

# **DISPUTE RESOLUTION SERVICE**

**D00020762**

## **Decision of Independent Expert**

ENSCO 1092 Limited

and

Identity Protect Limited

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

Lead Complainant: ENSCO 1092 Limited  
Cuthbert House  
Arley Street  
Sheffield  
S2 4QP  
United Kingdom

Respondent: Identity Protect Limited  
PO Box 786  
Hayes  
Middlesex  
UB3 9TR  
United Kingdom

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

outdoormegastore.co.uk

### **3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that

could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

29 October 2018 16:22 Dispute received  
30 October 2018 14:50 Complaint validated  
30 October 2018 15:01 Notification of complaint sent to parties  
16 November 2018 01:30 Response reminder sent  
21 November 2018 08:35 No Response Received  
26 November 2018 10:29 Notification of no response sent to parties  
06 December 2018 01:30 Summary/full fee reminder sent  
06 December 2018 14:42 Expert decision payment received  
12 December 2018 Keith Gymer appointed Expert wef 17 December 2018  
12 December 2018 Expert made request for Further Statements from Parties  
13 December 2018 Nominet communicated Expert's request to Parties  
20 December 2018 Complainant provided Further Statement and evidence  
21 December 2018 Respondent provided Further Statement

#### **4. Factual Background**

The Complainant, Ensco 1092 Limited (UK Co. No. 9231479) purchased certain assets of Outdoor Megastore Limited (UK Co. No. 3913663) out of administration via a Sale of Assets Agreement and associated Assignment of Intellectual Property concluded with the Administrators on 7 October 2014. These agreements specified various Business Rights, including the Domain Name, in the list of Assets to be transferred.

The Complainant took no timely action to contact the registrar (123-Reg) to record its claimed acquisition of the Domain Name.

In May 2018, the Complainant became aware that a website was actively using the Domain Name, apparently to promote sales via links to Amazon. (When inspected by the Expert, the website links to Amazon were operative – but did not appear to be directed to any particular Amazon seller. No information could be found identifying the operator of the website.) The Complainant discovered that the Respondent was identified as the current registrant of the Domain Name. It wrote to the Respondent asking for transfer of the Domain Name, based on its claimed acquisition of the Domain Name in 2014.

The Respondent, Identity Protect Limited, is a privacy protection business operated in connection with the registrar 123-Reg Limited, and is ultimately owned by GoDaddy Inc. The Respondent replied to the Complainant's request stating that the Domain Name was transferred to 123-Reg on 4 June 2015, and that 123-Reg had no record or knowledge of the Complainant's involvement with the Domain Name nor of the apparent selling party to the Sale of Assets Agreement. The Respondent refused to disclose the identity of its principal (i.e. the name of the beneficial owner of the Domain Name), which is concealed.

According to the WHOIS records provided by Nominet, the Domain Name was first registered on 24 November 1999 to a registrant identified as “Outdoor World”, with an address at 79-83 Rimrose Road, Bootle, L20 4HN. There were apparently no changes to those Registrant details until 14 October 2014, when the Registrar 123-Reg reportedly changed the Registrant to Identity Protect Limited (their WHOIS privacy service). It apparently provides a contact email address of [outdoormegastore.co.uk@identity-protect.org](mailto:outdoormegastore.co.uk@identity-protect.org) for the Domain Name owner.

## **5. Parties’ Contentions**

### **Complainant**

In the original Complaint, the Complainant simply asserted that it is the rightful owner of the Domain Name by virtue of the Assignment of Intellectual Property Rights from Outdoor Megastore Limited dated 7 October 2014. It claims that Outdoor Megastore Limited was the original registrant of the Domain Name.

It points to the definition of “Business Rights” under the Assignment, which makes specific reference to the Domain Name, and that all of the rights in and to the Business Rights, and therefore including rights to the Domain Name at issue were transferred to the Complainant.

The Complainant asserted that the Domain Name is an Abusive Registration as it is being used for a website by a party whom the Complainant has been unable to identify. It states that there is no relationship between the Respondent and the Complainant, and that, as the successor in title to the Domain Name, the Complainant has not given consent to the use of the Domain Name by any third parties.

It says that it is unclear as to how and/or on what basis the rights in and to the Domain Name have been “transferred” to and are being used by the party, as yet unknown (concealed by the Respondent) which is actually operating the website under the Domain Name.

The Complainant submits that the transfer of the registration to the Respondent creates an Abusive Registration in that it is a blocking registration against a Domain Name in which the Complainant has rights, and that, in addition or in the alternative, the registration unfairly disrupts the business of the Complainant in that they are unable to make use of the Domain Name, which they had acquired for value.

