

DISPUTE RESOLUTION SERVICE

D00011298

Decision of Independent Expert

Mahindra and Mahindra Ltd

and

Mr Mark Brooks

1. The Parties:

Lead Complainant: Mahindra and Mahindra Ltd
Mahindra India & World Headquarters
Mahindra Towers
G M Bhosale Marg
Mumbai 400018
New Delhi
110006
India

Respondent: Mr Mark Brooks
3 Sam Road
Diggle
Saddleworth
OL3 5PU
United Kingdom

2. The Domain Name:

The disputed Domain Name is mahindra.co.uk

3. Procedural History:

The Complaint under the Nominet UK Dispute Resolution Service Policy (the "Policy") and the Nominet Dispute Resolution Service Procedure (the "Procedure") was received on May 4, 2012, and was notified to the Respondent.

A Response was received from the Respondent on May 30, 2012, and was notified to the Complainant on June 6, 2012. The Complainant did not exercise its option to submit a Reply to the Response and the Parties were so notified on June 14, 2012.

On June 27, 2012, Clive N. A. Trotman was appointed Independent Expert to decide the dispute in accordance with the Policy and the Procedure. The Expert confirmed his independence and impartiality in the terms of paragraph 9(a) of the Procedure.

4. Factual Background

On the basis of evidence produced by the Complainant, it is a major international corporation based in India, founded in 1945, with now about 144,000 employees in 100 countries including the United Kingdom. The Complainant manufactures and trades in motor vehicles, tractors, jeeps and other products, which it lists as “aerospace, aftermarket, agribusiness, automotive, components, construction equipment, consulting services, defense, energy, farm equipment, finance and insurance, industrial equipment, information technology, leisure and hospitality, logistics, real estate, retail, and two wheelers”.

The Complainant has been using the trademark MAHINDRA since 1977 and has produced copies of trademark registration documents from a number of jurisdictions. It is sufficient to cite Indian Trademark Registry number 354729 dated October 25, 1979; and Community Trademark issued by the Office for Harmonization in the Internal Market, number 492066, dated August 31, 1999.

The Complainant has a number of domain names incorporating its name, including mahindra.com. When, recently, the Complainant came to register the disputed Domain Name mahindra.co.uk, it was found to have been registered by the Respondent.

According to the Respondent, he is an individual who registered the disputed Domain Name in July 2006 for the purpose of creating a website with a theme of Indian travel information, and still intends to do so. The Domain Name was based on the name Mahindra as being a popular Indian family name.

The Respondent relates a recent history, since first notification of a Complaint, of being willing to transfer the Domain Name to the Complainant for what the Respondent regards as a small fee.

5. Parties' Contentions

Complainant

The Complainant contends that it is the owner of and has rights in the registered trademark MAHINDRA, and has produced copies of supporting documentation. It says that the Respondent's Domain Name mahindra.co.uk is effectively identical to its trademark, the domain designators being of no consequence.

The Complainant says it is so large and universally known, and its trademark has been known for so many years, that the Respondent's Domain Name will lead to the deception of Internet users. People will be confused into an association of the Domain Name with the Complainant. The Supreme Court of India has observed that the Mahindra name has acquired distinctiveness and a secondary meaning in the relevant business or trade.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. He has made no use of it for a *bona fide* offering of goods or services. He has no proprietary or contractual rights in any corresponding trademark whether registered or in common law, and has not been commonly known by the name Mahindra. The Respondent has no connection with the Complainant and has not been authorized by the Complainant to use its name.

The Complainant further contends that the Domain Name constitutes an Abusive Registration. It is inconceivable that the registration was made without full knowledge of the

Complainant's trademark because it is so well known and publicised. The Respondent intentionally attempts to attract Internet users to his website by confusion for commercial gain.

It is submitted that the Domain Name could be used by the Respondent to extract money from the Complainant, could be transferred to a competitor of the Complainant, could be used to host prejudicial material, or may have been registered to stop the Complainant from using it.

The Complainant has cited a number of previous disputed domain name decisions that it wishes the Expert to consider as possible precedent.

The Complainant requests the transfer to itself of the disputed Domain Name.

Respondent

The Respondent denies the Complaint.

The Respondent says that he registered the Domain Name as a generic Indian name for a travel information site specialising in India. He says his intentions have never been devious, the Domain Name has never been listed for sale, and it does not appear in search engine results.

The Respondent says he wholeheartedly refutes that the Domain Name was registered to take advantage of the Complainant's goodwill and reputation.

The Respondent contends that since the dispute surfaced, initially under a different number in February 2012, he had been willing to transfer the Domain Name to the Complainant in exchange for, variously, a small donation to a charity, or a gift of some promotional items, which offers were declined. The Complainant has been filed afresh and the Respondent's position is essentially the same as before. He may even have transferred the Domain Name free of charge if the Complainant had asked in a non-threatening way.

6. Discussions and Findings

Paragraphs 2(a) and 2(b) of the Policy require that the Complainant, in order to succeed, must prove on the balance of probabilities that:

- "i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Complainant's Rights

The Complainant has produced satisfactory evidence that it has the required rights in the name MAHINDRA, which is its registered trademark.

The disputed Domain Name is "mahindra.co.uk", of which the domain designation ".co.uk" may generally be disregarded in the determination of identity or similarity. What remains is "mahindra", which clearly is identical to the Complainant's name and trademark. The Complainant has satisfied the requirements of paragraph 2(a)(i) of the Policy and is required next to establish that the Domain Name constitutes an Abusive Registration.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights”.

