Decision for dispute CAC-UDRP-102511

Case number	CAC-UDRP-102511
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Domain names	upworkskills.com

Case administrator

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

Complainant

Organization	Upwork Inc.
Organization	Upwork Global Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	Anupam Kumar

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

In this proceeding, the Complainants rely on a number of “UPWORK” trademark registrations, including:

- BENELUX word trademark “UPWORK” No. 0974795, registered on May 18, 2015;

- US word trademark “UPWORK” No. 5,237,481, registered on July 4, 2017.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

Founded in 2014 from the combination of Elance and oDesk, Upwork Inc. and its wholly-owned subsidiaries including

Upwork Global Inc. (collectively, "Upwork") seeks to create economic opportunities, by operating the largest online global marketplace that enables businesses to find and work with highly-skilled freelancers.

The Complainants allege that as of the end of last year, the total dollar value transacted through the Upwork platform was $1.8 billion, Upwork users spanned across one hundred and eighty countries, and more than 30% of Fortune 500 companies were using Upwork.

The disputed domain name was created on November 7, 2017.

According to the Complainants, as of at least a year before the disputed domain name was created, the Upwork site was already one of the top 250 most popular sites in India where the Respondent resides. In the month before the disputed domain name was created, Upwork appeared on "Bloomberg Technology" and in Barron's. By July 2017 (approximately four months before the creation of the disputed domain name), the UPWORK mark was already found to be "distinctive and widely known, particularly through its popular "www.upwork.com" website," and was "one of the top 500 most popular global websites on the Internet" (as stated in Upwork Global Inc., Upwork Inc. v. Imran khan, All Education info. / Md Abdul Malek, 1Links.in / Aman Shah, BollyJoGot.com / Rubel SbS, Hostsbs, WIPO Case No. D2017-1104, <allupworktestanswers.com>).

The first Complainant (Upwork Inc.) relies on its various “UPWORK” trademark registrations, including word trademarks in the US and Benelux.

Previous UDRP panels recognized that Upwork has established rights in the UPWORK mark.

The Complainants state that the mere addition of descriptive terms such as “skills” does not adequately distinguish the disputed domain from the UPWORK marks.

The descriptive wording in the disputed domain name is within Upwork's field of commerce and indicative of Representative Upwork Skills Related Services, which supports a finding of confusing similarity under the Policy.

The UPWORK mark is recognizable within the disputed domain name, and the additional word does nothing to distinguish the disputed domain name from the UPWORK mark because it clearly relates to the business conducted by the Upwork under that mark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainants contend that the Respondent describes its services as providing clues and samples papers to help pass Upwork skills tests. Freelancers can receive recommendations and resources for passing Upwork skill tests from either Upwork under its UPWORK mark, or from the Respondent via the disputed domain name. The Complainants claim that in offering such highly related services under a confusingly similar mark, the Respondent also uses the disputed domain name to advertise a general offer to sell the disputed domain name.

A general offer to sell the disputed domain name supports there is no rights or legitimate interest in this domain name.

The Respondent is not an authorized reseller or distributor of Upwork skill tests, and has no permission or approval from Upwork to use its trademarks in any manner.

The Respondent is not legitimately known by the disputed domain name, and has not likely registered personally to do business under the trade name "Upwork Skills". As part of Upwork's mark use guidelines, incorporated into its terms of service, it is prohibited to use Upwork's marks as part of a business name or a domain name.

Considering the disputed domain name is generally offered for sale in almost every post on the site, there is a page in the footer specifically appealing directly to potential advertisers, and an appeal to contribute funds to the Respondent's PayPal

account, this site is by its very nature commercial.

Besides, the Respondent did not go out of his way to make it clear to Internet users visiting his website that it is not affiliated with Upwork.

The only disclaimer on Respondent's site is generic.

The use of the disputed domain name cannot be considered to be in connection with a "bona fide" offering if the probability is that it was meant to confuse Internet users as to source or affiliation.

Not only have the Complainants never authorized the Respondent to use the “UPWORK” mark, but its testing requirements prohibit, among other things, publishing, reproducing, or transmitting any part of Upwork Skill Tests, in any form, by any means, for any purpose without express written permission from Upwork.

The terms of service incorporating the brand usage guidelines cover both prohibited uses of the mark, and restrict use of copyrighted works by Upwork without its permission or approval in writing.

