

# Nominet UK Dispute Resolution Service

**DRS 5876**

## **Mash Direct Limited v. Paul Liesching**

### **Decision of Independent Expert**

#### **1. Parties**

Complainant: Mash Direct Limited  
Address: 81 Ballyrainey Road  
Comber  
Newtownards  
Co. Down  
Postcode: BT23 5JU  
Country: GB

Respondent: Paul Liesching  
Address: 88 Portobello Road  
London  
Postcode: W11 2QD  
Country: GB

#### **2. Domain Name**

The domain name in dispute is *mashdirect.co.uk* ("the Domain Name").

#### **3. Procedural Background**

- 3.1 The Complaint was received in full by Nominet on 16 July 2008. Nominet validated the Complaint and sent a copy to the Respondent the same day, informing him that he had until 7 August 2008 to lodge a Response.
- 3.2 The Respondent's Response was received by Nominet in hard copy on 7 August 2008 and was forwarded to the Complainant the same day. The Complainant's Reply was received and forwarded to the Respondent on 19 August 2008. The dispute then proceeded to Informal Mediation, starting on 26 August 2008. This was unsuccessful.
- 3.3 On 3 October 2008 the Complainant paid Nominet the required fee to obtain a decision of an Expert pursuant to paragraph 7(a) of the Nominet UK Dispute Resolution Service ("DRS") Policy ("the Policy"). Nominet invited me, Anna Carboni, to provide a decision on this case and, following confirmation to Nominet that I knew of no reason why I could not properly accept the invitation to act in this case and of no matters which ought to be drawn to the attention of the parties that might appear to call into question my independence and/or impartiality, Nominet appointed me as Expert on 10 October 2008.

#### **4. Outstanding Formal/Procedural Issues**

- 4.1 There are no formal or procedural matters to deal with before turning to the facts.

## 5. The Facts

- 5.1 The Complainant, Mash Direct Limited, is a private limited company incorporated in Northern Ireland. It trades from premises in Co. Down, Northern Ireland, under the name "Mash Direct" and has done so since 2004 when its owners, Martin and Tracy Hamilton, decided to expand their potato and vegetable growing business into the production and marketing of a range of chilled, prepared vegetables. These are sold through retail outlets, including all major supermarkets in Southern and Northern Ireland, and food services companies under the brand name "Mash Direct".
- 5.2 The Complainant is the registered proprietor of United Kingdom registered trade mark no. 2399228, registered as of 12 August 2005 in respect of "steam cooked and mashed potato and vegetable products". This trade mark is depicted below:



- 5.3 The Complainant is the registrant of the domain name *mashdirect.com* and advertises and promotes its Mash Direct business through a website at *www.mashdirect.com*.
- 5.4 The Respondent is an individual called Paul Liesching, who lives in London, England. He is the son of Eardley Liesching, who worked as a contractor for the Complainant and/or its owners from around the time the Mash Direct business was set up until April 2008.
- 5.5 The Respondent registered the Domain Name on 23 October 2003. The Domain Name resolves to the Complainant's website.
- 5.6 In the evening of 7 February 2008, Neil Houghton of the Complainant sent an e-mail to the Respondent in the following terms:

"Paul,  
I look after various elements of the Mash Direct IT infrastructure. I have been into this account that you have created and changed the password. It would however be simpler if you could transfer it to our current provider who is Fast Hosts.  
[domains@fasthosts.co.uk](mailto:domains@fasthosts.co.uk) Collette at Laird Design looks after these for us.  
[collette@ld2.com](mailto:collette@ld2.com) If you have already transferred to 123 never mind, but we would like to keep them together. Let me know.  
Regards  
Neil Houghton"

- 5.7 The Respondent responded by e-mail the same evening, saying:

"Thanks Neil ill (sic.) get on it tomorrow. I don't think it has completed yet so I may be able to head it off at the pass.  
Ill let you know.  
Regards  
Paul"

- 5.8 On or shortly before 27 February 2008, Mr Houghton submitted a request to Nominet to change the identity of the registrant of the Domain Name from the Respondent to the Complainant. Nominet responded on 27 February 2008, stating that this would amount to a registrant transfer, which required completion of a registrant transfer form and a confirmatory letter from both parties, agreeing to the transfer, as well as identification of any individual involved by producing a copy of a utility bill or driving licence.
- 5.9 Mr Houghton immediately forwarded a copy of Nominet's e-mail to the Respondent, asking him to fill in the transfer form and send a photocopy of a utility bill, so that he could organise the transfer. The Respondent replied by e-mail the same day, stating:

"Ok Neil understood, we have moved house so will have to dig up an old bill."

