



महाराष्ट्र MAHARASHTRA

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NS 203166

ARBITRATION AWARD

**BEFORE THE SOLE ARBITRATOR DIPAK G. PARMAR
.IN REGISTRY
(C/o NATIONAL INTERNET EXCHANGE OF INDIA)**

Udacity Inc.

...Complainant

v/s

Alex Wang

...Respondent

In the matter of Disputed Domain Name <UDACITY.CO.IN>.

1 The Parties

The Complainant is Udacity Inc., 2465 Latham Street, 3rd Floor, Mountain View, California 940040 USA, represented by Ramfry & Sagar.

The Respondent is Alex Wang, 995 Shangchuan Road, Pudong, Shanghai 210016, China.

2 Procedural History

- 2.1 A Complaint dated September 9, 2015 has been filed with the National Internet Exchange of India (hereinafter referred to as the "Exchange"). The Complainant has made the Registrar verification in connection with the Disputed Domain Name. It is confirmed that presently the Respondent is listed as the registrant and provided the contact details for the administrative, billing and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (hereinafter referred to as the "Policy") and the Rules framed thereunder.
- 2.2 The Exchange appointed Dipak G. Parmar, Advocate as the sole Arbitrator in this matter. The Arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- 2.3 On September 30, 2015, the Arbitrator had emailed to the Respondent setting forth the relief claimed in the Complaint and directed the Respondent to file his reply to the Complaint. On October 13, 2015, the Respondent submitted his reply. On October 20, 2015, the Complainant submitted the Rejoinder. The Respondent filed the Reply to Rejoinder on October 25, 2015.
- 2.4 Email is the mode of communication of this Arbitration and each email is copied to the Complainant, the Respondent and to the Exchange.

3 Factual Background

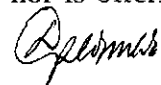
From the Complaint and its Annexures, the Arbitrator has found the following facts:

- 3.1 Udacity Inc., the Complainant, founded in 2011. The Complainant is in the business of providing of education services namely University Level Online Courses. The Complainant has known through its unique online courses designed in tandem with others. The Complainant had continuously delivered online university level courses created and taught by engineers and analysts since 2012.
- 3.2 The Complainant's trademark 'UDACITY' is a registered trademark in the US, the European Union, China and Canada. In India, the Complainant's trademark application no. 2365810 for the trademark 'UDACITY' is pending.
- 3.3 The Complainant is the registrant of the domain names <UDACITY.COM> and other generic top level domain and country code top level domain names which, inter alia, includes <UDACITY.US>, <UDACITY.ORG>, <UDACITY.KR>, <UDACITY.JP> and <UDACITY.SG>.
- 3.4 The Disputed Domain Name <UDACITY.CO.IN> was registered on January 29, 2012. At the time of filing the Complaint, the Disputed Domain Name does not resolve to a website.



