

DISPUTE RESOLUTION SERVICE

DRS 8320

Decision of Independent Expert

Pitchmastic PmB Limited

and

Robert Taylor

1. The Parties

Complainant: Pitchmastic PmB Limited
Address: Panama House
184 Attercliffe Road
Sheffield
South Yorkshire
Postcode: S4 7WZ
Country: UK

Respondent: Robert Taylor
Address: 254 St John Street
London
Postcode: EC1V 4PY
Country: UK

2. The Domain Name

pitchmastic.co.uk

3. Procedural History

Nominet checked that the complaint dated 26 February 2010 complied with its UK Dispute Resolution Service Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint, inviting him to file any response by 19 March. The response is dated 8 March. The Complainant replied to the response on 11 March. Informal mediation was attempted but was not successful. On 14 April Nominet told both parties that, if it received the appropriate fee, the case would be referred for an expert decision.

On 20 April I, Mark de Brunner, agreed to serve as an expert under Nominet's Dispute Resolution Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

4. Factual Background

I have attempted to visit the website at the domain name at issue and have visited the websites at the domain names pitchmasticpmb.co.uk and pitchmasticpmb.com registered by the Complainant. From those limited checks, the complaint, the response, the reply and the administrative information supplied routinely by Nominet, I accept the following as facts.

The Complainant runs a global business supplying products and services to protect civil infrastructure such as bridges and tunnels from environmental and corrosive attack. It has developed a special membrane system ('PmB') which acts as a waterproof and corrosion-resistant seal. Its contracts include work on the Tyne Bridge, the Tyne Tunnel and Heathrow Terminal 5 in the UK, on the Channel Tunnel and on the Mussafah and Sheikh Zayed bridges in the United Arab Emirates.

The Complainant has been using the Pitchmastic PmB brand for more than twenty years and has a distinctive brand logo. It has registered the domain names pitchmasticpmb.co.uk and pitchmasticpmb.com. In the UK, the Complainant holds a trademark registration for Pitchmastic PmB, filed on 19 June 2006.

The domain name at issue was registered on 7 May 2009 in the name 'Yummy Mummy'. Following correspondence between the Complainant and Nominet, on 24 February 2010 the record was updated to show the registrant as 'Matthew Gregland', a non-trading UK individual.

The Complainant first became aware of the domain name on 10 February 2010 when it was contacted by one of its regular customers. The customer had not received a quotation from the Complainant for a major project on the M6 motorway between Harrowthred and Thrimby, despite sending numerous emails to what it thought was the Complainant's email address, info@pitchmastic.co.uk. On 11 June 2009 the customer had received a reply in the following terms:

Thank you for your enquiry, however due to current workloads we will be unable to quote on this occasion.

Regards

David

Pitchmastic is part of the USL group of companies including ASL.

According to the customer, an identical response was received when following up another invitation to tender for a different project on the M6.

At 3 May 2010 the domain name was not connected to anything. But on 10 February 2010 it resolved to a website that included the Complainant's logo.

The Complainant and the Respondent are not connected.

5. Parties' Contentions

Complaint

The Complainant says that it has rights in the name Pitchmastic PmB and that the domain name is an abusive registration for the following reasons.

- (i) The domain name is similar to its trademark (which predates the Nominet registration), to its company name and to a name in which the company also holds unregistered rights; and the use of the domain name has caused confusion among its customers.
- (ii) The Respondent's use of the domain name has caused unfair disruption to the Complainant's business.
- (iii) The Respondent does not have a legitimate interest in 'pitchmastic' and therefore this can only be a 'blocking' registration.
- (iv) The Respondent provided false contact details to Nominet, an indication of bad faith.
- (v) The Respondent is not making legitimate non-commercial use of the domain name.
- (vi) The domain name is not being used in connection with a genuine offering of goods or services.

Response

In response, the Respondent makes the following points.

- (i) He represents a group of amateur baseball players and supporters who meet socially several times a month and who wanted a forum to advertise the group and its social activities.
- (ii) The group chose the domain name because 'pitch' is a reference to the throwing of the ball in baseball and 'mastic' reflects the sticky wicket that the amateur players frequently experience.
- (iii) The domain name was registered using a name associated with a cancer charity to which several group members had made donations. There was no intention to deceive Nominet and this was not evidence of bad faith.
- (iv) It took eight months for the Complainant to find out that one of its regular customers had been trying to email it at the wrong address. (The implication is that this was not an especially regular customer, because a close business contact might be expected to have the right email address for the Complainant and to discover any misdirection sooner.)
- (v) As a 'gesture of goodwill' he has placed a temporary footnote on the web page at the domain name, to make clear that the web site is not connected with the Complainant.
- (vi) Just because the Complainant has rights in Pitchmastic PmB it does not follow that no-one else can have rights in a part of that name. The Respondent argues that if Disney had rights in 'supercalifragilisticexpialidocious' it would not mean that no-one else could use the word 'super'.
- (vii) The Complainant is attempting to bully the Respondent and the group he represents.

Reply

The Complainant replies as follows.

