

Decision for dispute CAC-UDRP-104523

Case number CAC-UDRP-104523

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Domain names upworkrh.com

Case administrator

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

Complainant

Organization Upwork Global Inc.

Complainant representative

Organization Microsoft Corporation

Respondent

Organization UpWork Rh

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 bases its Complaint on several UPWORK trademark registrations, namely:

- AUSTRALIA, Reg. No. 1676473; priority filing date 26 August 2014 ICELAND 2303/2014; Issuance Date: January 15, 2016; International Classes 9, 35, 36, 38, 41 & 42.

- BENELUX, Reg. No. 974795; priority filing date August 2014 ICELAND 2303/2014; Issuance Date: May 18, 2015; International Classes 9, 35 & 42.

- HONG KONG; Reg No. 303312396; priority filing date: January 28, 2016; International Classes 9, 35, 36, 38, 42.

- ICELAND, Reg. No. V0093956; priority filing date August 26, 2014; Issuance Date: May 29, 2015; International Classes 9, 35, 36, 38, 41 & 42.

- ISRAEL, Reg. No. 272529; priority filing date February 22, 2015; Issuance Date: January 2, 2017; International Classes 9, 35,

38, 42.

- KAZAKHSTAN, Reg No. 51512; priority filing date: March 16, 2016; International Classes 9, 35, 42.
- MEXICO, Reg Nos. 1539995, 1650070, 1655485; priority filing date: 23/03/2014 ICELAND AUGUST 26, 2014; Issuance dates: May 22, 2015, July 1, 2016, July 13, 2016; International Classes 9, 35, 42.
- NORWAY; Reg. No. 282322; priority filing date 26 August 2014 ICELAND 2303/2014; Issuance Date: June 19, 2015; International Classes 9, 35 & 42.
- PAKISTAN, Reg. No. 381888; International class 9; Dates 23/2/2015.
- PRC, Reg. Nos. 16413729, 16413728, 16413727, priority filing date May 21, 2016; International Classes 35, 38, 42.
- RUSSIAN FEDERATION, Reg No. 578187; priority filing date: June 17, 2016; International Classes 9, 35, 36, 38, 41, 42.
- S. KOREA, Reg. No. 450061860; priority filing date February 26, 2015; Issuance Date: January 11, 2016; International Classes 9, 35 & 42.
- UAE, Reg. Nos. 229783-85; priority filing date March 26, 2015; Issuance Dates: September 3, 2015; September 30, 2015; International Classes 9, 35, 42.
- UNITED STATES, U.S. Reg. No. 5,237,481; Issuance date: May 29, 2015; priority filing date August 26, 2014 based on its Icelandic registration No. 426/2015 International Classes 9, 35, 36, 38, 41, and 42.

According to the Complainant's allegations, Upwork Global Inc. is a wholly-owned U.S. subsidiary of Upwork Inc., the owner of the above trademarks. Both entities are part of the same common corporate structure. According to the Complainant, since May 2015, Upwork Global owns and runs the platform bearing the UPWORK mark, located at www.upwork.com, and is a licensee of Upwork Inc.

The parent company, Upwork Inc., has expressly acknowledged that Complainant Upwork Global, which operates with 'Upwork' in its trade name, has the right to conduct this proceeding and any proceeding relating to the UPWORK registered mark. The acknowledgement also includes the right to decide, in Complainant Upwork Global's sole discretion what action if any to take in respect of any infringement or alleged infringement of its marks in any medium or passing off.

FACTUAL BACKGROUND

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

Upwork operates the world's largest work marketplace at upwork.com that connects businesses, with independent talent, as measured by gross services volume. Its talent community, including everyone from one-person start-ups to over 30% of the Fortune 100, earned over \$3.3 billion on Upwork in 2021 across more than ten thousand skills in over ninety categories. TIME, the global media brand reaching a combined audience of more than 100 million around the world, selected Upwork, from nominations in every sector, and from industry experts around the world, for its annual TIME100 Most Influential Companies list highlighting businesses making an extraordinary impact.

Complainant Upwork Global Inc. is a wholly-owned U.S. subsidiary of Upwork Inc., the owner of the below trademarks which predate the registration of the Disputed Domain name. Between the parent company, Upwork Inc. and the complainant Upwork Global Inc there is in place a license according to which the Complainant Upwork Global, which operates with 'Upwork' in its trade name, has the right to conduct this proceeding and any proceeding relating to the UPWORK registered mark.

The Disputed Domain Name < upworkrh.com> has been registered on March 26, 2021.

The Disputed Domain Name resolve to an active website that relate to human resources services.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions are the following:

The Disputed Domain name is confusingly similar to the trademarks in which the Complainant has rights, as such incorporates the entirety of the UPWORK trademark, and is therefore, in the Complainant's view, generally considered confusingly similar to that mark for purposes of UDRP standing.

