



UNITED PARCEL SERVICE)
OF AMERICA, INC.)
c/o Greenberg Traurig, LLP)
3333 Piedmont Road, NE)
Suite 2500)
Atlanta, GA 30305)
))
(Complainant))
))
v.)
))
BETH BRESLAW)
104 Montgomery St)
Brooklyn, New York 11225)
US)
))
(Respondent))
_____)

Domain Names In Dispute:
<www.upsfteamstersunited.org>
<www.upsteamstersunited.org>

**COMPLAINT IN ACCORDANCE WITH
THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

[1.] This Complaint (“Complaint”) is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (Policy), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999, and the Rules for Uniform Domain Name Dispute Resolution Policy (UDRP Rules), with an effective date of July 31, 2015, and the National Arbitration Forum’s (FORUM) Supplemental Rules (Supp. Rules), included as **Annex 1**, **Annex 2**, and **Annex 3**. UDRP Rule 3(b)(i).

[2.] **COMPLAINANT’S INFORMATION**

- [a.] Name: United Parcel Service of America, Inc. (“UPSoA”)
- [b.] Address: c/o Greenberg Traurig, LLP
3333 Piedmont Road, NE, Suite 2500
Atlanta, GA 30305
- [c.] Telephone: 678-553-4778
- [d.] Fax: 678-553-4779
- [e.] E-Mail: <feldmanjoel@gtlaw.com>; <atldomains@gtlaw.com>

INFORMATION FOR COMPLAINANT’S REPRESENTATIVE

UDRP Rule 3(b)(ii).

- [a.] Name: Joel R. Feldman, Greenberg Traurig, LLP
- [b.] Address: 3333 Piedmont Road, NE, Suite 2500, Atlanta, GA 30305
- [c.] Telephone: 678-553-4778
- [d.] Fax: 678-553-4779
- [e.] Email: <feldmanjoel@gtlaw.com>; <atldomains@gtlaw.com>

UPSoA’s preferred method for communications directed to UPSoA in the administrative proceeding (UDRP Rule 3(b)(iii)):

Electronic-Only Material

- [a.] Method: Email
- [b.] Address: <feldmanjoel@gtlaw.com>
- [c.] Contact: Joel R. Feldman

Material Including Hard Copy

- [a.] Method: Facsimile
- [b.] Address/Fax: 678-553-4779
- [c.] Contact: Joel R. Feldman

UPSoA chooses to have this dispute heard before a single-member administrative panel. UDRP Rule 3(b)(iv).

[3.] RESPONDENT’S INFORMATION

- [a.] Name: Beth Breslaw
- [b.] Address: 104 Montgomery St., Brooklyn, New York 11225 US
- [c.] Telephone: +1.9177453931
- [d.] Fax: n/a
- [e.] E-Mail: <info@teamstersunited.org>;
<webmaster@upsfteamstersunited.org>;
<webmaster@upsteamstersunited.org>

[4.] DISPUTED DOMAIN NAMES

- [a.] The domain names that are the subject of this Complaint are: <www.upsfteamstersunited.org> and <www.upsteamstersunited.org> (the “Infringing Domain Names”). (UDRP Rule 3(b)(vi)).
- [b.] Registrar Information: UDRP Rule 3(b)(vii).

- [i.] Registrar’s Name: GoDaddy.com, LLC
- [ii.] Registrar Address: 14455 North Hayden Road, Suite 226
Scottsdale, AZ 85260

- [iii.] Telephone Number: +1.4806242505
- [iv.] E-Mail Address: abuse@godaddy.com

[c.] Trademark/Service Mark Information (UDRP Rule 3(b)(viii)):

UPSoA owns numerous United States trademark and service mark registrations incorporating the UPS mark, including the following:

- [i.] UPS (U.S. Reg. No. 966,774) for transportation of personal property for hire by diverse modes of transportation, attached hereto as **Annex 4**;
- [ii.] UPS (U.S. Reg. No. 1,752,464) for envelopes, cardboard, packing cardboard, cardboard packaging boxes, cardboard envelopes and cartons; plastic bags and envelopes and pouches for packaging, plastic bubble packs for wrapping or packaging, newspapers, books, brochures, newsletters, printed instructional, educational and teaching material, all pertaining to the transporting of packages and documents and other personal property; and shipping and address labels, attached hereto as **Annex 5**; and
- [iii.] UPS (U.S. Reg. No. 2,491,124) for air transportation services, namely, transportation of passengers and personal property by air, attached hereto as **Annex 6**.
- [iv.] UPS Stylized Shield Device (U.S. Reg. No. 2,867,999) for Freight forwarding; packaging articles for transportation; transportation and delivery of personal property by air, rail, boat and motor vehicle; warehousing, storage, packing, delivery and returns with respect to the foregoing; arranging ship charters for others; document box rental, document forwarding and receipt and delivery of documents for others, attached hereto as **Annex 7**.

[5.] **FACTUAL AND LEGAL GROUNDS**

This Complaint is based on the following factual and legal grounds: UDRP Rule 3(b)(ix).

- [a.] *The Infringing Domain Names are confusingly similar to UPSoA's UPS mark.* UDRP Rule 3(b)(ix)(1); UDRP ¶ 4(a)(i).

Background

UPSoA was founded in 1907 and is one the world's largest package delivery companies and the leading global provider of specialized transportation and logistics services. *See Annex 8*. UPSoA specializes in providing transportation services, logistics services, freight services, shipping services, franchising services, and retail services worldwide. *See Annex 8*. Today, UPSoA has over 10.3 million pick-up and delivery customers in over 220 countries and territories. *See Annex 8*. Since 1933, UPSoA has provided its services under the UPS mark, and

today UPSoA and its UPS mark are well-known worldwide. In 2003, UPSoA started using the Gold Stylized Shield Device shown below. Today, the Stylized Gold Shield Device is also well-known and clearly identifies UPSoA’s UPS-branded goods and services:



Since 1992, UPSoA has offered its services through UPS.com. *See Annexes 9 and 10.* The UPS.com website makes a wide variety of delivery goods and services available directly to customers. For example, through UPS.com, customers can track packages, schedule package pickups, order delivery supplies, and calculate the time and cost to ship packages worldwide. *See Annex 9.* The UPS.com website is an important part of UPSoA’s brand and worldwide presence.

UPSoA’s Rights Under the Policy

The UPS mark has been recognized as a well-known mark by various WIPO panels and by the FORUM. *See United Parcel Service of America, Inc. v. upsgroundmap.com*, Case No. D2008-1925 (WIPO Feb. 11, 2009) (“Complainant’s distinctive trademark UPS is widely known”); *United Parcel Service of America, Inc. v. UDRP Account / P.D.R Solutions FZC*, FA 1684057 (FORUM Aug. 31, 2016) (finding that respondent’s knowledge of UPSoA’s rights “is evident from the notoriety of Complainant’s trademark”). Accordingly, the UPS mark has acquired a high degree of public recognition and distinctiveness as a symbol of the source of high quality services offered by UPSoA, and embodies the valuable reputation and goodwill belonging exclusively to UPSoA.

As a result of UPSoA’s use and registration of the UPS mark for over 80 years, UPSoA enjoys strong rights worldwide in this mark for various goods and services. *See e.g. Annexes 4 – 7.* UPSoA’s ownership of various federal trademark registrations for UPS is sufficient, under the UDRP, to establish its rights in the UPS mark. *See United Parcel Service of America, Inc. v. Sean Selvidge et. al.*, FA 1748088 (FORUM October 30, 2017) (evidence of UPSoA’s trademark registrations for the UPS marks was sufficient to show UPSoA had trademark rights in the UPS mark); *see also United Parcel Service of America Inc. v. Luanfei*, Case No. D2010-0965 (WIPO Aug. 18, 2010) (finding that UPSoA clearly has rights in the UPS mark in view of its various trademark registrations for the UPS mark).

