

ADMINISTRATIVE PANEL DECISION

Autodesk, Inc. v. hai qing cai, caihai qing
Case No. D2023-1277

1. The Parties

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

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

2. The Domain Name and Registrar

The disputed domain name <revitcadservice.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 March 23, 2023. On March 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 27, 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 March 27, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On March 27, 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 the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on April 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 25, 2023.

The Center appointed Keiji Kondo as the sole panelist in this matter on May 4, 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 is a US-based corporation with its principal place of business in the State of California. The Complainant is the owner of the trademarks AUTOCAD and REVIT (hereinafter collectively referred to as the “Marks”), and it has continually used the Marks in commerce since at least 1984. The Complainant sells licenses for its various software products with their names incorporating the Marks. There are over 9,000,000 users of the Complainant’s products.

On January 29, 1985, the United States Patent and Trademark Office (“USPTO”) granted US registration number 1316773 covering use of the trademark AUTOCAD to the Complainant. On April 30, 2002, the USPTO granted US registration number 2565790 covering the trademark REVIT to the Complainant’s predecessor-in-interest as concerning said registration. That registration was assigned to the Complainant via written agreement effective June 3, 2002. On March 15, 2016, the USPTO granted US registration number 4919621 covering additional use of the trademark REVIT to the Complainant. On August 8, 2017, the USPTO granted to the Complainant US registration number 5261364, covering another use of the trademark REVIT.

The disputed domain name, <revitcadservice.com>, was registered on May 27, 2022. The disputed domain name resolves to a commercial website with a landing page displaying gambling- and pornography-related advertisements.

On June 27, 2022, the Complainant sent correspondence regarding the disputed domain name and the Respondent’s website to the Respondent. The Respondent did not respond.

5. Parties’ Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Marks.

The addition of a generic Top-Level Domain (“gTLD”) such as “.com” is irrelevant to analysis of identicalness or confusing similarity under paragraph 4(a)(i) of the Policy. Here the relevant inquiry is whether the disputed domain name is confusingly similar to the Marks. The disputed domain name consists of REVIT and CAD, plus the word “service.” Incorporating a complainant’s registered trademark into a disputed domain name is sufficient without anything more to establish that the domain name is confusingly similar to said registered trademark for purposes of the Policy. When taking into consideration that both REVIT and CAD are combined into the disputed domain name, the entire disputed domain name clearly is confusingly similar to the Marks.

Moreover, the disputed domain name consists only of the generic suffix “service” appended to the Marks. The confusingly similar inquiry thus depends on the relative distinctiveness of the Mark and the non-Mark element in the disputed domain name, and whether the non-Mark element (*i.e.*, “service”) detracts from or contradicts the Mark’s function as an origin indicator. *Philip Morris USA Inc. v. n/a*, WIPO Case No. [D2004-0462](#). Where the incorporated trademark enjoys a high degree of inherent distinctiveness reinforced by longstanding international recognition so as to amount to a famous mark (which is the case with the Marks), and where the non-Mark element is a generic word or phrase that does nothing to dispel the connection in the public’s mind between the trademark and the complainant, paragraph 4(a)(i) of the Policy is satisfied. Here, the non-Mark element “service” only reinforces the connection in the public’s mind between the Marks and the Complainant’s providing of products and corresponding services in connection

with the Marks, which is why the Respondent included the term in the disputed domain name. The disputed domain name in its entirety is therefore confusingly similar to the Marks, and the Complainant has satisfied paragraph 4(a)(i) of the Policy.

The Respondent has no right or legitimate interest in the disputed domain name.

The second element the Complainant must establish is that the Respondent has no right or legitimate interest in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy. The Complainant must merely make a *prima facie* showing of this element to shift the burden to the Respondent to produce conclusive evidence to the contrary. *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). The Respondent is better situated to adduce specific knowledge of rights or interests it may have in the disputed domain name.

