

.nz Dispute Resolution Service

DRS Reference: 984

Beachbody, LLC v Ai Leen

Key words -

Identical or similar trade mark or name

Registered mark - well-known mark - similar - mark with generic word

Unfair registration

Unfair registration – unfair use – likely to confuse, mislead or deceive - pattern of registration

1. Parties

Complainant:

Beachbody, LLC

3301 Exposition Blvd., 3rd Floor,

Santa Monica, CA 90404

United States

Represented by: Ms Camille Miller, Cozen O’Conner, Attorneys for Complainant

Respondent:

Ai Leen

23 Lee Road

Sydney NSW 1023

Australia

2. Domain Name/s

beachbodyfitness.co.nz ("the Domain Name")

3. Procedural history

- 3.1 The Complaint was lodged on 11/07/14 and Domain Name Commission (DNC), notified Respondent of the validated Complaint on 16/07/14. The domain was locked on 14/07/14, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 There was no response filed by Respondent.
- 3.3 Complainant paid DNC the appropriate fee on 26/08/14 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

- 3.4 Mr Clive Elliott QC, the undersigned, (“the Expert”) confirmed to the DNC on 29/08/2014 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual background

- 4.1 According to WHOIS, the Domain Name was registered on 19 April 2012.

5. Parties’ contentions

5.1 Complainant

- 5.1.1 Complainant states that it is a globally renowned creator and seller of in-home fitness, health, wellness and weight loss solutions and that a main component of its business is the development, production, sale and distribution of its line of fitness products and service, including its in-home fitness DVDs and kits.
- 5.1.2 Complainant contends that since 1998 it has had a strong presence in the fitness industry as a leading provider of exercise and fitness instruction, exercise, health and nutrition goods and services. Its products and services have achieved success in the United States and in many jurisdictions including New Zealand, Australia, the United Kingdom and Canada. Complainant further states that it has consistently used its BEACHBODY® mark (Complainant’s Mark) since 1998.
- 5.1.3 Complainant states that it trades under the BEACHBODY® name, and is the source of and owns all intellectual property rights in and related to its line of health, wellness, weight loss and fitness products and services. Complainant is the registered proprietor of New Zealand trade mark registration 829876 BEACHBODY in classes 5, 9 and 41 dated 3 September 2010.
- 5.1.4 The success of its products and services, Complainant asserts, is due in part to its marketing and promotional efforts, including significant advertising and promotion of its Mark, name, products and services through its websites. These websites include its main website located at Beachbody.com (“Complainant’s flagship website”); its New Zealand website at Beachbody.co.nz; its Australian website at Beachbody.com.au; and its other international sites including Beachbody.co.uk, and Beachbody.ca. It also advertises and promotes its products and services through its Facebook company pages, print and other internet-based advertising, together with in-person and televised promotional appearances by its trainers, and as well as its infomercials.
- 5.1.5 Complainant asserts it has gained significant common law trademark and other rights in Complainant’s Mark. It advises that it has also protected Complainant’s Mark by filing for and obtaining trademark registrations in various jurisdictions throughout the world, including in New Zealand.