- (i) There is no evidence of the baseball group mentioned by the Respondent.
- (ii) The Respondent's explanation for the choice of domain name is hard to believe. In particular, 'sticky wicket' is not a term used in connection with baseball.
- (iii) There is no evidence that the Respondent was entitled to register the domain name in the name Yummy Mummy and on the basis that he was not entitled to do so he was in breach of Nominet's standard conditions.
- (iv) The reply made to the potential customer's query ('...due to current workloads...') does not square with the Respondent's baseball group explanation: 'The Complainant submits that this is not the way a website

set up by a group of baseball enthusiasts would reply to an email regarding a tender for work on a major road building project on the M6.'

- (v) The Registrant has altered the appearance of the website since the Complaint was filed. But the source code remains unchanged - including, in particular, the metatags (which still make reference to the trade marks of the Complainant as well as to a number of technical terms including 'bridge joint', 'asphalt plug joint' and 'asphaltic plug joint').
- (vi) 'Pitchmastic' is similar to the name in which the Complainant has rights.
- (vii) The Complainant has not bullied the Respondent and there is no evidence of such behaviour – just the Respondent's unsupported assertion.

6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the domain name; and that
- the domain name, in the hands of the Respondent, is an abusive registration

Rights

The Complainant has been using the Pitchmastic PmB brand for many years. It has trademark registrations in that name. It therefore has both unregistered and registered rights in Pitchmastic PmB.

The domain name is pitchmastic.co.uk. In comparing domain names with the name in which a Complainant asserts rights, it is usual to ignore the penultimate and final suffixes (here: 'co' and 'uk'). On that basis, the domain name is the name in which the Complainant has rights, with the addition of three letters.

I conclude that the Complainant has rights in respect of a name or mark which is similar to the domain name.

Abusive registration

As defined by the Policy, an abusive registration is a domain name which either:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration. The Complainant's main arguments reflect them: that the Respondent's use of the domain name has confused internet users into believing that it is connected with the Complainant; that the domain name can only have been registered for the purpose of unfairly disrupting the Complainant's business; that the Respondent registered the domain name as a blocking registration; and that the Respondent gave Nominet false contact details.

The complaint also picks up and rejects two of the factors that the Policy identifies may be evidence that the domain name is not an abusive registration: that a respondent has made legitimate non-commercial use of the domain name and has used the domain name in connection with a genuine offering of goods or services.

The Respondent essentially says that he, and the group he represents, had a legitimate and unobjectionable reason for the choice and use of the domain name and for the contact details provided at registration. The only evidence of bad faith, on that argument, is the Complainant's 'bullying' tactics. The Respondent says that the example of confusion and disruption to the Complainant's business is weak or hard to believe – because it took a long time for a regular customer to establish that it was using an inappropriate email address – and that in any event subsequent changes to the website would eliminate any confusion. He accepts that the Complainant has rights in Pitchmastic PmB but argues that that does not give it exclusive rights in the 'pitchmastic' element.

I have to say I find a number of the Respondent's claims fundamentally implausible. The reasons given for the choice of domain name do not appear to me to be even internally consistent: 'mastic' apparently reflects the idea of a 'sticky wicket', but that is a cricketing term – it has nothing to do with baseball. The justification offered for providing the contact name 'Yummy Mummy' at registration – its association with a cancer charity to which some members of the group had made donations – is not backed up by any evidence.

Contrary to the Respondent's claims, the Complainant's example of confusion and unfair disruption is strong. It does not seem unlikely to me that a customer would try and use a general email address and – given the distinctive, made-up nature of the name pitchmastic – assume that the domain name belonged to the Complainant. It is understandable that the customer then took a long time to

discover that it had been using the wrong email address. It is especially understandable – and damaging to the Respondent’s case – that one of the reasons the discovery took so long was that the domain name was used to reply to the customer, by email, as if from the Complainant. I note that the Respondent has chosen not to explain what appears to be an attempt to mislead. The Respondent accuses the Complainant of bullying but, if there is any bad faith, it is surely more likely to be found in the apparent impersonation of the Complainant in the Respondent’s use of the domain name for email.

There is a disagreement between the parties about the nature of changes made to the website as a result of the complaint, but I have to say I attach little weight to the Respondent’s unsupported claims that there was no subsequent room for confusion.

The Respondent argues that rights in Pitchmastic PmB do not automatically give the Complainant exclusive rights to the ‘pitchmastic’ element. That is true, but the fundamental question remains whether the Respondent’s registration or use of the domain name took unfair advantage of or was unfairly detrimental to the Complainant’s rights.

The Complainant has not sought to develop the argument that this was a ‘blocking’ registration but in my view the other factors here help more in determining the character of the domain name. On the facts as presented there appears little doubt that the Respondent used a significant part of the name in which the Complainant has rights, not for any genuine offering of goods or services, but unfairly to disrupt the Complainant’s business. It follows that, in my judgement, this was not legitimate non-commercial use of the domain name.

On the balance of probabilities, I am satisfied that the Respondent’s registration and use of the domain name was unfairly detrimental to the Complainant’s rights.

7. Decision

I find that the Complainant has rights in respect of a name which is similar to the domain name and that the domain name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the domain name be transferred to the Complainant.

Signed: Mark de Brunner

Dated 20 May 2010