The Complainant is the exclusive owner of all rights in and to the Marks in several jurisdictions around the world. The Complainant has never authorized the Respondent, nor anyone else, to incorporate the Marks into a domain name or use the Marks in connection with any other activity. Certainly, the Complainant has never authorized anyone, the Respondent included, to use the Marks in connection with any pornography content.

The Complainant is not affiliated with, and has never endorsed or sponsored, the Respondent or the Respondent's business. Therefore, the Respondent has no basis to argue that it has any right or legitimate interest in the disputed domain name.

The Respondent knew or should have known of the Complainant's exclusive rights to the Marks when the Respondent registered the disputed domain name. This dispute concerns world-famous marks (*i.e.*, the Marks) used by the Complainant around the globe for nearly two decades. Neither the Marks nor the disputed domain name have any meaning except as name and source indicators of some of the Complainant's products, services, and events. Any story that the Respondent may spin in trying to prove its alleged unawareness of the Complainant's rights to the Marks when the Respondent registered the disputed domain name would not be believable. The Respondent conspicuously registered the disputed domain name several years after the Complainant began obtaining registrations covering the Marks and many years after the Complainant registered and began using its very similar <revit.com> and <autocad.com> domain names as a portal to the Complainant's official website. Consequently, the Respondent had notice of this dispute when the Respondent registered the disputed domain name and cannot prove any right or legitimate interest in the disputed domain name under paragraph 4(c)(i) of the Policy.

This conclusion is amply reinforced by the fact that the Respondent knowingly chose to register the disputed domain name consisting of nothing more than the Mark with the word "service" in an obvious attempt to divert traffic from the Complainant's official website found at <revit.com> and <autocad.com> domain names and towards the Respondent's Website for the purpose of commercial gain.

The Respondent has not used the disputed domain name in connection with a *bona fide* or legitimate offering of goods.

The Respondent cannot establish any right or legitimate interest in the disputed domain name under paragraph 4(c)(i) or 4(c)(iii) of the Policy because the Respondent has never used the disputed domain name in connection with a *bona fide* or legitimate offering of goods or services. Instead, the Respondent registered and has been using the disputed domain name simply because, with the confusing similarity between the Marks and the disputed domain name, the Respondent is able to trick consumers looking for information on the Complainant's software products into unwittingly visiting the Respondent's website where the Respondent earns income, if not from those consumers directly, then from the many, glaring gambling ads and other advertisements therein.

The use of a disputed domain name for a nefarious purpose is not a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy. See *Autodesk, Inc. v. zhang jie*, WIPO Case No. [D2019-1583](#) ("there

has been no evidence adduced showing Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services” based on the use of the disputed domain name for distributing pornography content); *Autodesk, Inc. v. Milo Kram*, WIPO Case No. [D2016-1779](#) (WIPO) (the respondent could not demonstrate any right or legitimate interest in the disputed domain name being used to distribute unauthorized copies of Autodesk’s software products); *Autodesk, Inc. v. Shao Juan Huang*, WIPO Case No. [D2020-2156](#) (“[t]he Panel agrees ... that such use of the Disputed Domain Name [for a website with pornography content and gambling advertisements] does not constitute a *bona fide* offering of goods and services”). As stated plainly in *Milan Presse v. See Privacyguardian.Org / Home, Maxim Antonov*, WIPO Case No. [D2019-0640](#): “Respondent’s website features pornography. The posting of pornographic content at a website through use of a domain name confusingly similar to another’s trademark is not a legitimate use of the Domain Name.” This logic applies squarely here and proves that the Respondent has no right or legitimate interest in the disputed domain name and no basis to utilize paragraph 4(c)(i) of the Policy to prove otherwise.

Respondent has never been commonly known by the disputed domain name.

“What paragraph 4(c)(ii) envisages is a situation where a person or business is commonly known ... prior to registration of the disputed domain name.” *Paule Ka v. Paula Korenek*, WIPO Case No. [D2003-0453](#). Further, “the registration and use of the disputed domain name, in connection with the Respondent’s website, does not by itself support a conclusion that the Respondent was commonly known by the domain name”. *Yakka Pty Ltd. v. Mr. Paul Steinberg*, WIPO Case No. [D2004-0502](#).

