

ADMINISTRATIVE PANEL DECISION

Autodesk, Inc. v. hai qing cai, caihai qing
Case No. D2023-0740

1. The Parties

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

The Respondent is hai qing cai, caihai qing, China.

2. The Domain Name and Registrar

The disputed domain name <revitblocks.com> is registered with GMO Internet, Inc. d/b/a Discount Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2023. On February 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 21, 2023, 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.

On February 22, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On February 22, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that 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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on February 28, 2023. In accordance with paragraph 5 of the Rules, the due date for Response was March 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 21, 2023.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on March 30, 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant sells licenses all over the world and on every continent for its various software products that incorporate the REVIT trademarks (the “REVIT Marks” or “REVIT Mark”) into their names. There are over 9,000,000 users of the Complainant’s products. To accommodate this enormous user base, the Complainant 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 REVIT Marks into their names.

The Complainant is the owner of the globally registered REVIT Marks including the United States Trademark Nos. 2565790 (registered by the Complainant’s predecessor in interest on April 30, 2002, and assigned to the Complainant on June 3, 2002), 4919621 (registered on March 15, 2016) and 5261364 (registered on August 8, 2017), Chinese Trademark No. 4418919 (registered on August 21, 2007), European Union Trade Mark No. 002144129 (registered on August 6, 2002) and Canadian Trademark No. TMA715562 (registered on May 30, 2008).

Since 2002, the Complainant has owned the domain name <revit.com> and used it as a portal to webpages in its official website where Autodesk markets its software products that have the REVIT Marks incorporated into their names.

The disputed domain name was registered on October 19, 2022. The disputed domain name resolves to a commercial website with a landing page displaying a myriad of gambling and pornographic content and advertisements.

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

The addition of a generic Top-Level Domain (“gTLD”) such as “.com” is irrelevant to the analysis of identicalness or confusing similarity under paragraph 4(a)(i) of the Policy. The Second Level Domain “revitblocks” consists of the registered REVIT Mark plus the word “blocks”. Incorporating the Complainant’s registered REVIT Mark into the disputed domain name is sufficient without anything more to establish that the disputed domain name is confusingly similar to the registered REVIT Mark for purposes of the Policy.

The Complainant has never authorized the Respondent to incorporate the REVIT Mark into the disputed domain name or use the REVIT Mark in connection with any other activity. The Complainant is not affiliated with and has never endorsed or sponsored the Respondent. The Respondent had actual or constructive knowledge of the Complainant’s exclusive REVIT Mark rights when the Respondent registered the disputed domain name. The Respondent registered and has been using the disputed domain name simply because, with the confusing similarity between the REVIT Mark and the disputed domain name, the Respondent is able to trick consumers looking for information on the Complainant and/or its software products into unwittingly visiting the website with pornographic content where the Respondent earns income, if not from those consumers directly, then from the many advertisements therein. No evidence suggests that the Respondent has ever been called by any name incorporating the REVIT Mark or been “commonly known” by the REVIT Mark or the Second Level Domain “revitblocks”. This is demonstrated by the fact that neither the Whois record for the disputed domain name, nor the content of the website mentions the REVIT Mark.

There is a strong likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the website to which the disputed domain name resolves. The Respondent offered the links to pornographic content via the website to which the disputed domain name resolves, presumably for commercial gain. The confusing similarity between the disputed domain name and the Complainant's REVIT Mark and the pornographic nature of the website, with its "tarnishing" capacity, are in combination sufficient to conclude that the disputed domain name was registered and has been used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, in the absence of an agreement between the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests that the proceeding be held in the English language with the reason that the ".gmo Domain Name Registration Policies" are written in English. However, the policies referred by the Complainant are not the Registration Agreement for the disputed domain name, but the policies governing the operation of the new gTLD ".gmo" offered by GMO Registry. As the Registrar confirmed, the language of the Registration Agreement for the disputed domain name is Japanese.

Although the Respondent has not expressly agreed with the Complainant on the language of the proceeding, the Respondent did not submit any objection to the Complainant's request that the proceeding be held in the English language when the Center sent the notification regarding the language of the proceeding to the Parties by email both in English and Japanese. In addition, the Center formally notified the Respondent in English and Japanese of the Complaint. Accordingly, also considering that the Respondent resides in China, where English is more popular than Japanese, and even assuming that the Respondent is conversant in Japanese, the necessity for conducting the proceeding in Japanese would not justify the costs of translation and delay.

In view of these circumstances of the administrative proceeding, the Panel decides that English should be the language of the proceeding.

6.2 Substantive Elements of the Policy

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (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

The Panel confirms that the REVIT Marks are globally registered and maintained by the Complainant.

Generally, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a

finding of confusing similarity under the first element in paragraph 4(a) of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)). The Complainant’s REVIT Mark is entirely reproduced in the disputed domain names and the addition of the term “blocks” does not prevent a finding of confusing similarity between the disputed domain names and the REVIT Mark (see *LEGO Juris A/S v. Ashley Core, Green Path Solutions and Noah Beauvais, Green Path Solutions*, WIPO Case No. [D2019-2267](#)).

The gTLD “.com” may be disregarded for the assessment of confusing similarity under the first element in paragraph 4(a) of the Policy (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In light of the above, the disputed domain name should be considered confusingly similar to the Complainant’s REVIT Marks, and thus, the first element in paragraph 4(a) of Policy is satisfied.

B. Rights or Legitimate Interests

As the Complainant asserts, the Respondent has never been called or commonly known by any name incorporating the REVIT Mark. Further, the Complainant has neither authorized the Respondent to incorporate the REVIT Mark into the disputed domain name, nor endorsed or sponsored the Respondent. Thus, it is clear that no *bona fide* or legitimate use of the disputed domain name could be claimed by the Respondent (see *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Moreover, the use of the disputed domain name which resolves to a website with a landing page displaying a myriad of gambling and pornographic content and advertisements cannot constitute a *bona fide* offering of goods and services (see *Autodesk, Inc. v. Shao Juan Huang*, WIPO Case No. [D2020-2156](#)). Rather, the content of the website resolved from the disputed domain name indicates the Respondent’s intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s REVIT Marks.

As a result, the Complainant has satisfied its burden of providing sufficient evidence to make a *prima facie* case showing that the Respondent lacks rights to or legitimate interests in the disputed domain name, and the Respondent has failed to produce any evidence to establish rights or legitimate interests in the disputed domain name.

Therefore, the Panel holds that the second element of paragraph 4(a) of the Policy is fulfilled.

C. Registered and Used in Bad Faith

The Complainant’s REVIT Marks are well known in the field of a building information modelling software tool. Thus, it is difficult to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant’s REVIT Marks at the time of the registration of the disputed domain name (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On November 14, 2022, the Complainant sent a takedown notice regarding the disputed domain name to the Registrar, and it is presumed that the notice was forwarded by the Registrar to the Respondent, but no response has been received from the Respondent. The Respondent still uses the disputed domain name to resolve to a commercial website with gambling and pornographic content and advertisements. The Respondent is considered to be intentionally attempting to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant’s REVIT Marks pursuant to paragraph 4(b)(iv) of the Policy and/or to tarnish the Complainant’s REVIT Marks (see section 3.12 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel concludes that the disputed domain name has been registered and used by the Respondent in bad faith and the third element of paragraph 4(a) of the Policy has been proved.

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 <revitblocks.com> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: April 13, 2023