



Resolution Institute

Administrative Panel Decision (single panellist)

The Mind of the Man Pty Ltd vs Celefest Pty Ltd

Disputed Domain Name: <www.manwithvan.com.au>

Matter Number: auDRP_23_06

1. The Parties

The Complainant is The Mind of the Man Pty Ltd, of 53, Church Street, Abbotsford, Victoria 3067.

The Respondent is Celefest Pty Ltd, of 1, Rippon Court, Templestowe, Victoria 3106.

2. The Domain Name and Registrar

The disputed domain name <manwithvan.com.au> is registered with Crazy Domains.

3. Procedural History

Date	Process Stage
9/5/2023	Complainant: complaint filed with Resolution Institute, for action.
12/5/2023	RI: acknowledges receipt of complaint.
12/5/2023	RI: Complaint notified to Registrar.
12/5/2023	Registrar: acknowledges complaint to RI and locks Domain Name
18/5/2023	RI: Notifies Respondent of Domain Name Dispute (copied to Complainant, Registrar, and auDA).
7/6/2023	Due date for receipt of Respondent's response. Not received.
13/6/2023	RI: Notifies Parties, Registrar, and auDA of lack of Respondent response.
14/6/2023	Respondent: Response to RI, Complainant, Registrar, and auDA.

Date	Process Stage
15/6/2023	RI: Statement of Independence & Impartiality sent to nominated panellist: Jon Kenfield.
16/6/2023	RI: Acknowledges late submission received from Respondent to Respondent, Complainant, Registrar, and auDA.
16/6/2023	Panellist: Returns Statement of Independence & Impartiality to RI. RI: Notice of Appointment of single panellist to both parties. RI: Case files sent to panellist.
19/6/2023	Panellist: confirms appointment and documents received from both parties to parties.
29/6/2023	Decision published.
30/6/2023	Decision due date.

4. Discussions and Findings

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and, in accordance with the Policy, these Rules, and any rules and principles of law that the Panel deems applicable.

5. Factual Background (per submissions)

5.1. Complainant (per submission)

The Complainant in this administrative proceeding is The Mind of the Man Pty Ltd (ACN 625 286 697 / ABN 99 625 286 697) a company incorporated under the laws of Australia, in 2018.

The complaint relates to the business “Man with a Van”, which was protected by Victorian Business Name Registration on 18th January 2005, and by trademark #1089886 <Man with a Van>, filed on 11th December 2005, limited to the state of Victoria.

The trademark registration was opposed in 2007 by one Michael John Cummins. The opposition failed through a process finalised in 2008.

5.2. Complaint

The Complainant alleges that the disputed domain name / URL: <manwithvan.com.au> is substantially identical to, or at least deceptively similar to, the Complainant’s own trademark and is promoting services similar to their own, thereby infringing their rights to protection of a registered trademark under the Trade Marks Act 1995 and,

Using the disputed URL makes a false representation to potential consumers that the Respondent is an approved licensee or authorised agent of the Complainant, contrary to ss.18 and 19 of the Competition and Consumer Act 2010.

It could also provide grounds for a passing off action, as well as being in contravention of the auDRP (Australian Domain Name Dispute Resolution Policy).

5.3. Respondent (per submission)

- Has owned the disputed domain for 6+ years.
- The domain matches exactly to a service provided since 2008: Man with Van at an hourly rate.
- The disputed domain doesn't exactly match with the Complainant's business.
- Many other businesses sell similar services using this phrase on their websites.
- As soon as an email was received from Tim Bishop, references to "Man with a Van" on Respondent's website were removed, wherever possible.
- They answer calls received as Red Rock Removals, not as "Man with a Van".
- The colour theme of their website is completely different to the Complainant's website. This demonstrates lack of intention to copy.
- Respondent owns over 100 URLs used for marketing strategy.
- The Respondent claims their actions are completely legal and do not cause any harm to the Complainant.
- The Respondent minimises his use of "Manwithavan" logo (sic) wherever possible, but sometimes has to use the phrase "Man with a van" in response to enquiries eg: "we recommend you hire 1 man with a van to move your washing machine".
- Respondent owns the trademark "Move My Stuff" believing it's a generic English phrase in general use that he can't stop others from using. The Phrase "Man with a van" is similar. It's just a generic English phrase used to describe a service.

5.4. Remedy Sought

The Complainant seeks the immediate "takedown" of the disputed website and transfer of the licence for the domain name registration to themselves.

Under the Rules, the Complainant must succeed **on all three bases** of complaint:

- (A) The Disputed Domain Name is identical or confusingly similar to a name, trademark, or service mark in which the Complainant has rights; **and**
- (B) The Respondent does not have rights or legitimate interests in respect of the Disputed Domain Name; **and**
- (C) The Disputed Domain Name was registered, or subsequently used, in bad faith.

