

ADMINISTRATIVE PANEL DECISION

Uber Technologies, Inc. v. john smith
Case No. D2024-2976

1. The Parties

Complainant is Uber Technologies, Inc., United States of America (“United States” or “U.S.”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

Respondent is john smith, United States.

2. The Domain Name and Registrar

The disputed domain names <gfeuber.com>, <ubergfe.com> (the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 23, 2024. On July 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 23, 2024, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

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 Respondent of the Complaint, and the proceedings commenced on July 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 16, 2024.

The Center appointed John C. McElwaine as the sole panelist in this matter on August 28, 2024. 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

Complainant is a global technology company founded in 2009 that operates a platform connecting consumers with independent drivers for ridesharing services, as well as with restaurants and other businesses for delivery services.

Complainant owns numerous trademark registrations for the UBER trademark worldwide, including:

- U.S. Registration No. 3,977,893 for UBER, registered on June 14, 2011;
- International Registration No. 1,111,203 for UBER, registered on December 13, 2011;

Collectively, these trademark rights are referred to as the "UBER Mark". Complainant also owns and uses the domain name <uber.com>, which was created on July 14, 1995, and acquired by Complainant no later than January 4, 2011.

The Domain Names were registered on August 15, 2016 (<ubergfe.com>) and December 9, 2021 (<gfeuber.com>) and both link to an active website.

5. Parties' Contentions

A. Complainant

By way of background, Complainant is the operator of several well-known mobile applications for ridesharing and delivery services and is a public company traded on the New York Stock Exchange since May 2019 and the S&P 500 since December 2023. Complainant asserts that as of December 31, 2023, Complainant had operations in over 10,000 cities worldwide, approximately 30,400 employees globally, 150 million monthly active platform consumers, and annual revenue of \$37.281 billion.

Regarding the first element, Complainant asserts that the Domain Names incorporate its UBER Mark in its entirety, with the addition of the term "gfe" (an acronym for "girlfriend experience," which is associated with escort services). Complainant argues that this addition does not prevent a finding of confusing similarity under the Policy.

Concerning the second element, Complainant states that it has not authorized Respondent to use the UBER Mark or register domain names incorporating the mark. Complainant alleges that Respondent is using the Domain Names for websites containing pornographic content and promoting escort services, which Complainant argues cannot constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use.

As for the third element, Complainant contends that Respondent registered and is using the Domain Names in bad faith. Complainant points to Respondent's use of the Domain Names for websites offering escort services, which Complainant argues intentionally trades on the goodwill of its famous UBER Mark to attract Internet users for commercial gain. Complainant also notes that Respondent previously used a stylized version of the UBER Mark identical to Complainant's own stylized UBER Mark, further evidencing bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Although Respondent defaulted, to succeed in this proceeding, paragraph 4(a) of the Policy requires Complainant to prove its assertions with evidence demonstrating:

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

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kasso Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); and see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows:

A. Identical or Confusingly Similar

The Panel finds that Complainant has established rights in the UBER Mark through its numerous trademark registrations worldwide in the UBER Mark.

As stated in section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy.

The Domain Names incorporate Complainant's UBER Mark in its entirety, with the addition of the term "gfe" either before or after the mark. As noted in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element. The Panel finds that the UBER Mark is clearly recognizable within both Domain Names.

Therefore, the Panel concludes that the Domain Names are confusingly similar to Complainant's UBER Mark, and Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make a prima facie case that Respondent lacks rights or legitimate interests in the Domain Names, after which the burden of production shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests. See section 2.1 of the [WIPO Overview 3.0](#).

Here, Complainant has stated that it has not licensed or otherwise authorized Respondent to use its UBER Mark or to register domain names incorporating the mark. Likewise, there is no evidence that Respondent has been commonly known by the Domain Names or that Respondent has acquired any trademark rights in the term "uber", "gfeuber", or "ubergfe".

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Names. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy¹ or otherwise.