Confusing Similarity

Respondent’s <upsfteamstersunited.org> and <upsteamstersunited.org> domain names are confusingly similar to UPSoA’s UPS mark. The Infringing Domain Names contain UPSoA’s UPS mark in its entirety and differ in substance from the UPS mark by the addition of the terms “Teamsters” and “United,” and in the <upsfteamstersunited.org> domain name, also by the addition of an “f.” The addition of “Teamsters United” to the Infringing Domain Names does not distinguish the Infringing Domain Names from the UPS mark. This is because UPS retains its

brand significance as the world-famous parcel delivery company even if an additional brand is attached. The combination of Respondent’s business name, “Teamsters United” with UPSoA’s UPS trademark creates the false impression that there is an affiliation or connection between Teamsters United and UPSoA. *See Annex 11*. This is especially true because the juxtaposition of UPS and Teamsters followed by the word “united” suggests UPS and the Teamsters are united with one another for the purposes of the content shown on the Infringing Domain Names. This is common for co-branded goods or services. But UPS retains its significance even in co-branded domain names. *See AT&T Corp v. rnetworld*, Case No. D2006-0569 (WIPO June 27, 2006) (finding that the <att-yahoo.com> domain name was confusingly similar to complainant’s AT&T mark, especially since AT&T and Yahoo! offered a co-branded DSL service); *Google Inc. v. hejie / jerry jerry*, FA 1422208 (FORUM Feb. 10, 2012) (holding that the <google-ipad.com> domain name was confusingly similar to complainant’s GOOGLE mark); *ACCOR, SoLuxury HMC v. Whois privacy services Domain protect LLC / Alex Gusev*, Case No. D2012-0389 (WIPO April 12, 2012) (“The disputed domain names comprise the Complainant’s SOFITEL and NOVOTEL trademarks in their entirety with the additional word “dorint”. This additional word is also the undisputed trademark of a German company (not part of this proceeding) with which the Complainant formerly had business relations (and is now a competitor). The Panel cites with agreement the decision in *Yahoo! Inc. and Overture Services, Inc. v. Registrant (187640), a/k/a Gary Lam, a/k/a Birgit Klosterman, a/k/a XC2, a/k/a Robert Chua, a/k/a Registrant*, WIPO Case No. D2004-0896 which held that the inclusion of a third party’s trademark in a disputed domain name does not alter the visual impression that the disputed domain name is associated with the complainant’s trademark”). Further, the presence of the “f” in the <upsfteamstersunited.org> domain name also does not function to distinguish the domain name from UPSoA’s UPS mark because as seen on the <upsfteamstersunited.org> website, *see Annex 12*, the “f” within the Infringing Domain Name stands for “freight,” which is also a term associated with UPSoA’s business. *See United Parcel Service of America, Inc.*, FA 1679868 (FORUM July 26, 2016) (transferring <tlupsfreight.com> to UPSoA).

Also, the addition of the gTLD “.org” does not distinguish the Infringing Domain Names from UPSoA’s UPS mark. *See HY IP Holding Company LLC v. Hudson Yards Consulting*, FA 1745643 (FORUM Sept. 18, 2017) (noting that the addition of a gTLD is insufficient in distinguishing a domain name from a mark under Policy ¶ 4(a)(i)).

[b.] ***Respondent does not possess any legitimate rights or interests in the Infringing Domain Names.*** UDRP Rule 3(b)(ix)(2); UDRP ¶ 4(a)(ii).

Under UDRP ¶ 4(c), Respondent can only establish legitimate rights or interests in the Infringing Domain Names if: (1) before notice of the dispute, it was using the domain names in connection with a *bona fide* offering of goods or services; (2) it is commonly known by the domain names; or (3) it is making a legitimate noncommercial or fair use of the domain names, without intent for commercial gain. *See* UDRP ¶ 4(a)(ii); 4(c). Respondent cannot demonstrate any of these three requirements.

UPSoA has not given Respondent permission to use the federally-registered UPS mark or to register the Infringing Domain Names. Further, there is no evidence within the WHOIS information that Respondent is commonly known as “upsf” or “ups.” *See Annex 13 and 14*. Therefore, Respondent does not possess any legitimate rights or interests in the Infringing

Domain Names based on its name. *See Reese v. Morgan*, FA 917029 (FORUM Apr. 5, 2007) (concluding that the respondent was not commonly known by the <lilpunk.com> domain name as there was no evidence in the record showing that the respondent was commonly known by that domain name, including the WHOIS information as well as the complainant's assertion that it did not authorize or license the respondent's use of its mark in a domain name). Likewise while Respondent's organization, Teamsters United, is calling itself "UPS Teamsters United" on the Infringing Websites, it is doing so without authorization from UPSoA, so this only serves to increase the likelihood of confusion caused by the Infringing Domain Names.

