



RESOLUTION INSTITUTE DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

Matter: auDRP_15_09

Domain name: powercharge.com.au

Complainant: Regal Electro Pty Ltd

Respondent: Sidekick Creative Pty Ltd

Date: 11 November 2015

Panelist: Andrew Robertson

PANEL DECISION

Case number:	auDRP_15_09
Domain:	powercharge.com.au
Panel:	Andrew Robertson
Complainant:	Regal Electro Pty Ltd
Represented by:	Actuate IP
Respondent:	Sidekick Creative Pty Ltd
Represented by:	McKean Park
Date of decision:	11 November 2015

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1. Procedural history

- 1.1 The disputed domain name is <powercharge.com.au>.
- 1.2 From the material provided to me it appears that the complainant lodged a complaint pursuant to the .au Dispute Resolution Policy ("auDRP") with the Resolution Institute ("the Institute") on 5 October 2015.
- 1.3 The Institute advises that the registrar was advised of the complaint, with a request to clarify the respondent and lock the domain name, on 7 October 2015. The registrar advised the Institute on 8 October 2015 that the disputed domain was locked.
- 1.4 The Institute advised auDA of the dispute on 8 October 2015.
- 1.5 The panel was advised by the Institute that the respondent was advised of the complaint by the Institute on 8 October 2015 and their response sought by no later than 28 October 2015. The respondent acknowledged receipt of the complaint on 8 October 2015.
- 1.6 The respondent provided its response on 26 October 2015.
- 1.7 The panel was approached by the Institute to act as panellist in this matter on 28 October 2015. The panel signed and returned a declaration of impartiality and independence on 29 October 2015.
- 1.8 The panel received the case file on 29 October 2015.
- 1.9 The panel received the following material from the Institute:
 - (a) Draft Statement of Impartiality and Independence;
 - (b) A Procedural History setting out the details as indicated above;
 - (c) The complaint dated 5 October 2015 together with a covering letter of that date and Annexures 1 to 11;
 - (d) A pdf containing:
 - (1) An email chain concluding on 7 October 2015 from the Institute acknowledging the receipt of correspondence and below in the chain an email from Kerri Lambrianis (on behalf of the complainant) dated 5 October 2015 to the Institute apparently originally attaching the complaint;
 - (2) An Acknowledgment of Complaint Lodged dated 29 October 2015 (but from its contents the panel infers that the document was originally attached to the email of 7 October 2015 and the date shown simply represents when the pdf was prepared for forwarding to the panel);
 - (3) A copy of an email dated 7 October 2015 giving notice to the registrar;
 - (4) The registrar's response of 8 October 2015;

- (5) An email chain concluding on 8 October 2015 from auDA and below in the chain an email from the Institute dated 8 October 2015 to auDA giving notice of the dispute; and
- (6) An email of 8 October 2015 from the Institute to admin@sidekick.com.au together with an acknowledgment from Jayden Lawson (on behalf of the respondent) dated 8 October 2015.
- (e) An email of 26 October 2015 to the Institute from David Brett (on behalf of the respondent), together with a LEADR & IAMA Domain Name Dispute Response Form and response dated 26 October 2015; and
- (f) Notification of Panellist allocated dated 29 October 2015.

1.10 A sole panellist has been requested.

1.11 The panel find that it was properly constituted for this complaint.

2. Parties

- 2.1 The named respondent is Sidekick Creative Pty Ltd (“Sidekick”). The respondent submits that Sidekick is an IT service provider which hosts and manages the disputed domain on behalf of Battery Enterprises Pty Ltd.
- 2.2 In the response form it is asserted that Sidekick holds written consent from Battery Enterprises Pty Ltd to use Sidekick’s contact detail on the domain’s Registrant Contact Information, in accordance with section 4.2 of auDA’s “2010-07 – Registrant Contact Information Policy”.
- 2.3 The panel has not been provided any additional evidence.
- 2.4 Nevertheless the panel accepts that is the case and that it is Battery Enterprises Pty Ltd who operates the website and is the registrant.
- 2.5 The panel notes that the complaint had identified that the website at the disputed domain offered goods for sale from Battery Enterprises Pty Ltd.

