

DISPUTE RESOLUTION SERVICE

D00010860

Decision of Independent Expert

Pop Up Power Supplies Limited

and

Macs Automated Bollard Systems Ltd

1. The Parties:

Complainant:

Pop Up Power Supplies Limited
PO Box 1447
Ilford
Essex
IG2 6GT
United Kingdom

Respondent:

Macs Automated Bollard Systems Ltd
Unit 8.1b Tameside Business Park
Windmill Lane
Denton
Lancashire
M34 3QS
United Kingdom

2. The Domain Name(s):

popuppowersupplies.co.uk

3. Procedural History:

01 February 2012 Dispute received
01 February 2012 Complaint validated
22 February 2012 Notification of complaint sent to parties
29 February 2012 Response received
29 February 2012 Notification of response sent to parties
06 March 2012 Reply received
06 March 2012 Notification of reply sent to parties
06 March 2012 Mediator appointed
16 March 2012 Mediation started
03 May 2012 Mediation failed
03 May 2012 Close of mediation documents sent
09 May 2012 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 7 January 2011.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to the Complaint and the Response, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant has operated under the name Pop Up Power Supplies for over 10 years, including by way of advertising.
- b. The Respondent is a competitor of the Complainant.
- c. At the time when it registered the Domain Name, the Respondent was aware of the Complainant and its business.
- d. Confusion has arisen amongst customers as a consequence of the Respondent's use of the term "Pop Up Power".

5. Parties' Contentions

Complaint

A summary of the Complainant's submissions is set out below.

The Complainant has rights in the Domain Name because:

- (1) *The Complainant has operated under the Pop Up Power Supplies name for 11 years, having been incorporated at Companies House on 4 May 2001.*

- (2) *The Complainant's name has been used on all of its products, advertising, brochures, promotional material, letterhead and company documentation during that time (examples of which are appended to the Complaint).*
- (3) *As a consequence, Pop Up Power Supplies is recognised in the trade as indicating goods supplied by the Complainant.*

The Domain Name in the hands of the Respondent is abusive because:

- (1) *The Domain Name was primarily registered to disrupt the business of the Complainant and the Respondent is using it to direct traffic to its own website.*
- (2) *The Respondent is in direct competition with the Complainant.*
- (3) *The Respondent's products have a very similar look to those of the Complainant.*
- (4) *By diverting traffic to its own website, with potential clients going to the wrong website, the Respondent is seeking to take advantage of the extensive advertising which the Complainant has done over the last 11 years under the Pop Up Power Supplies name, which is intrinsically linked in the trade with the Complainant and its products.*

Response

A summary of the Respondent's submissions is set out below.

- (1) *There is a history between the parties. At a trade show in 2007, someone from the Complainant visited the Respondent's stand and thanked the Respondent for the business which the Complainant had obtained as a result of the Respondent's advertisements for its energy tower called "Pop Up Power". He said clients had contacted the Complainant as a consequence and he had obtained several contracts in this way.*
- (2) *This was corroborated by a couple of people who visited the Respondent's stand at that trade show and said that they had thought they were ordering our product but ended up with something else instead.*
- (3) *More recently the Complainant telephoned the Respondent and stated that he had obtained lots of contracts as a result of the Respondent calling its energy tower product "Pop Up Power".*
- (4) *The Respondent is not using the Domain Name as a source of traffic for its own website nor to capitalise on the Respondent's advertising. The Respondent carries out more expensive and higher quality advertising than that of the Complainant.*

