

DISPUTE RESOLUTION SERVICE

DRS 08429

Decision of Independent Expert

The Society of Operations Engineers

and

Tim Blakemore

1. The Parties:

Complainant: The Society of Operations Engineers
Address: 22 Greencoat Place
London
Postcode SW1P 1PR
Country: UK

Respondent: Tim Blakemore
Address: Hilltop, Beech Hill
Headley Down
Bordon
Hampshire
Postcode: GU35 8BD
Country: UK

2. The Domain Name(s):

transport-engineer.co.uk (“the Domain Name”)

3. Procedural History:

The Complaint was filed on 22 March 2010. The Response was filed on 14 April 2010. A Reply was filed on 21 April 2010. Mediation closed on 21 April 2010. The Complainant paid for a decision on 29 April 2010.

On 19 May 2010 I, Adam Taylor, the undersigned, confirmed to Nominet that I knew of no reason why I could not properly accept the invitation to act as expert in this case and further confirmed that I knew of no matters that ought to be drawn to the attention of the parties which might appear to call into question my independence and/or impartiality.

4. Factual Background

The Complainant, a registered charity, is a professional membership organisation for engineers. It was formed in 2000 following the merger of two existing professional bodies: the Institute of Road Transport Engineers (IRTE) and the Institution of Plant Engineers (IPlantE).

IRTE published a magazine known as "Transport Engineer" since 1970. From 2000 it has been published by the Complainant.

From 1995 until November / December 2009 (the exact date is in dispute, but immaterial) the production of Transport Engineer was outsourced to Aztec Media Services Limited ("Aztec"). The Respondent is the managing director and owner of Aztec.

The Respondent registered the Domain Name on 22 October 2006.

5. Parties' Contentions

Complaint

Rights

All assets of the IRTE, including Transport Engineer magazine, were transferred to the ownership of the Complainant upon its formation in 2000.

The IRTE Professional Sector of the Complainant (as it is now known) was established in 1944 and today has approximately 11,000 members worldwide.

IRTE members receive Transport Engineer magazine each month.

Transport Engineer magazine has been independently-audited by the ABC (Audit Bureau of Circulation) since 1970.

Transport Engineer takes an independent stance on controversial transport engineering issues, and is the principal forum for comment on those issues.

The primary readership of Transport Engineer is individual and company members of the IRTE Professional Sector of the Complainant. There are also subscribers who make up around 2% of the total readership.

Advertising space is sold in every edition of Transport Engineer. Revenue achieved from advertising sales is split between the contract publisher and IRTE Services Ltd, the trading arm of the Complainant.

The October 2009 edition produced by Aztec Media lists the Complainant as the publisher and therefore owner of the title / magazine.

The Complainant owns www.transportengineer.org.uk, which is used as a supporting website for Transport Engineer magazine.

Abusive Registration

The Domain Name was registered by as a result of the publishing contract signed between the Complainant and Aztec.

When the Domain Name was registered in 2004 (sic) up until the contract expiry in December 2009, the Domain Name was used solely for the support and promotion of Transport Engineer magazine.

Aztec's continued operation of the Domain Name is potentially confusing to members, advertisers and customers, who may visit the website to find out information about the Complainant's magazine, as they have done in the past. This is potentially very damaging for the Complainant, its members and its charitable aims.

Following the contract expiry, the Respondent and his company Aztec established a rival publishing venture, and are currently using the Domain Name to support this new venture.

This is an attempt by them to promote their new venture and to gain commercial advantage, using the long-established and respected name of Transport Engineer. It is a deliberate attempt to confuse the market place and generate income from potential advertisers/customers who may be duped into thinking that the new venture is a replacement for Transport Engineer magazine.

Transport Engineer is synonymous with the IRTE Professional Sector Complainant. As owner and publisher of Transport Engineer magazine for nearly 40 years, the Complainant believes it has rights over and should own and control the Domain Name.

For the Respondent to continue to use and control the Domain Name after 31 December 2009 constitutes an abuse of the Transport Engineer name.

Response

The initial acquisition and registration of the Domain Name by the Respondent was not an abusive registration as it did not take unfair advantage of the Complainant and was not unfairly detrimental to the Complainant's rights. Similarly, this is not an abusive registration because the Domain Name has neither been used in a manner which has taken unfair advantage of nor been unfairly detrimental to the Complainant's rights.

