



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**United Parcel Service of America, Inc. v. Wesley Bryant**

**Case No. DAU2009-0012**

#### **1. The Parties**

The Complainant is United Parcel Service of America, Inc. of Atlanta, Georgia, United States of America, represented by King & Spalding, United States of America.

The Respondent is Wesley Bryant, Hawthorn, Victoria, Australia.

#### **2. The Domain Name and Registrar**

The disputed domain name <pickupsonline.com.au> is registered with IntaServe.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 30, 2009. On December 1, 2009, the Center transmitted by email to IntaServe a request for registrar verification in connection with the disputed domain name. On December 3, 2009, IntaServe transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 21, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was January 10, 2010. On Respondent's request the Response due date was extended to January 23, 2010. The Response was filed with the Center on January 21, 2010.

The Center appointed Andrew Frederick Christie as the sole panelist in this matter on January 28, 2010. 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 Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is the world's largest package delivery company and one of the leading global providers of specialized transportation and logistics services. It provides air and ground transportation and delivery services for packages, documents and other personal property throughout the world. The Complainant has continuously owned and used the name and mark UPS and has established use in connection with its products and services since at least 1933.

The Complainant owns trademark registrations for the mark UPS in the United States of America (first registered August 21, 1973), in Australia (first registered April 12, 1985) and in more than 190 other countries. The Complainant also owns trademark registrations for the mark UPS.COM in the United States of America (first registered August 28, 2001), and for the mark UPS ONLINE in Australia (first registered November 5, 1996).

The Respondent registered the disputed domain name on February 1, 2005. The Respondent is the Manager of Pick Ups Online, an online freight brokerage business. The business focuses on servicing small businesses, businesses with small or ad hoc freight volumes, businesses that use various categories of freight requiring several suppliers, and consumers with casual or one-off freight or courier requirements. Pick Ups Online commenced operation in early 2006, with the Respondent operating as a sole trader. In June 2006, the company Deliver Management Australia Pty Ltd. was incorporated to run the business. By mid June 2009, the business had annual sales in excess of \$A0.5million.

The disputed domain name resolves to the home page of the website of the business Pick Ups Online. The website provides substantial information about the various services provided by Pick Ups Online, and enables customers to determine the transit times and costs of shipping goods by those various services.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to its UPS, UPS.COM and UPS ONLINE trademarks. The disputed domain name contains the entire UPS ONLINE trademark, with the addition of the prefix "pick". The inclusion of the UPS ONLINE trademark in the domain name creates a strong likelihood of confusion as to source, sponsorship, affiliation, or endorsement of the Respondent's domain name and website by the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. There is no evidence that the Respondent has used the domain name or was preparing to use the domain name in connection with a *bona fide* offering of goods and services. The Respondent has used the domain name to mislead and confuse the public, by drawing on the fame and goodwill of the Complainant's well-known trademark. The Respondent is not known and has never been known by the disputed domain name. The Respondent's use of the disputed domain name is

neither legitimate nor fair. The domain name is intended to deceive and to confuse for the sole purpose of commercial gain.

The Complainant contends that the Respondent registered and is using the domain name in bad faith, because: the UPS trademark is famous and predates the Respondent's activity; the Respondent must have been aware of the UPS trademark given its fame; and the intention of the Respondent in registering the domain name is to confuse and deceive the public into believing the domain name is associated with the Complainant's goods and services, so as to divert potential customers to the Respondent's activities in an attempt to defraud members of the public.

## **B. Respondent**

The Respondent contends that the disputed domain name is not identical or confusingly similar to the UPS and UPS ONLINE trademarks. "UPS" is an acronym for United Parcel Service and the Complainant is commonly known by these letters. The Respondent's use of these letters in its business name, in its logos and in the disputed domain name is as a word – "ups" is referred to and pronounced as a whole word, not as three letters. The addition of the word "pick" to the words "ups" and "online" in the disputed domain name is significant – "Pick Ups Online" is descriptive of the business activity undertaken by the Respondent.

The Respondent contends that it has a right or a legitimate interest in the disputed domain name. It has engaged in a *bona fide* business for over four years, with a further two years of preparation and planning prior to commencing to trade. The Respondent has used the domain name since 2005 to provide its services, before the Complainant's first correspondence to the Respondent in July 2006. The Respondent owns an Australian company the name of which is Pick Ups Online Pty Ltd. The Respondent is commonly known by the disputed domain name among its customers, prospects and suppliers in Australia and particularly in its local area of Melbourne.

