

DISPUTE RESOLUTION SERVICE

D00021275

Decision of Appeal Panel

Tarmac Trading Limited

and

Maurice Birch

1. The Parties:

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

Respondent: Mr Maurice Birch
Orchard Meadow
Exeter Road
South Brent
Plymouth
TQ10 9JP
United Kingdom

2. The Domain Name

The domain name in issue is tarmacdrivewaysplymouth.co.uk (the "Domain Name")

3. Procedural History

This is an appeal against the summary decision of Stephen Bate (the "Expert") issued on 10 May 2019 in favour of the Respondent¹. Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy (as in effect from 1 October 2016) (the "Policy") unless the context or use indicates otherwise.

Nick Gardner, Claire Milne and Ian Lowe (together, "the Panel") have each made a statement to the Nominet Dispute Resolution Service in the following terms:

"I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need

¹ It appears that the Complainant took steps to file an appeal immediately after the decision was provided, and paid the applicable fee, but as the result of an administrative oversight the relevant appeal process was not commenced until much later. The Panel does not consider anything turns on this timing.

be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.”

4. The Nature of This Appeal

Paragraph 20.8. of the Policy provides that: “The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters. The appeal panel should not normally take into consideration any new evidence presented in an appeal notice or appeal response, unless they believe that it is in the interests of justice to do so”. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

The Expert provided a summary decision as no Response had been filed to the Complaint. The observations the Expert made in support of his decision are provided below.

For convenience the Panel will continue to refer to the parties as the “Complainant” and “Respondent”.

5. Factual Background

The Complainant is a large public company. It is the successor in title to a company called Tar Macadam Syndicate Ltd, founded in 1903. The product tarmacadam was patented by the Complainant’s predecessor in 1903 and comprises a mixture of broken stone or slag held in a matrix of tar or tar and creosote. “Macadam” refers to a type of road surface invented in around 1820 by John Macadam comprising a crushed bed of small angular stones. The Complainant’s predecessor coined the term “Tarmac” to describe its version of a tarmacadam product which comprised iron slag impregnated with tar and creosote. It obtained a registered trade mark for the term TARMAC (see below).

The Complainant in 2017 had a turnover of over £2 billion and employed over 2,700 people. It is the leading supplier of building materials in the United Kingdom. It supplies a wide range of building materials for agricultural, housing and industrial purposes, as well as for rail, ports and harbour, road and other public and private utilities infrastructure. It (or other companies in its group) operates some 120 quarries and 74 asphalt plants.

The Complainant is the owner of numerous trade mark registrations for the word TARMAC. The earliest of these is UK trade mark no. UK00000254287, registered in 1903 in respect of “Tarred slag for use for making roads and pavements and for construction purposes and tar concrete”. The Complainant’s trade marks include other registered trademarks with a wider class of goods specified – for example UK trade mark no. 00000880350 is registered in respect of “Gravels, slags and non-metallic road making materials, all incorporating or being coated with tar; natural and artificial stone, lime (not for horticultural or agricultural purposes) motar [sic], plaster (not for medical or surgical use); none being in particulate form; pre-cast concrete elements for use in building and construction; ready mixed concrete; slag filter media; buildings and structures included in Class 19 made wholly or principally wholly [sic] of concrete; asphalt, pitch and bitumen; and pipes included in Class 19”.

The Respondent is an independent surfacing contractor. The Domain Name was at the time of the Complaint linked by redirection to the Respondent’s website at www.5stardrivewaysltd.co.uk. The Respondent offered surfacing of driveways and other surfaces in the Plymouth area. He described his services as “...providing driveway such as block paving, tarmac, resin bonding, concrete driveways and patios...”.

The Complainant sent letters to the Respondent on 19 April 2018 complaining about various issues including his use of the Domain Name. This was followed by correspondence by telephone on 23 April 2018 and by email on 8 June 2018 where it was explained to the Respondent that if he did not deactivate the Domain Name the Complainant would file a Nominet complaint.

6. Parties' contentions

In its original Complaint, the Complainant presented evidence of its Rights and argued that the registration of the Domain Name was abusive both at the time of registration and through its subsequent use, through causing "damage and loss to the Complainant's business and reputation".