Aztec, headed by the Complainant and David Wilcox, has a long and distinguished track record in producing various high-quality publications, printed and online, read by transport engineers. It did so before, during and after the contract with the Complainant, which ended at the end of November 2009, not December as the Complainant wrongly asserts. These publications have been referenced using the Domain Name.

There are hundreds of thousands of transport engineers in the United Kingdom alone, probably millions elsewhere, including those in membership of such bodies as the Institute of Transportation Engineers with around 17,000 members, The Institute of the Motor Industry (IMI) with around 25,000 members, The Institution of Mechanical Engineers (IMechE) with around 80,000 members, The Institution of Engineering and Technology (IET) with around 150,000 members, The Society of Automotive Engineers (SAE) with around 90,000 members, The Chartered Institute of Logistics and Transport (CILT) with around 20,000 members, the Confederation of Passenger Transport (CPT) with around 1,100 member companies, and the Freight Transport Association (FTA) with around 11,000 member companies.

In addition, there are countless thousands of transport engineers who choose not to join any of these bodies.

The above references are specifically to road transport engineers. When the boundaries of the descriptive or generic term "transport engineer" are broadened a little to encompass other modes of transport such as rail, air and maritime, the list is almost endless. This contrasts with the number of transport engineers in SOE membership: fewer than 11,000 and falling.

To suggest anything else would be to give the Complainant "exclusive rights" in the words "transport engineer" and preclude any legitimate transport engineers from the right to describe themselves this way. Such a proposition would be preposterous.

The Respondent is a prominent road transport journalist, a "transport engineer" who specialises in transport engineering publications. So too is David Wilcox, editor of Aztec's Commercial Vehicle Engineer online magazine and former deputy editor of the printed publication Transport Engineer. The Respondent is a qualified transport engineer (registered as an Incorporated Engineer with the Engineering Council) as well as a Fellow of the Chartered Institute of Logistics and Transport. He has been a transport engineer for nearly 40 years and well known as a transport engineering journalist for more than 30 years.

The Complainant has existed only since 2000, formed by a controversial merger of IRTE and IPlantE. IRTE and IPlantE no longer exist as separate legal entities. So any direct connection between the Complainant and the term "transport engineer" cannot go back any more than ten years.

Aztec was responsible for the content of the magazine Transport Engineer from 1994 to 2009, retaining full editorial control and ownership of all copyright in the

contents throughout that time. Its rights have been asserted on the contents page of every issue of Transport Engineer produced by Aztec.

It is not true that the Respondent registered the Domain Name as a result of the publishing contract or that it was used solely for the support and promotion of Transport Engineer magazine.

The Domain Name has hardly ever been used to support and promote Transport Engineer magazine or any other Complainant publication. Perhaps deliberately, the Complainant is confusing the Domain Name with transportengineer.co.uk, the subject of a separate Nominet dispute.

None of the contracts between Aztec and the Complainant contains any reference to any domain names.

The Domain Name was acquired and registered by the Respondent because he recognised and was responding to growing use of the internet by the transport engineers for whom he produces various publications such as Fraikin guides, Truck and Bus Builder and the FTA's Freight magazine. It made sense to register a descriptive term to link to websites dealing with transport engineering matters in general and publicising in particular the Respondent and Aztec's activities in the field of transport engineering.

The Domain Name has been pointed to the website of Aztec from the outset in 2006.

Since 2004 the separate domain name transportengineer.co.uk has been pointed to an Aztec website with the full knowledge of the Complainant. Screenshots from 2004 – 2006 show that the name TRANSPORT ENGINEER is firmly linked to the name "Aztec Media Services" on the website heading.

The use made of any website associated with the Domain Name has been decided entirely and exclusively by the Respondent. The Complainant has never had anything to do with this domain name. All costs related to the Domain Name and associated websites have been borne by the Respondent.

There was an abortive complaint to Nominet from the Complainant about the Domain Name last year but the Complainant failed to meet the deadline for expert decision payment. Apart from this, there has been no previous complaint in four years from the Complainant or anyone else either about our registration of the Domain Name or about its use on the Aztec Media website to which it is linked.

