Decision for dispute CAC-UDRP-102777

Case number	CAC-UDRP-102777
Time of filing	2019-11-22 10:53:53
Domain names	newupwork.com, newupwork.org, newupwork.net, newupwork.info

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Upwork Inc.
Organization	Upwork Global Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	Md Alamin

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is owner of the Trademark Word "UPWORK", BX Reg. No. 0974795, since 25.05.2015, valid until 2025 and various (25) national Word-Trademarks and the international Trademark Word "UPWORK" IR 1383791. First Registration of the Word-Trademark "UPWORK" was in ICELAND 26.08.2014.

Further the Complainant is owner of domain name upwork.com

FACTUAL BACKGROUND

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

The Complainant is a major player in the field of online freelancing, linking companies and individuals. The Complainant is a company with its registered office located in Mountain View, California, USA. The Complainant uses the company name Upwork Inc., the domain name <upwork.com> and the word trademark "UPWORK" registered before the Respondent registered the disputed domain name. Upwork Inc. (hereinafter referred to as Complainant) is the proprietor of the Upwork trademarks. The Complainant uses his domain name to connect to a website through which it informs potential customers

about its UPWORK mark and its services.

The Respondent from Bangladesh registered the domain name <newupwork.com> in 2019. Then in the same year he registered the domain names <newupwork.Org>, <newupwork.net> and <newupwork.info>. The disputed domain names currently resolves to a website which is a freelancing platform. The Respondent used a hidden name, organized by a provider in Panama (registrant).

To begin with, the Complainant contends that the first 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 “new” as prefix, which also describes the Complainant’s activity and therefore increases a likelihood of confusion.
The same arguments the Complainant presented concerning Respondents later registered disputed domain names <newupwork.org>, <newupwork.net> and <newupwork.info>.

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

The Complainant also claims that the disputed domain names were registered and are being used in bad faith as the Respondent uses the disputed domain names 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 names which in turn, led the Respondent to register the disputed domain names anonymously.

SCHEDULE OF CITATIONS provided by the Complainant:

FN1 E.g., Upwork Inc. and Upwork Global Inc. v. Anupam Kumar, CAC Case No. 102511 (transferring <upworkskills.com> to Complainant Upwork Inc.) (July 16, 2019), archived at https://perma.cc/ Upwork Global Inc., Upwork Inc. v. Imran khan, All Education info. et al., WIPO Case No. D2017-1104 (July 23, 2017) (ordering <allupworktestanswers.com> be transferred to Upwork Inc. in a joint complaint filed by Complainants), archived at https://perma.cc/

FN2 E.g., Bayer AG v. Cagri Savan, WIPO Case No. D2015-1573 (Oct. 26, 2015), https://perma.cc/

FN3 E.g., Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Nat. Arb. Forum, July 31, 2000), archived at https://perma.cc/

FN4 E.g., CAC Case No. 102511 (cited above); Upwork Inc. v. Anh Nguyen, CAC Case No. 101367 (Jan. 1, 2017), archived at https://perma.cc/ Upwork Inc. / Upwork Global Inc. v. Brian Benedict, CAC Case No. 101370 (Jan. 27, 2017) (finding both registered trademark rights and common law rights in UPWORK by virtue of "overwhelming" extent of use of the mark as part of its re-branding, whereby by May 2015, the mark was already being used in relation to the provision of services to users numbering in the multi-millions), https://perma.cc/ Upwork, Inc. v. Abwebtech c/o Satish Kumar, INDRP/899 (June 27, 2017) (ordering <upworktest.in> to be transferred to Upwork, Inc., (decision available from the .IN registry, automatically downloadable from https://perma.cc/ WIPO Case No. D2017-1104, <allupworktestanswers.com> ("The Complainant Upwork Inc. has registered trademark rights in UPWORK. Its wholly owned subsidiary, Upwork Global Inc. is licensed by its parent to use that mark. Accordingly, both Complainants have rights in the UPWORK mark."), available at https://perma.cc/

FN5 CAC Case Nos. 100832, Cephalon, Inc. v. Wuxi Yilian LLC a/k/a Gracia Elmandero et al. (Oct. 21, 2014) (<provigilmodafinilforsale.com>), available at https://perma.cc/ Teva Respiratory, LLC v. Health Matrix Direct, Inc. (2015-09-23) (proairdiscountcard.com), available at https://perma.cc/

FN6 Cf. Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc, WIPO Case No. D2017-0481 (May 8, 2017) (finding bad-faith, and on the same facts, rejecting claim to legitimate interests where the logical inference that the Domains were chosen for their value in suggesting an association with the complainant, or otherwise to attract persons seeking complainant), archived at https://perma.cc/

FN8 Chevron Intellectual Property LLC v. Fred Wallace, FA1506001626022 (Forum July 27, 2015) (finding that the respondent was not commonly known by the <chevron-europe.com> domain name under Policy paragraph 4(c)(ii), as the WHOIS information named “Fred Wallace” as registrant of the disputed domain name)

FN9 Pfizer Inc. v. Ubrokerage inc, WIPO Case No. D2015-1927, <sayanapress.com> (cited by WIPO Overview 3.0, para. 2.5.3) ("Use of the [Domain]in connection with a website addressing women's health issues (and containing advertising) would take unfair advantage of Complainant's...marks, which are used by Complainant in the women's health field in connection with a women's contraceptive product. Thus, Respondent's claimed purpose for the Domain..., which is identical to the name of Complainant's ...product, is either a pretext or would result in bad faith use.")

