Decision for dispute CAC-UDRP-102645

Case number	CAC-UDRP-102645
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Domain names	odeskwork.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Upwork Global Inc.
Organization	Upwork Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Organization	automax

OTHER LEGAL PROCEEDINGS

The Panel became aware of the following proceedings which relate to the disputed domain names:

1) CAC Case No. 102549 in regard to <odeskwork.biz> and <odeskr.com>, brought by the Complainant in the present proceeding against the same Respondent as in the present proceeding and making also substantially the same allegations concerning the Respondent’s registration and use of these additional disputed domain names.

2) A trademark opposition made by the Complainant on 15 November 2019 at the Indian trademark registry, Intellectual Property India, against the Respondent’s application for the trademark “ODESKWORK” (No. 4181541 of 20 May 2019).

3) Earlier trade mark opposition proceedings brought by one or more third parties against the Complainant's application No. 2226193 to register "ODESK" as an Indian trade mark.

As to 1), the Panel pointed out the intimate connection between CAC Cases 102645 and 102549 and requested the Parties

to consider consolidation of the two proceedings. The Respondent requested such consolidation while the Complainant left the matter to the Panel's discretion. Accordingly, the Panel directed the consolidation of Case 102549 into the present proceeding. It did so pursuant to Paragraph 4(f) of the UDRP as the first-appointed Panel in the two cases and in exercise of the discretion that provision grants.

As to 2), an indication was made in the Case File of the opposition, which the Panel verified in exercise of its general powers under Paragraph 10 of the Rules. Since no request was made by either Party to suspend the present proceeding and, in the Panel's view, it poses no obstacle to it reaching a Decision, the Panel simply takes note of the parallel proceeding.

As to 3), the Panel discovered this opposition had occurred upon scrutiny of the Parties' rights in preparing the Identification of Rights section of this Decision, below. It informed the Parties accordingly and invited observations. Neither Party has contested the information in this regard which is contained in that section.

IDENTIFICATION OF RIGHTS

COMPLAINANT:

The Complainant adduced evidence of its ownership of the following trade marks for "ODESK", rendered here by country, registration number, type, Nice Classification class(es) and date of registration:

(1) Australia; No. 1455986; Word; Classes 9, 42; 4 June 2012;
(2) Canada; No. TMA866252; Word; Classes 9, 35, 41; 29 November 2013;
(3) European Union; No. 010370054; Word; Classes 9, 35, 42; 05 March 2012;
(4) India; No. 2226193; Word; Classes 9, 35, 42; 10 August 2018*;
(5) United States; No. 2906076; Word (with stylized/illustration elements); Class 42; 30 November 2004;
(6) United States; No. 2906077; Word (with stylized/illustration elements); Class 38; 30 November 2004;
(7) United States; No. 4696235; Word; Classes 9, 35; 3 March 2015.

* The date of the Complainant's application was 28 October 2011. The application was opposed in September 2013. Following the close of the opposition proceedings in March 2018, the registration certificate was issued on 10 August 2018.

For ELANCE-ODESK: Australia; No. 1640135; Word; Classes 35, 38, 42; 3 March 2016.

The Complainant is the holder of the domain names <odesk.com> and <elance.com>, as well as of <upwork.com>, among others.

RESPONDENT:

The Respondent adduced evidence of its application to register the trade mark "ODESKWORK" in Nice Classification Class 35 (which includes services to help in the working of an undertaking) at the Indian trade mark registry, Intellectual Property India. The application, No. 4181541, was made on 20 May 2019 and was accepted and advertised (after official examination) on 15 July 2019. As noted above, the Complainant has opposed registration; links from the Complainant's evidence to Intellectual Property India's status page for the application show that a decision on the opposition is not imminent.

The Respondent's evidence further shows that he was entered on the Indian enterprise register ("Udyog Aadhaar") under the

trading name of "ODESKWORK" through a filing made on 1 November 2018 and that he established the company ODESKWORK PRIVATE LIMITED on 18 November 2019.

Lastly, the Respondent has shown that he has held the disputed domain name <odeskwork.com> since 24 October 2017, <odeskwork.biz> since 16 September 2019, and <odeskr.com> since 24 November 2017, and that he became the holder of the .in ccTLD domain name <odeskwork.in> on 29 October 2017 -- a domain name which lies outside the scope of the UDRP.

