

.nz Dispute Resolution Service

DRS Reference: 1136

**Counties Ready Mix
Limited
Andrew Payne**

v

**Interbloc Limited
Jack Bright**

Key words

Domain name

bigblock.co.nz
bigblock.nz

Identical or similar trade mark or name

Registered mark - unregistered mark – identical – similar – generic – descriptive

Rights

Demonstrable preparations to use – legitimate non-commercial or fair use – generic – descriptive

Unfair registration

Unfair registration – unfair use – fair registration – fair use - likely to confuse, mislead or deceive – prior relationships between the parties – unfairly disrupting the business of the Complainant

1 Parties

Complainant:

Counties Ready Mix Limited
Andrew Payne
14 Bremner Road
Drury
New Zealand

Represented by: Mr Ben Cain, James & Wells

Respondent:

Interbloc Limited
Jack Bright
241 Bremner Road
Drury
New Zealand

2 Domain Name/s

bigblock.co.nz
bigblock.nz

3 Procedural history

- 3.1 The Complaint was lodged on 11 November 2015 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 13 November 2015. The domain/s were locked on 13 November 2015, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 02 December 2015 and the DNC so informed the Complainant on 10 December 2015. The Complainant filed a Reply to the Response on 21 December 2015. The DNC informed the parties on 26 January 2016 that informal mediation had failed to achieve a resolution to the dispute.
- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 04 February 2016 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4 Sheana Wheeldon, the undersigned, (“the Expert”) confirmed to the DNC on 10 February 2016 that she knew of no reason why she could not properly accept the invitation to act as Expert in this case and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

4 Factual background

The Complainant’s rights

- 4.1 The Complainant is Counties Ready Mix Limited, a New Zealand company. It is based in Drury and has since 1999 been manufacturing concrete, including concrete blocks which are made from surplus concrete. Its main website is at www.crml.co.nz.
- 4.2 The Complainant also now operates a website at www.bigblocks.co.nz. It registered this domain on 13 January 2015, and it registered bigblocks.nz on 31 March 2015.
- 4.3 The Complainant owns trade mark registration no. 1013027 which covers two variants of a trade mark comprising the words BIG BLOCKS in relatively plain font but as part of a somewhat distinctive Logo containing a ‘Swoosh’ design (**‘BIG BLOCKS Logo’**), as shown below:





- 4.4 That registration dates from 29 January 2015. It covers a wide range of goods in class 19 including various concrete building products, as well as related services in classes 35 and 37.
- 4.5 The Complainant also owns a pending application to register the trade mark BIG BLOCKS in plain block capitals, under application no. 1027204. This was filed on 7 September 2015 and its status is 'under examination'. The Expert notes that this application does not encompass concrete products or any building products in class 19, but is limited to services in classes 35 and 37.
- 4.6 The Complainant says it began manufacturing and selling blocks in early 2007 using descriptive terms such as 'interlocking blocks' and 'interlocking concrete blocks'. In January 2015 the Complainant adopted the term BIG BLOCKS for its concrete block products. It says it has supplied concrete blocks to customers throughout New Zealand under and by reference to what it characterises as 'the BIG BLOCKS Mark'.
- 4.7 The question of whether BIG BLOCKS is a trade mark in which the Complainant has Rights, or merely a descriptive term, is key to the Complaint and this decision. Therefore the Expert will use the more neutral description, 'the term BIG BLOCKS'.
- 4.8 The Complainant's concrete blocks have a number of uses including rural and residential applications, commercial and industrial retaining walls, traffic barriers and storage bins.
- 4.9 Since the end of January 2015 the Complainant's concrete blocks have been stamped with a version of the BIG BLOCKS Logo, which from the photographs provided appears to have been slightly varied to allow for being stamped on a concrete block.
- 4.10 The Complainant says that since January 2015 it has invested in excess of NZ\$35,000 in the branding and promotion of 'BIG BLOCKS' product. Its evidence includes photographs of signage, print advertising (since March 2015) in contracting and rural publications, email newsletters, stationery, brochures, websites, clothing, quotations and at trade shows.
- 4.11 It is necessary to consider this evidence in some detail. The Expert notes that:
 - a. There are two photographs of signage. One of these has no reference to BIG BLOCKS at all, but only to the Complainant's company name and other material. In the other photograph it is the BIG BLOCKS Logo that appears in the signage, with an 0800 number and a reference to the website www.bigblocks.co.nz below in smaller font.

