

Nominet UK Dispute Resolution Service

DRS 00177

Tarmac Limited –v- Andrew Etches

Decision of Independent Expert

1. Parties:

Complainant: Tarmac Limited
Address: Millfields Road
Ettingshall
Wolverhampton
West Midlands

Postcode: WV4 6JP
Country: UK

Respondent: Mr Andrew Etches
Address: 89 Arundel Street
Ashton-Under-Lyne
Manchester

Postcode: OL6 6RH
Country: UK

2. Domain Name:

tarmacvandal.co.uk (“the Domain Name”)

3. Procedural Background:

The Complaint was lodged with Nominet on 27 December 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on 31 December 2001 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainant and on 4 February 2002 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

Andrew Murray, the undersigned, (“the Expert”) has confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Outstanding Formal/Procedural Issues (if any):

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”).

The Expert has seen copy communications from Nominet to the Respondent and has no reason to doubt that the Respondent has been properly notified of the complaint in accordance with paragraph 2 of the Procedure.

Paragraph 15b of the Procedure provides, inter alia, that “If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the complaint.”

There is no evidence before the Expert to indicate the presence of exceptional circumstances; accordingly, the Expert will now proceed to a Decision on the Complaint notwithstanding the absence of a Response.

The lack of a response does not entitle the Complainant to a default judgement. The Complainant must still prove its case to the required degree. The Expert will evaluate the Complainant’s evidence on its own merits and will draw reasonable inferences from it in accordance with paragraph 12b of the Procedure.

Paragraph 15c of the Procedure provides that “ If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure , the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.”

Generally, the absence of a Response from the Respondent does not, in the Expert’s view, entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit. In this case it seems to the Expert that the probable facts speak for themselves and that it is not necessary to draw any special inferences. The Expert finds that the probable facts asserted by the Complainant and set out in the next following section are indeed facts.

5. The Facts:

The Complainant is named as Tarmac Limited. The Complainant company was incorporated in England and Wales on 7 May 1948 and is a wholly owned subsidiary of Anglo American plc. Anglo American plc is a publicly traded company on the London Stock Exchange, the Johannesburg Stock Exchange, the Botswana Stock Exchange, the Namibian Stock Exchange and the Swiss Exchange SWX. The Complainant is well known as a supplier of building materials to the construction

industry and for the supply of associated products and services. The Complainant holds twenty trade mark registrations in the word Tarmac including nine in the United Kingdom.

The Domain Name was registered on 2 November 2000.

The address www.tarmacvandal.co.uk resolves to a website relating to performance and modified road cars. A copy of the relevant page was supplied to the Expert as part of the papers provided by Nominet. In the introductory page of the Respondent's website it is stated that "*If you are a law enforcement officer, you may like to know that Tarmacvandal.com does not advocate or arrange cruises or 'rave rallies in cars' as the Sunday Telegraph calls them. We just think they are an active way to entertain today's youth and understand that our visitors are interested in this subject.*" While it is clear the Respondent does not organise or promote cruises, it is clear from the above statement that the Respondent's site is associated with such activities.

6. The Parties' Contentions:

Complainant:

The Complainant's contentions are as follows:

1. The Complainant is the proprietor of trade mark registrations for the mark Tarmac in a large number of countries throughout the world, all of which pre-date the Respondent's domain name registration. These include UK registrations: 880348 for motor land vehicles (other than those designed for use on airfields), 4155398 for a variety of goods including axle and axle caps for vehicles, brakes, springs, luggage carriers and couplings for vehicles, coach ironmongery, bodies and frames for motor cars and trucks, mudguards, hubs, rims and spokes for vehicles, fenders and shock absorbers, 806516 for road building, road-repairing and road making materials all included in class 19 and all consisting of or containing tar, 254287 for tarred slag for use for making roads and pavements and for construction purposes and tar concrete, and 880350 for a variety of goods including gravels, slags and non-metallic road making materials.
2. The Complainant's trade mark Tarmac is the dominant part of the Respondent's domain name, and the Respondent's domain name is therefore similar to the Complainant's registered trade mark.
3. The use of the Complainant's trade mark in conjunction with a word commonly used to describe a person who causes deliberate damage to person or public property is likely to tarnish the substantial good reputation the Complainant has in their Tarmac trade mark. The association of the Complainant's trade mark with an illegal activity such as vandalism is clearly unfairly detrimental to the Complainant's rights.
4. The Complainant wrote to the Respondent prior to lodging this complaint, to express its concern over the Respondent's use of its trade mark and to request the transfer of the domain name to the Complainant. In his response, the Respondent stated that "The reason for the inclusion of the word tarmac within our name is that it is synonymous with road surfaces." In response to the

Complainant's letter the Respondent also modified his web-site to state "*This week we have also received a nasty letter from Tarmac the building company who want our name, they seem to think we are tarnishing their reputation! What do you reckon lads? Let us know by e-mail on tarmac-as-in-the-road-not-the-building-company@tarmacvandal.co.uk*" as shown in Annex D of the Complaint.

Respondent:

The Respondent has not responded

7. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Complainant is the proprietor of a portfolio of registered trade marks comprising the word Tarmac.

In his response to the Complainant's request to transfer the Domain Name, the Respondent indicated that, "The reason for the inclusion of the word tarmac within our name is that it is synonymous with road surfaces." In other words, the Respondent claimed the Complainant's trade mark was a generic word for a road surface. This is an important claim to review as if the term Tarmac is indeed a generic term for a road surface then under Section 46(1)(c) of the Trade Marks Act 1994 the Complainant's proprietary interest in the term Tarmac would be susceptible to revocation.

