

## **ADMINISTRATIVE PANEL DECISION**

upGrad Education Private Limited v. Upgrad  
Case No. D2022-0968

### **1. The Parties**

The Complainant is upGrad Education Private Limited, India, represented by Khaitan & Co., India.

The Respondent is Upgrad, India.

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

The disputed domain name <upgradcareer.com> is registered with Domainshype.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 21, 2022. On March 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 23, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on April 5, 2022, providing the additional registrant and contact information disclosed by the Registrar. The Complainant filed two amended Complaints on April 7, 2022 and April 8, 2022, respectively.

The Center verified that the Complaint together with the amended Complaints 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2022.

The Center appointed Shwetasree Majumder as the sole panelist in this matter on May 12, 2022. The Panel finds that it was properly constituted. 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 an online higher education company based out of India. The Complainant's website is at "www.upgrad.com". The Complainant is the registered owner, user, and proprietor of the mark UPGRAD in India as well as in several jurisdictions worldwide. The Complainant's earliest Indian registrations for its mark UPGRAD are dated June 15, 2015 (e.g., Indian trademark No. 2985062). The Complainant also owns several domain names consisting of its mark UPGRAD. Its domain name <upgrad.com> which hosts its current website was created on December 28, 2001.

The disputed domain name <upgradcareer.com> was registered on November 23, 2020. The disputed domain name resolves to a website on which the Respondent offers online education courses. The Respondent uses the sign Upgradcareer, which has a similar colour scheme as the Complainant's UPGRAD trademark, on its website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant founded in the year 2015 claims to be one of South Asia's largest online higher education companies. The Complainant claims to have invented and coined the mark UPGRAD and claims to have acquired valuable, substantial and extensive goodwill and reputation.

The Complainant's mark UPGRAD is registered in India as well as in other jurisdictions. The Complainant has submitted a list of such trademark registrations and copies of registration certificates as Annex D with the Complaint. This Panel notes that some of the earliest Indian registrations for the mark UPGRAD are dated June 15, 2015. The Complainant claims that its mark UPGRAD is a well-known mark in India and that it has incurred substantial expenditure in advertisement and promotion of the goods/services under its mark. The Complainant claims to have statutory as well as common law rights in the well-known mark UPGRAD in several countries of the world.

The Complainant argues that the disputed domain name incorporates its mark in its entirety and hence is identical and confusingly similar to the Complainant's mark UPGRAD. The terms "career" and ".com" in the disputed domain name can be classified as non-distinctive generic wordings and are not sufficient to avoid the likelihood of confusion among Internet users and the general public. The Complainant states that the inclusion of the generic wordings does not impact the consumer perception that the disputed domain name is confusingly similar to its mark UPGRAD. To this extent the Complainant has cited the decision in *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#).

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name. It is the Complainant's case that the name of the Respondent cannot legitimately be "Upgrad" since the Complainant's mark UPGRAD is an invented and coined mark. The Complainant states that registering and using the disputed domain name constitute trademark infringement. To address this, the Complainant states to have sent a cease and desist notice to the Respondent but states to have not received any response.

The Complainant argues the disputed domain name was registered and is being used in bad faith. The Complainant submits that the disputed domain name was registered in an attempt to attract, for commercial gain, Internet users to the proposed website bearing the disputed domain name or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the proposed website or location or of a product or service on the proposed website or location.

## B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

As per paragraph 5(f) of the Rules where a Respondent does not submit a response, in the absence of exceptional circumstances, the panel may decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response. As per paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the panel may draw such inferences as it considers appropriate. It remains incumbent on the Complainant to make out its case in all respects under paragraph 4(a) of the Policy.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements required under by a preponderance of evidence:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has produced trademark registration certificates in India, and other jurisdictions, in respect of the mark UPGRAD. The Complainant's trademark registrations for the mark UPGRAD are prior to the date of registration of the disputed domain name. The disputed domain name incorporates the Complainant's mark UPGRAD in its entirety, together with the term "career". Referring to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, this Panel notes that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. In the present case, the Complainant's mark UPGRAD is clearly recognizable in the disputed domain name <upgradcareer.com> and therefore the addition of "career" does not prevent a finding of confusing similarity (see *F. Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#)).

The [WIPO Overview 3.0](#), section 1.7 provides the consensus view of UDRP panels: "While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The generic Top-Level Domain ("gTLD") ".com" is generally disregarded for the purposes of comparison under this element.

In view of the above-mentioned findings, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark UPGRAD and that the requirement of paragraph 4(a)(i) of the Policy stands satisfied.

## B. Rights or Legitimate Interests

The consensus view of the second element under paragraph 4(a) of the Policy requires the Complainant to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel notes that the Complainant has already submitted evidence that it holds exclusive rights in the trademark UPGRAD by virtue of statutory registrations and by common law use, which rights have accrued in the Complainant's favour. The Complainant's revenue and advertising expenditure for its mark UPGRAD (Annex F to the Compliant) run into millions of Indian Rupees.

The disputed domain name <upgradcareer.com> resolves into a website where the Respondent appears to be offering online education courses, similar products to those of the Complainant. The Complainant asserts that the Respondent's actions of using the mark UPGRAD in the disputed domain name and the sign Upgradcareer on its website for similar services constitute infringement and dilution of its mark UPGRAD.

The view of previous UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy has been summarized in section 2.1 of the [WIPO Overview 3.0](#), which states: "While the overall burden of proof in UDRP proceedings is on the complainant, [...] where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name." Although the website at the disputed domain name includes a fine print disclaimer at the bottom of the homepage stating that "All the course names, logos, and certification titles we use are their respective owners' property. The firm, service, or product names on the website are solely for identification purposes. We do not own, endorse or have the copyright of any brand/logo/name in any manner. Few graphics on our website are freely available on public domains", it does not prominently and accurately disclose that the Complainant is the owner of the mark UPGRAD, and there is no relationship between the Complainant and Respondent. Under the present circumstances and in absence of the Respondent's rebuttal to the Complainant's contentions, this Panel does not find the Respondent's offering of goods or services on the website "www.upgradcareer.com" as *bona fide* or legitimate noncommercial.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Respondent has failed to file a response to rebut the Complainant's *prima facie* case or to advance any claim as to rights or legitimate interests in the disputed domain names (particularly, in accordance with paragraph 4(c) of the Policy). Accordingly, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

In order to prevail, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith according to paragraph 4(a)(iii) of the Policy. Bad faith is understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see section 3.1 of the [WIPO Overview 3.0](#)).

The Respondent's conduct of subsuming the Complainant's mark in the disputed domain name, which resolves into a website offering similar services, does not appear to be *bona fide*. Here, such conduct falls within the example of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy namely that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The Panel notes that the Complainant has extensively used its UPGRAD trademark for a long time before the registration of the disputed domain name, including using it on the Internet. The Respondent's probable purpose in registering the disputed domain name which incorporates the entire mark of the Complainant is, in the Panel's view, to capitalize on the reputation of the Complainant's mark.

As set out in the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Here, there is no doubt that the Complainant's mark UPGRAD is a widely known mark in the education industry, in particular in India where the Parties are located. Hence, the Panel is satisfied that the Respondent knew, or in any event ought to have known, of the mark's existence when registering the disputed domain name. The Panel therefore concludes that the disputed domain name was registered and is being used in bad faith.

The Respondent has not availed itself of the opportunity to present any case of good faith that it might have had, and, in view of the circumstances, the Panel cannot conceive of any. The Panel finds that on the balance of probabilities, the Respondent's conduct in registering and using the disputed domain name constitutes bad faith under the Policy.

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

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <upgradcareer.com> be transferred to the Complainant.

*/Shwetasree Majumder/*

**Shwetasree Majumder**

Sole Panelist

Date: May 26, 2022