3. Background

- 3.1 The panel propose to set out the background chronologically. There is some importance to this approach given the issues in this dispute.
- 3.2 The respondent submits that Battery Enterprises Pty Ltd was incorporated in December 1995. It commenced trading in April 1996, and since 1998 has been importing and selling a range of batteries described as Power Charge.
- 3.3 The respondent claims that since its first sales in 1998 it has sold in excess of \$20 million worth of batteries in Australia under and by reference to what the respondent describes as the Power Charge brand.
- 3.4 The respondent has provided 5 pieces of correspondence the earliest dated 16 March 1998 and the last dated 25 March 2002¹ demonstrating the use of the words POWER

¹ The other dates are 24 April 1998, 23 April 1999 and 24 December 2001.

CHARGE (all capitalised) on the respondent's letterhead on the dates of the correspondence. The name also appears on business cards, the panel assumes from the late 1990s but that is not clear on the evidence. The business card also includes a stylized lightning bolt.

- 3.5 Two sale invoices, one from 8 October 1998 and another from 26 March 2003, were also provided showing the words POWER CHARGE used prominently by the respondent (the latter also with the stylized lightning bolt but what appears to be a different font).
- 3.6 Price lists, said to be from 2001 and 2007, show the words Power Charge. The respondent says the price lists were provided to third party purchasers and potential consumers around Australia.
- 3.7 The respondent provided an advertisement in the 2003 yellow pages under the name Battery Enterprises Pty Ltd but prominently incorporating the words POWER CHARGE and a stylised lightning bolt.
- 3.8 Concept art for an advertisement in the Yellow Pages was also provided by the respondent. It bears the date 31 March 2004. The respondent submits that the words POWER CHARGE are a prominent and significant feature of the proposed artwork. The document supports that submission.
- 3.9 The respondent has in its material included two invoices issued in 2007 from a Malaysian company which describe in part the batteries supplied pursuant to the invoice with "Brand: Power Charge".
- 3.10 The respondent has provided a photograph of what is said to be a battery which displays the words POWER CHARGE and a stylised lightning bolt. The respondent has provided what it says are the properties for the jpeg image showing the photograph as having been "Modified: Tuesday 22 January 2008". The respondent says the photograph was taken in January 2008.
- 3.11 The respondent provided copies of what is said to be in-store displays and advertising on buildings displaying the words POWER CHARGE and the stylized bolt. The respondent says it cannot date this material with certainty but that it has been determined they were created before 2008. How that was determined is not explained.
- 3.12 The complainant was established on 5 November 2008. It says that since incorporation it has manufactured and supplied a range of batteries with reference to the name POWER CHARGE. It uses a logo involving a stylized rendering of the words POWER CHARGE.
- 3.13 The complainant's evidence suggests, and no evidence to the contrary was advanced, that it sells substantial levels of battery products in parts of Australia and New Zealand and has done so since 2008.
- 3.14 It appears to be common ground that the batteries sold by the respondent under the name power charge are not the same batteries as those manufactured and sold by the complainant under the same name. The complainant asserts that the batteries sold by the respondent are manufactured by another entity based in Malaysia. This is consistent with the invoices.

- 3.15 The complainant is the holder of an Australian registered trade mark number 1268903 filed on 7 November 2008 by reference to the words POWER CHARGE and a logo. The logo uses 2 curved arrows forming an ellipse around the words POWER CHARGE.
- 3.16 The respondent provided material from the Capricorn Society, whom the respondent describes as an automotive trade based organisation that the respondent advertises with, containing the words POWER CHARGE. This material was said to encompass multiple dates but goes back to 2010.
- 3.17 The respondent says in October 2010 it became aware of the complainant when a third party indicated it was surprised that the respondent was selling batteries with a new Power Charge design on them.
- 3.18 In October and November 2010 the respondent claims that it contacted the complainant “concerning its [the claimant’s] use of the Power Charge mark and Battery Enterprises’ concerns about confusion in the market place”.
- 3.19 The respondent says in early 2011 the parties had solicitors exchange correspondence. That correspondence is not in evidence.
- 3.20 In March 2011 the respondent claims it received a call from a disgruntled purchaser of battery branded as Power Charge but upon investigation it was the claimant’s battery not the respondent’s battery.
- 3.21 The respondent says that it was in early 2013 it decided it needed to create a website to advertise its goods and services. The respondent says that it chose the domain name <powercharge.com.au> as it had been promoting its goods and services under and by reference to the Power Charge trade mark since 1998. The respondent further submits that it was known interchangeably as Power Charge and as Battery Enterprises and it was well known as the source of batteries branded as Power Charge batteries.
- 3.22 The complainant identifies 28 June 2013 as the first date on which it has identified use of the domain by reference to Wayback Machine archive.
- 3.23 There is also reference to a related company of the respondents, Power Charge Pty Ltd (ACN 072 203 582) but the respondent did not provide further details and therefore this is not of assistance in resolving the issues for determination.