The grounds for this were said to be, first, probable confusion: that the presence of the distinctive term "tarmac" (along with the non-distinctive elements "Plymouth" and "driveways"), and the content of the website itself (advertising the services of an apparently successful surfacing contractor) render it "more likely than not that the website would be mistaken for one connected to the Complainant".

The second grounds were of harm caused to the Complainant: "The unauthorised use of the TARMAC Trade Mark (in the name of the Domain and on the website the Domain re-directs to), if acted upon by consumers (to whatever extent), may lead to confusion, disappointment or frustration as to the website origin. Therefore, the current use of the Domain risks causing substantial harm to the Complainant's rights and reputation."

In its Appeal Notice the Complainant submits that the Expert was mistaken in concluding, on the evidence before him, that "the word [TARMAC] is commonly used to describe a road surface and is not a word that exclusively denotes the Complainant or its goods and services."

It goes on to reassert in stronger terms than before the arguments associated with abusive registration on the first grounds above, using for example the following statements: "the Respondent's business is highly likely to confuse people and businesses into believing that the domain name is connected in some way to the Complainant", and "It is inconceivable that the above was not intended by the Respondent at the time the domain name was registered".

A further remark "The Complainant will have no control over the quality of the surfacing services that the Respondent provides by reference to the domain name, which itself runs the serious risk of causing damage to its valuable TARMAC trade marks" effectively reasserts the second grounds.

The Respondent provided no response either to the original Complaint or to this Appeal.

7. The Expert's Decision

Although this Appeal is in substance a redetermination on the merits (see above) the Panel considers that given the difficult issues it raises it is helpful to set out in full the observations the Expert made in his decision, as follows:-

"Although the Complainant has Rights in view of its trademarks, the meaning of the word 'tarmac' or 'TARMAC' is not confined to the registered trademark of the Complainant. The word is commonly used to describe a road surface and is not a word that exclusively denotes the Complainant or its goods or services.

Although it is likely that the Respondent was aware of the Complainant when registering the Domain Name, knowledge of the Complainant or its Rights does not make the registration abusive: see in this instance, watfordpavingandtarmac.co.uk (DRS D00015757).

The representation made by the Domain Name itself is that the Domain Name is connected with a business that provides tarmac driveways in the Plymouth area; not that it is a branch of the Complainant's business in that area or otherwise connected to the Complainant's business or to the TARMAC trademark or the goods or services sold under it.

Thus, there is no misrepresentation as alleged. In the absence of a misrepresentation, no 'initial interest confusion' is likely.

Use of the Domain Name is connected to what, on the facts relied on by the Complainant, is likely to be a legitimate business that includes the installation of driveways in Devon, covering Plymouth and other areas identified on the Respondent's website. That use implies no connection with the Complainant or its trademark. The word 'tarmac' appearing from the screenshots provided is clearly a reference only to the tarmac used in the driveways provided by the Respondent. There might be configurations of the word 'TARMAC' with a geographical identifier such as Plymouth that would convey a representation of a connection with the Complainant or its Rights, but the Domain Name does not do so.

The re-direction to '5stardrivewaysltd.co.uk' renders it even less (not more as the Complainant alleges) likely that an inference will be drawn that the website and the Domain are connected to the business of the Complainant in some capacity. The screenshots provided show that it is a company by that name that is offering the goods and services in question. No suggestion is made that it is in any way connected with the Complainant.

Therefore, I am not satisfied that the Domain Name was registered or otherwise acquired in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights”.

8. Previous “Tarmac” DRS cases

It is convenient to note at this stage that there have been at least 10 previous DRS cases where the Complainant (or its predecessors) has filed complaints against other parties who have incorporated the term “tarmac” into their domain name.

The majority of these cases have been summary decisions where the relevant expert has found in favour of the Complainant. See:

Lafarge Tarmac Trading Limited v Hibu (UK) Limited [2015] DRS 15776
<northerntarmac.co.uk>;

Lafarge Tarmac Trading Limited v Bluezon Limited [2015] DRS 15777
<millertarmac.co.uk>;

Lafarge Tarmac Trading Limited v Steve Floyd [2015] DRS 15990
<floydstarmac.co.uk>;

Tarmac Trading Limited v Webdesigns Andprint [2016] DRS 17740
<kentcountytarmac.co.uk>;

Tarmac Trading Limited v Mr Chris Carlin [2017] DRS 18424
<kentcountytarmacltd.co.uk>;

Tarmac Trading Limited v Mr Rory Flynn [2019] DRS 20908
<plhtarmac.co.uk>;

There have however also been a number of cases with reasoned decisions, as follows.

