

Institute of Arbitrators & Mediators Australia

ADMINISTRATIVE PANEL DECISION

Automatix Pty Limited trading as Popcake

v.

Todd Polke

Case No. IAMA 3710

1. The Parties

The Complainant is Automatix Pty Limited, an Australian registered company ABN 85 112 950 197 care of My Business Hosting, 40 Parkes Crescent, Blackett, New South Wales 2770.

(Complainant)

The Respondent is Mr. Todd Polke a natural person and individual/sole trader ABN 79 897 275 709.

(Respondent)

The Complainant is represented by Mr. Anastasios Tsapilis of 40 Parkes Crescent, Blackett, New South Wales 2770. The Respondent is not represented.

2. The Domain Name and Registrar

The disputed domain name <popcake.com.au> is registered with NetRegistry.

3. Procedural History

A complaint was filed with the Institute of Arbitrators & Mediators Australia (IAMA) Dispute Resolution Centre (Centre) under complaint dated January 2, 2013 (Complaint). On January 4, 2013, the Complainant transmitted to NetRegistry, the Registrar, details of the Complaint and disputed domain name with a request for Registrar verification in connection with the domain name at issue. On January 16, 2013, NetRegistry transmitted by email to the Centre its verification response confirming that the name in dispute was registered with NetRegistry. The Centre verified that the Complaint satisfied the formal requirements of .au Domain Administration Ltd (.auDA), relevantly, the .au Dispute Resolution Policy (Policy), the Rules for .au Dispute Resolution Policy (Rules) and the IAMA Supplemental Rules to the .au Dispute Resolution Policy (Supplemental Rules).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Centre formally notified the Respondent of the Complaint, and the administrative proceedings commenced on

January 4, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was January 24, 2013. The Respondent submitted a response dated January 27, 2013 (First Response) and a supplementary response dated February 8, 2013 (Supplementary Response). The lodgement of both responses is outside the time limit set under Rule 5(a) of the Rules. The Panel has discretion to extend time for performance. In the opinion of the Panel the lateness of the responses was not great and in any event the Panel had been provided with and read the responses. The Panel also notes that the Respondent is not represented. The Panel has decided to exercise its discretion and will take the responses into account in its deliberations.

On the material before it, the Panel could not be certain that the Supplementary Response of the Respondent had been served on the Complainant. Moreover, given that a Supplementary Response had been made by the Respondent, so as to accord the Complainant fairness and due process, the Panel issued Direction number 1 dated February 15, 2013. This Direction required service of the Supplementary Response on the Complainant and directed the Complainant, if it elected to do so, to issue and serve a reply by no later than February 22, 2013. The Complainant issued a reply dated February 21, 2013 (Complainant's Reply). Direction number 1 also provided for an extension of the time for issuing the Panel decision to March 11, 2013.

On February 25, 2013, the Panel issued Direction number 2 which directed the parties to notify the Provider forthwith of the date of registration with NetRegistry of the disputed domain name <popcake.com.au>. The date of registration was notified accordingly as being July 21, 2011.

The Centre appointed Mr. Michael JF Sweeney as the sole panellist in this matter on February 8, 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 Centre to ensure compliance with paragraph 7 of the Rules.

4. Factual Background

The Complainant is an Australian incorporated company. The Complainant states that it is in the business of pop cakes and operates in Australia, Asia, USA and Europe. The Panel understands that a pop cake includes what is known as a pan cake.

The Respondent is an individual sole trader with a registered Australian Business Number. It is engaged in a variety of industries and ventures. The Respondent states its activities include a planned business for cake pops. A cake pop has been described, in elementary terms, as consisting of a piece of cake on a stick.

Given the number of relevant dates and sequence of events, the factual background on matters that are the subject of public record may be conveniently set out in the form of the chronology below.

DATE	CHRONOLOGY - SUBJECT
12/03/02	Marek Szymanski – registers business name <POPCAKE> with ASIC. Registration current to 12/03/14