¹ The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name: "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired

Complainant also asserts that the Domain Names resolved to a website that displayed pornographic content and advertised escort services, which may be illegal. With no apparent connection between the term “uber” and such content, the Panel concludes that Respondent has not demonstrated a legitimate interest in the Domain Names, which contain the UBER Mark. See, *VKR Holding A/S v. 甄晶鑫 (jing xin zhe)*, WIPO Case No. [D2020-0352](#) (finding that a webpage displaying advertising for gambling and pornography websites not to be a bona fide offering of goods or services within the meaning of paragraph 4(c)(iii) of the Policy); *Unilabs AB v. Domain Administrator*, See *PrivacyGuardian.org / Xian Xing Hao*, WIPO Case No. [D2019-2599](#) (finding no rights or legitimate interests where respondent is using the domain name for commercial gambling and pornography site with no apparent connection to the Domain Name); *Hartsfield Area Transportation Management Association, Inc. v. Max Davidovich*, WIPO Case No. [D2006-0743](#) (finding no legitimate use by respondent of a domain name confusingly similar to the complainant’s mark that had links to pornography and gambling websites, alien to the business of the complainant, with the consequential tarnishing of the complainant’s trade name and service mark).

In addition, as Complainant asserts, the use of a domain name for pornographic content containing a third party trademark does not present a plausible defense of fair use. See, *William Hill Organization Limited v. Netmax Multimedia*, WIPO Case No. [D2001-0455](#) (“it is unacceptable use of a domain name when a Respondent associates Complainant’s trademark with pornography against its wishes.”); *Nintendo of America Inc. v. Baltic Consultants Limited*, WIPO Case No. [D2002-0449](#) (finding use of the domain name was for distinctly commercial purposes, namely, for the marketing of pornography or gambling, or both, and said use was not bona fide).

In sum, Complainant has made a prima facie showing of Respondent’s lack of rights or legitimate interests in the Domain Names and Respondent has failed to come forward to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent’s default as it considers appropriate. For all these reasons, the Panel accepts that the second element of the Policy is established by Complainant, and Respondent has no rights or legitimate interests in respect of the Domain Name, under the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent “knew or should have known” of a complainant’s trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). As discussed herein, Respondent registered the Domain Names long after Complainant established trademark rights in its well-known UBER Mark.

Based on Complainant’s submission, which was not rebutted by Respondent, it is likely that Respondent knew of Complainant’s UBER Mark when it registered the Domain Names. See *WhatsApp Inc. v. Francisco Costa*, WIPO Case No. [D2015-0909](#) (finding that “it is likely improbable that Respondent did not know about Complainant’s WHATSAPP trademark at the time it registered the Disputed Domain Name considering the worldwide renown it has acquired amongst mobile applications, and the impressive number of users it has gathered since the launch of the WhatsApp services in 2009”.) Panels have recognized that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

no trademark or service mark rights; or (iii) you are 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.”

It is not disputed that Respondent linked the Domain Names to a website displaying pornographic content. Although “uber” may have meaning in the English lexicon, there is nothing on Respondent’s webpage that indicates any meaning that the Domain Names might have other than as a reference to Complainant’s UBER Mark. In fact Respondent previously used a stylized version of the UBER designation on its website that was identical to a stylized version of the UBER Mark used by Complainant. Prior panel decisions have consistently recognized such registration and use of a domain name constitutes evidence of bad faith under Policy 4(a)(iii). *Daybreak Game Company LLC v. Lv Guo Ping*, WIPO Case No. [D2018-1935](#) (“the Panel has no hesitation in finding that the disputed domain name [...] was registered in bad faith and is being used in bad faith. The current advertisements for online gambling and pornography on the site disputed domain name resolves to establish Respondent is making a commercial gain from the site by attracting users to generate click through revenue”); *Valvoline Licensing and Intellectual Property LLC v. Andrei Arhipov*, WIPO Case No. [D2017-2453](#) (“The fact that the website at the disputed domain name provides adult sexually explicit content with pornography elements is a clear indication that the domain name has been registered and used in bad faith.”). Given the whole incorporation of Complainant’s UBER Mark in the Domain Name and the lack of any apparent connection between the term “uber” and the content of the website to which the Domain Names redirect, there can be no other reasonable explanation for Respondent to have chosen to register the Domain Names other than to intentionally trade off the goodwill and reputation of Complainant’s trademark or otherwise create a false association with Complainant. With no response from Respondent, this claim is undisputed nor is the decision to register and use the Domain Names justified.

As detailed above, the Panel finds on the record before it that Respondent’s intention in registering and using the Domain Names was to attract, for commercial gain, Internet users to Respondent’s website by creating a likelihood of confusion with the UBER Mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Names in bad faith under paragraph 4(a)(iii) of the Policy.

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 Domain Names <gfeuber.com> and <ubergfe.com> be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: September 9, 2024