- b. All the images provided of the print advertising (since March 2015) feature the BIG BLOCKS Logo. They also include other material – for example at least some contain the smaller notation ‘Call 0800 300488 or visit www.bigblocks.co.nz’. It is not clear whether all the print advertisements make reference to the website as some images are so small that only the BIG BLOCKS Logo is legible.
- c. On the page provided from the current www.bigblocks.co.nz website homepage the BIG BLOCKS Logo appears prominently at the top left. There are also references to ‘Big Block sizes & specifications’ and to the ‘**Big Blocks**[™] system’ and a statement:

‘Our BigBlocks[™] can be added to, moved, or modified quickly and cheaply, fully future proof’.
- d. The photographs of stationery, a brochure, and clothing all show the BIG BLOCKS Logo without any other obvious references to BIG BLOCKS. One item of stationery and a hat carry no visible reference to BIG BLOCKS but do carry the words ‘Counties Readymix’ in a Logo form containing a ‘Swoosh’ design very similar to the BIG BLOCKS Logo (**‘COUNTIES READYMIX Logo’**).
- e. The Quotation also carries the BIG BLOCKS Logo (as well as the COUNTIES READYMIX Logo). It shows images of different sized blocks described as ‘Small Block’, ‘Standard Block’ and ‘Large Block’.
- f. Photographs said to show use at trade shows include 1) Franklin A&P Show 2013 (with no reference to BIG BLOCKS but carrying the COUNTIES READYMIX Logo), 2) Auckland Easter Show 2015 and 3) Waikato Fieldays 2015 (both displaying the BIG BLOCKS Logo).

4.12 The Complainant asserts common law rights in the term BIG BLOCKS. In support of these rights it asserts that it has used the term BIG BLOCKS ‘exclusively in New Zealand for concrete blocks since January 2015’. It says that as a result of this use it has developed a reputation and goodwill in the term BIG BLOCKS notwithstanding the relatively short period in which it has been using it.

The Respondent’s activities

- 4.13 The Respondent is Interbloc Limited, a New Zealand company incorporated in November 2004 after its business was initially established in 2003. It is in the business of taking wet surplus concrete from Ready Mix Concrete suppliers and manufacturing concrete blocks to a unique interlocking design.
- 4.14 In its Response the Respondent describes having historically licensed its Interbloc system, initially to the Complainant and later, from 2006, to the Respondent’s manufacturing licensee. The manufacturing licensee was a company called Big Blocks 2006 Ltd (**‘BB 06’**). It operated the Respondent’s Drury manufacturing plant to exclusively manufacture blocks

under the trade mark Interbloc using concrete supplied by the Complainant.