FACTUAL BACKGROUND

The Complainant, Upwork, consists of a parent company and its subsidiary established in the US state of Delaware but operating from Silicon Valley in California. It is in the business of intermediating between those offering their freelance services (including via agencies acting on their behalf) and those clients interested in the services offered. It operates globally over a sophisticated platform and has achieved prominence in what is inherently a highly competitive market. Logos of several well-known companies who are Upwork's clients appear on its website's home page.

Upwork adopted its current corporate name in 2015 and updated its details in this connection at the registries where it held trade mark registrations. Before then, its corporate name was “Elance-Odesk”. That name had itself been adopted following a merger of two companies that had named themselves after their respective "Elance" and "Odesk2 platforms, both of which had been providing services in the same market segment as Upwork today. The merger was announced at the end of 2013.

With its change in corporate identity, Upwork in 2015 consolidated the two legacy platforms technically and in terms of branding into a new platform, the current <upwork.com>. In pursuing this transition Upwork retained the <elance.com> and <odesk.com> domain names. Both redirect to <upwork.com> and no longer to their own websites. Upwork also retained the trade marks ELANCE and ODESK, as noted under Identification of Rights above.

The transition to Upwork's new platform had been completed by the time of the present consolidated proceeding. Neither of the legacy names is prominent on the current version of the <upwork.com> website although some references to ODesk can be found there with the help of the on-site search facility.

The Respondent is a natural person with an address in the city of Jaipur in the Indian state of Rajasthan. He has for several years conducted business in film, video and animations production. The Respondent became the holder of the disputed domain names between 24 November 2017 and 16 September 2019 but has only used <odeskwork.com> actively, for a website and email facilities. The website is an intermediary platform in the same business area as <upwork.com> of freelance intermediation, but has several different features. Among them, the currency used is the Indian rupee. It is also much less sophisticated in design and lacks prominent client logos. Many of the individuals whose details appear on the site offer their services at very low hourly rates, although there are some postings at very high ones.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The following is a composite of the contentions advanced by the Parties in the consolidated cases, with reference being made to either case only where indispensable. The same applies to reference to the three disputed domain names in this case.

COMPLAINANT:
The Complainant introduces its arguments by asserting for the Respondent’s benefit that “merely filing trademark applications that have not [sic] registered would have no bearing on this administrative proceeding because no rights are

incurred by virtue of any such filing." It invokes to support this position the National Arbitration Forum Decision in National Cable Satellite Corp., d/b/a C-SPAN vs. Michael Mann / Omar Rivero, FA1707001741966 (2017).

As to the test of proof to be fulfilled, the Complainant asserts that it is the balance of probabilities, and goes on in this regard to suggest that "the Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory", citing as an example for the acceptability of this proposition the National Arbitration Forum Decision in Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095 (2000).

On the substance, the Complainant contends that:

. with respect to its own rights for the purposes of the first UDRP criterion, it refers to its ODESK trade marks and avers that it still uses the ODESK mark in connection with its Upwork platform, including to advertise that ODesk is now part of Upwork and to help those looking for the ODesk platform to navigate to the Upwork one;
. earlier (successful) typosquatting claims under the UDRP related to its rights in ODESK and ELANCE substantiate the Complainant's standing;
. mere addition in the disputed domain names <odeskwork.com> and <odeskwork.biz> of the word "work" to its registered mark ODESK renders it "highly related to Upwork's online marketplace", disregarding of course the technical gTLD suffixes in all three disputed domain names;
. the disputed domain names are all confusingly similar to the Complainant's registered mark ODESK in that they merely append a single letter ("r") or generic word ("work") to it, it having been found in other ADR cases that "small changes, such as adding a letter, does not usually change the perception of a mark within a domain name";
. beyond the initial confusion for internet users created by the similarity of the disputed domain name to the Complainant's trade mark and prominent brand, the Respondent's <odeskwork.com> website compounds the confusion because it "intentionally mimics the look and feel of Upwork (stylization, colors, layout, etc) to purportedly offer for sale, essentially the same services but that are unexpectedly, not actually under Complainants' management, supervision or control as would otherwise be expected" by the site visitor, as a side-by-side demonstrative comparison provided in evidence by the Complainant shows;
. as regards the second UDRP criterion (absence of rights or legitimate interest), the Respondent "certainly knew of Upwork, and either knew of Upwork's claim of trademark rights in the ODESK Marks or acted with indifference to the existence of such rights";
. the Respondent's application for a trade mark and business registration create no legitimate interest in particular but does show that he knows how to check the status of a trade mark in India;
. the Respondent is furthermore not commonly known by the disputed domain name, as evidenced by the registrar verification response;
. as regards the final UDRP criterion of bad faith, the Respondent is engaging in a competitive business in the same market segment as the Complainant and is trading on the Complainant's goodwill in its ODESK trade mark to do so, thereby creating a likelihood of confusion on the part of internet users;
. the Respondent's copying of significant parts of the Upwork site content and design, as indicated by a demonstrative side-by-side comparison already mentioned, is a clear indication of bad faith;
. the Respondent has also engaged in phishing through gathering the login data of users of the Complainant's platform by inducing in them the mistaken belief that the Respondent's platform <odeskwork.com> is related to it;
. the Respondent is therefore without any justification or authorization diverting traffic for his own commercial gain that would be intended for the Complainant, meaning bad faith must be presumed;
. this presumption is reinforced by evidence of the Respondent's passive parking of the disputed domain name <odeskwork.biz> in order to benefit from pay-per-click advertisements.

