

Decision for dispute CAC-UDRP-105276

Case number	CAC-UDRP-105276
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Time of filing	2023-07-25 13:31:42
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Domain names	upwork.page
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Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Upwork Inc.
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Complainant representative

Organization	Microsoft Corporation
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Respondent

Name	Karan Kanwal
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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 owns Trademark Registrations for the mark UPWORK including the following:

United States Trademark No. 5237481 registered on May 29, 2015;

Iceland Trademark Reg. No. V0093956 registered on May 29, 2015;

The People's Republic of China Reg. Trademark No. 16413729 registered on May 21, 2016;

Pakistan Trademark Reg. No. 381888 registered on February 23, 2015.

FACTUAL BACKGROUND

For a number of years prior to the registration of the disputed domain name, the Complainant has provided online employment recruiting and seeking services under trademark UPWORK. It also provides software, software hosting services, and it creates online publications in the fields of employment and computer software. The Respondent uses the disputed domain name to promote its offering of services relating to online marketing, social media management, SEO optimization, content creation, and branding.

PARTIES CONTENTIONS

The Complainant's contentions are summarised below.

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.

PRINCIPAL REASONS FOR THE DECISION

The Complainant's Contentions:

The Complainant operates the world's largest work marketplace at its <upwork.com> address 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 \$4.1 billion on Upwork in 2022. The Complainant has been the recipient of industry awards, its UPWORK trademark has been found to be widely-known and distinctive in a prior UDRP decision, and the mark has been the subject of many news stories publications with worldwide circulation.

The disputed domain name <upwork.page> was registered on August 23, 2022 and resolves to a website at which are offered services described as "Strategic Campaigns, Social Media Management, SEO Optimization, Content Creation, Branding, and more!". The Respondent is not affiliated with the Complainant and is not commonly known by the disputed domain name. The Complainant tried to contact the Respondent by email in order to try and resolve the matter amicably but it received no response.

PRINCIPAL REASONS FOR THE DECISION

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, UDRP-102809 (CAC January 21, 2020) ("the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.").

1. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. *Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant*, UDRP-103255 (CAC September 30, 2020) (“it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant’s trade mark(s).”).

The Complainant claims rights to the UPWORK trademark based on its registration with a number of trademark offices around the world. Registration with national trademark offices has been found sufficient to satisfy the threshold requirement of proving rights under Paragraph 4(a)(i) of the Policy. *Margaritaville Enterprises, LLC v. Neil Wein*, FA 1916531 (FORUM November 9, 2020) (“It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights”). Submitted into evidence are scans of registration certificates from a number of trademark offices including those of the United States, Iceland, The People’s Republic of China, Pakistan, and others as evidence that the Complainant owns registered rights to its asserted trademark. These range in dates from 2014 to 2016. Based on this evidence, the Panel finds that the Complainant has rights in the UPWORK trademark under Paragraph 4(a)(i) of the Policy.

Next, it is argued that the disputed domain name, which was registered on August 23, 2022, is identical to the Complainant’s trademark. Prior panels have found confusing similarity where the second level of a disputed domain name consists entirely of the asserted trademark. *Compagnie Générale des Etablissements Michelin v. Way Su*, D2016-2221 (WIPO December 28, 2016) (The disputed domain name <michelin.mom> was found to be identical to the Complainant’s MICHELIN trademark).

Also, a gTLD such as the extension “.page” typically adds little meaning or distinguishing element to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. *The Liverpool Football Club and Athletics Grounds Limited v. Thomas Morado*, UDRP-105579 (CAC August 17, 2023) (“the extension ‘.live’ is not to be taken into consideration when examining the similarity between the Complainant’s trademarks and the disputed domain names.”) Also see, *Novartis AG v. Wei Zhang*, 103365 (CAC December 9, 2020) (the top-level suffix in the domain name (e.g., ‘.com’) is to be disregarded under the confusing similarity test”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of a gTLD thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant’s trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to Paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, UDRP-100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy, relevant WHOIS information as well as any authorization to use the asserted trademark may factor into the determination of whether a Respondent is commonly known by a disputed domain name. See, *BOURSORAMA SA v. vikan koilzas*, UDRP-105026 (CAC December 28, 2022) (“the WHOIS information excludes that the Respondent could be commonly known with the sign BOURSO or BOURSO BANQUE.”) Also see, *Arla Foods Amba v. Kawashige Tsubasa*, UDRP-105010 (CAC January 2, 2023) (“lack of authorization to use a complainant’s mark may indicate that the respondent is not commonly known by the disputed domain name.”). Here, the Complainant states that it “has not authorized, licensed, or otherwise permitted Respondent to use the mark for a related site or the Domain. Respondent has not been commonly known by the Domain”. The WHOIS record for the disputed domain name lists the registrant as “Karan Kanwal” and the Respondent has not participated in these proceedings to assert that it is known otherwise. Further, as noted further below, the Complainant’s trademark is quite well-known and use of the phrase “Upwork.page” on the Respondent’s website does not, alone, demonstrate its reputation. *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, D2000-0847 (WIPO October 16, 2000) (“use which intentionally trades on the fame of another” should not be considered. “To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.”). Based upon the submissions and information before it, the Panel does not find sufficient evidence upon which to conclude, under Paragraph 4(c)(ii), that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain

name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. Using a confusingly similar domain name to pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See *Groupe Lactalis v. Kumar Vikas (Tigmoo Dot Com Limited)*, UDRP-105568 (CAC July 24, 2023) (“the disputed domain name is not used for a bona fide activity, because it resolves to a website that offers dairy products in competition with the Complainant. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.”). Here, the Complainant submits screenshots of the Respondent’s website and this contains the title “Upwork.page” and claims to offer services such as “Strategic Campaigns, Social Media Management, SEO Optimization, Content Creation, Branding, and more!”. At least some of these incorporate services of the type that are provided by the Complainant and claimed in its trademark registrations, e.g., providing software, software hosting services, and the creation of online publications in the fields of employment and computer software. In light of the well-known reputation of the Complainant’s trademark, as discussed more fully in the next section, the Panel views the content of the Respondent’s website as being for the purpose of creating the impression of origination with or approval by the Complainant and the Respondent has not filed a Response or made any other submission in this case to offer an alternative theory or explanation for its actions. As the Complainant has made out a prima facie case that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

3. The disputed domain name was registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain name was both registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

The Complainant first asserts that the Respondent was on actual notice of the UPWORK trademark at the time it registered the disputed domain name. The wide reputation of an asserted trademark may create a presumption that a given respondent knew of it at the time it registered a disputed domain name. *ARCELOMITTAL v. VANESSA RIBEIRO (VANESSA RIBEIRO)*, UDRP-105644 (CAC August 15, 2023) (“panels have held that the incorporation of a famous trade mark into a domain name, coupled with an active website, may be evidence of bad faith registration and use.”). Submitted into evidence are copies of news stories from such broad circulation publications as Time magazine, The New York Times, Business Insider, Forbes, CNBC, Bloomberg, Fast Company, Barron’s, and others. Each of these stories predates the Respondent’s registration of the disputed domain name. Also submitted are the results of an online search for the term “upwork” whose results refer exclusively to the Complainant. Further, the Complainant asserts that its trademark has been found to be well-known in prior UDRP decisions. See, e.g., *Upwork Inc. v. Benedict, Brian*, UDRP-101370 (CAC January 27, 2017) (use of the UPWORK trademark “can only be described as overwhelming...”). The Complainant argues that the “Respondent likely registered the Domain with full knowledge of Complainant’s rights....” The evidence in this case demonstrates that the UPWORK trademark has been used extensively and has become well-known prior to the date on which the disputed domain name was created. The Complainant’s trademark is also rather distinctive and, with no explanation or submission from the Respondent for its registration of a domain name that copies Complainant’s trademark, this Panel concludes that it is more likely than not that the term UPWORK has been used in the disputed domain name with actual knowledge of the Complainant’s trademark rights.

Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith as the Respondent exploits the Complainant’s brand reputation in promoting online marketing and related services. Using a confusingly similar domain name to pass oneself off as a complainant and offer competing goods or services can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See *MIGROS-GENOSSENSCHAFTS-BUND v. Zain Chukwuma*, UDRP-105434 (CAC June 21, 2023) (“Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain name and the Complainant’s mark, the fact that the disputed domain name was used to redirect Internet users to a website which offered competing services, the fact that no Response was submitted by the Respondent in response to the Complaint, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.”). The Complainant asserts that the disputed domain name is used, for commercial gain and based on confusion, to promote computer and software related services of the type offered by the Complainant and claimed in its trademark registrations. The screenshots of the Respondent’s website and the other evidence in this case shows that the Respondent is using the disputed domain name to pass itself off as the Complainant to actual and potential customers in furtherance of offering services that appear to be competing with the Complainant. The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds it highly likely that the Respondent registered and uses the disputed domain name in bad faith by seeking commercial gain through confusion with the Complainant’s trademark, per Paragraph 4(b)(iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **upwork.page:** Transferred

PANELLISTS

Name **Steven Levy Esq.**

DATE OF PANEL DECISION 2023-08-22

Publish the Decision