The Complainant further asserts that the Disputed Domain Name only appends the descriptive letters "RH" to the mark UPWORK, being used as an abbreviation in Spanish for "Recursos Humanos," meaning "Human Resources." In the Complainant's view, this broader context, if anything, increases confusion because it is closely related to the Complainant's services covered by the Upwork registration. For example, in Class 35, the Complainant contends that the UPWORK trademark registration expressly mentions human resources in a wide variety of contexts from "consulting services in the field of human resources" to the "administration, management, implementation and coordination of human resources" to "business management of human resources" and even "providing information in the field of human resources for others...".

Therefore, the Complainant asserts that the Disputed Domain Name is confusingly similar to the mark UPWORK in which Complainant has rights. To this end, the Complainant is a wholly-owned U.S. subsidiary of Upwork Inc., the owner of the invoked UPWORK trademarks, between these two entities being in place a license according to which the Complainant, which operates with 'Upwork' in its trade name, has the right to conduct this proceeding and any proceeding relating to the UPWORK registered marks.

Further, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

To this end, the Complainant asserts that the UPWORK trademark registrations are covering human resources and recruitment since at least 2015 and such were issued well before Respondent registered the Disputed Domain Name in March 2021. The Complainant further contends that, according to Respondent's website's terms and conditions, its corporate name does not include "UPWORK" but is "AR & CS MANAGMENT AND HUMAN RESOURCES, S.C.", and it has never received permission or approval from UPWORK to offer services that would be perceived as related bearing a substantially indistinguishable UPWORK trademark, or to register an UPWORK-domain name for competitive services. In the Complainant's view, the use of a substantially indistinguishable mark for closely related services on a competing site does not support a claim to rights or legitimate interests in the Complainant's view.

Lastly, the Complainant contends that the Disputed Domain Name was registered and is being used in bad-faith. In the Complainant's view, circumstances indicating bad-faith registration and use include the nature of the Disputed Domain Name, which wholly incorporates the relevant distinctive mark plus a descriptive term specifically related to the Complainant's area of commercial activity. Also, the Complainant asserts that the Disputed Domain Name was put to use for services specifically covered by the registration certificates, which indicates that Respondent's aim was to profit from or exploit the UPWORK trademark.

Furthermore, the Complainant asserts that the Respondent was clearly aware of UPWORK when it selected the Disputed Domain Name and this is due, in the Complainant's view, to the fact that, when the Complainant offered to reimburse the

documented out-of-pocket registration costs and give Respondent time to transition to a different domain name that is not confusingly similar, according to the correspondence attached to the file, the Respondent presented no credible evidence-backed rationale for how it came up with the mark independent of its trademark significance, and instead simply offered to sell the Disputed Domain Name for a profit clearly in excess of what was spent to register it in the first place. The Complainant further asserts that, while Respondent preferred to speak in Spanish, a translation was provided in Spanish as a courtesy, and from several responses received leading up to the submission of the Complaint, it is likely in his view that , the Respondent understood, especially given that he was presumably able to comprehend the English registration agreement that he agreed to when registering the Disputed Domain Name in English according to the registrar's verification response in this case. The Complainant contends that after the exchange and demand for a profit in excess of the registration costs, the Respondent then claimed it did not understand. In the Complainant's view, this is not likely especially given that he was presumably able to comprehend the English registration agreement that he agreed to when registering the Disputed Domain Name in English.

Furthermore, the Complainant asserts that, beneath the proxy registration, the Respondent chose to register the Disputed Domain Name in the name of "UpWork RH" instead of in the name of the beneficial owner of the Disputed Domain that controls it according to the Respondent's website. The Complainant contends that the Respondent has not provided any fictitious business name filing for the company purported to be the owner, specifically "AR & CS MANAGMENT AND HUMAN RESOURCES, S.C.". Therefore, in the Complainant's view, it is likely that the Respondent registered the Disputed Domain Name using a false and fictitious identification for the Respondent's organization according to the Registrar's verification response.

In any case, in the Complainant's view, with UPWORK appearing in all the top results of major search engines prior to when the Respondent registered the Disputed Domain Name, including Google search, the Respondent would have observed that UPWORK is being used in relation to human resources or recruitment. The Complainant further asserts that, it is difficult to accept that Respondent at the very least, did not even do a cursory search related to the term 'UPWORK' before selecting it and therefore, had actual knowledge of Complainant--the world's largest work marketplace as measured by gross services volume for recruitment and human resources-related activities--and Complainant's rights, before selecting to incorporate it into the Disputed Domain Name.