Now the Complainant has set up another website at www.transportengineer.org.uk, apparently aimed at a wider audience of transport engineers. This domain name was registered in February 2009. The publishers of this website are infringing copyright of Aztec / the Respondent. In a similar way, this complaint is an attempt by the Complainant to acquire the benefit of any goodwill built up in the Domain Name by Aztec / the Respondent.

The Complainant recognises that when Aztec was responsible for the content of the magazine Transport Engineer it was "renowned for its independent viewpoint and for its authoritative reporting, news analysis and comment."

If the term "transport engineer" has acquired any secondary meaning related to the publication of that name (which is strongly disputed), any goodwill attached to that secondary meaning must at the very least be shared with the contract publisher responsible for the publication and its editor.

It is not true that the Respondent's continued ownership of the Domain Name is "potentially confusing to members, advertisers and customers...."

The Complainant should try to tell that to the hundreds of thousands of transport engineers who have never heard of the Complainant or its "professional sectors".

The Domain Name now points to the Aztec online magazine Commercial Vehicle Engineer. This is aimed primarily at transport engineers and fleet managers so it is perfectly legitimate and sensible to point the Domain Name at it.

To borrow a phrase in a passing-off trial, not even "a moron in a hurry" could confuse Commercial Vehicle Engineer with any Complainant publication, including Transport Engineer.

The Respondent has no reason to wish to be associated with the Complainant, by mistake or otherwise. This complaint by the Complainant is an attempt at "reverse domain name hijacking".

Reply

From its registration in 2006, up until the end of the contract in early December 2009, the website hosted at www.transport-engineer.co.uk has been used to raise awareness of and promote Transport Engineer magazine.

From the date the Domain Name was registered in 2006, the Complainant's members and the general public would have only associated the Domain Name with Transport Engineer magazine.

It is untrue that the Domain Name has hardly ever been used to support and promote Transport Engineer magazine or any other Complainant publication. The front cover of the November 2009 edition of Transport Engineer magazine, and a summary of its contents, are clearly displayed on the website homepage.

The Domain Name was chosen and registered because Transport Engineer is, and has been, the title of the Complainant's official magazine since 1970.

The Domain Name would not have been registered if the Respondent / Aztec had not been under contract to produce Transport Engineer magazine.

SOE would never have allowed or agreed to Respondent / Aztec registering and operating the Domain Name had it not been used to promote Transport Engineer magazine from its registration.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of “rights” is clarified and defined in the Policy in the following terms:

“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”

Proof of rights

The Complainant relies on unregistered rights in the term “Transport Engineer” arising from the longstanding use of that name as the title of its magazine. The Complainant says that this magazine is distributed monthly to its “IRTE Professional Sector” which currently has approximately 11,000 members worldwide.

At this point, it is helpful to refer to the “Expert Overview” document published on Nominet’s website to assist those involved in DRS proceedings by explaining how experts have dealt with commonly raised issues in the past (including where they differ).

The Overview states at paragraph 2.2:

“2.2 What is required for a Complainant to prove that he/she/it “has rights” in paragraph 2(a)(i) of the Policy?”

As indicated above, the relevant right has to be an enforceable right (i.e. a legally enforceable right). Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist. The Expert will not expect the same volume of evidence as might be required by a court to establish goodwill or reputation, but the less straightforward the claim, the more evidence the better (within reason – this is not an invitation to throw in the ‘kitchen sink’)...

If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not

insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results).”

Despite this, the Complainant has provided little evidence in support of its assertion as to the existence of rights. For example, the Complainant says the magazine generates advertising revenue but provides no figures, let alone supporting evidence.

The Complainant does, however, provide a link to an ABC (Audit Bureau of Circulation) certificate showing that in 2009 the average circulation of the magazine was approximately 10,800 per month. (Paragraph 16(a) of the Procedure says that the Expert may look at any websites referred to in the Parties’ submissions.) This supports the Complainant’s assertion as to the level of circulation of its magazine. The Respondent does not dispute these circulation statistics.

What the Respondent does contest is the assertion that the Complainant’s “connection” with the term “transport engineer” can predate the Complainant’s formation in 2000. However, the Complainant says that all assets of IRTE including the magazine (presumably extending to the then-existing goodwill in the magazine title) were transferred to the Complainant in 2000. It would have been helpful if the Complainant had provided evidence of this assignment but nonetheless it seems reasonable to infer in the circumstances that such an assignment did take place.