- 5.10 Following this exchange, the Respondent failed to assist in arrangements for transferring the Domain Name. The Complainant therefore brought this Complaint.

## 6. The Parties' Contentions

### Complainant

- 6.1 The Complainant claims rights in the name "Mash Direct", based on the following facts:
- (1) Since about 2004, the Complainant's company name has been Mash Direct Limited; it has traded under the name "Mash Direct"; and its chilled vegetable products have been marketed under the brand name "Mash Direct".
  - (2) The Complainant has spent about £135,000 on advertising under the "Mash Direct" brand. It recently purchased a double decker bus and emblazoned this with the MASH DIRECT company logo (photographs are provided).
  - (3) The Complainant owns the UK registered trade mark referred to in paragraph 5.2 above.
  - (4) The Complainant is the registered proprietor of the domain name *mashdirect.com*, which directs internet users to its website at *www.mashdirect.com* through which it promotes its business.
- 6.2 In relation to the Respondent and the Domain Name, the Complainant says:
- (1) The Respondent's father, Eardley Liesching, was engaged as a contractor by the Complainant from about 2004. (The Complainant initially stated that Mr Liesching senior was an employee of the Complainant, but this was corrected in the Reply.)
  - (2) Due to his knowledge of the internet and related matters, Mr Liesching senior proposed that his son should register the Domain Name, which was done in 2004.
  - (3) Numerous attempts since then to move the Domain Name into the Complainant's hands have failed. Recent correspondence suggests that the Respondent wishes to retain the Domain Name and to make financial gain through doing so.
  - (4) Mr Liesching senior's engagement was terminated in April 2008. It appears from the Response (see below) that the termination of the engagement has led to the Respondent's refusal to transfer the Domain Name.
  - (5) At no stage has the Respondent asserted that either he or his father has any proprietary rights in the Domain Name. On the contrary, the e-mails referred to at paragraphs 5.6 to 5.9 above showed the Respondent's willingness and agreement to transfer the registration to the Complainant. Any claims made in the Response to the opposite effect are refuted.
  - (6) The Respondent's claim to own the domain name *mashdirect.com* is untrue: the Complainant owns and maintains that domain name at its own cost.
  - (7) The Complainant has paid costs associated with the Domain Name. (A copy of an invoice dated 17 October 2007 is produced, showing that the Complainant was charged £150 plus VAT for renewal and hosting of the Domain Name, though this does not actually show who paid the sum.)
  - (8) The Respondent has no legitimate business, commercial or financial reason to remain registrant of the Domain Name.
- 6.3 The Complainant requests that the Domain Name be transferred to it.

### Respondent

- 6.4 The Respondent claims to have "rightful ownership" of the Domain Name, based on the following facts:

- (1) The Respondent's father worked for Mr and Mrs Hamilton from mid to late 2004, initially as a contractor working on the building of their factory, set up to produce potato products, and then to instigate the initial marketing of those products. Mr Liesching senior had no contract of employment or supply contract with the Hamiltons or the Complainant.
- (2) The Complainant's directors initially wanted to call the company "The Mashed Potato Company" but, on finding this name was not available, asked Mr Liesching senior to come up with a name. He conceived the name "Mash Direct" and suggested it to the company, which accepted it. He also enlisted his son, the Respondent, to register the domain names *mashdirect.com* and *mashdirect.co.uk*.
- (3) Mr Liesching senior also conceived the Complainant's company name.
- (4) At no time has "the ownership or the IPR" in the domain names and the company name been transferred to the Complainant.
- (5) "Since the registration of the domain", the Respondent has paid all costs associated with the Domain Name and has never requested monies from the Complainant.
- (6) The Respondent has a "fair claim to the ownership of the IPR which encompasses the *.co.uk* and *.com* web address and the company name".
- (7) The Complainant's suggestion that the Respondent wishes to make financial gain by retention of the Domain Name is a scurrilous lie with no basis in truth or fact. The Respondent has simply acted in the interests of fair play. On the contrary, this accusation is illustrative of Mr and Mrs Hamilton's shoddy business practices, and it is they who are "at best economical with the truth and at worst inveterate liars".