- 4.15 The Respondent says it has established Interbloc as a premium brand with over 100,000 blocks in the market place and has spent over \$1 million on marketing and branding activities.
- 4.16 It says that in 2009 the Complainant commenced manufacturing concrete blocks in competition with the Respondent using the trade name 'Counties Blocks'. The Complainant disputes the assertion that it only began manufacturing concrete blocks in 2009, and says it has never used 'Counties Blocks' as a trade mark. Little turns on these points.
- 4.17 The Respondent registered the domain names bigblock.co.nz and bigblock.nz ("**Domain Names**") on 2 April 2015. It says that it did so 'in good faith, unaware that the complainant had changed their branding to 'Big Blocks''. It says this strategy was consistent with its marketing approach to securing descriptive terms for specific market targeting. In support of this it has provided evidence of having registered the domains retaining.co.nz and counterweights.co.nz on 17 September 2013, and concreteblock.net.nz on 7 October 2014.
- 4.18 The Domain Names both resolve to a website of the Respondent headed up 'Interbloc'. The text on the homepage begins 'Interbloc interlocking mass concrete blocks incorporate a unique interlocking design which...'. The homepage cycles through several prominent headings, including 'The Original Concrete Block' and 'The smart concrete block choice' along with images of large concrete blocks carrying the 'Interbloc' brand.
- 4.19 The Respondent says it first became aware of the Complainant's name change to 'Big Blocks' at the National Fieldays in June 2015. It was unaware of the Complainant's registration as a trade mark of the BIG BLOCKS Logo.
- 4.20 The Respondent says it began a specific marketing campaign around the concept of Interbloc® as a 'Big Block Solution' well before the Complainant registered the Domain Names. It says this campaign started in 2009 and continued until 2013, and involved significant direct mail campaigns targeting 80,000 consumers. The Respondent has provided a number of exhibits to support these statements. These are:
 - a. A document entitled 'Interbloc News' said to date from 2009 showing an advertisement (for the Respondent's interlocking concrete blocks) containing, in large print, the phrase:

'Interbloc – for really Big Block Building Solutions...'
 - b. Advertisements and wording from, variously, 'Interbloc News' 2009, 'Interbloc News' 2010 and 'Interbloc News Rural' 2011, all containing this same phrase, under the page heading 'Interbloc Advertorial'.

- c. An invoice and email correspondence from a supplier of content for the advertisements, all dated September 2009. One email says the 'supplement' including pictures 'will be printed and in the homes of 80,000 farmers by this time next week'.
 - d. An invoice dated 31 December 2011 from New Zealand Post Ltd to the Respondent described in the Response as 'confirming the mail out'.
- 4.21 The Respondent also says that it seriously considered including 'Big Block' in its logo refresh as late as 2013. It has provided documentary evidence of that in the form of internal email dated 13 September 2013 attaching what are described as 'the shortlisted taglines'. One of these does indeed show the tagline 'Big Block Construction' together with the main trade mark Interbloc.

Correspondence between the parties

- 4.22 The Complainant's lawyers wrote to the Respondent on 7 September 2015. Their letter asserts that the Complainant 'owns and uses the BIG BLOCKS and BIGBLOCKS trade marks in New Zealand....and has registered its mark via New Zealand Trade Mark Registration 1013027'. It goes on to assert that 'use of marks such as 'big block' or any other similar variation' is covered by the Complainant's trade mark rights in BIG BLOCKS.
- 4.23 As well as trade mark infringement the letter asserts breaches of the Fair Trading Act 1986 and passing off. It demands undertakings to cease all use of the Domain Names and of BIG BLOCK, amongst other things. It refers to the Complainant initiating court proceedings seeking injunctions, damages, delivery up or destruction of products, and other remedies.
- 4.24 The Respondent says this letter was the first time it was aware the Complainant had registered a trade mark for the term BIG BLOCKS. It was surprised as it did not believe 'such a generic and descriptive term' could be registered. Investigations by its solicitor found it was the BIG BLOCKS Logo that the Complainant had registered, not the words 'BIG BLOCKS'. (Indeed, the Complainant's application to register BIG BLOCKS (words) was filed the same day this letter was written.) There is some basis for the Respondent's initial perception that the Complainant was asserting a trade mark registration of BIG BLOCKS standing alone.
- 4.25 On 21 September 2015 the Respondent's solicitors responded. They said 'Big Block' is a term widely used in the relevant industry, is descriptive and is not distinctive, and noted that the trade mark registration referred to was for a combined mark only. They said the Respondent is entitled to own the Domain Names and any steps to challenge its rights would be opposed.
- 4.26 Subsequently the Respondent has applied to the Intellectual Property Office for a declaration of invalidity in respect of the Complainant's BIG BLOCKS Logo registration no. 1013027.