Each of the Infringing Domain Names directs to a unique website. *See Annex 12 and 15*. However, the look and feel of both websites is nearly identical. Specifically, both of the target websites adopt a color-scheme, text, and style that is very close to that of the UPS official website. *See Annex 9*. The target websites' use of a brown and gold color scheme is especially troubling because the colors brown and gold have long been associated with UPSoA and its UPS brand. *See Annexes 16, 17, 18*. Further, the target websites display UPSoA's Gold Stylized Shield Device over fifteen times between the two websites. And, Respondent is referring to itself as "UPS Teamsters." *See Annexes 12 and 15*. Respondent's (i) use of "ups" in the Infringing Domain Names, (ii) references to itself as UPS TEAMSTERS, (iii) mimicking of the look and feel of the UPS website, and (iv) excessive use of the Stylized Gold Shield Device on the Infringing Websites misleads consumers as to Respondent's connection to or affiliation with UPSoA and cannot constitute a *bona fide* use. *See Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union*, Case No. D2013-1304 (WIPO Oct. 7, 2013) (finding that respondent had no legitimate rights to the <reallywalmart.com> in part because even though it was a site focused on critiquing complainant, "[r]espondent's webpage content does not clearly alert users at first view, that having entered or clicked on the disputed domain names, they are being routed to a website unaffiliated with [c]omplainant. Despite some content that is clearly critical and inviting visitors to post their own stories and sign a petition, the overall appearance of the page and the textual links at the top of the page create the opposite impression"); *Diners Club Int'l, Ltd. v. Infotechnics Ltd.*, FA 0169085 (FORUM Aug. 20, 2003) ("Respondent may have the right to post criticism of Complainant on the Internet, however, Respondent does not have the right to completely appropriate Complainant's registered trademark in a domain name in a way that will mislead Internet users as to the source or affiliation of the attached website," transferring domain name <diners-club.net> which incorporated complainant's DINERS CLUB mark); *Philip Morris USA Inc. v. DAVID DELMAN / DAVID@DELMAN.TV*, FA 1567138 (FORUM August 4, 2014) ("The Panel finds that Complainant has the right to control the use of its own mark and, though Respondent has the right to criticize Complainant, it may not do so using Complainant's mark").

Further, Respondent's use of the Infringing Domain Names is commercial. On the <upsfteamstersunited.org> website there is a tab that reads "shop gear." *See Annex 19*. On the <upsteamstersunited.org> website, there is a tab that reads "order palm cards and petitions." *See Annex 20*. Both of those tabs redirect to <teamstersunitedgear.org>, a commercial webpage that sells Teamsters United merchandise. *See Annex 21*. Notably, some of the merchandise listed for sale uses a description that incorporates the UPS mark and some of the merchandise is even branded with the UPS mark. *See Annex 21*. Respondent is thus using the Infringing Domain Names to create the impression it is connected to UPSoA and sell its own merchandise. This is not a legitimate noncommercial use of the Infringing Domain Names. *See Holding Acquisition*

Company, LP d/b/a Rivers Casino v. Jeremy Pollard, FA 1622988 (FORUM July 16, 2015) (finding no legitimate rights where the infringing domain name gave no indication that the resolving site was not affiliated with complainant and the resolving site was clearly directed at promoting respondent's union and intended to result in commercial/financial benefit to that union); *See also Summit Group, LLC v. LSO, Ltd.*, FA 758981 (FORUM Sept. 14, 2006) (finding that the respondent's use of the complainant's LIFESTYLE LOUNGE mark to redirect Internet users to respondent's own website for commercial gain does not constitute either a *bona fide* offering of goods or services pursuant to UDRP ¶ 4(c)(iii); *see also National Academy of Recording Arts & Sciences, Inc. v. Abrams Cohen Phelps Phillips Stein*, FA 1344880 (FORUM Oct. 28, 2010) (finding that respondent's use of a confusingly-similar domain name to operate a website that advertises services and solicits respondent's own business is not a *bona fide* offering of goods or services pursuant to UDRP ¶ 4(c)(iii)).

