

DISPUTE RESOLUTION SERVICE

D00019293

Decision of Independent Expert

Tarmac Trading Limited

and

Ian Sheeran

1. The Parties:

Complainant: Tarmac Trading Limited
Portland House
Bickenhill Lane
Solihull
Birmingham
B37 7BQ
United Kingdom

Respondent: Ian Sheeran
13 Bickerton Avenue
Wirral
Merseyside
CH63 5NA
United Kingdom

2. The Domain Name(s):

northern-tarmac.co.uk

3. Procedural History:

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

31 August 2017 17:41 Dispute received
04 September 2017 10:12 Complaint validated
04 September 2017 10:19 Notification of complaint sent to parties
05 September 2017 17:42 Response received
05 September 2017 17:42 Notification of response sent to parties
07 September 2017 17:10 Reply received
07 September 2017 17:10 Notification of reply sent to parties
12 September 2017 11:22 Mediator appointed
13 September 2017 11:58 Mediation started
06 October 2017 08:12 Mediation failed
06 October 2017 08:13 Close of mediation documents sent
17 October 2017 08:55 Expert decision payment received

4. Factual Background

The Complainant is a leading building materials and construction solutions business. It has a long trading history dating back to 1903. It is the owner of numerous UK and European trade mark registrations for the word TARMAC, including UK trade mark no UK 254287, registered in 1903 for “tarred slag and tar concrete for road making etc.”. The Complainant has provided details of 8 other trade mark registrations, including UK trade mark 1287560 registered in 1986 for “construction, building and services”. The Third edition of the Oxford English Dictionary defines “Tarmac” in terms of its registered trade mark status as; “the registered trademark of a kind of tar macadam consisting of iron slag impregnated with tar and creosote”.

The Complainant has a website at www.tarmac.com. It has provided screenshots of the website. These show prominent use of the TARMAC mark.

The Complainant was incorporated on 7 May 1948 and incorporated TARMAC into its registered company name on 30 July 1987. Various group companies under common control of the Complainant trade under the TARMAC mark under licence from the Complainant. These include companies which use the TARMAC trade mark within their company and/or trading names in conjunction with a generic geographical element e.g. Tarmac Central Limited, Tarmac Northern Limited and Tarmac South Western Limited. A full list of subsidiaries has been provided by the Complainant consisting of 67 companies, many of which include the TARMAC mark in their corporate name.

The Complainant has provided details of its turnover for the year ended 31 December 2014. It exceeded £1.8 billion.

The Respondent registered the Domain Name on 28 March 2017 as a sole trader. In its Response the Respondent refers to himself as “a company” but there is no evidence to support that status and the Expert will therefore proceed based on his sole trader status. The Respondent trades under the name Northern-Tarmac. The business reconstructs new driveways. It is operating a website hosted at the Domain Name which describes the Respondent as offering “tarmacadam and resurfacing services in the Wirral.”. The website states that “we undertake both domestic and commercial work, from tarmac driveways, road marking, road resurfacing to large car parks and playgrounds.”

In 2015 The Complainant (under its previous name Lafarge Tarmac Trading Limited) successfully challenged the use of the domain name northerntarmac.co.uk by a company called Hibu (UK) Limited. The domain name was transferred to the Complainant on 14 May 2015 (Summary Decision DRS 015776). Hibu (UK) Limited had the same registered office as the Respondent in this matter. The 2015 domain name was identical to the domain at issue in this matter except for the use of a hyphen in the current domain name.

5. Parties’ Contentions

The Complaint

The Complainant asserts Rights in the TARMAC mark. It relies on its trade mark registrations set out in section 4 of this Decision. It also asserts goodwill and unregistered Rights in the TARMAC mark relying on its extensive use of the TARMAC mark.

