

Decision for dispute CAC-UDRP-105275

Case number	CAC-UDRP-105275
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Time of filing	2023-08-15 10:07:21
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Domain names	upworkwriters.com
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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	c/o Jonathan Matkowsky (Microsoft Corporation)
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Respondent

Name	Rogers Aranda
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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 is the owner of the American UPWORK trademark No. 5,237,481 registered on July 4, 2017 under priority on a foreign registration issued on May 29, 2015. This trademark is protected in International Classes 9, 35, 38 and 4.

The disputed domain name <upworkwriters.com> was registered on October 11, 2022 with a privacy shield service.

The Respondent's data were disclosed by the Registrar.

The Respondent is an individual domiciled in Kenya.

FACTUAL BACKGROUND

Upwork Inc. is an American company which operates the world's largest work marketplace at www.upwork.com, that connects businesses with independent talent. 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. 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.

The disputed domain name <upworkwriters.com> resolves to a website offering freelance writers services to complete students works.

The "Who is" section of the available website mentions the domain name <assignmenthelper.net>, whereas the "disclaimer" section explains that <homeworkmarket.ca> is an "educational resource where over 1,000,000 essays are collected".

According to the provided pieces of evidence, the <homeworkmarket.ca> domain name account was suspended.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT

The disputed domain name is identical to Upwork's domain <upwork.com> except for appending the generic term "writers" in the same TLD.

The trademark is recognizable within the disputed domain name, and the addition of descriptive terms, especially relevant to Upwork's business does not prevent a finding of confusing similarity under the first element.

Accordingly, Upwork satisfies the requirements of § 4(a)(i) of the Policy.

Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent is not commonly known by the disputed domain name and Complainant has not authorized or licensed Respondent any rights in the UPWORK mark. The Registrar's verification response of record and the WHOIS information supports that Respondent is not commonly known by the disputed domain name. Respondent's "About Us" section states that it is "Assignmenthelper.net", a suspended website, and the Disclaimer section of its site states that it is "Homeworkmarket.ca", which is a domain name on a misconfigured server.

Additionally, lack of authorization to use the UPWORK mark indicates that Respondent is not commonly known by the Domain.

Furthermore, Respondent fails to use the disputed domain name in connection with a bona fide offering of goods or services or legitimate noncommercial or fair use. Respondent purports to use the disputed domain name specifically to commercially profit by offering freelance writers to complete student papers for a competitive rate.

Freelance services are broadly covered by the UPWORK certificate of registration and even assuming Respondent's services are lawful, they would certainly be directly competitive with Complainant's UPWORK mark and services.

This is the opposite of bona fide services, and luring potential customers to Respondent's websites is not a bona fide use.

Bad faith registration and use

The resolving website purports to offer services that from a trademark perspective, would be deemed in competition with Complainant.

Using a confusingly similar domain name to trade upon the goodwill of a complainant by offering services deemed competing from a trademark perspective can evince bad faith under Policy § 4(b)(iv).

The disputed domain name was created on October 20, 2022.

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 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."

By 2019, Upwork was already within the top 500 most popular global websites on all of the Internet, according to Alexa.com traffic statistics.

Upwork had appeared in CNBC, in The New York Times Business Insider, The Wall Street Journal, Forbes.com, TechCrunch, Bloomberg.com, FastCompany.com, Barrons.com, Forbes.com and many other publications archived under the 'press recognition' section of its website on www.upwork.com. Even based on search results on Upwork writers from even only a month prior to the creation of the Domain, Respondent would have been aware of Upwork as evidenced from the historical search results from prior to when the Domain was created.

Therefore, Respondent likely registered the Domain with full knowledge of Complainant's rights, and shows bad faith under Policy § 4(a)(iii). Respondent has by using the 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 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 § 4(b) of the Policy.

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

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has rights on the prior UPWORK American trademark No. 5,237,481.

The disputed domain name is composed with the Complainant's trademark UPWORK.

The position of the word UPWORK at the beginning of the disputed domain name makes the Complainant's trademark UPWORK immediately recognizable.

The disputed domain name only differs from the UPWORK trademark by the addition of the term "writers", which is a generic term directly connected to the scope of protection of the UPWORK trademark and to the services offered by the Complainant under its UPWORK trademark.

This generic term does not avoid the confusing similarity.

Thus, the disputed domain name <upworkwriters.com> is confusingly similar to the Complainant's UPWORK trademark.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed Domain Name by demonstrating any of the following:

- before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Respondent did not respond to the Complaint to rebut Complainant's *prima facie* case.. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed Domain Name.

The Respondent is not related in any way with the Complainant, nor has ever been authorized by the Complainant to use the UPWORK trademark to register the disputed domain name.

There is no indication that the Respondent is commonly known by the "UPWORK" word.

The Respondent uses the disputed domain name to resolve to a website offering services competing with the Complainant's UPWORK services, for a commercial gain.

This website is presented as being operated by third parties under two other domain names, that are not connected with the Complainant.

Therefore, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

- circumstances indicating that the Respondent has registered or the respondent has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the Domain Name; or
- the Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that the respondent has engaged in a pattern of such conduct; or
- the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your 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."

The disputed domain name was used to resolve to a website offering services competing with the services offered by the Complainant under its UPWORK trademark.

Given the composition and the use of the disputed domain name <upworkwriters.com> and the position of the Complainant on the market, the Respondent was well aware of the Complainant's rights on the UPWORK trademark when it registered the disputed domain name.

The Panel is of the opinion that it is sufficient evidence for a finding of bad faith registration.

On the "Who is" and "disclaimer" sections of its website, the Respondent mentions two different domain names.

According to the provided evidences, the suspension of the account appears to apply to one of them, which is "Homeworkmarket.ca".

Given the use of the disputed domain name, the Panel is of the opinion that the Respondent has used the disputed domain name in an attempt "to attract, for commercial gain, Internet users to your 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 the meaning of paragraph 4(b)(iv) of the Policy.

The Panel is of the opinion that it is sufficient evidence for a finding of bad faith use.

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 disputed domain name <upworkwriters.com> incorporates the UPWORK trademark, which is recognizable in this domain name.

The Respondent is not commonly known by the disputed domain name and is not related in any way with the Complainant nor has ever been authorized by the Complainant to use the UPWRK trademark, or to register the disputed domain name.

The Respondent made a commercial use of the disputed domain name, to offer services which are competing with the services offered by the Complainant under its UPWORK trademark.

The Respondent did not contest the complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **upworkwriters.com**: Transferred

PANELLISTS

Name	Marie-Emmanuelle Haas Avocat
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DATE OF PANEL DECISION 2023-09-25

Publish the Decision