Decision for dispute CAC-UDRP-101252

Case number	CAC-UDRP-101252
Time of filing	2016-09-12 11:05:23
Domain names	upworkmarket.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	UPWORK INC.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	WHOISGUARD, INC., WHOISGUARD PROTECTED a/k/a SHARK FREELANCE LLC, ANTHONY KIMANI

IDENTIFICATION OF RIGHTS

The Complainant uses the domain name <upwork.com> which is connected to the official website of the Complainant, and is also the owner of two trademarks for the name UPWORK, namely the Benelux trademark No. 0974795 filed on February 25th, 2015, in classes 09, 35, 42 and the Icelandic trademark No. V0093956 filed on August 26th, 2014, in classes 09, 35, 36, 38, 41, 42.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, a major player in the field of online freelancing, is a company with its registered office located in Mountain View, California. The Complainant uses the domain name <upwork.com> and the trademark UPWORK to link companies and individuals with freelancers all around the world.

The Respondent registered the domain name <upworkmarket.com> on November 22nd , 2015. The disputed domain name currently resolves to a website which is a freelancing platform.

To begin with, the Complainant contends that the disputed domain name is confusingly similar to its UPWORK trademark as it incorporates the entirety of the said trademark, in association with the generic term “market”, which also describes the Complainant’s activity and therefore increases a likelihood of confusion.

The Complainant further alleges that the Respondent does not have any rights or legitimate interest in the disputed domain name as the Respondent offers directly competitive services on the website corresponding to the disputed domain name, which does not constitute a bona fide offering of goods and services or a noncommercial or fair use of the disputed domain name.

The Complainant also claims that the disputed domain name was registered and is being used in bad faith as the Respondent uses the disputed domain name to offer competitive services. Hence, the Complainant contends that the Respondent had actual knowledge of the Complainant's trademark at the time of registration of the disputed domain name which in turn, led the Respondent to register the disputed domain name anonymously.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interest in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name to have been registered and to be currently used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

After the present proceedings were initiated and upon standard request of verification by the Provider, the Registrar disclosed the identity of the actual registrant which originally registered the disputed domain name anonymously.

In its amended Complaint, the Complainant has named WHOISGUARD INC, WHOISGUARD PROTECTED / SHARK FREELANCE LLC, ANTHONY KIMANI as the Respondent due to the amended Complaint submission form not enabling the deletion of the initial Respondent's name: WHOISGUARD INC, WHOISGUARD PROTECTED.

The communications provided in the case file show that the Complainant and Anthony Kimani (on behalf of Shark Freelance LLC) discussed the disputed domain name after the Registrar disclosed the identity of the latter. Anthony Kimani also filed a Response to the Complaint which was not admitted in the present proceedings as it did not specifically respond to the statements and allegations listed in the Complaint nor did it include any and all bases for the domain name holder to retain registration and use of the disputed domain name.

As a result, the Panel will treat SHARK FREELANCE LLC, ANTHONY KIMANI as the sole Respondent (See e.g. Xtraplus Corporation v. Flawless Computers, WIPO Case No. D2007-0070, March 9th, 2007).

After filing the amended Complaint, the Complainant submitted as additional evidence, an email dated October 31st, 2016, in which the Respondent offered to transfer the disputed domain name to the Complainant in exchange for $100.000.

Under paragraph 10(d) of the Rules, the Panel shall discretionarily determine the admissibility, relevance, materiality and weight of any evidence. Many Panels have held that additional submissions are inappropriate except in the rarest of circumstances, such as discovery of evidence not reasonably available to the submitting party at the time of its initial submission, or arguments by the respondent that the complainant could not reasonably have anticipated (See e.g. Plaza Operating Partners, Ltd.; Document Technologies, Inc. v. International Electronic Communications, Inc., WIPO Case No.

D2000-0270, June 6, 2000).

In the present case, the Panel finds that the aforementioned submission by the Complainant is evidence previously unavailable that the Complainant could not have reasonably anticipated at the time of the filing of the amended Complaint. Consequently, the Panel has taken the abovementioned submission into consideration before rendering its decision.

Therefore, the Panel is satisfied that all procedural requirements under UDRP have been met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

I. As the respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate.

II. The Panel finds that the disputed domain name <upworkmarket.com> is confusingly similar to a trademark in which the Complainant has rights as the disputed domain name wholly incorporates the Complainant's distinctive trademark together with the descriptive and generic term "market" which directly relates to the Complainant's activity and therefore enhances the likelihood of confusion (See e.g. Cephalon Inc v. WhoisGuardService, AF 101174, Nat. Arb, Forum, April 1st, 2016). The Panel agrees with the well-established view under UDRP that generic Top-Level Domain (gTLD) extensions may typically be considered irrelevant in assessing confusing similarity between a trademark and a disputed domain name (See e.g. Boehringer Ingelheim International GmbH v. Ralf Zinc, WIPO case No. D2016-1236, August 1st, 2016) and considers the gTLD extension ".com" to be irrelevant in the present case.

III. The Panel is of the view that the Complainant has presented a clear prima facie showing of the Respondent's lack of rights or legitimate interest in the disputed domain name. As a result of the Respondent's default, the Respondent has failed to rebut that showing. Moreover, the Respondent cannot be considered to be making a bona fide offering of goods and services as within the meaning of paragraph 4(c)(i) of the Policy given that the disputed domain points to a website offering directly competitive services. Such use cannot be said to be a legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy. Furthermore, the Respondent did not provide the Panel with any evidence of being commonly known by the disputed domain name as referred to in paragraph 4(c)(ii) of the Policy (See e.g. CMC Markets UK Plc v. Domains BY Proxy LLC and Mohammad Shekh Sliman, AF 101282, Nat. Arb. Forum, October 7th, 2016).

IV. The Panel finds that the Respondent registered and used the disputed domain name in bad faith as the Respondent, by offering directly competitive services to those of the Complainant through the disputed domain name, has intentionally attempted to attract Internet users to the disputed domain name for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and of services on the Respondent's website (See e.g. Boehringer Ingelheim Pharma GmbH v. Ayma, AF 101231, Nat. Arb. Forum, July 26th, 2016). On that basis, the Panel considers that the initial concealment of identity of the owner of the disputed domain until the present proceedings is a subsidiary element indicating registration and use of the disputed domain name in bad faith by the Respondent (See e.g. Fifth Third Bancorp v. Secure Whois Information Service, WIPO Case No. D2006-0696, September 14th, 2006). Finally, the Panel agrees with the view that an offer to sell the domain name for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name is not only evidence of, but conclusively establishes that the domain name has been registered and is being used in bad faith (See e.g. CBS Broadcasting Inc v. Gaddoor Saidi, WIPO Case No. 2000-0243, June 2nd, 2000). The Panel therefore finds that the bid offer made by the Respondent to the Complainant is additional evidence of registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **UPWORKMARKET.COM**: Transferred

PANELLISTS

Name	Nathalie Dreyfus

DATE OF PANEL DECISION 2016-11-09

Publish the Decision