

ADMINISTRATIVE PANEL DECISION

UpGrad Education Private Limited v. Kunal Dhameja
Case No. D2023-3973

1. The Parties

The Complainant is UpGrad Education Private Limited, India, represented by Sim And San, Attorneys At Law, India.

The Respondent is Kunal Dhameja, India.

2. The Domain Name and Registrar

The disputed domain name <upgrad.academy> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 22, 2023. On September 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 25, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 2023, 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 the same day.

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 October 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 1, 2023.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on November 7, 2023.

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, Upgrad Education Private Limited, is a company incorporated under the laws of India in 2012. The Complainant is an online higher education service provider and offers services of undergrad courses, campus and job linked programs, and assists the students in studying in the global colleges.

The Complainant is the registered proprietor of the mark UPGRAD in India, including the registration trademark No. 2985064, registered on June 15, 2015 in class 41. The trademark is valid and subsisting. The Complainant also owns several domain names consisting of its mark UPGRAD, including the domain names <upgrad.com>, <upgrad.co>, <upgrad.info>, <upgrad.net>, and <upgrad.org>.

The disputed domain name was registered on October 20, 2022. Evidence submitted by the Complainant shows that the disputed domain name redirects to a third-party website at the domain name <smmpanel.ai>.

5. Parties' Contentions

A. Complainant

The Complainant asserts to be India's largest online higher education company with the highest gross revenue in the Indian market. It claims to offer undergraduate courses, campus and job linked programs, study abroad courses, short form to executive programs, and degrees at both masters, and doctoral level. The Complainant claims to have a learner base of over 3 million spread across 50 countries, over 300 University partners, and a business with a client base of over 658 companies.

The Complainant was incorporated in 2012 and registered the domain name "www.upgrad.com" on December 28, 2001, which it operates. The Complainant states that it commenced business in 2015. The Complainant is the registered and lawful proprietor of the mark UPGRAD in India in various classes and claims to actively enforce its rights in the said mark. The Complainant further asserts that its mark UPGRAD is a well-known mark in India.

The Complainant states that, over the years, it has invested substantial expenses in promoting and advertising of the mark UPGRAD and/or the services provided thereunder. Moreover, it claims to have expended time, money, and resources towards promoting and protecting its trademark rights and goodwill vested therein, based on which it claims common law rights.

The Complainant also claims to have prominent social media presence, including Facebook, YouTube, LinkedIn, and X (formerly Twitter). The Complainant also claims that over the years, it has also received extensive media coverage from time to time.

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 Complainant further contends that the only difference between the Complainant's UPGRAD trademark and the disputed domain name is the generic Top-Level Domain ("gTLD") suffix ".academy". The term "academy" can be classified as non-distinctive generic wording and is not sufficient to avoid the confusion between the disputed domain name and the Complainant's mark among Internet users.

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not a licensee of the Complainant, nor has it been otherwise authorized or allowed by the Complainant to make any use of its UPGRAD mark, in a domain name or otherwise.

The Complainant also contends that there has been no use of, and/or demonstrable preparations to use the mark UPGRAD or the disputed domain name by the Respondent in connection with a bona fide offering of goods or services before being aware of the Complainant's dispute. The Complainant further contends that there is no indication in the record that the Respondent has ever been commonly known as "upgrad" and holds no association with the trademark and the disputed domain name. The UPGRAD trademark is not a generic or descriptive trademark and hence, there is no justification on the part of the Respondent to purchase and/or use the Complainant's UPGRAD mark.

The Complainant argues the disputed domain name was registered and is being used in bad faith by the Respondent. There is no plausible reason for the registration and use of the disputed domain name, other than with the ulterior motive 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.

The Complainant contends that the Respondent has registered the disputed domain name intentionally to attract, confuse, and profit from Internet users seeking the Complainant's products and services who unintentionally and inadvertently search for the Complainant's trademark UPGRAD with the gTLD term "academy", as the Complainant primarily provides education services. The Complainant claims that the Respondent does not have any legitimate rights and interest in the disputed domain name and has evidently registered the same with the mala fide intention of making illegitimate and illegal commercial gains.