- (5) *The Respondent purchased the Domain Name and paid for sponsored links with a view to stopping the issues which had arisen previously regarding contracts lost to the Complainant.*
- (6) *By way of comparison, if one types "Easyjet" into a web search, the first sponsored link which comes up is for Jet2. This is just one example of how key words are interpreted on the Internet.*
- (7) *"Pop Up Power Supplies" and similar terms are used by numerous companies on the Internet (and the Response appends the Respondent's evidence in support of that submission) . It is a common phrase in the industry to describe the Respondent's products and is not specific to any one business. The Complainant should not be able to block other people from using that term. The Complainant does not, and should not, have a monopoly in it.*
- (8) *The Respondent is not passing itself off as the Complainant. It only promotes and invests in its own brands Macs and Pilomat. In addition, the Respondent tends to sell its relevant products to existing clients along with other products.*
- (9) *The Respondent has had a relationship with an Italian company called Pilomat since 2001 and that company manufactures and supplies, amongst others, products called "Pop Up Energy Towers/Pop Up Power Supplies".*
- (10) *The Complainant is not a main competitor of the Respondent. The Respondent rarely comes across the Complainant in its business.*
- (11) *The appearance of one of the Respondent's products may look similar to the Complainant's in that they are both orange. However, the products are very different because the Complainant's is crank-armed, whereas the Respondent's is semi-automatic. Moreover, the appearance of the Respondent's product (a Pilomat product) has not changed in the last 15 years.*

Reply

A summary of the Reply is set out below.

- (1) *The technical term for the type of products in question is "retractable service feeder pillar". "Pop Up Power Supplies" is not a generic term, it is the name of the Complainant's business.*
- (2) *In the ESI publication, the Respondent had an advertisement for "Pop Up Energy Towers" next to the Complainant's advertisement. When this happened the Complainant contacted ESI and also raised the issue with the Respondent. The Respondent's advertisement was not repeated.*
- (3) *Confusion arose when a local council called the Complainant with a health and safety issue. The Complainant told them to visit its website. Confusion*

arose because the council had mistakenly gone to the Respondent's website under the Domain Name and could not access the safety information for the Complainant's products.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).*

Complainant's Rights

"Rights" are defined under the Policy as meaning:

"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"

On the face of it, the name "Pop Up Power Supplies" is reasonably descriptive in nature. The name is not particularly unusual, nor particularly distinctive in relation to the Complainant's products. Nevertheless, the Complainant has traded under the name "Pop Up Power Supplies" for over 10 years, and the evidence (see further below) suggests that the name is associated with the Complainant, in other words that it has a "secondary meaning". In addition, the evidence of that specific name being used descriptively in the relevant trade is not strong (again, see further below). In light of those factors, on balance I find that the Complainant does have some goodwill in that specific name. That goodwill is legally protectable and constitutes Rights for the purposes of the Policy. In making this finding, I take into account that the threshold for establishing Rights under the Policy has been held not to be a high one.

The correct approach is to disregard the generic .co.uk suffix of the Domain Name. Doing so means that the Domain Name should be properly considered as identical to the name which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive 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 used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The main factors under paragraph 3a on which the Complainant (explicitly or implicitly) relies in this case is as follows:

- "i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A.;*
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - C. for the purpose of unfairly disrupting the business of the Complainant;**
- ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant"*

Paragraph 4 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is not an Abusive Registration. The main factors under paragraph 4a on which the Respondent (explicitly or implicitly) relies in this case is as follows:

- "i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
 - A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
 - B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
 - C.....; or**
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it"*

A key aspect of this case is the extent to which the name or term "Pop Up Power Supplies" is associated with the Complainant or is a descriptive term used in the trade sector in question. The Respondent contends that the term is essentially generic and that the Complainant should not be able to prevent anyone else using

it. The Complainant disputes this and submits that “Pop Up Power Supplies” is recognised as designating the Complainant’s business and products.

