Decision for dispute CAC-UDRP-103412

Case number	CAC-UDRP-103412
Time of filing	2021-01-20 08:57:38
Domain names	upworkpakistan.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Upwork Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky, VP, Digital Risk - Incident Investigation and Intelligence (i3)

Respondent

Name	Muhammad Saad

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

In this proceeding, the Complainant relies on a large number of various “UPWORK” trademarks listing them all in a separate annex, including inter alia:

- the Benelux trademark “UPWORK” (word) No. 974795, registered on May 18, 2015;

- the Pakistani “UPWORK” trademark (word) No. 381888, registered on February 23, 2015; and

- the US “UPWORK” trademark (word) No. 5,237,481, registered on July 4, 2017.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is headquartered in Santa Clara, California, with an office in Chicago as well as team members in more than 800 cities worldwide, is the leading online talent solution transforming traditional staffing.

It empowers businesses with more flexible access to quality talent, on demand. Through Upwork's matching technology and services, companies have access to a global pool of proven professionals so they can scale their teams dynamically to meet business needs. Upwork also provides skilled professionals access to more opportunities. The community of independent professionals working via Upwork spans many categories— over 8,000 skills— including software development, creative & design, finance & accounting, consulting, operations, and customer support. For the year 2019, Upwork's gross services volume was $2.1 billion with more than 30% of Fortune 500 companies using its services across more than 180 countries. Clients include Airbnb, Automattic, BISSELL, GE, and Microsoft.

The Complainant claims that the disputed domain name is confusingly similar to its "UPWORK" trademarks and its domain <upwork.com> except for appending the geographically descriptive term "Pakistan". The relevant trademark is recognizable within the disputed domain name, and the addition of a geographically descriptive term, particularly given that Upwork has registered trademark rights in Pakistan since 2015 certainly would not prevent a finding of confusing similarity under the first element.

According to the Complainant the disputed domain name is confusingly similar to its name and trademark in which it has established rights and this finding is consistent with several Panels before the Czech Arbitration Court, World Intellectual Property Organization and the National Internet Exchange of India, relying, in particular on CAC Case No. 103379; CAC Case No. 102777; CAC Case No. 102511; CAC Case No. 101367 and CAC Case No. 101370.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The disputed domain name was registered on June 28, 2020.

The Complainant asserts that one of the previous UDRP Panels recognized that even by 2016, the extent of the use of the UPWORK mark by Complainant "can only be described as overwhelming" and was "already being used in relation to the provision of services to users numbering in the multi-millions".

By 2019, Upwork was already within the top 500 most popular global website on all of the Internet according to Alexa.com traffic statistics.

The Complainant contends that the website by the disputed domain name has led to actual confusion.

According to the Complainant the Respondent's use of the disputed domain name falsely suggests affiliation with the trademark owner.

The Respondent has no connection or affiliation with the 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 make any legitimate use of the disputed domain name for non-commercial activities.

The Respondent has likely registered and used the disputed domain name to mislead internet consumers for its own commercial gain.

When the Complainant contacted the Respondent to protest that the disputed domain name was registered and being used in bad-faith and the Respondent denied that there is any confusing similarity or bad-faith intent and suggested that a legal battle would cost more than paying Respondent tens of thousands of dollars to stop using the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

According to the Complainant the Respondent has likely intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the respondent’s website or location in contravention of par. 4(b) of the Policy.

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

A. Identical or confusingly similar with Complainant’s trademark

The Complainant is the owner of numerous “UPWORK” trademark registrations in various jurisdictions.

As confirmed by WIPO Overview 3.0, paragraph 1.2.1: “Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

The disputed domain name fully incorporates the “UPWORK” mark of the Complainant with the addition of “PAKISTAN”.

It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of geographical terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0).

The Panel notes that the addition of “Pakistan” does not change overall impression and does not eliminate the confusing similarity between the disputed domain name and the Complainant’s “UPWORK” trademarks.

The trademark is clearly recognizable in the disputed domain name.

The gTLD suffix “.com” is to be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284.

The disputed domain name was registered on June 28, 2020 and is currently inactive.

The Complainant provided evidence that the disputed domain name was used for a website allegedly offering “online” jobs thus creating a potential confusion with the Complainant and its services.

The Complainant denies any connection with the Respondent and any authorization to the Respondent to use the “UPWORK” mark in the disputed domain name.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, National Arbitration Forum).

The Complainant has made out a prima facie case and there is no evidence in this case that would demonstrate any possible rights or legitimate interests of the Respondent.

The use of Complainant’s mark in the disputed domain name and on the website offering the same services as the Complainant does not create rights or legitimate interests and cannot be considered a bona fide offering of goods or services.

As stated in WIPO Overview 3.0. “where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner…

Certain geographic terms, or terms with an “inherent Internet connotation” are seen as tending to suggest sponsorship or endorsement by the trademark owner” (see par. 2.5.1).

The Panel, therefore, finds that the Complainant satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

The other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

The website by the disputed domain name is inactive on the date of the decision, however the Complainant provided

evidence that the website was used for offering various “online jobs”.

As stated by WIPO Overview 3.0 and confirmed by UDRP panels “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark” (see par. 3.1) and “particular circumstances panels may take into account in assessing whether the respondent’s registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant’s mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant’s area of activity or natural zone of expansion), (ii) the chosen top-level domain, (iii) the content of any website to which the domain name directs, (iv) the timing and circumstances of the registration (v) any respondent pattern of targeting marks along a range of factors, such as a common area of commerce, intended consumers, or geographic location, (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent’s choice of the domain name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant” (see par. 3.2.1).

The Panel finds that most, if not all, of the factors listed above are present in this case.

The Complainant’s “UPWORK” trademark is widely-known and distinctive as confirmed by some previous UDRP panels (see Upwork Global Inc., Upwork Inc. v. Imran Khan, All Education info. / Md Abdul Malek, 1Links.in / Aman Shah, BollyJoGot.com / Rubel SbS, Hostsbs, WIPO Case No. D2017-1104) and supported by the evidence provided by the Complainant.

The disputed domain name fully incorporates the Complainant distinctive mark coupled with "Pakistan" that may be seen as reference to Complainant’s activity in this country where the Complainant has trademark rights.

The disputed domain name registered after registration of Complainant’s UPWORK trademarks and content of the website by the disputed domain name clearly implies certain connection with the Complainant: “online jobs”, “data typing jobs”, “link clicking jobs”.

All the circumstances and evidence in this case indicate Respondent’s awareness of the Complainant trademark.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see par. 3.1.4 of WIPO Overview 3.0).

The Complainant provided a copy of the response by the Respondent offering “to take down the website” at the costs of 15,000 US dollars.

In the view of this Panel this serves as an additional proof of bad faith.

As noted by one of the previous UDRP panels “given the use made of the disputed domain name it 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 authorized by the Complainant even though it is not” (see CAC Case No. 101660).

The disputed domain name fully incorporates the Complainant’s highly distinctive trademark with the addition of a geographic term.

The Respondent failed to respond and provide any explanations and one can hardly envisage any conceivable good faith use of the disputed domain name by the Respondent in these circumstances.

Taking into account all of the above the Panel agrees with the Complainant that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s mark.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UPWORKPAKISTAN.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi / Mocni Konsalting doo**

DATE OF PANEL DECISION 2021-02-19

Publish the Decision