Tarmac Ltd -v- Etches [2002] DRS 177 <tarmacvandal.co.uk> is a full decision in a case where no Response was filed (summary decisions did not at that date form part of the available Nominet procedure). This case was brought in respect of a domain name which was linked to a website promoting various motor related activities. Although no response was filed, the respondent had asserted in correspondence that his use of the term “tarmac” was merely descriptive. The expert considered the applicable principles in some detail, as follows:

“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 or 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”.

Tarmac Trading Limited v Ian Sheeran [2017] DRS 19293 <northern-tarmac.co.uk> is a case in which a response was filed. In this case the respondent appears to have argued that he was in a different area of business (the provision of services involving surfacing) from the complainant (the supply of construction materials) and no confusion arose, hence there was no abusive registration. The expert rejected this argument and found for the complainant. In

doing so the expert stated: *“The TARMAC mark is so well known in the UK that the Expert finds that anyone in the construction/resurfacing trades would associate it [with] the Complainant and its licensees. The Oxford English Dictionary has a reference under TARMAC which refers to its status as a trade mark. This indicates that the mark has acquired a secondary meaning of brand significance which goes beyond a description of a type of product”*.

Tarmac Trading Limited v Drivecareuk [2019] DRS 21282 <tarmac-surfacing.co.uk> is another case in which a response was filed. In this case the respondent expressly argued that the term “tarmac” was generic: “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 expert did not expressly deal with this argument but upheld the complaint. He stated: *“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”*.

Lafarge Tarmac Trading Limited v Smart Numbers Ltd [2015] DRS 15757 <watfordpavingandtarmac.co.uk> is a further case in which a response was filed. In this case the expert rejected the complaint. He accepted the respondent’s arguments that the term tarmac was descriptive. He stated *“The Respondent asserts that it is using the word TARMAC as a description of the products/services offered by it. It does not seem to me that this assertion is remotely fanciful or disingenuous and I accept that it is being used in such a manner. Notwithstanding the Complainant’s assertions to the contrary, it seems to me to be a really rather obvious proposition that the word TARMAC is commonly used to describe a road surface and is certainly not a word that exclusively denotes the Complainant or its goods or services. I consider it entirely right and proper for an expert to assess the descriptiveness or otherwise of a word that is contained within the Domain Name on the basis of his/her knowledge, and in making such an assessment he/she may not require the parties to have provided evidence in that regard, particularly as in the present case where the descriptive use of the word is so common”*.

It should be noted that from the Reply in DRS 15757 it appears the Complainant does not claim any rights in the term “tarmacadam” and accepts that is a descriptive word – it stated: *“Insofar as the Respondent is asserting that the Domain Name is generic or descriptive, the Complainant says that this is wrong and that the Respondent has provided no evidence to back-up such an assertion. The word TARMAC is not generic, and the Respondent likely has in mind the word TARMACADAM”*.

For completeness, the Panel notes one further additional full no-response decision it has identified, although this case involves rather different facts - Tarmac Limited v Dariusz Hermann [2008] DRS 5514 <tarmacterrorist.co.uk>, where the domain name pointed to a holding page containing a mixture of links, some to adult services. This was decided in favour of the Complainant on grounds which are not relevant to the present case.

9. Relevant Material

A question arises in this case as to the extent (if at all) that it is permissible for an expert or this Panel to rely upon either their own knowledge or the results of their own enquiries. As appears above the Expert took the view that the word tarmac is *“commonly used to describe a road surface and is not a word that exclusively denotes the Complainant or its goods or services”*. The expert in DRS 15757 (supra) took a similar view and stated *“I consider it entirely right and proper for an expert to assess the descriptiveness or otherwise of a word that is contained within the Domain Name on the basis of his/her knowledge, and in making such an assessment he/she may not require the parties to have provided evidence in that*

regard, particularly as in the present case where the descriptive use of the word is so common”.

So far as the Policy is concerned it provides (at paragraph 18):

“18.1 The Expert will decide a complaint on the basis of the Parties' submissions and this Policy. It is the Parties' responsibility to explain all the relevant background facts and other circumstances applicable to the dispute in their submissions, and to support those submissions with appropriate evidence. In the ordinary course an Expert will not perform any research into a dispute or check the parties' assertions, However an Expert may (in their entire discretion) check any material which is generally available in the public domain.