- 5.1.6 Complainant contends that it has held rights in Complainant's Mark, sold its BEACHBODY® line of in-home, instructional fitness exercise DVDs, fitness kits, equipment and other products and services in commerce, and obtained trademark registrations before Respondent registered the Domain Name on April 19, 2012.
- 5.1.7 Complainant submits that the Domain Name fully incorporates Complainant's Mark in its entirety, and displays the identical characters in the exact same chronological order, in combination with the descriptive word "fitness", and is therefore identical or similar to Complainant's Mark.
- 5.1.8 Complainant further claims that the Domain Name is confusingly similar to its New Zealand domain name, www.beachbody.co.nz, and that the addition of the descriptive term "fitness" to Complainant's Mark fails to distinguish it, but rather increases the likelihood of confusion, amongst consumers as to the source of the Domain Name and associated website.
- 5.1.9 Complainant argues that Respondent is using the Domain Name for the purpose of unfairly disrupting Complainant's business in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with Complainant. Complainant further suggests that Respondent has engaged in a pattern of unfair registrations, as the website at the Domain Name includes the e-mail address "beachbodysale.nz@gmail.com" as a contact email address. This is not an official e-mail of Complainant, and is nearly identical to the e-mail that was used on the website at the www.beachbodyfitness.net.au domain name, which was transferred to Complainant pursuant to WIPO Case No. DAU2013-0020.
- 5.1.10 Complainant asserts that Respondent is not affiliated with it, and there is no evidence to suggest that Respondent has registered the Domain Name to advance legitimate interests or for the bona fide offering of legitimate goods or services.
- 5.1.11 Complainant alleges that Respondent is advertising, offering and selling unauthorised and counterfeit copies of Complainant's products, including unauthorised and counterfeit versions of its DVDs and workout kits (collectively Complainant's "Products").
- 5.1.12 Complainant indicates that it closely monitors the distribution and sale of its Products, which are only sold via television infomercials, on the Internet at Beachbody's authorised websites, and through authorised independent contractor sales representatives known as "Team Beachbody Coaches" who reside only in the United States and Canada.
- 5.1.13 Complainant contends that Respondent has created a website that mimics the look and feel of Complainant's flagship website, making unauthorised and infringing use of Complainant's copyright protected content. The Domain Name website shows Complainant's copyrighted product images, graphics

and content, and uses the same color scheme and background, logos and fonts as Complainant's flagship website without a license or Beachbody's authorisation or approval.

- 5.1.14 Complainant submits that Respondent's use of the copyrighted product images, graphics, and other content, when combined with an email address that incorporates the BEACHBODY® mark, further deceives consumers into mistakenly believing that the Domain Name is "official," legitimate and authorised by Complainant to sell its well-known line of Products, when it is in fact not. Further, Complainant contends, that Respondent falsely represents on the browser tab of the Domain Name webpage that this website is the "Official Online store New Zealand, Beachbody Workout DVDs and program sale at cheap price, free shipping."
- 5.1.15 Complainant submits that Respondent has attempted to take commercial advantage of Complainant's Mark and commercial reputation and trade off Complainant's goodwill, in which Complainant has invested significant time, effort and resources.
- 5.1.16 Finally, Complainant submits that by Respondent registering and using the Domain Name and its associated website to advertise, offer for sale and sell counterfeit versions of Complainant's Products, is evidence of unfair registration and that Respondent is engaged in a pattern of making unfair registrations.

5.2 Respondent

- 5.2.1 There was no response filed by the Respondent.

6 Discussion and findings

- 6.1 In terms of paragraph 4.1 of the Policy, where a Complainant asserts that:

The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; **and**

The Domain Name, in the hands of the Respondent, is an Unfair Registration

pursuant to paragraph 4.2 of the Policy the Complainant is required to prove to the Expert that, on the balance of probabilities, both elements are present.

- 6.2 Paragraph 3 of the Policy (Definitions) defines "Unfair Registration" as:

... a Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR

(ii) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's Rights.

- 6.3 In order to support a complaint of this kind Complainant must satisfy three elements:
- (a) Rights in respect of a name or mark (para 4.1.1);
 - (b) Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and
 - (c) Unfair registration in the hands of the Respondent (para 4.1.2).

7 Decision

- 7.1 Given that Respondent filed no response the Expert is only able to assess the information and submissions filed by Complainant. In the absence of any dispute as to the accuracy and correctness of that information, the Expert will decide this proceeding on the basis of Complainant's undisputed representations and draw such inferences it considers appropriate. In this regard, the Expert considers that there is nothing in Complainant's submissions or factual statements that are clearly contradictory.

