

DISPUTE RESOLUTION SERVICE

DRS 08687

Decision of Independent Expert

LEGO Juris A/S

and

R LIM

1. The Parties:

Lead Complainant: Lego Juris A/S
Address: Koldingvej 2
Billund
Denmark
Postcode: DK-7190
Country: DK

Respondent: R LIM
Address: Suite 2302-3 Pacific Plaza,
410 Des Voeux Road West,
Central
Hong Kong
Postcode:
Country: HK

2. The Domain Name:

The domain name in dispute is < legocity.org.uk >

3. Procedural History:

On 3 June 2010 the Complaint was received by Nominet UK.

On 4 June 2010 Nominet UK validated the Complaint.

On 4 June 2010 a notification of complaint was sent to the Parties by Nominet UK.

On 28 June 2010 as no Response had been received a notification of no response was sent to the Parties by Nominet UK.

On 7 July 2010 James Bridgeman was appointed as Expert.

4. Factual Background

The Complainant is the owner of the trademark LEGO and all other trademarks used in connection with the LEGO brand of construction toys and other LEGO branded products and has built up a substantial goodwill in the use of the LEGO trade mark in many jurisdictions across the world.

The Complainant is the owner of numerous registrations for the LEGO trademark including CTM registration no. 000039800 registered on 5 October 1998 in respect of various goods and services in classes 3, 9, 14, 16, 20, 24, 25, 28, 38, 41, 42 pursuant to an application filed on 1 April 1996, and UK Trade Mark registration number 1283286, LEGO registered on 09 August 1991 in classes 35, 40, 41, 42, 43, 44 pursuant to an application filed on 1 October 1986.

The Complainant is also the owner of more than 1000 domain names containing the term LEGO, among these <lego.com> and <lego.co.uk>.

There is no information available about the Respondent except for that provided in the Complaint and in the registration details on the Whols.

The disputed domain name was registered on October 1, 2009.

5. Parties' Contentions

COMPLAINANT

The Complainant, based in Denmark, has provided evidence of its ownership of the LEGO trademark and claims rights in all other trademarks used in connection with the LEGO brand of construction toys and other LEGO branded products.

In an annex to the Complaint, the Complainant has furnished details of the above-mentioned registered trademarks and in particular CTM registration no. 000039800 and UK Trade Mark registration number 1283286 on which this Complaint is based.

The Complainant claims to be the owner of more than 1000 domain names containing the term LEGO, among these <lego.com> and <lego.co.uk>.

The Complainant submits that the trade mark LEGO is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. The Complainant further submits that the LEGO trade mark and brand have been recognized as being famous. In an annex to the Complaint the Complainant has furnished a list of the official top 500 Superbrands for 2009/10, provided by Superbrands UK, showing LEGO as number 8 of the most famous trademarks and brands in the world. The LEGO Group has expanded its use of the LEGO trademark to, *inter alia*, computer hardware and software, books, videos and computer controlled robotic construction sets.

Over the years, the business of making and selling LEGO branded toys has grown remarkably. By way of example, the Complainant states that the revenue for the LEGO Group in 2008, was more than \$1,8 billion. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the United Kingdom.

The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in the United Kingdom and elsewhere. The Complainant states that it is the strict policy of the Complainant that all domain names containing the word LEGO should be owned by the Complainant.

The Complainant claims long established use of the LEGO trade mark in the United Kingdom and claims extensive, exclusive and continuous use of the LEGO trade mark since prior to the establishment of the British company within the group in 1959.

The Complainant submits that the LEGO trademark is inherently and substantially distinctive and asserts that there is widespread and significant awareness of the LEGO trade mark. The Complainant submits that according to the provisions of Article 6bis of the Paris Convention for protection of Industrial Property, confirmed and extended by Article 16.2 and Article 16.3 of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement"), the stature of a well-known trademark provides the owner of such a trademark with the right to prevent any use of the well-known trademark or a confusingly similar denomination in connection with any products or services (i.e. regardless of the list of the products and services for which the trademark is registered). The Complainant submits that it follows that the protection afforded to its rights in the LEGO trade mark goes far beyond toys and goods similar to toys.

The Complainant submits that the disputed domain name <legocity.org.uk> comprises the word LEGO, which is identical to the registered trademark LEGO, which has been registered by the Complainant as a trademark and domain names in numerous countries all over the world.

