

# **DISPUTE RESOLUTION SERVICE**

**D00022258**

## **Decision of Independent Expert**

Ejot Uk Limited

and

Get Fletch Ltd

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

Complainant: Ejot Uk Limited  
Address: Hurricane Close  
Sherburn In Elmet  
LEEDS  
Yorkshire  
LS25 6PB  
United Kingdom

Respondent: Get Fletch Ltd  
Address: 1 Lumley Walk  
Leeds  
West Yorkshire  
LS4 2NR  
United Kingdom

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

liebig.co.uk (the "Domain Name")

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

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the “Policy”) unless the context or use indicates otherwise.

23 January 2020	Dispute received
23 January 2020	Complaint validated and notification of complaint sent to the parties
11 February 2020	Response reminder sent
12 February 2020	Response received and notification of response sent to the parties
17 February 2020	Reply reminder sent
18 February 2020	Reply received and notification of reply sent to the parties
21 February 2020	Mediator appointed
24 February 2020	Mediation started
28 April 2020	Mediation failed
28 April 2020	Close of mediation documents sent
30 April 2020	Expert decision payment received

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

The Complainant and Sormat Oy (registered in Finland) (“Sormat”) are both companies within the EJOT Group. Sormat is the owner of a registered trademark in the name LIEBIG and has authorised the Complainant to act on its behalf in this Complaint.

Sormat designs and manufactures fixing products for construction and general industry including high load anchors for use in concrete under the trade mark LIEBIG. In 2017 Sormat became part of the EJOT group of companies and the Complainant took over distribution of LIEBIG products in the UK.

The previous registrant of the Domain Name, Avantifix (Fixing Solutions) Limited (“Previous Registrant”) had entered into an agreement (“Agreement”) with Sormat on or around 1 October 2013 to act as Sormat’s exclusive distributor in the UK.

The Previous Registrant engaged the Respondent to develop a website to sell LIEBIG products. The Domain Name was registered in the name of the Previous Registrant on 3 June 2014.

The Previous Registrant went into liquidation and commenced winding up on 21 October 2019. On 11 November 2019 the Respondent transferred the registration of the Domain Name to itself.

Avantifix Limited (“Avantifix”), was incorporated on 26 September 2019 and subsequently acquired the Previous Registrant’s assets from the liquidators. The Response was submitted by Avantifix.

## **5. Parties' Contentions**

### **The Complaint**

#### ***Complainant's Rights***

The Complainant's assertion of rights in the name LIEBIG is that its sister company in the EJOT group of companies, Sormat, is the owner of a UK registered trade mark LIEBIG (UK00001037884 registered on 6 November 1974,) and that by written authority dated 7 November 2019 the Complainant is authorised to act for Sormat in the UK.

#### ***Abusive Registration***

The Complainant's assertions of Abusive Registration are:

1. In June 2016 the Complainant paid £1,365 for the transfer of the Domain Name from the Previous Registrant to the Complainant. The Previous Registrant failed to make the transfer but did include a statement on the website at [www.liebig.co.uk](http://www.liebig.co.uk) (the "Website") acknowledging Sormat as the owner of the Domain Name.
2. The Complainant entered into discussions with the Previous Registrant during 2018 to take control of the Website. The Previous Registrant asked for additional sums to be paid and failed to make the previously agreed transfer of the Domain Name. Mike McElhatton (the director of the Previous Registrant) claimed that the previous payment was for the development of the Website; this is not the Complainant or Sormat's understanding. The Previous Registrant's invoice refers to the Domain Name rather than any development work. The Complainant and Sormat believe that this was an attempt to persuade them to make an additional payment for the transfer of the Domain Name
3. The Complainant has approached the liquidators of the Previous Registrant who confirmed that such right, title and interest as the Previous Registrant had in its business has been transferred to Avantifix.
4. It appears from correspondence with the liquidators and with the Respondent (in particular an email from the Respondent between 27 and 28 November 2019) that the transfer of the Domain Name to the Respondent was initiated by the Respondent rather than by the liquidators.
5. Neither the Respondent nor Avantifix has an ongoing role as distributor of LIEBIG products. Any permission granted to the Previous Registrant to use Sormat's trade mark and the Domain Name has been revoked. There is no reasonable justification for the transfer of the Domain Name to the Respondent.
6. The Complainant attempted to engage with the Respondent to obtain a voluntary transfer of the Domain Name and has offered to pay the associated costs but has not made any progress. The Respondent is taking instructions from the director of the Previous Registrant (and a director of Avantifix) in relation to the Domain Name and is therefore relying on the Previous Registrant's claim that the payment of £1,365 by Sormat was for development work.