FN10 Segway Inc. v. Domains By Proxy, LLC / Arthur Andreasyan, NIM, WIPO Case No. D2016-0725 (June 23, 2016).

FN11 E.g., CAC Case No. 102088

FN12 CAC Case No. 102323 (finding that the disclaimer itself shows that the Respondent was well-aware of the Complainant's rights); CAC Case No. 101388 (finding that even if the disclaimer were seen and read, it is not clear that the product is not licensed or otherwise approved by the trademark holder).

FN13 Google LLC v. Nidhi Rao, Claim No. FA1803001779544 (May 8, 2018) (internal citations omitted), available at https://perma.cc/

FN14 Avast Software s. r. o. v. Victor Chernyshov, CAC Case No. 101568 (internal citations omitted)

FN15 Target Brands, Inc. v. Bobby Henderson, Claim No. FA1109001408381 (Oct. 24, 2011) (internal citations omitted), https://perma.cc/

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLAINT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have 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 was founded in 2014, called Upwork Inc. The Complainant seeks to create economic opportunities with an online marketplace (https://www.upwork.com). In 2018 the total dollar value transacted through Complainants platform was $1.8 billion. More than 30% of Fortune 500 companies were using the services of the Complainant. The Complainant is therefore a well known company in the world.

The Complainant showed evidence of having elder Trademark Rights in the Word-Mark UPWORK for Purposes of the First Element of the Policy than the Respondent registered his four disputed domain names.

The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name NEWUPWORK.com. These references create the impression that the Respondent is the Complainant or is somehow affiliated with the Complainant. See as an example the CAC Case No. 102292 or WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following:
“In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”.

The same reasoning should apply in the current case and the three other disputed domain names should be considered as confusingly similar to the trademark UPWORK because the suffix .org, .net and .info are top-level suffix and therefore to be disregarded as well.

The four disputed domains incorporate the entirety of the UPWORK mark, adding only the descriptive term, "new" as prefix. "Adding such generic and descriptive terms do not distinguish the [Domain] from the Complainant’s trademark", CAC Case Nos. 100832, Cephalon, Inc. v. Wuxi Yilian LLC a/k/a Gracia Elmandero et al. (Oct. 21, 2014) (<provigilmodafinilforsale.com>), available at https://perma.cc/ Teva Respiratory, LLC v. Health Matrix Direct, Inc. (2015-09-23) (proairdiscountcard.com), available at https://perma.cc/

Panels have found that domain names identical to a complainant’s trademark "carry a high risk of implied affiliation" [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) § 2.5.1.
In this instance, not only is Respondent not commonly known by the Domain as evidenced by the registrar verification, eg. Chevron Intellectual Property LLC v. Fred Wallace, FA1506001626022 (Forum July 27, 2015) (finding that the respondent was not commonly known by the <chevron-europe.com> domain name under Policy § 4(c)(ii), as the WHOIS information named “Fred Wallace” as registrant of the disputed domain name, but Upwork has not authorised, licensed, or otherwise permitted Respondent to use the mark for a competitive site.

Use of a domain to sell products and/or services that compete directly with a complainant's business does not constitute a bona fide offering of goods or services pursuant to Policy § 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy § 4(c)(iii); it does not alleviate the misleading nature of Respondent's use of the domain name, eg. Google LLC v. Nidhi Rao, Claim No. FA1803001779544 (May 8, 2018) (internal citations omitted), available at https://perma.cc/

Respondent is attempting to create confusion as to Complainant's affiliation with the Domain and resolving website for his own commercial gain. Respondent's registration and use of the Domain to profit from Internet user confusion is evidence of bad faith registration and use, eg. Avast Software s. r. o. v. Victor Chernyshov, CAC Case No. 101568 (internal citations omitted); Target Brands, Inc. v. Bobby Henderson, Claim No. FA1109001408381 (Oct. 24, 2011) (internal citations omitted), https://perma.cc/

Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and CAC Case no. 102292 USA-NOVARTIS.com.

Furthermore, the Respondent was using a hidden identity. But this argument is not to be discussed further because bad faith is evident during registration and use, whatsoever.

Accordingly, the Panel finds that the disputed domain names were both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NEWUPWORK.COM**: Transferred
2. **NEWUPWORK.ORG**: Transferred
3. **NEWUPWORK.NET**: Transferred
4. **NEWUPWORK.INFO**: Transferred

PANELLISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2020-01-22

Publish the Decision