18.2 An Expert may be in possession of relevant information which is not in the case papers, and upon which he or she wishes to rely for the purposes of the Decision. In this event, the Expert will inform the Parties that he or she holds such relevant information and invite them to make submissions.”

It is also appropriate to note that in this case the Complainant expressly invited the Expert to make additional enquiries, stating in the Complaint as follows: “While the Complainant is of the view that the goodwill and reputation in the TARMAC name and brand in the UK is self-evident, it is conscious that it should not take for granted the knowledge of any Expert Nominet may appoint in connection with this complaint. In that regard, and with a view to providing sufficient evidence, while not labouring the point or burdening the Expert with an over-abundance of material, the evidence of goodwill and reputation provided is intended to be non-exhaustive and indicative only. If an Expert wishes to exercise their discretion and supplement this evidence with their own investigations, the Complainant would encourage them to do so”.

In general terms it seems to the Panel that an expert should avoid making independent enquiries as to matters that are, or are likely to be, controversial. Matters of public record (e.g. on file information at Companies House or the Intellectual Property Office) will not normally fall into this category, but the appropriateness of any wider enquiries should be carefully considered. In any circumstance where the results of such enquiries are likely to be determinative in the expert's reasoning it will generally be appropriate for the Expert to communicate via Nominet with the parties and afford them an opportunity to comment upon the material in question. In any event the wording of the Policy paragraph 18.2 (above) would appear to require the expert to do so.

The Panel considers the same general approach should be adopted if an expert is minded to apply his own knowledge. The Panel considers it would be unrealistic to expect an expert to ignore what he considers, based on his own knowledge, is the ordinary English meaning of a word where that issue is relevant to his conclusion. However it would also appear to be the case that the expert's own knowledge as to the meaning of a word, if not in the case papers, will be “relevant information” if the expert considers that meaning to be a significant factor, and particularly where this factor is crucial to the Expert's reasoning. It follows that again paragraph 18.2 should apply and the parties should be afforded an opportunity to comment upon the Expert's view before he renders his decision. In the present case the Panel has ultimately concluded (by a majority) that the fact that the word “tarmac” has a generic meaning – see below – is not determinative of the outcome of this appeal and hence the Panel has not found it necessary to seek further comment from the parties on this issue.

10. Is the term “tarmac” generic?

The Complainant has placed in evidence an entry from the Shorter Oxford English Dictionary 3rd edition which provides as follows: “Tarmacadam 1882 ... a material for making roads consisting of some kind of broken stone or ironstone slag in a matrix of tar alone or of tar with some mix of pitch or creosote. Hence tarmac the registered trademark of a kind of tar macadam consisting of iron slag mixed with tar and creosote”.

Taking up the Complainant’s suggestion of supplementing its evidence through independent enquiry, two Panel members carried out simple Google searches on the term “Tarmac”, one (who happened to be in France) limiting hits to UK results; the other was in London. The first found that there were a significant number of entries in the first few pages of results where the word “tarmac” was used in a generic sense (see discussion below) but that overall the majority of entries returned over those first few pages of results concerned the Complainant and/or its use of the term “Tarmac” in a trade mark sense. The other found that the first three pages of findings jointly produced 40 search results, of which 11 referred directly to the Complainant; the third page contained only one reference to the Complainant. Most of the other 29 results were links to surfacing contractors, with a few being dictionary or other discussions of the meaning of the term, of which some examples are reproduced below. Taken together, these findings support both the Complainant’s claim of its trade mark’s renown and the common use of the same word to indicate a substance used in hard surfacing.

Material supporting the proposition that the word “tarmac” is commonly used generically to refer to a road surface includes, for example:

<https://www.bbc.com/news/magazine-23315384> which is an article on the BBC website entitled “Who, what, why: When does tarmac melt?” The word “tarmac” is used in the heading and the body of the article to refer to road surfaces generally.

<https://www.readersdigest.co.uk/lifestyle/technology/black-gold-how-tarmac-transformed-society> - which is an article in Readers Digest entitled “Black Gold: How Tarmac Transformed Society” which expressly asserts the term “tarmac” is generic: “The road surfaces we know now are technically asphalt concrete—bitumen, concrete and small aggregate mixed prior to laying and rolling. But the term “tarmac” has become a generic term for transport surfaces. When we say, “The plane is on the tarmac,” it usually isn’t—it’s on concrete.”

