Decision for dispute CAC-UDRP-101294

Case number	CAC-UDRP-101294
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Domain names	UPWORKCRACK.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	UPWORK INC.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	Sunny Kumar

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant relies on its registered marks in various jurisdictions and submitted evidence of an Icelandic word mark no. v0093956, UPWORK, in classes 9,35,36,38,41 and 42 and a Benelux word mark no. 0974795, UPWORK, registered on 18 May 2015 claiming priority from the Icelandic mark. It refers to but does not evidence, marks in Switzerland, Japan, Mexico, New Zealand and Russia.

It also relies on its registered word and figurative marks for UP in the Benelux, no. 0974823 in classes 9,35 and 42 registered on 8 May 2015. It claims it also has the mark in Switzerland, Norway and the Philippines but does not provide evidence.

FACTUAL BACKGROUND

Factual Background

The Complainant, known until recently as Elance-oDesk, is a freelancing site. It claims to have offices in the US and in Norway.

In order to help its users demonstrate proficiencies, it offers certain tests and qualifications.

The Respondent registered the Disputed Domain Name on 30 August 2015. At the site to which it resolves he describes himself as “top rated freelancer” and at the Disputed Domain Name is a “Upwork Top Rated Freelancer Sazzad Hossain Interview.” That site seems to list the tests he has taken on the Complainant’s site or a list of the tests and posts on topics including “Upwork Skill Test Question,” “The Pros and Cons of Upwork,” “WordPress help,” “Article Writing Tool,” and “What did you buy from Upwork earnings” as well as posts on Upwork tests with headings such as “Upwork U.S. English Basic Skills Test Contents” etc.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant's Background and Trademark Rights

In May 2015, Elance-oDesk, the world’s largest freelance talent marketplace, relaunched with a new name, Upwork, and a new freelance talent platform, also called Upwork. Upwork, located at <www.upwork.com>, is the world’s largest freelancing website. As an increasingly connected and independent workforce goes online, knowledge work—like software, shopping and content before it—is shifting online as well. This shift is making it easier for clients to connect and work with talent in near real-time and is freeing professionals everywhere from having to work at a set time and place.

Freelancers are earning more than $1 billion annually via Upwork. Upwork is headquartered in Mountain View, California, with offices in San Francisco, California, and Oslo, Norway.

The Complainant claims to own numerous registrations for UPWORK around the world, including without limitation in Switzerland, Japan, Mexico, New Zealand, and Russian Federation, but for purposes of this proceeding, the Complainant introduces into evidence a representative registration in Benelux, claiming priority on its filing in Iceland (for details see section “Identification of rights”).

In addition, the Complainant owns numerous registrations around the world for either/both UP (in standard characters) and UP (& design), including without limitation in Switzerland, Norway, and the Philippines, but for purposes of this proceeding, the Complainant introduces into evidence, a representative current printout of its registration rights in Benelux (for details see section “Identification of rights”). The stylized UP portion of the UPWORK mark is used in a wide variety of contexts, such as where the UPWORK mark might not fit as well. Representative example of such use in the context of Mobile Apps are submitted in evidence.

It is widely acknowledged and accepted under the Policy that the Complainant is actually only required to demonstrate rights in a single jurisdiction and that it does not have to be where the Respondent resides or operations, e.g., Koninklijke KPN N.V. v. Telepathy, Inc., D2001-0217 (WIPO May 7, 2001), so according to the Complainant it has more than satisfied this element of the Policy.

I. The Disputed Domain is Confusingly Similar to Complainant's UPWORK Mark, in Which it has Established Rights.

The disputed domain incorporates the entirety of Complainant's mark UPWORK, and adds only the dictionary word 'Crack' followed by the gTLD '.com', which does not distinguish the disputed domain because 'Crack' is a generic or descriptive term with no distinguishing capacity in the context of the Policy (e.g., Wal-Mart Stores, Inc. v. Walsucks & Walmarket Puerto Rico, No. D2000-0477 (WIPO July 20, 2000) ("The addition of a common or generic term following a trademark does not create a new or different mark in which Respondent has rights."), much like the generic Top-Level Domain '.com' has no relevance in the context of this element of the Policy.