Therefore, the Complainant contends that Respondent has by using the Disputed Domain Name, 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. Furthermore, the Complainant asserts that there are also circumstances indicating that the Respondent has likely registered the Disputed Domain Name primarily for the purpose of selling it to the owner of the trademark, for valuable consideration in excess of the Respondent's documented out-of-pocket registration costs for the Disputed Domain Name because even after protest, Respondent demanded at least a thousand dollars and had no credible explanation for how it came up with the name other than claiming UpworkRH is "totally different" than Upwork. The Complainant further asserts that, it is much more likely that RH was intended to be a non-distinctive acronym for "Recursos Humanos" (meaning "Human Resources.") as Respondent even when out of its way to display "RH" in capital letters and to differentiate it from "UpWork" in the logo on its homepage.

For all of the foregoing reasons, the Complainant contends that it has satisfied all three elements of the Policy.

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

I. Confusing Similarity

The Panel agrees that the Disputed Domain Name <upworkrh.com> incorporates in its entirety the earlier UPWORK trade marks in which the Complainant has rights and that the addition of the letters "rh" which might come from "Recursos Humanos" in Spanish, meaning "Human Resources" in English and which corresponds to services for which the earlier UPWORK trademarks are protected and also to the services provided by the Complainant is not sufficient to escape the finding that the Disputed domain Name is confusingly similar to the earlier UPWORK trademarks.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

The Panel agrees that for purposes of this proceeding, the Complainant has demonstrated authorization to bring this proceeding based on the parent company's, Upwork Inc., trademark registrations establishing its rights in the UPWORK marks for purposes of Policy Par. 4(a)(i) as previous UDRP panels have also established, for example in Grupo Televisa, S.A. et al. v. Party Night Inc. a/k/a Peter Carrington, WIPO Case No. D2003-0796 - "Paragraph 4(a)(i) of the Policy requires, as one element to be proved, that the domain name be identical or confusingly similar to a trademark or service mark in which Complainant has rights. These words do not require that Complainant be the owner of the mark and would include, for example, a licensee of the mark. It has been accepted in several decisions that a company related as subsidiary or parent to the registered holder of a mark may be considered to have rights in the mark. See for example Miele, Inc. v. Absolute Air Cleaners and Purifiers, WIPO Case No. D2000-0756 where Complainant's grand-parent corporation had a long-established U.S. trademark registration for the mark for vacuum cleaners."

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The Complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent is not a licensee of, nor has any kind of relationship with, the Complainant, which has rights in several earlier UPWORK trademark registrations. Also, the Respondent does not appear to be commonly known by the Disputed Domain as according to the Respondent's website's terms and conditions, its corporate name does not include "UPWORK" but is "AR & CS Management AND HUMAN RESOURCES, S.C. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the Disputed Domain Name, especially for competitive services related to human resources services.

Also, the Respondent has registered the Disputed Domain Name much later after the registration of the UPWORK

trademarks in which the Complainant has rights.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the filed evidences, the Complainant is a United States company that operates one of the world's largest work marketplace at <upwork.com> that connects businesses, with independent talent, as measured by gross services volume under the UPWORK trademark. A simple search on the Google search engine would have revealed as top results the UPWORK trademarks in which the Complainant has rights as being used in relation to human resources or recruitment.

Therefore, the Panel concludes that at the time of registration of the Disputed Domain Name, the Respondent was well aware of the UPWORK trade marks in which the Complainant has rights and has intentionally registered the Disputed Domain Name <upworkrh.com> in order to benefit from the reputation of the UPWORK previous trade marks in which the Complainant has rights.

In the present case, the following factors should be considered:

(i) the UPWORK trade marks in which the Complainant has rights, which are earlier rights, are distinctive signs;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the Disputed Domain Name;

(iii) the Respondent registered the Disputed Domain Name incorporating in its entirety the earlier UPWORK trade marks in which the Complainant has rights and has added the letters "rh" which might come from "Recursos Humanos" in Spanish, meaning "Human Resources" in English, which corresponds to services for which the earlier UPWORK trademarks are protected and also to the services provided by the Complainant;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trade marks for competing services;

(v) the Disputed Domain Name seem to be used in relation to human resources services which are similar or competing to the ones offered by the Complainant. The Respondent thus, intentionally attempted to attract, without authorization, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the UPWORK trademarks in which the Complainant has rights as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website;

(vi) the Respondent has registered the Disputed Domain Name in the name of "UpWork RH" instead of in the name of what appears to be the beneficial owner of the Disputed Domain that controls it according to the Respondent's website, namely AR & CS MANAGEMENT AND HUMAN RESOURCES, S.C.;

(vii) from the provided evidences, there are also circumstances indicating that the Respondent has likely registered the Disputed Domain Name primarily for the purpose of selling it for valuable consideration in excess of the Respondent's documented out-of-pocket registration costs for the Disputed Domain Name.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the Disputed Domain Name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. UPWORKRH.COM: Transferred
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PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION 2022-07-10

Publish the Decision
