

Decision for dispute CAC-UDRP-105214

Case number **CAC-UDRP-105214**

Time of filing **2023-03-23 14:43:51**

Domain names **upworkmedia.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **Upwork Inc.**

Complainant representative

Organization **Microsoft Corporation**

Respondent

Name **Leo Svedman**

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 is the holder of numerous registered trademarks including the following:

- United States word mark UPWORK registered under No. 5237481 since May 29, 2015, covering goods and services in classes 9, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant, Upwork Inc., operates a freelancing platform at <upwork.com> that connects businesses with independent talent. In 2022, the Complainant was listed in the TIME100 Most Influential Companies, which reported that the Complainant had nearly 800,000 clients.

The Complainant is the owner of the registered word marks for UPWORK in several classes since 2015.

The disputed domain name <upworkmedia.com> has been registered on September 19, 2022, and appears to resolve to a website under construction mentioning services such as design, marketing and e-commerce.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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.

Procedural issue: Language of proceedings

Pursuant to the Rules, Paragraph 11, in the absence of an agreement between the Parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding.

According to information received from the Registrar, the language of the registration agreement for the disputed domain name is Swedish. The Complainant requests that the language of the proceedings is English.

Previous UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include:

- evidence showing that the respondent can understand the language of the complaint;
- potential unfairness or unwarranted delay in ordering the complainant to translate the complaint;
- other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

The Panel notes that the disputed domain name is composed exclusively of English words and that the website linked to the disputed domain name, albeit under construction, has English content. In addition, in view of the absence of any Response or other communication from the Respondent, the Panel finds that it would be a disadvantage for the Complainant to be forced to translate the Complaint. For these reasons and given the circumstances of this case as further explained below, the Panel determines that the language of the proceedings is English.

PRINCIPAL REASONS FOR THE DECISION

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

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of

probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of registered UPWORK trademarks, which is used in connection with the Complainant's freelance platform, it is established that there are trademarks in which the Complainant has rights.

The disputed domain name <upworkmedia.com> incorporates the Complainant's UPWORK trademark in its entirety, merely adding the word "media". In the Panel's view, this addition does not prevent the Complainant's trademark from being recognizable within the disputed domain name (see section 1.8 of the WIPO Overview 3.0).

Additionally, it is well established that the Top Level Domains ("TLDs") such as ".com" may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and *Champion Innovations, Ltd. V. Udo Dussling* (45FHH), WIPO case No. D2005-1094; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO case No. D2003-0455; *Belupo d.d. v. WACHEM d.o.o.*, WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. The Whois records relating to the disputed domain name indicate that the Respondent is known as "Leo Svedman". The Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant's mark is often central to this inquiry. Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Even 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 (see section 2.5.1 WIPO Overview 3.0). The disputed domain name incorporates the Complainant's UPWORK trademark in its entirety and simply adds the descriptive word "media". The Panel finds that the addition of this term does not avoid any confusion with the Complainant. Therefore, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant and cannot constitute fair use in the circumstances of this case, as described below.

Moreover, the Panel observes that the disputed domain name appears to resolve to a website under construction, but already mentioning services such as "Website Development", "Marketing", and "eCommerce" on its "What We Do" and "Services" pages. The Complainant shows that such services are highly related to products and services covered by the Complainant's trademarks. Even though the precise intention of the Respondent cannot be inferred from a website under construction, the Panel does not find evidence of a legitimate noncommercial or fair use of the disputed domain name.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. *Telstra Corporation Limited v. Nuclear Marshmallow*, WIPO Case No. D2000-0003; *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070). In the instant case, the Panel finds it more likely than not that the Respondent was aware of the Complainant's rights in the UPWORK trademark at the moment it registered the disputed domain name:

- the disputed domain name incorporates the Complainant's distinctive UPWORK trademark in its entirety with the mere addition of a descriptive term;
- some of the Complainant's trademarks were registered more than 5 years before the registration of the disputed domain name;
- the Complainant has provided conclusive evidence of the reputation of its mark, which has also been confirmed by previous UDRP panels.

In view of the nature of the disputed domain name and the absence of any evidence of actual or contemplated good-faith use, the Panel finds 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 as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on the website.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **upworkmedia.com**: Transferred

PANELLISTS

Name	Flip Petillion
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DATE OF PANEL DECISION 2023-05-22

Publish the Decision