Decision for dispute CAC-UDRP-103379

Case number	CAC-UDRP-103379
Time of filing	2020-11-03 14:55:58
Domain names	upworksolution.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Upwork Inc.

Complainant representative

Organization	RiskIQ, Inc. - Incident, Investigation and Intelligence (i3), Jonathan Matkowsky

Respondent

Organization	upworkSolution

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has documented to be the owner of numerous registrations for the UPWORK mark.
The Complainant is, inter alia, the owner of the following trademarks:
• United States trademark registration no. 5237481 “UPWORK” registered on July 4, 2017;
• United Arab Emirates trademark registration no. 229783 “UPWORK” registered on September 3, 2015.
The Complainant is also the holder of the domain <upwork.com>.

FACTUAL BACKGROUND

The Complainant is a leading online provider of talent solutions to transform traditional staffing. It empowers businesses with more flexible access to quality talent, on demand. For the year ended December 31, 2019, the Complainant’s gross services volume was $2.1 billion, with more than 30% of Fortune 500 companies using its services across more than 180 countries.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that the disputed domain name is confusingly similar to the Complainant's registered trademark; that the Respondent has no rights or legitimate interests whatsoever with respect to the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant's claims for each point are here below reported:
(1) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The disputed domain name <upworksolution.com> reproduces the Complainant's UPWORK trademark in its entirety with the sole addition of the generic term "solution", thus the Complainant's UPWORK trademark is undoubtedly recognizable within the disputed domain name, and the addition of the descriptive term "solution", which is particularly relevant to the Complainant's business, does not prevent a finding of confusing similarity under the first element.

The Complainant concludes that the disputed domain name is confusingly similar to the prior registered trademark in which the Complainant has rights in satisfaction of paragraph 4(a)(i) of the Policy.

(2) The Respondent has no rights or legitimate interests in respect of the domain name;

The Respondent has no rights or legitimate interests in respect of the disputed domain name because it was registered and is being used for the sole purpose of a fraudulent scheme masquerading as Upwork (i.e. the Complainant).

In support of this assertion the Complainant has argued that a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner, and that the Respondent's use of the Complainant's brand, stylized logos, and color scheme at the resolving website is overwhelming evidence that the Respondent is seeking to fraudulently masquerade as the Complainant to deceive people visiting the site for the Respondent's illegitimate gain.

The Respondent's registration and use of the disputed domain name to profit from Internet user confusion is evidence of bad faith registration and use pursuant to Policy paragraph 4(b)(iv).

The mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Respondent is not an authorized dealer of the Complainant's nor has it ever been authorized by the Complainant to use the UPWORK trademark in the disputed domain name.

The Respondent registered the disputed domain name in December 2019, several years after the UPWORK trademark became widely known.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of thedisputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

(3) Holder of the disputed domain name registers and uses the disputed domain name in bad faith.

The Respondent is certainly aware of the Complainant's rights because the stylized Upwork logo displayed on the Respondent's website is taken from the Complainant's brand assets, literally right down to the color scheme.

The Respondent registered and is using the disputed domain name in bad faith, masquerading as the Complainant, which disrupts the Complainant's business and creates a threat that Internet users will divulge their personal data to the Respondent in the mistaken belief that they are communicating with the Complainant.

The Respondent was aware of the trademark use guidelines for Upwork and accepted them as part of registering and

continuing to use the Complainant's platform at the time that it registered the disputed domain name, in direct contravention of such guidelines it accepted.

The Complainant's representative was not able to find any actual entity called "Upwork", "Upwork Solution", or "UpworkSolution" when searching licenses issued in the UAE either in the Unified Commercial Registration System - Ministry of Economy by business name, or by trade name search in the Department of Economic Development - Abu Dhabi. This supports the argument that no entity exists at the false address provided in the registrar verification response.

The Respondent's use of a proxy to register the disputed domain name, masking the identity of a non-existent entity, supports the argument of bad-faith registration and use.

In light of the above, the Complainant concluded that the disputed domain name was registered and is being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy.

RESPONDENT:
In a very short response the Respondent contends that:

• The disputed domain name is its own property and any resemblance with the UPWORK mark is not prohibited;
• It has removed the UPWORK logo from its website; and
• It is willing to sell the disputed domain name for a good offer.

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

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name registered by the Respondent be transferred to the Complainant:
1) the domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the domain name; and
3) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar
The Complainant has established that it has rights in the UPWORK registered trademark.

The disputed domain name <upworksolution.com> reproduces the Complainant's UPWORK trademark in its entirety with the addition of the term “solution”.
The Panel agrees with the Complainant’s assertion that the addition of the descriptive term “solution”, which is closely linked to and associated with the Complainant’s business activity, does not prevent confusing similarity.
The Complainant has, to the satisfaction of the Panel, shown that 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).

B. Rights or Legitimate Interests
Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain name. Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:
a) that before any notice to the respondent of the dispute, he or she used or made 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;
b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that the respondent is making a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.
The Respondent has no connection or affiliation with Complainant, which has not licensed or otherwise authorized the Respondent to use or apply for any domain name incorporating the Complainant’s trademark. The Respondent does not appear to make any legitimate use of the domain name for non-commercial activities. On the contrary it appears that the Respondent has registered and used the disputed domain name to mislead internet consumers for its own commercial gain. In addition, the Respondent has failed to argue, still less show, any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name in accordance with the UDRP Policy.
Accordingly, the Panel finds that Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith
For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder’s documented out-of-pocket costs directly related to the domain name; or
ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder’s web site or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the holder’s web site or location or of a product or service on the holder’s web site or location.

Accordingly, for a Complainant to succeed, the Panel must be satisfied that the domain name has been registered and is being used in bad faith.

The Panel, on the basis of the evidence presented, accepts and agrees with the Complainant’s contentions that the disputed domain name was registered in bad faith and has been used in bad faith.

Particularly relevant are the Complainant’s unchallenged assertions (which the Panel accepts and partially reports below) that:

the Respondent offered to sell the disputed domain name to the Complainant for an amount exceeding out-of-pocket expenses;

the Respondent was aware of Complainant's trademark rights and activity at the time it registered the disputed domain name and nevertheless went ahead and registered it;

the Respondent has taken active steps to conceal its true identity. In fact not only has it used a privacy shield registration service for the disputed domain name, but it also appears, from the case file, that it has given the privacy shield company an incorrect or at least not updated address. While the use of a privacy or proxy registration service is not in and of itself an indication of bad faith, it is the Panel's opinion that in the present case the use of a privacy shield, combined with the elements previously discussed, amounts to a further inference of bad faith registration and use.

Finally, in its short response, the Respondent has not denied the bad faith allegations concerning the registration and use of the disputed domain name (nor the allegations of providing a false address) made by the Complainant in this proceeding. Indeed, it has limited its response to denying the confusing similarity between the disputed domain name and the Complainant's trademark, and to seeking to make a "good" profit by selling the disputed domain name to the Complainant.

It is the Panel's opinion that all of the above has shown the Respondent's bad faith registration and use of the disputed domain name, which clearly falls within the example given in paragraph 4 of the Policy.

Considering the foregoing, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraphs 4(a)(i) and 4(a)(iv) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UPWORKSOLUTION.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2020-12-23

Publish the Decision