Decision for dispute CAC-UDRP-100678

Case number	CAC-UDRP-100678
Time of filing	2014-07-03 12:41:01
Domain names	elence.com, odessk.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Elance, Inc.
Organization	oDesk Corporation

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Admin Manager LLC

Respondent representative

Name	Mr. William A Delgado Esq.

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

The ELANCE Trademark

The federally registered American ELANCE trademark has been in continuous use is in commerce since 1999. Elance owns numerous registrations for the ELANCE mark around the world, including but not limited to federal trademark registrations in the United States, such as: Reg. No. 2,772,962, first used in 1999, filed in January 2001, issued October 14, 2003, in Classes 35, 36, 38, and 42; Reg. No. 2,900,142, first used in 2002, filed in January 2001, issued in 2004, in Class 9.

These registrations also evidence the wide scope of protection to which the ELANCE name and mark is entitled.

The ODESK Trademark

Since at least as early as 2003, the ODESK mark has been in continuous use in commerce. oDesk owns numerous registrations for the ODESK mark around the world, including without limitation, federal trademark registrations in the United States, such as: ODESK, Reg. No. 2,906,076, issued November 30, 2004 with a priority application filing date of December 8, 2003, in Class 42; and Reg. No. 2906077, issued November 30, 2004 with a priority fling date of December 8, 2003, in Class 38; and others. These registrations also evidence the wide scope of protection to which the ODESK name and mark is entitled.

FACTUAL BACKGROUND

The ELANCE and ODESK trademarks are protected in the United States and have been continuously used in commerce since their registration.

The disputed domain name <elence.com> has been registered on December 13, 1999, whereas <odessk.com> has been registered on September 24, 2010.

The registrant of both disputed domain names was changed for the last time in 2014, from Oversee Domain Management to Admin Manager, LLC, domiciled in Los Angeles, in the United States.

Both domain names have been used to resolve to parking websites featuring the respective trademarks "Elance" and "Odesk" on the top of the website pages and providing links to the Comaplainants' websites www.elance.com and www.odesk.com, as well as to competitors' websites. They are also offered for sale online, on the respective websites, at the minimum price of $ 5000.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The Complainants' Rights and Priority

The Complainants have established rights in their ELANCE and ODESK trademarks through registrations with the USPTO.

As background, in April 2014, the name (but not the physical address or phone number) of the registrant for both disputed domains was changed from Oversee Domain Management to Admin Manager, LLC.

From the current and historical Whois records, as of October 16, 2008, the domain <elence.com> was registered to Internet Reit, Inc., and an affiliate of the Respondent, Portfolio Brains LLC, first registered the domain subsequently thereafter.

As of August 15, 2010, the domain <odessk.com> was registered to Jin Quian, Nanjing Panchuang, and an affiliate of the Respondent first registered the domain subsequently thereafter.

The Complainants claim that they first acquired their respective rights in their marks prior to when both of the domains were registered by the Respondent, either directly, or as part of any genuine conglomerate of which the Respondent is a part. Therefore, Complainants have established priority in their respective marks.

II. The Domain Names are Confusingly Similar to the Complainants' Protected Marks.

According to Complainants, a domain name which contains a common or obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name. Exchanging the single letter "e" for the letter "a" in the domain <elence.com> is an obvious misspelling of Complainant Elance's trademark ELANCE.

Similarly, adding the letter "s" to Complainant oDesk's mark ODESK in the domain <odessk.com> is an obvious misspelling.

Furthermore, the disputed domains are confusingly similar to the relevant marks because “[t]he practice of typosquatting has been consistently regarded in previous UDRP decisions as creating domain names confusingly similar to the relevant mark.” The practice of typosquatting is designed to take advantage of Internet users' typographical errors, which means the typos of the ELANCE and ODESK names must be confusingly similar by design.

III. The Respondent does not have any rights or legitimate interest in the domain names.

The Complainants contend that they have not authorized, licensed, or permitted the Respondent to register or use the disputed domain names or to use their respective trademarks. The Respondent is not known by the disputed domain names, nor has acquired any trademark rights in respect of the domain names.

The Complainants state that there is also no legitimate interest in typosquatting.

The Respondent uses the disputed domain names that have no primary dictionary meanings to host commercial websites that provide competing web portal links and general advertisement links to a variety of businesses and products, none of which is a bona fide offering of goods or services under the Policy.

