

DISPUTE RESOLUTION SERVICE

DRS 08705

Decision of Independent Expert

Lego Juris A/S

and

Ajay Ahuja T/A Webhosting UK Com

1. The Parties:

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

Respondent: Ajay Ahuja T/A Webhosting UK Com
Address: Floor 5 Amphenol Business Complex
Thanet Way
Whitstable
Kent
Postcode: CF5 3JF
Country: GB

2. The Domain Name(s):

businesslego.co.uk (the "Domain Name")

3. Procedural History:

10 June 2010	Nominet validated the Complaint
10 June 2010	Nominet sent the Complaint to the Respondent
2 July 2010	No Response received from the Respondent
15 July 2010	David King appointed as Expert Reviewer
15 July 2010	Steve Ormand appointed as Expert

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

4. Factual Background

The Complainant is the owner of the trademark LEGO registered in many countries, including UK registration no. 1283286 registered on 9 August 1991.

The Complainant has subsidiaries and branches throughout the world and LEGO products are sold in more than 130 countries, including in the UK where LEGO Limited was established in 1959. LEGO UK has used the LEGO mark under licence from the Complainant in connection with LEGO branded toys and products.

Revenue of the LEGO Group in 2008 was more than \$1.8 billion. The LEGO brand was placed at no. 8 in the top 500 brands in 2009/2010.

The Domain Name was registered to Ajay Ahuja, trading as Webhosting UK Com, on 23 January 2009.

5. The Parties’ Contentions

The Complaint

The Complainant contends that it has Rights in the mark LEGO because:

1. It is the owner of the trademark LEGO and all other trademarks used in connection with the famous LEGO brand of construction toys and other LEGO branded products
2. The Complainant’s licensees are authorized to exploit the Complainant’s intellectual property rights, including its trademark rights, in the United Kingdom and elsewhere.
3. LEGO Limited’s use of the LEGO mark has been extensive, exclusive and continuous since 1959 and even before that.
4. Over the years, the business of making and selling LEGO branded toys has grown remarkably to more than \$1.8 billion for the LEGO Group in 2008.
5. The Complainant is also the owner of more than 1000 domain names containing the term LEGO, among these LEGO.com and LEGO.co.uk.
6. It is the strict policy of the Complainant that all domain names containing the word LEGO should be owned by the Complainant.
7. The trademark 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.
8. The LEGO trademark and brand have been recognized as being famous. It is number 8 in the list of the official top 500 Superbrands for 2009/10, provided by Superbrands UK, being the most famous trademarks and brands in the world.
9. 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.
10. The mark LEGO is in possession of substantial inherent and acquired distinctiveness.
11. The awareness of the trademark LEGO is considered in the whole Community to be significant. According to the provisions of Article 6bis of the Paris Convention for protection of Industrial Property (“PC”), 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 statute (*sic*) 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).

12. Thus, the protection for LEGO goes far beyond toys and goods similar to toys.
13. The Domain Name 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 addition of generic prefixes and suffixes do not prevent a domain name from being considered similar to a trademark.
14. The addition of the prefix “business” 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. That opinion has been stated in several cases decided by Nominet, for example in DRS No. 03847, *Playboy Enterprises International, Inc. v JML*. The expert stated that the most important component of the domain name *playboyenterprises.co.uk* was “the word “Playboy”. The insertion of the neutral word “Enterprises” does not displace the overall impact.” The domain name, *playboyenterprises.co.uk*, was therefore to be seen as similar to the trademark PLAYBOY.
15. The Domain Name was registered on January 23, 2009. This date is subsequent to when the Complainant registered the trademark LEGO in the UK and elsewhere. The first trademark registration for LEGO made in the UK became official in 1986.

The Complainant contends that the Respondent’s registration and use of the Domain Name is an Abusive Registration because:

1. 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 trademark LEGO in the domain name or in any other procedure.
2. The Complainant has made searches in relevant trademark databases and has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name.
3. Searches have been made in the online trademark search provided by the Intellectual Property Office and in the CTM Online Search. No information indicates that the Respondent is commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.
4. As the initial address presented in the whois was invalid (the postal letters came back to the Complainant), the cease and desist letter was sent to Nominet, on April 23, 2009 and with a reminder on June 6, 2009. In the letter the Complainant advised the Respondent that the unauthorized use of the LEGO trademark in the Domain Name violated the rights in the trademark LEGO, owned by the Complainant. The Complainant requested the immediate transfer of the Domain Name and offered compensation for the expenses of registration and renewal fees (not exceeding out of pocket expenses). In August 2009 Nominet informed the Complainant that they had initiated a gone away process. On the 7th of October 2009 Nominet informed the Complainant that the Domain Name was suspended and scheduled for cancellation on 30 October 2009. However, on the 28th of October the Respondent's contact details were updated. The Complainant then sent a new cease and desist letter to this address, but without any reply.
5. The trademark LEGO in respect of toys belonging to the Complainant 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 (as an indication, please see DRS 8448 and the number of UDRP cases, all ruled in the favour of the Complainant e.g. cases D2009-0848, D2009-0784, D2009-0753, D2009-0685, D2009-0680, D2009-0644, D2009-0564, D2009-0500, D2009-0438, D2009-0437, D2009-0381, D2009-0184, D2009-0170, D2008-1826, D2008-1715, D2008-1692.) The considerable value and goodwill of the mark LEGO is most likely a large contribution to this and also what made the Respondent register the Domain Name at issue here.

