

## **DISPUTE RESOLUTION SERVICE**

**D00024127**

### **Decision of Appeal Panel**

Tarmac Group, including Tarmac Trading Limited

and

Mr Wesley Mahoney

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

Complainant: Tarmac Group, including Tarmac Trading Limited  
c/o Freeths LLP  
The Colmore Building  
20 Colmore Circus  
Queensway  
Birmingham  
West Midlands  
B4 6AT  
United Kingdom

Respondent: Mr Wesley Mahoney  
Kerak  
Chalkhouse Green Road  
Reading  
RG4 9AS  
United Kingdom

#### **2. The Domain Name:**

The domain name in issue is readingtarmac.co.uk (the **Domain Name**).

### 3. Procedural History

The original Complaint in this case was submitted on 18 October 2021. Nominet duly notified the Respondent of the Complaint, but he did not file a Response. The Complainant opted for a summary decision and paid the relevant fee.

Michael Silverleaf (the **Expert**) issued a summary decision in favour of the Respondent on 3 December 2021 (the **Decision**).

The Complainant submitted an appeal notice on 21 December 2021 and the Respondent submitted a brief appeal response on 10 January 2022.

Anna Carboni, David King and Philip Roberts were appointed as the appeal panel (the **Panel**) on 19 January 2022. They have each confirmed that they are independent of each of the parties and that there are no past, present, or foreseeable facts or circumstances that need to be disclosed which might call their independence into question.

### 4. The Nature of This Appeal

In accordance with paragraph 20.8 of the Policy, the Panel will consider this appeal by conducting a full review of the matter. Neither party has attempted to present any new evidence on appeal, so the case proceeds as a re-determination on the merits, taking account of the Expert's comments and the parties' respective appeal submissions as well as the original Complaint (with annexed documents), which are all set out or summarised below.

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

### 5. Formal and Procedural Issues

This case is dealt with under Nominet's current UK Dispute Resolution Service Policy, in effect since 1 October 2016 (the **Policy**). Terms that are defined in the Policy have the same meaning when used in this decision, unless otherwise indicated.

The Panel refers to the **Experts' Overview** (or, simply, **Overview**), the document published under that name on Nominet's website, which discusses commonly raised issues under the Policy and explains how Experts have dealt with those issues in the past, highlighting areas of consensus and those where Experts' views differ.<sup>1</sup>

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<sup>1</sup> The current version of the Experts' Overview is version 3, dated December 2016, found here: <https://nominet.uk/wp-content/uploads/2018/09/24124932/expert-overview.pdf>.

The Experts' Overview does not cover all the issues that need to be examined in this case, some of which are more familiar in the context of trade mark claims in court or before an IP office. But in relation to such points the Panel bears in mind the following extract from the foreword by Nick Gardner, Chair of the 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...*

The last point to mention in this section is that this case follows numerous others in which the Complainant (or a predecessor) has filed a DRS complaint in respect of domain names containing the term "tarmac" (**tarmac cases**). Several of these have led to expert decisions, and one reached an appeal decision dated 29 April 2020 in the case of Tarmac Trading Limited v Maurice Birch (D00021275) concerning the domain name <tarmacdrivewaysplymouth.co.uk> (the **Plymouth case**), which has some similarities to the present case.

Paragraph 20.12 of the Policy provides that, "*Appeal decisions will not have precedent value, but will be of persuasive value to Experts in future decisions*".

The foreword to the Overview states:

*While there is no system of precedent under the DRS Policy, for the DRS Policy to be effective there has to be a measure of consistency in the decisions and the panel of Experts does its best in that regard, although, as will be seen below, there are a few areas where differing views prevail. If anyone involved in a dispute under the DRS Policy proposes to rely upon the rationale of any previous DRS decision, the more recent decisions (particularly at appeal level) are more likely to represent current thinking.*

The Panel takes from these extracts that it is not bound by the reasoning or outcome of any of the other tarmac cases, including the Plymouth case. But it is appropriate to review the decisions issued in the tarmac cases to date, and to pay particular attention to the Plymouth case, given that it is both recent and an appeal.

## **6. The Facts**

The only named Complainant is Tarmac Trading Limited, English company registration number 00453791. The Complainant owns several trade mark registrations for the word TARMAC, including UK trade mark no. UK00000254287, registered since 1903 in respect of "tarred slag for use for making roads and pavements and for construction purposes and tar concrete". The Complainant uses TARMAC as a trade name in connection with its very substantial business in construction products and services.

In the year ending 31 December 2019, the Complainant's turnover was £2.13 bn and, in each of the preceding 4 years, its turnover exceeded £2 bn.