Complainant's registered 'Upwork' mark is an arbitrary term that has no dictionary meaning. The mark is recognizable as such within the disputed domain name, because 'crack' is a dictionary word, whose primary definition is to break (something) so that there are lines in its surface but it is usually not separated into pieces; to hit or press (something) so hard that it breaks apart or opens suddenly; to hit (someone or something) hard and usually suddenly. Incorporation of the trademark combined only with a dictionary word such as 'Crack' is sufficient to establish that the domain name is confusingly similar to Complainant's registered mark. E.g., Hoffmann-La Roche Inc. v. Hightech Industries, Andrew Browne, WIPO Case No. D2010-0240 finding “the incorporation of a trademark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark.”

There is also a risk that Internet users may actually believe there to be a real connection between the domain name and the complainant and/or its goods and services because of the domain name's overall impression. The title of the site on the disputed domain relates to a blog about freelancing, which is directly related to Complainant's mark and its freelance talent marketplace. Furthermore, the homepage features a purported "Top Rated Freelancer" with a link to Upwork.com, again highly related to Complainant's business and site. Finally, Respondent's own logo evidences that the Respondent intended the UPWORK component of the domain name in which the Complainant has rights to be dominant and recognizable as such, as the word 'Crack' in the logo used on the disputed domain name appears separately—beneath the 'Upwork' component, and the 'Upwork' component is actually two to three times larger than the word 'Crack.' Respondent's intent for 'Upwork' to be separately recognizable is further evidenced by Respondent's social media accounts associated with the disputed domain name. Respondent's Facebook Page clearly shows "Upwork" as the primary component followed by the descriptive word 'Crack.' And the Twitter Page emphasizes 'Upwork' separately, with 'crack' in lower case - "Upwork crack blog about freelancing."

Furthermore, although there is no "About Us" or "About Me" section of the website in the navigation menu bar, if a user happens to scroll through blog post entries, there is one entry entitled "About Us," which can be found at <www.upworkcrack.com> in which it states that Respondent is a professional Web Developer "working with [U]pwork for last 5 years [with] 3200+ hours logged." It further states that the site was started about Complainant's freelance talent marketplace, Upwork, to help the rookie, focused on "all the aspect[s] of [U]pwork and web technology." Id. Clearly, the Respondent concedes the site is highly related to Complainant's freelance talent marketplace. Without even any conspicuous disclaimer, clearly there is a risk that Internet users may actually believe there to be a real connection between the domain name and the complainant and/or its goods and services because of the domain name's overall impression.

II. Respondent Does Not Have Any Rights or Legitimate Interest in the Domain Name.

No authorization has been given by the Complainant to the Respondent to use or register the disputed domain name, the Respondent has not been commonly known by the disputed domain name as is evidenced by the Whois record, and the Respondent has no prior rights or legitimate interests in the disputed domain name.

The disputed domain name resolves to a commercial website which provides test answers from skills tests available on Upwork (“Upwork Skills Tests”) combined with advertisements through Google's DoubleClick ad platform or Google Adwords with links to commercial websites. As the Respondent is using the disputed domain name for his own commercial gain, there is no bona fide offering of goods and services by the Respondent.

Furthermore, the Respondent registered the disputed domain name primarily to disrupt Complainant's business by displaying answers to Upwork Skills Tests. By way of background, freelancers on Upwork can prove their skills and impress potential clients by taking free third-party skills tests available via the platform. The more relevant tests a freelancer passes, the better they can market their services. Freelancers must comply with certain requirements while taking Upwork Skills Tests, such as not taking a test on behalf of someone else, not obtaining improper access to the test or any part of the test before taking it by observing someone else taking the test, discussing questions or answers with someone else who took the test, looking up test questions or answers online, etc. In addition, a freelancer is not allowed to disclose, publish, reproduce or transmit any part of the Upwork Skills Tests, in any form, by any means, visual, verbal, or written, for any purpose without the express written permission from Upwork. Taking screen shots during any test is strictly prohibited. The tests are meant to be taken by a single individual only. Freelancers are not allowed to collaborate with other test-takers or

refer to their screens, testing materials, or written notes while taking the test. Finally, those who take the tests are not permitted to copy questions and/or answers or share them with other test-takers.

