

## **ADMINISTRATIVE PANEL DECISION**

UpGrad Education Private Limited v. Dr Shailesh Chaube  
Case No. D2023-1183

### **1. The Parties**

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

The Respondent is Dr Shailesh Chaube, India.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2023. On March 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 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 March 17, 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 March 18, 2023.

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 March 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2023. The Center received informal emails from the Respondent on March 21, 2023.

The Center appointed Maninder Singh as the sole panelist in this matter on April 12, 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.

On April 19, 2023, the Complainant submitted unsolicited supplemental filings to the Center in reply to the Respondent's informal emails.

#### **4. Factual Background**

The Complainant, Upgrad Education Private Limited, is a company incorporated under the laws of India. It is a Learning Tech Company. It claims to have a learner base of over 3 million across 50 countries, over 300 University partners, and a business with a client base of over 658 companies. It offers undergraduate courses, campus & job linked programmes, study abroad courses, short form to executive programmes, and degrees, Masters, and Doctoral. The Complainant also claims to be India's largest online higher education company with the highest gross revenue in the Indian market. The Complainant adopted and commenced the use of the UPGRAD trade mark in March 2015. The Complainant has registered and applied for numerous trademarks consisting of the term UPGRAD in India in connection with its goods and services (see, e.g., India Application No. 2985062, applied for on June 15, 2015, and valid until June 15, 2025). The domain name <upgrad.com> is also registered in favour of the Complainant. Complainant is also the owner of numerous domain names consisting of the UPGRAD trade mark such as <upgrad.co>, <upgrad.info>, <upgrad.net>, and <upgrad.org>.

The disputed domain name was registered on August 28, 2021. Evidence submitted by the Complainant shows that the Disputed Domain Name resolved to an active website, which also offered educational services and included links to another website.

#### **5. Parties' Contentions**

##### **A. Complainant**

- The Complainant claims to have coined, adopted, and started using the mark UPGRAD in 2015. The Complainant is the registered and lawful proprietor of the mark UPGRAD in India in various classes. The Complainant further claims that the Complainant has also been actively enforcing its rights in the mark UPGRAD and has devoted significant resources to protect its trade mark rights and goodwill.
- One of the annexures to the Complaint [Annexure 6] shows that the Complainant had registered the domain name <upgrad.com> on December 28, 2001, and operates its website "www.upgrad.com" and as noticed above, started using the domain name from 2015.
- The Complainant, over the years, claims to have invested substantial expenditure in promoting and advertising the mark UPGRAD and/or the services provided thereunder. The Complainant also claims to have prominent social media presence, on various social media platforms viz. Facebook, YouTube, LinkedIn, and Twitter. The Complainant also claims that over the years, it has also received an extensive media coverage from time to time.

Contentions of the Complainant regarding the disputed domain name being identical or confusingly similar to the Trademark or Service Mark of the Complainant:

- The Complainant contends that the disputed domain name is identical to the Complainant's UPGRAD Mark. The disputed domain name contains the Complainant's trademark UPGRAD in its entirety.
- The Complainant further contends that the only difference between the Complainant's UPGRAD trademark and the disputed domain name is the ".education" suffix. The Complainant contends that since the primary business of the Complainant is in the education industry, it does not carry any distinctiveness.

Contentions regarding the Respondent having no rights or legitimate interests in the disputed domain name:

- The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name resolves to an active webpage offering educational services. The Respondent neither holds any rights in the trademark UPGRAD nor is known to be associated with it.
- The Complainant further contends that 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 UPGRAD Mark 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 contends that the Respondent intended to register the Complainant's UPGRAD Mark deliberately and preemptively as a domain name and thereafter, intentionally attempted to attract, confuse, and profit from Internet users seeking the Complainant's products and services who unintentionally and inadvertently search for the Complainant's trade mark UPGRAD with the term "education", as the Complainant primarily provides education services. The Respondent, therefore, does not have any legitimate rights and interests in the disputed domain name.
- 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 arises no justification on part of the Respondent to purchase and/or use this UPGRAD Mark.

Contentions regarding bad faith registration and use of the disputed domain name by the Respondent:

- The Complainant contends that 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 of causing a likelihood of confusion as to source, sponsorship, affiliation or endorsement of the website to which the disputed domain name is pointed thus showcasing the Respondent's bad faith.
- The Complainant contends that given the Complainant's renown and goodwill worldwide and particularly its popularity and trademark rights well established in India, it would be inconceivable that the Respondent did not have knowledge of the Complainant's UPGRAD Mark at the time of registration in 2021 and thus, the registration of the disputed domain name amounts to registration in bad faith.
- The Complainant further contends that the Respondent registered/acquired the disputed domain name on August 28, 2021, with an intention to take advantage of the users who search for the trade mark UPGRAD along with the term "education" for commercial gain and creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website, and thus bad faith is implicit in the registration of the disputed domain name.
- The Complainant contends that the disputed domain name, which is identical to the Complainant's UPGRAD Mark, is currently being used by the Respondent to point to a website promoting a similar service. Thus, it is clear that the disputed domain name is being used for the sole purpose of misdirecting Internet users, who may be seeking the Complainant's website, to an unrelated website that offers identical services.
- The Complainant contends that the Respondent has registered the disputed domain name primarily to disrupt the business of the Complainant. The Respondent offers identical services as of the

Complainant and is, admittedly, engaged in services that compete. The Respondent has caused actual disruption in its business by preemptively registering the dispute domain name and causing a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website by the Complainant and taking unfair advantage of the Complainant's rights. Consumers looking for education services and visiting the website of the Respondent will be misled and confused by thinking that the Respondent's website in fact belongs to or is affiliated with the Complainant.