The Respondent is an individual based near the town of Reading in England, who advertises and promotes his business as a "local tarmacadam contractor" via a website hosted at the Domain Name (the **Website**). The Respondent uses both the initials "RT" and the name "Readingtarmac" on the Website to identify his business.

The Domain Name was registered on 11 May 2020 in the name of Domain by Proxy LLC. It is not clear if this was done on behalf of the Respondent at the time, but it was plainly controlled by the Respondent by at least some time in July 2020.

The Complainant wrote to the Respondent on 30 July 2020 and 30 September 2020, complaining about (among other things) the use of the Domain Name. The Respondent did not reply, but made some subsequent changes to the Website.

## **7. The Complaint**

The Respondent failed to file a Response to the Complaint and the Complainant opted to apply for a summary decision under Section 12 of the Policy. There was, therefore, no recitation of the Complainant's contentions in the body of the Decision. These are therefore summarised here, before setting out how the Expert dealt with the matter, followed by the parties' respective submissions on appeal.

The Complainant claims to be the UK's leading sustainable building materials and construction solutions business and the successor in title to the original Tar Macadam Syndicate Ltd, founded in 1903. It is the owner of numerous trade mark registrations for the word TARMAC, including the UK trade mark mentioned in section 6 above. The name TARMAC has been part of its company name since 30 July 1987. Through its own activities under the name TARMAC and those of its group companies, it has generated and now owns enormous goodwill and reputation in the TARMAC name in relation to construction and surfacing products and services.

The Complainant presents impressive financial results. The turnover figures set out in section 6 above are confirmed in a FAME report contained in Annex 3 to the Complaint. The Complainant also provides a copy of its website at <tarmac.com> in Annex 4 to the Complaint with information and further detail about the Complainant's business and history. The Complainant's home page states "*We are the UK's leading sustainable construction materials, road contracting and building products business*". The website contains various links to information on the Complainant's products and services.

The above facts and supporting exhibits are relied on by the Complainant to support its claim to own earlier Rights in the mark TARMAC (within the meaning of the Policy), which is incorporated in the Domain Name. The Complainant then asserts

that the Domain Name is an Abusive Registration because its registration took unfair advantage of those Rights and its use has taken unfair advantage of and/or has been unfairly detrimental to such Rights. It also claims that 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.

The Complainant says the Domain Name came to its attention in the context of its regular monitoring and enforcement activities, and assumes that, despite being formally registered in the name of Domain by Proxy LLC, of Scottsdale, Arizona, USA, the true registrant of the Domain Name is the entity listed on the Website, Reading Tarmac of 549 Oxford Road, Reading. It sent letters to the Respondent on 30 July 2020 and 30 September 2020 and various emails between 22 October 2020 and 30 November 2020, complaining about various issues including their use of the Domain. The Respondent subsequently removed certain references to the TARMAC trade mark on their website but not all, but no response was received.

The Complainant explains its objection to the registration and use of the Domain Name as follows:

- The Domain hosts a website promoting road surfacing and similar surfaces provided by the Respondent's business under the sign READING TARMAC.
- The Domain itself incorporates the Complainant's registered trade mark TARMAC in conjunction with the word READING which is descriptive and therefore non-distinctive. The presence of the TARMAC mark as the distinctive element in the Domain, in conjunction with the underlying website which promotes services under the TARMAC sign, renders it more than 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 business operated via the Website holds itself out as being successful, purporting to be a well-established company operating in Reading. Those claims are (in conjunction with the use of the Domain) part of a factual matrix which make it more likely than not that the website would be mistaken for one connected to the Complainant.
- In all the circumstances, the Complainant considers that the Domain is being used in conjunction with the unauthorised marketing and provision of services, which infringe its registered trade mark and other rights.
- Furthermore, following the well-established reasoning in the case of *British Telecommunications v One in a Million Ltd* [1999] 1 WLR 903, the mere appearance of the Respondent's name on the publicly accessible records relating to the Domain amounts to a misrepresentation which is likely to deceive the public into believing that the Domain is under the control of the Complainant.

- The unauthorised use of the TARMAC trade mark (in the name of the Domain and on the website hosted at the Domain), 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.
- Even if a consumer intending to access a website owned by the Complainant perceives something is amiss when they find themselves on the Respondent's website, the distinctive character and reputation of the TARMAC trade marks are harmed by association in any event due to a frustration that they have not arrived at the website they intended. If they do not perceive anything is amiss, this could potentially lead to lost business for the Complainant. In all the circumstances, there is a detrimental impact on the business of the Complainant.
- The longer the Respondent holds and controls the Domain, the more damage and loss will be caused to the Complainant's business and reputation.
- It is evident that the Complainant's name is being used in the Domain Name to attract web traffic to the Respondent's website from users that are attempting to access domains associated with the Complainant.
- In all the circumstances, the Respondent is taking unfair advantage of the Complainant's Rights in the TARMAC trade mark. The registration of the Domain incorporating the TARMAC trade mark was undertaken with a view to exploit the Complainant's trade mark rights and substantial goodwill and reputation to generate income for the Respondent for the purposes of commercial gain.

