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Requirement to prove absence of rights or legitimate interests not met in '.io' case

International - [Hogan Lovells](#)

- The owner of the mark MINDMEISTER, which operates a website at 'mindmeister.com', sought the transfer of 'mindmaster.io' under the '.io' Policy
- There was no evidence that the respondent's Mindmaster product was anything more than a competing product aimed at a similar market
- It would not be safe to consider this case to be so clear-cut that the respondent's claim to a legitimate interest could be rejected

In a recent [decision](#) under the '[.io' Domain Name Dispute Resolution Policy](#) (.io' Policy) before WIPO, a panel refused to transfer the disputed domain name 'mindmaster.io', finding that the complainant had failed to prove that the respondent had no rights or legitimate interests in the domain name.

Background

The complainant was MeisterLabs GmbH, a German company developing internet applications intended to help teams of all sizes and industries to implement and realise their projects. The complainant marketed Mindmeister, a mind-mapping solution first launched in 2007 and said to be used by more than 15 million people globally at the time of the decision. The complainant owned various trademarks for MINDMEISTER, the earliest of which appeared to have been registered in 2007. The Mindmeister software was available via a website linked to the domain name 'mindmeister.com'.

The respondent was Shenzhen Edraw Software Co Ltd, China. The respondent registered the domain name 'mindmaster.io' in 2019. At the time of the complaint, the domain name was linked by redirection to a website at the domain name 'edrawsoft.com', which offered mind-mapping software for download under a heading which read "EdrawMind (Formerly MindMaster) for Mind Mapping".

The complainant initiated proceedings under the '.io' Policy for a transfer of ownership of the domain name. To be successful under the '.io' Policy, a complainant must satisfy the requirements of Paragraph 4(a), namely:

- the disputed domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- the respondent has no rights or legitimate interests in the disputed domain name; and
- the disputed domain name was registered or is being used in bad faith.

Decision

Paragraph 4(a)(i)

The complainant considered that the domain name was confusingly similar to its MINDMEISTER trademark.

The complainant argued that, in relation to the visual impression, the domain name and the trademark only differed in the letter 'a' instead of 'ei' in the second part of the trademark. The first five letters were identical, as well as the last four letters of both words, and this was in line with the similar aural impression, as both signs consisted of three syllables.

The complainant also considered that the term '*Meister*' was commonly known among the English-speaking public, and the domain name was simply an English variation of the complainant's trademark.

The respondent denied that the domain name and the trademark were confusingly similar by arguing that (i) they were in different languages, and (ii) product reviews showed there was no confusion. The respondent produced, as evidence, links to a number of Spanish, German and Italian website articles and some reviews in English, all of which were not taken into account by the panel because the language of the proceedings was English and, even with regard to the reviews in English, their independence was not established.

The panel found that the domain name was confusingly similar to the trademark in that it was aurally and visually similar. The panel was of the view that a significant number of persons would recognise '*Meister*' as the German equivalent of 'master' and that the two terms differed only by the change from an 'a' to an 'ei' within the body of the word. The panel added that it was well established that the top-level domain, in that case '.io', did not affect the domain name for the purpose of determining whether it was identical or confusingly similar.

Paragraph 4(a)(ii)

The complainant contended that the respondent had no rights or legitimate interests in the term 'Mindmeister' because:

- the complainant had not granted any licence or authorisation for the respondent to use the MINDMEISTER trademark or any confusingly similar sign;
- the respondent was not affiliated with the complainant in any way and
- the respondent did not use the domain name for a *bona fide* purpose or legitimate non-commercial purpose; rather, the domain name resolved to a page in English with a "full-featured collaborative mind mapping and brainstorming tool" which tried to imitate the complainant's software and did not provide the respondent with rights or legitimate interests.

The respondent indicated that it was a legitimate company that had been in business since 2004 and that had invested significant time and resources in developing its own Mindmaster software and in marketing and protecting its IP rights. The respondent provided evidence showing it owned several registered trademarks for the word 'Mindmaster' in China, the United States and the European Union, including for example a US trademark registered in 2019 and claiming a first use in commerce in 2017.

The respondent described its software as "a versatile, user-friendly, and professional mind mapping tool. Available on multiple platforms (Windows, macOS, Linux, Google Chrome, iOS and Android), including PC, tablet, mobile and web, it allows the users to create mind maps and access them from each platform. With this excellent collaborative mind-mapping tool, working with teammates has never been easier". The respondent stated that its offering of that software established a legitimate interest and denied acting in bad faith.