The Complainant furthermore alleges bad faith both at registration and in the use of the disputed domain names. It finds it inconceivable that the Respondent could append the term "work" to ODESK for freelance related services in ignorance of tens of thousands of links specifically related to Upwork's business. For, when oDesk and Elance announced the merger at the end of 2013, there was already more than a billion dollars of work completed cumulatively via the ODESK platform with clients that are among the best known companies in the world.

RESPONDENT:

The Respondent:

- In regard to the Complainant's rights:

. denies that a mark that may be well known in the United States means that it also is in India;
. disputes that, in India, the Complainant enjoys longstanding protection of its trade mark, noting, to the contrary, that the evidence of rights shows that registration of the Complainant's "ODESK" was only completed on 10 August 2018 due to long-running opposition proceedings beforehand;
. calls into question the distinctiveness of the Complainant's ODESK mark itself, saying that it is mainly composed of a common (generic) word, which, being descriptive, is open to anyone to use and invokes the Decision in WIPO Case No. D2008-1475 Advance News Service Inc. v. Vertical Axis, Inc. / Religionnewsservice.com in support of this proposition;
. contends that even a Complainant having multiple trade marks for different services cannot target any single domain name simply on this basis of it since every trade mark has its limitations of scope;
. denies that he is the holder of the domain name <odeskworkr> as incorrectly stated in the Complaint in consolidated Case 102549, this being a domain name that is still available for registration;

- In regard to the Complainant's allegation of confusing similarity:

. points out that the "ODESKWORK" stem in the disputed .com and .biz domain names is not identical to "ODESK" and refutes the confusing similarity alleged by the Complainant;
. contends that the Complainant's and the Respondent's sites are demonstrably "entirely" different, from logo to site design to the technology employed, the Respondent's site using WordPress and a design theme supplied by FreelanceEngine under licence;
. asserts that, therefore, users will be aware of the differences in the sites and their functions;
. provides in evidence his own demonstrative side-by-side comparison of the two websites, both to show that the <odeskwork.com> website is a genuine one with distinct features and to demonstrate that it is run in a bona fide and honest manner, as shown by refunds made to dissatisfied clients;
. refutes that there is any presumption that ordinary visitors will be confused, arguing that the Complainant has not offered proof in this regard or more generally;
. adduces evidence of other trade marks close in appearance to the Complainant's ODESK trade mark that have been registered in India, notably ODESKART;

- In regard to the Complainant's allegations of absence of rights or legitimate interest on his part:

. avers that he is known (locally) by virtue of his computer goods and desk work services and that the addition of an "o" to "deskwork" in two of the disputed domain names and in his business and his company's corporate registration signifies "operate's" [sic];
. avers (but without submitting proof) that since becoming holder of the disputed domain name <odeskwork.com> he is known by professionals and clients also in this manner;
. invokes in support of these contentions his longstanding professional background that dates from before 2009 in the areas of film and video production, VFX (integration of actual and animated footage), 2-D and 3-D animations, and automotive, news and computer "deskwork" related services;
. avers that, under the name Automax, he had by 2016 achieved success in the offline local market for computer deskwork services and then decided to offer his services over an online platform, "ODESKWORK", that he established in 2017 under the disputed domain name <odeskwork.com>;

