

DISPUTE RESOLUTION SERVICE

D00021282

Decision of Independent Expert

Tarmac Trading Limited

and

Drivecareuk

1. The Parties

Complainant: Tarmac Trading Limited
c/o Freeths LLP
3rd Floor, The Colmore Building
Queensway
Birmingham
B4 6AT
United Kingdom

Respondent: Drivecareuk
1 Hurst Lane
Egham
Surrey
TW20 8QJ
United Kingdom

2. The Domain Name

<tarmac-surfacing.uk>

3. Procedural History

03 April 2019 15:32 Dispute received
03 April 2019 16:59 Complaint validated
03 April 2019 17:02 Notification of complaint sent to parties
24 April 2019 02:30 Response reminder sent
24 April 2019 17:11 Response received
24 April 2019 17:11 Notification of response sent to parties
29 April 2019 02:30 Reply reminder sent
02 May 2019 10:54 Reply received
02 May 2019 10:55 Notification of reply sent to parties
08 May 2019 10:14 Mediator appointed
08 May 2019 10:14 Mediation started
09 September 2019 16:28 Mediation failed
10 September 2019 15:02 Close of mediation documents sent
20 September 2019 02:30 Complainant full fee reminder sent
24 September 2019 12:48 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties and that, to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is a company registered in England. It is a supplier of construction materials.

The Complainant is the owner of various registrations for the trade mark TARMAC including United Kingdom trade mark number 245287 for the word mark TARMAC, first registered on 6 May 1903 in Class 19 for “tarred slag for use for making roads and pavements and for construction purposes and tar concrete.”

The Respondent is a company registered in England which provides roadway and groundwork surfacing services including “tarmacadam surfacing”.

The Domain Name was registered on 26 July 2018.

The Respondent has used the Domain Name for the purposes of a website at “www.tarmac-surfacing.uk”. The website is headed “DriveCareUK” and offers:

“Private & Commercial Tarmacadam Across Surrey, Berkshire & London”

Its home page goes on to say:

“We have been involved in tarmacadam surfacing for over 60 years. We supply & lay tarmacadam either by machine or hand lay, covering all aspects of roadway and groundwork construction from pathways, drives to roads and carparks, including all excavation & preparation. We also cover all drainage and pipeline construction.”

5. Parties’ Contentions

The Complaint

The Complainant submits that it has longstanding trade mark rights in the name and mark TARMAC and that it and its predecessors in title have generated and enjoy enormous goodwill and reputation in that mark in relation to construction products and services. It states that the name “Tarmac” is recognised by the Oxford English Dictionary as enjoying trade mark protection. It produces evidence of its principal website at “www.tarmac.com” and of turnover in 2017 in excess of GBP 2 billion. The Complainant submits that its group companies and various licensees use the TARMAC trade mark in conjunction with a geographic descriptor and other non-distinctive elements and have generated further goodwill as a result of that use.

The Complainant submits that the Domain Name takes unfair advantage of its TARMAC trade mark because people are likely to be confused into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant, which is a category of Abusive Registration under paragraph 5.1.2 of the Nominet Dispute Resolution Service Policy (“the Policy”).

The Response

The Respondent states that it has been involved in surfacing roads for over 60 years and that it bought the Domain Name on the understanding that it was suitable for its business. The Respondent submits that the term “tarmac” is widely used in the construction industry and does not necessarily indicate the Complainant’s group companies. The Respondent states that it has made a significant investment in promoting its business and would suffer significant loss if forced to hand over the Domain Name.

The Reply

The Complainant replies that the Respondent is named “DrivecareUK” but chooses to trade off the Complainant’s trade mark TARMAC rather than its own business name. The Complainant submits that this indicates an intention to take unfair advantage of the Complainant’s trademark. The Complainant also disputes the length of time that the Respondent has been involved in the road surfacing industry, stating that other publicity refers to 25 rather than 60 years.

6. Discussions and Findings

This matter falls to be determined under the terms of the Policy.

