



NOMINET

DISPUTE RESOLUTION SERVICE

D00017484

Decision of Independent Expert

Brain Vision UK Ltd

and

Brain Products GmbH

1 The Parties:

Complainant: Brain Vision UK Ltd
Zeal House
8 Deer Park Road
London
SW19 3GY
United Kingdom

Respondent: Brain Products GmbH
Zeppelinstr. 7
Gilching
82205
Germany

2 The Domain Name(s):

brainvision.co.uk

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.

17 May 2016 11:18 Dispute received
 18 May 2016 12:07 Complaint validated
 25 May 2016 12:52 Notification of complaint sent to parties
 26 May 2016 09:42 Response received
 26 May 2016 09:42 Notification of response sent to parties
 01 June 2016 02:30 Reply reminder sent
 03 June 2016 13:14 Reply received
 03 June 2016 13:15 Notification of reply sent to parties
 03 June 2016 13:15 Mediator appointed
 08 June 2016 15:18 Mediation started
 29 June 2016 16:47 Mediation failed
 29 June 2016 16:49 Close of mediation documents sent
 07 July 2016 14:28 Expert decision payment received

4 Factual Background

The Complainant is Brain Vision UK Ltd, a private limited company registered in England and Wales under company number 05032580.

The Respondent is Brain Products GmbH, a company based in Germany.

The Domain Name was registered in the name of the Respondent on 16 March 2004. The Domain Name is used and is still used as the website address for the Complainant's business. The Complainant's annual accounts for the year ended 31 March 2008 and abbreviated accounts for the year ended 31 March 2015 ("the Accounts") demonstrate that the Complainant has been trading during that period under the name Brain Vison (UK) Limited.

The Complainant and Respondent were in a business relationship from around 2004 which was terminated by the Respondent on 4 May 2016. The Complainant purchased products from the Respondent and marketed and sold them in the UK during that period.

Email correspondence submitted by the Complainant from the Respondent to it dated 21 April 2016 states as follows: the Respondent owns the Domain in the UK as it does in all its largest markets in the world. It is registered in its name because Brain Vision is the product family. As such it will not transfer the Domain Name to the Complainant. It offers the Complainant a choice of continuing to host its website at the Domain Name or to move it somewhere else.

5 Parties' Contentions

The parties' contentions can be summarised as follows:

The Complainant's complaint

5.1 The Complainant makes the following submissions:

- 5.1.1 Mary Tighe ("MT") of the Complainant was appointed by the Respondent in 2003 to represent it in making sales of its products in the UK via Medtech Limited ("MED") a third company. Alexander Svojanovsky ("AS") of the Respondent purchased MED. The

Complaint is not clear as to when this purchase took place. The Complainant was incorporated in 2004 to support MT's sales activities.

- 5.1.2 AS sold the Complainant to MT in 2008. The Complainant has submitted an Annual Return from Companies House confirming MT is its sole shareholder. MT assumed that when she purchased the Complainant from the Respondent, the sale included 'the website'. MT has altered and changed the website hosted at the Domain Name three times without authority from the Respondent. MT has invested over £100,000 in the website/the business over the years.
- 5.1.3 MT has successfully conquered the entire psychophysiology market of the main competitor in the UK and has made a success for the Respondent's products in the UK.
- 5.1.4 The Complainant asserts that the Domain Name belongs to it based on MT's purchase of the Complainant from the Respondent. It asserts that it appears to be an error or technicality that the Domain Name is registered to the Respondent.

Respondent

- 5.2 The Respondent has not responded to the Complaint. However a third party namely Abbey Support Limited confirmed by email to Nominet on 25 May 2016 that it was asked by MT to host the website in 2008 and 2009 and to pay the renewal fees. In turn the Complainant paid them for this.

Complainant's reply to response

- 5.3 The Complainant advises that the Domain Name has been paid for and annually renewed by Abbey Support Limited and then by TRU Office Limited, ever since the purchase by MT of the Complainant in 2008.

6 Discussions and Findings

General

Under paragraph 2 of the DRS Policy ("the Policy") the Complainant is required to show, on the balance of probabilities that:

- (i) the Complainant 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.

Rights include, but are not limited to, rights enforceable under English Law.