6.5 The Respondent then makes the following assertion:

"The domain appears to have been transferred to the complainants design company Laird Design. The respondent assumes that some form of legal deed must have changed hands in order to allow this to happen. The respondent recalls no time at which this was provided, which would lead to the inevitable assumption that something was "created" in order to enable the transfer to happen."

6.6 He exhibits e-mail correspondence between himself and Collette McGrade of Lairdesign in early July 2008, in which he claimed to have registered both the Domain Name and *mashdirect.com* and not to have authorised any transfer of ownership to Lairdesigns (which he appears to think has happened at that point), and requested that both domain names be transferred back to him. In a chaser e-mail, he threatened to pursue the matter through the courts. Ms McGrade responded as follows:

"As stated in our Telephone discussion, I do not have proof of the transfer of *mashdirect.co.uk* in 2005, though I do remember some email communication to and from you which I believe resulted in an email stating that you had allowed for a transfer to begin and the details for this to occur. I no longer have the emails or the PC which I used at this time.

Mashdirect.com was registered by myself on behalf of the client in 2005, I am unaware of any other ownership on this domain ever other than ourselves/Mash Direct.

Please contact our client Mash Direct if you have any further queries on either of these domains."

6.7 The Respondent ends the Response with an assertion that he does not wish to cause the Complainant undue hardship, so he suggests that the Complainant continues to use the domain names in perpetuity at no cost, while the Respondent remains the owner of the domain names.

6.8 I have reviewed all of the parties' respective exhibits as well as the Complaint, Response and Reply, and I take these all into consideration in reaching my decision.

## 7. Discussion and Findings:

### General

- 7.1 Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:
- i. it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

### Complainant's Rights

- 7.2 Under paragraph 1 of the Policy, "**Rights** includes, but is not limited to, rights enforceable under English law". Previous cases have established that this broad definition extends to registered trade mark rights and unregistered rights in names and marks, such as rights in passing off in the United Kingdom and similar rights in jurisdictions elsewhere.
- 7.3 I have no doubt that the Complainant has Rights in the name "Mash Direct" by virtue of its registered trade mark and its four years of trading under the Mash Direct name and brand.
- 7.4 Even if all the facts asserted by the Respondent were true, they would not detract from the existence of these Rights or their ownership by the Complainant. It is the Complainant that owns the registered trade mark; and it is the Complainant that has traded under the name Mash Direct and thereby built up goodwill in its prepared and cooked potato and vegetable business under that name. I consider below whether the Respondent's assertions nevertheless establish that the Respondent (and/or his father) also own(s) relevant rights and/or support the Respondent's defence to this Complaint.
- 7.5 I have to ignore the *.co.uk* suffix in considering the identity or similarity of the Domain Name to the name "Mash Direct". It is also appropriate to ignore the space between "Mash" and "Direct" because it would not appear in a domain name. On that basis, I find that the name "Mash Direct" is identical to the Domain Name for the purpose of the Policy.
- 7.6 The first limb of the test in paragraph 2 of the Policy is therefore satisfied.

### Abusive Registration

- 7.7 Paragraph 1 of the Policy defines an "**Abusive Registration**" as:
- "a Domain Name which either:
- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
  - (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."
- 7.8 I must take into account all relevant facts and circumstances which point to or away from the Domain Name being an Abusive Registration.
- 7.9 Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. Those that are relevant to this case are as follows:
- "3(a)(i) 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;

(B)...; or

(C) for the purpose of unfairly disrupting the business of the Complainant;

(ii) ...; (iii) ...; (iv) ...; or

(v) The domain name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

(A) has been using the domain name registration exclusively; and

(B) paid for the registration and/or renewal of the domain name registration."