. relies on his (application) for the word trade mark “ODESKWORK” and its subsequent acceptance by the trade mark registry examiner;
. claims further legitimation is provided by the business and corporate registrations referred to in Identification of Rights that repeat the name “ODESKWORK”, above;
. notes that there has been no cancellation of any kind of the ODESKWORK name in India, in relation to the Complainant’s indication that it may seek this;
. countering allegations of illegitimate use, shows that the Complainant introduced a claim of phishing against <odeskwork.com> with HostGater and that HostGater dismissed the claim;
. refutes in particular the suggestion that users of the Complainant’s <upwork.com> platform are at risk of entering their log-in details if attempting to log in at <odeskwork.com>, since the latter has a different type of user interface and excludes entry of unrecognized credentials;
- In regard to the Complainant’s allegations of bad faith:
. avers that he had no idea that the Complainant held a similar domain name or trade mark at the point of registration because there were no “working websites or domain names” then that represented “oDesk” and cites in his support the WIPO Decision in Craig Media, Inc. v. Kim Hungho, No. D2004-0091;
. refers to the availability for registration of the disputed domain names at the time he became holder of them;
. avers that he became aware of Upwork’s connection to ODESK only at a later stage, by when Upwork had long phased out the oDesk and eLance platforms;
. points out the delay of over three years since the Respondent’s registration of the first of the disputed domain names, indicating that the Complainant did not truly believe that the registration was in bad faith;
. explains that site content-writers whom the Respondent hired were responsible for introducing some similarities to the content of the <upwork.com>, which, upon discovery, were promptly removed by the Respondent, as shown by his side-by-side comparison;
. denies that use of the disputed domain name in connection with email is in any way illegitimate but rather normal use in connection with the Respondent’s operation of its website in order to correspond with users;
. avers that he has registered other domain names incorporating variations of the descriptive words “Work” and “Desk”;
. alleges that the Complainant sought to obtain the transfer of the disputed domain name (deskwork.com) through an offer of payment, which the Respondent refused;
. alleges that the Complainant is making false and baseless claims and moreover subjecting the Respondent to further unfounded allegations such as the complaint of phishing mentioned above that HostGater rejected;
. mentions, without explanation, reverse domain name hi-jacking and registration of a domain name prior to a trade mark.

RIGHTS

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

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

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

As noted under “Other Legal Proceedings” above, the Panel exercised its discretion in accordance with Paragraph 4(f) of the Policy to consolidate proceeding CAC Case 102549 into the present proceeding.

The consolidation took place in three steps:

(1) The Panel informed the Parties of the procedural possibility of consolidation in light of the circumstances in the two proceedings.

(2) Having received the Parties' views, including a formal request for consolidation from the Respondent, the Panel issued a Procedural Direction in the form of a Non Standard Communication (NSC) requesting the Case Administrator to implement the consolidation including with respect to the Case File in the present proceeding.

(3) The Case Administrator entered the pertinent documents from CAC Case 102549 into the present proceeding's Case File by means of an NSC and closed CAC Case 102549 on the adr.eu platform.

In regard to the trade mark opposition proceedings before Intellectual Property India, the Panel takes note of them but finds it unnecessary to consider a suspension of the proceeding under Paragraph 18 of the Rules in the absence of any request to do so.

The Panel exercised its general powers to make additional inquiries of its own at sources indicated in the Case File, where it considered details required clarification. This concerned particularly the Parties' respective websites as well as registrations or proceedings mentioned in the Case File.

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

1. Procedural factors

The Complainant in this consolidated case:

(1) Initiated this proceeding and another proceeding against the same Respondent in relation to the same domain name stem in the knowledge that their respective <.com> and <.biz> gTLD extensions, being purely technical suffixes, would be almost certainly disregarded in both proceedings;
(2) During both cases' pendency, initiated trade mark opposition proceedings in India whose outcome might be material to the present consolidated proceeding;
(3) In respect of its Indian trade mark in the description of its rights, failed to disclose the registration date, whereas it set forth both the application (or priority) and the registration date in respect of the other trade marks it relies upon;
(4) Repeated in that description, again only in respect of its Indian trade mark, the same trade mark by reference to each class in which it relates as separate items, whereas the other items are arranged according to different trade marks irrespective of how many Nice Classification classes they cover;
(5) Alleged that the Respondent registered the domain name <odeskworkr.com>, whereas the domain name actually registered was <odeskr.com>;
(6) Suggested to the Panel in this contested case that it is "entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory", citing the example of Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095 (2000).