It asserts that the Domain Name is an Abusive Registration on the following grounds:

1. the registration of the Domain took unfair advantage of the Complainant’s rights (such activities falling within part (i) of the definition of Abusive Registration under the Policy);
2. the Domain has been used in a manner which has taken unfair advantage of and / or has been unfairly detrimental to the Complainant’s rights in the TARMAC Trade Marks (such activities falling within part (ii) of the definition of Abusive Registration under the Policy);
3. people are likely to be confused into believing that the Domain is registered to, operated or authorised by or otherwise connected with the Complainant (such as Nominet is entitled to consider under paragraph 5.1.2 of the Policy);

4. the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern (such as Nominet is entitled to consider under paragraph 5.1.3 of the Policy). This submission refers to DRS 015776 referred to in paragraph 4 of this Decision. The Complainant asserts that despite the finding that the northerntarmac.co.uk domain name was an Abusive Registration the Respondent has chosen to register an almost identical domain. The Respondent has therefore shown it is engaged in a pattern of registrations which correspond to well-known names or trade marks in which the Respondent has no apparent rights.

The Complainant's overall concern is the longer the Respondent holds and controls the Domain, the more damage and loss will be caused to its business and reputation.

The Response

The Respondent asserts that he has been trading under the name Northern Tarmac since 2000. He 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. He also states that he is taking legal advice on his position and will keep Nominet informed of the outcome. No information has been forthcoming at the time of this Decision.

The Reply

In its Reply the Complainant asserts that there is no evidence that the Respondent has used the trading name since 2000. But, even if he has under various guises, the Complainant's use of the TARMAC mark predates 2000 and the Complainant has actively objected to the Respondent's use of the Northern Tarmac trading name during this period.

The Complainant disputes that there is no common field of activity between the Parties. A number of the Complainant's products are used for the reconstruction of driveways, including the successful ULTIDRIVE product which is marketed under the TARMAC mark.

6. Discussions and Findings

The Complainant must establish 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, (as defined in Paragraph 1 of the Policy) and

the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in Paragraph 1 of the Policy).

Rights

Rights are defined in Paragraph 1 of 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 registered trade mark rights in the TARMAC mark which predate the earliest date that the Respondent claims to have begun using the Northern Tarmac name (2000). The Complainant's registered Rights date back to 1903.

The Complainant has also established unregistered Rights in the TARMAC mark through its extensive, long lasting and successful business presence in the UK. The Expert accepts that the unregistered Rights have been in existence since at least 2000.

The TARMAC mark is so well known in the UK that the Expert finds that anyone in the construction/resurfacing trades would associate it 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.

The TARMAC mark in which the Complainant has Rights is not identical to the northern-tarmac.co.uk domain name but it is similar. The overall impact of the Domain Name comes from the TARMAC component. The addition of "northern" does not dilute the significance of the TARMAC mark, nor does the use of the hyphen. The .co.uk suffix can also be disregarded.

The first requirement of the Policy has accordingly been established by the Complainant on the balance of probabilities. It has established registered and unregistered Rights in a mark which is similar to the Domain Name.

Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

The Complainant bases its case on both grounds.

Before moving on to consider the Decision there is an area of factual uncertainty in the submissions before the Expert relating to whether the Respondent was responsible for the earlier registration of the domain name northerntarmac.co.uk which was the subject of the summary decision in May 2015. The Respondent in that matter was Hibu (UK) Limited. The company shared an address with the Respondent. The Complainant refers to the Respondent in the 2015 and the current complaint as if they were one and the same.

On the Evidence before the Expert there is no clear evidence or explanation to establish that the Respondent in this matter and the Respondent in the 2015 Complaint were one and the same. The Expert has carried out a Companies House search of Hibu (UK) Limited and of the current Respondent which has shed no light on the matter. The company currently incorporated as Hibu (UK) Limited acquired that name after the 2015 decision and has no obvious connection with the Respondent.