No evidence suggests the Respondent has ever been called by any name incorporating the Marks or been “commonly known” by the Marks or the disputed domain name. This is demonstrated by the fact that neither the WHOIS record for the disputed domain name nor the content of the Respondent’s website mentions the Marks.

The Respondent’s commercial use of the Marks do not create any right or legitimate interest in the disputed domain name in the Respondent’s favor.

Paragraph 4(c)(iii) of the Policy allows a respondent to claim a right or legitimate interest in a domain name by demonstrating that it has been “making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”. Not only is the Respondent precluded from utilizing paragraph 4(c)(iii) of the Policy because the Respondent’s association of the disputed domain name with the website with pornography content is not a “legitimate ... or fair use”, but paragraph 4(c)(iii) of the Policy is further unavailable to the Respondent because Respondent’s only use of the disputed domain name has been for the website through which the Respondent reaps profits from users and/or the gambling advertisements. As a matter of well settled UDRP law, such commercial use of a domain name renders paragraph 4(c)(iii) of the Policy inapplicable to the Respondent. See *Autodesk, Inc. v. zhangjie*, WIPO Case No. [D2019-1583](#) (“[t]here has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the disputed domain name ... [because] the website, currently resolved by the disputed domain name, is a website with porn pictures”).

The Respondent registered and is using the disputed domain name in bad faith.

The Complainant must satisfy paragraph 4(a)(iii) of the Policy by showing that the Respondent registered and is using the disputed domain name in bad faith. Paragraph 4(b) of the Policy enumerates non-exclusive situations in which the Panel must make a bad faith finding against the Respondent for its registration and use of the disputed domain name. Here, by applying several relevant factors, it “is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate”. *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Respondent’s bad faith is established by the fame of the Marks.

“A finding of bad faith may be made where the Respondent ‘knew or should have known’ of the registration and use of the trademark prior to registering the domain name”. *Façonnable SAS v. Names4sale*, WIPO Case No. [D2001-1365](#). In other words, “registration of a well-known trademark as a domain name is a clear indication of bad faith in itself, even without considering other elements”. *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#); See also *Autodesk, Inc. v. Shao Juan Huang*, WIPO Case No. [D2020-2156](#) (applying expressly that conclusion in finding bad faith and registration and use). Such is the case with the Respondent’s registration of the disputed domain name many years after the Complainant began obtaining its registered and common law rights in the Marks. See *Autodesk, Inc. v. Private Registration (name)*, WIPO Case No. [D2011-1986](#). On the record presented it would be implausible for the Respondent to assert that it registered the disputed domain name in good faith and without knowledge of the Complainant’s rights to the Marks.

The Respondent has used the disputed domain name in bad faith with the intention to attract, for commercial gain, users to the Respondent’s website.

A registrant’s use of a domain name in which the registrant has no right or legitimate interest for the purpose of pursuing an illegal or nefarious activity constitutes bad faith registration and use under the Policy as a matter of law. *Prada, S.A. v. Michael Faronston*, WIPO Case No. [D2006-0585](#). The specific facts underlying this proceeding have already been addressed by previous Panels finding bad faith registration and use on the same record. For example, in *Autodesk, Inc. v. zhang jie*, WIPO Case No. [D2019-1583](#), concerning that respondent’s posting online of pornography content via the domain name <autodeskmakedonija.com>, the Panel concluded: “Given the reputation of the AUTODESK marks, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to the fact. 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. In other words, Respondent has through the use of a confusingly similar disputed domain name created a likelihood of confusion with the AUTODESK marks. Moreover, as mentioned above, Respondent offered the links to pornographic content via the website to which the disputed domain name resolves, presumably for commercial gain. The Panel therefore concludes that the disputed domain name was registered and is being used by Respondent in bad faith. Such use of the disputed domain name is also disruptive in relation to the interests of Complainant (see *Sbarro Franchise Co., LLC v. Kouwenbin*, WIPO Case No. [D2019-0884](#)).”