### **Remedy Requested**

Transfer of the Domain Name to the Complainant.

### **Respondent**

The Respondent did not provide any Response to the original Complaint.

### **Expert’s Request for Further Statements**

After an initial review of the Complaint, the Expert requested Further Statements from the Parties, pursuant to Paragraph 17.1 of the Policy (with supporting evidence, if available), to address points and apparent inconsistencies, as follows:

*“1. The Complainant has provided a copy of an Assignment of Intellectual Property dated 7 October, 2014 from Outdoor Megastore Limited (UK Co. Reg. 3913663) (“OML”) with an address at 107 Rimrose Road, Bootle, Liverpool, L20 4HN, to ENSCO 1092 Limited (“the Complainant”), which purports to transfer domain names, (including [outdoormegastore.co.uk](http://outdoormegastore.co.uk) (“the Domain Name”)), as “Business Rights”, which are also stated to include otherwise unspecified “Business Names”. The Assignment appears to have been executed as a collateral agreement to a separate Sale Agreement, a copy of which has not been provided. The Grant at paragraph 2 of the Assignment includes a rider “...save as expressly provided in the Sale Agreement”. The extent of any such savings is not explained. Paragraph 4 of the Assignment expressly excludes any covenant or guarantee as to title in relation to the Intellectual Property and Business Rights which it purports to assign - i.e. there is no warranty (or evidence) that OML had any of the rights purportedly assigned.*

*2. The Complainant has not offered any explanation as to why the Domain Name is now registered in the name of Identity Protect Limited, which is not a party to the Assignment. This raises the question of whether OML actually had a claim to any assignable Business Rights in the Domain Name at the date of the Assignment, or whether Identity Protect Limited, or some other unidentified party may have separately acquired rights to the Domain Name from the/a previous Registrant.*

*3. According to the Whois history records, provided by Nominet, the Domain Name was first registered on 24 November 1999 to a registrant identified as “Outdoor World”, with an address at 79-83 Rimrose Road, Bootle, L20 4HN. There were apparently no changes to the Registrant details until 14 October 2014, when the Registrar 123-Reg reportedly changed the Registrant to Identity Protect Limited (their WHOIS privacy service). It apparently provides a contact email address of [outdoormegastore.co.uk@identity-protect.org](mailto:outdoormegastore.co.uk@identity-protect.org).*

*4. The Companies House records for OML show that OML was not incorporated until 26 January 2000 - i.e. after the date of registration of the Domain Name; that it entered into administration as of 8 September 2014; and that it was dissolved on 10 December, 2015.*

*5. In the light of these facts, the Expert requests that the Complainant provide a Further Statement, with supporting evidence, if available, to explain how rights to the Domain Name, originally registered to “Outdoor World” in 1999 and held in that name until 14 October 2014, came to be held by OML, and why those rights would have been validly assignable by OML to the Complainant as at 7 October 2014. Additionally, the Complainant is requested to specify what actions it has taken to contact Identity Protect Limited to establish why the Registrant's name was changed on 14 October 2014, and whether Identity Protect Limited itself, or some undisclosed other party, has assumed any rights or a prior claim to hold the Domain Name (e.g.*

*they may conceivably have beneficial rights acquired via Reg-123 by virtue of the Registrar's contract with the original Registrant, if that original Registrant failed to pay for renewal or hosting of the Domain Name and possibly owed an undischarged debt to the Registrar - perhaps if "Outdoor World" failed to pay fees due, because it no longer traded).*

*6. This request should be copied to Identity Protect Limited, as the nominal Registrant, for them to respond with their own Statement and supporting evidence to explain their actions in changing the Registrant details in 2014, and to explain whether they, or some other undisclosed party whose identity they are concealing, do make any claim to rights in respect of the Domain Name and, if so, on what grounds."*

### **Complainant's Further Statement**

The Complainant stated that the Outdoor Megastore business is understood to have been established in around 1993, and that it was originally operated as an unincorporated body until January 2000, when it was incorporated under the name Outdoor Megastore Limited. The Complainant provided a copy of an article published in October 2014 in the Liverpool Echo which outlined the background to the business and its collapse. The article mainly refers to closure of the physical store premises. It does make passing reference to a "web presence" established by the business, but does not expressly refer to the Domain Name.

No information is said to be available relating to any assignment of rights to the Domain Name from the original registrant (Outdoor World) to Outdoor Megastore Limited.

