

Decision for dispute CAC-UDRP-104522

Case number	CAC-UDRP-104522
Time of filing	2022-09-16 09:50:37
Domain names	upworksolutions.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Upwork Inc.
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Complainant representative

Organization	Microsoft Corporation
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Respondent

Organization	www.dynamowes.com
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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 submitted evidence that it is the registered owner of the following trademarks:

- the Australian trademark No. 1676473 for the word "UPWORK" registered in classes 9, 35, 36, 38, 41 and 42, and having protection since 26 August 2014;
- the Benelux trademark No. 974795 for the word "UPWORK" registered in classes 9, 35 and 42, and having protection since 26 August 2014;
- the Hong Kong trademark No. 303312396 for the word "UPWORK" registered in classes 9, 35, 36, 38 and 42, and having protection partially since 26 August 2014 and partially since 25 February 2015;
- the Icelandic trademark No. V0093956 for the word "UPWORK" registered in classes 9, 35, 36, 38, 41 and 42, and having protection since 26 August 2014;
- the Israeli trademark No. 272529 for the word "UPWORK" registered in classes 9, 35, 38 and 42, and having protection since 22 February 2015;
- the Kazakh trademark No. 51512 for the word "UPWORK" registered in classes 9, 35 and 42, and having protection since 16 March 2016;
- the Mexican trademarks Nos. 1650070 and 1655485 for the word "UPWORK" registered in classes 35 and 42, and having

protection since 26 August 2014;

- the Norwegian trademark No. 282322 for the word "UPWORK" registered in classes 9, 35 and 42, and having protection since 26 August 2014;

- the Pakistani trademark No. 381888 for the word "UPWORK" registered in class 9, and having protection since 23 February 2015;

- the Chinese trademarks Nos. 16413729, 16413728, 16413727 for the word "UPWORK" registered in classes 35, 38 and 42, and having protection since 21 May 2016;

- the Russian trademark No. 578187 for the word "UPWORK" registered in classes 9, 35, 36, 38, 41 and 42, and having protection since 26 August 2014;

- the Korean trademark No. 45-0061860 for the word "UPWORK" registered in classes 9, 35, 38 and 42, and having protection since 26 August 2014;

- the UAE trademarks Nos. 229783, 229784 and 229785 for the word "UPWORK" registered in classes 9, 35 and 42, and having protection since 26 March 2015; and

- the US trademark No. 5,237,481 for the word "UPWORK" registered in classes 9, 35, 36, 38, 41 and 42, and having protection since 26 August 2014.

FACTUAL BACKGROUND

The Complainant 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 startups to over 30% of the Fortune 100, earned over \$3.3 billion on [the Complainant's service] Upwork in 2021. TIME, the global media brand reaching a combined audience of more than 100 million around the world, selected the Complainant, 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.

The disputed domain name was registered on 1 June 2021.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

PARTIES CONTENTIONS

The Complainant made the following contentions:

Regarding confusing similarity with its trademarks, the Complainant argues that the disputed domain is confusingly similar to the Complainant's trademarks as well as domain <upwork.com> except for appending the descriptive term "solutions". The relevant trademark is recognizable within the disputed domain name and the addition of descriptive terms, especially relevant to the Complainant's business, certainly would not prevent a finding of confusing similarity under the first element. Accordingly, the Complainant concludes that the requirement of paragraph 4(a)(i) of the Policy is satisfied in both establishing rights in the "UPWORK" name and demonstrating that the disputed domain is confusingly similar to its trademark in which it has established rights. The Complainant supports its conclusion by reference to other UDRP Panel decisions, in particular the Czech Arbitration Court, the World Intellectual Property Organization, as well as the National Internet Exchange of India.

Regarding the Respondent's lack of rights or legitimate interests, the Complainant contends that the Complainant's "UPWORK" registration covers a variety of computer services and software, including specifically in Class 41, "consultation, design and development of computer software programs for use by others". The Complainant argues that the Respondent's use of the Complainant's mark to offer substantially the same services as covered by the "UPWORK" registration, specifically custom software development, is evidence that the Respondent is trying to exploit the registered mark by incorporating it in the disputed domain name to confuse people visiting the site. The Complainant points to earlier decisions of UDRP panels that have found that domain names identical to a complainant's trademark "carry a high risk of implied affiliation". In this instance, according to the Complainant, not only is the Respondent not commonly known by the disputed domain as evidenced by the registrar verification response, but the Complainant has not authorized, licensed, or otherwise permitted

the Respondent to use the mark for a competitive site or the disputed domain name.