Under paragraph 2 of the Policy:

“2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

Under paragraph 1 of the Policy the term “Rights”:

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

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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. is being or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it is the owner of long-standing registered trade mark rights in the mark TARMAC. The Domain Name comprises the term “tarmac” together with the addition “-surfacing” and the top-level domain “.uk” which is typically to be disregarded for the purpose of comparison. The term “surfacing” is descriptive in nature and is connected with the Complainant’s products, and the Expert does not therefore consider the addition of that term to be sufficient to distinguish the Domain Name from the Complainant’s trade mark.

The Expert therefore finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

The Respondent has used the Domain Name for the purpose of a website promoting a business which offers roadway and groundwork surfacing using the Complainant’s “Tarmac” product.

Under paragraph 8.1.1.1 of the Policy, a respondent may be able to show that a registration is not an Abusive Registration where, before being aware of the complainant’s cause for complaint, it has:

“... 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.”

There is no suggestion in this case that the Respondent’s business is non-existent or a sham and the question for the Expert is therefore whether the Respondent’s use of the Domain Name for the purpose of that business falls legitimately within the above provision or, alternatively, takes unfair advantage of, or is unfairly detrimental to, the Complainant’s Rights.

In certain limited circumstances, a reseller of trade marked goods, or a supplier of services relating to such goods, may legitimately use the trade mark in question as part of a domain name. The circumstances in which such use is permissible were considered by a Nominet Appeal Panel in *Toshiba Corporation v. Power Battery Inc* [2010] DRS Case No. 07791 where the Panel made the following observations:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.

3. Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.

The application of the first of these criteria is well illustrated by previous decisions under the DRS involving the Complainant’s TARMAC trade mark. For example, in *Lafarge Tarmac Trading Limited v. Smart Numbers Ltd* [2015] DRS Case No. 15757 (domain name <watfordpavingandtarmac.co.uk>) and in *Tarmac Trading Limited v. Mr Maurice Birch* [2019] DRS Case No. 21275 (domain name <tarmacdrivewaysplymouth.co.uk>) the respective Experts decided, on the particular facts of those cases, that the incorporation of the TARMAC mark into the relevant domain name did not take unfair advantage of, and was not unfairly detrimental to, the complainant’s rights. In other cases, however, including *Tarmac Trading Limited v. Mr Chris Carlin* [2017] DRS Case No. 18424 (domain name <kentcountytarmacld.co.uk>) and *Tarmac Trading Limited v. Ian Sheeran* [2017] DRS Case No. 19293 (domain name <northern-tarmac.co.uk) the respective Experts concluded, on the facts of those cases, that the inclusion of the TARMAC mark did take unfair advantage of, or was unfairly detrimental to, the complainant’s rights.

For the purposes of the fourth criterion above, the Expert finds no evidence in this case that the Respondent is using the website linked to the Domain Name to offer products emanating from competitors of the Complainant (as was the position in the *Toshiba* case itself). Nor does the Complainant make clear in either the Complaint or Reply that the Complainant itself (or its authorised contractors) offers services with which the Respondent’s business competes.

In the view of the Expert, therefore, the case turns upon the second and third of the criteria mentioned in the *Toshiba* case, namely, whether the Respondent’s use of the Domain Name implies a commercial connection with the Complainant, in particular by reason of “initial interest confusion”.

In this case the Expert finds, on balance, that the choice of the Domain Name is liable to cause “initial interest confusion”. The Expert takes this view because the term “surfacing” used in the Domain Name is capable of indicating not only a service but also specifically the type of product for which the Complainant’s trade mark is registered, i.e. material used to form a surface. In the view of the Expert, therefore, the Domain Name inherently implies a commercial connection with the Complainant and does not include any additional element which would signal a lack of such connection. The Expert considers, therefore, that there is a significant likelihood of Internet users visiting the Respondent’s website in the mistaken belief that it is operated or authorised by the Complainant. In circumstances where an Internet user is induced to visit a website because of the nature of the domain name itself (i.e. “initial interest confusion”) then an unfair advantage has been obtained by the inclusion of the trade mark in question, even

if on visiting the website it becomes apparent that an independent business is involved.

The Expert therefore concludes that the Domain Name takes unfair advantage of the Complainant's rights and is an Abusive Registration.

7. Decision

The Expert has concluded that the Complainant 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. The Complaint therefore succeeds and the Expert directs that the Domain Name, <tarmac-surfacing.uk>, be transferred to the Complainant.

Steven A. Maier
Independent Expert

3 October 2019