

Decision for dispute CAC-UDRP-104521

Case number	CAC-UDRP-104521
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Time of filing	2022-07-26 10:00:16
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Domain names	upworkflow.com
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	Community Devs LLC
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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

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

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 start-ups 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 <upworkflow.com> was registered on 2 July 2021 and resolves to a parking page with pay-per-click (“PPC”) links.

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.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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 “flow”. The term 'flow' in the context of work is descriptive of a workflow. 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.

Regarding the Respondent's lack of rights or legitimate interests, the Complainant contends that already by 2016, a Panel before the Czech Arbitration Court recognized in CAC Case No. 101370 that even at that time, the extent of the use of the “UPWORK” mark by the 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." The Complaint then claims to have further increased its online

popularity and press recognition.

The Complainant states that 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.

Furthermore, applying paragraph 4(c) of the Policy, the Complainant argues that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering because the domain name is not an actual dictionary word or phrase and hosts no PPC links genuinely related to the dictionary meaning of the words or phrase comprising the domain.

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. This applies, as well, to the use of links to third-party websites (CAC Case No. 101835).

The disputed domain resolves to a parking page which contains monetized (pay-per-click) links to third-party websites, including even to the Complainant's direct competitors and specifically related to freelance hiring. The website is thus clearly of a commercial nature and being used in bad faith by targeting the trademark in the disputed domain and using it to display ads linking to direct competitors.

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.

As the owner of the disputed domain, entirely and solely responsible for the content of the website and the functioning of the disputed domain regardless of whether the pay-per-click links on the site are selected by the Respondent or by another entity. Bad faith may be found so long as commercial gain is sought by another person or entity who benefits from the function of the disputed domain name (WIPO Case No. D2000-0923).

The Respondent has by using the disputed domain, 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 paragraph 4(b) 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

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 "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 incorporates the word "flow" at the end. In view of the Panel, the addition of the term "flow" must be considered 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 "flow" is generic and, with respect to the area of the Complainant's business, rather descriptive and commonly used (as "workflow"). With that in mind, and in absence of any plausible explanation by the Respondent, the Panel takes the view that such addition 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 confusingly similar to a trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not affiliated with or authorized by the Complainant to use its trademark for commercial activities. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain name is used to host a parking page with PPC links, some of which appear to divert users to websites of competing or similar services as those of the Complainant.

Such use does not appear to be a bona fide offering of goods nor a 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 its rights when registering the disputed domain name. The Respondent had the opportunity to participate in this proceeding actively and offer a plausible explanation of its legitimate interest in the disputed domain name but failed to do so.

The Panel has therefore 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) that the Respondent intentionally attempts 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; (b) that the Respondent had actual knowledge of the Complainant's trademarks; and (c) that the Respondent is using the disputed domain name to display advertising that links to direct competitors of the Complainant.

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 (or should have) been aware of the existence of the Complainant, its trademark 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 explanation whatsoever.

Upon review of the evidence and especially the printouts showing the PPC links, the Panel must agree with the Complainant in that the Respondent acquired the disputed domain name comprising of the Complainant's trademark with the intention to attract for commercial gain Internet users to the Respondent's website.

With that in mind, the Panel finds that the disputed domain name has been registered and has been 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. **UPWORKFLOW.COM:** Transferred

PANELLISTS

Name	Mgr. Vojtěch Chloupek
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DATE OF PANEL DECISION	2022-08-29
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Publish the Decision