Decision for dispute CAC-UDRP-101370

Case number	**CAC-UDRP-101370**
Time of filing	**2016-12-14 10:02:06**
Domain names	**freeupwork.com, elance.career**

Case administrator

Organization	**Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization	**Upwork Inc.**
Organization	**Upwork Global Inc.**

Complainant representative

Organization	**RiskIQ, Inc**

Respondent

Name	**Benedict, Brian**

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 names.

IDENTIFICATION OF RIGHTS

The Complainant states and provides evidentiary documentation that it has been assigned all the rights to the number of trademarks for, among others, the words ELANCE, UPWORK. For example:

- BENELUX trademark “UPWORK” no. 0974795, filed on 25.02.2015, registered on 18.05.2015
US trademark “ELANCE” no. 76200301, filed on 26.01.2001, registered on 12.10.2003

FACTUAL BACKGROUND

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

“Complainant Upwork Global Inc. is a wholly-owned U.S. subsidiary of Complainant Upwork Inc., formerly Elance-oDesk Inc., incorporated in the United States. Both Complainants are part of the same common corporate structure (individually, or collectively, as the case may be, "Upwork")”.

“The Elance and oDesk freelance talent marketplaces and platforms merged in 2015 to combine ideas, technology and resources. 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.' The Upwork platform, located at www.upwork.com, is now the world’s largest freelancing website. Freelancers are earning more than $1 billion annually via Upwork. The Elance freelance platform is currently still available for Elance users. E.g.,. The ELANCE mark has been in continuous use since 1999. Upwork Global Inc owns numerous registrations for the ELANCE mark around the world, including but not limited to U.S. Reg. No. 2,772,962 issued October 14, 2003 in Classes 35, 36, 38, and 42, and Reg. No. 2,900,142 issued in 2004 in Class 9.. Prior to the merger, Elance has been featured throughout the media, including ABC News, USA Today, The Wall Street Journal, CNET, The New York Post, ABC Good Morning America, The New York Times, NBC News, and Larry King Live. As early as 2013, a Learned Panelist before the Czech Arbitration Court recognized the ELANCE mark as a famous and well-known trademark entitled to a broad scope of protection. See CAC Case No. 100614 ("Given the well-known trademarks at stake, which have very high recognition on a worldwide basis, it is inconceivable that Respondent registered the disputed domain names without having in mind the Complainants' respective trademarks.")“.

The Complainant further agrues that the Disputed domain names are confusingly similar to the Complainant’s trademarks, the Respondent has no rights or legitimate interest in the Disputed domain names and registered them in bad faiths and is using them in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The First Complainant, Upwork Inc, has shown to the satisfaction of the Panel the Disputed domain name FREEUPWORK.COM is confusingly similar to a trademark in which the First Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Second Complainant, Upwork Global Inc, has shown to the satisfaction of the Panel the Disputed domain name ELANCE.CAREER is confusingly similar to a trademark in which the Second Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed domain Names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainants have, to the satisfaction of the Panel, shown the Disputed domain Names have been registered and are 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 provides its principal reasons for the decision in relation to each domain name below.

FREEUPWORK.COM

The Complainants have demonstrated to the satisfaction of the Panel that the First Complainant, Upwork Inc, has registered rights in the trademark UPWORK that predate the registration of the domain name <FREEUPWORK.COM> by the Respondent.

The Complainant is correct in asserting that its reliance on registered rights in a single jurisdiction, even if it is one in which the Respondent does not reside or operate, is sufficient for the purposes of establishing rights referred to in paragraph 4(a)(i) of the UDRP (Koninklijke KPN N.V. v. Telepathy, Inc., D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). This is especially appropriate on the present facts considering the trademarks are registered and used in relation to online platforms, which by their nature are targeted to a global market.

It is further noted that the Complainants assert that in the Respondent's home jurisdiction, the United States, there has been strong promotion and use of the trademarks and therefore it has acquired a secondary meaning sufficient to acquire common law rights. In Case Record Connect, Inc v. Chung Kit Lam / La-Fame Corporation, FA1609001693876 (Forum, 3 November 2016) the learned Panelist stated:

"To have common law rights, a complainant must demonstrate that a mark has acquired secondary meaning. Relevant evidence of secondary meaning can include sales figures, length of use of a mark, and expenditures in maintaining the mark."