9/4/02	Marek Szymanski – registers Trade Mark POPCAKE + logo + smiling face. Registration remains current
1/8/02	Polke, Todd ABN 79 897 275 709 - registered as individual/sole trader
14/7/03	Popcake International Pty Ltd ACN 105 517 280 incorporated. Remains current
15/9/03	Marek Szymanski – registers Trade Mark POPCAKE as a word alone. Registration remains current
15/2/05	Automatix Pty Limited ABN 85 112 950 197 - incorporated. Remains current
15/2/05 to 3/5/05	Automatix Pty Limited – trading name <Pop Cake International> noted on company records. Trading name lapses
3/5/05 to 23/5/05	Automatix Pty Limited – trading name <POPCAKE INTERNATIONAL> noted on company records. Trading name lapses
23/5/05 to present	Automatix Pty Limited – trading name <POPCAKE> noted on company records. Trading name remains current
26/10/10	Todd Polke – trading name noted on the Polke, Todd individual/sole trader records
21/7/11	.au Domain Name <popcake.com.au> registered with NetRegistry to Polke, Todd ABN 79 897 275 709
4/1/12	Ignition Ed Pty Ltd ABN 95 147 163 406 – incorporated. Remains current
21/2/12	.au Domain Name <cakepopmaker.com.au> registered with NetRegistry to Polke, Todd ABN 79 897 275 709 .au Domain Name <tinytreats.com.au> registered. Date unknown
17/10/12	Polke, Todd ABN 79 897 275 709 – registers business name <pop cakes australia> with ASIC
21/12/12	Ignition Ed Pty Ltd – registers business name <CAKE POPS AUSTRALIA> with ASIC

2/1/13	Complainant lodges formal dispute with Provider
4/1/13	Date of commencement of Administrative Proceeding
15/2/13	Panel Directions #1
25/2/13	Panel Directions #2

5. Parties' Contentions

A. Complainant

The Complainant contends as to those matters listed in the chronology that concern it and its entities and as supported by the summary of the relevant extracts from the public records.

In addition, the Complainant's contentions in its Supplementary Response include:

- (1) Point 2 on page 3: 'The Complainant has shown their entitlement to the domain name via the registered business names, registered Trademarks, and related web sites showing the business name and the trademarks'.
- (2) The Complainant is the holder of an unregistered trading name <popcake>.
- (3) Point 3 on page 3: 'Complainant has been operating under the Trade Mark POPCAKE since 2001'.
- (4) Point 3 on page 4: The Complainant states that it 'has been operating the domain name www.popcake.com.au since 2002.'
- (5) Point 3 on page 4: The Complainant states that it operates in Australia, Asia, the USA and Europe under the <POPCAKE> trade mark and 'has corresponding trade mark registrations in such countries'.
- (6) The disputed domain name is identical or confusingly similar to the name and Trade Marks of the Complainant.
- (7) The Respondent has no legitimate rights or interest in the disputed domain name.
- (8) The Respondent at the time of registration was not the owner of any business of relevance to the domain name.
- (9) The Respondent has registered the disputed domain name in bad faith.

B. Respondent

The Respondent contends as to those matters listed in the chronology that concern it and its entities and as supported by the summary of the relevant extracts from the public records.

In addition, the Respondent's contentions include:

- (1) He has been involved in a variety and range of industries and ventures set up since 2002.
- (2) The business name <pop cakes Australia> was registered as from December 21, 2012.
- (3) Various business names including <pop cakes Australia> were used prior to the domain name dispute being registered on January 2, 2013.
- (4) The disputed domain name does have a substantial connection to the planned business of cake pops giving a legitimate right and interest in the domain name.
- (5) Cake pops are not a competing product to the Complainant's business of pop cakes and the domain name has not been registered in bad faith.
- (6) He has demonstrated preparations to use the disputed domain name by registering various business names and the specific additional domain name <pop cakes Australia>.
- (7) A trade mark is not an automatic right that enables registration of a domain name.
- (8) Onus of proof is on the Complainant under the auDA Policy and Rules.
- (9) He has not registered the disputed domain name in bad faith.

6. Discussion and Findings

Pursuant to paragraph 10 of the Rules, the Panel is required to conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and Rules. Under sub paragraph (viii) of paragraph 3 of the Rules, the Complainant is required to comply with certain matters including specifying the name(s), trade mark(s) or service mark(s) on which the Complaint is based and, for each mark describe the goods or services, if any, with which the mark is used. Under sub paragraph (ix) of paragraph 3, the Complainant is required to describe, in accordance with the Policy, the grounds on which the Complaint is made.

Paragraph 4(a) of the Policy requires a complainant to prove:

- (i) the respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent's domain name has been registered or subsequently used in bad faith.

The Panel's discussion and findings in respect of the matters required to be proved are as follows.

A. Identical or confusingly similar to a name in which the complainant has rights

It is a matter of record that the business name <popcake> was registered to Marek Szymanski on March 12, 2002. Trade Mark 908816 for the word <popcake> and image of smiling face licking lips logo was registered to Marek Szymanski from April 9, 2002. Trade Mark 970828 for the word <popcake> alone was registered to Marek Szymanski from September 15, 2003. (For reference purposes, the registered trade marks are collectively referred to below by the expression 'Trade Marks').