## The Response

The Response was submitted by Alex McElhatton (Finance Director) on behalf of Avantifix, No express permission or authority to act on behalf of the Respondent has been presented in the papers before me.

Nevertheless, I have set out below the statement from Avantifix as to why the Complaint should not succeed:

1. The payment of £1,365.00 made by Sormat to the Previous Registrant was for development of the Website.
2. The majority of emails and discussions regarding the development of the Website were instructed by a previous employee of the Previous Registrant who is now an employee of the Complainant. This employee had no authority to negotiate a transfer of the Domain Name and nor did a transfer ever occur.
3. The statement on the Website that the Complainant says indicates the ownership of the Domain Name was not authorised by the Previous Registrant; it has since been removed. Any communications to add this statement to the Website were from Sormat and/or the previous employee to the Respondent.
4. Mike McElhatton was the sole director and shareholder of the Previous Registrant and in any communication with Sormat and the Complainant he has never stated that the payment was for the transfer of the Domain Name.
5. The invoice evidence by the Complainant for the payment was typed by a purchase ledger clerk, with 'website – domain name' merely being a customer order reference. The invoice evidence submitted with the Response shows that the Previous Registrant engaged the Respondent 'for the website build for the domain liebig.co.uk'. The second invoice submitted with the Response is the Respondent's claim for fees to the Previous Registrant for renewal of the Domain Name. The Previous Registrant has always paid the Domain Name renewal fees and no invoice was raised to Sormat.
6. The handwritten note on the Complainant's evidenced invoice stating 'liebig.co.uk' was written by Sormat not by the Previous Registrant. The invoice only states 'Liebig Website'; the blue writing has been added by Sormat or the Complainant to falsely enhance the claim.
7. Mike McElhatton and Sormat had discussions that the Website required development to push the brand forward, and this required a contribution from Sormat. The amount paid by Sormat (of £1365.00) is not the true value of the Domain Name but is in line with development costs.
8. If a transfer had taken place, the Previous Registrant and Sormat would have written up a contract; neither did this.
9. Sormat has never disputed that development work was carried out. If the invoice was for the transfer of the Domain Name, why was an additional invoice for the development work never produced?
10. The development works was carried out in 2016. When Sormat became part of the Ejot group, the Complainant raised the issue of the Domain Name and was told that the payment in 2016 had been for development work.

11. Due to the liquidation of the Previous Registrant, its computer system can no longer be accessed but there are emails evidencing that the Complainant offered to buy the Domain Name but a fee could not be agreed. The Complainant should have copies of these emails.
12. Avantifix purchased the assets of the Previous Registrant from the liquidators and the value of the Domain Name was part of the negotiations for the value of the assets.
13. The liquidators have told the Complainant that Avantifix is owner of the Domain Name.
14. It is also worth noting that the domain 'Liebig.com' is owned by an Italian food company.

## **The Reply**

The Complainant submitted a Reply:

1. No explanation has been provided as to why the Domain Name was transferred to the Respondent rather than Avantifix on the insolvency of the Previous Registrant. No authority has been provided for Avantifix to respond on behalf of the Respondent. The Complainant did not contact Avantifix prior to filing the Complaint because Avantifix has no standing in this dispute.
2. Neither the Complainant nor Sormat has any relationship with Avantifix nor is Avantifix an authorised distributor of the Liebig products.
3. The Response relies on actions taken by employees of the Previous Registrant which are claimed to have taken place without the authority or approval of the Previous Registrant's management. No evidence has been provided of this lack of authority. The subsequent employment of one of the employees by the Complainant followed an approach to the Complainant by that employee and that did not occur until the first quarter of 2018. This is irrelevant to the Complaint.
4. The Response claims that either Sormat or the previous employee instructed the addition of the ownership statement to the Domain Name, but no evidence of this is submitted. Even if this wording was added at Sormat's request, it was not queried by the Previous Registrant at the time and remained on the Website for some time, which indicates that the Previous Registrant had no objection to it. The statement was only removed after the Complaint was filed.
5. The Response alleges that the handwritten reference to the Domain Name to the invoice submitted in evidence was added to falsely enhance the claim. The Complainant confirms that this was a note added as part of Sormat's internal record keeping process. The typed elements of the invoice still clearly refer to the Liebig website and the reference "domain name".
6. The Response claims that the payment of £1,365 does not reflect the true value of the Domain Name but is in line with development costs only. The invoice for the development work suggests that the cost was around £1,190, indicating that the amount actually charged is in excess of development costs.
7. Given that the direct costs of registering a domain name are relatively low, and that any goodwill in the Liebig name is owned by Sormat as the trade mark

owner, any attempt by the Previous Registrant or Avantifix to profit from any increase in value generated by the use of the Domain Name, under the permission granted by Sormat during the distribution relationship, is in itself abusive.

8. The Response suggests that there should have been a contract for the purchase of the Domain Name. This is not a strict legal requirement and in any event the distribution agreement between the parties already stated that all intellectual property rights belong to Sormat.
9. The Response includes an invoice that is claimed to be for renewal fees. It is, however, an invoice for hosting fees which does not prove who owns the Domain Name. It also does not prove that this cost was not then passed through to the Complainant. In any event, even if it was not passed through, the Previous Registrant's failure to invoice the Complainant for fees relating to the Website does not prove that the Previous Registrant owned the Domain Name.
10. The Response claims that email correspondence has not been provided. This was provided at Annex H to the Complaint and does not prove that the Domain Name belonged to the Previous Registrant. It shows that there was a difference of opinion as to ownership which the Complainant was attempting to resolve from early 2018 onwards.
11. The Response claims that Avantifix's payment of a fee for the assets of the Previous Registrant makes it the owner of the Domain Name. The Complainant's understanding is that the purchase from the liquidators is of such right, title and interest as the Previous Registrant had in the assets. If the Previous Registrant did not own the Domain Name, the liquidators would not have been able to transfer any rights in it to Avantifix and it is usual for the risk that assets are not transferable to rest with the buyer in such sales.
12. The ownership of the liebig.com domain name is irrelevant.

## **6. Discussions and Findings**

### **General**

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test that:

*2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

### **Complainant's Rights**

Rights is defined in §1 of the Policy 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”.

The wholly generic suffix “.co.uk” may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced a long standing trade mark in the name LIEBIG which, as confirmed in several first instance DRS decisions and the appeal panel in DRS 2802 (ruggedcom.co.uk), is sufficient to demonstrate Rights for the purposes of §1 of the Policy.

Accordingly, I find that the Complainant has Rights in the name LIEBIG which is identical to the Domain Name.

### **Abusive Registration**

Abusive Registration is defined in §1 of the Policy 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy which includes the following:

*5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*5.1.1.1 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;*

.....

*5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;*

.....

*5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant’s mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.*

The crux of this Complaint is that the Complainant says it paid the Previous Registrant for the transfer of the Domain Name in 2016 whilst Avantifix says that the payment in 2016

was for the development of the website and that the Domain Name was owned by the Previous Registrant and now by Avantifix (having purchased the assets of the Previous Registrant following its liquidation).

It is clear that the original registration of the Domain Name and the development of the Website was for the purposes of promoting Sormat products in the UK by the Previous Registrant. However, neither party presents satisfactory evidence to establish whether or not the Complainant paid for, and the Previous Registrant agreed to, the transfer of the Domain Name to the Complainant. The DRS provides a low cost, informal and quick procedure for resolving domain name disputes in a fair manner. The DRS is not a forum for presenting evidence that requires cross examination to test the arguments and evidence presented or to assess the credibility of the witnesses, to uncover the truth of events at registration and subsequent use of the Domain Name.

Accordingly, as is the norm in DRS cases, I will reach my decision on the basis of the written arguments and evidence in the papers before me and which the parties have elected to make available to me. On that basis, I am not able to reach a decision as to which side's explanation of the arrangements, with regard to whether or not there was an agreement to transfer the Domain Name to the Complainant, is correct.