5 Parties' contentions

Complainant

- 5.1 The Complainant seeks to have the Domain Names transferred to it from the Respondent.
- 5.2 As mentioned above the Complainant asserts registered and unregistered trade mark rights in the term BIG BLOCKS. It says the Domain Names are similar to BIG BLOCKS as the only difference is the omission of the letter 'S'.
- 5.3 The main assertions of the Complainant in support of its Complaint are as follows:
 - a The Domain Names are Unfair Registrations because they were registered and/or have been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's prior rights in term BIG BLOCK (limbs (i) and (ii) of the definition of Unfair Registration).
 - b The Respondent registered the Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant (as set out in paragraph 5.1.1(c) of the Policy).
 - c The Respondent is using the Domain Names in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant (as set out in paragraph 5.1.2 of the Policy).
 - d The Respondent's registration of the Domain Names has caused and is causing damage to the Complainant (this assertion is not referenced to the Policy).
- 5.4 The Complainant also asserts that the Respondent cannot demonstrate that the Domain Names are not Unfair Registrations. In this regard it refers to a number of the factors listed in paragraphs 6.1 and 6.2 of the Policy that may be evidence that a Domain Name is not an Unfair Registration.
- 5.5 In support of these assertions the Complainant says:
 - a The term BIG BLOCKS is not a generic or descriptive term for precast concrete blocks but is distinctive of the Complainant's goods as it is exclusively associated with the Complainant.
 - b Though the word 'block' on its own is a descriptive term, 'no other provider of precast concrete blocks in New Zealand uses the word 'big' in connection with 'block' or 'blocks' as a *badge of origin*' (emphasis added).
 - c The Respondent does not use the term BIG BLOCK(S) in trade in relation to its goods or services – its trade mark is INTERBLOC.

- d Visitors to the Domain Names are taken to the Respondent's principal website at interbloc.co.nz.
- e Based on the organic (that is, excluding paid Ads) results of a Google search undertaken on 4 November 2015 using the term 'big blocks' the Complainant is shown to be the only supplier of concrete blocks using 'the BIG BLOCKS Mark'. A similar search of TradeMe yielded no results matching the term 'big block'.
- f The industry standard terms are 'block(s)', 'interlocking block(s)' and 'interlocking concrete block(s)'. As evidence of this the Complainant has provided pages from websites of the Respondent and four other New Zealand businesses that appear to supply concrete blocks, and says these reveal no use of the term BIG BLOCK(S). It is not clear how these particular websites were selected.
- g The Complainant refers to an email it received on 13 October 2015 from a customer. This states that when the customer attempted to show a client the Complainant's website, it was redirected to 'interbloc'. The customer asks for confirmation that the Complainant still supplies 'blocks' and for the size of a 'standard block'. The email states that the customer was 'looking at using big blocks for a retaining wall'. This is said to illustrate how the Respondent's registration of at least one of the Domain Names is disrupting the Complainant's business.
- h The Complainant also refers to a situation in 2015 when its own Google Ad words were linking to the domain bigblock.co.nz, causing traffic to be directed to the Respondent's website for a period of time. However the Complaint makes it clear that the situation was caused by an error on the Complainant's part.

Respondent

- 5.6 The Respondent rejects the Complainant's assertion that it has Rights in the Domain Names. Its factual assertions can be summarised as follows:
- a Big blocks is a very common term used to describe blocks that are large and made of concrete.
 - b Big blocks is a wholly descriptive term for any big block regardless of whether it 'interlocks' or not.
 - c A Complainant is unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business (referring to the definition of 'Rights' in the Policy).
 - d The Complainant's BIG BLOCKS Logo, which is registered, 'is a combined mark, which gives no general rights to wording contained therein'.