A copy of the Sale of Assets Agreement between Outdoor Megastore Limited (in Administration), its Administrators, and the claimant is also provided. In line with standard practice relating to transfers from administrators, there are no warranties as to ownership. However, the Complainant asserts that the specific references made to the Domain Name would indicate that the administrators believed that the Domain Name was owned by the company Outdoor Megastore Limited at the date of the Assignment, and that they did have an ability to transfer the Domain Name to the Complainant at that time.

Responding to correspondence from the Complainant's representatives dated 29 May 2018, the Respondent's email reply of 27 June 2018 suggested that "the whois privacy does not impede the DRS procedure", which led the Complainant to take this route.

### **Respondent's Further Statement**

The Respondent asked that its brief statement be kept confidential and not be disclosed to the Complainant. Consequently, the Expert considers no admissible statement to have been made.

## **6. Discussions and Findings**

## General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

## Complainant's Rights

As defined in the Policy, “**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.”

In the present case, the Complainant claims rights pursuant to the contracts of 7 October 2014, being the Sale of Assets Agreement and the associated agreement for Assignment of Intellectual Property.

There is no doubt that these are potentially relevant contractual agreements. However, a major stumbling block for the Complainant is the inconsistency between the identity of the registrant of the Domain Name from the Nominet WHOIS record at the date of those Agreements – i.e. “Outdoor World”, with an address at 79-83 Rimrose Road, Bootle, L20 4HN - and the identity of the purported Assignor – i.e. Outdoor Megastore Limited, with an address at 107 Rimrose Road, Bootle, L20 4HN – together with the fact that the Domain Name was first registered as of 24 November 1999, prior even to the incorporation of Outdoor Megastore Limited on 26 January 2000.

The Complainant has not been able to offer any evidence of a transfer of ownership of the Domain Name from Outdoor World to Outdoor Megastore Limited. It simply says that the Administrators must have believed that Outdoor Megastore Limited had such rights because they were included in the Agreements of 2014. Neither has it offered any explanation for its failure to record the purported transfer of the Domain Name in 2014.

The Complainant's arguments are unconvincing. The Sale of Assets Agreement includes various Exclusions of Warranties, notably:

13.1 The Buyer [i.e. *the Complainant*] admits that the Buyer has inspected and made all investigations it wishes concerning the Assets and that the Buyer enters into this Agreement solely as a result of that inspection and investigation and on the basis of the terms of this Agreement and not in reliance upon representations or warranties whether written or oral express or implied made by or on behalf of the Seller or the Administrators or their employees or any agents or representatives thereof or any of them.

It is not uncommon for businesses to hold trading assets in the name of a different entity from the active trading entity, specifically to keep such assets outside of the control of a liquidator if the trading entity fails. That could conceivably have been the

situation here. If so, the Complainant may be the unfortunate victim of a failure of due diligence in having failed to obtain proof that the rights purportedly to be transferred were in fact actually held by Outdoor Megastore Limited at the time. As it is, there is no evidence that the Domain Name was so held. It is a fundamental principle of contract law that *nemo dat quod non habet* [no-one gives what they do not have] – Outdoor Megastore Limited could not then have validly assigned rights it did not actually possess, and the Complainant itself could not thereby have acquired any valid rights to the Domain Name.

There are, of course, possible exceptions to the *nemo dat quod non habet* principle, and the original registrant “Outdoor World” may itself have been a previously unincorporated business operating at a different address or under another trading style, which was subsumed into or taken over by Outdoor Megastore Limited at some time, but the Complainant has provided no evidence to support such a contention or any alternative. Indeed, the Complainant has not provided any evidence at all as to when or how the Domain Name was used, either at the time of or prior to the date of the Agreements. Nor has it provided any information as to who paid for renewal of the Domain Name and for the hosting of any website using the Domain Name before 7 October 2014, or who may have been paying for these since then.

Evidence of use might have been available, for example, from the Wayback Machine web archive at [web.archive.org](http://web.archive.org) or from accounts in the Records to which the Complainant evidently previously had access (and which are referred to in the Sale of Assets Agreement).

It is also pertinent to note that, whilst contractual rights may possibly be considered sufficient to establish that a party has “Rights in respect of a name or mark which is identical or similar to the Domain Name” as required under the Policy, that will not necessarily be so. The Appeal Panel in the Appeal Decision in DRS16584 (“[polo.co.uk](http://polo.co.uk)”) has noted that there is a difference between a contractual claim to rights **to** a Domain Name itself (as in the present case) as against a claim to have rights **in** a name or mark which is identical or similar to the Domain Name, which is what is required under the Policy.