While the Respondent refers to his site on the disputed domain name as a blog, it is anything but a non-commercial fan-site. Apart from Google ads with links to third-party commercial sites, the only other main element of the site on the disputed domain is published answers to the Upwork Skills Tests, in violation of the requirements designed to protect the platform's integrity. The Respondent seeks to derive commercial advantage from its registration and use of the disputed domain name for an Upwork Skills Tests cheating site through pay-per-click revenue on the domain. This is certainly not a right or legitimate interest in the disputed domain name as these test answers could only be obtained through a violation of the terms of service ("TOS") applicable to Upwork, specifically including the site license and intellectual property rights section of its TOS, including the test requirements associated with the Upwork Skills Tests. E.g., Penn Foster, Inc. v A Kalinchuk / Email Me If you wanna buy / this domain / Penn Foster Exam Answers / Jaden Galloway / PFANSWER, PRIVATE REGISTRATION / Pf Answer PF ANSWER / Pf Helps Claim Number: FA1104001383827 ("Penn Foster") (transferring <pf-answers.com>, <pfanswers.biz>, <pfanswers.net>, <pfexamanswers.com>, <pfanswer.info>, and <pfhelper.com> domain names); see also Star Stable Entertainment AB v. javier chong, Claim Number: FA1604001670616 ("Star Stable"): "Respondent is using the <starstablehack.us> domain name to run a "cheat" site where Complainant's users can get unlimited "Star Coins" and life memberships to Complainant's site undetectably. Such sites (and information) undoubtedly have a negative impact on Complainant's revenue.").

III. The Domain Name Has Been Registered and is Being used in Bad Faith

Respondent registered the disputed domain name with Complainant's mark in mind, in order to profit from disrupting Complainant's business by diverting traffic to its cheating site in violation of the Upwork Skills Test, which is being monetized through Google with commercial third-party ads for Respondent's own financial gain. Such registration and use disrupts Complainant's business in its freelancing test skills and is evidence of bad faith under paragraph 4(b)(iii) of the Policy. Cf. Star Stable and Penn Foster.

The answers to Upwork Skills Test material and content and the use of Complainant's mark creates a strong likelihood of confusion among Internet users as to Complainant's sponsorship of, or affiliation with the site. The Respondent attempts to profit from this confusion through the offering of Upwork Skills Test answers by diverting traffic to its commercial ads from Google. This constitutes bad faith use and registration under paragraph 4(b)(iv) of the Policy.

Therefore, according to the Complainant paragraph 4(a)(iii) of the Policy has been met.

RESPONDENT:

The Response reads as follows:

"I am not sure why www.upworkcrack.com is a disputed domain. Upwork might be trademark of Upwork INC. But upwork and upworkcrack are two very different things.

For example take the example of upwork old name odesk and desk. Desk is used by other and odesk is being used by upwork earlier. Zendesk is having desk in there domain name as well. So I am not sure why upwork and upworkcrack are similar.

There are many example of same domain names. I am okay with giving the domain name to upwork if my domain name is confusing."

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown the 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 Panel notes that the Complainant's word marks UPWORK and UP are somewhat descriptive. In addition, unusually, the Complainant does not have the registered mark in either Norway or the US—its two places of business.

The Panel viewed the EU IPO database and notes that two applications for a Community Trade Mark for the word mark and the logo mark, Upwork (with the first two characters in Green and a stylised P in the logo mark) No.s EU013759221 and EU015007818 are both opposed by HOPWORK SAS, owner of an earlier French mark for HOPWORK no. 3986926.

Further, while there is an application in the US, No. 86543527, it was only published for opposition on 6 September 2016 and has not yet gone to grant it appears.

This information is available on the public registers and a panelist is able to consult these and other information in the public record.

The term work is descriptive when applied to any employment context. This may explain the registrations in registries where English is not the Official Language such as the Benelux and Iceland. Those registries would be less likely to raise descriptiveness.

