

DISPUTE RESOLUTION SERVICE

DRS 8448

Decision of Independent Expert

LEGO Juris A/S

and

Phuong Tran

1. The Parties:

Complainant: LEGO Juris A/S
Address: Anne-Mette Holm Madsen
Koldingvej 2
Billund
Postcode: DK-7190
Country: Denmark

Respondent: Phuong Tran
Address: 16 Harper Road
London
Postcode: SE1 6AD
Country: United Kingdom

2. The Domain Names:

<legodeathstar.co.uk>, <legominifigures.co.uk>, <legostarwarships.co.uk> and
<starwarslegosets.co.uk>

3. Procedural History:

| | |
|---------------|--|
| 25 March 2010 | Complaint received |
| 25 March 2010 | Complaint validated |
| 25 March 2010 | Notification of complaint sent to parties |
| 20 April 2010 | No Response Received |
| 20 April 2010 | Notification of no response sent to parties |
| 27 April 2010 | Expert decision payment received |
| 04 May 2010 | Expert appointed |
| 04 June 2010 | It having become apparent that the Expert originally appointed would not be able to produce the requisite decision, a replacement was found in the person of Tony Willoughby who duly filed with Nominet a signed declaration of impartiality and independence in the prescribed form. |

4. Factual Background

The Complainant is the proprietor of the internationally well-known LEGO brand. It is the proprietor of a large number of trade mark and service mark registrations featuring the LEGO mark including by way of example UK registration no. 1283286 dated 1 October 1986 in classes 35, 40, 41, 42, 43 and 44 for a wide variety of services.

Since 1999 the Complainant has been licensed by LucasFilm Limited to incorporate within its LEGO range of products a Star Wars range. The range includes a LEGO Death Star and LEGO Star Wars Mini Figures.

The Domain Names were all registered on 11 September, 2009.

On 8 October, 2009, the Complainant's agent wrote to the Respondent drawing the Respondent's attention to the Complainant's rights and seeking transfer of the first three of the Domain Names listed above in return for payment of the Respondent's out-of-pocket registration expenses. At that stage the Complainant was unaware of the existence of the fourth Domain Name (i.e. <starwarslegosets.co.uk>).

There being no reply to that letter, the Complainant's representative sent a 'chaser' on 25 November, 2009, but again no reply was received.

Each of the Domain Names is connected to a site devoted primarily to links to sites selling the Complainant's products, but there are advertising links to other sites offering goods and services having no connection with the Complainant's products. In small print at the bottom of each page below the copyright notice is a passage reading "All trademarks and registered trade marks are the property of their respective owners. This website is independent and has nothing to do with the trade mark owners of [Lego Death Star][Lego Minifigures][Lego Star Wars Ships][Star Wars Lego Sets] or any other company.

5. Parties' Contentions

The Complainant

The Complainant recites the facts set out in paragraph 4 above (duly supported by documentary evidence) and contends that each of the Domain Names is an Abusive registration.

The Complainant points out that each of the Domain Names comprises within it the Complainant's LEGO trade mark and another word or words indicative of products in the Complainant's LEGO range of products.

It contends that in respect of each of the Domain Names the Complainant has rights in respect of a name or mark, which is similar to the Domain Name.

The Complainant contends that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration.

The Complainant asserts that it has given the Respondent no permission to use its trade mark.

The Complainant contends that the Respondent registered the Domain Names knowing of the Complainant's trade mark rights and with the intention of exploiting them for profit on the back of the reputation and goodwill associated with the Complainant's LEGO trade mark. The Complainant contends that it is likely that the Respondent is earning advertising income through the advertising links featured on the webpages to which the Domain Names are connected.

The Complainant further contends that the Respondent has used the Domain Names abusively within the meaning of paragraph 3a.ii of the Policy.

The Respondent

The Respondent did not file a Response.

6. Discussions and Findings

General

The Complainant is required under clause 2b of the Policy to prove to the Expert 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 Names; and

ii the Domain Names, in the hands of the Respondent, are Abusive Registrations.

Complainant's Rights

"Rights" are defined in the Policy and in the Procedure. Rights "includes, but is not limited to, rights enforceable under English law". As indicated in section 4 above the Complainant is the registered proprietor of many LEGO trade mark registrations.

For the purpose of assessing similarity under this head of the Policy the generic domain suffix may be ignored.

The Expert is satisfied that the Complainant has Rights in a name or mark (i.e.LEGO), which is similar to each of the Domain Names. Each of the Domain Names features the Complainant's LEGO trade mark in combination with a word or words apt to describe a product or products in the Complainant's LEGO range of products.

Abusive Registration

Factors to be considered

Paragraph 1 of the Policy defines "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.

The facts of this case as set out in section 4 above are straightforward and have not been challenged by the Respondent.

The Complainant is the proprietor of the well-known LEGO brand. The Respondent selected the Domain Names with the Complainant's trade mark firmly in mind. This is indisputable for several reasons. First the other elements of the Domain Names are words peculiarly apt to describe products in the Complainant's range. Secondly, the webpages to which the Domain Names are connected have been designed with the Complainant's products primarily in mind. Thirdly, the notice featured at the base of each page (see section 4 above) demonstrates that the products described in the Domain Names are the subject of trade mark rights.

The Complainant asserts and the Expert has no difficulty in accepting that the Respondent was given no permission to use the Complainant's trade mark. The Complainant further asserts that the Respondent is likely to be deriving advertising income of some kind from the advertising links featured on the webpages to which the Domain Names are connected. It is within the experience of the Expert that that is likely to be the case and the Respondent has not denied the Complainant's allegation.

The Complainant asserts that the Respondent is using the Domain Names abusively within the meaning of paragraph 3.a.ii of the Policy which reads:

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

Is it likely that Internet users seeing the Domain Names as part of web addresses will believe that the Domain Names are “*registered to, operated or authorised by, or otherwise connected with the Complainant*”? In the view of the Expert the answer has to be in the affirmative for precisely the reasons which have led the Expert to regard the Domain Names and the Complainant’s trade mark to be similar.

Is there an argument available to the Respondent along the lines of paragraph 4.a.i.A of the Policy that he has been using the Domain Names for a lawful *bona fide* business selling the Complainant’s products identified in the Domain Names?

He has not advanced any such argument. Moreover, he does not appear to be a seller, his webpages feature links to sites selling goods and services bearing no relation to the Complainant’s products (see section 4 above) and one would have expected his disclaimer to have been very much more prominent. ‘Losing’ it in the small print at the foot of each page indicates that the Respondent was not overly keen that it should be noted.

The Expert finds on the balance of probabilities that (a) the Respondent registered the Domain Names for the purpose of deriving advertising income from Internet users looking for the Complainant’s products (i.e. the purpose for which he is currently using the Domain Names) and (b) while some Internet users may visit the Respondent’s webpages either knowing that they were unlikely to be official webpages of the Complainant or not caring one way or the other, nonetheless a significant (in the sense of not insignificant) number of visitors are likely to have made the visit in the belief that the webpages were “*registered to, operated or authorised by, or otherwise connected with the Complainant*”.

7. Decision

The Expert finds that the Domain Names, in the hands of the Respondent, are Abusive Registrations within the meaning of paragraph 3.a.ii of the Policy.

Signed Tony Willoughby

Dated 4 June, 2010