The Complainant then comes to a conclusion that the use of a domain confusingly similar to the Complainant's registered mark to sell products and/or services protected by the registration without permission or approval from the trademark owner cannot constitute a bona fide offering of goods or services.

Turning to the bad faith argument, the Complainant submits that bad faith registration and use has often been found where a respondent intentionally attempts to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

The Respondent presumably at least did a cursory search related to the term 'Upwork' on the Internet before selecting it and therefore, had actual knowledge of the Complainant. Based on search results prior to the disputed domain name registration, the Respondent was likely aware of the Complainant when the Respondent registered and used the disputed domain.

The Respondent has by using the disputed domain, intentionally attempted to attract, for commercial gain, Internet users to its website 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 Respondent's website or location or of a product or service on the Respondent's website or location, in contravention of paragraph 4(b) of the Policy.

The disputed domain name was created on 1 June 2021. By 2016, a Panel before the Czech Arbitration Court recognized that even at that time, the extent of the use of the "UPWORK" mark by the Complainant could "only be described as overwhelming" and was "already being used in relation to the provision of services to users numbering in the multi-millions" (CAC Case No. 101370). By 2019, the Complainant was already within the top 500 most popular global websites on all of the Internet, according to Alexa.com traffic statistics. The Complainant had appeared in CNBC, in The New York Times, BBC News World Service, The Wall Street Journal, Forbes.com, TechCrunch, Bloomberg.com, FastCompany.com, Barrons.com, and many other publications archived under the 'press recognition' section of its website on <upwork.com>; all as follows from evidence submitted by the Complainant.

Therefore, the Respondent likely registered the disputed domain name with full knowledge of the Complainant's rights and shows bad faith under paragraph 4(a)(iii) of the Policy. By using the Domain, the Respondent has likely intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website hosted on the disputed domain name.

In addition, the Respondent did not respond to a request to turn over the disputed domain name prior to the submission of the complaint. Specifically, the Complainant contacted the Respondent by email at the email address on the site to amicably resolve the matter and the Respondent did not respond. Failure to respond to a cease and desist notification may be considered further evidence of bad faith registration and use pursuant to paragraph 4(a)(iii) of the Policy.

Finally, the Complainant argues that the Respondent registered the disputed domain name according to the registrar verification response using a URL as the name of the registrant organization. It appears likely that the proxy service masking this false information is in the context of this specific case further evidence of bad faith registration and use.

For all of the foregoing reasons, the Complainant concludes that it has satisfied all three elements of the Policy and requests that the disputed domain name is transferred to the Complainant.

The Respondent made the following contentions:

The Respondent claims that it is not "manipulating any information" regarding the Complainant's trade mark. The Respondent points to the fact that the Complainant operates a platform with a freelance market under the "upwork" trade

name, and that there is no such service on the Respondent's platform offered that would mismatch or misguide any user landed on the disputed domain name. The Respondent argues that users will not be confused because the Complainant's business model and the Respondent's content are unique and not conflicting with each other. The Respondent then offers to apply measures such as taking down all necessary pages and links and displaying warning messages or popup banners to inform users that the relevant website is not related to the Complainant, if there is any misleading information or infringement of copyright on its website.

The Respondent also mentions that there are different domains available on behalf of major companies that have similar short names, such as fb.com owned by Facebook and fb.net representing another business entity different from Facebook. The Respondent makes an analogy to the present case to say that <upwork.com> has no similarity over <upworksolutions.com>. In particular, the Respondent contends that both websites' logos, contents and graphics are different.

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

This is a mandatory administrative proceeding pursuant to paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to paragraph 4(a) of the Policy, a complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns numerous trademark registrations for the word mark "UPWORK" in various countries which were all obtained several years before the registration of the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name incorporates the Complainant's trademark "UPWORK" in its entirety. It differs from the Complainant's trademark insofar as it contains the word "solutions" at the end. In view of the Panel, the addition of the term "solutions" must be considered as insufficient to prevent or diminish confusing similarity. The Panel believes that such an addition does not change the overall impression of the disputed domain name as being connected to the Complainant's trademark "UPWORK". The Panel tends to agree with the Complainant's allegation that the term "solutions" could be considered descriptive with respect to the area of the Complainant's business.