Based on the above submissions, the Complainant asked for the Domain Name to be transferred to it.

As mentioned above, the Respondent did not file a Response to the Complaint.

## **8. The Expert's Decision**

The form of a summary decision identifies the parties and the domain name in issue and then requires the Expert to give yes/no answers to the following four questions:

- 1) whether they are satisfied that Nominet sent the complaint to the Respondent in accordance with the Policy;
- 2) whether the Complainant has shown rights in respect of a name or mark which is identical or similar to the domain name in issue;
- 3) whether the Complainant has shown that the domain name is an Abusive Registration; and
- 4) whether they are satisfied that no other factors apply which would make a summary decision unconscionable in all the circumstances.

In this case the Expert answered “yes” to the first, second and fourth question, but “no” to the third – i.e. the Complainant had not persuaded him that the Domain Name is an Abusive Registration. On that basis he refused the Complainant’s application and ruled that the Domain Name should remain with the Respondent.

Although there is no requirement to explain the reasoning behind a summary decision, there is a space on the form for optional comments, which the Expert chose to use in this case. He explained his decision as follows:

*The complainant's trade mark TARMAC, despite having long been registered as a trade mark, is a well-known word in the English language which is wholly descriptive of the product used to surface roads and aircraft runways and is used as a verb to describe the process of laying those surfaces. All the major English dictionaries list the word tarmac with these meanings. Some but not all of them note that it is a registered trade mark. In these circumstances, the complainant cannot object to such use of the word, whether as part of a domain name or otherwise.*

*It is apparent both from the content of the complaint and other decisions in relation to domains containing the word "tarmac" (e.g. the decision of Steven Maier in DRS 21282 which refers to a previous decisions going either way) that the question of whether or not the registration is abusive will depend upon whether or not the domain is in fact likely to take unfair advantage of the complainant's trade mark registration or whether in reality it is an essentially descriptive use of the words "reading" and "tarmac" in conjunction to indicate that the respondent's business is a tarmac contractor in the Reading area.*

*The limited information in the complaint does not of itself support a conclusion that the domain is abusive or that it will lead to the kinds of association with the complainant's business which are suggested. In particular, it is not explained how the complainant became aware of the registration and the respondent's use of it. Nor has the correspondence between the parties to which reference is made in the complaint been provided. Nor have any particulars been given of the changes which were made to the respondent's website following that correspondence been provided. Nor is there any evidence or indication that there has been confusion of the public or that anyone has in fact taken the domain name to indicate a connection with the complainant.*

*The screenshot from the respondent’s website which accompanied the complaint shows that the respondent is using the brand “R|T” and that the respondent is a tarmac contractor in Reading (a location confirmed by his address). In these circumstances and in the absence of such information or any other material to indicate that the domain is being used in a way which would imply a connection with the complainant's business, I am unable to conclude that the registration is abusive.*

*I therefore dismiss the complaint on the basis that the use being made of the individual words "reading" and "tarmac" in the domain and the respondent's website is descriptive. Indeed, the complaint itself almost recognises this when it describes the domain as "incorporat[ing] the Complainant's registered trade mark TARMAC in conjunction with the word READING which [is] descriptive and therefore non-distinctive". That explanation correctly recognises the descriptive nature of the use of the word READING but fails to acknowledge that the word TARMAC is being used in precisely the same way and that the effect is to combine two descriptive (i.e. individually non-distinctive) elements to form a composite trading name or mark.*

## **9. The Parties' Arguments on Appeal**

### Complainant

The Appeal Notice starts by pointing out that, by accepting that the Complainant had "shown rights in respect of a name or mark which is identical or similar to the domain name", the Expert must have accepted a number of the facts presented by the Complainant in support of its claim to own such rights, including that:

- the Complainant has registered trade marks for the word TARMAC, including UK marks dating back over 100 years, none of which has ever been revoked on grounds of genericisation or found invalid on any absolute ground;
- the TARMAC trade marks are used and licensed by the Complainant for its business activities including highway maintenance and road laying/surfacing, and are registered for related goods and services, and the Complainant has enormous goodwill and reputation in relation to its business in the TARMAC brand;
- the Complainant makes significant financial investments to enforce its rights "precisely to avoid the genericisation of TARMAC"

The Complainant also highlights that the Respondent did not challenge any of the Complainant's rights.