The Complainants emphasize that the Respondent's website does not accurately disclose its relationship with Upwork and state that the Respondent uses a copyright notice legend in the name of a fictitious (non-existent) trade name "Upwork Skills", which most people would likely believe, mistakenly, is affiliated with Upwork.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainants contend that Respondent's resources cause a likelihood of confusion, and disrupt Upwork's business by undermining the integrity of the testing requirements on Upwork.

Upwork is also unable to maintain quality control over such resources being provided, and people will likely think that the disputed domain name is either being used with permission or approval from Upwork, or in violation of its rights — both of which are harmful to Upwork's reputation and brand.

While most Internet users that land on the site and do not manage to dispel the initial interest confusion on their own will likely only think that the site is unofficially sanctioned as an Upwork resource for passing its skills tests - rather than a site officially from Upwork - the Policy covers likelihood of confusion as to sponsorship, affiliation or endorsement, and not only as to the source.

Aggravating circumstances include selecting the user name "Upwork Skills" rather than using his own name, displaying a colored logo and favicon on the site closely resembling the Upwork Logo Mark and displaying a copyright notice legend using a false trade name "Upwork Skills".

According to the Complainants, the deliberate creation of initial interest confusion and the consequent diversion of Internet traffic is sufficient to establish bad faith on Respondent's part.

Additional evidence of bad faith registration and use includes the offer for sale with a link to advertising to reach new audiences and generate leads, a general offer to sell the Domain, and Respondent's failure to respond to Upwork's notice sent in January.

According to the Complainants, it seems reasonable to infer that the Respondent registered the disputed domain name intending to use it in a manner calculated to create and exploit confusion with Upwork's mark for the purpose of selling the domain name, monetizing the content, and with the intent to disrupt Upwork’s business.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainants have, 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 Complainants 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 name (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 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

A. Identical or confusingly similar with Complainant’s trademark

The first Complainant (Upwork Inc.) owns various “UPWORK” trademark registrations.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition(“WIPO Overview 3.0”), see paragraph 1.2.1: “Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

The disputed domain name entirely incorporates the Complainant’s trademark with the addition of the word “skills” in the end.

As stated in WIPO Overview 3.0 “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (see par. 1.8).

In the present case, the Complainant’s “UPWORK” trademark is clearly recognizable in the disputed domain name. The addition of the “skills” word does not change an overall impression of the disputed domain name and may be seen as indicating connection with Complaints' business.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied (see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110;

Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 and CAC Case No. 101284).

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and FORUM Case No. FA0006000095095, Vertical Solutions Management, Inc. v. webnet-marketing, inc.).

The disputed domain name is used for a website that provides clues and sample papers to help pass Upwork skills tests. Test samples are provided on the website as well as answers to some of the tests' questions.

Besides, an offer to sell the disputed domain name is placed on most of the pages of the website. There is also a web page offering to advertise via the website under the disputed domain name. Nowhere on the website is there any information about the Respondent and any explanations about his relationships/connections with Upwork. There is also a copyright notice in the bottom of the website -"© Copyright 2017- Upwork Skills".

The disclaimer page of the website contains only general information about intellectual property rights, links to other websites as well as other general information without any explanations about the Respondent, his real name, identity and his relationship with Upwork.

The website also displays a colored logo and favicon on the site closely resembling the Upwork Logo.

The Complaints argue that the Respondent is not an authorised reseller or distributor of Upwork skill tests, and has no permission or approval from Upwork to use its trademarks in any manner, including in or on the disputed domain name. Even if the Respondent was an authorized person the Oki Data test set forth in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2011-09093, would not be applicable since it is prohibited to use Upwork's marks as part of a business name or a domain name and the Respondent did not go out of his way to make it clear to Internet users visiting his website that it is not affiliated with Upwork.

As stated in WIPO Overview 3.0 "a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner" (see par. 2.5).

The Panel notes that it is not inconceivable to imagine legitimate use of the disputed domain name taking into account Upwork's business and a descriptive term "skills" that is a part of the disputed domain name and all circumstances of the case should be analyzed to reach a conclusion.

"Certain additional terms within the trademark owner's field of commerce or indicating services related to the brand, or which are not obviously critical may or may not by themselves trigger an inference of affiliation, and would normally require a further examination by the panel of the broader facts and circumstances of the case" (see WIPO Overview 3.0 par. 2.5.1).

