstances, the Center on July 17, 2009, appointed a single-member Panel,¹ vested with the “discretion to review *inter alia* the composition and appointment of the Panel, to order such procedural steps as it may consider necessary, to consider the admissibility of the late filed Response, and to proceed to a substantive decision on the merits should this be found to be appropriate by such Panel.”

The single-member Panel appointed by the Center issued an Administrative Panel Procedural Order on July 24, 2009, in which it determined that the most appropriate course of action would be for the Center to proceed to the appointment of a three-member Panel. The Center thereafter appointed William R. Towns, Tony Willoughby and Jonathan Agmon as panelists in this matter on August 18, 2009. The Panel finds that it was properly constituted. Each member of 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 the principal investment holding company for the Tata Group, a large multinational conglomerate based in India. The record reflects that the Complainant derives its name from Jamsetji Tata, who founded the original Tata trading company in the mid-19th Century. Today the business operations of the Tata Group include communications and information technology, engineering, materials, services, energy, consumer products and chemicals. Major companies in the group include Tata Steel, Tata Motors², Tata Consultancy Services (TCS), Tata Power, Tata Chemicals, Tata Tea³, Indian Hotels and Tata Communications, the latter being formed after the Tata Group acquired a controlling interest in the Indian telecommunications giant Videsh Sanchar Nigam Limited (VSNL) in 2002.⁴ According to the company’s website at “www.tatacommunications.com”, Tata Communications has operations in more than 80 locations in 40 countries. VSNL, now Tata Communications, acquired the Canadian-based communications company Teleglobe International Holdings Limited in 2006.

The Complainant is the owner of numerous trademark registrations for TATA in India, the United States, and the European Union, as well as many other countries around the world. These marks are used in connection with the diverse goods and services offered by the Tata Group. The mark has been in use since as early as 1917. At least one judicial decision from India has determined that the TATA mark is a well known mark under the laws of that nation.⁵ In addition, the Complainant’s TATA mark has been found to be well known or famous in several cases decided under the Policy.⁶ The

¹ The Center appointed Warwick A. Rothnie as the single-member Panel.

² Tata Motors is a manufacturer of commercial vehicles and recently acquired Jaguar and Land Rover.

³ Tata Tea owns the Tetley brand, having acquired the Tetley Group in 2000.

⁴ The company was renamed Tata Communications in February 2008.

⁵ *Tata Sons v. Suresh Jain*, CS (OS) 1992/2003.

⁶ See *Tata Sons Limited v. Advance Information Technology Association*, WIPO Case No. D2000-0049; *Tata Sons Limited v. D & V Enterprises*, WIPO Case No. D2000-479; *Tata Sons Limited v.*

Complainant's TATA mark has been recognized as a leading global brand, and the Tata Group has been recognized by Forbes as one of the top 20 global firms in terms of reputation.

The disputed domain name <tata-telecom.com> was created on May 2, 2003, according to the concerned registrar's WhoIs database. The domain name registrant currently is identified in the WhoIs records as TATA Telecom/Mr Singh. The Respondent's postal address is not provided. At the time of the filing of the Complaint in this matter, the identity of the registrant was shielded by use of a privacy protection service. The Response submitted in this matter identifies the Respondent as Mr. Manmohan Singh Thamber, who presumably is the "Mr. Singh" referred to in the WhoIs registrant information.

The disputed domain name resolves to the Tata Telecom Inc. website. According to the website, Toronto Asia Tele Access (Tata Telecom Inc.) is a provider of international long distance communication services founded in 2005 and headquartered in Canada. The record reflects that Toronto Asia Tele Access Telecom, Inc. was incorporated under Canadian law in May 2006, and the Respondent registered "Tata Telecom" for use as an assumed business name in Canada in April 2008. There is no evidence in the record of a separate corporate entity registered as Tata Telecom, Inc. The Respondent states that it has "sister companies" in India.

The Complainant by email provided notice of this dispute to the Respondent on July 24, 2008, requesting that the Respondent cease use of the business name Tata Telecom. The record does not reflect that the Complainant received any reply to this communication. The Respondent continues to use Tata Telecom with its business operations.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has continuously and consistently used TATA as a trademark with its business activities since as early as 1917, and that TATA has become a house mark and source indicator for the diverse goods and services provided by the Tata Group of companies, both in India as well as in other countries. The Complainant indicates that the Tata Group has a major presence in various fields of commercial activities, including automobiles, steel, power, chemicals, telecommunications, retailing, computer software, tea, financial services, and mutual funds, owns more than 100 companies worldwide, employs some 220,000 people, and has more than 2 million shareholders. The Complainant maintains that most of the companies within the group also use "Tata" in their trade or business names, noting by way of example Tata Tele Services Limited, Tata Communications, Tata Motors, Tata Chemicals, and Tata Consultancy Services.