The Respondent refutes the allegation that it has registered and is using the disputed domain name in bad faith. It has been operating a *bona fide* business where its domain name is its primary link to the market it services. It does not use the domain name to cause confusion to consumers or profit from the goodwill of the Complainant. The Respondent does not compete in the same market as the Complainant. The markets serviced by the Complainant in Australia are logistics and international courier. The Respondent does not service the logistics market and has very little activity in the international courier market. The Respondent has never offered the disputed domain name for sale to the Complainant or to any third party.

The Respondent contends that the Complaint was brought in bad faith, and requests the Panel to make a finding of reverse domain name hijacking. The Complainant either made no effort to investigate the Respondent's activities or set out to intentionally deceive the Panel with the contents of its Complaint with full knowledge of the Respondent's business activities. If the Complainant had investigated the Respondent's website at the disputed domain name it would have ascertained that the Respondent was operating a *bona fide* business. Furthermore, the Complainant made allegations that are false and would have been known to be false. The Complaint states that the fact that the version of the Respondent's logo that the Respondent sought to register as an Australian trademark was modified to remove a space between "Pick" and "UpsOnline" demonstrates that the Respondent was aware of the emphasis placed on these word elements and believed that the removal of the space would increase the likelihood of registration. This is a fabrication to deceive the Panel for the Complainant's gain. The

Complainant's legal representation was aware of the reasons for rejection by IP Australia of the Respondent's trademark application and that there was no reference to the Complainant's trademarks.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

At first glance, it might be thought that the issue of confusing similarity in this case is straight forward, because the disputed domain name incorporates two of the Complainant's trademarks – UPS and UPS ONLINE – in their entirety. Furthermore, the domain name differs from one of the Complainant's trademarks – UPS ONLINE – only by the addition of the common word “pick”. It is well accepted that, *in most cases*, the inclusion of a word, especially a common word, in a domain name containing the entirety of a complainant's trademark will not prevent the domain name from being confusingly similar to the trademark – see, *e.g.*, *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. D2001-0087. However, this statement is not a rule of interpretation to be applied when determining the issue of confusing similarity; rather, it is merely an observation of fact (the fact being that, in most cases, the addition of a word does not lessen the confusing similarity that arises from incorporation of a complainant's trademark in a domain name). The issue of confusing similarity must always be determined on the particular facts of the individual case. Undoubtedly there will be cases where the inclusion of a word, including a common word, will have the effect of dispelling a potential confusing similarity between the domain name and the complainant's trademark.

Previous panels deciding cases under the Policy have recognized that the determination of the issue of confusing similarity requires careful consideration. As was stated in *Telstra Corporation Limited v. kids@m-a-i-l.com 987654321*, WIPO Case No. D2003-0169, and adopted and applied in *A & F Trademark, Inc., Abercrombie & Fitch Stores, Inc., and Abercrombie & Fitch Trading Co., Inc. v. Chad Nestor*, WIPO Case No. D2003-0260: “In determining confusing similarity between a domain name that incorporates several terms or trademarks, a mere visual comparison is a simplistic test. The touchstone in determining confusing similarity is whether the combination of terms used in a domain name has the potential to mislead unsuspecting users.”

A careful consideration of the particular facts of this case produces the following outcome. The inclusion of the alphabetic characters “p”, “i”, “c” and “k” has an effect that goes beyond merely preceding the Complainant's trademark UPS ONLINE with four letters. The effect of the inclusion of these four letters is three-fold: (i) the four letters are read as the common word “pick”; (ii) the word “pick” interacts with the letters “u”, “p” and “s”, so that those letters are perceived to be the common word “ups”; and (iii) the coincidence of the words “pick” and “ups” is perceived to be the compound word “pickups” (the hyphen-less version of the plural of the noun “pick-up”, the action or an act of picking up something or someone: *Oxford English Dictionary* online). That is to say, the inclusion of “pick” before the trademark UPS ONLINE in the disputed domain name makes the natural reading of the domain name to be the phrase “pickups online”. In this Panel's view, the typical member of the Internet-using public would perceive the disputed domain name to be describing an online service relating to picking up things or persons.