The Complainant therefore argues that the Expert was wrong to conclude that the word TARMAC is "wholly descriptive" and that the "Complainant cannot object to such use of the word, whether as part of a domain name or otherwise".

The Appeal Notice goes on to criticise the Expert's comments that the Complaint does not explain how the Complainant became aware of the registration, that there is no evidence that there has been confusion of the public, and that correspondence between the parties has not been provided. In response, it reiterates that the Complainant discovered the Domain Name through its enforcement activities, that actual confusion is not required, and that the correspondence is not relevant for the



assessment of whether the registration is abusive. It also emphasises that the Respondent only removed some, and not all, references to TARMAC on its website.

The Appeal Notice lists the Complainant's key arguments for the Domain Name being an Abusive Registration, in the following terms:

- a. *The domain name used by the Respondent includes as its dominant element, the Complainant's trade mark TARMAC which is used in the same industry and in relation to which, the Complainant has built a significant reputation, as set out above.*
- b. *In doing so, the Respondent's business is highly likely to confuse people/businesses into believing the domain name is connected in some way to the Complainant (e.g. by way of licence). The addition of the geographical location READING (which is descriptive and non-distinctive) is insufficient to alleviate the likelihood of confusion, particularly as the Complainant operates on a national basis.*
- c. *Further, in doing so, the Respondent has and continues to use the domain name to take unfair advantage of the distinctive character and reputation of the TARMAC trade marks without due cause.*
- d. *In this regard, the domain name creates a link with the TARMAC trade marks which takes unfair advantage of their reputation as it will enable the transfer of the reputation of the TARMAC trade marks to the Respondent's business in an unfair and unjust manner.*
- e. *It is inconceivable that the above was not intended by the Respondent when the domain name was registered. This is particularly because the TARMAC trade marks are premier and well-known in the highway maintenance and road laying/ surfacing industry and are associated with the Complainant; this being an industry which the Respondent is very familiar with as it operates in the same. Accordingly, the Respondent will have been well aware of the significance and attractiveness of using the TARMAC brand in its domain name because it would be perceived as a surfacing business connected with the Complainant. The Respondent seeks the commercial benefit of this association without a licence from the Complainant.*
- f. *The Complainant has no control over the quality of the services that the Respondent provides by reference to the domain name, which creates a serious risk of causing damage to its TARMAC trade marks.*

### Respondent

The Respondent filed a brief Appeal Response, as follows:

*I fully support and agree with the initial independent experts findings. One point I would like to make is that we do not use the word "tarmac" at all within our website. The word "readingtarmac" (no space) is used. As far as I am aware Tarmac Limited has no trade mark against this name.*

## 10. Previous “Tarmac” DRS cases

As mentioned above, there have been numerous previous DRS complaints in respect of domain names containing the term “tarmac”, most notably the **Plymouth case**. The Complainant clearly had full knowledge of the Plymouth case when it filed the present Complaint, but there is no indication that the Respondent knew about it. The Panel would expect the Expert, having made express reference to *‘other decisions in relation to domains containing the word “tarmac”*’, to be aware of the Plymouth case though it is not mentioned explicitly in the Summary Decision.

The Panel in the Plymouth case conducted a helpful review of the DRS decisions that had been published up to that point in the tarmac cases, in order to inform their views on how to apply the Policy. In short, they listed six summary decisions that had been issued in favour of the Complainant and summarised three full decisions in favour of the Complainant and one that went the other way. The Panel takes account of that review, which contributed to that Panel’s majority decision in favour of the Complainant. Since then there have been four further Summary Decisions in tarmac cases, one of which is the Decision in the present case. The others can be briefly summarised as follows:

In Tarmac Trading Limited v Robert Stratford (D00023426) <halfpricetarmac.co.uk>, the Expert found for the Complainant, stating that his decision was “in line with the majority view expressed in the Appeal in [the Plymouth case] *“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...”*

In Tarmac Trading Limited v S. Matthew Paving (D00023847) <tarmacaberdeen.co.uk>, the Expert stated that she had taken careful note of the Appeal Panel’s reasoning in the Plymouth case and commented as follows: *“The domain names involved in that case and this are clearly sufficiently similar that the reasoning of the Appeal Panel is highly relevant. Indeed, I consider that there is nothing material to distinguish between the cases which would justify a different finding here. I have therefore reached this decision in accordance with the reasoning of the Appeal Panel in the afore-mentioned case.”*

The Panel in the present case notes that the form of the domain name in the case immediately above was extremely similar to this one, being a combination of a town name with the word “tarmac”, albeit in the opposite order.