Based on the foregoing, and relying on judicial decisions in India, several prior UDRP Panel decisions, and listings of leading global brands, the Complainant maintains that the TATA mark is highly distinctive and internationally recognized as a well known and famous mark. The Complainant maintains that the disputed domain name is confusingly similar to the Complainant's TATA mark because the domain name incorporates the Complainant's mark its entirety. Such confusing similarity, according

to the Complainant, is compounded by the Respondent's use of the domain name in connection with a business that is similar to that of one or more companies in the Tata Group.

The Complainant asserts that Tata Communications Limited, formerly known as Videsh Sanchar Nigam Limited (VSNL), is India's largest telecommunication company in international long distance, enterprise data and internet services. According to the Complainant, the Tata Group acquired a controlling stake in VSNL in 2002, and the company was renamed Tata Communications in February 2008. The Complainant states that VSNL acquired Teleglobe International Holdings Limited, Canada's largest communication company, in 2006.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name, contending that the Respondent has illegally and without the Complainant's authorization misappropriated the Complainant's well known and famous TATA mark for use as a domain name. The Complainant argues that the Respondent is not commonly known by the disputed domain name, but is instead commonly known as Toronto Asia Tele Access Telecom, Inc. The Complainant submits that the Respondent obviously knew of the Complainant's world famous trademark TATA when the Respondent registered the disputed domain name, and that the only reasonable inference that can be drawn therefrom is that the Respondent registered the disputed domain name in order to exploit and profit from the Complainant's trademark rights. Accordingly, the Complainant asserts that the Respondent cannot claim to be using the disputed domain name with a *bona fide* offering of goods or services, and has not otherwise made a showing of demonstrable preparations to do so.

The Complainant concludes from the foregoing that the Respondent registered and is using the disputed domain name in bad faith. According to the Complainant, it first became aware of the Respondent's use of "Tata Telecom" in July 2008, after the Respondent approached one of the Complainant's existing telecommunications customers. The Complainant alleges that many of its existing and potential customers, upon being contacted by the Respondent, were confused by the Respondent's use of "Tata Telecom" and contacted the Complainant seeking confirmation that the Respondent was affiliated with the Complainant. This, according to the Complainant, establishes *prima facie* the Respondent's awareness of the Complainant and the commercial value attached to the Complainant's mark. The Complainant maintains it is evident that the Respondent registered and is using the disputed domain name in bad faith to create initial interest confusion based on the reputation and fame of the Complainant's TATA mark.

B. Respondent

The Respondent generally denies each and all of the Complainant's contentions, and asserts that the Complainant has failed to present any evidence to support its claims under the UDRP. The Respondent disputes that the Complainant has established proprietary rights in the trademark TATA. According to the Respondent, the Complainant cannot claim trademark rights in the TATA mark because "Tata" is merely the surname of the Complainant's founder, and thus is not inherently distinctive. Further, the Respondent asserts that the Complainant cannot assert exclusive rights in TATA, claiming that there is significant third party use of the mark. This is so, according to the Respondent, because the Complainant has failed to establish that it owns or controls any of the business entities that the Complainant maintains are part of the "Tata Group" or "House of Tata". The Respondent maintains that each of these

companies has a separate juristic personality under Indian corporate law, so that any use of TATA by these companies must be considered separate use.

The Response indicates that the Respondent began providing telecommunications services in Canada under the registered business name Toronto Asia Tele Access Telecom, Inc. in 2002,⁷ and that it has been selling calling cards in Europe since 1996. The Respondent claims to have adopted TATA as a trademark/trade name because it is an abbreviation for "Toronto Asia Tele Access". The Respondent avers that it did so honestly and without reference to or knowledge of the Complainant or the Complainant's trademark rights in TATA.

In addition, the Respondent asserts that it has established senior trademark rights in TATA with respect to telecommunications services in the United States, Canada, and the European Union, based on continuous and uninterrupted use of the mark in these jurisdictions since 2002. The Respondent asserts that the Complainant cannot claim trademark rights for TATA in relation to telecommunication services if at all until 2008, when VSNL was renamed Tata Communications Limited, and that the Complainant knows or should have known of the Respondent since 2002, as the Respondent has "sister companies" in India.

Relying on the foregoing, the Respondent contends that the Complainant has failed to establish rights in any trademark to which the disputed domain name is identical or confusingly similar. The Respondent further asserts that no confusing similarity arises because the Respondent's business activities are distinct and separate from those of the Complainant, and that in any event the relevant class of consumers do not associate the word TATA with the Complainant in relation to any goods or services.