4. Relevant principles

- 4.1 This dispute is to be resolved in accordance with auDRP Policy published by .au Domain Administration Ltd including Schedule A to that document.
- 4.2 Paragraph 4 (a) of the auDRP Policy provides that for the dispute to come within the auDRP a complainant must establish that:
- (a) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
 - (b) the respondent has no rights or legitimate interests in respect of the disputed domain name; and

- (c) the disputed domain name has been registered or subsequently used in bad faith.

4.3 Each of these elements must be established if the complainant is to succeed. The remedies available to the parties are limited in this process to those contained in the policy. Therefore a decision in this determination resolves only the issues and the question of relief provided for in the auDRP.

4.4 In these proceedings the complainant bears the onus of proof for establishing it has made out the elements of auDRP.

Identical or confusingly similar

4.5 The panel finds the evidence as set out above establishes the first element. The complainant is the owner of a trademark which is identical or confusingly similar to the disputed domain.

4.6 The complainant has also asserted common law rights in support of its submissions with respect to the first element.

4.7 The panel find that the complainant has established the first element required in paragraph 4 (a) of the auDRP Policy.

No rights or legitimate interests

4.8 The second element of the policy requires the complainant to prove that the respondent lacks rights or legitimate interests in the domain name. The complainant's evidence and submissions went beyond the registered trademark to the evidence of extended use of the name and logo by the complainant such that the complainant asserted the mark was exclusively associated with the complainant. It was submitted that goods with the mark will appear to members of the public as having emanated from the complainant. Reputation was asserted to establish significant common law rights.

4.9 It is not for this panel to make any finding on these allegations beyond the extent to which these matters assist the complainant to establish the matters relevant to the auDRP Policy.

4.10 As the complainant notes the wording of the auDRP requires the complainant to prove a negative with respect to the second element – that the respondent does not have rights or legitimate interests in respect of the domain names. The complainant asserts that it must make out a prima facie case after which the respondent must provide evidence of its right or legitimate interest in the domain.

4.11 The panel propose to deal with these issues in this way.

4.12 The complainant seeks to make out the lack of bona fides on the part of the respondent by reason of the complaint's registration and use of the power charge name and mark prior to the first use of the web site. The complainant also notes the difference between the Enterprises name and the mark, and by extension presumably the domain.

4.13 Based on the facts the complainant asserts that the respondent had actual or constructive knowledge of the complainant's trademark when registering the domain.

It is asserted that the respondent has not been legitimately known by the domain name or the trademark and is in effect passing itself off as the complainant by trading on its reputation.

- 4.14 The panel finds that the complainant has made out a prima facie case. The respondent must provide evidence of its right or legitimate interest in the disputed domain otherwise the second element would be established.
- 4.15 The prima facie case appears to be made of several elements which the panel felt the respondent needed to provide some explanation, including:
- (a) The similarity of the disputed domain with the complainant's trade mark;
 - (b) The disputed domain having been registered some years after the complainant commenced trading;
 - (c) The complainant asserted it has established a reputation by the time of the registration, which the complainant suggests the respondent sought to benefit from, relying on the lack of connection between the respondent's name and the disputed domain.

Trade mark

- 4.16 The complainant's case relies on its registered trademark. Absent the respondent's evidence and submissions there is a good prima facie case.
- 4.17 However the respondent's evidence identifies a long course of conduct which places the respondent's conduct in a different light. The respondent has provided multiple examples of its use of the words power charge prior to the registration of the trademark.
- 4.18 The respondent responded to the complainant's allegations of trademark infringement by referred to and relied upon sections 122 (fa) and 124 of the *Trade Marks Act 1995* (Cth) in its submissions. The respondent submits that these sections provide a valid and complete defence to any infringement allegation of the claimant's registered trademark.
- 4.19 The panel is not in a position to reach any conclusion on the *Trade Marks Act* issue however on the face of the respondent's evidence, and the complainant's material is not inconsistent with it, there does appear to have been use by the respondent of the POWER CHARGE name in the connection with the offering and sale of batteries since 1998 and there is several examples of its use provided by the respondent prior to the incorporation of the claimant or the registration of the trade mark.
- 4.20 All the panel can say as to the *Trade Marks Act* submissions of the respondent is that on what the panel has seen the respondent's position is arguable.
- 4.21 The panel notes the logo registered by the complainant incorporates the words POWER CHARGE but aside from both brands containing the words with each letter capitalised the complainant's and respondent's brands appear to differ. The complainant uses 2 curved arrows forming an ellipse around the words. The respondent appears to have preferred, when there is an image, a stylised lightning bolt or an anthropomorphised battery with a lightning bolt on its chest.

- 4.22 The respondent's evidence suggests that the complainant and the respondent have each separately sought to trade on the name POWER CHARGE being unaware of the other prior to 2011. The words power and charge separately, and to a lesser extent in combination, are general words describing the basic elements of batteries. It seems to me quite probable and reasonable that competitors in the business of selling batteries may each independently resolve to connect their business with these general words.
- 4.23 The panel finds on balance the respondent's evidence has provided the necessary response to the complainant's case such that the complainant's trademark cannot be said to demonstrate the respondent has no rights or legitimate interests in respect of the disputed domain name.

The remaining issues

- 4.24 The complainant's submissions were not so narrow however that the trademark finding by itself is sufficient to dispose of the issue.
- 4.25 The registration of the disputed domain several years after the registration of the complainant's trade mark and established reputation is prima facie requiring of some explanation.
- 4.26 The respondent was aware, on its own submissions, of the complainant at the time of the registration of the domain name. The panel accepts that the complainant may have (but the panel need not decide) established reputation by 2013 having by then been trading for some five years. The panel also accepts that the use by both complainant and respondent of the words POWER CHARGE may cause confusion. The panel can make that finding confidently as the respondent's submission made reference to this very point.
- 4.27 The respondent's submissions referred to purchasers complaining to the respondent regarding batteries the respondent alleges were the complainant's.
- 4.28 However it does not necessarily follow, as the complainant submits, that this prior reputation of the complainant deprives the respondent of right or legitimate interest in the disputed domain. This is because the respondent's evidence suggests and the respondent's submissions appear to assert a reputation associated with POWER CHARGE and use from 1998, that is pre-dating the complainant by several years.
- 4.29 The complainant, quite properly, referred to paragraph 4 (c) (i) of the auDRP Policy which provides that use of a domain name may be found to be legitimate if before any notice to the respondent of the subject matter of the dispute, the respondent bona fide used of, or there is evidence of demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or service.
- 4.30 The complainant's case relied upon the respondent having sought to trade on the complainant's reputation. The material from the respondent, including material prior to the complainant having commenced to trade, suggests otherwise.
- 4.31 The complainant seeks to impugn the decision by the respondent to register this particular domain as an effort to trade on the complainant's reputation. As the panel understand the submission the complainant relies on its established and long-held

reputation in the domain named to effectively exclude the use of the domain name by another party as legitimate.

- 4.32 At the time of the complainant's submissions it did not have the benefit of the respondent's evidence but the panel finds that in light of the respondent's evidence that the submission put in the manner the complainant has cannot be made out.
- 4.33 While the complainant has established that it has traded with a connection to POWER CHARGE since at least November 2008 the respondent's evidence suggests that it had a prior and separate reputation
- 4.34 The respondent's case acknowledges that it was aware of the respondent approximately two years prior to the registration of the domain, which is consistent with the assertion of the complainant as to the respondent's knowledge at the time of registration of the domain. However the evidence in its totality of the prior use back to 1998 contradicts the submissions of the complainant seeking to link these matters so as to deprive the respondent of a legitimate interest in the domain.
- 4.35 The evidence lead by the respondent appears to bring the respondent within paragraph 4 (c) (i) of the auDRP Policy. There is also some evidence that the respondent falls within paragraph 4 (c) (ii) of the auDRP Policy but the panel need not decide that.
- 4.36 If this is a case where the claimant and respondent had both independently established reputation associated with the words POWER CHARGE then the respondent cannot be said to have no rights or legitimate interests in respect of the disputed domain name.
- 4.37 As the panel has noted it seems to me quite probable and reasonable that competitors in the business of selling batteries may each independently resolve to connect their business with the general words POWER CHARGE with neither party seeking to trade off of the reputation of the other.
- 4.38 For all these reasons the panel finds the complainant has not established that the respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

- 4.39 In light of the panel's decision with respect to the second element for the reasons set out above the panel finds the complainant has not established the disputed domain name has either been registered or subsequently used in bad faith.

5. Conclusion and decision

5.1 For the reasons set out in this determination the panel orders that the complaint be denied.



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Andrew Robertson

Dated: 11 November 2015