<https://www.instituteofmaking.org.uk/materials-library/material/tarmac> - which is a web page produced by what appears to be an informal group at University College London calling itself the “Institute of Making” and which is its entry under “materials” for “tarmac”: “Tarmac is the generic name given to road surfacing materials, which is comprised of tar-like materials mixed with mineral aggregates like Portland cement, sand, gravel or concrete. However, the word 'tar' is used to describe a number of distinct substances that aren't actually tar. Tar is refined natural resin or 'pitch', usually from the wood and roots of pine trees, but these are rarely found in our pavements. In fact, most of the 'tar' in tarmac is bitumen, which can be found in nature as a semi-solid form of petrol; but it is more commonly a bi-product of crude oil production by distillation”

Whilst not necessarily an authoritative source, Wikipedia currently defines “tarmacadam” as follows: “Tarmacadam is a road surfacing material made by combining macadam surfaces, tar, and sand, patented by Welsh inventor Edgar Purnell Hooley in 1902. The terms "tarmacadam" and tarmac are also used for a variety of other materials, including tar-grouted macadam, bituminous surface treatments, and modern asphalt concrete”.

It is also easy to find examples of surfacing contractors using the term generically – see for example <https://www.premiersurfacing.co.uk/hints-tips/all-you-need-to-know-about-tarmac-and-your-driveway/> which includes the following passage “Tarmac is actually a trademark name that has slipped into common usage, much like Hoover, Astro-Turf and Jacuzzi, and is often used as a generic term with a lowercase t. A lot of people use the term tarmac when actually they mean asphalt concrete. You may see the term bitmac used instead of tarmac because now, bitumen is used as a binding agent instead of tar but you basically get the same effect”, and so forth, using “tarmac” in its generic sense.

The Oxford Dictionary of English, Third Edition 2010, provides a separate definition for tarmac as follows:

“Noun [mass noun] (trademark in the UK) material used for surfacing roads or other outdoor areas, consisting of broken stone mixed with tar. (the tarmac) a runway or other area surfaced with tarmac or a similar material.

verb (tarmacs, tarmacking, tarmacked) [with obj] surface a road or other outdoor area with tarmac or a similar material (as adj: tarmacked) there are no tarmacked roads.

ORIGIN early 20th cent.: abbreviation of tarmacadam”.

Note that the Panel considers it likely that the designation of the term “tarmac” as a trade mark in dictionaries will have been prompted by correspondence from the Complainant or its representatives.

Accordingly, the members of this Panel do agree with the view expressed by the expert, and consistent with the materials identified above, that the word tarmac is commonly used in modern English by ordinary members of the public to describe a hard road or transport surface made up of tarmacadam or similar material and irrespective of whether or not the material making up that surface originates from the Complainant.

The Panel would also add that, for reasons discussed in more detail below, the Panel considers that a relevant issue is how the term “tarmac” is understood in the trade. No systematic evidence on this is available to the Panel, but the following views of respondents are drawn from the four full decisions listed above:

DRS 177: “The reason for the inclusion of the word tarmac within our name is that it is synonymous with road surfaces”

DRS 15757: “the use of the use of the word TARMAC in the Domain Name is not a representation of the Respondent’s name, but a product/service that is offered to customers. The Respondent does not hold itself out to be the Complainant² but uses the term so that the public will recognise a material that is used in the provision of the Respondent’s services.”

DRS 19293: “..disputes any potential for confusion between the Complainant and the Respondent because there is no common field of activity between them. The Complainant sells a product, Tarmac, and the Respondent provides service - he reconstructs driveways. He does not find the trading names confusing.”

DRS 21282: “the term “tarmac” is widely used in the construction industry and does not necessarily indicate the Complainant’s group companies”

Together with usage on various surfacing contractors’ websites and the Respondent’s own website, these remarks support the view that when addressing potential retail customers,

² Corrected from “Respondent” in the original, which cannot have been the intended meaning. “the Respondent’s name” in the previous sentence may also be intended to be read as “the Complainant’s name”, but this is less clear, and makes less difference to the overall sense.

contractors use the term “tarmac” in its generic sense, which is how they expect the public to understand it. No evidence is available, however, on how far surfacing contractors in general, or the current Respondent in particular, are also aware (before receiving a warning letter from the Complainant) of the word as a trade mark, or, importantly, of restrictions associated with its trade mark status. Having heard of the Complainant does not imply an understanding of possible detrimental implications of using its name.

