

ADMINISTRATIVE PANEL DECISION

Forideas Pty Limited v. Movember Organization

Case No. D2013-1385

1. The Parties

The Complainant is Forideas Pty Limited of Victoria, Australia, represented by Sipara, United Kingdom of Great Britain and Northern Ireland.

The Respondent is Movember Organization of Montreal, Quebec, Canada.

2. The Domain Name and Registrar

The disputed domain name <movemberorg.com> is registered with FastDomain, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 2, 2013. On August 6, 2013, the Center transmitted, by email to the Registrar, a request for registrar verification in connection with the disputed domain name. On August 6, 2013, the Registrar transmitted, by email to the Center, its verification response confirming that the Respondent is listed as the registrant and providing contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 22, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was September 11, 2013. No response was timely filed. Accordingly, the Center notified the parties of the Respondent's default on September 13, 2013. On September 16, 2013, the Center received a communication, as described below, from the Respondent. On September 17, 2013, the Center acknowledged receipt of this communication.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on September 19, 2013. 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

As reflected in the registration record for the disputed domain name in the Registrar's Whois database (a copy of that record appears in Annex 1 to the Complaint) and confirmed by the Registrar, the disputed domain name was both created and registered to the Respondent on October 30, 2012, and is set to expire on October 30, 2013.

A. Complainant's MOVEMBER Marks

The Complainant owns trademark registrations in various countries for the mark MOVEMBER in block letters and in a stylized fashion with a design element. In Annex 4 to the Complaint, the Complainant has provided a listing of its registrations. Pertinent details of some of those registrations are as follows:

1. MOVEMBER (block letters)
Australia registration no.: 1462968
registered as of: December 2, 2011; filed: December 2, 2011

This mark is registered for use in connection with: "business management and administration; charitable services in this class including business management and administration; advertising and marketing, including of charities, charitable fundraising and events; business research; marketing research; retaining of goods, including retailing of magazines, brochures, printed matter and publications, paper and cardboard goods, photographs, posters, educational and training materials, playing cards, memorabilia, clothing, footwear and headgear" all in international class 35; "Fund raising; charitable fund raising and collections; funding of research" in international class 36; "Entertainment services; organizing events for entertainment purposes; organising of entertainment and social events; event management; publication services, including electronic publication services; electronic publication of information about a wide range of topics, including online and over a global computer network; education and training; health education; organizing seminars and conferences" all in international class 41; "Scientific, medical and health research; organization and co-ordination of research projects in the fields of science, medicine and health" in international class 42; and "Medical and health services; development, implementation and provision of health programmes, including prevention and intervention programmes; providing information relating to health and medicine; providing health services and medical services information" in international class 44.

2. movember (with a stylized "M" situated directly above the term "movember")
Australia registration no.: 1013032
registered as of: August 21, 2006; filed: August 21, 2006

This mark is registered for use in connection with: "A charity event held each November that promotes male health awareness, raises funds for cancer research by participants growing moustaches" in international class 36.

3. movember (with a stylized "M" situated directly above the term "movember")
Canada registration no: TMA748,327
registered: September 22, 2009; filed August 24, 2006

This mark is registered for use in connection with the following goods: "Magazines, brochures, printed matter, namely books, brochures, greeting cards, magazines, newspapers, post cards; men's and women's clothing, namely, pants, shirts, shorts, jogging suits, sweaters, sweat shirts, sweat pants, vests, leggings, tights, dresses, jumpers and blouses; outerwear, namely, jackets, coats, sport coats, parkas, rainwear, raincoats; footwear, namely shoes and rain boots; headwear, namely hats, caps, visors"; and the following services: "Charitable fundraising; charitable services namely business management and administration; organizing events for entertainment purposes, namely Gala parties, launch/media/sponsor functions, concerts, productions, sporting events, surf, skate and snow competitions, office functions; organizing of entertainment and social events, namely Gala parties, launch/media/sponsor functions, concerts, productions, sporting events, surf, skate and snow competitions, office functions; charitable event

management”.

4. movember (with a stylized “M” situated directly above the term “movember”)
United States registration no. 3,514,689
registered: October 14, 2008; filed: December 20, 2006

This mark is registered for use in connection with: “Magazines, brochures, newsletters and books in the field of charitable organizations and causes and fundraising events; posters; postcards; drink coasters made of paper” all in international class 16; “Clothing, namely, shirts, t-shirts and underwear; footwear; headwear, namely hats and baseball caps” all in international class 25; “Charitable services in this class including business management and administration, namely developing and coordinating fundraising events for charitable organizations” in international class 35; “Charitable fundraising” in international class 36; and “Entertainment services, namely organizing and conducting events in the nature of gala parties and men’s facial hair fashion competitions” in class 41.

B. The Parties

The Complainant is affiliated with various charities around the world to raise awareness of men’s health issues such as prostate cancer, testicular cancer and depression. The Complainant raises funds for those charities by encouraging men to grow a moustache for the whole month of November and be sponsored for doing so. The Complainant licenses its MOVEMBER marks to those charities.