The same record was also presented in *Autodesk, Inc. v. Shao Juan Huang*, WIPO Case No. [D2020-2156](#), regarding the disputed domain name <autocad96.com>. In finding bad faith registration and use, that Panel held: (a) “it is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name is confusingly similar to the Complainant’s AUTOCAD trademark, and that the website to which the Disputed Domain Name resolves contains obscene content and hyperlinks to third party gambling and pornography-related websites”; and (b) “any use of the Disputed Domain Name would likely mislead Internet users into believing the Disputed Domain Name is associated with the Complainant, particularly given that the Disputed Domain Name is almost identical to the Complainant’s domain name <autocad.com> and the website to which the Disputed Domain Name resolves does not contain any disclaimer language”.

The present case is identical to the *Autodesk, Inc. v. zhang jie*, supra and *Autodesk, Inc. v. Shao Juan Huang*, supra proceedings as to whether the disputed domain name has been registered and used in bad faith. The disputed domain name consists only of the Complainant’s trademarks plus the generic suffix “service”, the affiliated pornography website serves pornographic content and gambling advertisements to the public that tarnish the Marks and damage the Complainant’s goodwill therein, and the Respondent profits from the pornography website. As the Panel reasoned in *VIVENDI v. Guseva Svetlana*, WIPO Case No. [D2018-2631](#): “It is not necessary for the Respondent’s conduct to fall precisely within any of the examples of bad faith registration and use which are set out at paragraph 4(b) of the Policy. These are only examples, and do not limit the circumstances which might constitute bad faith registration and use. In this case, the confusing similarity between the disputed domain name and the Complainant’s trademark, and the pornographic nature of the website, with its ‘tarnishing’ capacity, are in combination sufficient for the Panel to conclude that the disputed domain name was registered, and has been used, in bad faith. The Respondent

cannot escape the required conclusion that the Respondent both registered and is using the disputed domain name in bad faith, and the Complainant has therefore satisfied paragraph 4(a)(iii) of the Policy.”

The Respondent’s registration of the disputed domain name, so obviously connected with the Complainant, proves opportunistic bad faith.

Panels have recognized that a bad faith registration and use finding is necessary where a domain name “is so obviously connected with such a well-known product that its very use by someone with no connection to the product suggests opportunistic bad faith”. *Go Daddy Software, Inc. v. Internet Masters*, WIPO Case No. [D2002-0570](#); See also *RapidShare AG, Christian Schmidt v. PrivacyProtect.org, Domain Admin n/a Sergey Malgov*, WIPO Case No. [D2010-0608](#). Panels have easily reached this conclusion regarding other respondents’ unauthorized incorporation of the Mark into disputed domain names. See, e.g., *Autodesk, Inc. v. Domain Admin / Whois Privacy Corp.*, WIPO Case No. [D2016-2063](#) (regarding the disputed domain name <autocadfree.org>, the panel found bad faith registration and use in part because “incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be an indication of bad faith”). The same circumstances exist here and require a finding that the Respondent registered and is using the disputed domain name 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

The Complaint was filed in English. The Registrar has informed the Center that the language of the Registration Agreement for the disputed domain name is Japanese. In its Complaint, the Complainant requests that the language of the proceeding be English.

On March 27, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On March 27, 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.

Considering the following circumstances, the Panel, exercising its authority to determine the language of the proceeding under paragraph 11(a) of the Rules, has decided English as the language of the proceeding:

- the Complaint was filed in English;
- the Complainant is a US entity, and represented by a US law firm;
- the Respondent’s address is in China;
- the disputed domain name comprises an English word “service”;
- the Respondent’s website is written in Chinese, but not in Japanese;
- the Complainant has submitted its request that English be the language of the proceeding, but the Respondent did not comment on the language of the proceeding;
- the Respondent did not reply to the Complainant’s contentions in any manner; and
- ordering the translation of the Complaint would only result in extra delay of the proceeding and additional cost for the Complainant.