The fact that both respondents share an address is not sufficient to support a finding that the respondents (and the domain name registrants) in the current and 2015 complaints were the same. For that reason, the Complainant's submission that the Respondent is engaged in a pattern of abusive registrations fails. The Expert places no reliance on the 2015 decision in her findings below.

Registration

The Domain Name was registered on 28 March 2017. The Respondent trades in the same broad area of activity as the Complainant. It is inconceivable that the Respondent would not have been aware of the Complainant and its TARMAC mark at the time of registration of the Domain Name in 2017. The strength of the TARMAC brand and its strong association with the Complainant gives rise to a de facto presumption that the Respondent intended to take advantage of the goodwill in the TARMAC mark when he sought to register it for his own business.

The Respondent seeks to rebut that presumption by explaining that he has used the northern tarmac mark as a trading name since 2000. Under the Policy a Respondent can rebut a finding of Abusive Registration by establishing that he has

- 8.1.1 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;
- 8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or
- 8.1.1.3 made legitimate non-commercial or fair use of the Domain Name

The Expert finds that the Respondent has not made out its case. Firstly, he has provided no evidence beyond an unsubstantiated submission about when he began use of the northern tarmac trading name.

Secondly, even if he could establish use of the trading name since 2000, the Expert finds on the submissions before her that the Respondent's unauthorised adoption of the TARMAC mark in 2000 (or indeed at any point between 2000 and the date of this decision) would not have been legitimate. It would have taken advantage of the Complainant's Rights. Compelling evidence would be needed from the Respondent to establish that he has acquired his own bona fide goodwill in the Northern Tarmac trading name through marketing and use. No evidence has been forthcoming.

The second requirement of the Policy has accordingly been established by the Complainant on the balance of probabilities. It has established that the registration of the Domain Name was an Abusive Registration.

Use

The Respondent has used the Domain Name to host a website. Screenshots of the website have been supplied as an annex to the Complaint and are referred to in section 4 of this Decision. The Respondent has not disputed them. The website promotes the Respondent's construction and resurfacing services under the Northern-Tarmac name. There is no evidence about when the website was launched.

Paragraph 5.1.2 of the Policy states that a factor which may indicate that the Domain Name is being used in an abusive way is that there are circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Respondent disputes that this takes advantage of the Complainant's Rights or causes detriment to the Complainant. This submission turns on the Respondent's rejection of any potential for confusion between the parties. He provides services. The Complainant supplies products- and one product in particular, Tarmac. The Complainant seems to accept that it provides products not services but indicates that its range of products extend to products that would be used in the type of resurfacing service that the Respondent undertakes.

The Expert notes that while there is a difference in the output of each of the parties, the products and the services offered by the respective parties fall within the same business sector- construction/resurfacing. The Respondent's website states that its services are provided to private customers and to businesses. On the balance of probabilities, the Expert finds that the similarity in the field of activity gives rise to a potential for confusion that the Respondent is connected to or authorised by the Complainant. This potential for confusion is increased because the Complainant licenses the use of its TARMAC mark to its subsidiaries. Some of these subsidiaries use trading names which are similar to the Respondent's trading name, for example Tarmac Northern Limited. Customers or potential customers with knowledge of this practice of the parties would be likely to infer that the Respondent is a licensee of the Complainant.

The use of the Domain Name by the Respondent is taking unfair advantage of the goodwill and brand recognition generated by the Complainant's Tarmac mark. The Respondent is promoting himself and attracting business through a parasitical use of the TARMAC mark. The use is also on the balance of probabilities causing unfair detriment to the mark. The Complainant has no control over the Respondent or its services. As such, the strength of its ability to control the use of its mark and to safeguard its reputation is weakened.

The Expert also finds that the Complainant has established on the balance of probabilities that the use of the Domain Name is an Abusive Registration under Paragraph 1 of the Policy.

7. Decision

The Expert finds 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 is an Abusive Registration. The Expert orders that the Domain Name be transferred to the Complainant.

Signed Sallie Spilsbury

Dated 9 November 2017