6. The Domain Name is currently connected to a parked web page. Under paragraph 3 (a) (ii) of the Policy, the non-exhaustive factors which may be evidence that the Domain Name is an Abusive Registration include circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant.
7. With the fame and well-known reputation of the Complainant's trademark in mind, the Complainant finds it likely that a visitor would believe that the Domain Name is operated or authorized by the Complainant as the Domain Name and the Complainant's trade mark must be considered to be similar. In DRS No. 08216, *deluxtrades.co.uk (sic)*, incorporating the trademark *DELUX (sic)*, the Expert stated the following; "...where a member of the public sees the Domain Name they will on the balance of probabilities initially associate it with the Complainant because of the distinctive nature of the Complainant's well known mark. This in itself can amount to confusing use under the Policy." These same circumstances prevail in this case as well.
8. With above mentioned in mind the Respondent must be considered to have taken an unfair advantage of the Complainant's trademark rights.
9. Summarizing this, the Complainant is the owner of the well known trademark LEGO. There is no doubt that the Respondent was aware of the rights the Complainant has in the trademark LEGO and the value of said trademark, at the point of the registration. The Domain Name in question is clearly similar to the Complainant's registered trademark LEGO since it reproduces the mark in its entirety. The prefix "business" does not detract from the overall impression. Consequently, by referring to the above-mentioned, the Domain Name must therefore be considered to be similar to the Complainant's trademark and the registration should be seen as an abusive registration.

The Response

The Respondent did not respond to the Complaint.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

1. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
2. *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainant's Rights

Rights is defined in §1 of the Policy as rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

The wholly generic suffix “.co.uk” is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced registered rights in respect of the name LEGO dating back to 1991, pre-dating the registration of the Domain name by almost 30 years. I am also satisfied on the evidence before me that the name LEGO is an extremely well know brand that has acquired a secondary meaning.

The Domain Name is a combination of the name LEGO and a descriptive element, the word "business". The latter does not detract from the dominant and distinctive use of the name LEGO in the Domain Name. The Complainant has quoted one of a number of DRS decisions which establish the principle that the insertion of a neutral or descriptive word, such as "business", does not displace the overall impact of a domain name which incorporates a name such as LEGO.

Accordingly, the Complainant has satisfied the first limb of the test by demonstrating that it has Rights in the name LEGO, a name which is similar to the Domain Name save for the addition of the generic suffix.

Abusive Registration

Abusive Registration is defined in the Policy as a Domain Name which either:

1. *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*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

The Complainant primarily cites §3a ii of the Policy (being one of a non-exhaustive list of factors set out in the Policy which may be evidence that the Domain Name is an Abusive Registration) as the basis for its assertion of Abusive Registration, namely:

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

The Complainant does not claim actual confusion but asserts that, although the Domain Name is connected to a parked web page, the fame and well-known reputation of the name LEGO is such that a visitor would believe that the Domain Name is registered to, operated or authorised by the Complainant and on the balance of probabilities will associate the web site with the Complainant. The Complainant quotes DRS 08216 (Imperial Chemical Industries Ltd –v- Roy Moulton re duluxtrades.co.uk) in support of its assertion.

It is well established in DRS cases that such “initial interest confusion” is a basis for a finding of Abusive Registration since the visitor to the website has been deceived by the

domain name. This is particularly the case where the domain name is identical to a name in which the complainant has rights. Where that name is also exclusively referable to the complainant (and there is no obvious justification of the respondent's adoption of the domain name and he has offered no explanation) then it is reasonable for the expert to infer that the domain name was registered for an abusive purpose (see DRS 00292 Chivas Brothers Limited –v- David William Plenderleith).

In this Complaint the Domain Name is similar, not identical, to the name LEGO. However, it is a distinctive and very well known name and, despite the addition of the descriptive word "business", I am satisfied on the evidence before me that on the balance of probabilities there will be initial interest confusion.

The Complainant also asserts, which I accept, that there is no connection or cooperation between it and the Respondent and the Respondent is neither licensed nor authorised to use the Complainant's trade mark. Moreover, the Complainant has searched trademark databases and finds no evidence that the Respondent has any registered trade marks corresponding to the Domain Name and no information indicates the Respondent is known by or connected with a mark which is identical or similar to the Domain Name.

Accordingly, I find that the Respondent registered the Domain Name for the purpose set out in §3a ii of the Policy and is thus an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name, businesslego.co.uk, be transferred to the Complainant.

Signed: Steve Ormand

Dated: 2 August 2010