Paragraph 3 of the Policy sets out a non-exhaustive selection of circumstances that may be evidence that the Domain Name is an Abusive Registration. The parts of Paragraph 3 of the Policy relevant to the present case read:

“3. Evidence of Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

[iii - v]

b. Failure on the Respondent’s part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

[c]”

The onus of proof is upon the Complainant, which must establish on the evidence the grounds on which there may have been Abusive Registration.

Paragraph 3(a)(i) of the Policy refers to the primary purpose for which the Domain Name was initially registered, which to some extent may need to be derived from the purpose for which it has demonstrably been used.

In the terms of paragraph 3(a)(i)(A) of the Policy, there is no palpable evidence, after five and a half years of holding the registration, that the Respondent registered the Domain Name primarily for the purpose of profitable transfer to the Complainant or to any other hypothetical party.

Irrespective of the Complainant’s predicament that the Domain Name has not been available to itself, there is no evidence that the Respondent did anything that could create the semblance of an intentional blocking action against the Complainant within the meaning of paragraph 3(a)(i)(B) of the Policy. No evidence has been produced to the effect that the Complainant’s business has been disrupted by the Respondent, or that this has been the Respondent’s primary purpose, in the terms of paragraph 3(a)(i)(C) of the Policy.

Paragraph 3(a)(ii) of the Policy refers to the use of the Domain Name. The paragraph has wide application where it can be shown that the Domain Name has been conceived as a device in order to draw Internet users to the Respondent's Internet presence by intentional confusion with the Complainant, and it is widely accepted that the act of confusion occurs at the moment of initially accepting or typing the Domain Name rather than on arrival at the website or mail service. The Complainant asserts that anyone accepting mahindra.co.uk from a search engine, or typing it in anticipation, would expect to arrive at the Complainant's website but would arrive by confusion at the Respondent's website.

The wording of paragraph 3(a)(ii) of the Policy, at "using or threatening to use", projects at least slight overtones of requiring nefarious intent. Technically the Respondent is not "using" the Domain Name (in the immediate context) and his vaguely stated intentions for its eventual use may appear to be lower than a "threat". Conversely paragraph 3(b) of the Policy is highly discretionary and cannot be inverted to mean that a Domain Name not in use is thereby not an Abusive Registration.

The Complainant asserts that "...the burden is on the Respondent to prove that it has rights and legitimate interests in the disputed Domain Name". Whilst the onus of proof remains upon the Complainant in accordance with paragraph 2(b) of the Policy, nevertheless a Respondent whose Domain Name conflicts with a well-known trademark should be able to offer a satisfactory explanation. Paragraph 4 of the Policy provides a non-exhaustive list of factors whereby the Respondent may seek to show that the Domain Name is not an Abusive Registration, the presently relevant clauses of which read:

"4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C. made legitimate non-commercial or fair use of the Domain Name;

or

ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;

[iii - iv]

[b - e]"

The Respondent has outlined an intention to institute a travel information website, but paragraph 4(a)(i) of the Policy requires more. He has not produced evidence of at least demonstrable preparations to use the Domain Name for his stated purpose; he does not claim to be known as Mahindra or to have a business incorporating that name; and he has not made a non-commercial or fair use of the Domain Name. Furthermore in terms of paragraph 4(a)(ii) of the Policy, whilst the name Mahindra might be regarded as common or generic, there has been no qualifying use of the Domain Name.

In any case, in order possibly to qualify under paragraph 4(a)(i) of the Policy, the Respondent would need to have done so before being aware of the cause for the Complaint, which is not necessarily the Complaint under the DRS, but in this instance the pre-existence of the Complainant's potentially conflicting name and trademark dating back to 1977.

Abusive registration may, however, fall outside of the examples given in paragraph 3 of the Policy. Experts have tended to respect a principle that the possession of a domain name comprising essentially a well known name or trademark, without a satisfactory explanation, may be a sufficient basis for a finding of Abusive Registration. The Respondent is contractually bound by the Nominet Terms and Conditions of Domain Name Registration, which specify among other things:

"7 By entering into this contract you promise that:

[...]

7.4 by registering or using the domain name in any way, you will not infringe the intellectual property rights (for example, trademarks) of anyone else;

7.5 you are entitled to register the domain name; and

7.6 you have not registered the domain name in a way that fails to meet with any legal duty you have."

There can be little doubt that the Complainant's name was, at the relevant time, well known internationally and that the Complainant's business predominates in search engine results. The Respondent ought to have conducted basic checks and ought to have ascertained, before adopting the chosen Domain Name, that the probability of it being confused with the Complainant could be high. Irrespective of the Complainant's prominence, it is not the function of the DRS to rank contenders for a domain name according to which may appear to be the most deserving. Had the Respondent, or indeed any other registrant, been genuinely known by the reputedly common Indian name Mahindra or made genuine preparations to operate an Internet presence by that name that did not impinge on the Complainant's business, the outcome might possibly have been different. The Respondent has been unable to establish these pivotal requirements and having regard to all the evidence the Domain Name is found to be an Abusive Registration.

7. Decision

The Expert finds that the Complainant has Rights in respect of the name and trademark MAHINDRA; that the disputed Domain Name mahindra.co.uk is identical to the Complainant's name and trademark; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name mahindra.co.uk is ordered to be transferred to the Complainant.

Signed Clive N. A. Trotman

Dated July 19, 2012