This is the point that the Respondent is making in the response –if you select a highly descriptive mark, you cannot expect any exclusivity in common words and terms with information values that many traders will want to use. The online registers show many using marks including the word work.

Further, as to actual use in trade and common law rights, if any, although the Complainant's website was relied upon, no evidence of sales/income or advertisements and advertising spend was provided, nor any evidence of hits or unique visitor numbers. It seems that the name and marks are newly adopted and may only have been in use since 2014 at the earliest and that previously the Complainant traded under Elance-oDesk.

So while there are some registered rights, the rights are weak. This can impact bad faith in some cases. As it happens it is not relevant here for reasons discussed below.

The real issue in this case is whether the Respondent has a legitimate interest in use of the Disputed Domain Name where he uses the Complainant's name to identify (name) it and then discuss it, in what he says is a blog. The content includes references to his work with/for the Complainant and also has a discussion on “the Pros and Cons of Upwork.” Based on the screenshots submitted by the Complainant, the content of the various tests is discussed. There is also a discussion on which tests to take that starts: “Wondering which tests to take? Here are some ideas: start with the skills you have listed on your profile. Take the corresponding tests...” There is an explanation of scores and how ranks work, troubleshooting and “how to” sections.

So firstly, the use of the Complainant's name to refer to the Complainant and its services is 'nominative' use -that is, it uses a name in a referential sense and not a trade mark sense. It is using the name to identify the Complainant and its services. It is descriptive use in a broad sense and should not sustain a trade mark infringement action in the EU as it does not implicate the origin function of the mark. The addition of Crack (in the sense of and with a similar meaning here to 'Hack') signals that the Respondent's site is 'about' the Complainant and how to deal with it and that it is not the Complainant –to avoid impersonation or confusion.

The Respondent's discussion of the Complainant at his site is speech protected by Freedom of Expression and Art. 10 ECHR --subject to the rights of others in 10(2). EU law balances conflicting rights where they conflict so that the Complainant's rights as an owner of a name and mark would be protected by Art. 1, First Protocol to ECHR and also Art. 17 of the Charter (Treaty on the Functioning of the EU). The balance is adequately struck in trade mark law and norms –as reflected in the Policy.

While the Complainant says test answers are provided and its business disrupted –that was not at all clear to the Panel from the evidence. The content of tests seems to have been discussed in general terms but answers proper are not provided as far as the panel can tell from the evidence. Even if they were, the Complainant's remedy would be in breach of contract against the Respondent either under its website terms or any employment/services contract in relation to his web development work for the Complainant. The Policy does not provide a remedy for breach of contract. The focus of the Policy is a remedy for online trade mark infringement and passing/off or unfair competition.

UDRP cases dealing with similar speech issues tend to have fallen into categories like fan sites, sucks sites or parody sites and newly "brand criticism." It is now accepted that there is the narrow and wide view and an "all circumstances view," see Bettinger Domain Name Law and Practice, Second Edition at pp.1398-1399 ¶ IIIE.334.-339. This panel prefers the final approach and adopts it here.

The Disputed Domain Name is employed in connection with an 'about' site -closer to a fan site than a criticism site. Even if the subject does not like it, it is paradigm expression and legitimate use. The Complainant relies on the fact that the site uses pay per click ads when the Policy says the legitimate or fair use should be non commercial but minor commercial use does not these days impact the analysis. See Bettinger (above).

The Complainant says the Respondent is disrupting its business by providing answers but as discussed, this is not clear to the Panel. It seems to be a discussion and guide in the most general terms- so again, 'about' the test --rather than a cheat site based on the screenshots submitted in evidence and viewed by the panel. This is also relevant to Bad Faith.

The use of Crack mitigates against an attempt to confuse or impersonate and signals that the site has knowhow and is informational and about the Complainant. This also negates Bad Faith –as does the fact that the Complainant is being genuinely referred to and discussed.

Usually if legitimate interests are made out, there will not be Bad Faith and the panel finds it so here.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **UPWORKCRACK.COM**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2016-10-30