In order to reach a view on this issue, it is important to consider carefully the evidence which the Respondent has submitted in support of its contention. Taking this evidence in turn:

- (a) The brochure for the Respondent’s Pilomat products is headed on its front page with “PILOMAT RETRACTABLE SYSTEMS”. The term “retractable” is used throughout and there is no reference to “Pop Up”, “Pop Up Power” or “Pop Up Power Supplies”.
- (b) The Pilomat technical instructions document is for a product called the “Pop Up Energy Tower”. There is no reference in that document to “Pop Up Power” or “Pop Up Power Supplies”.
- (c) The natural results of the Google search for the term “Pop Up Power Supplies” has only one relevant result on the first page of results, namely for “pop up power” products from a Chinese company called DHgate. The second page of natural results has three websites which refer to “pop up power supplies” and one which refers to a “pop up power supply”. It also has three third party websites which refer to the Complainant.
- (d) The web page for a company called EDS uses a mix of terms, including “Retractable power pole”, “Retractable power post”, “Rising power poles”, “Power bollards”, “Pop up power posts” and “Pop up power supplies”.

Based on this evidence, there would appear to be some usage of “pop up power supplies” as a descriptive term. However, the evidence for the term being generic is not strong. It is noteworthy that the first page of natural results from the Google search brought up just one reference to “pop up power” (and one which relates to a Chinese company) and none for “pop up power supplies”; also that the Respondent’s own materials relating to the Pilomat products make no reference to “pop up power” or “pop up power supplies”, the main brochure using the term “retractable” and not referring to “pop up” at all.

I turn now to the evidence of confusion having arisen between the Complainant and the Respondent. The Complainant makes reference to a local council having gone to the Respondent’s website at www.popuppowersupplies.co.uk in the mistaken belief that this was the Complainant’s website. The Complainant has not submitted any corroboration for this having happened, so it is difficult to attach much weight to this. Nevertheless, the Respondent itself refers to confusion having been caused by its advertisements for its energy tower called “Pop Up Power”, with potential customers contacting the Complainant as a consequence. In my view, this is evidence of the terms “Pop Up Power” and “Pop Up Power Supplies” being associated with the Complainant. Otherwise why would those customers have contacted the Complainant? If the terms were generic, there would be no reason

for the customers to contact the Complainant any more than any business operating in the same sector.

On balance I conclude that, in the sector in question and particularly in the relevant UK market, the specific term “Pop Up Power Supplies” is associated with the Complainant to a material degree. It should also be noted that the Domain Name is identical to that specific term.

The Respondent’s main website is at www.macs-bollards.com , corresponding directly with its company name. It registered the Domain Name in January 2011. At this point, on its own evidence, the Respondent was fully aware of the existence of the Complainant. It claims that it did so in order to stop the earlier instances of confusion with the Complainant which had been caused by the Respondent’s advertisements for a “Pop Up Power” product. This reason does not ring entirely true. Using a website under the Domain Name would not seem to be a way of removing confusion, in fact it would be likely to increase it. If the Respondent wished to remove the risk of confusion, the obvious route to that would have been to cease using the term “Pop Up Power”, not to use it more and at the same time use as a website address the exact name of the Complainant’s business.

For completeness, I should deal with the Respondent reference to the fact that, when it carried out a Google search for “Easyjet”, the first sponsored link which came up was for Jet2. This is not a proper comparison with the Respondent having registered the Domain Name. Website addresses are distinct from sponsored links. To come up as a sponsored link under the term “Easyjet”, Jet2 must have purchased that term as an Adword with Google. The website address which came up for Jet2’s sponsored link was presumably a Jet2 website address. A better comparison with this case would be if Jet2 had registered the domain name *easyjet.co.uk*. I assume that the Respondent is not suggesting that this would be acceptable, whether generally or under the Policy.

Taking all of the above into account, including the Respondent’s awareness of the Complainant at the time when it registered the Domain Name, together with the instances of confusion which had previously occurred, I find that the Respondent has registered and used the Domain Name in a way which both (a) takes advantage of and is detrimental to the Complainant’s Rights, and (b) is unfair.

7. Decision

Having found that the Complainant has rights in respect of a name which is identical to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *popuppowersupplies.co.uk* be transferred to the Complainant.

Signed Jason Rawkins

Dated: 30 May 2012