This Panel accordingly proceeds on the basis that the word “tarmac” is used by the general public in the UK to refer generically to a hard road surface, as well as being a trade mark of the Complainant. As explained above if this fact were likely to be determinative of the Panel’s reasoning the Panel would have invited further submissions from the parties. However, since it is not (see below), the Panel does not feel this is necessary.

The Panel also notes that it appears that no-one (including the Complainant) nowadays uses “tarmac” as a surfacing material if that term is restricted to the strict sense of the word that the Complainant relies upon as meaning slag mixed with tar or tar and creosote. The evidence before the Panel is not very clear on this issue but it seems that equivalent products nowadays use bitumen as the binding agent, and are commonly described as “asphalt”. Certainly the Complainant’s website promotes a wide range of asphalt products but nowhere that the Panel can see does it offer or promote a product described as “tarmac”. As noted above, however, its Tarmac trade mark applies to a wide range of road surfacing materials.

11. Trade mark law considerations

As noted in the Experts’ Overview (a document published on Nominet’s website which explains the consensus views amongst Nominet’s panel of Experts): “Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant’s use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the law are too far apart, the DRS Policy will inevitably lose some of its value. Rights owners or domain name registrants (depending upon the nature of dispute) may prefer the expense of litigation to the likely result under the DRS Policy”.

The present case necessitates at least some consideration of the relevant principles of trade mark law and how those interact with the DRS in relation to a term which may be generic. In very broad terms if a coined word is used as a trade mark but the word passes into common usage it may become so generic as to be incapable of serving as an identifier of the trade mark proprietor’s goods or services. In such circumstances the trade mark may be liable to revocation (see below). Students of trade mark law will be familiar with often cited examples of coined terms which have become generic, for example trampoline, escalator and videotape. There are further trade marks which are at least to some extent at risk of becoming generic but where the trade mark owner is typically making efforts to prevent that occurring and hence to preserve the relevant trade mark. These are often words which are used at least to some extent in common parlance to refer to the type of object in question, but where trade mark registration still exists and where (generally) competitors do not use the term in question. Oft cited examples of this type of term are Hoover and Jacuzzi. Whether or not a given registered trade mark ends up being revoked because it has become generic will depend upon legal actions taken in a given jurisdiction. Given that trade mark protection generally occurs on a territorial basis different outcomes may occur in different territories depending on the relevant facts and the applicable law.

So far as the law of England is concerned the relevant provision (as noted by the expert in DRS 177 supra) is Section 46(1)(c) of the Trade Marks Act 1994: “Revocation of registration. (1)The registration of a trade mark may be revoked on any of the following grounds...(c) that,

in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered". This Panel would agree with the Expert in DRS 177 (supra) that "*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 present case, although there is material (see discussion above) that indicates that the public at large commonly use the term "tarmac" in a generic sense to mean a hard road or transport surface, there is insufficient evidence before the Panel to enable it to reach a conclusion as to the awareness among surfacing contractors of its trade mark status.

So far as the Policy is concerned it provides at paragraph 8.1 as follows: "A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:...8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it". The Policy is silent as to whether this is referring to being generic in the sense of having become a common term within the trade or generic in the sense of being used in a descriptive manner by the public at large (or a proportion thereof).

12. Application of the Policy

General

Pursuant to paragraph 2.1 of the Policy, the Complainant must prove in relation to the Domain Name, on the balance of probabilities, that:

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

"Rights" are defined in the Policy as follows: "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."

The Complainant has established that it is the owner of a number of registered trade marks for the word "Tarmac".

The Domain Name is, in the opinion of the Panel, similar to these trade marks. It in substance combines the trade mark with a geographic non-distinctive term "Plymouth" and the generic word "driveways". The suffix ".co.uk" may be ignored for the purposes of this assessment. Accordingly, the Panel is satisfied that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

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

There being no response in this case, the Panel does not know what was in the Respondent's mind when registering the Domain Name or why he chose to include the term “tarmac”. There would seem logically to be two possibilities: either as a reference to the Complainant and its trade mark or because of the way the word tarmac is understood generically by the public (see discussion above). If the latter, the Panel would nevertheless have thought it more likely than not that the Respondent as a surfacing contractor was aware of the Complainant and its position as the largest supplier of construction materials in the UK.

