Decision for dispute CAC-UDRP-101367

Case number	**CAC-UDRP-101367**
Time of filing	**2016-12-14 09:53:59**
Domain names	**iupwork.com, getupworks.com**

Case administrator

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

Complainant

Organization	**Upwork Inc.**

Complainant representative

Organization	**RiskIQ, Inc**

Respondent

Organization	**Anh Nguyen**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

According to the evidence submitted by the Complainant, the Complainant is the owner of the following trademark:

Benelux wordmark UPWORK number 0974795, filed on 25 February 2015, registered on 18 May 2015.

Iceland wordmark UPWORK number V0093956, filed on 26 August 2014, registered on 29 May 2015.

FACTUAL BACKGROUND

According to the information provided the Complainant, the world's largest freelance talent marketplace, relaunched in May 2015 with a new name, Upwork, and a new freelance talent platform, also called Upwork. Upwork, located at <www.upwork.com>, is the world's largest freelancing website. The website of the Complainant using the domain name <upwork.com> was also relaunched in May 2015. The Complainant is headquartered in Mountain View, California, with offices in San Francisco, California, and Oslo, Norway.

According to the public Whois information the date of first registration of the Disputed domain name <getupworks.com> is 8 November 2016 and the date of first registration of the disputed domain name <iupwork.com> is 18 October 2016.

Before the filing of the complaint, the websites to which the disputed domain names resolved mentioned that the disputed domain names were for sale. After the filing of the complaint the websites mention they are under construction and are “coming soon”.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

THE COMPLAINANT:

According to the Complainant the Disputed domain name <iupwork.com> incorporates the entirety of the Complainant's UPWORK mark, adding only the letter "i" which does not negate the confusing similarity as it simply exploits a typographical error. Similarly, the Disputed domain name <getupworks.com> simply adds the letter 's' to the mark and combines this typographical error with a generic term that suggests or implies one can acquire the goods or services identified the trademark which follows in a domain name. Accordingly, both Disputed domain names are confusingly similar to the UPWORK trademark in which the Complainant has rights.

According to the Complainant, the Respondent has no rights or legitimate interest in the Disputed domain names. The Complainant has not authorized or licensed the Respondent to use its trademark UPWORK, and has not consented to use of the mark in the Disputed domain names. Furthermore, based on the Whois records, it is apparent that the Respondent is not known by the disputed domain names. The Respondent disrupted the Complainant's business by sending an unsolicited email to a variety of email addresses associated with the Complainant to offer the Disputed domain name <iupwork.com> for sale, and threatening that if not contacted soon the disputed domain name will be sold. Both Disputed domain names advertise directly that offers to buy the Disputed domain names should be sent to the same account. This shows that the email sent to the Complainant was likely sent by the Respondent or its authorized agent. The Respondent does not use the Disputed domain names to provide a bona fide offering of goods or services or a legitimate noncommercial or fair use.

According to the Complainant the Disputed domain names are registered and used in bad faith. The Respondent sent an unsolicited mass email to numerous contacts at the Complainant threatening that if the Complainant does not contact the Respondent with an offer to buy one of the Disputed domain names, <iupwork.com>, the domain name would be sold to a third-party. Under the circumstances, this constitutes evidence that the Respondent knew of the Complainant's rights when the Disputed domain names were registered and is using them to try and profit by expressly (as evidenced by the email sent to the Complainant) or at least implicitly (as advertised on the Disputed domain names) threatening that the Disputed domain names will be sold to the highest bidder. The fact that the Respondent is entertaining offers on both of the Disputed domain names indicates it is looking to profit from the highest bidder and registered them to profit, not just recoup its out-of-pocket costs associated with the registrations.

THE RESPONDENT:

According to the Respondent Upwork might be trademark of the Complainant. The Respondent asserts that Upwork.com and <iUpWork.com> and <GetupWorkS.com> are two very different things.

