

## **DISPUTE RESOLUTION SERVICE**

**D00015757**

### **Decision of Independent Expert**

Lafarge Tarmac Trading Limited

and

Smart Numbers LTD

#### **1. The Parties:**

Lead Complainant: Lafarge Tarmac Trading Limited  
Portland House  
Bickenhill Lane  
Birmingham  
West Midlands  
B37 7BQ  
United Kingdom

Respondent: Smart Numbers LTD  
20-22 Richfield Ave  
Reading  
Berkshire  
RG1 8EQ  
United Kingdom

#### **2. The Domain Name(s):**

watfordpavingandtarmac.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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

07 April 2015 11:25 Dispute received  
07 April 2015 14:19 Complaint validated  
07 April 2015 14:24 Notification of complaint sent to parties  
15 April 2015 13:35 Response received  
15 April 2015 13:36 Notification of response sent to parties  
20 April 2015 02:30 Reply reminder sent  
22 April 2015 08:44 Reply received  
22 April 2015 08:45 Notification of reply sent to parties  
22 April 2015 08:45 Mediator appointed  
27 April 2015 10:38 Mediation started  
17 August 2015 10:32 Mediation failed  
17 August 2015 10:32 Close of mediation documents sent  
28 August 2015 02:30 Complainant full fee reminder sent  
01 September 2015 12:04 Expert decision payment received

### **4. Factual Background**

The Complainant is the successor in title to Tar Macadam Syndicate Ltd, founded in 1903. It is the owner of various trade mark registrations for the word TARMAC, including UK No 254287, registered in 1903 for “*tarred slag for use for making roads and pavement and for construction purposes and tar concrete*” and has provided products and services under that mark to the construction sector, including via licensed companies that have incorporated the mark into their name, Tarmac Central Limited and Tarmac Southern Limited, by way of example.

The Domain Name was registered on 9 July 2014. The Response identifies that the Domain Name was registered by Scott Woolaway who is a sole trader, trading as Watford Paving & Asphalt Services and who

provides paving and landscaping services in the Watford area. The Domain Name is pointed to the Respondent's website where one of the services provided is identified as "Tarmac Driveways", with the materials used to provide a driveway surface variably referred to as "Tarmac" and "Tarmacadam".

The Complainant asserts that until recently the Respondent used the word "Tarmac" in his trading name, but dropped this recently following legal correspondence from the Complainant in which it demanded that the Respondent cease such use, including within the Domain Name.

## **5. Parties' Contentions**

### **a. The Complaint**

The Complainant asserts that it has Rights in the word TARMAC arising from its trade mark registrations and its extensive use as a company name for the provision of goods and services, and that the Domain Name incorporates a name in which it has Rights.

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

1. People are likely to be confused into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.
2. The website to which the Domain Name is pointing takes unfair advantage of and/or is detrimental to the reputation of the Complainant's rights.
3. Because of the Complainant's practice of licensing the TARMAC mark to group companies to be used in conjunction with a geographical descriptor, it is more likely than not that the Respondent's use will be mistaken for one of the Complainant's operating companies.

### **b. The Response**

The Respondent asserts that 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 Respondent but uses the term so that the public will recognise a material that is used in the provision of the Respondent's services.

c. The Reply

The Complainant asserts that the Respondent recently ceased using the word TARMAC in its trading name and that this is an acceptance of the Complainant's Rights.

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.

The Complainant expends significant sums of money each year in marketing and providing services under the TARMAC mark. Some businesses, usually smaller ones with limited legal knowledge, misunderstand the nature and scope of the TARMAC trade mark, which leads to situations like the present one. The Complainant allocates financial and other resources each year to educate the market and to undertake enforcement. Larger businesses refrain from using the mark.

## **6. Discussions and Findings**

a. General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name; and

- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

b. Complainant's Rights

The DRS Policy defines Rights 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 is the proprietor of the trade mark registration(s) referred to above. That registration is subsisting as at the date of the Complaint, and notwithstanding the views that I express below, in circumstances where a trade mark registration subsists as at the date of the Complaint, it clearly meets the definition of Rights as set out in the DRS Policy and as such, in my view the Complainant has shown that it has Rights as a result of its trade mark registration(s).

For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one should ignore the .co.uk suffix. The comparison is therefore between 'WATFORDPAVINGANDTARMAC' on the one hand and 'TARMAC' on the other. In my opinion the inclusion of the latter in the former is sufficient for me to be able to conclude that the Complainant has established that it has Rights in a mark similar to the disputed Domain Name.

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration. In doing so, I would stress that the assessment that I must make, is whether the Domain Name is abusive when judged against the criteria set out in the Policy, and not whether the Domain Name infringes the Complainant's rights in law.

The Policy defines an 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"*

and goes on to set out a (non-exhaustive) list of factors which may evidence that a domain name is an Abusive Registration, or not.

The Complainant asserts that the Domain Name is an Abusive Registration because it will be taken as being associated with the Complainant, or it takes unfair advantage of or causes detriment to the Complainant's Rights.

DRS Case 4331 (*Verbatim*) addressed the relevance of knowledge and intention in determining whether a domain name is an Abusive registration.

It listed the following factors:

- (1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.*
- (2) Secondly, 'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.*
- (3) Thirdly, 'intention' is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- (4) Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the*

*registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*

- (5) *Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.*

The following provisions of the DRS would seem to be particularly relevant to the Response put forward by the Respondent:

*“4(a)(i) Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*

*A. 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” and*

*“4(a)(ii) The Domain Name is generic or descriptive and the Respondent is making fair use of it”.*

Whilst I think it quite likely that the Respondent would have been aware of the Complainant when registering the Domain Name given the nature of its business, I do not think that knowledge of the Complainant or its Rights would necessarily make the registration abusive of itself.

It therefore seems to me that the issue to be resolved in this complaint boils down to whether or not the Respondent is using the Domain Name in a manner which is intended to be, or is taken by the public to be a reference to the Complainant, or whether it is using the word complained of as a description of its services.

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.

For the Complainant to succeed in its complaint, it would have to prove that on the balance of probabilities the use made by the Respondent was not in respect of a genuine offer of goods or services, or descriptively and fairly. The Complainant has not provided any evidence to support the contention that the Domain Name was adopted intentionally by the Respondent to take unfair advantage of the Complainant's Rights (or cause detriment), and nor has it provided any evidence in support of its allegation that the Respondent's business will be mistaken for one of the Complainant's. From the evidence that I have seen, the Respondent is using the word TARMAC to describe a genuine offering of services. In that respect, I do not consider that the change of name by the Respondent to drop the word TARMAC following legal correspondence from the Complainant, is an acceptance of any wrongful conduct or intention by the Respondent, but is more likely the impact of a small business receiving a threat from a large company, and the potential financial consequences to it thereof.

I would point out that in coming to this conclusion, I am not reaching any view on the validity or otherwise of the Complainant's trade mark registration(s). As I have said above, the DRS is a contractual process which is governed by the Policy, and in my opinion the Complainant has failed to persuade me that the Domain Name is an Abusive Registration in accordance with the provisions of the Policy.

## **7. Decision**

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is similar to the Domain Name <watfordpavingandtarmac.co.uk>, however I do not find that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore fails.

**Signed Simon Chapman**

**Dated 14 September 2015**