

DISPUTE RESOLUTION SERVICE

D00008849

Decision of Independent Expert

LEGO Juris A/S

and

Porchester Partners Inc.

1. The Parties:

Complainant: LEGO Juris A/S
Koldingvej 2
Billund
Denmark
DK-7190
Denmark

Respondent: Porchester Partners Inc.
Mossfon Building, 2nd Floor, East 54st Street
Panama
P.O. BOX 0
Panama

2. The Domain Name:

<legolanddiscovery.co.uk> (the "Domain Name")

3. Procedural History:

On 16 July 2010 the Complaint was received by Nominet.

On 19 July 2010 Nominet validated the Complaint.

On 19 July 2010 a notification of Complaint was sent to the Parties by Nominet.

On 10 August 2010, because no Response had been received, a notification of no response was sent to the Parties by Nominet.

On 24 August 2010 Christopher Gibson was appointed as Expert for this case.

4. Factual Background

The Complainant is the owner of the trademarks LEGO (registered all over the world in respect of various goods and services) and LEGOLAND (registered for classes 9, 16 and 25 in the United Kingdom since 1989), used in connection with LEGO brand toys and products, as well as the Legoland Park located in Windsor and opened in 1996. The Complainant has developed substantial goodwill through use of the LEGO trade mark in many jurisdictions across the world.

The Complainant is also the owner of more than 1000 domain names containing the terms LEGO and LEGOLAND, including <lego.com>, <lego.co.uk>, <legoland.com>, and <legoland.co.uk>.

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

The Domain Name was registered on 27 March 2010.

5. Parties' Contentions

Complainant

The Complainant, based in Denmark, has provided substantial evidence of its ownership of the LEGO and LEGOLAND trademarks, used in connection with LEGO brand of toys and products, and also for LEGOLAND branded theme parks in various countries including the United Kingdom. The Complainant has also provided evidence that it is the owner of more than 1000 domain names containing the terms LEGO and LEGOLAND, including <lego.com>, <lego.co.uk>, <legoland.com>, and <legoland.co.uk>.

The Complainant states that the trademark LEGO is among the best-known marks in the world, due to decades of extensive advertising that prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. The Complainant has furnished a list of the top 500 Superbrands for 2009/10, provided by Superbrands UK, which shows LEGO as number 8 of the most famous trademarks and brands in the world. The LEGO Group has expanded its use of the LEGO mark to include computer hardware and software, books, videos and computer controlled robotic construction sets. The Complainant states that, over the years, the LEGO business has grown remarkably, with revenue for the LEGO Group in 2008 reaching more than US\$1.8 billion. The Complainant explains

that it has subsidiaries and branches around the world, with LEGO products sold in more than 130 countries, including in the United Kingdom.

The Complainant contends that the Domain Name <legolanddiscovery.co.uk> is an Abusive Registration because it incorporates the word “Legoland”, which is confusingly similar as well as identical, respectively, to the registered trademarks LEGO and LEGOLAND that have been registered by the Complainant as trademarks and domain names in numerous countries around the world. The addition of generic or geographical suffixes does not prevent the Domain Name from being considered similar to the marks. The addition of the suffix “discovery” is 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. The Complainant confirms that this opinion has been confirmed 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” did not displace the overall impact. The domain name, <playboyenterprises.co.uk>, was therefore seen as similar to the trademark PLAYBOY.

The Complainant asks this Expert to note that the Domain Name was registered on 27 March 2010, subsequent to the Complainant’s registration of the LEGO and LEGOLAND marks in the UK and elsewhere.

Moreover, the Complainant states there is no connection or co-operation between Complainant and the Respondent. The Complainant has neither licensed, nor otherwise authorized the Respondent to use the LEGO or LEGOLAND marks in the Domain Name. 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. No information indicates that the Respondent is commonly known by the name or legitimately connected with a mark that is identical or similar to the Domain Name.