Finally, in Tarmac Group, including Tarmac Trading Limited v Fundacion Comercio Electronico (D00024167) <tarmacbluecircle.co.uk>, the Expert stated: *“The disputed domain name incorporates the Complainant’s two marks, TARMAC and BLUE CIRCLE, rendering it likely that an inference may be drawn by internet users that the Respondent’s domain is associated with the business of the Complainant in some capacity in what is known as “initial interest confusion”. This capacity for deceiving*

*and confusing, at least initially, visitors who come upon the domain that the domain is somehow connected with the Complainant, which is untrue, provides grounds for a finding of an Abusive Registration.*

This latter case is the only 'tarmac' decision which post-dates the Summary Decision under appeal. The Expert in that case did not refer to the Plymouth case, perhaps not surprisingly given the clear difference that a second trade mark of the Complainants was in issue (BLUE CIRCLE) alongside its claimed rights in TARMAC. The Panel refers to this case for completeness, but does not place any reliance on its outcome.

For convenience, a list of the tarmac cases in which decisions have been published to date is set out in the Annex to this decision. Some cases in the list appear on their face to be of a different nature to the case in issue, because the terms combined with the "tarmac" element of the domain names concerned are of a different nature (e.g. tarmacvandal.co.uk, tarmacterrorist.co.uk and tarmacbluecircle.co.uk). But, of the dozen or so cases concerning domain names that combine a place name, surname or other arguably descriptive element with "tarmac", it is notable that only three decisions have been in favour of the respondent, one of which was the Plymouth case that was overturned on appeal and another being the decision that is currently under review.

The only unappealed DRS decision against the Complainant or its predecessors is that of Lafarge Tarmac Trading Limited v Smart Numbers LTD (D00015757) concerning the domain name <watfordpavingandtarmac.co.uk>, in which the expert accepted the respondent's argument that the term "tarmac" is commonly used to describe a type of road surface and does not exclusively denote the Complainant or its goods and services, and that the term "tarmac" was being used in the domain name in its descriptive sense.

On the face of it, the case immediately above is an 'outlier', reaching a different conclusion from the subsequent Plymouth case and many others both before and after. But it was one of the few cases that was actively defended, and of course every case has to be decided on its particular facts and one has to be cautious about drawing conclusions from a list of apparently similar previous cases. The Panel explains how much '*persuasive value*' it has attached to each of the previous tarmac cases in the sections below.

## **11. The alternative meanings of TARMAC**

The Plymouth decision contains a lengthy section headed, "*Is the term "tarmac" generic?*". It starts by stating that the Complainant had 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*". The Plymouth Panel then went on to describe the results of various Google searches and other research that illustrated different ways in which the word "tarmac" is used by the Complainant, by journalists, in dictionaries, on Wikipedia, and by surfacing contractors. They also analysed the reasons given by respondents in some of the earlier tarmac cases for having chosen to include the word in their domain names. (The respondent in the Plymouth case had not given such an explanation as he did not file a Response to the complaint or the appeal.)

The Plymouth Panel concluded from this research that:

- their 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"*;
- *"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"*; and
- *"when addressing potential retail customers, [surfacing] contractors use the term "tarmac" in its generic sense, which is how they expect the public to understand it."*

Therefore, the Panel proceeded *"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"*.

The Plymouth Panel also examined the question of whether surfacing contractors are generally aware of the trade mark status of the word "tarmac", and determined that there was insufficient evidence about this to reach a conclusion. Of course, in this case, as in others where the Complainant sends a letter of complaint to a contractor using the word "tarmac", the contractor is made aware of its trade mark rights.

Despite the extensive discussion of the alternative trade mark and generic meanings of the word "tarmac" in the Plymouth case, the Complainant chose not to address the subject at all in the Complaint in this case, and omitted the dictionary entry for "Tarmacadam" described above, which it had relied on in previous cases apparently to contrast the trade mark nature of the term "tarmac" with the generic meaning of "tarmacadam".

In the light of the Complainant's silence on the topic, and the absence of a Response from the Respondent, this Panel has considered whether it is right to follow the route taken by the Plymouth Panel and take account of information derived from their research, or indeed to conduct similar research itself, and generally from

previous tarmac cases. The Panel adopts the analysis set out in the Plymouth case (Section 9: Relevant Material) whereby that Panel decided to do so, and adds that:

- the Complainant has expressly encouraged the Panel in this case to exercise their discretion and supplement the evidence presented with their own investigations;
- the Expert in the Decision under appeal stated that “tarmac” is a well-known word in the English language which is wholly descriptive of the product used to surface roads and aircraft runways and is used as a verb to describe the process of laying those surfaces;
- the Complainant directly challenges that finding of descriptiveness and states that it cannot be made out on the evidence provided “*or at all*”.

Accordingly, the Panel proceeds with its analysis of the application of the Policy to the Domain Name on the same basis as the Plymouth Panel: that the word “tarmac” has a generic meaning as well as being a registered trade mark of the Complainant. Of course, this does not answer the question of which meaning should be attributed to the “tarmac” element of the Domain Name, which is examined further below.

## **12. Discussion and Conclusions under the Policy**

Paragraph 2 of the Policy provides that the Complainant must prove, on the balance of probabilities, that:

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

**Rights** are defined as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

Even if it is the case that members of both trade and public frequently use the word “tarmac” as a generic word for a type of road surface, there is no doubt that the Complainant has Rights as defined in the Policy in respect of the name and mark TARMAC by virtue of its various registered trade marks and its long use of TARMAC as a trade name and to identify certain of its goods and services.

Within the terms of the Policy, the word “tarmac” has acquired a secondary meaning as an indication of commercial origin denoting the Complainant, albeit not one which has completely subsumed or overridden the alternative descriptive meaning.

In this regard the Panel respectfully differs from the view taken by the Expert that the term “tarmac” is ‘*wholly descriptive*’ (which is not far removed from the

conclusion that the registered trade marks upon which the Complainant relies are devoid of distinctive character i.e. invalidly registered). In the absence of any evidence at all from the Respondent, the Panel does not feel able to reach such a conclusion.

The Domain Name consists of the identical word “tarmac” preceded by the word “reading”, which will be taken by most people to refer to the town of Reading, though could theoretically be understood as the gerund for the verb “read”. Either way, ignoring the suffix “.co.uk”, the Domain Name is clearly similar to the name and mark TARMAC.

Therefore, the Panel finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

Turning to **Abusive Registration**, this is defined as a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Complainant relies on both limbs of this test.

#### Initial registration / acquisition of Domain Name

The only aspects of the Complaint that would appear aimed at establishing the position when the Respondent initially registered / acquired the Domain Name are the evidence going to the existence and strength of the Complainant's Rights including its reputation and goodwill, and assertions as to the likely impact of the appearance of “tarmac” in the Domain Name on internet users.

There was no Response and no evidence as to the Respondent's thought processes or intent when he chose the name. His Appeal Response does not shed any light either. In the light of the above discussion about how “tarmac” is used both as a brand name and as a descriptive term, the Respondent may have had either meaning in mind – or both. He no doubt wanted to inform internet users that he had a business in Reading as a surface contractor, so he used a name that he thought would convey that information. But did he intend internet searchers to believe that his business was licensed or otherwise authorised by the Complainant? Did he perceive that there might be a risk that his website, by virtue of its domain name, could mislead consumers into believing that he was the Reading-based arm or authorised distributor of the Complainant's products? There is no evidence of that. We do not know if the Respondent was aware of the Complainant or its Rights. While it is rather unlikely that he had never heard of the Tarmac group of companies in general terms, he may nevertheless have been thinking primarily or exclusively of

the term "tarmac" as one used in the trade as a generic descriptor when he chose it for his domain.

The Panel disagrees with the Complainant's assertion that this is a case like British Telecommunications v One in a Million Ltd [1999] 1 WLR 903 where the Domain Name can be taken without more to constitute an instrument of fraud because it is incapable of honest use by anyone other than the Complainant. The mere appearance of the six letters "tarmac" in the Domain Name does not amount to an inherent and automatic misrepresentation which is likely to deceive the public into believing that the Domain is under the control of the Complainant. In such a case, it would not be necessary to speculate about what was in the mind of the registrant, and unfair advantage or detriment could be assumed in the absence of evidence to the contrary.

On the scant evidence adduced by the Complainant the Panel is not persuaded that the Complainant has discharged the burden of proving unfair advantage or detriment arising out of the initial registration or acquisition of the Domain Name.

#### Subsequent use of the Domain Name

The Panel now turns to the second limb of Abusive Registration, namely whether the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Expert started from the proposition that the term "tarmac" was '*wholly descriptive*' and hence '*the complainant cannot object to such use of the word, whether as part of a domain name or otherwise*', and unsurprisingly therefore the Expert concluded that the Domain Name was not an Abusive Registration.

The Panel prefers a more nuanced starting point, as explained above, namely that "tarmac" is a registered trade mark with (at the very least) a modicum of distinctive character, which nonetheless coexists with its descriptive meaning. Whether the trade mark or descriptive meaning will be attributed to the term will vary according to context.

As is apparent from the previous cases decided under the Policy concerning the term 'tarmac', each case must be considered on its own facts and on the evidence and arguments put forward by the parties. There is no rule or presumption that all use of "tarmac" domains is abusive, nor is there a rule or presumption that all use of "tarmac" domains is non-abusive. Context is key.

In addition it should be noted that the Panel has had the benefit of the further submissions from the Complainant contained in its Appeal Notice, though once again the Respondent has proffered nothing of substance.

It is understandable, though not particularly helpful, that the Complainant is unwilling or unable to countenance the possibility that "tarmac" might have

descriptive significance for some people or in some contexts. The present Panel shares the reservations expressed in the Plymouth case concerning the Complainant's central allegations of deliberate diversion and/or deception. No direct evidence of confused or disappointed consumers or tradespeople has been adduced, and the present Panel sees no other basis for inferring that the Respondent must have intended to block, harm or disrupt the Complainant's business.

From a more realistic standpoint, based on the evidence (such as it is) before the Panel, the pivotal question in this appeal concerns the species of abusive registration found in the Plymouth case, namely whether the Respondent's use of the Domain Name has gained unfair leverage at the expense of the Complainant's Rights: Will the Respondent's selection and use of the Domain Name have unfairly boosted the profile of his business due to a perceived link with the Complainant's large and venerable corporate group? Will the Respondent's mode of use of "tarmac" unfairly contribute to the diminution of the distinctive character of the Complainant's Rights?

Regrettably, neither party in this dispute has grappled with, or assisted the Panel in deciding, this central issue. While the Respondent might be forgiven for not doing so, the Complainant was the successful appellant in the Plymouth case and has no such excuse.

While it has not been an entirely easy or straightforward decision, on the evidence before it the Panel has concluded that the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights. The Panel has reached this conclusion on the following bases.

First, of the submissions which have actually been put forward by the parties to this Appeal, the Complainant's is the more cogent and persuasive. The only positive argument which has been put forward by the Respondent in the appeal is that the Complainant only owns a trade mark for "tarmac" and not "readingtarmac", but that is no answer to the Complaint; the threshold requirement in the Policy is couched in terms of similarity rather than identity. The Complainant's argument in the appeal is, in effect, that in a case where the Complainant's evidence stood unchallenged and the Expert had accepted that the Complainant owned a registered trade mark for the purposes of the analysis of Rights, the Expert should not have approached the analysis of Abusive Registration on the basis that the same mark was incapable of distinguishing the Complainant's goods and services.

Second, the Panel does not accept the Respondent's contention that no use is made of the word "tarmac" in connection with his website accessible via the Domain Name. Quite apart from all the appearances of "Readingtarmac", the following wording appears as the Google search result for the site:

**"Reading Tarmac: Tarmac Surfacing Contractor**  
*Tarmac Contractor / Asphalt Driveways / Car Park Construction Family ran asphalt contractor - Commercial and Residential tarmac works carried out."*



Third, the Respondent's site clearly uses "Readingtarmac" and the initials "RT" as the trading name of the business, i.e. in a trade mark sense rather than as an obviously descriptive indication. The juxtaposition of the use of the descriptive term 'tarmacadam' within the site serves to reinforce this impression rather than diminish it. While the Panel accepts that this does not indicate an *intention* to deceive internet users into believing that the site is commercially associated with the proprietor of the "tarmac" trade mark, this does nothing to assuage the concerns of the Complainant that such users may nonetheless get the wrong impression.

Fourth, the Panel is satisfied that the Respondent must have been aware of the Complainant and its Rights. The Respondent was notified by the Complainant of its cause for complaint prior to the continuation of the use in question, and it is in any event apparent from the content of the website that the author or designer of the site appreciates the distinction between and significance of the terms tarmac, tarmacadam and asphalt.

Fifth, the failure of the Respondent to provide a Response concerning his registration or use of the Domain Name has not assisted his case, as it leaves the contentions raised by the Complainant essentially unchallenged. The DRS process is user-friendly and it does not require significant resources or legal sophistication to adduce a reasoned Response or an Appeal Response, even if it is only to confirm innocent adoption and honest use of the domain name in question. Complaints are only required to be proven on the balance of probabilities and it is imprudent for a respondent not to challenge or rebut the contentions made by a complainant.

Sixth, while previous DRS decisions are not binding, DRS users are nonetheless entitled to expect a degree of consistency and predictability from the service. When attempting to categorise and reconcile the various "tarmac" decisions it is apparent that the only case that has resulted in No Action ([watfordpavingandtarmac.co.uk](http://watfordpavingandtarmac.co.uk)) was the outlier: a fully-defended case involving a four word domain, of which two words were capable of describing a roadway surface. If anything, the present Domain Name is further beyond the dividing line than the domain name in the Plymouth case ([tarmacdrivewaysplymouth.co.uk](http://tarmacdrivewaysplymouth.co.uk)).

Finally, to the extent that the present fact pattern does not fall neatly within the specific illustrative examples of Abusive Registration given in the Policy, it must always be borne in mind that the general overarching test for Abusive Registration is defined in terms of use which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights. That includes use which goes beyond fair descriptive use of a term and crosses the line into unfairly gaining traction and prominence at the expense of the Complainant's Rights.

Accordingly the Panel concludes that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### **13. Decision**

The Panel finds that the Complainant has Rights in a name or mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. It is therefore determined that the Domain Name be transferred to the Complainant.

**Dated** 18 February 2022

**Signed** .....  
Anna Carboni

**Signed** .....  
David King

**Signed** .....  
Philip Roberts

### Annex: Tarmac DRS Cases

| DRS Case No.                                  | Decision Date | Complainant(s)                                 | Respondent                     | Domain Name                   | Decision Type | Order                                    |
|---|---------------|--|--------------------------------|-------------------------------|---------------|--|
| D00000177                                     | 15/02/2002    | Tarmac Limited                                 | Andrew Etches                  | tarmacvandal.co.uk            | Full          | Transfer                                 |
| D00005514                                     | 12/05/2008    | Tarmac Ltd                                     | Dariusz Herman                 | tarmacterrorist.co.uk         | Full          | Transfer                                 |
| D00015776                                     | 19/05/2015    | Lafarge Tarmac Trading Limited                 | Hibu (UK) Limited              | northerntarmac.co.uk          | Summary       | Transfer                                 |
| D00015777                                     | 17/06/2015    | Lafarge Tarmac Trading Limited                 | Bluezon Limited                | millertarmac.co.uk            | Summary       | Transfer                                 |
| D00015990                                     | 03/08/2015    | Lafarge Tarmac Trading Limited                 | Steve Floyd                    | floydstarmac.co.uk            | Summary       | Transfer                                 |
| D00015757                                     | 29/09/2015    | Lafarge Tarmac Trading Limited                 | Smart Numbers LTD              | watfordpavingandtarmac.co.uk  | Full          | No Action                                |
| D00017740                                     | 06/09/2016    | Tarmac Trading Limited                         | Webdesigns Andprint            | kentcountytarmac.co.uk        | Summary       | Transfer                                 |
| D00018424                                     | 02/03/2017    | Tarmac Trading Limited                         | Mr Chris Carlin                | kentcountytarmacltd.co.uk     | Summary       | Transfer                                 |
| D00019293                                     | 13/11/2017    | Tarmac Trading Limited                         | Ian Sheeran                    | northern-tarmac.co.uk         | Full          | Transfer                                 |
| D00020908                                     | 02/05/2019    | Tarmac Trading Limited                         | Mr Rory Flynn                  | plhtarmac.co.uk               | Summary       | Transfer                                 |
| D00021275<br>(the Plymouth case – first inst) | 10/05/2019    | Tarmac Trading Limited                         | Mr Maurice Birch               | tarmacdrivewaysplymouth.co.uk | Summary       | No Action<br>(overturned on appeal)      |
| D00021282                                     | 04/10/2019    | Tarmac Trading Limited                         | Drivecareuk                    | tarmac-surfacing.uk           | Full          | Transfer                                 |
| D00021275<br>(the Plymouth case – appeal)     | 29/04/2020    | Tarmac Trading Limited                         | Mr Maurice Birch               | tarmacdrivewaysplymouth.co.uk | Appeal        | Transfer                                 |
| D00023426                                     | 24/03/2021    | Tarmac Trading Limited                         | Robert Stratford               | halfpricetarmac.co.uk         | Summary       | Transfer                                 |
| D00023847                                     | 25/08/2021    | Tarmac Trading Limited                         | S. Matthew Paving              | tarmacaberdeen.co.uk          | Summary       | Transfer                                 |
| D00024127<br>(the present case – first inst)  | 06/12/2021    | Tarmac Group, including Tarmac Trading Limited | Mr Wesley Mahoney              | readingtarmac.co.uk           | Summary       | No Action<br>(under appeal in this case) |
| D00024167                                     | 13/12/2021    | Tarmac Group, including Tarmac Trading Limited | Fundacion Comercio Electronico | tarmacbluecircle.co.uk        | Summary       | Transfer                                 |