6.2. Substantive Issues

A. Identical or Confusingly Similar

The first element functions primarily as a standing requirement. In this case, the disputed domain name consists of “revit”, “cad”, “service”, and the gTLD “.com”. The Complainant has US trademark registrations for the trademark REVIT, which is incorporated into the disputed domain name in its entirety.

The Complainant additionally alleges that the disputed domain name is confusingly similar also to the Complainant’s trademark AUTOCAD because it incorporates “cad”. However, “cad” may be recognized as acronym of “computer-aided design”, and incorporation of “cad” into the disputed domain name would not necessarily make the disputed domain name confusingly similar to AUTOCAD.

Regardless of whether “cad” is recognized as acronym of “computer-aided design”, or as part of the Complainant’s trademark AUTOCAD, addition of “cad” does not affect the confusing similarity of the disputed domain name to the Complainant’s trademark REVIT. The addition of the term “service” does not affect the finding of confusing similarity, either. It is well-established that the gTLD “.com” is not relevant in the appreciation of confusing similarity.

In this proceeding, the fact that the Complainant’s trademark REVIT is recognizable in the disputed domain name is sufficient for the Complainant to satisfy the standing requirement. Since only the first element is concerned here, the Panel, at this stage, refrains from discussing whether addition of “cad” may strengthen the Complainant’s case from the viewpoints of other elements to be considered under the Policy, and will revisit the issue in relation to the third element, that is, bad faith registration and use.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark REVIT within the meaning of paragraph 4(a)(i) of the Policy.

Accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Respondent’s name is in no way similar to the disputed domain name, nor is it similar to the Complainant’s trademark REVIT. In addition, when the Complainant sent correspondence regarding the disputed domain name to the Respondent, the Respondent did not respond. Had the Respondent been commonly known by the disputed domain name, or by the Complainant’s trademark REVIT, it should have been easy for the Respondent to respond. Therefore, the Panel finds that the Respondent has never been commonly known by the disputed domain name or the Complainant’s trademark.

The disputed domain name resolves to a commercial website with a landing page displaying gambling- and pornography-related advertisements. Such a use is obviously a commercial use, and does not fall into the category of legitimate noncommercial or fair use.

As will be discussed with respect to the third element, the Respondent uses the disputed domain name in bad faith, and, therefore, the Respondent cannot be regarded as using the disputed domain name for *bona fide* offering of goods or services.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Complainant's trademark REVIT does not have a dictionary meaning. The first registration of the Complainant's trademark REVIT in US was granted in 2002, about twenty years before the Respondent registered the disputed domain name.

The Complainant is a multinational software corporation that makes software products and services for a wide range of industries including architecture, engineering, construction, and manufacturing. Without knowledge of the Complainant's business, however, no one would have any reason to combine the Complainant's trademark REVIT and the terms "cad" and "services". Therefore, even if "cad" is the acronym of "computer-aided design", but may not be a part of the Complainant's trademark AUTOCAD, when the Respondent registered the disputed domain name, which combines "revit", "cad" and services, in 2022, the Respondent should have known not only the Complainant's trademark REVIT, but also the Complainant's business.

Internet users interested in software products and services for architecture, engineering, construction, and manufacturing would easily associate the disputed domain name with the Complainant and its business. Therefore, the disputed domain name would easily attract the attention of Internet users and mislead them to the Respondent's website, through which the Respondent gains commercial gain by advertising gambling and pornographic content. The Respondent should have intentionally chosen the disputed domain name to cause such confusion.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Accordingly, paragraph 4(a)(iii) of the Policy is satisfied.

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, <revitcadservice.com> be transferred to the Complainant.

/Keiji Kondo/

Keiji Kondo

Sole Panelist

Date: May 18, 2023