4 Parties' Contentions

- 4.1 The Complainant claims that the Complainant has continually used the trademark 'UDACITY' since 2012 and has received considerable media attention for its commercial success. The Complainant also claims that 'UDACITY' has garnered media attention for its partnership with Georgia Tech and AT&T to offer the first online massive open online master's degree program in computer science for less than USD 7,000 in tuition specifically targeted to students in India - the Complainant's second largest market for student enrollment.
- 4.2 The Complainant states that distinctiveness and well-known nature of the trademark 'UDACITY' is exemplified by the 582,000 search results for the term 'UDACITY' generated from <http://www.google.co.in>, almost all of which are related to the Complainant. The Complainant further states that, Complainant's having 580,000 followers and 9 million page views on Google+, 103,000 followers on Twitter, and 122,000 'Likes' on Facebook.
- 4.3 The Complainant contends that the Disputed Domain Name is identical to the trademark 'UDACITY' in which the Complainant has right because the Disputed Domain Name contains the whole of the mark 'UDACITY' and consists solely of the trademark 'UDACITY'. Accordingly, the use of the Disputed Domain Name is likely to mislead consumers into believing <UDACITY.CO.IN> is affiliated with the Complainant. The Respondent argues that at the time of registration of the Disputed Domain Name, the Complainant has no exclusive trademark rights in the India and other countries. The Complainant states that the Complainant has prior proprietor rights vesting in the mark 'UDACITY' *vis-a-vis* the Respondent.
- 4.4 The Complainant argues that the Respondent has no rights or legitimate interests in the Disputed Domain Names beyond a purely commercial interest in diverting legitimate customers from the Complainant's website or in ransoming the Disputed Domain Name to the Complainant. The Complainant further argues that the Respondent has been passively holding the Disputed Domain Name since its registration i.e. January 29, 2012. The Respondent states that the word 'UDACITY' comes from two words 'Uda' and 'city'. The word 'Uda' means 'quickly reach' in the Chinese. The Respondent claims that he had originally coined the word 'UDACITY'. The Complainant states that there is no evidence provided by the Respondent to substantiate his claims of the Chinese meaning of word 'UDACITY'. The Complainant argues that the explanation of re coinage cannot stand the test of reason and, therefore is frivolous.
- 4.5 The Respondent claims that the Respondent is a startup and developed the application and web site about the novelties search and shopping in the city. The Respondent claims that he have been preparing his service for a long time and is not being finished now. The Respondent claims that the Disputed Domain Name is just a protected registration and to forward it to <http://udcity.strikingly.com>. The Respondent further claims that hosting a coming soon page is the common practice of a startup while the website is under development and, argues that, it indicates that the Respondent has been prepared and used the Disputed Domain Name reasonably. The Complainant claims that the Respondent has failed to display any use or intention to use the Disputed Domain Name. The Complainant further claims that the Respondent has not commenced any use thereof nor is offering any



goods/services using the Disputed Domain Name till date. The Complainant states that the Respondent had filed no evidence as to substantiating use of the Disputed Domain Name for novelties search and shopping in the city but the Respondent has been passively holding the Disputed Domain Name since its registration. The Complainant claims that the Respondent has simply lifted Complainant's prior trademark and registered the same as a domain name and has no rights/interest vesting in the same.

- 4.6 According to the Complainant, the Respondent acquired the Disputed Domain Name for the sole purpose of misleading consumers, blocking the Complainant's rights in the trademark and domain name 'UDACITY', or reselling the Disputed Domain Name to the Complainant. The Complainant argues that the Respondent's registration of the Disputed Domain Name was direct response by the Respondent to the Complainant's creation and use of the coined term 'UDACITY'. The Complainant argues that the Respondent had actual knowledge of the Complainant's rights in the mark 'UDACITY' as demonstrated by the Respondent's registration of the Disputed Domain Name within a week of the Complainant's public launch of its website at <UDACITY.COM>. The Complainant claims that the Respondent was very well aware of the Complainant's presence and its trademark 'UDACITY'.
- 4.7 The Complainant's states that a reverse WHOIS lookup identifies 950 domain names currently registered in connection with the Respondent's email address i.e. himeme@foxmail.com. Out of these 950 domain names, 925 domain names are '.in' domain names. The Complainant argues that the exorbitant number of domain names that the Respondent has registered demonstrates that the Respondent has engaged in a clear pattern of the registering domain names in bad faith. The Respondent claims that he was not aware of the Complainant before the registration of the Disputed Domain Name nor intend to sell the Disputed Domain Name to anybody. The Respondent states that he did not contact the Complainant to sell the Disputed Domain Name. The Respondent tried to justify registration of many domain names as other Domain Investor like Baidu.com, Alibaba.com and Google.com.

5. Discussion and Findings

5.1 According to the Policy, the Complainant must prove that:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered or is being used in bad faith.