Under the Sale of Assets Agreement, the Complainant ostensibly acquired rights to use the Business Name “Outdoor Megastore” without objection from the Seller. However, Clause 10 of the Agreement still allowed for continued use of the Business Name by the Seller (Outdoor Megastore Limited) and the Administrators, although such use must have ceased by 10 December 2015 when the Seller was dissolved. There were no registered trade mark rights to the Business Name.

Prior use of the Business Name might have given rise to relevant Rights for the purpose of the Policy, if such use had been sufficient to establish reputation and goodwill in the Business Name. However, although the Liverpool Echo article suggests that some goodwill might possibly have existed in 2014, the Complainant has provided no substantive evidence of the nature and extent of such goodwill (e.g. of the extent of promotional and sales activities using the Business Name).

Furthermore, neither the Sale of Assets Agreement nor the Assignment of Intellectual Property provided for the acquisition of any goodwill in the Business Name or

Business Rights. Indeed, it is expressly stated under Clause 5 of the Sale of Assets Agreement that the sale was not of the Seller's business as a going concern.

Consequently, there would appear to be no possibility for the Complainant to claim any common law rights in the Outdoor Megastore name by virtue of goodwill established by its prior use, and any such residual goodwill would likely have been extinguished by now in any event.

In conclusion, the Expert is not convinced that the Complainant has actually acquired the contractual rights to the Domain Name on which this Complaint is based (on the face of it, as Outdoor Megastore Limited was not the registrant of the Domain Name, it would not itself have had the right to the Domain Name that it purported to assign) and, regardless of the contractual position, in line with the distinction drawn in the polo.co.uk Decision referenced above, the Expert considers that such a bare contractual right to the Domain Name would not alone be sufficient to constitute Rights in a name or mark similar or identical to the Domain Name for the purposes of the Policy. Further, although the possible existence of common law rights in the Business Name might otherwise have provided basis for a claim to appropriate Rights, the Complainant has not demonstrated that it has any such Rights.

Accordingly, in the absence of a showing of Rights under the Policy, the Complaint must necessarily fail on this ground.

### **Abusive Registration**

The Complainant would also have had to show that the disputed Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines "Abusive Registration" as a Domain Name which either:

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

Given the Expert's finding that the Complainant lacks relevant Rights under the Policy, it is not necessary to make a detailed analysis or finding on this aspect.

However, the Expert does wish to comment on the Respondent's assertion in its email to the Complainant that "the whois privacy does not impede the DRS procedure". In the Expert's view, the lack of disclosure of the true identity of the beneficial owner of the Domain Name and the person or entity which instructed 123-Reg to conceal their identity clearly does impede a Complainant from obtaining appropriate information to determine the appropriate course of action.

In the present case, the timing of the concealment action taken shortly after the completion of the Agreements, and the subsequent, apparently commercial, operation of a website using the Domain Name to route potential sales generally to Amazon, and without any proper identification of the name and address of the party operating



the website, does rather suggest that something dubious has been going on. It is conceivable that this could involve someone previously involved with the Seller, who may have made misrepresentations about the Domain Name to the Administrators and/or the Complainant in 2014, and then sought to frustrate the intentions of the Agreements. The motives can only be speculation without knowledge of the person behind the current use of the Domain Name.

The e-Commerce Regulations (Section 6(1)) specifically require an “information society service provider” (e.g. a commercial website operator) to make publicly available the following information as a minimum:

- (a) the name of the service provider;
- (b) the geographic address at which the service provider is established;
- (c) the details of the service provider, including his electronic mail address, which make it possible to contact him rapidly and communicate with him in a direct and effective manner.

In the Expert’s view, it must be objectionable that individuals or enterprises operating websites like that using the Domain Name, for apparently commercial purposes, are able to rely on so-called privacy services to conceal their identities. If a domain name is being used for such purposes, without providing the identification information required by the e-Commerce Regulations, then there is surely a strong case that the privacy service responsible for concealing that information should be obliged to disclose it.

As it stands, the Complainant would certainly seem to have reasonable grounds to want to know who the Respondent’s real client actually is, who has been paying to maintain the Domain Name and the website hosting, and who has been setting that website up (including possibly their login ID and IP addresses), particularly if their real identity is hidden behind a trading style, such as appears to have been the case with “Outdoor World”.

There is no power to require such disclosure under the Policy. If it wishes to pursue its claims, therefore, unfortunately, it would seem that the Complainant may have no other option but to take appropriate Court action.

## **7. Decision**

As the Expert has found that the Complainant has failed to show that it has applicable Rights in accordance with the Policy the Complaint is dismissed. No action is to be taken.

**Signed .....**  
**Keith Gymer**

**Dated 8 January, 2019**