To assess whether the respondent had rights or legitimate interests in the term 'Mindmeister', the panel made reference to the list of circumstances that may demonstrate that a respondent has rights or legitimate interests in a domain name, as provided by Paragraph 4(c) of the '.io' Policy, namely:

- (i) before any notice to the respondent of the dispute, the use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or*
- (ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or*
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*

The panel held that Paragraph 4(c)(i) was potentially applicable because the respondent had clearly been offering its mind-mapping software under the name Mindmaster prior to the complaint being lodged by the complainant. The panel considered that, although the precise date of the commencement of the offering was not clear, it accepted that first use commenced in 2017 as claimed in the US trademark registration, and absent any evidence to the contrary.

With regard to the *bona fide* requirement, the panel considered that it had to encompass the respondent's knowledge and motives in choosing its name - in other words, whether it was done deliberately to trade off, or take advantage of the complainant's name or reputation. To attempt to resolve the issue, the panel looked at the term 'Mindmaster' and did not find it to be so unusual as a name for mind-mapping software as to rule out the possibility of independent derivation. However, the panel pointed out that the respondent had not explained how it had come to decide upon the name Mindmaster for its software, or whether it had performed any searches on the name and, if so, with what result, and specifically whether it had identified or was aware of the complainant or its software.

The panel also noted that neither party had explained what (if any) other users there were of the term 'mindmaster'. For example, the panel had no knowledge of how (if at all) the domain name 'mindmaster.com' was being used and by whom, and even had the respondent identified the complainant or its software when it decided to use the name Mindmaster, it may have formed the view that the complainant's name indicated a Germanic product and that its adoption of an English version of the name was legitimate.

Regarding the complainant's contention that the respondent was selling software which tried to imitate the complainant's software, the panel was not clear exactly what the complainant meant. It appeared to the panel that both software products were directed at the same type of functionality, namely a product which enabled the visual representation of thought processes and ideas. The panel indicated that there was no evidence that the respondent's product was anything more than a competing product aimed at a similar market and there was nothing wrong with that.

The panel also noted that:

- the complainant had not produced any evidence that the respondent's software targeted any other rights of the complainant;
- as matter of visual observation, the respondent's website was significantly different to the complainant's website; and
- in any event, the website indicated that the respondent's software had been rebranded, although curiously the respondent had not explained the reasons for and time of the rebranding and the reference to "EdrawMind (formerly MindMaster)" or when it introduced such change.

The panel explained that proceedings under the '.io' Policy were of a limited and restricted nature, they did not involve oral hearings, discovery or cross examination, and hence were only applicable to clear-cut cases, and it was not usually appropriate for the panel to decide disputed questions of fact or matters of truth or falsehood. The panel added that such restrictions did not however mean that it could not reach a conclusion as to the veracity of a case that was being advanced, where the only evidence provided was in the form of conclusory statements that were inherently not credible, and which were not supported by relevant corroborative or third-party evidence.

The panel found the respondent's evidence seemingly incomplete and would have expected a much fuller explanation of how and why the respondent had adopted the name **Mindmaster** for its software. However, the panel also pointed out that (i) the respondent had been offering its Mindmaster software for several years and claimed to have millions of users of that software, whereas (ii) the complainant had not, to the panel's knowledge, sought to claim any rights in the term 'mindmaster' as opposed to 'mindmeister', which left open a question as to whether the respondent had transgressed upon the complainant's rights in adopting the name Mindmaster.

The panel held that it was not convinced that the complainant had discharged its burden in showing that the respondent lacked a legitimate interest, and considered that the question of whether the respondent's action, in adopting the name, targeted any other applicable rights the complainant may have had, was an issue to be resolved in a court of law, where procedures such as disclosure, oral testimony and cross-examination were likely to be available.

In addition, the panel considered that the respondent's registration of trademarks for MINDMASTER could contribute to establishing a right or legitimate interest and that a finding to the contrary would, in effect, deprive the respondent of the benefit of its trademarks.

As a conclusion, the panel declared that it would not be safe to consider this case to be so clear-cut that the respondent's claim to a legitimate interest could be rejected, and therefore held that the complainant had not discharged its burden of establishing that the respondent lacked rights or legitimate interests in the domain name.

Paragraph 4(a)(iii)

The panel declined to consider the third element of Paragraph 4(a) given its decision on the second element of the same paragraph.

Comment

This decision shows the importance of credibly demonstrating a respondent's absence of rights or legitimate interests, and underlines the difficulty of doing so when the respondent is an active competitor with a live website offering similar products or services to a similar market.

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