Automatix Pty Limited ABN 85 112 950 197, the Complainant, was incorporated on February 15, 2005. Details from the Australian government <business.gov.au> web site record that from May 23, 2005 to the present, the name <popcake> has been a trading name of Automatix Pty Limited. There is nothing in this entry that reveals that the trading name is registered.

Paragraph 4(a)(i) of the Policy requires that the Complainant, amongst other proofs, must demonstrate that the Respondent's domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights. Further, Note 1 to the Policy states:

For the purposes of this Policy, auDA has determined that a 'name ... in which the complainant has rights' refers to:

- (a) the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority; or*
- (b) the complainant's personal name.*

To satisfy paragraph 4(a)(i) of the Policy, the complainant must adduce evidence that the respondent's domain name is identical or confusingly similar to a name, trade mark or service mark *in which the complainant has rights*. This right of a complainant to the name or trade mark under the Policy is a prerequisite which a complainant must establish before it can then proceed to discharge its burden of proving that a respondent's domain name is identical or confusingly similar to the Complainant's name or trade mark. To the extent that the Complainant asserts that it has rights to a name (as distinct from a complainant's personal name, a trade mark or service mark), Note 1 requires that the name be registered with the relevant Australian government authority.

In the factual circumstances recited above, does the Complainant have rights to the registered name <popcake> or to the Trade Mark <popcake> where the business name <popcake> and the Trade Mark <popcake> are registered, not in the name of the Complainant, but in the name of Marek Szymanski?

Details of the Complainant company (extracted November 15, 2012 from <business.gov.au>) denote 'popcake' as a trading name of the company from May 23, 2005 which remains current. The Panel is not aware that there is a system for registration of a trading name unless that trading name is registered as a business name. No evidence has been adduced that there is a registration process for a trading name that is not sought to be registered as a business name. There is nothing in the Complainant company entry details that indicates that the trading name is registered to the Complainant. Indeed, from the ASIC extract (dated November 15, 2012) the business name <popcake> is registered in the name of Marek Szymanski from March 12, 2002 and remains current.

The evidence of the several extracts from the relevant Australian government authorities show that the Complainant does not have a right established by registration to the name <popcake>. All that the Complainant has provided is evidence of its use of that name as an apparently unregistered trading name.

In respect of the Trade Marks over <popcake>, the Complainant's evidence shows registration in the name of Marek Szymanski. There is no direct explanation as to how the rights in the Trade Mark <popcake> are claimed by the Complainant.

The Complaint and Complainant's Reply also include the following contentions.

- (1) Point 2 on page 3: 'The Complainant has shown their entitlement to the domain name via the registered business names, registered Trademarks, and related web sites showing the business name and the trademarks'.

The reference to 'related web sites' appears to be a reference to online access to the registry concerning trade marks, to ASIC online and to business.gov.au site relating to business names. From the examination of the evidence as above, the business name <popcake> is not registered to the Complainant and nor are the Trade Marks.

- (2) Point 3 on page 3: 'Complainant has been operating under the Trade Mark POPCAKE since 2001'.

In fact the dates of registration of the Trade Mark that has the word <popcake> with the image and the Trade Mark for the word <popcake> alone are April 9, 2002 and September 15, 2003 respectively. As has already been established the Trade Marks are in the name of Marek Szymanski with no evidence of any earlier registration in any other name. Apart from the Complainant's assertion, there is no evidence as to the Complainant 'operating under the Trade Mark <popcake> 'since 2001'.

- (3) Point 3 on page 4: The Complainant states that it 'has been operating the domain name www.popcake.com.au since 2002.'

This statement is inconsistent with the fact of the subsequent registration of the same domain name to the Respondent and inconsistent with the basis of the making of this Complaint, which asserts that the Respondent's domain name is the same or confusingly similar to its business name or Trade Marks. There is no publicly accessible web site <www.popcake.com.au> at the time of this decision, although there is an operative site under www.popcake.com. The statement may be a reference to the operation of the <popcake> business name, which has been held by Marek Szymanski since 2002, or it may be a reference to the operation of the <.com> web site (as distinct from the .au domain). The assertion as to use in the .au domain is not clear or supported.

- (4) Point 3 on page 4: The Complainant states that it operates in Australia, Asia, the USA and Europe under the <POPCAKE> trade mark and 'has corresponding trade mark registrations in such countries'.

Beyond the simple assertion that it operates under the Trade Marks in Australia, this contention provides no evidence as to how or by what arrangement or authority the Complainant company operates under the <popcake> Trade Marks.