6. Parties' Contentions

(A) The Disputed Domain Name is identical or confusingly similar to a name, trademark, or service mark in which the Complainant has rights. (Policy, Schedule A, para, 4(a)(i))

6.1 Complainant (per submission)

The disputed domain name: <manwithvan.com.au> is substantially identical to, or at least deceptively similar to, the Complainant's own trademark and is promoting services similar to their own, thereby infringing their rights to protection of a registered trademark under the Trade Marks Act 1995.

Use of the disputed domain name makes a false representation to potential consumers that the Respondent is an approved licensee or authorised agent of the Complainant, contrary to ss.18 and 19 of the Competition and Consumer Act 2010, and could be grounds for a passing off action, as well as being in contravention of the auDRP (Australian Domain Name Dispute Resolution Policy).

6.2 Respondent (per submission)

The Phrase "Man with a van" is just a generic English phrase used to describe a service.

Many other businesses use the same phrase in their work and marketing and our use does not cause any harm to the Complainant.

6.3 Considerations and Decision

The first test under the Policy of whether a disputed domain name is ***"identical or confusingly similar"*** is designed to be an initial threshold test based on commonsense: is a reasonable internet user (ie: the sort of person likely to find themselves in the disputed domain's website as a consequence of their self-directed internet activities) likely to be confused as to the owner of said website by similarities between the domain they've arrived at, and the legitimate owner of ***"various marks in which the Complainant has rights?"***

This is not a complicated legal concept about infringement of rights, it's rather a practical test of whether a reasonable person is likely to be confused into believing that something they've been presented with might reasonably be expected to create confusion in their minds as to who, or with what entity, they're actually dealing.

With reference to Paragraph 4 of the Policy, is the Disputed Domain Name <manwithvan.com.au> confusingly similar to the registered mark: "Man with a Van", in respect of which the Complainant has legal rights and an established reputation in Victoria?

The dominant and principal elements of the Disputed Domain Name lie within the phrase: **"Manwithvan"**. The words "man" and "van" appear to be confusingly similar to the marks in which the Complainant has prior rights: "Man with a Van" because, when a Disputed Domain Name incorporates the entirety of a trademark, or where a dominant feature of the relevant trademark is recognisable in the Disputed Domain Name, the Disputed Domain Name is held to be confusingly similar to that mark.

6.4 Finding

The reasonableness test suggests that “Man with Van” could easily be confused with “Man with a Van”, given the only difference lies in the “a”, which is the least noticeable part of the phrase. In addition, there’s an explicit reference to “Man with a Van” in the disputed website search results within a Google search, even though it’s not mentioned on the Home Page of the disputed website itself.

I also note, from a direct Google search for <man with a van> conducted from Ashburton in Victoria, that:

- The Respondent’s website: “Move my Stuff” comes up as the tenth listed business after four sponsored businesses are listed above the official <Man With A Van> website listing, plus three geographic business listings (including two <Man with a Van> listings, plus two further listings (excluding Product Review website).
- Several of the businesses that appear on Page 1 of the above Google search, including “Move my Stuff”, include the description: “Man with a Van” (ie: Moving Men Removals | Melbourne City Movers | Quick Pick Movers | Move 4 Cheap).

A Google search using <manwithvan> as the search term produces slightly different results.

From a Google search an average consumer could initially be confused, and potentially misled, as to who, or with what entity, they’re actually dealing, since the name used within the disputed domain name is, in Melbourne at least, somewhat of a “household name”.

However, I also note that a plethora of other sites come up with the same “Man with a Van” line in Google searches. This supports the Respondent’s contention that it’s a generic English phrase in common use to describe a service.

6.5 Decision

On balance, the Panel considers that the disputed domain name satisfies the formal requirement of being confusingly similar to a mark in which the Complainant has rights, pursuant to paragraph 4(a)(i) of the Policy.

(B) The Respondent has no legitimate rights or interests in respect of the Domain Name (Policy, Schedule A, para 4(a)(ii))

7.1 Complainant (per submission)

The Complainant alleges that use of the disputed domain name makes a false representation to potential consumers that the Respondent is an approved licensee or authorised agent of the Complainant, contrary to ss.18 and 19 of the Competition and Consumer Act 2010. The Complainant adds that there could also be grounds for a passing off action.

Contravention of the auDRP (Australian Domain Name Dispute Resolution Policy) is included in the list of possible transgressions.

Domain Name Dispute: <manwithvan.com.au>

This amounts to an allegation that the Respondent's use of the Disputed Domain Name in connection with an offering of goods or services is not bona fide because:

- (a) The Respondent has never been licensed or otherwise permitted to use the Registered "Man with a Van" mark; and
- (b) The Website misleadingly suggests it is an approved licensee or authorised agent of the Complainant.