The Complainant submits that the additional element “city” is of a generic character and does not prevent a domain name from being considered similar to a trademark. The Complainant submits that the addition of the word “city” is therefore not relevant and will not have any impact on the overall impression of the dominant part of the name, LEGO, instantly recognizable as a world famous trademark.

In support of this submission the Complainant cites Nominet, DRS decisions viz. Playboy Enterprises International, Inc. v JML DRS No. 03847, in which the expert stated that the most important component of the domain name playboyenterprises.co.uk was the word “Playboy” and the insertion of the neutral word “Enterprises” did not displace the overall impact. The domain name, <playboyenterprises.co.uk>, was therefore to be seen as similar to the trademark PLAYBOY.

Furthermore the Complainant submits that because it markets a line of products called “LEGO City”, the combination of the two elements “lego” and “city” in the disputed domain name is more likely to strengthen the impression that the domain name belongs to, or is affiliated with Complainant.

The Complainant asks this Expert to note that the disputed domain name was registered on October 1, 2009 subsequent to the Complainant’s first use and registration of the LEGO trade mark.

The Complainant states that the only information available about the Registrant is to be found in the details on the WhoIs. There is no information to indicate that the Respondent is legitimately connected with a mark which is identical or similar to the disputed domain name. It appears from the details on the WhoIs, the registrant is known as R LIM and not known by the name LEGO CITY. The Complainant submits that there is no connection or co-operation between the Complainant and the Respondent. The Complainant has neither licensed, nor otherwise authorized the Respondent to use the trade mark LEGO in the domain name or in any other procedure. The Complainant submits that it has made searches in relevant trade mark databases, specifically the online trademark search provided by the UK Intellectual Property Office and in the CTM Online Search and has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name.

Because no address was presented in the WhoIs, the initial cease and desist letter was sent to the registrar on 23 December 2009. As a consequence of the letter, the site was deactivated but in order to get in contact with the Respondent, the registrar referred the Complainant to Nominet UK. Therefore, on 13 January 2010 an email was sent to Nominet UK, asking for the address to the Respondent. Nominet UK

provided the Complainant with a postal address for the Respondent and a cease and desist letter was sent on 26 January 2010.

The Complainant advised the Respondent that the unauthorized use of the LEGO trademark in the disputed domain name violated the Complainant's rights in the LEGO trade mark. The Complainant requested the immediate transfer of the disputed domain name and offered compensation for the expenses of registration and renewal fees (not exceeding out of pocket expenses). Despite the letter and reminders the Complainant never heard back from the Respondent and somewhere along the line, the web site was reactivated.

The Complainant submits that its LEGO trade mark has the status of well-known and reputed trademark with a substantial and widespread reputation throughout the whole Community, and throughout the world. The awareness of the trademark LEGO is considered, in the whole Community in general, to be significant and substantial. The number of third party domain name registrations comprising the trademark LEGO in combination with other words has skyrocketed the last years. In support of this argument, the Complainant refers to a number of decisions of administrative panels established under the UDRP.

The Complainant relies on paragraph 3 (a) (ii) of the DRS Policy which lists the non-exhaustive factors which may be evidence that the disputed domain name is an Abusive Registration include circumstances indicating that the Respondent is using or threatening to use the disputed domain name in a way which has confused or is likely to confuse people or businesses into believing that the disputed domain name is registered to, operated or authorized by, or otherwise connected with the Complainant. The Complainant asks this Expert to draw an inference from the fact that the disputed domain name is currently connected to a web site with sponsored links and argues that it is obvious that the Respondent derives income through the web site to which the disputed domain name resolves.

The Complainant submits that the Respondent most likely had the Complainant and its business in mind when registering the disputed domain name and argues that this is particularly obvious since the Respondent had already been Respondent in a UDRP case concerning the trademark LEGO when the registration of the Domain Name took place.