The Complainant further reiterates that the Respondent has registered the disputed domain name with the Complainant's mark UPGRAD with the term "academy", for commercial gain and to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website, and on this basis, alleges bad faith. The Complainant also relies upon the fact that the disputed domain name is being used to redirect the Internet users, who may be seeking the Complainant's services, to an unrelated third party website, for commercial gain, which also shows bad faith use.

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.

Paragraph 15(a) of the Rules instructs the Panel to decide a complaint “on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Having considered the Complainant’s case and the evidence available, the Panel finds as follows.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has successfully established the ownership of the UPGRAD trademark rights, which by virtue of being wholly incorporated and clearly recognizable within the disputed domain name, establishes confusing similarity with the Complainant’s trademark.

Per section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “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”.

Regarding the addition of the descriptive gTLD term “.academy”, the Panel confirms that it does not prevent a finding of confusing similarity between the disputed domain name and the trademark UPGRAD. The Panel considers it useful to refer to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable gTLD in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel confirms that the Complainant has satisfied the first element contained in paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established statutory rights in and to its trademark UPGRAD which it has substantially used for over a decade. The Complainant has further affirmed that it has not granted any license or authorization to the Respondent to use its trademark UPGRAD and nor is it affiliated with the Respondent. There is no evidence before the Panel to suggest that the Respondent is commonly known by the disputed domain name.

The Panel finds that based on the facts and arguments set out above a prima facie case is made by the Complainant, pursuant to which, the burden of production shifts to the Respondent to come forward with an appropriate allegations and relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Respondent has failed to demonstrate any rights or legitimate interests over the term “upgrad” or the disputed domain name as per paragraph 4(c) of the Policy.

For these reasons, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name (see *Deutsche Lufthansa AG v. Mustermann Max, Muster AG*, WIPO Case No. [D2015-1320](#); *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. [D2006-1095](#); and *Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#)).

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant claims that the mark UPGRAD has been held as well-known mark in some prior UDRP decisions. The Panel is satisfied of the tremendous goodwill and reputation in the mark, which the Complainant has demonstrated in the present case, by way of extensive evidence of use, awards, and other recognitions for the mark UPGRAD and the services provided thereunder.

Moreover, [WIPO Overview 3.0](#), section 3.1.4 states that “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain name comprising typos or 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”.

The Panel also concurs with the Complainant’s contention that the Respondent registered the disputed domain name with the intent of using the Complainant’s trademark UPGRAD and redirected Internet users to third-party websites to profit from the renown of the Complainant’s trademark commercially. The Complainant’s mark UPGRAD is widely popular throughout India and internationally for educational services. The Respondent, who is based in India, is likely to have had knowledge of the Complainant’s said trademark, its business and reputation. Therefore, the Respondent’s registration and use of the disputed domain name is a clearly done in bad faith and with the ill-intentions of the Respondent to mislead and divert the Complainant’s customers to a third-party website. The Respondent’s bad faith actions are further demonstrated in hiding his identity by using a privacy service at the time of registration of the disputed domain name. See section 3.6 of the [WIPO Overview 3.0](#).

UDRP paragraph 4(b)(iv) provides that the following non-exclusive scenario constitutes evidence of a respondent’s bad faith: “by using the domain name, the respondent has intentionally attempted 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 the respondent’s website or location”. The Panel finds that the above circumstances are present in this case.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and used in bad faith pursuant to paragraph 4(b)(iv) of the Policy and that the Complainant has satisfied the third element of the Policy on this as well.

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, <upgrad.academy>, be transferred to the Complainant.

/Meera Chature Sankhari/

Meera Chature Sankhari

Sole Panelist

Date: November 27, 2023