- 7.10 The last of these factors, under paragraph 3(a)(v), is close to the situation in this case. Although the Respondent did not have a direct employment or general contractor relationship with the Complainant, he registered the Domain Name to help out the Complainant because his father asked him to do so, in his father's capacity as a contractor to the Complainant or its owners/directors. He therefore at the very least had a business understanding with his father, whom he knew to be acting on behalf of the Complainant, to the effect that he was to register the Domain Name for the benefit of the Complainant.
- 7.11 It is unclear whether the Respondent had any direct dealings with the Complainant at that time, other than through his father, but I do not think that this matters. The nature of the arrangement was such that all parties were aware that the Domain Name was effectively the Complainant's, subject to payment of the registration fee.
- 7.12 Neither side states who actually paid the initial registration fee, but I conclude from the evidence on the balance of probabilities that the Complainant did. The Respondent claims to have paid all costs associated with the domain name "since the registration" (my emphasis). I would expect him to have made the point specifically if he had paid for the registration itself without being reimbursed. The Complainant's recent renewal invoice, made out to "Mash Direct" at the Complainant's address, also persuades me that the Complainant has taken responsibility for renewal fees.
- 7.13 As far as paragraph 3(a)(i)(A) is concerned, the Complainant makes a general assertion that the Respondent appears to wish to make financial gain by retaining the Domain Name. Although I can understand why the Complainant might suspect this, I have not seen anything in the file that gives direct support to such a suspicion. I am not prepared to draw such an inference from the circumstances, particularly in the light of the Respondent's offer to allow the Complainant to continue to use the Domain Name in perpetuity at no cost.
- 7.14 In relation to paragraph 3(a)(i)(C), the Respondent clearly did not register the Domain Name in the first place for the purpose of unfairly disrupting the Complainant's business. However, it is certainly not a comfortable position for the Complainant to be in to know that the Domain Name is registered and controlled by the son of a contractor whose contract has been terminated, who himself is on unfriendly terms with the Complainant's owners/directors. While the Domain Name currently points to the Complainant's website, the Complainant has no control over whether this continues to be the case, and there is clearly potential for mis-use.
- 7.15 I have considered whether any of the reasons put forward by the Respondent for holding onto the Domain Name match up to the factors that are listed in paragraph 4 of the Policy as evidence to demonstrate that the Domain Name is not an Abusive Registration. They do not. However, I note that paragraph 4(a)(iii) suggests that, if the Respondent's holding of the Domain Name were consistent with an express term of a written agreement between the parties, this might assist him.

- 7.16 The position in this case is far removed from the example in 4(a)(iii). Not only was there no written agreement, but even the Respondent's own evidence does not support the existence of any implied agreement to the effect that he was entitled to retain the Domain Name. As I have said above, the Respondent and his father both knew the registration was for the benefit of the Complainant at the time; it has always been used for that purpose; and the Respondent gave clear written indications in his e-mail correspondence with Mr Houghton in February 2008 that he intended to take the necessary steps to transfer the Domain Name to the Complainant in order to regularise the position.
- 7.17 From the Respondent's explanation about his father having come up with the name "Mash Direct" in the first place, and his assertion that the "IPR" (intellectual property rights) have not been transferred to the Complainant, it seems that the Respondent is under the impression that he or his father own some rights in the name and are thereby entitled to hold onto the Domain Name. Unfortunately for the Respondent, it is not the idea for a name that gives rise to rights; it is the use and registration of the name which does that. I have not been presented with any evidence to support a finding that the Respondent or his father own rights that afford the Respondent the right to retain the Domain Name, or that the Complainant agreed that the Respondent should remain the registrant after the initial registration.
- 7.18 It does not seem to me that the Respondent's explanation about the company name or the .com domain name assist him. Even if he or his father secured the company name in the first place, that name is simply the name of the Complainant, and there is no separate registration in which the Respondent or his father can claim rights. In relation to the .com domain name, the WHOIS search print-out provided by the Complainant shows that this was registered in the name of the Complainant on 30 April 2005, which is also corroborated by the Respondent's exhibited e-mail from Ms McGrade of Lairdesign, which I have quoted above.
- 7.19 In summary, while the Complainant has a strong business reason for owning the Domain Name which was registered on its behalf in the first place, the Respondent has not persuaded me that he has any legitimate business or other reason to remain as registrant. He is effectively unfairly "squatting" on what is rightfully the Complainant's domain name, thereby restricting the Complainant's ability to control access to its website by use of the Domain Name.
- 7.20 In all the circumstances, I conclude that the Domain Name has been used in a manner which is unfairly detrimental to the Complainant's Rights in the name "Mash Direct" and is thus an Abusive Registration.

## 8. Decision

I find that the Complainant has Rights in respect of a name and mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. I therefore direct that the Domain Name *mashdirect.co.uk* should be transferred to the Complainant.

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Anna Carboni

22 October 2008