In the case of the Disputed domain name <iUpWork.com>:

- iUpWork is "i Up Work". It's different with "Upwork".

- "Up" is a verb (meaning lift, increase, rise), "Work" is a noun (meaning job, task) and "i" is a popular letter in domain name industry.

- A lot of domain names begin with "i" and end with "Work".

In the case of the Disputed domain name <GetupWorkS.com>:

- GetupWorkS is "Getup WorkS". It's different with "Upwork".

- "Getup" is a noun (meaning wakening), "Works" is a plural noun (with "S" in the end). It's meaning "Getup! and Works".
- A lot of domain names begin with "Getup" and end with "WorkS"

According to the Respondent there are many examples of same domain names.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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 are 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 for Uniform Domain Name Resolution Policy (“the Rules”) instructs the Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Uniform Domain Name Resolution Policy (“the Policy”), these Rules and any rules and principles of law that it deems applicable”.
Paragraph 4(a) of the Policy requires that the complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:
(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.
The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

In the opinion of the Panel the Disputed domain names are confusingly similar to the Complainant's UPWORK Benelux trademark (Policy, paragraph 4 (a)(i)). Many decisions under the Policy have found that a disputed domain name is identical or confusingly similar to a complainant’s trademark where the disputed domain name incorporates the complainant’s trademark or the principal part thereof in its entirety. The Disputed domain name <getupworks.com> contains the UPWORK trademark in its entirety, with the addition of the generic, descriptive and non-distinctive word “get” and the addition of the non-distinctive letter “s”. The Disputed domain name <iupwork.com> contains the UPWORK trademark in its entirety, with the addition of the non-distinctive letter “i”.

The submission by the Respondent that there are many other domain names which include similar dictionary words is irrelevant as the only relevance for this procedure is the confusing similarity between the trademark of the Complainant and the Disputed domain names. In addition, paragraph 4 (a)(i) of the Policy is basically a standing requirement. Finally, the addition of the generic Top-Level Domain (“gTLD") “.com” may be disregarded for purposes of paragraph 4 (a)(i) of the Policy.

In the opinion of the Panel the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interest in the Disputed domain names. Based on the evidence provided by the Complainant, the Disputed domain names resolve to parking websites on which it was first stated “Domain name for sale” and later “is coming soon”. Such use cannot be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the Disputed domain name. The Respondent is also not commonly known by the Disputed domain names nor has he acquired any trademark rights.

Under these circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed domain names (Policy, paragraph 4 (a)(ii)).

The Panel finds that the Disputed domain names have been registered and are being used in bad faith (Policy, Par. 4(b)(iv)). The evidence submitted by the Claimant verify that the trademark of the Complainant has been existing before the registration of the Disputed domain names; in addition the Complainant's website <upwork.com> which incorporates the trademark of the Complainant was operational before the registration of the Disputed domain names. The Respondent knew or should have known that the Disputed domain names included The Complainant’s trademark. The Panel notes that there are currently no active websites at the Disputed domain names. However, such passive holding of the websites does not prevent the Panel from finding registration and use in bad faith. The Panel also notes that the Respondent’s undeveloped use of the websites at the Disputed domain names which incorporate the Complainant’s trademark in its entirety indicates that the Respondent possibly registered the Disputed domain names with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of the Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location.

In addition, bad faith registration and use is further indicated by the fact that the Respondent offered the Disputed domain names for sale; in his mail of 5 December 2016 to the Complainant, the Respondent asked for a “reasonable and fair offer” which indicates that the Respondent registered the Disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the Disputed domain names to the Complainant (the owner of the trademark) for valuable consideration in excess of documented out-of-pocket costs directly related to the Disputed domain names.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IUPWORK.COM**: Transferred
2. **GETUPWORKS.COM**: Transferred

PANELLISTS

Name	**Dinant T.L. Oosterbaan**

DATE OF PANEL DECISION 2017-01-17

Publish the Decision