Secondary meaning

Is such use by the Complainant sufficient to constitute rights?

The Respondent says that the term “transport engineer” describes a person who works in or is interested in the engineering aspects of transport. He claims that there are hundreds of thousands of transport engineers in the UK involved in road transport and that when one expands this to other forms of transport, the list is almost endless. The Respondent contrasts this with the number of “transport engineers” in the Complainant’s membership which he states to be “fewer than 11,000 and falling”. He adds that he himself is a transport engineer.

It is obvious that the term is descriptive. The Respondent argues that it is so descriptive that it is doubtful whether it could ever acquire a “secondary meaning” (as envisaged by the definition of “rights” above).

I disagree. In my view, by virtue of the long-standing use of term “Transport Engineer” for the title of a magazine distributed monthly to some 11,000 readers, the Complainant has shown that it has acquired a reputation in that name such that a significant part of the relevant public would associate it with the Complainant’s product.

The Respondent says that such a conclusion would give the Complainant exclusive rights in the words "transport engineer" and preclude any legitimate transport engineers from describing themselves in this way.

See, however, *DRS 7195 (machinebuildingsystems.co.uk)* where the Expert stated:

"I conclude that the Complainant has established a reputation in the name "Machine Building Systems" as a source of products used by machine builders and that it has common law trademark rights in that name despite the fact that that expression (without the capital initial letters) is used by some of its competitors to describe such products. Those rights could, in principle, enable the Complainant to restrain use by others of that name to pass themselves off as the Complainant but not to restrain use by others of those words merely to describe products used by machine builders."

Similarly, it seems to me that the Complainant could restrain use by others of the name "Transport Engineer" to pass themselves off as the Complainant whereas it could not restrain a purely descriptive use of those words.

It is also worth noting that there is a low threshold to establish "rights" under the DRS. See, eg, the recent decision in *DRS 8195 (erac.co.uk)*.

Ownership of copyright in content of magazine

The Respondent claims that it was responsible for the content of the magazine Transport Engineer from 1994 to 2009 and that it owned all copyright in the content of the magazine. It says that if (which it denies), the term "transport engineer" has acquired any secondary meaning, any goodwill attached to that secondary meaning must at the very least be shared with the contract publisher responsible for the publication and its editor.

But, as is stated in a number of versions of the magazine's "information page", the Complainant is the "publisher" of the magazine. The Complainant clearly owns the rights in the magazine title "Transport Engineer". The Respondent / Aztec are simply producing and editing the publication under contract with the Complainant. I see no evidence indicating that the Respondent / Aztec should be treated as anything other than licensees of the Complainant or that there is any reason as to why goodwill in the name should be considered to accrue to either.

The question of ownership of copyright in the magazine's content is also irrelevant. We are concerned here with rights in the magazine's name, not its content.

Rights – conclusion

For the reasons stated above, I conclude that the Complainant has demonstrated rights in the name "Transport Engineer" and that this is similar to the Domain Name, differing only by a hyphen between the words in the Domain Name.

Abusive registration – introduction

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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.”*

Here, the Complainant does not suggest that the Domain Name was acquired in an abusive manner. The Complainant's case turns on the use by the Respondent after the end of the contract between the Complainant and Aztec (ie under the second limb of the above definition).

However, before assessing the later use of the Domain Name, it is helpful to consider the circumstances surrounding the acquisition of the Domain Name and its use during the period of the contract.

Circumstance surrounding the acquisition of the Domain Name

Since 1995, the Complainant and its predecessor outsourced production of the magazine to Aztec. (It is not in dispute that this company is controlled by the Respondent. Accordingly, for the purpose of this decision, I will treat the Respondent and Aztec interchangeably.)

The Respondent registered the Domain Name on 22 October 2006.

The Complainant says that the Domain Name was registered “as a result” of the publishing contract and that it was used solely to promote “Transport Engineer” magazine from date of registration.

The Respondent denies this. He claims none of the contracts between Aztec and the Complainant contains any reference to any domain names. The Respondent has produced the most recent contract dated 2007 and certainly that one makes no mention of the Domain Name.

The Respondent claims that he registered the Domain Name because he was responding to growing use of the internet by the transport engineers for whom he produces various publications such as Fraikin guides, Truck and Bus Builder and the FTA's Freight magazine. He says that it made sense to register a descriptive term to link to websites dealing with transport engineering matters in general and publicising in particular the Respondent's and Aztec's activities in the field of transport engineering.