Since the start of the Complainant’s first charitable organization in Melbourne, Australia in 2003, the Complainant has grown to where, in 2012, it was active in 21 countries and has run formal campaigns in: the United Kingdom, United States, Canada, Australia, New Zealand, South Africa, Ireland, Finland, the Netherlands, Spain, Denmark, Norway, Belgium, the Czech Republic, Austria, France, Germany, Sweden, Switzerland, Hong Kong and Singapore.

The Complainant also has supporting organizations in Russia, United Arab Emirates, Hong Kong, Brazil and India. In 2012 the entire global Movember campaign run by the Complainant raised over GBP 90.5 million (as reported in copies, of web pages taken from the Complainant’s web site, appearing in Annex 5 to the Complaint).

The Complainant also licenses its MOVEMBER marks to appear on merchandise created by various third parties, including Links of London, Marshall Amplification, Kent Brushes, Toms Shoes and Lucky Seven. Links to these products appear on the Complainant’s website (as shown in copies of web pages from that site which appear in Annex 7 to the Complaint).

Currently, the disputed domain name resolves to a website which is seemingly designed to raise awareness about men’s cancer, and raises funds in support of that cause (see a copy of the home page of that site appearing in Annex 8 to the Complaint). The site contains no substantive content under the “About Us” and “Photos” categories, and very little substantive content elsewhere other than photographs of men with moustaches. Clicking on “Merchandise” brings a pop-up (a copy of which is provided in Annex 9 to the Complaint) which encourages the public to “Buy your MOVEMBER T-Shirt”, with “\$5 from each sale will be donated to Prostate Cancer Canada”. Prostate Cancer Canada is a Canadian charity affiliated with the Complainant. When an Internet user clicks on the “Donate” button, the site redirects the user’s browser to a PayPal page (a print-out of which is provided in Annex 10 to the Complaint) where donations are solicited for “movemberorg.com donate”. The Complainant has been in contact with Prostate Cancer Canada - one of the charities licensed by and affiliated with the Complainant. To the best of both of their knowledge, neither the Complainant nor Prostate Cancer Canada has ever received any charitable donations from the Respondent.

The Complainant contacted the Respondent on May 31, 2013 and set forth its concerns about the disputed domain name and links on its site to Prostate Cancer Canada and to the Complainant. The Respondent refused to provide information about those links stating that they “have no obligation to provide you with any

information regarding our fundraising events". Further, the Respondent has invited the Complainant to "consider a more serious and reasonable offer" for the domain name, despite the Complainant having already offered USD 50 to the Respondent towards the administrative costs of registering a new domain name. A copy of the chain of correspondence between the parties appears in Annex 11 to the Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark MOVEMBER as the name contains that mark in combination with the term "org", where the latter, being identical to a well-known generic Top Level Domain (.org), fails to add any distinctiveness whatsoever to the name sufficient to distinguish it from the mark so as to mitigate any resulting confusion of Internet users.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, before the Respondent received any notice of this dispute, the Respondent has not used or made demonstrable preparations to use, the disputed domain name in connection with an *bona fide* offering of goods or services. In that regard, the name currently resolves to a website which seems to raise awareness about men's cancer, and, by so doing, raise funds in support of that cause (see a copy of the home page of that site appearing in Annex 8 to the Complaint). While it specifically states that funds are being raised for a Canadian charity, Prostate Cancer Canada (which is affiliated with the Complainant), neither that organization nor the Complainant itself has yet to receive any funds from the Respondent. Accordingly, this solicitation is not *bona fide*.

Second, while the Respondent's web page clearly shows the Complainant's mark MOVEMBER, the Complainant has never authorized the Respondent to use any of the Complainant's MOVEMBER Marks.

Third, the Respondent has not been commonly known by the disputed domain name.

Fourth, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue. Specifically, the offering for sale of t-shirts clearly demonstrates that the Respondent is using the disputed domain name to misleadingly divert consumers to its website at which it can generate commercial revenue through such sales.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent knew of the existence of the Complainant and its MOVEMBER marks at the time the Respondent registered the disputed domain name. This knowledge is clearly evidenced by the content of the Respondent's web site being exclusively directed to raising funds for men's health charities by encouraging men to grow of a moustache during the month of November - which is the Complainant's primary mode of operation. In light of exclusive trademark rights residing in the Complainant and the

Complainant's mode of operation - of which obviously the Respondent was well aware at the time it registered the disputed domain name, the Respondent's only intention in having done so was to cause confusion of Internet users.

Through causing confusion, the Respondent is attempting to attract Internet users to its website to encourage them to purchase goods or make donations (to a recipient which is not clearly an authorized charitable cause) by suggesting that the Complainant endorses the Respondent's website and the products sold on the Respondent's website - when, in actuality, no such endorsement exists. This confusion is accentuated by the Respondent's use of a moustache logo on its website and by suggesting that money from purchases of merchandise purchased through the site will be donated to charity. These further enhance the impression in the minds of Internet users that the Respondent's website is associated with or endorsed in some fashion by the Complainant.