The Complainant observes that all contact information for the Respondent has been omitted from the Whois service. A first cease and desist letter was sent to the Respondent on 5 May 2010 via postal mail. The Complainant advised the Respondent that the unauthorized use of the LEGO trademark in the Domain Name violated the Complainant’s rights in the LEGO and LEGOLAND marks. 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). The Respondent never replied to the letter, so a reminder was sent on 22 June 2010, but no reply was received. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the DRS process.

The Complainant submits that the trademark LEGO has the status of well-known trademark with a substantial and widespread reputation throughout the whole Community and the world. The awareness of the marks LEGO and LEGOLAND 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, and the

Complainant has listed the various DRS cases in which it has sought to protect its rights. The Complainant states that the considerable value and goodwill of the mark LEGO is most likely a large contribution to this and is also what made Respondent register the Domain Name here.

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. The Complainant has submitted evidence that the Domain Name is currently connected to a web site with sponsored links, and it is obvious that through this Respondent derives income. The Respondent most likely had the Complainant and its business in mind when registering the Domain Name. Complainant states in DRS No. 6365, *Oasis Store Ltd. and J Dale*, that the Expert argued that a domain name registrant is abusively using a domain name if the registrant 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. These same circumstances apply in this case. With these considerations in mind, the Complainant asserts that the Respondent must be considered to have taken an unfair advantage of Complainant's trademark rights.

In summary, the Complainant states that it is the owner of the well known LEGO and LEGOLAND marks. There is no doubt that the Respondent was aware of the Complainant's rights in these marks and their value, at the point of the registration. The Domain Name in question is clearly similar to the Complainant's registered LEGO and LEGOLAND marks, since it reproduces the marks in their entirety. The suffix "discovery" does not detract from the overall impression. Consequently, the Domain Name must therefore be considered to be similar to the Complainant's trademarks and the registration should be seen as an abusive registration.

Respondent

There was no Response filed.

6. Discussions and Findings

Paragraph 2.a of the DRS Policy provides that a Respondent must submit to proceeding if a Complainant asserts, 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 substantial evidence of its ownership of the LEGO and LEGOLAND trademarks in various jurisdictions around the world, including the United Kingdom, and that these marks have achieved global fame. The Complainant has developed substantial goodwill and reputation in the use of the LEGO and LEGOLAND marks in relation to toys, other goods and services, and Legoland theme parks.

Identical or Similar

The Domain Name consists of the word "Legoland" in combination with the word "discovery" and the ccTLD extension ".co.uk". For the purpose of making a comparison, the ccTLD extension may be ignored. The dominant element of the domain name is the letters "lego" or "legoland". The second element, "discovery", is not sufficiently distinctive to remove the similarity between the Complainant's LEGO or LEGOLAND marks and the Domain Name.

The Expert finds that the Domain Name is similar to the Complainant's trademark and the similarity is not decreased by the addition of the "discovery" element.

This Expert finds, on the evidence, that the Complainant has rights in the LEGO and LEGOLAND trademarks, which are similar to the Domain Name <legolanddiscovery.co.uk>. 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 combination of the words "Legoland" and "discovery" create a Domain Name that would seem to refer to Complainant's famous marks and its goods and services, including the Legoland branded theme parks. Moreover, there is no independent or alternative meanings for the terms "lego" or "legoland". On the evidence, the Expert finds that it is beyond coincidence that the Respondent would have chosen and registered the Domain Name without knowledge of the Complainant and its goodwill. Instead, the Respondent was aware of the Complainant's reputation and registered the Domain Name in order to use it to take predatory advantage of the Complainant's goodwill by confusing Internet users and diverting them to Respondent's web site for commercial gain. The

Domain Name resolves to a webpage which contains links to Legoland, Disney World and other leisure travel destinations.

This Expert finds, on the balance of probabilities, that Respondent has been using 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. It follows that the 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 and LEGOLAND marks 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 these marks.

This Expert finds therefore that the 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 Domain Name <legolanddiscovery.co.uk >be transferred to the Complainant.

Signed Chris Gibson

Dated 17 Sept 2010