The Respondent contends that it has rights or legitimate interests in respect of the disputed domain name. The Respondent maintains that the disputed domain name was registered without knowledge of the Complainant or the Complainant's mark, and that TATA was adopted for use as a trademark because it is an abbreviation for "Toronto Asia Tele Access", the Respondent's corporate name in Canada. Accordingly, the Respondent submits that there has been no bad faith registration and use of the disputed domain name.

6. Preliminary Issues

A. Late Filed Response

The due date for the Response under the Rules was June 23, 2009. The Respondent contacted the Center on June 22, 2009, seeking an extension of time. The Respondent failed to offer any explanation for this last-minute request, even though the Rules permit the Center to extend the time for filing a response only in exceptional cases, absent a written stipulation by the Parties. The Center therefore did not extend the due date. The Respondent thereafter indicated to the Center that the extension was needed so that the Respondent could retain legal counsel. The Response eventually was filed

⁷ As noted earlier, the Respondent's website represents that Toronto Asia Tele Access Telecom, Inc. was founded in 2005, and the record does not reflect the incorporation of this company in Canada until May 2006, with the assumed business name Tata Telecom not being registered until April 2008. However, the Respondent submitted a copy of a Calling Card Distribution Agreement between "Tata Telecom Inc." and WTN Holding AG bearing an execution date of November 13, 2002. The Response describes WTN Holding AG as a "sister concern". The Response also asserts that the Respondent has "sister companies" in India, which the Respondent maintains the Complainant is aware of.

on July 17, 2009.

The Response was not submitted to the Center until more than six weeks after the Center formally notified the Respondent of the Complaint on June 3, 2009, and more than two months after the initial filing of the Complaint on May 21, 2009. The ostensible reason for this delay was the Respondent's need to obtain legal counsel. Why the Respondent was unable to obtain legal counsel in a timely manner has not been made clear to this Panel. Countless respondents in other proceedings under the Policy have done so.

In view of the foregoing, the Panel is acting with some reluctance in accepting the late filed Response, which also appears to violate the word limit requirements of paragraph 10 of the Supplemental Rules. However, the Panel's paramount concern is that the decision it reaches on the merits in this case be based on as complete a record as possible, with a view to best achieving the fundamental objectives of the Policy, which include ensuring that, while the administrative proceeding takes place with due expedition, the Parties are treated with equality and each is given a fair opportunity to present its case. Accordingly, the Panel has determined to accept the late filed Response.

7. Discussion and Findings

A. Scope of the Policy

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (i) 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) The respondent has no rights or legitimate interests with respect to the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the Complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

B. Identical or Confusingly Similar

The Panel finds that the Complainant beyond question has established rights in the TATA trademark. The Respondent's arguments to the contrary are without merit. The Panel further finds that the disputed domain name <tata-telecom.com> is confusingly similar to the Complainant's TATA mark for purposes of paragraph 4(a)(i) of the Policy. The critical inquiry under the first element is whether the mark and domain name, when directly compared, have confusing similarity. *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662. They do in this instance. The disputed domain name incorporates the Complainant's mark in its entirety. The addition of the descriptive term "telecom" does not dispel such confusing similarity, as many of the Tata Group companies use Tata as the initial word in their business or trade names – i.e., Tata Communications, Tata Teleservices, Tata Steel, Tata Tea, and so forth.

Accordingly, the Panel finds that the Complainant has met its burden under paragraph 4(a)(i).

C. Rights or Legitimate Interests

As noted above, once the Complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden to the Respondent to come forward with evidence of rights or legitimate interests in the disputed domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) has been made. The disputed domain name is confusingly similar to the Complainant's mark, which the record reflects to be a distinctive, widely used and well known mark. It is undisputed that the Respondent has not been authorized to use the Complainant's mark. Nevertheless, the Respondent is using disputed domain name in connection with a commercial website on which, using the name Tata Telecom, the Respondent offers telecommunications services related to those offered by several of the Complainant's companies.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following non-exclusive factors:

- (i) before any notice to it 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 has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial 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.

The Respondent asserts that it registered the disputed domain name without knowledge of the Complainant or the Complainant's TATA mark. The Respondent claims that it registered the disputed domain name because it is an abbreviated version of Toronto Asia Tele Access Telecom, Inc. (Tata Telecom), and the Respondent asserts it was legitimately using the disputed domain name in connection with a *bona fide* offering of goods or services prior to any notice to it of this dispute. In addition, the Respondent asserts that it has established trademark rights in TATA.