Use of the Domain Name during the contract

It is useful to compare this claim by the Respondent with the evidence as to the actual use of the Domain Name during the period of the contract.

The Complainant says that the Domain Name was used solely for the support and promotion of Transport Engineer magazine until the end of the publishing contract (ie some three years).

The Respondent, however, says that the Domain Name has hardly ever been used to support and promote Transport Engineer magazine or any other Complainant publication. The Respondent suggests that the Complainant is confusing the Domain Name with transportengineer.co.uk, apparently the subject of a separate Nominet dispute.

The Respondent suggests that other publications produced by the Respondent relating to transport engineers “have been referenced using the domain name transport-engineer.co.uk”. The Respondent also says that the Domain Name has been pointed to “the website of Aztec” from the outset in 2006.

These statements by the Respondent are unclear. He provides no detail about which other publications have been allegedly been “referenced” using the Domain, let alone any screenshots. Nor does he explain what he means by “the website of Aztec”. Is it the Aztec / Respondent website connected to the Domain Name which was in fact used to promote the Complaint’s publication (see below)? Or some other website?

The only screenshot of a website at the Domain Name during the period of the contract is one from November 2009 provided by the Complainant:

In this version, the header on the homepage contained the name “Transport Engineer” in a stylised form on the left and the name Aztec Media Services Ltd is shown on the right.

There was a “welcome” paragraph at the top of the homepage as follows:

“Transport Engineer is the top technical monthly for transport engineers and fleet managers, offering a unique combination of analysis, comment and news on the commercial vehicle market and aftermarket. CLICK ON JOBS FOR THE LATEST VACANCIES INCLUDING ...”

Beneath this, next to an image of the cover page of the printed version of the magazine, there was a heading “Transport Engineer: November 2009 Contents” followed by a summary of the contents of the magazine under the various headings such as “Comment”, “Letters”, “News” etc. A list of “useful links” appears on the right. The top two links are “Aztec Media Services” and “Society of Operations Engineers”.

To me, the overwhelming impression from the website is that it is the official website for the Complainant’s publication. I do not consider that this impression is in any way weakened by the use of the Aztec name in the header. Even if users were to notice this, Aztec was at that time contracted to publish the magazine and indeed its name was used on the information page in the printed magazine. It therefore seems natural for its name to appear on an “official” website also.

In view of the lack of clarity in the Respondent's account and of the absence of evidence supporting its claims, I conclude on the evidence before me and on the balance of probabilities that, from registration in 2006 until termination of the contract, the Domain Name has in fact been used solely to promote the Complainant's publication and also that this was in a form which implied to the public that it was the official website of that publication.

The domain name transportengineer.co.uk

As mentioned above, the Respondent suggests that the Complainant is confusing the Domain Name with transportengineer.co.uk which, he implies, has indeed been used to promote the magazine.

He also states that since 2004, transportengineer.co.uk has been pointed to "an Aztec Media Services website" and that this was with the full knowledge of the Complainant. He provides archive screenshots dated 21 July 2004, 5 February 2005, and 3 August 2006 and states that these are evidence showing that the name "TRANSPORT ENGINEER" is linked on the website header to the name Aztec Media Services.

Yet all of these three screenshots show websites which are identical in format to the November 2009 printout of the website at the Domain Name, mentioned above.

The Respondent's production of these archive screenshots relating to transportengineer.co.uk contrasts with the absence of evidence from the Respondent concerning use of the Domain Name itself.

Use of the Domain Name after the contract

Following the termination of the contract, the Respondent used the Domain Name to promote its own online magazine called "Commercial Vehicle Engineer" aimed at transport engineers and fleet managers.

The Complainant has exhibited a version of the site at the Domain Name as of March 2010.

While the colour scheme had changed, the template and structure of the site remained identical to the way it looked when it was used to promote the Complainant's magazine. The stylised name "Transport Engineer" on the left of the header was replaced with the stylised name "Commercial Vehicle Engineer".