The Panel takes no issue with (2); the Complainant is of course free to pursue opposition proceedings.

However, the impression the Panel has formed from the above points as a whole is that the Panel is constrained to exercise caution in respect of the Complainant's submissions, lest it be misled.

There can in particular be little justification for (1), which carries with it the danger of gamesmanship between proceedings and thus a real potential for abuse of process.

The Panel also takes exception to either Party in a contested proceeding inviting the Panel to accept whatever that Party says as being true absent clear evidence of contradiction. It notes that the case the Complainant cites was an uncontested one and what that Panelist actually said was that "As a result [of the Respondent submitting no response in the matter], all reasonable inferences of fact in the allegations will be deemed true". By contrast, what the Complainant is suggesting is tantamount to the Panel abandoning its core duty of impartiality under the Rules.

In regard to (3) and (4), the Panel has specified the Complainant's trade mark rights in India not as stated but as forming one trade mark under Identification of Rights, above. It will also treat the reference to <odeskworkr.com> instead of <odeskr> at two places in the Complaint in consolidated case 102549 as oversights in view of the clear specification of the latter in the Case File.

As to the Respondent's mention of reverse domain name hijacking, the Panel notes that this was not developed into a full allegation in either Response in this consolidated proceeding and does not consider the above points to amount to this in any event.

2. The first UDRP criterion: identicality or confusing similarity to a trade mark in which the Complainant has rights

It is uncontested that the Complainant has rights thanks to its ODESK trade marks, which are well evidenced. It accordingly has standing to bring both of the claims in this consolidated proceeding.

Beyond this basic prerequisite, there is also no question of identicality between the Complainant's marks and any of the disputed domain names; they are different.

The remaining question is twofold: a) is the scope of the Complainant's rights sufficient in the circumstances of this case and b) are the disputed domain names different enough in these circumstances so as not to be confusingly similar?

As to a), the UDRP's first criterion does not call for the Complainant to be the proprietor of a trade mark in every jurisdiction on Earth. One somewhere will suffice in principle. Nevertheless, that is not the end of the matter; the absence of a trade mark in a particular jurisdiction may then open the possibility for others to assert their different and competing rights which they enjoy in that jurisdiction under the second URDP criterion.

As to b), the test of confusing similarity is one derived from trade mark law that boils down to a global appreciation of the two marks in question in order to determine whether a claimant has proved a likelihood on the part of the public of confusion, notably as to the source of the product or service concerned. The confusion caused can be visual, aural or

conceptual in light of the distinctive and dominant elements of the trade mark itself and the competing mark.

In this consolidated proceeding, despite the Respondent's contentions, the dominant element in the variant of ODESK in <odeskr.com> is unquestionably the string composed of the identical first five letters. The single additional character "r" produces little that is distinctive in any way in relation to the rest of the stem or the <.com> extension. Confusingly similarity is thus evident.

This confusing similarity is moreover still relevant legally even if today the mark's owner wants its users to think of the Complainant and its platform only in terms of its UPWORK mark and brand. For the Complainant still maintains its <odesk.com> and <elance.com> domain names to redirect those seeking either of the old platforms – even several years after rebranding – to navigate to the service they seek from the provider they are seeking.

Moreover, at some point in the future the Complainant may decide to launch an oDesk brand again for some purpose. That is its perfect right, just as it is the right of any trade mark owner anywhere to act similarly in the course of its product and branding strategy.

It is true that there is a "use it or lose it" approach that States often adopt within the first five years of a trade mark's life. But this does not apply to the Complainant. It used its oDesk trade mark to the tune of a billion dollars and amassed much goodwill in the process that it might wish to exploit at a suitable point. To be sure, policy objections have been made to "trade mark cluttering" on the part of owners who no longer use marks; but matters have not yet reached the point at which a doctrine akin to desuetude applies to idle trade marks by law.