The Panel finds the Respondent's arguments on balance unpersuasive. When the disputed domain name was registered in May 2003, the Tata Group was already a major conglomerate which was widely known not only in India but in other areas of the world. The Complainant's TATA mark was well known and in use in connection with a variety of goods and services related to the Tata Group's numerous areas of commercial activity. Such commercial activities included the information and communications fields. The year prior to the registration of the disputed domain name the Tata Group acquired a controlling interest in VSNL, the Indian telecommunications giant. The Respondent acknowledges it was aware that VSNL had been acquired by the Complainant prior to registration of the disputed domain name, and further states that it has "sister companies" in India, which the Respondent asserts the Complainant should be aware of.

On the basis of the record before it, the Panel does not consider the Respondent's claim of being unaware of the Complainant and the Complainant's TATA mark when registering the disputed domain name to be credible. To the contrary, based on the totality of circumstances in the record as described above, it is a virtually inescapable conclusion that the Respondent was aware of the Complainant when registering the disputed domain name. For the Respondent to assert that it has "sister companies" in India of which the Complainant is aware, while denying any knowledge on its part of the Complainant and the Complainant's well known TATA mark, simply defies credulity. Based on all of the foregoing, the Panel draws a strong inference that the Respondent was well aware of the Complainant and the Complainant's TATA mark, and that the Respondent in fact registered the disputed domain name with the aim of trading on the strength and reputation of the Complainant's mark.

In light of the foregoing, the Panel is of the view that the Respondent has not established rights to or legitimate interests in the disputed domain name. The Respondent's use of TATA to trade on Complainant's goodwill and reputation precludes any *bona fide* offering of goods or services under paragraph 4(c)(iii) of the Policy. See, e.g., *First American Funds, Inc. v. Ult.Search, Inc.*, WIPO Case No. D2000-1840 (for offering under Paragraph 4(c)(i) to be considered *bona fide*, domain name use must be in good faith under Paragraph 4(a)(iii)). See also *Philip Morris Inc. v. Alex Tsyppin*, WIPO Case No. D2002-0946; *Amphenol Corporation v. Applied Interconnect, Inc.*, WIPO Case No. D2001-0296.

Nor can the Respondent legitimately claim to have been commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy. Paragraph 4(c)(ii) requires evidence that the Respondent had rights prior to and not merely following from use of the domain name. *Paule Ka v. Paula Korenek*, WIPO Case No. D2003-0453. This is particularly the case where the Respondent has adopted another's well known trademark. See *Palm, Inc. v. South China House of Technology Consultants Ltd.*, WIPO Case No. D2000-1492 ("Respondent should not be able to take advantage of this sub-paragraph if the domain name was adopted with *mala fide* intent."). The Respondent cannot establish rights or legitimate interests in a domain name by appropriating another's well known trademark and then claiming to be commonly known by the name. See *Madonna Ciccone v. Dan Parisi*, WIPO Case No. D2000-0847; *Tata Sons Limited v. tataconnect*, WIPO Case No. D2006-0572.

Given the strength and reputation of the Complainant's TATA mark, the Panel is of the view that the Respondent adopted the disputed domain name with the intent of creating a likelihood of confusion with the Complainant's well known mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and services. The Panel rejects as untenable the Respondent's claim to have established trademark rights

in TATA. The Panel further notes the lack of any evidence in the record that the Respondent has ever registered or applied to register TATA as a trademark, and the Respondent's submissions in any event do not reflect use sufficient to establish common law rights in TATA.

Accordingly, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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 and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (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) circumstances indicating that the respondent 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) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.


For the reasons discussed under the preceding heading, the Panel draws a strong inference from the record that the Respondent knew of and had in mind the Complainant's mark when registering the disputed domain name. See *Ticketmaster Corporation v. Spider Web Design, Inc.*, WIPO Case No. D2000-1551. Under the circumstances presented here, the Respondent's claim to have been unaware of the Complainant and the Complainant's well known TATA mark lacks credulity. Moreover, as noted in *Research In Motion Limited v. Dustin Picov*, WIPO Case No. D2001-0492, when a domain name is so obviously connected with a Complainant, its very use by a registrant with no connection to the Complainant suggests "opportunistic bad faith". See also *Paule Ka v. Paula Korenek*, WIPO Case No. D2003-0453. Under the circumstances presented here, the Panel is firmly of the opinion that the Respondent

has used the disputed domain name in bad faith to attract Internet users to the Respondent's website for commercial gain, by creating a likelihood of confusion in terms of paragraph 4(b)(iv) of the Policy. See *Edmunds.com v. Ult. Search, Inc.*, WIPO Case No. D2001-1319.

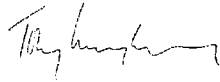
Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

8. Decision

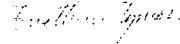
For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <tata-telecom.com> be transferred to the Complainant.



William R. Towns
Presiding Panelist



Tony Willoughby
Panelist



Jonathan Agmon
Panelist

Dated: September 1, 2009