The "welcome" paragraph was very similar to the previous version (see above):

"Commercial Vehicle Engineer is the new online monthly for transport engineers and fleet managers, offering a unique combination of analysis, comment and news on the commercial vehicle market and aftermarket. The March issue is now online. To subscribe click on the page-turning icon below. CLICK ON JOBS (LEFT) FOR THE LATEST VACANCIES, INCLUDNG..."

The image of the cover page of the Complainant's publication was replaced with what looked like an image of the cover page of the printed version of a magazine

entitled “Commercial Vehicle Engineer” (notwithstanding that this publication is said to be an online one). There was a summary of contents in similar format to that used previously, including headings such as “Comment”, “Letters”, “News”.

Paragraph 3(a)(ii) of the Policy

The gist of the Complainant’s case is that the Respondent’s use of the Domain Name after the end of the contract was potentially confusing to members, advertisers and customers, who might visit the website to find out information about the Complainant’s magazine as they had done in the past and that this was potentially very damaging for the Complainant, its members and its charitable aims.

Paragraph 3 of the Policy enumerates a number of non-exhaustive factors which may be evidence that a domain name is an abusive registration. Paragraph 3a(ii) is the most relevant:

“ii. 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”

Borrowing a phrase from a well-known passing-off case, the Respondent says that, not even “a moron in a hurry” could confuse Commercial Vehicle Engineer with any the Complainant publication, including Transport Engineer.

However, given the Respondent’s use of the Domain Name for some three years as an official (or at least official-looking) site for the Complainant’s publication (as I have concluded above), I consider that the Respondent’s subsequent use of a virtually identical site for its own competing publication is very likely to confuse people or businesses into believing that the Domain Name is connected with the Complainant. I think it inevitable that users will continue to visit the site seeking the Complainant’s publication and, given the nature of the site, will assume that there is a connection with the Complainant.

I do not believe that this likelihood is any way diminished by the continued appearance of the Aztec name on the top right of the header. On the contrary, it may enhance the confusion on the part of those who noticed that same name previously when the site was used for the Complainant’s publication.

Paragraph 4(a)(ii) of the Policy

Paragraph 4a(ii) is a factor which may be evidence that a domain name is not an abusive registration:

“ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it”

Paragraphs 4.7 and 4.9 of the DRS Expert Overview are relevant here:

“4.7 Is it possible for a Respondent to make fair use of a domain name where (a) that name is also the Complainant’s trade mark and (b) the Respondent’s use of the domain name is causing confusion?”

Another use, which may not be regarded as unfair within the terms of the DRS Policy, is where the Complainant’s name or mark is a dictionary word or a combination of dictionary words and not well-known and the Respondent reasonably registered and has been using the domain name in ignorance of the Complainant’s rights. In such circumstances, if the confusion is likely to be very limited, an Expert might conclude that it would be unjust to deprive the Respondent of his domain name. [The Appeal decision in DRS 04889 (wiseinsurance.co.uk)]. However, there is a view among some Experts (albeit a minority) that a confusing use which is likely to constitute trade mark infringement cannot be anything other than unfair.”

“4.9 Can use of a purely generic or descriptive term be abusive?”

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration. A helpful discussion is found in DRS 04884 (maestro.co.uk) where the Appeal Panel observed "Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy".”

It is clear from both of these paragraphs that even purely generic or descriptive terms can be abusive. The relevance is that the more generic / descriptive the term, the higher degree of evidence that will be required to show that a respondent was aware of a complainant’s rights. But, here, the Respondent was obviously well aware of the Complainant’s rights.

The Respondent argues that it is perfectly legitimate and sensible to point the Domain Name to a magazine which is aimed primarily at transport engineers and fleet managers. But, given the background to this case, it is difficult to conceive that the Respondent in fact elected to use the Domain Name for this purpose based on its generic or descriptive qualities rather than to capitalise on the Complainant’s rights.

Alleged infringement of the Respondent’s copyright

The Respondent argues that a website set up by the Complainant at www.transportengineer.org.uk in February 2009 infringes the copyright of Aztec / the Respondent. I do not have sufficient information to come to a conclusion on this point but, even if I did, I do not see the relevance to the issues in this case.

Abusive registration – conclusion

In the circumstances outlined above, the Domain Name is an abusive registration in that it has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

7. Decision

I find 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. I therefore decide that the Domain Name transport-engineer.co.uk should be transferred to the Complainant.

Signed: Adam Taylor

Dated 25 May 2010