

ADMINISTRATIVE PANEL DECISION

Autodesk, Inc. v. Mohammad Saeed Rezaee
Case No. DIR2022-0009

1. The Parties

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

The Respondent is Mohammad Saeed Rezaee, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <auto-desk.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 20, 2022. On June 1, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On June 2, 2022, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details that were the same as in the Complaint.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 15, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was July 5, 2022. On July 6, 2022, the Center notified the Respondent’s default.

The Center appointed Luca Barbero as the sole panelist in this matter on July 13, 2022. 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 United States corporation that creates and provides software products and services for the architecture, engineering, construction, manufacturing, media, education, and entertainment industries.

The Complainant was founded in 1982 by John Walker, who was a co-author of the first versions of the Complainant's AutoCAD computer-aided design software, primarily used by architects, engineers and structural designers to design, draft and model buildings and other structures.

The Complainant sells licenses all over the world and on every continent for its software products under the trademark AUTODESK, which are used by over 9 million users.

The Complainant is the owner of several trademark registrations for AUTODESK, including the United States trademark registration No. 1316772 for AUTODESK (word mark), filed on April 9, 1984, and registered on January 29, 1985, in international class 9.

The Complainant is also the owner of the domain name <autodesk.com> which was registered on August 3, 1989, and is used by the Complainant to advertise and offer for sale its AUTODESK software products.

The disputed domain name <auto-desk.ir> was registered on January 5, 2020, and, according to the Panel's verifications from Italy, is pointed to a website published at the domain name <autodeskiran.ir>, the content of which cannot be accessed due to limitations set in the visitors' IP addresses. According to the screenshots submitted by the Complainant - which have not been challenged by the Respondent - the disputed domain name was previously pointed to a website offering software licenses and stating that "Autodesk Iran is the only reference available to provide and use the unique services of Autodesk in Iran, which includes a wide network of suppliers around the world".

5. Parties' Contentions

A. Complainant

The Complainant contends that disputed domain name is identical to the trademark AUTODESK in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of a hyphen between the words "auto" and "desk" and the country code Top-Level Domain ("ccTLD") ".ir".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that it has never authorized the Respondent to incorporate the trademark into the disputed domain name or to use the trademark on the correspondent website.

The Complainant also contends that it is in no way affiliated with, and has never endorsed or sponsored, the Respondent and asserts that the Respondent's unauthorized use of the trademark, and the creation of a false association with the Complainant, cannot be considered a *bona fide* offering of goods or services.

The Complainant further highlights that, considering the Respondent registered the disputed domain name more than 35 years after the Complainant registered its trademark AUTODESK and more than 3 decades after the Complainant registered and began using its corporate domain name <autodesk.com>, the Respondent knew or should have known the Complainant at the time of registering the disputed domain name.

Moreover, the Complainant states the Respondent is also not commonly known by the disputed domain name and cannot demonstrate it has been making a legitimate noncommercial or fair use of the domain name, without the intent for commercial gain, to misleadingly divert consumers or to tarnish the trademark or service mark at issue, since the Respondent has been using the disputed domain name for commercial reasons to misleadingly divert consumers looking for the Complainant or its software products.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent's registration of the disputed domain name decades after the Complainant began obtaining its registered and common law rights in the trademark is in itself evidence of bad faith registration and use of the disputed domain name.

The Complainant emphasizes that, considering the disputed domain name consists of a minor variation of the Complainant's trademark, there is no basis for the Respondent to assert that it registered the disputed domain name in good faith and without knowledge of the Complainant's trademark rights.

The Complainant submits that the Respondent intentionally attempted to attract for commercial gain Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of either the Respondent or the Respondent's website.

Indeed, in view of the Complainant, the Respondent blatantly capitalizes on the fame and the goodwill in the trademark AUTODESK by intentionally exploiting consumers who may be led to mistakenly believe that the Complainant is somehow affiliated with and/or has endorsed the Respondent's website.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark AUTODESK based on the trademark registration cited under section 4 above.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")¹, the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel finds that the disputed domain name is confusingly similar to the trademark AUTODESK as it reproduces the trademark in its entirety with the mere addition of a hyphen between the words "auto" and "desk" and the ccTLD ".ir", which can be disregarded when comparing the similarities between a domain name and a trademark. See, along these lines, sections 1.8 and 1.11.1 of the [WIPO Overview 3.0](#).

¹ In view of the substantive similarities between the Policy and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel has referred to [WIPO Overview 3.0](#), where appropriate.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

Furthermore, there is no indication before the Panel that the Respondent might have made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without the intent to misleadingly divert consumers or to tarnish the Complainant's trademark.

Indeed, the disputed domain name is currently pointed to a webpage, published at the domain name <autodeskiran.ir>, the content of which is restricted. In addition, according to the documents and statements submitted by the Complainant, the disputed domain name was pointed to a website where the Respondent offered software licenses and indicated to be an official supplier of the Complainant's products in Iran (Islamic Republic of), suggesting an affiliation with the Complainant that, according to the Complainant, does not exist.

The Panel further finds that the disputed domain name, being substantially identical to the Complainant's trademark AUTODESK, carries a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered or is being used by the Respondent in bad faith.

The Panel finds that, in light of i) the prior registration and use of the Complainant's trademark AUTODESK in connection with the Complainant's software products, ii) the widely known character of such trademark in the field of software and iii) the substantial identity of the disputed domain name with the trademark AUTODESK, the Respondent very likely registered the disputed domain name having the Complainant's

trademarks in mind.

Moreover, as mentioned above, the disputed domain name has been pointed to a website offering software products and expressly mentioning to be an official supplier of the Complainant in Iran (Islamic Republic of). Whilst such indication is not true according to the Complainant's allegations – which have not been challenged by the Respondent –, it clearly confirms the Respondent's knowledge of the Complainant's trademark.

In view of the above-described use of the disputed domain name, the Panel also finds that the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has proven that the Respondent registered and has also been using the disputed domain name in bad faith according to 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 disputed domain name <auto-desk.ir> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: July 28, 2022