In the present case, however, the Panel, having reviewed all the circumstances of the case and evidence available, agrees with the Complainants that nothing indicates any legitimate rights and interests of the Respondent.

Facts of this case do not allow to apply "nominative (fair) use" and Oki Data test criteria, in particular due to a failure of the

Respondent to “accurately and prominently disclose the registrant’s relationship with the trademark holder”.

Previous UDRP panels confirm this position (see e.g. The Procter & Gamble Company v. Whoisguard, Inc. / Enzo Gucci, Xtremcare, Tony Mancini, USDIET, USDIET Ltd, WIPO Case No. D2016-1881 –“there is no indication in the record that the Respondents have accurately disclosed their relationship with the Complainant…”; The Royal Edinburgh Military Tattoo Limited v. Identity Protection Service, Identity Protect Limited / Martin Clegg, WM Holdings, WIPO Case No. D2016-2290 -“the disclaimer introduced by the Respondents is not prominently displayed, and the wording used erroneously gives the impression that some form of agency arrangement exists”).

There is no information whatsoever disclosing relationship between the parties and even a small disclaimer explaining an unofficial nature of the website is absent.

The website under the disputed domain name cannot be considered non-commercial or fair under the circumstances of this case (see also FORUM Case No. FA1408001576766, Capsim Management Simulations, Inc. v. Charles Cook / Capsim Tutor - “the Panel concludes that Respondent’s efforts to profit from tutorials targeted at Complainant’s business simulation materials does not amount to a bona fide offering of goods or services under Policy 4(c)(i), or a legitimate noncommercial or fair use under Policy 4(c)(iii)”).

No other facts or circumstances of this case indicate legitimate rights and interests of the Respondent.

The Panel notes, in particular, that this case should be distinguished from CAC Case No. 101294 where the Panel found that “UPWORK” name was used in a referential sense and not a trade mark sense (“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 Panel in CAC Case No. 101294 also relied on speech protection (Freedom of Expression and Art. 10 ECHR) and there were some other relevant factors (i.e. some sort of identification of the respondent on the website– “Respondent is a professional Web Developer "working with Upwork for last 5 years [with] 3200+ hours logged", website’s nature – “a blog about freelancing”).

All these elements (“primarily descriptive use”, “free speech component”, “Respondent’s identification”) are absent in the present case.

Therefore, the Panel finds that the Complainants have satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

Some of such factors are listed in par. 3.2.1 of WIPO Overview 3.0 and are relevant in the present dispute (i.e. the nature of the domain name, the content of the website).

The UPWORK trademarks were already widely-know and distinctive by the time of registration of the disputed domain name (see Upwork Global Inc., Upwork Inc. v. Imran khan, All Education info. / Md Abdul Malek, 1Links.in / Aman Shah, BollyJoGot.com / Rubel SbS, Hostsbs, WIPO Case No. D2017-1104) and the Respondent’s use of the disputed domain name and content of the website (including use of a colored logo similar with the UPWORK logo) under the disputed domain name prove Respondent’s actual knowledge of Upwork and its trademarks (see e.g. CAC Case No.101660 - “key factors leading to that conclusion are the way that the logo used by the Respondent mimics that of the Complainant and the fact that Complainant promotes the services of Wordpress freelancers”; The Procter & Gamble Company v. Whoisguard, Inc. / Enzo

Gucci, Xtremcare, Tony Mancini, USDIET, USDIET Ltd, WIPO Case No. D2016-1881 -“it is a reasonable inference in the circumstances of this case that the Respondents registered the disputed domain name based on the attractiveness of the Complainant’s mark, in order to drive traffic to the Respondents’ websites, without accurately disclosing the Respondents’ relationship with the Complainant”).

The Respondent failed to respond to Complainants’ letter and failed to provide any response in this dispute. There is no information disclosing actual relationship between the parties and no proper disclaimer on the website under the disputed domain name.

To a website visitor it is unclear whether this is an unofficial website about Upwork or some website supported, operated by Upwork or affiliated with Upwork.

The Panel notes that in UDRP disputes the standard of proof is balance of probabilities (“more likely than not”) and facts and circumstances of the present dispute indicate that the Respondent’s conduct falls within 4 (b) (iii) and/or 4(b)(iv) of the Policy.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UPWORKSKILLS.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2019-07-16

Publish the Decision