- The Respondent has registered the disputed domain name with a privacy shield service to hide its identity and prevent the Complainants from contacting it. Usage of privacy shield services indicates bad faith registration.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. However, vide an e-mail dated March 21, 2023, the Respondent has stated that he is an authorized channel partner for upgrad education doing business with them from February 5<sup>th</sup>, 2021. He has further stated that the disputed domain name was freely available and was taken by him by paying due service charges for the same.

## **6. Discussion and Findings**

### **6.1. Procedural Issues: Unsolicited Supplemental Filings**

Paragraph 10 of the UDRP Rules vests the Panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition. Further, paragraph 12 of the UDRP Rules expressly provides that it is for the Panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case. Accordingly, unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. See [WIPO Overview 3.0](#), section 4.6.

The Panel has reviewed the Complainant's unsolicited Supplemental Filing of April 19, 2023, and will admit it into consideration in light of the fact that the Respondent's informal emails raised into consideration new evidence regarding the Respondent's alleged "authorized channel partner" agreement, to which the Complainant's unsolicited Supplemental Filing addresses in response.

### **6.2. Substantive Merits**

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

- The Panel finds that the Complainant has trade mark rights in the mark UPGRAD, by virtue of its many trade mark registrations in different classes. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.1. The Panel is also satisfied that the disputed domain name is identical to the Complainant's UPGRAD trade mark. See, [WIPO Overview 3.0](#), section 1.7. The generic Top-Level Domain ("gTLD") ".education" can be disregarded as a standard technical registration requirement and thus does not prevent confusing similarity. See, [WIPO Overview 3.0](#), section 1.11.1.
- The Complainant has therefore succeeded in establishing the first element of the test in paragraph 4(a) of the Policy

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

- The second element requires the Complainant to make a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

- The Panel observes that the Complainant has made out a case proving its rights in the trademark UPGRAD. The Complainant enjoys goodwill and reputation for the marks registered by it. The Panel has no doubt that the disputed domain name incorporates the well known and famous trademark UPGRAD of the Complainant, adding only the gTLD “.education” to it. The Panel finds that due to the composition of the disputed domain name, particularly the relevance of the gTLD to the educational services rendered by the Complainant, the disputed domain name carries a direct inference to the Complainant that cannot constitute fair use.
- The Panel observes that the Respondent in its response merely stated that he is a channel partner of the Upgrad Education.
- The Panel has taken note of the additional submissions made by the Complainant in its unsolicited Supplemental Filing of April 19, 2023. The attention of the Panel has been drawn to the “Oki Data Test” laid down in the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), contending that there is no fair right use available to the Respondent in the facts and circumstances of the present case and also having regard to the prohibition contained in the Agreement between the Complainant and the Respondent [Annexure FS1], described as Channel Partner Agreement, and also the fact that the Respondent having created a hyperlink on the disputed domain name to another website. Thus, the Oki Data Test does not apply in this case.
- The Panel observes that the Respondent, through the disputed domain name is misdirecting Internet users, who may be seeking the Complainant’s website, to an unrelated website that offers identical services. Such an attempt on the part of the Respondent is to create confusion and to cash on/ride over the name, goodwill and reputation of the Complainant. The Panel agrees with contention of the Complainant that the Respondent has breached the terms of the Channel Partner Agreement entered into between the Complainant and the Respondent.
- In the facts and circumstances of the present case, the Panel accepts and agrees that the Respondent has not proved any *bona fide* use of the disputed domain name as he has failed to submit any appropriate and proper response to the contentions made by the Complainant.
- The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

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

- Under the third element, the Complainant is required to establish that the disputed domain name has been registered and is being used in bad faith by the Respondent.
- The Panel observes that the disputed domain name is identical to the Complainant’s trademark UPGRAD. The Respondent’s use of the mark UPGRAD in the disputed domain name is a violation of the Complainant’s UPGRAD trademark. The Panel also observes that the Respondent cannot have any rights or legitimate interests in the disputed domain name.
- The Panel observes that in fact the Respondent had executed a Channel Partner Agreement [Annexure FS1] filed with the Complainant containing therein a prohibition against violating the intellectual property rights of the Complainant in the domain name in question. It was, therefore, not permissible for the Respondent to register the disputed domain name.
- The Panel agrees with the Complainant’s contention that the disputed domain name is being used for the sole purpose of misdirecting Internet users, who may be seeking the Complainant’s website, to an unrelated website that offers identical services. Such use of the Domain Name to misdirect Internet users for commercial gain is considered as strong evidence of bad faith in accordance with paragraph 4(b)(iv) of the Policy. The Panel in this regard, relies on decision of the Centre in *State of Wisconsin v. Pro-Life Domains, Inc.*, WIPO Case No. [D2003-0432](#), holding that using a party’s name to redirect

Internet users to an unrelated commercial site for profit is recognized under the Policy as evidence of bad faith registration and use.

- The Panel, therefore, finds that the disputed domain name was registered and being used in bad faith by the Respondent.

## **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.education>, be transferred to the Complainant.

*/Maninder Singh/*

**Maninder Singh**

Sole Panelist

Date: April 26, 2023