5.2 Identical or Confusingly Similar

5.2.1 The Respondent does not dispute the prior use of the mark 'UDACITY' and registration of <UDACITY.COM> by Complainant. However, the Respondent emphasize on the fact that the Complainant has no exclusive trademark rights in the India and other countries before the time of the Registration of the Disputed Domain Name. The Arbitrator agrees with the current consensus view¹ that if the complainant

¹ See WIPO Overview of WIPO Panel View on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), I.1 and cascs cited therein.



owns a trademark, then it generally satisfies the threshold requirement of having trademark rights. The location of trademark, its date or registration are all irrelevant for the purpose of finding rights in a trademark under the first elements. The Arbitrator also agrees with the current consensus view² that registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity. Like the Uniform Domain Name Dispute Resolution Policy (UDRP), the INDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights. The Arbitrator finds that the Complainant has trademark rights in the mark 'UDACITY'.

5.2.2 The Disputed Domain Name <UDACITY.CO.IN> incorporated the Complainant's trademark 'UDACITY' in its entirety without any other word or letter. It is well-established in various decisions under the UDRP and INDRP that the presence or absence of spaces, punctuation marks between words or indicators for Top Level Domains, such as '.com', '.us', '.in', 'co.in' etc., are irrelevant to the consideration of identity or confusing similarity between a trademark and a disputed domain name. The 'co.in' suffixes should not be taken into account while comparing the Complainant's trademark 'UDACITY' and the Disputed Domain Name. The Arbitrator, therefore, finds that the Disputed Domain Name <UDACITY.CO.IN> is identical to the Complainant's trademark 'UDACITY'.

5.3. Rights or Legitimate Interests

5.3.1 The Complainant asserts that it has not authorised or licensed the Respondent to use the trademark 'UDACITY'. It is therefore for the Respondent to show that he comes within one of the situations envisaged by paragraph 7 of the INDRP, or that there exists some other basis on which to find his rights or legitimate interests to the Disputed Domain Name.

5.3.2 The Respondent is not commonly known by the Disputed Domain Name nor conducted legitimate business under such name. At the time of filing the Complaint, the Disputed Domain Name does not resolve to any website. The Disputed Domain Name is being passively held since its registration. The Respondent had filed no evidence as to substantiating use of the Disputed Domain Name for novelties search and shopping in the city. The Respondent's argument that hosting a coming soon page is the common practice of a startup while the website is under development and it indicates that the Respondent has been prepared and used the Disputed Domain Name reasonably, is completely misplaced in this case and not amount to demonstrable preparations to use of the Disputed Domain Name. Consequently, the Arbitrator concludes that the Respondent has no rights or legitimate interests in the Disputed Domain Name <UDACITY.CO.IN>.

5.4 Registered and Used in Bad Faith

The Respondent has undoubtedly registered the Disputed Domain Name after the Complainant's registration of domain name <UDACITY.COM> and use of the trademark

² See WIPO Overview of WIPO Panel View on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), 1.4 and case cited therein.



'UDACITY' in trade and commerce. Hence, the Complainant is clearly a prior user of the trademark 'UDACITY'. The Arbitrator has already found that the Disputed Domain Name is identical to the trademark 'UDACITY' in which the Complainant has rights. Any use of the Disputed Domain Name will suggest at the very least an endorsement of, or affiliation with, the Respondent's services by Complainant. Such circumstances amount to registration and use in bad faith.³ The Disputed Domain Name is being held passively by Respondent, which under the circumstances discussed amounts to bad faith use⁴. Accordingly, the Arbitrator finds on balance that the Respondent has registered and is using the Disputed Domain Name in bad faith.

6. Decision

In light of the foregoing findings, namely, that the Disputed Domain Name is identical to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and that the Disputed Domain Name was registered in bad faith in accordance with the Policy and the Rules; the Arbitrator orders that the Disputed Domain Name <UDACITY.CO.IN> be transferred to the Complainant.



Dipak G. Parmar
Sole Arbitrator

Date: November 6, 2015

³ See *The Royal Bank of Scotland Group plc, Coutts & Co. National Westminster Bank plc v. Domain Manager / yoyo.email / Giovanni Laporta*, WIPO Case No. D2014-0825

⁴ See *Airbus SAS, Airbus Operations GmbH v. Alesini Pablo Hernan / PrivacyProtect.org*, WIPO Case No. D2013-2059