

## **ADMINISTRATIVE PANEL DECISION**

Asana, Inc. v. Privacy service provided by Withheld for Privacy ehf / Malo Demino

Case No. D2022-1595

### **1. The Parties**

Complainant is Asana, Inc., United States of America (“United States”), represented internally.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Malo Demino, United States.

### **2. The Domain Name and Registrar**

The Disputed Domain Name <asanacareer.com> (hereinafter the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2022. On May 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on May 10, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 10, 2022, and on May 31, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on June 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 22, 2022.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on June 28, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

Complainant offers a work management platform that helps teams orchestrate their work, from daily tasks to cross-functional strategic initiatives. Since at least 2009, Complainant has used the ASANA trademark in connection with the aforementioned services.

Complainant owns several United States trademark registrations for the mark ASANA (Reg. No. 4,057,052, Registered November 15, 2011; Reg. No. 4,126,017, Registered April 10, 2012; Reg. No. 4,214,394, Registered on September 25, 2012; Reg. No. 6,264,426, Registered February 9, 2021) (the “Mark”). Complainant also owns multiple domain names incorporating its ASANA trademark, including <asana.com>, <asana.org>, <asanacareers.com>, <asanajob.com>, <asanawork.com>, and <asa.na>. Complainant’s primary domain name, <asana.com> was registered on January 21, 2009, and it uses this domain name for its company email addresses (@asana.com), for both internal and external communications.

Respondent registered the Disputed Domain Name on April 21, 2022, long after Complainant registered its ASANA mark. The Disputed Domain Name resolves to an inactive webpage.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that its mark is well known by virtue of its use of the ASANA mark in connection with its work management platform and related services since at least 2009. Complainant states that more than 100,000 organizations pay for Complainant’s services, and millions of organizations freely use Complainant’s services in 190 countries.

Complainant became aware of the Disputed Domain Name when individuals who had received emails from the email address associated with the Disputed Domain Name, [...]@asanacareer.com (the “Disputed Email Address”), contacted Complainant about nonexistent job offers that were discussed in these emails.

Complainant contends that the Disputed Domain Name is confusingly similar to its ASANA mark, as the Disputed Domain Name incorporates the entirety of the Mark, merely adding the term “career” after the Mark. Complainant claims that the inclusion of the term “career” exacerbates the risk of consumer confusion because the Disputed Domain Name is being used as part of a phishing scam offering jobs at Complainant’s company.

Next, Complainant states that Respondent has no rights or legitimate interests in the Disputed Domain Name, as Complainant has not authorized Respondent to use the Disputed Domain Name. According to Complainant, Respondent also has been using the Disputed Domain Name to impersonate an employee of Complainant to send fraudulent recruiting emails, aimed at obtaining confidential personally identifiable information from the recipients. Complainant contends that Respondent registered the Disputed Domain Name solely to further this phishing scam.

Finally, Complainant alleges that Respondent registered and continues to use the Disputed Domain Name in bad faith. Complainant contends that Respondent’s use of the Disputed Domain Name to impersonate an employee of Complainant is evidence of Respondent’s knowledge of the Mark. Complainant further claims that Respondent’s use of the Disputed Domain Name in a phishing scheme is evidence of bad faith. In light of Respondent’s purported knowledge of Complainant’s goodwill in the ASANA mark, Respondent is not capable of using the Disputed Domain Name for a legitimate purpose.

## B. Respondent

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that Complainant's trademark registrations establish that it has rights in the ASANA mark. The Panel further finds that, because the Disputed Domain Name incorporates Complainant's mark entirely, it is confusingly similar to Complainant's registered marks. Respondent's addition of the term "career" in the Disputed Domain Name does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; see also *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (transferring <ge-recruiting.com>).

### B. Rights or Legitimate Interests

Complainant has presented a *prima facie* case for Respondent's lack of rights or legitimate interests in the Disputed Domain Name, which Respondent has not rebutted. Complainant has not authorized Respondent to use its trademark. Respondent also has not answered this Complaint and there is no evidence or reason to suggest Respondent is, in fact, commonly known by the Disputed Domain Name or that Respondent is using the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

The use of an email account to send emails falsely purporting to be Complainant also does not give rise to rights or legitimate interests in the Disputed Domain Name. Use of a domain name for illegal activity, such as impersonation, can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#), section 2.13; see also *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) ("phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name.")

The Panel finds that Respondent does not have rights or a legitimate interests in the Disputed Domain Name and that Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

The Panel finds that Respondent registered and is using the Disputed Domain Name in bad faith. Respondent was likely aware of Complainant and its rights in the ASANA trademark when Respondent registered the Disputed Domain Name as evidenced by Respondent's use the Mark to register the Disputed Domain Name and Respondent's sending of emails from the Disputed Email Address advertising job openings at Complainant's company. Respondent's incorporation of the term "career" in the email address supports an inference of an intent to deceive recipients into mistakenly believing there is an affiliation with Complainant's recruiting department. This constitutes bad faith. See *Minerva S.A. v. Whoisguard Protected, Whoisguard, Inc. / Greyhat Services*, WIPO Case No. [D2016-0385](#) (the disputed domain name was registered and used in bad faith by sending fraudulent emails in an attempt to create a likelihood of confusion between it and the Complainant); see also *BHP Billiton Innovation Pty Ltd. v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#) ("[T]he use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.").

The evidence supports the finding that Respondent sought to use the Disputed Domain Name to promote a phishing scheme targeting individuals that sought employment with Complainant. Use of a domain name in connection with phishing is bad faith use. [WIPO Overview 3.0](#), section 3.4; see also, e.g., *Sarepta Therapeutics, Inc. v. Domain Privacy Service FBO Registrant, The Endurance International Group, Inc. / Name Redacted*, WIPO Case No. [D2020-3239](#) (the disputed domain name was registered and used in bad

faith because the respondent used the disputed domain name incorporating complainant's mark to send emails making false offers of employment with complainant).

Complainant has satisfied paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <asanacareer.com>, be transferred to the Complainant.

*/Lawrence K. Nodine/*

**Lawrence K. Nodine**

Sole Panelist

Date: July 12, 2022