B. Respondent

In response to the Notification of Respondent Default, the Respondent sent a communication to the Center on September 16, 2013 which stated, in its entirety:

"Hi [...] what is there to answer i'm keeping this domain and there is no way that movember.com is going to get it.
What do I have to reply to???"

6. Discussion and Findings

The Respondent's communication on September 16, 2013 does not constitute a substantive response as required under paragraph 5 of the Rules and the Panel finds that there are no exceptional circumstances. Accordingly, the Panel will ignore this communication and will proceed in the case of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's factual representations as set forth in the Complaint, all of which are undisputed.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's MOVEMBER marks.

From a simple comparison of the disputed domain name to the Complainant's mark MOVEMBER, no doubt exists that the disputed domain name is confusingly similar to the Complainant's marks. The primary difference between the disputed domain name and the mark MOVEMBER is appending the term "org" to form a separate corresponding composite term "movemberorg" along with, secondarily, appending the generic Top-Level Domain ("gTLD") ".com" to that term to form the disputed domain name, with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding a generic term, that being the "org" - which is a well-known generic Top Level Domain, in the manner which the Respondent specifically did, to the mark MOVEMBER clearly resulted in such a minor variation. See, e.g., *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg &*

Associates, Inc., WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. 117876.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's MOVEMBER marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the MOVEMBER Marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's mark MOVEMBER or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *AlgaeCal; General Motors, National Westminster, Amy Stran v. EzDomainSearch.com, Juan Curtis*, WIPO Case No. D2011-1710; *Tommy Bahama, Space Needle, Oakley, Burberry, HRB Innovations Inc., Dreamworks, MySpace, Blackrock, F. Hoffmann-La Roche AG, National Football League, Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between itself and the mark MOVEMBER or even any mark similar thereto, at least for the goods and services provided by the Complainant under its marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark MOVEMBER. Nor could the Respondent likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back some six years (in Canada) prior to when the Respondent registered the disputed domain name in 2012 and the reputation which the Complainant has gained in its MOVEMBER marks ever since. See, e.g., *General Motors*, *National Westminster*, *Tommy Bahama*, *Amy Stran*, *Space Needle*, *Oakley*, *Burberry*, *Starline Publications*, *HRB Innovations Inc.*, *MySpace* and *Treeforms, Inc.*, all cited *supra*. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Further, as the Respondent's website is clearly engaged in soliciting commercial sales of clothing, its use of the disputed domain name does not constitute a legitimate noncommercial or fair use of any of the disputed domain name sufficient to bring the Respondent within the ambit of paragraph 4(c)(iii) of the Policy.

As such, based on the evidence before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy. There is no evidence that the Respondent in any other way has rights or legitimate interests in the disputed domain name.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel believes that the Respondent was very well aware of the Complainant and its mark MOVEMBER when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the disputed domain name to opportunistically exploit the Complainant's reputation through the potential of that domain name to generate confusion of Internet users for the Respondent's eventual pecuniary benefit.

This exploitation is clearly evident from the Respondent's ensuing actions.

The Respondent adopted basically the same operational business model as the Complainant uses: soliciting funds, including through an effort to encourage men to grow moustaches during the month of November, to raise awareness of men's health issues, particularly prostate cancer. In doing so, the Respondent incorporated considerable substantive content on its website, including the Complainant's mark MOVEMBER together with depiction of a moustache and pictures of various men with moustaches, that directly mimicked the Complainant's business model. This, in turn, conveyed a rather distinct and compelling, but totally erroneous, impression in the minds of Internet users that the Respondent's website was affiliated, related or endorsed in some manner with the Complainant's website and was raising money for a legitimate charity, specifically Prostate Cancer Canada. Thus, those Internet visitors who sought the Complainant's website but instead were diverted to the Respondent's website likely thought that, through their T-shirt purchases, they were benefiting Prostate Cancer Canada. This impression was reinforced by a representation on the Respondent's website which expressly stated that a portion of the proceeds of each sale would be donated to Prostate Cancer Canada. However, despite that very representation, Prostate Cancer Canada never received any funds whatsoever from the Respondent. The Panel infers, from the lack of any substantive response, that some sales actually occurred through the Respondent's website which yielded sales proceeds, a portion of which should have been directed as donations to that charity. However, the Respondent evidently directed those donations elsewhere and in a manner that ultimately yielded some financial benefit to the Respondent.

Consequently, the Panel believes that the Respondent would not have chosen to register a domain name that includes the Complainant's mark MOVEMBER if the Respondent's intention from the onset was not to

exploit the reputation and goodwill of that mark for its own financial benefit. There is no plausible explanation from the evidence of record - particularly in light of a lack of any substantive response - that would suggest otherwise.

Hence, the Panel concludes that the Respondent's registration and use of the disputed domain name fall within the bad faith provision of paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <movemberorg.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: October 3, 2013