[c.] ***Respondent registered and is using the Infringing Domain Names in bad faith.***
UDRP Rule 3(b)(ix)(3); UDRP ¶ 4(a)(iii).

Respondent registered the Infringing Domain Names in bad faith for two reasons. First, Respondent is using the Infringing Domain Names to promote its own business and disrupts UPSoA's business. Second, Respondent's attempt to mimic the look and feel of the UPS official website is intentionally misleading.

First, as described above, the Infringing Domain Names resolve to a commercial website promoting Respondent's union services and selling Respondent's own merchandise. Using the UPS mark within the Infringing Domain Names for Respondent's own commercial benefit constitutes bad faith use and registration under the Policy. *See Holding Acquisition Company, LP d/b/a Rivers Casino v. Jeremy Pollard*, FA 1622988 (FORUM July 16, 2015) (finding bad faith use and registration of the infringing domain name where respondent used complainant's mark to attract Internet users to the infringing website where it attempted to recruit new members for its union, which profits financially through member dues); *See Nat'l Rifle Ass'n. v. fredg.com*, FA 95837 (FORUM Nov. 30, 2000) (finding bad faith where respondent registered the domain names <friendsofnra.com>, <freindsofnra.net>, and <friendsofnra.org> with the intention of using the domain names in connection with individual NRA fundraising, but without permission from complainant to use the registered marks).

Second, Respondent's attempt to mimic the look and feel of UPS's official website through its use of an identical brown and gold color-scheme and use of UPSoA's Stylized Gold Shield Device shows that Respondent intended to mislead consumers as to Teamsters United's connection to or affiliation with UPSoA, and is further evidence of Respondent's bad faith use and registration of the Infringing Domain Names. *See Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union*, Case No. D2013-1304 (WIPO Oct. 7, 2013) (noting that "the use of language, trademarks, and a style on the website to which the disputed domain name routes that intimates Complainant's website is also misleading; it compounds confusion, while the language of the website does not clearly and immediately dispel that confusion," and that this added to a finding of bad faith registration and use of the infringing domain name); *United States Postal Service v. Kinh Doanh*, FA 1747997 (FORUM Oct. 8, 2017) ("Respondent's website misappropriates Complainant's trademark as well as other proprietary material such as its registered Sonic Eagle Design and Complainant's UNITED STATES POSTAL SERVICE

design mark. Respondent's use of Complainant's intellectual property further shows Respondent's bad faith as it attempts to pass itself off as Complainant.")

Further, the <upsfteamstersunited.org> website uses one of UPSoA's copyrighted photographs (shown below), without authorization, further establishing Respondent's bad faith use and registration of the Infringing Domain Names:



See Lilly A/S v. yiyi chen, FA 1704586 (FORUM Jan. 5, 2017) ("Respondent's <lillykleid.com> redirects Internet users to a website that copies the layout, look and feel, and copyrighted images from Complainant's official website in an attempt to sell products. The Panel may agree with Complainant's claim and find Respondent engaged in bad faith registration and use under Policy Section 4(b)(iv)").

[6.] **REMEDY SOUGHT**

UPSoA requests that the Panel issue a decision that the following domain names either (i) be transferred from Respondent to UPSoA: <upsfteamstersunited.org> and <upsteamstersunited.org> or (ii) be cancelled. *UDRP Rule 3(b)(x)*; *UDRP ¶ 4(i)*.

[7.] **OTHER LEGAL PROCEEDINGS**

No other legal proceedings have commenced or terminated in connection with or relating to the Infringing Domain Names that are the subjects of this action. *UDRP Rule 3(b)(xi)*.

[8.] **MUTUAL JURISDICTION**

UPSoA will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to jurisdiction where Respondent is located, as shown

by the address given for the domain-name holder in the WHOIS Database at the time of the submission of the Complaint to the FORUM. UDRP Rule 3(b)(xiii).

[9.] **CERTIFICATION**

UPSoA agrees that its claims and remedies concerning the registration of the domain names, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against: (a) the FORUM and panelists, except in the case of deliberate wrongdoing; (b) the registrar; (c) the registry administrator; and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

UPSoA certifies that the information contained in this Complaint is to the best of UPSoA's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,



Joel R. Feldman
GREENBERG TRAURIG, LLP
Date: March 22, 2018