It is not disputed that Sormat entered into an Agreement with the Previous Registrant to distribute Sormat's LIEBIG products and that Agreement clearly states that ownership of all intellectual property in the name LIEBIG remains with Sormat. The Complainant has evidenced that the Website at the time of the Complaint included the statement "*© Copyright – All rights reserved. This website is administered and operated by Avantifix (Fixing Solutions) Limited, UK, on behalf of and with a permission from the domain owner Sormat Oy, Finland.*" as a footer on the Home Page (the "Statement"). The Complainant is correct in its assertion that the Statement has now been removed by the Respondent following the receipt of this Complaint and it is no longer present as a footer on the Home Page of the Website. However, the Statement remains as the opening sentence on the Legal Page of the Website where it is immediately followed by "*The content of this web site may not be copied, disseminated, altered or made accessible to third parties for commercial purposes without written authorization from Sormat Oy, Finland.*". I also note that the footer on the Home Page now states "*© Copyright – All rights reserved. This website is administered and operated by Avantifix Limited, UK*".

I do not accept Avantifix's assertion that the Statement should not have been present on the Website; the fact is that it was present and no evidence has been submitted to the contrary. Furthermore, Avantifix has not explained why the first sentence on the Legal Page has not been removed. I can only conclude that neither Avantifix nor the Respondent is completely aware of the content of the whole Website.

The Website remains active and offers LIEBIG products. The Complainant says that neither Avantifix nor the Respondent is authorised to use the LIEBIG trademark or to distribute LIEBIG products. Avantifix has had the opportunity to evidence that it does have such authority but it has not done so. I therefore accept the Complainant's statement.

The new footer on the Home Page makes the false representation that the copyright in the content of the Website is claimed by Avantifix and that Avantifix administers and operates



the Website with the authorisation of Sormat and/or the Complainant and that Avantifix is an authorised distributor of LIEBIG products.

Avantifix has responded to the Complaint with what I can only conclude is the Respondent's agreement and thus it can also be concluded that the Respondent agrees with Avantifix's assertions that Avantifix purchased the Domain Name as part of the Previous Registrant's assets and the Previous Registrant owned the Domain Name. In the period following the Previous Registrant's liquidation the Respondent transferred the Domain Name to itself for reasons which have not been explained.

The Agreement establishes that the Previous Registrant has no intellectual property rights in the name LIEBIG and thus Avantifix could not have acquired any such rights in purchasing the assets of the Previous Registrant. Avantifix says that the Previous Registrant's invoice in 2016 was for the development of the website; any further development costs incurred by the Previous Registrant are now lost in the liquidation. A demand for anything more than the reasonable costs of transfer would indicate Abusive Registration.

Whether Avantifix's purchase of the Previous Registrant's assets included the right to the registration of the Domain Name is not capable of resolution in this forum for the reasons already explained. The DRS can only establish whether the acquisition and/or current registration and/or use of the Domain Name in the hands of the Respondent is Abusive on the papers submitted. For that purpose, the Respondent has not evidenced any reason for such acquisition and use.

Accordingly, I find that the Domain Name is an exact match for the name or mark LIEBIG in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having acquired the Domain Name, which is evidence of Abusive Registration pursuant to §5.1.6 of the Policy. I cannot conceive of any legitimate use of the Domain Name by the Respondent. Furthermore, the Respondent's acquisition of the Domain Name falls squarely into the "*high risk activity insofar as the DRS Policy is concerned*" referred to by the appeal panel in *World Wrestling Entertainment, Inc. -v- Daniel Raad* (DRS 16416) and is therefore likely to fall within §5.1.2 of the Policy indicating that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

For the avoidance of doubt, had Avantifix evidenced that it had acquired the registration of the Domain Name from the liquidators, or had the Domain Name been transferred to Avantifix by the Respondent, I would have reached the same conclusion for the reasons stated above.

Thus, the acquisition and use of the Domain Name by the Respondent amounts to Abusive Registration and there are no circumstances presented in the papers before me that would lead me to find otherwise.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant.

**Signed** .....

**Steve Ormand**

**Dated: 29<sup>th</sup> May 2020**