It is also no answer to the Complainant's assertion of its trade mark rights to mention that this disputed domain name was available for registration.

As to the other two disputed domain names, <odeskwork.com> and <odeskwork.biz>, their similarity to ODESK is less great. The dominant and distinctive part is nevertheless imparted by the first part of their stem, namely ODESK. The likelihood of confusion is also less, but it still persists, particularly since, by adding "WORK", the compound noun becomes more readily intelligible and brings it closer to the Complainant's rebranding of itself and its platform to "UPWORK".

Nor does the intended meaning of the one-letter prefix – in ODESK undoubtedly "online", in ODESKWORK, "operative" – make a difference, as in both cases it could be obscure to some users but the resulting compound nevertheless remains quite distinctive by producing an arbitrary variant to the descriptive word, "DESK" on its own.

It is thus difficult to avoid a conclusion of confusing similarity in regard to all three disputed domain names.

3. The second UDRP criterion – absence of rights or legitimate interests in respect of the domain names on the part of the Respondent

The purpose of the second criterion is to subtract the scope of deserving particular cases from the wide range of claim allowed under the first criterion.

The Respondent falls outside that scope for the disputed domain name <odeskr.com> because he has no trade mark of his own in “ODESKR” while mere registration of a domain name does not of itself establish a legitimate interest. Were this not so, no cybersquatter would ever lose a domain name. The Panel further finds the other arguments advanced by the Respondent in regard to this disputed domain name unconvincing.

As to the disputed domain names <odeskwork.com> and <odeskwork.biz>, the Respondent has observed that, at the time of registration of the former domain name in 2017, the Complainant’s trade mark application in India for ODESK had been made but was being opposed. Yet the opposition proceeding had concluded more than a year before the Respondent applied for the trademark “ODESKWORK” in India and the Complainant’s trade mark been granted nine months before the Respondent’s application. There was also no reason why the Respondent could not detect the existence of the Complainant’s trade mark in India; Intellectual Property India provides transparent and user-friendly information as well as efficient search facilities on its website for all.

In the circumstances of this case, it is certain that the Respondent has built up a significant interest in his <odeskwork.com> domain name and the platform he built for it. But this has taken place without a legal right that can be invoked against the Complainant (subject to the outcome of the present trade mark opposition proceeding) and without a legitimate interest. This is because, when conducting business in the same market segment as the Complainant but without having a legal right to use its name, there is at least the possibility of the Respondent obtaining the benefit of goodwill that is the Complainant’s. It furthermore makes no difference that the Respondent has registered himself as “ODESKWORK” in the Indian enterprise register or established a company whose name includes “ODESKWORK”.

The Panel must therefore find that the Respondent does not have rights or interests for the purposes of the UDRP’s second criterion.

Should, however, the Respondent have reason to believe that the opposition proceeding brought by the Complainant against the Respondent in India will fail, the Respondent remains in a position to challenge this finding before a court in India and to ask for this Decision to be stayed in its effect until all opposition proceedings have been completed.

4. The third UDRP criterion – bad faith

The Panel finds that the Respondent has acted honestly in this proceeding. From the Respondent’s own submissions, it is moreover apparent that what must have induced the Respondent to register the disputed domain names was a rebranding on the Complainant’s part that suggested its former brand oDESK had been abandoned, thereby creating an entrepreneurial opportunity in the area of freelance intermediation for the Respondent to seize.

On the other hand, as the Complainant points out, the Complainant still retained its rights and for a considerable time it did include on its website mention that Upwork is the former oDesk. In these circumstances, the Panel considers that the Respondent must at some level have suspected that it ought to ask the Complainant first before adopting the latter's trade mark in the Respondent’s domain name identity and subsequent trade under that identity.

To this limited extent, the UDRP standard for bad faith is met, and it is particularly the circumstance that the Respondent obtained registration of the disputed domain name <odeskr.com> only a month after obtaining <odeskwork.com> in 2017 that supports this conclusion.

Decision

For all the reasons stated above, the Complaint is:

Accepted

and the disputed domain names are to be:

Transferred to the Complainant

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ODESKWORK.COM**: Transferred
2. **ODESKWORK.BIZ**: Transferred
3. **ODESKR.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2019-12-09

Publish the Decision