Decision for dispute CAC-UDRP-101660

Case number	**CAC-UDRP-101660**
Time of filing	**2017-11-29 11:17:50**
Domain names	**wpupwork.com**

Case administrator

Name	**Aneta Jelenová (Case admin)**

Complainant

Organization	**Upwork Inc.**

Complainant representative

Organization	**RiskIQ, Inc**

Respondent

Organization	**iFrux Technologies**

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

Various registered trademarks either comprising or incorporating the text UPWORK including United States Reg. trademark No. 5,237,481 in Classes 9, 35, 36, 38, 41, and 42 for the standard character mark UPWORK filed on February 23, 2015 and claiming a priority filing date of 26 August 2014 from an earlier Icelandic trademark.

FACTUAL BACKGROUND

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

Through its wholly-owned subsidiary, Complainant ("Upwork"), based in Silicon Valley with several offices across the United States and in Oslo, Norway, has connected approximately 13 million freelancers with over 5 million employers seeking on-demand talent. Providing companies with over 3,500 skills, millions of jobs are posted on Upwork's site via <upwork.com> annually, and freelancers annually earn more than a billion dollars through Upwork.

As of shortly before the disputed domain was created in December 2016, the Upwork site was already ranked as the 336th most popular website globally, 335th most popular in the United States, and 212th most popular site in India where Respondent resides.

Respondent offers various services of the sort covered by the Complainant’s trademark;, specifically providing online publications, chat and e-mail support services to operators of websites running on installations of WordPress, where tickets are submitted via a WP Upwork CRM dashboard for remote online workers to track their commissioned WP projects collaboratively with their WP clients through online messaging, display of recent activity by WP client, calendaring, bill payments, reports, invoices, milestones, expenses.

By incorporating Complainant's mark in the disputed domain name to offer services covered by, or highly related to Complainant's mark as described above, a class of prospective clients of Respondent are likely to mistakenly believe that Upwork is a party to the dealings with Respondent, supervising its work, and/or guaranteeing the quality, safety, or legality of its services, when that is not the case. Other prospective purchasers are likely to falsely believe at the very least, that the site has an affiliation with Complainant, or is sponsored or endorsed by Upwork. The site is also of poor quality with grammatical errors and inconsistencies, which is likely to tarnish the reputation of Complainant's mark.

Given the popularity of Complainant's trademark well before the disputed domain was created, it seems inconceivable based on the record, that Respondent registered the disputed domain name without prior knowledge of Complainant and its mark. In fact, Respondent's e-mail was used to log into Upwork this past summer using an account created in 2012. Further, it is unlikely Respondent was unaware the disputed domain name it chose could attract Internet users in a manner that is likely to create confusion for such users. Respondent's stylized WP UPWORK logo is even intended to closely mimic Complainant's stylized UPWORK logo both in terms of using script letters and substantially the same shade of green for the letters WP as Complainant uses for the UP portion of its logo. This suggests Respondent is likely using the domain name in bad-faith attempt to create confusion with Complainant's mark.

Complainant through its authorized agent, actually sent an e-mail to Respondent objecting to its registration and use of a confusingly similar domain name to the UPWORK mark in which Complainant asserted Respondent fully knows Upwork has established rights.

Complainant requested that Respondent confirm it would pick a new name and mark that does not include the UPWORK mark. Although an explanation by the Respondent was called for, not even a response was forthcoming.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 interests in respect of the disputed 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 disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has various registered trademarks comprising the term “Upwork”. The disputed domain name (the “Domain Name”) can reasonably be read as the term “upwork” combined with the term “wp” and the top level domain “.com”. Indeed, the Panel accepts given the subsequent use made of the Domain Name, that it was with this association in mind that the Domain Name was registered and has been used (as to the relevance of which see paragraph 1.15 of the WIPO Overview 3.0). The Complainant has, therefore, established that the Domain Name is confusingly similar to a trademark in which the Complainat has rights and has thereby made out the first element of the Policy.

Further, the Panel also accepts given the use made of the Domain Name has been registered and used in order to take unfair advantage of the Complainant’s mark, most likely by seeking to confuse internet users into believing that the Respondent’s website is associated with or authorised by the Complainant even though it is not. Key factors leading to that conclusion are the way that the logo used by the Respondent mimics that of the Complainant and the fact that Complainant promotes the services of Wordpress freelancers. This suggests that the Respondent has no rights or legitimate interests in the Domain Name and none has been asserted. The Panel therefore concludes that the Respondent has no rights or legitimate interest in the Domain Name. The Complainant has also thereby satisfactorily demonstrated to the Panel that the Domain Name has been registered and used in bad faith.

The Complainant has, therefore, made out the second and third elements of the Policy.

There is a complication in this case in that the Domain Name arguably incorporates the mark of another and that raises the question whether the Domain Name should be transferred or cancelled. The Complainant contends that this does not matter as the majority view is that in such a case transfer can take place. The Panel accepts that the Complainant’s contentions are partially consistent with paragraph 4.13 of the of the WIPO Overview 3.0. However, the Panel also suspects that there is real question as to whether this is right (as to which see the remarks in passing at paragraphs 6.29 to 6.31 of Fadaat Media Limited, Alaraby Aljadeed Limited, Rainbow Media SAL v. Zaki Moussa, Film Matters Ltd Case No. D2016-2073). It also notes that as, paragraph 4.13 of the of the WIPO Overview 3.0 recognises, in many cases panels faced with this issue have sought "some reasonable assurance of the third party’s non-objection" before ordering transfer.

Nevertheless, on the peculiar facts on this case and in particular bearing in mind that this other “mark” comprises only two letters and the Complainant has contended (and this has not been disputed) that it would be entitled to use any mark in any event, the Panel is prepared to order transfer, without the need to issue a procedural order in this respect.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **WPUPWORK.COM**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2018-01-13

Publish the Decision