

ADMINISTRATIVE PANEL DECISION

Mind Gym plc v. Intuition Publishing Limited
Case No. D2022-3598

1. The Parties

The Complainant is Mind Gym plc, United Kingdom, represented by Lewis Silkin LLP, United Kingdom.

The Respondent is Intuition Publishing Limited, Ireland, represented by FRKelly, Ireland.

2. The Domain Name and Registrar

The disputed domain name <mindgym.com> (the “Domain Name”) is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 28, 2022. On September 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on October 5, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Response was filed with the Center on October 28, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on November 9, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a public limited company organized under the laws of England and Wales. As described on its website at “www.themindgym.com” (the “Complainant’s website”) the Complainant is a consultancy with offices in London, New York, and Singapore that applies principles of behavioral science to create “behaviour change programmes” for leadership and staff in business and other organizations. The Complainant has provided services to “over half the FTSE 100 and the S&P 100” companies.

Documents attached to the Complaint include historical screenshots from the Complainant’s website as early as December 2000, as well as media articles about the Complainant dated from 2015 to 2022. The Complainant reported revenues in excess of GBP 49 million in the fiscal year 2022.

Incorporated as a limited company under another name in 1999 and then, in March 2000, as “The Mind Gym Limited”, the Complainant changed its name to “Mind Gym Limited” in March 2012. It became a public limited company under its current name, “Mind Gym plc”, on June 22, 2018, and began trading on the FTSE AIM market. These name changes are reflected in the succession of similar registered trademarks listed below. According to the Complaint, the Complainant’s “core branding” is MINDGYM.

The Complainant holds several relevant trademark registrations, including the following:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
THE MIND GYM (word)	United Kingdom	UK00901959683	February 7, 2002
THE MIND GYM (word)	European Union (“EU”)	1959683	February 7, 2002
THE MIND GYM (word)	United States of America (“United States”)	3436504	May 27, 2008
MINDGYM (word)	United States	5888481	October 22, 2019
MINDGYM (word)	United Kingdom	UK00003420245	December 13, 2019
MINDGYM (word)	International Trademark (designations for EU and many countries)	1538691	January 21, 2020
MINDGYM (word)	United States	6161618	September 29, 2020
MINDGYM (word)	United States	6358847	May 25, 2021
MINDGYM (word)	United States	6358848	May 25, 2021

The application for the earliest United Kingdom trademark was filed on October 31, 2000, and the earliest United States trademark application claimed first use in commerce on January 31, 2001.

According to the Registrar’s Whols database, the Domain Name was created on September 26, 1996, and is registered to the Respondent, Intuition Publishing Limited (“Intuition”), Ireland. According to the online database of the Companies Registration Office of Ireland, the Respondent is a private company limited by shares, which was registered in August 1985.

It does not appear that the Respondent has used the Domain Name for a separate website. Instead, the Domain Name redirects to the Respondent’s website at “www.intuition.com”, which advertises the Respondent’s e-learning education and training services for organizations worldwide:

“Intuition is a leading global knowledge solutions company. We help clients develop the skills and expertise they need to unlock their potential.”

The Respondent's website claims 750 active clients, with more than two million annual users. The Complainant's representatives sent a "letter before action" to the Respondent on March 11, 2022, claiming trademark infringement and demanding transfer of the Domain Name. The Respondent's representatives replied on October 5, 2022, shortly after the Complaint was filed in this proceeding, requesting that the Complaint be withdrawn because "our client's rights predate your client's rights".

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its registered MINDGYM and THE MIND GYM trademarks. The Complainant states that it has not given permission for the Respondent to use those marks, and the Respondent is not known by a corresponding name. Rather, the Respondent uses the Domain Name to redirect Internet users to its own website advertising educational services to organizations. The Complainant contends that this does not represent a legitimate interest in the Domain Name.

The Complainant argues from these circumstances that the Respondent uses the Domain Name in bad faith, primarily to disrupt the business of a competitor. "Given the fame attached to the Complainant's trade marks, not only is it likely that the Respondent was aware of the Complainant's rights prior to adopting the Domain Name but it is inevitable that visitors to the Domain Name would mistakenly believe there to be an association with the Complainant."

The Complainant also cites *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), "where there is passive use of a widely known trade mark in a domain name where there is no response and no explanation as to why the use could be good faith". The Complainant evidently means for this last argument to apply in the event of non-response: "Therefore, in the absence of a response from the Respondent the Complainant submits that, on the balance of probability, the Respondent has registered and used the Domain Name in bad faith." (This argument evidently does not apply, as the Respondent has, in fact, submitted a detailed Response to the Complaint.)

B. Respondent

The Respondent does not challenge the Complainant's trademarks but states that the Complainant's trademark registrations, and indeed its business and trademark applications leading to trademark registrations, all came substantially later than the Respondent's registration of the Domain Name on September 26, 1996. By its own account, the Complainant started using the mark "The Mind Gym" only four years later, in late 2000.

The Respondent contends that it has been "legitimately using its domain since 1996 when it first coined the term 'MindGym'":

"At the time, the Respondent was developing a number of educational software products in partnership with the publisher Simon & Schuster. 'MindGym' was one of a number of names the Respondent was going to use in respect of its products and in accordance with its standard practice, it proceeded to secure its domain. Other names included 'Brainstorm' and a copy of this product can be seen at Annex 2. Mockups and visuals of the 'MindGym' educational software were created by the Respondent but these cannot be located given the length of time that has elapsed since then, namely 26 years. Ultimately the 'MindGym' educational software was not published but the Respondent has continued to keep its domain alive (as it is entitled to do) on the basis it may commercialise 'MindGym'."