- e There is a substantial difference between the form of the Domain Names and the stylised registered trade mark (the BIG BLOCKS Logo).
 - f It is common to see the singular and plural of a generic name being used by two companies in the same industry, for example car.com and cars.com.
 - g The Complainant's contention that the Respondent has never used 'big blocks' in marketing or selling blocks is 'disingenuous at best'.
 - h 'Big blocks' is not a technical term but two generic dictionary words, used by the Respondent when describing products to 'people in non-technical roles'.
 - i The Respondent has used 'Big Blocks' in advertising and sales pitches for over 10 years, including in the marketing campaign referred to in more detail above.
 - j The webpage to which the Domain Names resolve is clearly branded INTERBLOC.
- 5.7 Referring to the factors listed in the Policy as potential evidence that a Domain Name is not an Unfair Registration the Respondent says:
- a Before the Complainant had complained or even registered the Domain Names, 'there was demonstrable intention by the Respondent to continue to use the words 'big block' for the purposes of selling and marketing to select groups of people'.
 - b The Respondent has made fair use of the Domain Names in a way that is consistent with the generic and descriptive character of the words 'big block'.
 - c The Respondent has used the Domain Names in connection with a genuine offering of goods and services.

Complainant's Reply

- 5.8 In its Reply the Complainant takes issue with some of the Respondent's assertions concerning peripheral factual matters.
- 5.9 One matter that warrants mention relates to the historic company BB 06 which was the Respondent's manufacturing licensee. In reply the Complainant says:
- a BB 06 used the INTERBLOC trade mark, it did not sell goods 'using the BIG BLOCKS name'.
 - b To the extent any rights in 'the BIG BLOCKS name' existed, they belonged to the sole director of BB 06, Mr Murray Lee and/or to BB 06.

- c In January 2015, 'as a matter of courtesy rather than legal requirement, the Complainant sought Mr Lee's consent to use the BIG BLOCKS name', which was given.
 - d The Complainant did not need Mr Lee's consent 'technically' because BB 06 was removed from the Companies Register in September 2010, any residual reputation it may have had in the 'BIG BLOCKS name' had faded, and the BIG BLOCKS name 'as a trade mark, was technically abandoned'.
- 5.10 To clarify a factual matter raised in the Response, the Complainant gives some facts on another domain it uses. It says that it registered the domain concreteblock.co.nz on 31 May 2010 and has operated a website under that domain since at least 2011. The Expert notes that that website is headed up with the COUNTIES READYMIX Logo and promotes concrete blocks, which are described on this site as 'large precast interlocking solid concrete blocks'.
- 5.11 The Complainant refers to the fact the Respondent had registered the domain name concreteblock.net.nz on 7 October 2014. It describes the fact this domain re-directs to the Respondent's website as 'earlier evidence of the Respondent's attempt to divert trade from the Complainant to itself and constitutes the first in a pattern of unfair domain name registrations'. This assertion appears to be based on the fact the Complainant had registered and was operating a website at concreteblock.co.nz.
- 5.12 For completeness the Expert notes that this could be construed as a reference to paragraph 5.1.3 of the Policy, which was not raised in the original Complaint. However the Complainant does not assert that 'concrete block' is a well-known name or trade mark, and clearly it is not. That is an essential aspect of the factor in paragraph 5.1.3, so the point will not be considered further.
- 5.13 The Complainant denies that the Respondent registered the Domain Names in good faith and that it was unaware of the Complainant's adoption of the term BIG BLOCKS. It points to the fact both the Complainant and Respondent are located in Bremner Road in Drury (it is not clear how far apart they are). The Complainant says, 'It is highly likely someone associated with the Respondent saw the BIG BLOCKS branding on the Complainant's goods', and that its launch of the term BIG BLOCKS was accompanied by 'extensive trade press' in March 2015.
- 5.14 The Complainant argues that the Respondent's advertisements showing prominent use of the phrase 'Interbloc for Really Big Block Building Solutions' show descriptive use of BIG BLOCK, not use as a trade mark.
- 5.15 Finally, the Complainant gives an account of what it describes as further confusion, in the form of an individual who phoned the Complainant on 3 December 2015 wanting prices on 'Interblocs'. He was told 'We don't sell 'Interblocs', we sell something similar'.

