

ADMINISTRATIVE PANEL DECISION

Udemy, Inc. v. Privacy Protection / Bruce, or cao
Case No. D2022-2890

1. The Parties

The Complainant is Udemy, Inc., United States of America (“United States”), represented by SafeNames Ltd., United Kingdom.

The Respondent is Privacy Protection, United States / Bruce, or cao, China.

2. The Domain Name and Registrar

The disputed domain name <udemy.xyz> is registered with Sav.com, LLC (the “Registrar”)

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 5, 2022, the Registrar 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 August 9, 2022, 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 amended Complaint on August 9, 2022.

The Center verified that the Complaint together with the amended 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 5, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on September 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 a leading online course provider, allowing users (businesses, professionals and students) access to over 480 million courses for the purposes of e-learning. The Complainant was founded in 2010 and is headquartered in San Francisco, California, United States, and has offices in Denver, Brazil, the Republic of Ireland and Türkiye. The Complainant's "UDEMY" service is available in 75 languages and has over 49 million learners utilising its platform across more than 180 countries from its main website at <udemy.com>. Its services have a global reach, amassing just over 100 million visits per month accordingly to third-party traffic statistics and it has an established social media presence under the UDEMY trade mark including 6.7 million 'likes' on Facebook, 266,000 followers on Twitter and 2.3 million followers on Instagram.

The Complainant owns various trade mark registrations for its UDEMY brand including European Union trade mark registration 011006319 registered on November 28, 2012.

The disputed domain name was registered on December 27, 2021 and resolves to a page at <sav.com> on which it is advertised as being available for sale for USD \$7,200.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it owns registered trade mark rights for its UDEMY mark as set out above. It submits that the disputed domain name is identical to its mark for the purposes of paragraph 4(a)(i) of the Policy and that the top level domain element ".xyz" should be disregarded for this purpose.

To the best of the Complainant's knowledge it submits that the Respondent does not have any trade mark rights to the term "UDEMY". It says that there is also no evidence that the Respondent retains unregistered trade mark rights in the term "UDEMY". Neither, says the Complainant, has the Respondent received any licence from the Complainant to use a domain name featuring the "UDEMY" trade mark.

The Complainant says that the Respondent has used the disputed domain name to re-direct to a SAV webpage that offers the disputed domain name for sale at USD 7,200 and that previous panels have found that the use of a domain name comprising a complainant's trade mark, for the purpose of advertising its sale on a reseller platform, does not constitute a *bona fide* offering of goods or services.

It further submits that the UDEMY brand has no descriptive or generic meaning and is rather a coined term and that its coincidental use in the disputed domain name is therefore highly unlikely, other than for the purpose of taking advantage of the goodwill and valuable reputation attaching to the "UDEMY" trade mark. The Complainant further says that there is no evidence that the Respondent has ever intended to use the disputed domain name in a legitimate non-commercial or fair manner. It says that using the disputed domain name to solicit offers for its acquisition at USD 7,200 which is far in excess of nominal registration and upkeep costs is clearly a commercial use and cannot be deemed to be a fair use.

The Complainant notes that its earliest trade mark registration predates the creation date of the disputed domain name by nine years and that substantial goodwill has accrued since the Complainant's establishment in 2010 such that the UDEMY name has become synonymous with the provision of online educational courses. It says further that searching "UDEMY" on popular Internet search engines such as Google lists the Complainant's brand and services as the first result.

As far as use in bad faith is concerned, the Complainant submits that the Respondent has listed the disputed domain name for sale on the platform "Sav" and has attempted to sell it for a consideration well in excess of its registration and maintenance costs. Considering the distinctiveness of the UDEMY mark, the Complainant says that the Respondent can only plausibly be targeting the Complainant by offering it for sale and notes that previous panels have established that it is unnecessary to show that a respondent directly

solicited an offer from a complainant in order to establish bad faith. The Complainant also submits that under paragraph 4(b)(iv) of the Policy, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's UDEMY mark to the <sav.com> web page from which it has then sought to elicit offers for the acquisition of the disputed domain name at an inflated price. This says the Complainant amounts to commercial use in terms of this provision of the Policy and is evidence of registration and use in bad faith.

It also notes, as set out in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 3.1.4, that: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." The Complainant submits that this presumption exists here, as the disputed domain name is identical to the Complainant's globally distinctive UDEMY trade mark.

Finally, the Complainant confirms that it has received no response from the Respondent to its pre-action cease and desist letter sent through the registrar for the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns various trade mark registrations for its UDEMY brand including European trade mark registration 011006319 registered on November 28, 2012. The element of the disputed domain name before the ".xyz" top level domain root is identical to this mark. Accordingly, the Panel finds that the Complaint succeeds under the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that to the best of its knowledge the Respondent does not have any trade mark rights, whether registered or unregistered to the term "UDEMY". Neither, says the Complainant, has the Respondent received any licence from the Complainant to use a domain name featuring the "UDEMY" trade mark.

The Complainant has further submitted that the UDEMY brand has no descriptive or generic meaning and is rather a coined term and that its coincidental use in the disputed domain name is therefore highly unlikely, other than for the purpose of taking advantage of the goodwill and valuable reputation attaching to the "UDEMY" trade mark. There appears to be nothing on the record to suggest that the Respondent ever intended to use the disputed domain name in a legitimate non-commercial or fair manner. Certainly, using the disputed domain name to divert to an SAV webpage at which offers are sought for the acquisition of the disputed domain name at a price far in excess of its nominal registration and upkeep costs is a commercial use rather than a fair use and appears to be a blatant attempt to take advantage of the UDEMY mark and it is notable that the Respondent has not even attempted to explain its conduct in this regard.

For these reasons the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. As the Respondent has failed to respond to or to rebut the Complainant's case and for the reasons set out under Part C below, the Panel finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was registered on December 27, 2021, more than a decade after the Complainant commenced its business and long after it registered its European trade mark for the UDEMY mark. The UDEMY mark is a coined and highly distinctive term, which has been used extensively on-line and in social media by the Complainant. In these circumstances it is very unlikely that the Respondent registered the disputed domain name by coincidence and that it was unaware of the Complainant and of its UDEMY mark when it did so.

Under paragraph 4(b)(i) of the Policy there is evidence of registration and use of a domain name in bad faith where there are circumstances indicating that a respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name.

In this case, the disputed domain name is a highly distinctive coined term that has been used extensively online and in social media for many years in relation to a well established and international online business. The Respondent, having only registered the disputed domain name at the end of 2021 does not appear to have used it other than to have advertised it through the <sav.com> website for sale at the inflated price of USD 7,200. In all the circumstances there is a very strong inference that the Respondent registered the disputed domain name knowingly and at such an inflated price that it was most likely aimed at the Complainant or at a competitor seeking to take advantage of the renown attaching to the Complainant's mark. The fact that the Respondent has failed to respond to the Complainant's cease and desist letter or to explain its conduct in the course of these proceedings and has used a privacy service in an attempt to mask its identity, only reinforces the Panel's view of the Respondent's bad faith.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith and that the Complaint also succeeds under this element of the 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, <udemy.xyz> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: September 26, 2022