Another consideration for the Panel is whether it may be open for the Panel to draw an inference that the Complainant has acquired rights from the registered owner of the business name and the Trade Marks, Marek Szymanski, by reason of some relationship (perhaps being a shareholder or director of the Complainant) or by inferring the receipt of a licence to use the registered business name <popcake> or the registered Trade Marks.

A close analogy to the .auDA process for dispute resolution is the Uniform Domain Name Dispute Resolution Policy and Rules (UDRP). Decisions made under the UDRP by prior panels have led to the development of a body of decisions, not of a binding or precedent nature, but decisions which have demonstrated a broad consensus view on various questions that regularly arise in the resolution of domain name disputes. Of course, any panel, including this Panel, must decide the issues for itself on the evidence before it.

A consensus view arising from prior panel decisions under the UDRP on the question of what evidence may be sufficient for a complainant to support that it has a right to a trade mark (when seeking to make its proofs analogous to those under paragraph 4(a)(i) of the Policy) may be of assistance in the present case. In collected prior decisions, the World Intellectual Property Organisation's (WIPO) Overview 2.0 notes that prior panels have in certain cases been prepared, in the absence of more direct evidence, to infer the existence of a license and/or authorisation from the particular facts.

Circumstances which may enable the drawing of an inference about a complainant's right to a trade mark were considered in *DigiPoll Ltd. v. Raj Kumar* [WIPO case No. D2004-0939, February 3, 2005], a decision of sole panellist The Hon Neil A. Brown QC. The Complainant was not the registered owner of the relevant trade marks (and apparently asserted no claim to a trade mark arising at common law). The owner of the trade marks was one of the Complainant company's two shareholders who was also one of its two directors. Letters were provided which demonstrated that the shareholder/director had granted a licence to the Complainant to use the trade marks, that the licence in favour of the Complainant had existed for some time and that the shareholder/director was instrumental in bringing the complaint to protect the trade mark. The panel regarded this as sufficient to establish the requisite right in the trade marks for the complainant to proceed to make out its case under the equivalent of paragraph 4(a)(i) of the Policy.

Insufficiency of evidence to enable drawing an inference was considered in the decision of *Applegate Directory Ltd. v. Interlution a/k/a Matthew Bessette* [WIPO case No. D2004-0181, May 26, 2004], a decision of three panellists. The Complainant admitted that there were two separate related entities, with the complaint being brought in the name of one entity but the trade mark being held by the other non complainant entity. The Complainant contended that it had a legal and contractual right to the trade mark (and therefore sufficient right to bring the complaint) by virtue of an assignment of rights to it from the other entity. However, because the Complainant did not provide any documentary evidence of its right to enforce the trade mark (and hence to support its allegation of the domain name use being identical or confusingly similar to the registered trade mark in which the complainant has rights), the panel dismissed the complaint. The present matter before the Panel is analogous to *Applegate Directory*, where the Complainant in the present matter has asserted that it has a right to the trade mark of Marek Szymanski, but has provided no proof of the same.

There must be persuasive evidence to enable the drawing of an inference by the Panel to support that the Complainant possessed rights to the registered business name or the

two Trade Marks due to some relevant relationship, assignment or licence. The Complainant has not provided any evidence of a relationship between it and Mr. Szymanski. It has not provided any evidence of a license to use the business name or Trade Marks held by Mr Szymanski.

The Complainant bears the burden of proof. The Policy makes it plain what matters are required to be proved. The Complainant had two opportunities of presenting evidence in support of its Complaint.

Having regard to the evidence presented by the Complainant asserting its right to the registered business name and the two Trade Marks, for the reasons given, in the opinion of the Panel, there is not sufficient evidence to establish that the Complainant has the requisite right in the registered business name <popcake> or the two registered Trade Marks. Further, there is no evidentiary basis from which the same could be safely inferred. Also, for the reasons given, the Complainant has not established any right it may have in respect of the trading name <popcake> sufficient to meet the requirements of paragraph 4(a)(i) and Note 1 to the Policy.

On the evidence therefore, it follows that the Complainant has failed to prove the first mandatory requirement under paragraph 4(a)(i) of the Policy that the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.

B. No rights or legitimate interests & registration in bad faith

As each of the elements of paragraph 4(a) of the Policy must be proved and the Complainant has failed to prove the first element (a)(i), the Complaint must fail. As a consequence, it is not necessary for the Panel to consider and decide upon the second two elements requiring the Complainant, under (a)(ii), to establish the Respondent's absence of rights or legitimate interests in the domain name and, under (a)(iii), that registration or use by the Respondent of the domain name was in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

Michael JF Sweeney

Sole Panellist

March 5, 2013