7.2 Respondent (per submission)

The disputed domain name:

- Has owned this domain for 6+ years.
- Matches exactly to a service provided since 2008: Man with Van at an hourly rate.
- Doesn't exactly match with the Complainant's business.
- Many other businesses sell similar services using this phrase on their websites (image supplied).
- As soon as an email was received from Tim Bishop, references to "Man with a Van" on Respondent's website were removed, wherever possible.
- Answers calls received as Red Rock Removals, not as "Man with a Van".
- The colour theme of their website is completely different to the Complainant's website. This demonstrates lack of intention to copy.
- Respondent owns over 100 URLs used for marketing strategy.
- The Respondent claims their actions are completely legal and do not cause any harm to the Complainant.
- The Respondent minimises his use of "Manwithavan" **logo** (sic) wherever possible, but sometimes has to use the phrase "Man with a van" in response to enquiries eg: "we recommend you hire 1 man with a van to move your washing machine".
- Respondent owns the trademark "Move My Stuff" believing it's a generic English phrase in general use that he can't stop others from using. The Phrase "Man with a van" is similar. It's just a generic English phrase used to describe a service.

7.3 Considerations and Decision

Paragraph 4(c) of the auDRP states that a respondent will be taken to have demonstrated their possession of rights to and legitimate interests in a domain name where (rephrased):

- (i) Before any notice has been received of the existence of a dispute, they can demonstrate bona fide use of, or demonstrable preparations for the use of, the disputed domain name or,

Domain Name Dispute: <manwithvan.com.au>

- (ii) The respondent individual, business, or other organisation has been commonly known by the domain name, even if they have acquired no trademark or service mark rights; or
- (iii) They are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.

7.4 Findings re Rights and Legitimate Interests.

Based on the brief submissions received and my review of the results of Google searches on <Man with a Van>, <Man with van>, and <manwithvan>:

1. The Respondent operates a business called "Red Rock Van", using the disputed domain name "ManwithVan".
2. The disputed domain name accurately reflects its operations, rather than its registered persona.
3. Per 4(c)(i): The Respondent has made bona fide use of the disputed domain name, before receiving notice of any dispute, for purposes of operating a removals business that promotes its activities and relies upon men using vans.
4. Per 4(c)(ii): The Respondent itself denies being "*commonly known by the domain name*" as they rely on "man with van" being a descriptor of their work, rather than the name of their business.
5. Per 4(c)(iii): The Respondent admits to holding a portfolio of 100 domains for "marketing strategy" and is clearly using the disputed domain to help leverage their own business on the back of the Complainant's well-known marks. This may constitute opportunistic commercial exploitation, but that does not constitute an unacceptable use of (unregistered) rights, or legitimate interests, in the marks.
6. There is nothing in the Red Rock website that seems likely to confuse, or potentially mislead, any reasonable customer as to what entity they're actually dealing with, nor is there any indication of intent to misleadingly divert consumers, or to tarnish the name, trademark, or service mark at issue.

7.5 Decision

The Panel concludes that although the Respondent's use of the disputed domain name was almost certainly driven by commercial opportunism, this does not preclude its possession, and acceptable use of, legal "rights and legitimate interests" in the marks.

(C) The Disputed Domain Name was registered, or has been subsequently used, in bad faith (Schedule A. Paragraph 4 (b)).

This complaint failed when the Panel found that the Respondent has rights to, and legitimate interests in, the disputed domain name. However, for the sake of completeness, we hereby address the third criteria:

Paragraph 4(b) of the Policy includes the following criteria as evidence of bad faith registration and/or use of a domain name:

“... (iii) [the Respondent has] registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location of a product or service on that website or location.”

8.1 Complainant (per submission)

Use of the disputed domain name makes a false representation to potential consumers that the Respondent is an approved licensee or authorised agent of the Complainant, contrary to ss.18 and 19 of the Competition and Consumer Act 2010.

There could also be grounds for a passing off action.

This amounts to an allegation that the Respondent's use of the Disputed Domain Name in connection with an offering of goods or services is not bona fide because:

- (a) The Respondent has never been licensed or otherwise permitted to use the Registered “Man with a Van” mark; and
- (b) The Website misleadingly suggests it is an approved licensee or authorised agent of the Complainant.

8.2 Respondent (per submission)

- Many other businesses sell similar services using this phrase on their websites.
- As soon as a complaint was received, references to "Man with a Van" on the website were removed, wherever possible.
- We answer calls as Red Rock Removals, not as “Man with a Van”.
- The website colour theme is completely different to the Complainant’s website.

8.3 Findings re Registration or Use of the Disputed Domain Name in Bad Faith

The Panel has found the Respondent had sufficient rights and legitimate interests to validly register the disputed domain name.

The Panel found the Respondent to be opportunistic in leveraging the Complainant’s marks to help sell its own services, but not in any way that breaches the auDRP.

The Panel finds no evidence referable to the auDRP that suggests mala fides with regard to improper use of, or misrepresentations made about, the “Man with a Van” mark.

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The Panel therefore concludes that the Respondent has rights and legitimate interests in the disputed domain name, and has used it for its own commercial benefit, as it is entitled to do.

We do not find any evidence of its use in Bad Faith.

9. Decision

For all the foregoing reasons, the Complaint is dismissed.

A handwritten signature in red ink that reads "Jon Kenfield". The signature is written in a cursive style with a large, sweeping underline.

Jon Kenfield (single Panellist)

Published: 29th June 2023