Moreover, the Complainants claim that the Respondent offered highly related services that are likely to cause confusion. For example, if someone mistakenly visits either of the disputed domains, and then types into the search box the trademark to try and find more information, the Respondent displays links to the Complainants' websites together with competitive sites, such as Freelance.com.

Regardless of whether the Respondent consciously included links highly related or competitive with Complainants' services and marks or whether an algorithm over which the Respondent had limited or no control generated is irrelevant.

III. The domain names have been registered and are being used in bad faith.

The Complainants claim that not only are Respondent’s uses of the disputed domain names discussed above not a bona fide offering of goods or services under the Policy, but consonant with the illustration of bad faith in paragraph 4(b)(iv) of the Policy, given the fame and distinctiveness of the Complainants’ respective marks, the Respondent intentionally sought to commercially gain by some machination or scheme from the likelihood of confusion, whether through general paid advertising, or passing off the landing pages as belonging to the relevant Complainant by displaying confusingly similar marks ODESSK.COM and ELENCE.COM on or in connection with listings for services that are highly related or competitive to those covered by the ELANCE and ODESK registrations.

The Complainants contend that the Respondent has a history of cybersquatting, which is further evidence of its bad faith in this case.

As discussed above, the registrant for both disputed domain names was changed from Oversee Domain Management to Admin Manager, LLC, but the other Whois contact details, like the physical address and phone number, remain the same.

Examples given by the Complainants of famous trademarks that the Respondent is typosquatting on include <beatsbtdre.com>, <chritianlouboutin.com>, and <surveyminkey.com>. This supports that Respondent has engaged in a pattern of such conduct under paragraph 4(b)(ii) of the Policy.

The Respondent's typosquatting behavior is, in and of itself, also evidence of bad faith.

Furthermore, both domains have a link at the bottom of the sites to inquire about purchasing the domain, but inquiries are only taken for offers in excess of $5,000 per domain--well in excess of the out-of-pocket costs associated with registering such domains.

Therefore, according to the Complainants there is bad faith under Policy Paragraph 4(b)(i) as well.

RESPONDENT:

The Respondent asserts that it acquires domain names through lawful and fair methods. As part of its business practice, it has a well-known dispute resolution policy, inter alia, whereby it invites putative complainants to contact it regarding domain names that complainants believe correspond to a trademark. And it has a liberal transfer policy whereby it typically agrees to voluntarily transfer domain names, typically irrespective of the legitimacy of the complainant's arguments, in an effort to avoid the needless time and expense associated with litigation and administrative hearings.

The Respondent had never heard of either Complainant or its trademarks prior to the filing of this matter. Upon learning of this matter and in an effort to resolve this matter expeditiously and without a substantial investment of time and expense by either party or the Panel, the Respondent contacted the Complainants on multiple occasions and offered a voluntary transfer of the domain name at issue. The Complaintants have not agreed.

So, without admitting fault or liability and without responding substantively to the allegations raised by the Complainants herein, to expedite this matter for the Panel so that its time and resources are not otherwise wasted on this matter, the Respondent stipulated that it is willing to voluntarily transfer the Domain Names to the Complainants. For the reasons stated below, the Respondent requested that the transfer be ordered without findings of fact or conclusions as to Policy 4(a) other than the Domain Name be transferred.

According to the Respondent, in numerous prior UDRP decisions, Panels have consistently ruled that when a complaint has been filed and the respondent consents to the transfer of the domain name, it is inappropriate to issue any decision other than simply ordering the transfer of the domain name. Such panels consistently hold that it would be improper to issue any findings of fact in such cases.

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, 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).

The Respondent does not pretend to have any right or legitimate interest in both disputed domain names.

The Respondent has not been authorized, licensed or permitted to register and use them. Furthermore, it has not been commonly known by the disputed domain names and it is not making a legitimate non-commercial use thereof, in the meaning of Par. 4(c) of the Policy.

BAD FAITH

The Complainant has, 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).

The Respondent asserts that it acquires domain names through lawful and fair methods and that it applies a fair and well-known dispute resolution policy that could have been applied to the case.

Respondent is using an automatized system for acquiring and using domain names.

The case at issue concerns the registration of domain names which are misspelling prior trademarks and which are used to resolve to a parking website providing links to the Complainants' website and to competitors' websites.