6 Discussion and findings

Relevant Provisions of the Policy

- 6.1 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely that:
- 6.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - 6.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.
- 6.2 Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.
- 6.3 The expression 'Rights' is defined in paragraph 3 of the Policy. That definition goes on to state:
- However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business.
- 6.4 The Policy provides that 'Unfair Registration' means a Domain Name which either:
- a 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
 - b has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- 6.5 Paragraph 5.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that a Domain Name is an Unfair Registration. They include the following:
- 5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - a. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out of pocket costs directly associated with acquiring or using the Domain Name; or
 - b as a blocking registration against a name or mark in which the Complainant has rights; or
 - c. for the purpose of unfairly disrupting the business of the Complainant; or
 - 5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive

people or businesses into believing that the Domain name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the Registrant of domain names (under .nz or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights and the Domain Name is part of the pattern;

6.6 Paragraph 6.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that the Domain Name is not an Unfair Registration. They include the following:

6.1.1 Before being aware of the Complainant's cause for Complaint (not necessarily the Complaint itself), 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;
- b been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- c made legitimate non-commercial or fair use of the Domain Name; or

6.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character.

Application of the Policy in this case

6.7 The first question is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names. Rights must be enforceable under New Zealand law and may be registered or unregistered.

Complainant's rights

6.8 The Complainant asserts registered and unregistered rights in the term BIG BLOCKS which the Expert finds is effectively identical to the Domain Names.

Complainant's registered trade mark rights

6.9 The Complainant's trade mark registration covers the BIG BLOCKS Logo. While the term BIG BLOCKS is one component of the BIG BLOCKS Logo, the registered mark as a whole contains significant other distinctive material including the Swoosh design.

- 6.10 The Complainant's application to register BIG BLOCKS in plain block capitals has not been accepted and presumably may have encountered objections on the grounds of descriptiveness and lack of distinctiveness. The fact the application is only pending means it cannot assist the Complainant, but in any event it has other limitations including:
- a The application is dated 7 September 2015, well after the Domain Names were registered and the Respondent began using them.
 - b The application does not extend to concrete blocks or any other class 19 goods, but only to services in classes 35 and 37.
 - c It therefore appears that in applying for registered trade mark protection the Complainant was not asserting ownership of the term BIG BLOCKS per se in respect of concrete blocks.
- 6.11 The Expert finds that the Complainant has registered trade mark rights in the BIG BLOCKS Logo but not in the term BIG BLOCKS.

Are the Domain Names similar to the BIG BLOCKS Logo?

- 6.12 In the context of concrete blocks that are also clearly large in size, the term BIG BLOCKS is extremely descriptive. As mentioned earlier the registered mark contains significant additional distinctive material.
- 6.13 The Expert considers the Complainant's trade mark registration of the BIG BLOCKS Logo cannot give it exclusive rights to the term BIG BLOCKS per se. In light of that, the BIG BLOCKS (words) component of the BIG BLOCKS Logo must to a large extent be discounted in considering whether that Logo is similar to the Domain Names.
- 6.14 In this context the Expert finds that the Domain Names are *not* similar to the BIG BLOCKS Logo as a whole, in which the Complainant has registered trade mark rights.

Does the Complainant have unregistered rights in BIG BLOCKS?

- 6.15 The Complainant also asserts unregistered rights in the term BIG BLOCKS.
- 6.16 As mentioned before the term BIG BLOCKS can only be seen as extremely descriptive, for obvious reasons. It comprises the word 'BLOCKS' which is in very common use in the industry, and the word 'BIG' which has only one, purely descriptive meaning.
- 6.17 Though this term is highly descriptive it is at least technically possible that the Complainant could have built up sufficient reputation to have acquired unregistered trade mark rights. However the Complainant still could not rely on any such rights if the term BIG BLOCKS is wholly descriptive of its business.

