

## **ADMINISTRATIVE PANEL DECISION**

Autodesk, Inc. v. rin pa  
Case No. D2022-4114

### **1. The Parties**

The Complainant is Autodesk, Inc., United States of America (“United States”), represented by Donahue Fitzgerald LLP, United States.

The Respondent is rin pa, United States.

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

The disputed domain name <autodeskflow.com> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 1, 2022. On November 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 2, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 3, 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 amendment to the Complaint on November 4, 2022.

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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 2, 2022.

The Center appointed Andrew J. Park as the sole panelist in this matter on December 11, 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 multinational software corporation that makes software products and services for the architecture, engineering, construction, manufacturing, media, education, and entertainment industries. The Complainant is headquartered in San Francisco, California and has offices worldwide. Since 1983, the Complainant has continuously used its trademark, AUTODESK, in connection with its commercial offering to the public of licensed copies of computer software programs, associated user manuals, and related documentation more than three decades. The Complainant sells licenses all over the world and on every continent for its various software products. There are over nine million users of the Complainant's products, and to accommodate this user base, Autodesk works with approximately 1,700 channel partners, 3,300 development partners, and 2,000 authorized training centers to assist its customers with their worldwide use of its products that incorporate the Complainant's trademark AUTODESK into their names.

The Complainant owns various national and International trademark registrations for AUTODESK worldwide, and has obtained registrations covering its trademark from at least 72 jurisdictions. The Complainant promotes its trademark worldwide with its official website under the domain name <autodesk.com> which was registered in 1989. A sampling of the worldwide registrations of the AUTODESK mark are as follows:

Trademark	Jurisdiction	Registration No.	Registration Date
AUTODESK	United States	1316772	January 29, 1985
AUTODESK	China	307891	February 10, 1988
AUTODESK	European Union	4036687	July 24, 2006

Also, the Complainant owns a pending trademark application with the United States Patent and Trademark Office for the mark AUTODESK FLOW filed on June 21, 2021, which predates the registration of the disputed domain name.

The disputed domain name <autodeskflow.com> was registered on September 9, 2022 and does not resolve to an active website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that the disputed domain name should be transferred to the Complainant for the following reasons.

(a) The disputed domain name is identical or confusingly similar to the Complainant's trademark AUTODESK in which the Complainant has rights.

The Complainant owns registration and common law trademark rights to the trademark AUTODESK. The Complainant's ownership of the trademark, AUTODESK and the exclusive right to use the AUTODESK trademark in commerce on or in connection with goods or services are *prima facie* evidence of the validity of the term AUTODESK as a trademark through its registrations with the United States Patent and Trademark Office ("USPTO"), European Union Intellectual Property Office ("EUIPO"), China National Intellectual Property Administration ("CNIPA"), and other jurisdictions around the world, which all predate the registration date of the disputed domain name. Also, the Complainant demonstrated its ownership of common law trademark rights in its trademark AUTODESK, which had become a distinctive identifier associated with the Complainant and its goods and services and had no other meaning other than these uses as a source indicator for the Complainant's products and services.

The Complainant claims that the disputed domain name incorporates the Complainant's trademark AUTODESK in its entirety paired with the word "flow". Adding the word "flow" to the Complainant's trademark in the disputed domain name fails to negate confusing similarity between the disputed domain name and the Complainant's trademark because the Complainant's incorporated trademark has a high degree of inherent distinctiveness reinforced by longstanding international recognition and where the word "flow" does nothing to dispel the connection in the public's mind between the trademark and the Complainant. Rather, the inclusion of the word "flow" increases and strengthens the confusing similarity since the disputed domain name is identical in all respect to the Complainant's AUTODESK FLOW mark filed with USPTO on June 21, 2021, which predates the registration date of the disputed domain name by the Respondent.

Also, the addition of a generic Top-Level Domain ("gTLD") such as ".com" to the domain name is completely without legal significance.

(b) The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant contends that the Complainant has never authorized, endorsed, or sponsored the Respondent to register and/or use its trademarks AUTODESK and AUTODESK FLOW for doing business as "autodeskflow.com".

The Complainant also claims that the Respondent is not a *bona fide* provider of goods or services under the disputed domain name and is not making any legitimate noncommercial use or fair use of the Complainant's trademark. Also, the Respondent is not commonly known by the disputed domain name and does not currently utilize the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith.

The Complainant claims that the Respondent registered the disputed domain name in bad faith. First, the registration date of the disputed domain name is much later than the Complainant's worldwide trademark registrations. The Respondent registered the disputed domain name with the aim of taking advantage of the reputation and goodwill of the well-known trademark AUTODESK of the Complainant. The Respondent must have been well acquainted with the Complainant and its trademark when it registered the disputed domain name because the disputed domain name is identical or confusingly similar to the Complainant's trademarks AUTODESK and AUTODESK FLOW. The Respondent registered the disputed domain name to create confusion between the disputed domain name and the Complainant's trademark, mislead consumers, and prevent the Complainant from registering and using a domain name that contains its AUTODESK mark and AUTODESK FLOW mark. Second, the Respondent has not published any substantive content on the website to which the disputed domain name resolved. The Respondent's passive holding of the disputed domain name also supports the finding of its bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the AUTODESK trademark, and that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name incorporates the Complainant's trademark in its entirety. The mere addition of the

term “flow” does not prevent a finding of confusing similarity to the Complainant’s trademark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Further, the addition of the generic Top-Level Domain (“gTLD”) “.com” may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#)).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks.

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. (See *Danzas Holding AG, DHL Operations B.V. v. Ma Shikai*, WIPO Case No. [D2008-0441](#); [WIPO Overview 3.0](#), section 2.1 and cases cited therein).

Here, the Panel finds that the Complainant has made out a *prima facie* case, which has not been rebutted by the Respondent.

The Panel finds that the Respondent has no relationship with or authorization from the Complainant to use its trademarks AUTODESK. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name. Also, there is no evidence that the Respondent has an intention to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Panel’s view is that these facts may be taken as true in the circumstances of this case.

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

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the 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 trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent violated the Policy, paragraph 4(b)(iv) by registering the disputed domain name in order to attempt to attract, for commercial gain, Internet users to the Respondent's website which the disputed domain name resolves to by creating a likelihood of confusion with the Complainant's trademark.

As stated previously, the Respondent did not file any response to the Complaint, failing thereby to rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain name.

Nevertheless, the Panel still has the responsibility of determining which of the Complainant's assertions are established as facts, and whether the conclusions asserted by the Complainant can be drawn from the established facts (see *Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

First, the Panel finds the Respondent intentionally registered the disputed domain name in bad faith. The Respondent registered the disputed domain name, which is identical or confusingly similar to the Complainant's trademark, AUTODESK, while aware of the Complainant's worldwide famous business and its trademark. Since the Complainant started its business in 1983, it has extensively used and continues to use its trademark AUTODESK in connection with various products and services developing substantial goodwill in its trademark AUTODESK. The Complainant's first use of the domain name <autodesk.com> for the Complainant's official website in 1989, and its first registration of the AUTODESK trademark in 1985, all pre-date the registration date of the disputed domain name by the Respondent in 2022, the sum of which clearly show that the Respondent had knowledge of the Complainant's trademark and business when it registered the disputed domain name, and that it tried to benefit of a likelihood of confusion with the Complainant's trademark.

Also, the disputed domain name combines the Complainant's trademark AUTODESK and the word "flow". Judging from the facts that the Complainant filed a trademark application for the mark AUTODESK FLOW one year before the Respondent's registration of the disputed domain name, and the disputed domain name is identical in all respects to the mark AUTODESK FLOW, the similarity between the dispute domain name and the Complainant's mark AUTODESK FLOW reinforces the finding that the Respondent intended the disputed domain name to create a likelihood of confusion with the Complainant's trademarks. Thus, it is clear that the Respondent registered the disputed domain name in bad faith, with full knowledge of the Complainant's trademarks and business.

Second, concerning bad faith use by the Respondent, the Complainant states that the disputed domain name does not lead to an active website. Passive holding of a domain name may not prevent a finding of bad faith under the so-called doctrine of passive holding. In particular, the following factors have been considered relevant in applying the passive holding doctrine (See *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. / Armando Machado*, WIPO Case No. [D2018-0082](#)):

- (i) the degree of distinctiveness or reputation of the complainant's mark,
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,
- (iii) the respondent's concealing its identity or use of false contact details; and
- (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel looks at the totality of the circumstances of this case and notes that the Complainant clearly shows that it has trademark registrations for AUTODESK in many jurisdictions which all predate the registration date of the disputed domain name and ever since the Complainant started its business in 1983, it has continuously used its trademark, AUTODESK in connection with its commercial products and services. The Panel finds that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and goodwill in its trademark worldwide. The Respondent failed to submit arguments to support its good faith registration and maintenance of the disputed domain name. The Respondent did not submit a response nor provide any evidence of actual or contemplated good faith use of the disputed domain name. Also, the Panel notes that the registrant and contact information confirmed by the Registrar for the disputed domain name appear to be false or incomplete. Furthermore, the Complainant's AUTODESK trademark has such a high degree of awareness among the public that it is implausible to believe that the Respondent was not aware of that mark when he registered the disputed domain name. According to section 3.1.4 of the [WIPO Overview 3.0](#), 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.

Accordingly, the evidence shows that the Respondent likely knew of and had sought to take unfair advantage of the confusing similarity between the disputed domain name and the Complainant's trademark all for commercial gain. The Respondent has not provided any evidence of plausible good faith use of the disputed domain name or objected to the Complainant's contentions that it registered and is using the disputed domain name in bad faith. Moreover, the Panel is unable to determine any plausible good faith use to which the disputed domain name, incorporating both the Complainant's AUTODESK and AUTODESK FLOW marks, could be put.

Considering all the circumstances, and in the absence of a Response, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy, paragraph 4(a)(iii).

## 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 <autodeskflow.com> be transferred to the first Complainant.

*/Andrew J. Park/*

**Andrew J. Park**

Sole Panelist

Date: January 4, 2023