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. The Domain Name incorporates the Complainant’s registered MINDGYM mark in its entirety. (As usual, the Top-Level Domain “.com” is disregarded as a standard registration requirement. See *id.* section 1.11.2.) The Panel finds that the Domain Name is identical to the Complainant’s registered mark and concludes, therefore, that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s 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) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, the absence of a corresponding name relating to the Respondent, and the use of the Domain Name only to redirect Internet users to the Respondent’s website. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent.

The Respondent claims that it is the initial registrant of the Domain Name and has “used” it since first registering the Domain Name on September 26, 1996. The Respondent offers as evidence only the Registrar’s Whois database record as of October 25, 2022, which shows when the Domain Name was created but does not establish when the Respondent acquired the Domain Name. There are understandable difficulties in retrieving records from 26 years ago, as the Respondent points out. The Panel notes that screenshots of the website associated with the Domain Name available from the Internet Archive’s Wayback Machine do not show redirection to the Respondent’s website until late 2011. Before that, the Domain Name seemed to produce only error messages. In fact, the Respondent does not appear to have published the Respondent’s website at “www.intuition.com” until April 2001. Before that, the archived screenshots

associated with that Domain Name related to a software development company for several years, and then briefly to a portal for pornography sites.

Where, as here, the disputed domain name is comprised of dictionary words, panels have generally taken the view that registering domain names based on dictionary words “does not automatically confer rights or legitimate interests on the respondent” (*id.*, section 2.10.1). Rather, panels seek to determine whether the domain name has been used for its general meaning or for its value in falsely implying association with a trademark owner:

“In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. ...”

In this case, the Respondent acknowledges that it has not taken steps to develop a website or otherwise commercialize the Domain Name. The only use to date has been redirection to the Respondent’s website at “www.intuition.com”, and the Panel finds no mention on that website of “mindgym”. The term is an apparent amalgamation of the dictionary words “mind” and “gym”. This could be considered an appropriate term to apply to learning products such as those offered by the Respondent, but it is absent from the description of the Respondent’s offerings of products and services and other discussions on its website. Thus, the redirection of the Domain Name to the Respondent’s website cannot be considered a “use” in connection with a *bona fide* offering of goods and services. Furthermore, merely maintaining the registration of the Domain Name over the years with the thought of possibly developing a relevant website in the future does not rise to the level of “demonstrable preparations to use” the Domain Name “in connection with a *bona fide* offering of goods or services”. See *id.*, section 2.2.

The Panel finds that the Respondent has failed to meet its burden of production and concludes that the Complainant has established the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following (in which “you” refers to the registrant of the domain name):

“(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

Notably, the Policy requires the Complainant to establish bad faith in both the registration and use of the Domain Name. The Complainant simply cannot do that on this record.

Although the Respondent does not demonstrate rights or legitimate interests in the Domain Name, not having made use of it (or demonstrable preparations for use) relating to the dictionary meaning of the terms “mind” and “gym”, the Complainant cannot establish bad faith in the registration of the Domain Name based on dictionary terms in 1996 when the Complainant by its own account did not start using a relevant mark until 2000. The Parties were not competitors in 1996 in any sense of the word, and the Respondent could not have had the intent of diverting Internet users from the Complainant, which did not exist at that time. On this record, the Panel cannot find that the Respondent more likely than not selected the Domain Name for its trademark value as opposed to the potential for using it appropriately with reference to the dictionary meaning of the terms “mind” and “gym”. That is because, absent evidence to the contrary, the Panel accepts the statements in the Respondent’s certified Response to the effect that the Respondent “registered

its domain in 1996” and has maintained the registration since then. As the Complainant had no claimed trademark use of MINDGYM before late 2000, and there is no evidence on this record that the Respondent registered the Domain Name four years earlier in anticipation of the trademark (see [WIPO Overview 3.0](#), section 3.8.2), the Panel finds that the Respondent had a plausible interest in the Domain Name for its dictionary sense rather than as a pretext for attacking a trademark that was not yet in contemplation.

The Panel concludes, therefore, that the Complainant has failed to establish the third element of the Complaint, bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

8. Reverse Domain Name Hijacking

Paragraph 15(e) of the UDRP Rules provides that, if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking (‘RDNH’) or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”. The Respondent has not requested such a finding here, but the Panel considers it appropriate in the circumstances.

Reverse Domain Name Hijacking is defined under the UDRP Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name”. Mere lack of success of a complaint is not sufficient to find Reverse Domain Name Hijacking. See [WIPO Overview 3.0](#), section 4.16. A finding of RDNH is warranted, for example, when a panel finds that the complainant (especially one represented by counsel) should have recognized that it could not succeed on one of the three elements of the complaint under any fair interpretation of the available facts or brings a complaint based “on only the barest of allegations without any supporting evidence” (*id.*).

In a proceeding under the Policy, it is elementary that the complainant must demonstrate bad faith both in the registration and use of the disputed domain name. In this case, the Domain Name was registered 26 years ago, a long delay for bringing a proceeding where the Complainant bears the ultimate burden of proof and must find persuasive evidence. Critically, the Domain Name was registered long before the Complainant acquired any trademark registrations and four years before the Complainant began doing business under the relevant name and claimed mark. The Complaint does not even address this glaring obstacle to relief under the Policy, which is amply discussed in the [WIPO Overview 3.0](#), section 3.8. The Overview clearly alerts complainants to this issue:

“Subject to scenarios described in 3.8.2 below [anticipatory domain name registrations], where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the respondent.”

The Complaint does not offer evidence or argument to indicate why bad faith should nevertheless be inferred in this instance.

The Panel finds that the Complainant brought the Complaint in bad faith, within the meaning of Rule 15(e), in an attempt at Reverse Domain Name Hijacking.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: November 23, 2022