8 Rights and Similarity

- 8.1 Complainant asserts it has rights in Complainant's Mark at common law and by filing for and obtaining trademark registrations in various jurisdictions, including in New Zealand. No contest has been raised by Respondent as to Complainant's rights in Complainant's Mark. The evidence is clear. The BEACHBODY trademark is well-known and absent evidence to the contrary it is reasonable to infer Complainant's products and services are known in New Zealand in relation to, inter alia, health, wellness and fitness products and services. The BEACHBODY trade mark is also registered in New Zealand.
- 8.2 Complainant contends that the Domain Name is confusingly similar to Complainant's Mark but also its New Zealand domain name, www.beachbody.co.nz, and that the addition of the descriptive term "fitness" to Complainant's Mark fails to distinguish it, but rather increases the likelihood of confusion, amongst consumers as to the source of the Domain Name and associated website. There is clear merit in this contention. The addition of the descriptive term "fitness" to BEACHBODY does not diminish the likelihood of confusion, it adds to it, given Complainant's connection and association with fitness products and services.
- 8.3 On this basis it is found that:
- (a) Complainant has rights in respect of Complainant's Mark;
 - (b) The Domain Name is confusingly similar to Complainant's Mark.
- 8.4 Accordingly, the Expert is satisfied that the first two elements of the Policy have been met.

9 Unfair Registration

- 9.1 Paragraph 3 of the Policy requires a Complainant to establish that one of the necessary requirements is established, namely that the Domain Name was registered or otherwise acquired in a particular way or has been used in a manner which is unfair or unfairly detrimental to Complainant's Rights. These requirements are stated in the alternative, meaning that in order to succeed a complainant need establish one or the other.
- 9.2 Paragraph 5.1 of the Policy sets out an inclusive list of factors which may be taken into account. It provides a relevant evidential context when an assessment is made as to whether the Domain Name is an Unfair Registration.
- 9.3 Paragraph 5.1.2 in particular refers to:
- Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- 9.4 In the present case Complainant asserts that Respondent has engaged in a range of questionable commercial activities; including:
- (a) creating and operating a website that mimics the look and feel of Complainant's flagship website;
 - (b) making unauthorised and infringing use of Complainant's copyright protected content including product images, graphics, colour schemes and logos;
 - (c) using an email address "beachbodysale.nz@gmail.com" as a contact email address; and
 - (d) falsely representing on the browser tab of the Domain Name webpage that the website is the "Official Online store New Zealand, Beachbody Workout DVDs and program sale at cheap price, free shipping."
- 9.5 On the basis of the above, the Domain Name appears to be employed as a means of diverting Internet customers, looking for health, wellness and fitness products and services. In those circumstances, it is difficult to see how Respondent's conduct could be seen as fair and legitimate.
- 9.6 Complainant further argues that use of the e-mail address "beachbodysale.nz@gmail.com" is evidence of a pattern of unfair registrations, as this e-mail address is used at the website which resolves to the Domain Name and is used as a contact email address. Complainant points out that this is not an official e-mail of Complainant, and is nearly identical to the e-mail that was used on the website at the www.beachbodyfitness.net.au domain name, which was transferred to Complainant pursuant to WIPO Case No. DAU2013-0020.

- 9.7 The Expert does not take this into account as evidence of a pattern of unfair registrations. It does however regard it as relevant evidence of a pattern of conduct which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with Complainant, contrary to the fact. It also suggests that Respondent is acting unfairly with regard to the interests of Complainant and has done so before.
- 9.8 On this basis, it is found that Respondent's conduct is unfair and detrimental to Complainant's Rights and that the third element of the Policy has been met.
- 9.9 Complainant has thus established all necessary parts of paragraph 4.1 of the Policy and is entitled to the relief sought. In the result, the Expert orders that the Domain Name be transferred from Respondent to Complainant.

Place of decision Auckland, New Zealand

Date 15 September 2014

Expert Name Clive Elliott QC



Signature