Under this reading of the domain name, there is no confusing similarity between the domain name and either of the Complainant's trademarks. This is because the natural

reading of the Complainant's trademark UPS is as the acronym for the Complainant (*i.e.* as the alphabetic letters "u", "p" and "s"), and the natural reading of the Complainant's trademark UPS ONLINE is as the acronym for the Complainant succeeded by the descriptive word "online". After careful consideration this Panel has formed the view that Internet users would not perceive the disputed domain name as containing the Complainant's trademark UPS, as distinct from the word "ups". Hence, this Panel concludes that the disputed domain name is not confusingly similar to either of the Complainant's trademarks.

## **B. Rights or Legitimate Interests**

Given the conclusion above regarding the lack of confusing similarity between the disputed domain name and the Complainant's trademarks, it is not necessary for resolving the outcome of the Complaint to determine if the Respondent has rights or legitimate interests. However, because of the Respondent's assertion of reverse domain name hijacking by the Complainant (discussed below), this Panel has given some consideration to the issue.

This Panel is inclined to the view that the Respondent does have a legitimate right or interest in the disputed domain name. The Respondent has demonstrated that it undertook preparations to use the disputed domain name from the date of its registration (February 1, 2005), and that these preparations were in connection with a *bona fide* offering of services. Further, the Respondent has demonstrated that, contrary to the Complainant's contention, the subsequent use of the domain name by the Respondent was in connection with a *bona fide* offering of services. Pursuant to the Policy, paragraph 4(c)(i), these facts demonstrate that the Respondent has a right or legitimate interest in the domain name, so long as either the use or the preparations to use occurred *before* notice to the Respondent of the dispute.

The Complaint appears to assert that the Respondent was first given notice of the dispute by the cease and desist letter of July 28, 2006, sent to the Respondent by the Complainant's Australian Counsel. (This Panel notes that, contrary to the implicit assertion in the Complaint, this letter did not refer to the disputed domain name; rather, it referred only to the Respondent's Australian trademark application. Nevertheless, this Panel is willing to treat the letter of July 28, 2006 as constituting notice of the dispute). The fact is that the Respondent's preparations to use the domain name in connection with a *bona fide* offering of services *preceded* this letter. Thus, it seems clear that the Respondent has demonstrated a right or legitimate interest in the domain name.

## **C. Registered or Used in Bad Faith**

Given the conclusion above regarding the lack of confusing similarity between the disputed domain name and the Complainant's trademarks, it is not necessary for resolving the outcome of the Complaint to determine if the Respondent has registered or used the domain name in bad faith. However, because of the Respondent's assertion of reverse domain name hijacking by the Complainant (discussed below), brief reference will be made to the issue.

This Panel is inclined to the view that the Complainant has failed to establish that the Respondent registered or is using the disputed domain name in bad faith. When the record of the case is considered in the context of the Panel's conclusion that the domain name is not confusingly similar to the Complainant's trademarks, and in the context of the evidence of the Respondent's *bona fide* preparations to use, and actual use of, the

domain name, it seems clear that the Respondent neither registered nor has used the domain name in bad faith.

#### **D. Reverse Domain Name Hijacking**

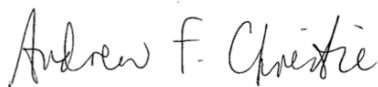
The Respondent's assertion that the Complainant has engaged in reverse domain name hijacking rested on two grounds: (i) the Complainant made insufficient investigations of the actual use of the domain name by the Respondent; and (ii) the Complainant made a knowingly false statement about the conclusions that could be drawn from the Respondent's modification of its Australian trademark application.

This Panel does not consider that either of these grounds has been established. First, the reasonable observations that the Complainant could make about the Respondent's use of the domain name do not, in this Panel's opinion, lead unequivocally to the view that the Respondent's use was *bona fide*. It is only upon consideration of the evidence provided in the Response about the nature and magnitude of the Respondent's business conducted under the domain name – being evidence that was not reasonably available to the Complainant prior to filing the Complaint – that such a view could be reached. Secondly, this Panel considers that the Respondent has misunderstood the substance of the assertion made by the Complainant in relation to the Respondent's modification of its trademark application. As understood by this Panel, the Complainant's assertion did not imply that IP Australia rejected the Respondent's trademark application by reference to the Complainant's trademarks.

Thus, this Panel does not consider that the record in this case discloses facts that would warrant a finding of attempted reverse domain name hijacking by the Complainant.

#### **7. Decision**

For all the foregoing reasons, the Complaint is denied.



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Andrew F. Christie  
Sole Panelist

Dated: February 11, 2010