On the present facts the duration of use has only being a matter of months prior to the registration of the Disputed domain name. Nevertheless the extent of the use in that period can only be described as overwhelming. The trade marks were adopted as part of a re-branding of a large existing business. As a result of this by May 2015 the trade marks were already being used in relation to the provision of services to users numbering in the multi-millions. The Panel accepts that in the matter of months prior to the registration of the domain name UPWORK had a secondary meaning as the name of what is now Upwork Inc's online platform.

The addition of the highly common and descriptive prefix FREE does nothing to alleviate the likelihood of confusion with the UPWORK trade mark and the Panel finds it is likely to be understood as a reference to the provision of information, software or service simply being provided without charge.

In relation to the Respondent the Panel finds it is not known by the name UPWORK or FREEUPWORK and has no rights or interest in the Disputed domain name. Further his email statement on 27 October 2016, so far as it asserts it registered the Disputed domain name in good faith, is not accepted as credible. Given in particular (a) the large reputation in UPWORK (b) the express previous reference to freelancing services on the Respondent's website; and (b) the Respondent's subsequent registration of another Disputed domain name containing one of the Respondents trade marks the Panel finds it inconceivable that the Respondent was unaware of the Complainants' rights when registering and using the Disputed domain name. The Respondent has then attempted to profit from his wrongdoing despite being offered a reasonable proposal for an amicable outcome by the Complainants. The Respondent has acted in bad faith in both the registration and use of the domain name.

For the reasons stated above, The Panel finds that the Complainants have established their prima facie case in respect to the Disputed domain name <FREEUPWORK.COM> and without any evidence from the Respondent to the contrary, the Panel is satisfied that the Complainants have satisfied all three elements of the paragraph 4(a) of the UDRP Policy.

ELANCE.CAREER

The Complainants have demonstrated to the satisfaction of the Panel that the Second Complainant, Upwork Global Inc, has registered rights in the trademark ELANCE that predate the registration of the Disputed domain name <ELANCE.CAREER> by the Respondent. They have also demonstrated this trade mark has been used for many years and remains very well known. The trade mark presently remains in use. Given the mentioned re-branding it is unclear if this will remain the case in years to come but sufficient rights have been established for the purpose of this proceeding.

In relation to the Respondent the Panel finds he is not known by the name ELANCE or ELANCE.CAREER and has no rights or interest in the Disputed domain name. At the time of registering and using the Disputed domain name there remained a very significant reputation in the ELANCE trade mark and given this fact, in addition to the fact that the Respondent had already registered and used <FREEUPWORK.COM> the Panel again finds it inconceivable that the Respondent was unaware of the

Complainants' rights when registering and using the Disputed domain name. As mentioned above, the Respondent attempted to profit from his wrongdoing despite being offered a reasonable proposal for an amicable outcome by the Complainants. The Respondent has acted in bad faith in both the registration and use of the Disputed domain name.

In reaching its decision the Panel did take into account the Respondent's registration of <FIVERR.CAREER>, which contains the trade mark of a third party competitor of the Complainants. It is not known if the Respondent had permission from the third party trade mark owner for the registration of the Disputed domain name. However its registration, together with the registration and use of the Disputed domain names that were the subject of this proceeding, shows the Respondent has a clear understanding of the marketplace in which the Complainants operate.

Further, the acts of registering the three domain names together also shows a tendency of the Respondent to register domain names containing, or consisting of, the trade marks of others. The Panel finds this tendency alone is not conclusive of bad faith. The Respondent may have had an unknown legitimate reason to register domain name <FIVERR.CAREER>. However the tendency to engage in such practices on multiple occasions may be a factor merely indicative of bad faith to be considered with other factors. The Panel has therefore treated the evidence of this tendency as such.

Following the argumentation above, The Panel finds that the Complainants have established their prima facie case in respect to the Disputed domain name <ELANCE.CAREER> and without any evidence from the Respondent to the contrary, the Panel is satisfied that the Complainants have satisfied all three elements of the paragraph 4(a) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FREEUPWORK.COM**: Transferred
2. **ELANCE.CAREER**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2017-01-27

Publish the Decision