The Panel notes that assessment of similarity involves only a side-by-side comparison of the disputed domain name and the textual elements of the relevant trademark to ascertain whether the mark is recognizable within the disputed domain name. It is not necessary to establish that there is actual confusion; the likelihood of confusion that derives from textual similarity is sufficient for this first requirement. With that in mind, the Panel takes the view that the addition of the word "solutions" to the mark "UPWORK" cannot prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark.

Therefore, the Panel finds that the disputed domain name is indeed confusingly similar to a trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

While the Respondent has filed a Response, it has not provided relevant information that would oppose the Complainant's allegations relating to the Respondent's lack of rights and legitimate interest in the disputed domain name.

In particular, the Respondent failed to address the Complainant's allegation that the Respondent exploits the "UPWORK" trademark registered throughout the world by incorporating it into the disputed domain name. In its Response, the Respondent claims that its services provided on the disputed domain name are different from those of the Complainant. However, it cannot be denied that the "UPWORK" trademark registrations cover a variety of computer services and software, including in Class 41, such as "consultation, design and development of computer software programs for use by others", as submitted by the Complainant. The Panel took special note that one of the trademarks asserted by the Complainant is the Pakistani trademark No. 381888 for the word "UPWORK" registered in class 9 for goods including computer application software for computers and mobile devices, that has protection already since 23 February 2015. This trademark is particularly relevant given that the Respondent is based in Pakistan and that it has branded its service on the disputed domain name as "Up-work Solutions, IVR & custom software solutions".

As the Respondent is not affiliated with or authorized by the Complainant to use its trademark for commercial activities, the Panel has difficulty in finding any right or legitimate interest of the Respondent. The Complainant demonstrated its increasing global reputation and showed that the Respondent should have been aware of its existence and particularly its rights when registering the disputed domain name. The Respondent has not offered a plausible explanation of its legitimate interest in the disputed domain name (and the Complainant's trademark registered long before the registration of the disputed domain name). The mere fact that the contents, logos and graphics on the disputed domain name are different to those on the Complainant's website, as the Respondent argues, cannot outweigh the basic finding that the Respondent included the Complainant's registered trademark in the disputed domain name without having any authorization to do so, and has been using the disputed domain name in a commercial manner to provide services and/or products covered by the respective trademark registrations which, in principle, cannot be considered a bona fide offering of goods or services.

Lastly, the Complainant demonstrated that the Respondent was not known by the disputed domain name and the Respondent has not proven otherwise.

With that in mind, the Panel has determined that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary: (a) the Respondent intentionally attempts to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website; (b) the Respondent must have had actual knowledge of the Complainant; (c) the Respondent did not respond to the Complainant's request for transfer of the disputed domain name, and (d) the Respondent registered the disputed domain name using a proxy service.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademark "UPWORK". It is well established that the mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

In addition, the Panel believes that the Complainant submitted evidence that sufficiently demonstrates the Respondent must have (and should have) been aware of the existence of the Complainant, its trademarks as well as its domain name. It is difficult to find any good faith reason for the registration of the disputed domain name by the Respondent and the Respondent has not offered any sufficient explanation. Arguments made by the Respondent that the services provided by both parties to this dispute are different, as well as the graphics and contents of their respective websites, cannot counter the fact that the disputed domain name includes the whole of the Complainant's mark protected by registered rights and that the Respondent would have found about the potential conflict with such a mark if it exercised even a minimum level of care and performed a simple online search (unless it indeed wanted to free-ride on the reputation of a well-established brand).

The Panel has also had to agree with the Complainant that failure to respond to a cease-and-desist letter has traditionally been found by UDRP panels to be indicative of bad faith. The Respondent has proposed certain measures in its Response. However, nothing prevented it from making such a proposal already in a response to the Complainant's communication of 7 September 2022 with a view of reaching an amicable resolution of this dispute. It is not in the competence of this Panel to make any reaction to the Respondent's proposals for measures to address potentially misleading information or copyright infringement on the disputed domain name. These proceedings are limited to the review of registration and use of the disputed domain name against the specific conditions set out in the Policy.

Having considered the facts of this case and the submissions of both parties, the Panel has reached the conclusion that the disputed domain name needs to be considered as having been registered and used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. UPWORKSOLUTIONS.COM: Transferred

PANELLISTS

Name	Mgr. Vojtěch Chloupek
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DATE OF PANEL DECISION 2022-11-07

Publish the Decision