The Complainant provided excerpts from the Collins English Dictionary & Thesaurus, 21st Century Edition, The New Shorter Oxford English Dictionary 1993, and Cambridge International Dictionary of English 1995, showing the dictionary definition of Tarmac. In all cases, it is stated that the word Tarmac is a proprietary name or a trademark. For the purposes of Section 46 though a dictionary definition is not to be the definitive guide to the status of a mark. Rather, Section 46(1)(c) requires that, "in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product of service for which it is registered". The question of whether a term has become a common name *in the trade* is, according to the Thirteenth Edition of Kerley's Law of Trade Marks and Trade Names, "a question of fact to be decided in the circumstances" (at paragraph 9-81). Unfortunately the simplified procedures provided under the Procedure do not allow for the "substantial independent evidence from the trade" envisaged by the authors. In the absence of expert testimony the Expert must decide based upon the evidence placed before him by the parties in accordance with Paragraph 12b of the Procedure.

In the instant case the Complainant has provided the dictionary definitions mentioned above and as evidence they have not allowed their mark to become a generic term for a road surface as a consequence of their inactivity, they cite their actions in relation to the Domain Name stating that, “The Respondent’s use of the trade mark Tarmac in his domain name as a generic word for a road surface, will encourage others to view the Complainant’s trade mark as common name for road surfacing materials, and in order to maintain the validity of its trade mark registrations, the Complainant is legally obliged to take action to stop this. By using the Complainant’s trade mark as a generic word for a road surface, the Respondent is jeopardising the Complainant’s trade mark registrations, and therefore the Respondent’s registration and use of domain name in suit is unfairly detrimental to the Complainant’s rights.”

The Respondent by not responding to the complaint has laid no evidence of the generic nature of the Complainant’s mark before the Expert.

On the basis of the submissions received the Expert finds that the term Tarmac is not a generic term in terms of Section 46 of the Trade Marks Act 1994 and that the Complainant has rights in the name Tarmac.

When comparing any name or mark in which the Complainant has rights with the Domain Name the first and second level suffixes of each of the domain names are to be discounted as they are generic in nature. In relation to the domain name the Expert is satisfied the Complainant’s direct proprietary interest in the Tarmac name and the goodwill associated with that name constitute sufficient grounds to conclude the Complainant has rights in respect of a name which is similar to the Domain Name.

Abusive Registration

Paragraph 1 of the Policy defines “Abusive Registration” as:-

“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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

The policy provides, at paragraph 3a, a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. Of these factors there is no inference or assertion in the Complaint of any of the factors referred to in paragraph 3a(iii) or 3a(iv). This leaves the Expert to consider paragraphs 3a(i) and 3a(ii), in turn.

Paragraph 3a(i) refers to:

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:

A. primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. primarily for the purpose of unfairly disrupting the business of the Complainant.”

There is no evidence that the Respondent's motivation has been to sell, rent or otherwise transfer the Domain Name to the Complainant or a competitor of the Complainant. Nor is there evidence that the Respondent's motivation has been to stop the Complainant using the Domain Name or that the Complainant would otherwise have sought to acquire it, were it not for the Respondent's conduct. Similarly, clause 3(i)(C) is inapplicable; whilst the Complainant may not like the Respondent's use of the name, that use does not suggest that the underlying purpose is to disrupt the Complainant's business.

In terms of paragraph 3a, this only leaves paragraph 3a(ii):

“Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

Paragraph 3a(ii) requires evidence of actual confusion on behalf of people or businesses that the Domain Name is being used by the Respondent in a way which has confused people or businesses into believing that the Domain Name is connected with the Complainant. No such evidence has been submitted. In fact the actions of the Respondent in drawing attention to the earlier letter sent to him by the Complainant's requesting transfer of the Domain Name clearly indicate the Respondent's actions were such as to minimise such confusion occurring.

Were the factors set out in paragraph 3 a comprehensive list of matters which could amount to an Abusive Registration, the Complainant would fail. However, the factors are not exhaustive; an Abusive Registration, as defined, includes a Domain Name which, “has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights” (paragraph 1). Accordingly, it is necessary to consider whether the Respondent's use of the Domain Name can be so categorised.

The first requirement of the definition outlined above is actual use of the Domain Name. This is established.

Does the use take unfair advantage of and/or is it unfairly detrimental to the Complainant's Rights? The Domain Name makes use of the Complainant's trade mark in conjunction with a word commonly used to describe a person who causes deliberate damage to personal or public property. Such a use is likely to tarnish the substantial good reputation the Complainant has in their trade mark. The association

of the Complainant's trade mark with an illegal activity such as vandalism is clearly unfairly detrimental to the Complainant's rights.

Further by examining the use being made of the Domain Name we see the web-site in question has an association with the practice of cruising. This practice is anti-social and may on occasion be illegal. The use of the Complainant's trade mark in the Domain Name is likely to lead to the Complainant being associated with such activities, and this is clearly unfairly detrimental to the Complainant's rights.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy on the basis that it is unfairly detrimental to the Complainant's Rights.

Having found the Complainant to have made out a prima facie case under the Policy the burden under paragraph 4a now shifts to the Respondent to demonstrate their use is not an Abusive Registration (the exception being paragraph 4b). The Expert having found the Respondent has a case to answer must make that answer. Here the Respondent has not answered. In the absence of such an answer the Expert may suggest a reasonable answer but here having already established the term "Tarmac" is not a generic term, and hence dealing with the possible defence offered by paragraph 4a(ii), the Expert finds no defence under paragraph 4.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration as defined by paragraph 1 of the Policy on the basis that it is being used in a manner which takes unfair advantage of the Complainant's rights.

8. Decision:

In light of the foregoing findings, namely 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, the Expert directs that the Domain Name, tarmacvandal.co.uk, be transferred to the Complainant.

Andrew D. Murray

14 February 2002