In Oasis Store Ltd. and J Dale DRS No. 6365 the Expert argued that a domain name registrant is abusively using a domain name if he is aware, or becomes aware, of a trademark's significance which is incorporated in his domain name, and allows the domain name to be used for a page generating sponsored links taking advantage of said trademark. The registrant cannot avoid such a finding by showing that he did not do this directly himself. The use of sponsored links and domain name parking services is further discussed, and the Expert states; "it is quite a different matter to seek financial gain for oneself or a third party by choosing and using a domain name that incorporates the name or mark of another business with a view to draw traffic to a domain name parking service web page. Such activity has been found to be

abusive in a number of cases under the Policy including *The Royal Bank of Scotland Group Plc v John Wilfred* (2006) DRS 3952 and *Newbury Building Society v Webster* (2006) DRS 3967". The Complainant submits that the same circumstances prevail in the present Complaint and argues that the Respondent must be considered to have taken an unfair advantage of the Complainant's trademark rights.

In summary, the Complainant submits that it is the owner of the well known LEGO trade mark. There is no doubt that the Respondent was aware of the rights the Complainant has in the LEGO trade mark and the value of said trademark, at the point of the registration. The Complainant submits that the disputed domain name is clearly similar to the Complainant's registered trademark LEGO since it reproduces the mark in its entirety and the suffix "city" does not detract from the overall impression but rather strengthens the likelihood of confusion with the Complainant's trademark since it refers to a product line produced by the Complainant. Consequently, by referring to the above-mentioned, the disputed domain name must therefore be considered to be similar to the Complainant's trademark and the registration should be seen as an Abusive Registration in the hands of the Respondent.

RESPONDENT

There was no Response filed.

6. Discussions and Finding

Paragraph 2.a of the DRS Policy provides that a Respondent must submit to proceeding if a Complainant asserts to us, according to the Procedure, 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.

Paragraph 2.b of the DRS Policy provides that the Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

Complainants' Rights

The Complainant has provided *prima facie* evidence of its ownership of the LEGO trademark through its registrations including the above CTM registration. On the evidence the Complainant has built up a substantial goodwill and reputation in the use of the LEGO mark in relation to construction toys and other goods and services.

Identical or Similar

The disputed domain name consists of the word “lego” in combination with the word “city” and the ccTLD extension “.org.uk”.

For the purpose of making the comparison the ccTLD extension may be ignored. The dominant element of the domain name is the letters “lego”, being the first and more distinctive of the two elements. The second element “city” is not sufficiently distinctive to remove the similarity between the Complainant’s LEGO mark and the disputed domain name as it carries an implied reference to buildings and construction and to a product line marketed by the Respondent.

This Expert finds that the disputed domain name is similar to the Complainant’s trade mark and the similarity is not decreased by the addition of the “city” element.

This Expert finds that on the evidence the Complainant has rights in the LEGO trade mark which is similar to the disputed domain name <legocity.org.uk> and the Complainant has therefore satisfied the first element of the test in Paragraph 2.a of the DRS Policy.

Abusive Registration

An Abusive Registration as defined in paragraph 1 of the DRS Policy 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 Complainants’ Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainants’ Rights.

The Respondent has not filed any Response or provided any explanation as to why he or she chose and registered the disputed domain name.

The combination of the words “lego” and “city” are very distinctive and unique. On the face of it and in the absence of any other explanation, the two elements in the disputed domain name refer to the Complainant’s goods and services. The Complainant has furnished prima facie evidence of its goodwill and an extensive reputation of its LEGO brand for construction toys and other products which has been built up over a number of years by the Complainant and its licensees.

On the evidence it is beyond coincidence that the Respondent would have chosen and registered the disputed domain name without knowledge of the Complainant and its goodwill. On the balance of probabilities the Respondent was aware of the Complainant’s reputation and chose and registered the disputed domain name in

order to use it to take predatory advantage of the Complainant's goodwill by confusing Internet users and diverting them away from the Complainant's website to the Respondent's web site for commercial gain.

On the balance of probabilities this Expert finds that the Respondent is using the domain name in a way which has confused or is likely to confuse people or businesses into believing that the disputed domain name is registered to, operated or authorized by, or otherwise connected with the Complainant. It follows that the disputed domain name 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 Complainants' Rights in the LEGO trade mark and since its registration it has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainants' Rights in the LEGO trade mark.

This Expert finds therefore that the disputed domain name is an Abusive Registration in the hands of the Respondent and the Complainant having satisfied the second element of the test in Paragraph 2.a of the DRS Policy is entitled to succeed in its application.

7. Decision

For reasons given above, I hereby decide and direct that the disputed domain name < legocity.org.uk >be transferred to the Lead Complainant.

Signed James Bridgeman

Dated 26 July 2010