The Panel does not however think the evidence before it establishes that members of the public, including actual or potential customers of the Respondent, would necessarily share that awareness. It seems to the Panel more likely than not that members of the public looking at the Domain Name would understand the inclusion of the term “tarmac” to be a reference to the generic type of surface the Respondent provides. That being the case the Panel thinks it more likely than not that the Respondent chose to include the term “tarmac” in its domain name because of the way it is likely to be understood generically by the public – it was seeking to convey to the relevant public that its business was the provision of hard surfaced driveways rather than to suggest it was in some way connected with, or approved by, the Complainant. There is also no evidence that anyone seeking the Complainant or its products would in some way be diverted to the Respondent. The use of the Domain Name would not in the Panel's opinion on the evidence before it cause any direct harm to the Complainant in terms of loss of business, diversion of customers and so on.

That being the case the Panel is doubtful that the Domain Name could be said to be “taking unfair advantage” of the Respondent's trade mark. On the matter of “unfair detriment”, however, the Panel is divided, and two views are given below. As background to those views, the Panel agrees that use of the term “tarmac” as part of a business name or as part of a domain name has potential to erode the distinctiveness of the Complainant's trade marks and could ultimately, if unchecked, contribute to the trade marks being liable to revocation (see discussion above). It is quite clear from both this case and the various other DRS cases cited above that the Complainant is actively taking steps to seek to prevent this happening. The Panel considers it is entitled to do so.

The Panel has considered whether the Respondent's intention matters. The Expert Overview addresses this issue at 2.4 where it states “A particular area of current debate among the panel of Experts is the extent to which the concepts of unfair advantage and unfair detriment as set out in the definition of Abusive Registration [paragraph 1 of the Policy] embrace a subjective element. The members of the Appeal panel in the Verbatim case took the view that for a registration to be labelled “Abusive” there had to be something morally reprehensible about the Respondent's behaviour, a view more recently adopted in DRS 07066 (whistleblower.co.uk). Others have expressed the view that what is or is not fair can be judged wholly objectively and that to gain or to cause damage by way of trade mark infringement is necessarily unfair irrespective of the motives of the Respondent”.

In the present case the Panel does not consider that the Respondent's motives matter, which is helpful considering the absence of evidence relating to them. It may be that at the time the Respondent registered the Domain Name he did so because of its generic meaning and had no intention to take advantage of, or cause detriment to, the Complainant's trademark. The Panel stresses however that once the Complainant had complained to the Respondent about his use

of the Domain Name (which it did – see factual background above) the on-going use by the Respondent thereafter would undoubtedly have been with the knowledge that such use was contrary to the Complainant’s wishes, and that the Complainant was the proprietor of registered trademarks for the term “tarmac”.

Abusive registration – majority view

The requirements of “taking unfair advantage” and “being unfairly detrimental” are alternative criteria for concluding there is an Abusive Registration. As explained above, the Panel does not see the Respondent’s use of the name as “taking unfair advantage” of the Complainant’s Rights.

Paragraph 8.1.2 of the Policy provides that it may be evidence that the Domain Name is not an Abusive Registration if “The Domain Name is generic or descriptive and the Respondent is making fair use of it”. Despite agreeing as explained above that the Domain Name is generic, two Panel members (Nick Gardner and Ian Lowe) do not see the Respondent’s use of the name as fair.

Those two Panel members conclude that the Respondent’s use of the Domain Name was an Abusive Registration as it was unfairly detrimental to the Complainant’s Rights in that it contributes to eroding the distinctive nature of those Rights. The third member (Claire Milne) takes a different view, explained below. The majority consider that although the actions of the Respondent would appear to amount to infringement of the Complainant’s registered trademarks, it is not in this case that the infringement automatically renders the registration an Abusive Registration – it is the fact that the activities in question are contributing to the erosion of the Complainant’s Rights.