Complainant's Rights

- 6.1 The Expert must first consider whether the Complainant has shown, on the balance of probabilities that it owns Rights in a name or mark that is identical or similar to the Domain Name.
- 6.2 Disregarding the ".co.uk" element of the Domain Name, it can be considered as consisting of the words "Brain" and "Vision" and the phrase "Brain Vision".
- 6.3 The Complaint is made in the name of Brain Vision UK Ltd. Brain Vision UK Ltd was incorporated on 4 February 2004. The Complainant has not asserted any registered trade mark rights identical or similar to the Domain Name nor has the Complainant asserted that the term "Brain Vision" or either of its constituent parts has acquired a reputation or goodwill or (as it could be viewed as a descriptive mark) has secondary meaning which is/are associated with the Complainant or the products and services it provides.
- 6.4 The Expert has checked the UK IPO Trade Marks database and there is no evidence of the Complainant holding any such relevant registered trade marks. A WHOIS search reveals that the registrant for the Domain Name is the Respondent and that it registered the Domain Name on 16 March 2004. The Domain Name resolves to a website ("the Website") which displays a "Brain Vision UK – solutions for neurophysiological research" logo ("the Complainant's Logo"). The Website also displays the Complainant's registered office address. The Website also contains the Respondent's "Brain Products - solutions for neurophysiological research" logo ("the Respondent's Logo").
- 6.5 The Complainant has submitted Annual Returns dated 23 March 2016 and 19 May 2008. The Annual Return dated 23 March 2016 shows that MT is the sole shareholder in the Complainant. The Annual Return dated 19 May 2008 shows that MT then owned 90% of the Complainant.
- 6.6 The Complainant has submitted its Annual Accounts for the year ended 31 March 2008 and Abbreviated Accounts for the year ended 31 March 2015 ("the Accounts"). The Expert is satisfied that the Accounts demonstrate that the Complainant has been trading during that period under the name Brain Vision (UK) Ltd.
- 6.7 The Complainant has also submitted invoices dated 20 November 2008 and 26th October 2009 from Abbey Support Reliability for web hosting and registration costs associated with the Domain Name ("the Invoices"). The Invoices are addressed to the Complainant.
- 6.8 The Expert is satisfied on the balance of probabilities that the Complainant has put forward sufficient evidence that it currently trades and has been trading under the name "Brain Vision" and/or "Brain Vision UK", since around 2008. In the absence of any evidence to the contrary, the Expert is satisfied that the Complainant has demonstrated that it has unregistered rights in the name Brain Vision through use and the creation of some goodwill and reputation. The Expert considers that the Domain Name may be largely descriptive and thus to have unregistered trade mark rights in it, it would have to have acquired secondary meaning. It is not clear here if this is the case. However it appears to the Expert that the Complainant is in a very specialised and niche market. Accordingly it would be easier to meet these requirements in that situation. The threshold

test for rights is well-known to be a relatively low one and in the circumstances the Expert is prepared to hold on the balance of probabilities that the test for Rights has been met here.

- 6.9 Accordingly the Expert finds that the Complainant has rights in the name Brain Vision which is identical or similar to the Domain Name.
- 6.10 Having found that the Complainant has established, on the balance of probabilities that it has Rights in the name which is either identical or similar to the Domain Name, it has to be considered whether the Domain Name, in the hands of the Respondent is an Abusive Registration.

Abusive Registration

- 6.11 Paragraph 1 of the Policy states that an Abusive Registration means 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The Complainant has made no submissions to support an argument that the Respondent's registration of the Domain Name is an Abusive Registration. The Complaint is limited to contractual based claims of ownership of the Domain Name *vis a vis* the purchase of the Complainant by MT. To determine if the Domain Name is an Abusive Registration it is relevant to examine whether either above limb of the definition of Abusive Registration is applicable.

- 6.12 The Respondent registered the Domain Name on 16 March 2004. At the time of registration the Expert understands that the Complainant was owned by the Respondent or one of its shareholders. It is also understood that the Complainant was set up by the Respondent to support MT's sales activities in relation to the Respondent's products in the UK. At the point of registration of the Domain Name the Complainant had no Rights in it, as it had only recently been incorporated by the Respondent to promote its business in the UK.
- 6.13 No evidence has otherwise been submitted to suggest that registration of the Domain Name at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights. Therefore the Expert considers on the balance of probabilities that the Domain Name in the hands of the Respondent is not an Abusive Registration as defined by the first limb of the paragraph 1(i) definition of Abusive Registration contained in the Policy.
- 6.14 The second limb to consider under paragraph 1(ii) is whether the registration has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

- 6.15 It is highlighted at paragraph 4.7(2) of version 2 of the Dispute Resolution Service – Experts’ Overview that *“provided the Respondent has done nothing new following the coming into existence of the Complainant’s Rights to take advantage of those rights, the Respondent’s use of the Domain Name is unlikely to lead to a finding of Abusive Registration.”*
- 6.16 Although the business relationship between the parties has been terminated, the Domain Name still resolves to the Complainant’s website. Email correspondence submitted by the Complainant from the Respondent to it dated 21 April 2016 states that it will not transfer the Domain Name to the Complainant because it considers it owns it in the UK and in the largest markets in the world. It offers the Complainant a choice of continuing to host its website at the Domain Name or to move it somewhere else. It is thus not demanding that the Complainant cease use of the Domain Name but rather that it may continue to use it for the address of its business and website. Accordingly it is not itself directly using the Domain Name to its advantage or otherwise. Nor is it proposing to do so. It would be for the Complainant to decide whether to continue to use the Domain Name for its website and whether or not to promote the Respondent and its products there.
- 6.17 No evidence has been submitted by the Complainant that leads the Expert to the conclusion that the Respondent’s behaviour in relation to the Domain Name has changed in any particular way since registration nor that any change has taken place which takes unfair advantage of the Complainant’s rights. Should the Respondent, for example, subsequently force the Complainant to cease use of the Domain Name, this could amount to a change which may satisfy the test of an Abusive Registration on the basis that this may, subject to the overall circumstances, take unfair advantage of the Complainant’s Rights.
- 6.18 The Expert is satisfied on the balance of probabilities that the Respondent has not acted in a way which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.
- 6.19 The Expert finds that the Domain Name in the hands of the Respondent is not an Abusive Registration under paragraphs 1(i) and (ii) of the Policy.

7 Decision

- 7.1 The Expert finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- 7.2 The Expert finds that the Complainant has failed to show that the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.3 The Complaint therefore fails. The Expert directs that no action be taken in relation to the Domain Name.

Signed
G GRASSIE

Dated 22/7/2016