- 6.18 The highly descriptive nature of the term BIG BLOCKS means that a very large amount of use as a trade mark – that is, to identify the origin of the goods or services in question – would be required to create unregistered trade mark rights.
- 6.19 The Complainant by its own account has only been using the term BIG BLOCKS since sometime in January 2015. It has been using the BIG BLOCKS Logo in print advertising only since March 2015, and the earliest signage of which there is evidence dates from Easter 2015.
- 6.20 These promotional activities by the Complainant all demonstrate use of the BIG BLOCKS Logo as the most dominant element, though some also refer to the website www.bigblocks.co.nz. That distinction runs through most if not all of the activities of the Complainant that are said to demonstrate use of the term BIG BLOCKS.
- 6.21 The Complainant asserts that it is using the term BIG BLOCKS as a badge of origin, but no one else does so, and that use of this term by others is simply descriptive use. As mentioned above, this is how the Complainant characterises the Respondent’s historic use of BIG BLOCK.
- 6.22 However it is by no means clear that the Complainant itself is using BIG BLOCK as a badge of origin other than as part of the BIG BLOCKS Logo. Most of its use is in that form, and on its website www.bigblocks.co.nz it uses the description ‘Our BigBlocks™ can be...’. Despite the use of the ™ symbol, this appears to be generic use.
- 6.23 It is therefore questionable how much use the Complainant has in fact made of BIG BLOCKS, and to what extent that term could be exclusively associated with it.

Circumstances and extent of Complainant’s use of BIG BLOCKS

- 6.24 The Complainant’s activities involving use of the term BIG BLOCKS began only a very short time before the two Domain Names were registered (on 2 April 2015) and began to be used by the Respondent.
- 6.25 The Complainant has given the figure of NZ\$35,000 for what it has ‘invested in ... the branding and promotion of BIG BLOCKS product and says that from 1 February to 30 September 2015 it sold more than NZ\$200,000 of goods ‘using the BIG BLOCKS Mark’. The Expert comments that:
- a It is not clear how much of the NZ\$35,000 related to promotion and how much to developing ‘branding’.
 - b The examples provided largely show use of the BIG BLOCKS Logo.
 - c This scale of use and promotion is insufficient to create an exclusive reputation and hence common law rights in the term BIG BLOCKS per se.

- d There is no other evidence to support the Complainant's assertion of unregistered rights in BIG BLOCKS.
- 6.26 The Google search results referred to by the Complainant demonstrate only that BIG BLOCKS is a descriptive term used by numerous businesses in many different fields.
- 6.27 The Complainant has attempted to show that the term BIG BLOCKS is not used by the Respondent or by others in the industry and has provided a number of website extracts which do *not* include the term BIG BLOCKS. However that does not make the term any less descriptive. As the Respondent has alluded to, descriptions and specifications on websites are directed at technical people. The word 'big' is an everyday word one would not expect to find in technical descriptions or formal documents on websites. The term 'large blocks' is used, however, and one would expect 'big' to replace 'large' in an informal context.
- 6.28 In its Reply the Complainant notes the Respondent has not provided any evidence of other traders' use of 'big block' or 'big blocks' as descriptive terms. That is not entirely correct. However it is not necessary for the Respondent to provide specific evidence of such use. There is evidence that the term BIG BLOCKS has been used in the past by the Respondent and others but it is, in the Expert's view, actually self-evident that 'big block' is extremely descriptive in the context of concrete blocks.
- 6.29 The Complainant's assertion that the term BIG BLOCKS is exclusively associated with it, despite the relatively short period of use, is further undermined by the fact the Respondent's licensee BB 06 historically used the company name Big Blocks 2006 Limited. Further, the Respondent itself used the term 'Big Block Solution' from 2009 until 2013 in advertisements and direct mail campaigns.
- 6.30 Finally, the Complainant's comments in its Reply concerning the residual reputation of BB 06 in the term BIG BLOCKS do not suggest the Complainant acquired any rights in this term from BB 06 or Mr Lee.

Conclusion – unregistered trade mark rights

- 6.31 Given the highly descriptive nature of the term BIG BLOCKS, and in light of the above facts and discussion, the Expert finds that the Complainant has fallen well short of proving on the balance of probabilities that it has unregistered trade mark rights in the term BIG BLOCKS, either at the time the Domain Names were registered or subsequently.

Is BIG BLOCKS wholly descriptive?