The Respondent even reproduces the ELANCE and ODESK trademarks on the top of the respective parking websites. It shows that it is well aware of the Complainants' trademarks.

At the same time, each disputed domain name is offered for sale at a minimum price of $ 5000.

This whole system is clearly aiming at taking advantage of the Complainants' trademarks goodwill, for commercial gain.

The Panel finds that both domain names have been registered and used in bad faith, in the meaning of Paragraph 4 (b) (i) and (iii) of the Policy.

PROCEDURAL FACTORS

This is a Class Complaint filed on behalf of Elance, Inc. and oDesk Corporation, and is filed pursuant to Paragraph 4, Art. 3 of Czech Arbitration Court's (CAC's) UDRP Supplemental Rules.

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.

In light of the Respondent's consent to transfer of the Domain Name, is it necessary for the Panel to proceed to a reasoned decision?

The Respondent requests the Panel to issue a decision ordering the transfer without any further findings of fact or liability.

It relies on prior cases where the panel has granted the relief requested on the basis of Respondent's consent without a review and analysis of the facts supporting the claim. Others have held that the consent to transfer is effectively a concession that the three elements of the Policy are met.

The Respondent stated that it “acquires domain names through lawful and fair methods” and that ‘it has a liberal transfer policy whereby it typically agrees to voluntarily transfer domain names, typically irrespective of the legitimacy of the complainants ‘arguments, in an effort to avoid the needless time and expense associated with litigation and administrative hearings”.

The Panel is of the view to rely on the Rules that govern the UDRP procedure.

As any domain name owner, the Respondent is subject to a UDRP dispute, in case a third party wants to request the transfer or the cancellation of one of its domain names.

The Respondent does not explain the rules that govern its own dispute resolution policy. It does not explain how it is supposed to ensure a fair and equal legal treatment of the submitted cases.

Offering to settle any dispute on the basis of its own resolution policy can not exclude the application of the UDRP Rules.

Paragraph 10 of the Rules sets out the General Powers of the Panel as follows:

“(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence”.

Paragraph 15(a) of the Rules provides that:

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 17 of the Rules governs termination of a proceeding in the following terms:

“(a) If, before the Panel's decision, the Parties agree on a settlement, the Panel shall terminate the administrative proceeding.

(b) If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel”.

The Panel is designated in order to issue a decision and the procedure can be terminated only in the cases identified in Paragraph 17 of the Rules. None of these conditions is fulfilled.

No suspension of the proceeding has been requested by the Complainants, in order to amicably settle the case.

For the foregoing reasons, the Panel decides to issue a decision based on the analysis of the three elements of paragraph 4(a) of the Policy.

PRINCIPAL REASONS FOR THE DECISION

The Complainants have prior rights on American ELANCE and ODESK trademarks.

The disputed domain names <elence.com> and <odessk.com> are misspelling the Complainants' trademarks. Therefore, the Panel finds that they are confusingly similar.

The Respondent has no right or legitimate interest in the disputed domain names.

The Respondent does not pretend to have any right or legitmate interest in both disputed domain names. It has not been authorized, licensed or permitted to register and use them. Furthermore, it has not been commonly known by the disputed domain names and he is not making a legitimate non-commercial use thereof, in the meaning of Par. 4(c) of the Policy.

Both domain names have been registered and used in bad faith.

The Respondent asserts that it acquires domain names through lawful and fair methods and that it applies a fair and well-known dispute resolution policy that could have been applied to the case.

As any domain name owner he is subject to a UDRP dispute in case a third party wants to request the transfer or the cancellation of one of its domain names. Offering to settle any dispute on the basis of its own resolution policy can not

exclude the application of the UDRP Rules.

The case at issue concerns the registration of domain names which are misspelling prior trademarks and which are used to resolve to a parking website providing links to the Complainants' website and to competitors' websites.

The Respondent even reproduces the ELANCE and ODESK trademarks on the top of the respective websites. At the same time, each disputed domain name is offered for sale at a minimum price of $ 5000. This whole system is clearly aiming at taking advantage of the Complainants' trademarks goodwill.

The Panel finds that both domain names have been registered and used in bad faith, in the meaning of Parapgraph 4 (b) (i) and (iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ELENCE.COM**: Transferred
2. **ODESSK.COM**: Transferred

PANELLISTS

Name	**Marie Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2014-08-25

Publish the Decision