Abusive Registration – dissenting opinion by Claire Milne

I do not find the pattern of arguments used in previous relevant decisions involving this Complainant persuasive in the present case. Six of them were summary decisions with no reasoning shown; a high proportion of summary decisions understandably are in favour of Complainants. Of the four full decisions summarised above, only two (DRS 177 and DRS 19293) were decided for the Complainant primarily on grounds of trade mark infringement. One (DRS 21282) was decided for the Complainant primarily on grounds of potential confusion, and one (DRS 15757) was decided for the Respondent. The domain name in that last case, <watfordpavingandtarmac.co.uk>, seems to me to be most similar to the current one, being the only one containing both a place name and a type of application along with the word “tarmac”; its reasoning, summarised above, also seems to me to be the most relevant. The whole Panel agrees that in the present case there is no risk of confusion.

I consider that the majority argument presented above, finding Abusive Registration on grounds of unfair detriment consisting of contributing to trade mark erosion, subverts an intention of the DRS Policy. This is summarised in a sentence from the Experts’ Overview quoted earlier: “Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant’s use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy”.

The argument made by my colleagues appears to me to be precisely that the fact of contributing to trade mark erosion, irrespective of the Respondent’s intention (or his awareness of the Complainant or his understanding of the relevant implications of trade mark law), and irrespective of the degree of unfairness or of detriment that the contribution to erosion implies to the Complainant, must result in a finding of Abusive Registration. In other words, following their logic implies that any knowing use of a trade mark that its proprietor is

actively defending (however innocent or ignorant and however minor that use) must automatically result in a finding of “unfair detriment” and hence of Abusive Registration, contrary to the sentiment expressed in the Overview.

In the current case, the Respondent’s failure to respond means that the Panel can have no view on his state of mind when registering or using the Domain Name. It is however probable that the Respondent, as a surfacing contractor, has a lesser grasp of trade mark law than DRS Experts, and in particular than my colleagues on this Panel. Their argument hinges on the Respondent’s failure to surrender the Domain Name on receipt of warnings from the Complainant. The text of the warnings has not been provided, so the Panel cannot assess their tone or likely effect on the Respondent.

At least two distinct effects are consistent with his non-response: he might have recognised the error of his ways and decided to keep the name regardless, or he might have felt puzzled and upset and just let the matter ride. The Panel cannot tell whether either of these happened, and any leaning towards one of these attitudes must be subjective.

In my view, not only is it fair to use the word “tarmac” descriptively (in the generic sense that the whole Panel agrees the word possesses), but also it does not automatically become unfair because the Respondent fails to surrender the name on receipt of a warning letter whose implications he may not fully understand. It is up to the Complainant to show unfairness, and in my view it has not done so. Rather, it has made a series of assertions of its own renown and importance, while failing to engage with the reality of alternative use of the word by the general public. This gives an appearance of wilful blindness to such use.

Given that the Complainant is actively defending its trade mark, I accept that any unauthorised use of its trade mark is in some degree detrimental to its interests. However, given the generic usage of “tarmac” and that the Respondent is only one of many surfacing contractors and others using the term in similar ways, I would say that the additional detriment in this instance cannot be material. I am struck in particular by this remark by the Complainant in the Complaint: “The unauthorised use of the TARMAC Trade Mark (in the name of the Domain and on the website the Domain re-directs to), if acted upon by consumers (**to whatever extent**), may lead to confusion, disappointment or frustration as to the website origin. Therefore, the current use of the Domain **risks causing substantial harm** to the Complainant’s rights and reputation. I have emboldened two contrasting phrases which to me highlight the disproportionality of their view. My colleagues are upholding this view. I believe, however, that the Nominet DRS Policy aims for outcomes based on a more balanced sense of proportion.

I also regard the argument that use in Domain Names “could ultimately, if unchecked, contribute to the trade mark being liable to revocation” as being unfair to this Respondent. I believe that his case should be judged on its own merits, as should others in future, and that on the balance of probabilities in this case, material unfair detriment has not been shown.

13. Decision

For the reasons set out above the Panel concludes unanimously that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. It concludes by a majority (Claire Milne dissenting) that the Domain Name, in the hands of the Respondent, is an Abusive Registration because it has been used in a manner which was

unfairly detrimental to the Complainant's Rights. Accordingly, the Panel finds that this appeal should be allowed and that the Domain Name tarmacdrivewaysplymouth.co.uk should be transferred to the Complainant.

Signed

Nick Gardner

Date

Signed

Claire Milne

Date

Signed

Ian Lowe

Date