- 6.32 For completeness consideration will also be given to whether the term BIG BLOCKS is wholly descriptive.
- 6.33 The meaning of 'wholly descriptive' was comprehensively analysed by the Expert in DRS 108, *B.O.P. Memorials v Jones & Company Funeral*

Services. The principles of that decision were succinctly summarised by the Expert in DRS 846, *Wellington Golf Centre Limited v Ricky Faesen Kloet* as follows:

- a *The test for determining whether words are merely descriptive is 'whether the words are equally applicable to any business of the like kind'. There is a continuum with, at the extremes, purely descriptive names at one end and purely invented names at the other. The closer one moves towards a merely descriptive name, the more a complainant will need to show that the name has acquired a secondary meaning equating it with the products of the complainant and the easier it will be to see a small difference in names as adequate to avoid confusion.*
- b *The more apt a word is to describe the goods or services, the less inherently apt it is to distinguish them as the goods of a particular merchant.*
- c *If the Complainant's product had acquired a secondary meaning, it must go beyond merely describing the name of the Complainant's services or products.*

6.34 The Expert considers the term BIG BLOCKS is at, or very near to, the 'purely descriptive' extreme end of the continuum. In the *BOP Memorials* case the mark was saved from the finding of being *wholly* descriptive by the fact BOP (which could have other meanings) was used, rather than the full BAY OF PLENTY. Where there are other ways of describing 'any business of the like kind' a descriptive phrase need still not be considered as *wholly* descriptive.

6.35 BIG BLOCKS is a very apt description for large concrete blocks. The fact 'BIG' could be replaced with 'LARGE' does not make 'BIG' any more distinctive. It is difficult to conceive of a scenario where the term BIG BLOCKS (in isolation from a distinctive Logo) could become exclusively associated with one business. Therefore faced with the available facts the Expert finds that the term BIG BLOCKS is wholly descriptive.

Are the Domain Names in the hands of the Respondent, Unfair Registrations?

6.36 Given the above findings it is unnecessary to consider whether the Domain Names are Unfair Registrations.

6.37 However for completeness, the Expert records her finding that the Complainant has not proved that the Domain Names in the hands of the Respondent are Unfair Registrations. The Complainant's assertions on that issue are unconvincing and unsupported by the evidence. Indeed, they are refuted by the Respondent's factual and documentary evidence.

6.38 Specifically:

- a The Expert accepts the Respondent's assertion that it was unaware the Complainant had adopted the term BIG BLOCKS when it registered the Domain Names.

- b The Respondent had previously used the term BIG BLOCKS in promotional material, long before the Complainant adopted the term.
 - c The Respondent's own manufacturing licensee had historically used the company name Big Blocks 2006 Ltd.
 - d The Respondent in 2013 and 2014 registered the three descriptive domains referred to in paragraph 4.17 above, demonstrating what it says is its securing of descriptive terms for specific market targeting. (The Complainant appears to have done the same thing in registering the domain concreteblock.co.nz in 2010).
 - e The Domain Names re-direct users to the Respondent's main website which makes no suggestion the Respondent's business is associated with the Complainant.
 - f The customer email and phone call referred to by the Complainant do not support the assertion that the Respondent's registration of the Domain Names is disrupting its business or causing any confusion.
- 6.39 Hence the Respondent's activities meet a number of the factors listed in the Policy as evidence that the Domain Names are *not* Unfair Registrations, including the following:
- i Before being aware of the Complainant's cause for complaint, it has:
 - A used and made demonstrable preparations to use the Domain Names in connection with a genuine offering of services; and
 - B made legitimate fair use of the Domain Names.
 - ii The Domain Names are generic and descriptive and the Respondent is making fair use of them in a way which is consistent with their generic or descriptive character.

7 Decision

- 7.1 In view of the findings made above the Expert directs that the Domain Names bigblock.co.nz and bigblock.nz remain with the Respondent. The Complaint is dismissed.

Place of decision: Auckland

Date: 24 February 2016

Expert Name: Sheana Wheeldon

Signature:

