

DISPUTE RESOLUTION SERVICE

D00020072

Decision of Independent Expert

LEGO Juris A/S

and

Identity Protect Limited

1. The Parties :

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

Respondent: Identity Protect Limited
5th Floor, The Shipping Building
Old Vinyl Factory, 252-254 Blyth Road
Hayes
Middlesex
UB3 1HA
United Kingdom

2. The Domain Name:

concretelegoblock.uk

3. Procedural History:

I can 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 being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

12 April 2018 Dispute received

16 April 2018 Complaint validated

16 April 2018 Notification of Complaint sent to parties
04 May 2018 Response reminder sent
09 May 2018 No Response Received
09 May 2018 Notification of no Response sent to parties
14 May 2018 Expert decision payment received

4. Factual Background

The Complainant is the owner of the LEGO trade mark and all other trade marks used in connection with the famous LEGO brand of construction toys and other LEGO branded products. It owns trade mark registrations for LEGO in the member countries of the European Union and numerous other countries around the world, including UK Registration No. UK00000754628 (registration date: 11 June, 1956) and EU Registration No. 000039800 (registration date: 5 October, 1998).

The Respondent registered the Disputed Domain Name (the Domain Name) on 11 October, 2017. The Respondent ignored correspondence sent on the Complainant's behalf concerning the registration and has taken no part in these proceedings. The Domain Name resolves to a commercial website offering concrete blocks shaped like LEGO blocks which are described as 'Concrete Lego Blocks'.

5. Parties' Contentions

The following is a summary of the Complaint's main contentions. As the Respondent has not filed a Response, these are the only contentions formally before the Expert.

Introduction

The Complainant 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 at the time of registration of the Domain Name. The Domain Name is clearly similar to the Complainant's LEGO trade mark should be seen as an abusive registration.

Rights

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 LEGO trade mark is of substantial inherent and acquired distinctiveness. It is among the best-known trade marks in the world, due in part to decades of extensive advertising which prominently depicts the LEGO trade mark on all products, packaging, displays, advertising and promotional materials. The LEGO trade mark and brand have been recognised as being famous. For instance, a list of the top 500 Superbrands for 2017, compiled by Superbrands UK, names LEGO as winner in the category 'Child Products - Toys and Education'.

As well as numerous trade mark registrations, the Complainant is also the owner of over 5,000 domain names containing the word LEGO, including <lego.com> and <lego.co.uk>.

Similarity

The Domain Name contains the trade mark, LEGO. The addition of the generic, descriptive terms 'concrete' and 'block' before and following the LEGO trade mark does not negate the confusing similarity between Domain Name and mark.

The Complainant is well known for making and selling toy building blocks for children. By including the word 'block' in the Domain Name, the Respondent obviously alludes to the Complainant's business, supporting the confusing similarity between Domain Name and mark.

There is a considerable risk that the public will believe the Domain Name is owned by the Complainant or that there is some kind of commercial connection with the Complainant.

By using the LEGO trade mark, the Respondent exploits the goodwill associated with the mark, which may result in dilution and other damage.

Abusive Registration

The Respondent registered the Domain Name a significant time after the LEGO trade mark was first registered in numerous countries around the world (and significantly later than the Complainant's registration of its <lego.co.uk> domain name on 26 February, 1997). The Respondent would therefore have been fully aware of the Complainant's rights in the LEGO trade mark (as well as in the <lego.co.uk> domain name) at the time of registration of the Domain Name.

In registering the Domain Name, the Respondent has created a domain name that is confusingly similar to the Complainant's trade mark, and also its <lego.co.uk> domain name.

The LEGO trade mark has a substantial and widespread reputation throughout the world. By registering the Domain Name, the Respondent has sought to trade on the goodwill and reputation of the LEGO trade mark and divert the Complainant's customers or parties interested in the Complainant, to the Respondent's website.

It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brand at the time the Domain Name was registered.

The Respondent has registered the Domain Name to ride on the Complainant's rights, taking undue advantage and causing detriment. In so doing, the Respondent must have realised, if not intended, that such would cause unfair disruption to the Complainant's business.

The Domain Name resolves to a commercial website offering concrete blocks, shaped like LEGO blocks, which are unrelated to the Complainant's products. Accordingly, the Respondent is attempting to cause consumer confusion in a nefarious attempt to profit therefrom. The impression created by the Domain Name and the website to which it resolves would cause consumers to believe that the Respondent is somehow associated with the Complainant when, in fact, it is not. The Respondent's actions thereby create a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Domain Name, and the Respondent is thus using the fame of the Complainant's trade mark to improperly increase traffic to its website for its own commercial gain.

The Respondent does not use and has not made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name, in connection with a genuine offering of goods and services.

There is no connection or co-operation between the Complainant and the Respondent. The Complainant has neither licensed, nor otherwise authorised the Respondent to use the LEGO trade mark in the Domain Name, or in any other respect.

The Respondent is not commonly known by a name or legitimately connected with a mark which is identical or similar to the Domain Name. The Complainant has searched trade mark databases but has found no registered trade marks or trade names in the Respondent's name which correspond to the Domain Name.

The Respondent has not made legitimate non-commercial or fair use of the Domain Name.

Absent a valid reason to register it, the Respondent has blocked, or prevented the Complainant from registering and using the Domain Name.

The Respondent ignored the Complainant's attempts to resolve this dispute prior to these proceedings.

6. Discussions and Findings

Under the provisions of the DRS Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's Rights

The meaning of 'rights' is defined in the DRS Policy as follows: *'Rights means 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 Complainant has several registered trade marks for LEGO and no doubt enjoys unregistered rights in the mark too. It is clear that the Complainant enjoys rights in the LEGO trade mark.

Similarity

The Domain Name encapsulates the Complainant's distinctive LEGO trade mark but also includes words of a generic or descriptive nature, namely 'concrete' (before LEGO) and 'block' (after LEGO). The LEGO trade mark however is clearly identifiable within the Domain Name and is its dominant element. The fact that it is sandwiched between two unremarkable generic or descriptive words, makes the LEGO trade mark no less identifiable and distinctive.

For the sake of completeness, it should be noted that the dominance of the LEGO trade mark within the Domain Name is in fact enhanced by the word 'block' which follows it, being a descriptive or generic word often associated with products sold under the LEGO trade mark.

The Complainant's LEGO trade mark and Domain Name are similar and accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark which is similar to the Domain Name for the purposes of the DRS Policy.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either '*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 which '*is being or has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights*';.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 5 of the DRS Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name *primarily* as a blocking registration against a name or mark in which the Complainant has rights (para 5.1.1.2), or for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1.3).

Other such factors suggesting an Abusive Registration include the Respondent 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 (para 5.1.2).

If the domain name is an exact match for the name or mark in which the complainant has rights, the complainant's mark has a reputation and the respondent has no reasonable justification for the registration, that too may evidence an Abusive Registration (para 5.1.6).

A non-exhaustive list of countervailing factors is set out in paragraph 8 of the DRS Policy i.e. factors which may indicate that the Domain Name is not an Abusive Registration. Included are circumstances suggesting that before being aware of the complainant's cause for complaint, the respondent has used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services (para 8.1.1.1). A respondent being commonly known by a name or legitimately connected with a mark which is identical or similar to the domain name (para 8.1.1.2), or having made legitimate non-commercial or fair use of the domain name (para 8.1.1.3), will also be indicative of a registration that is not abusive. If the domain name is generic or descriptive and the respondent is making fair use of it, that too may indicate that it is not an Abusive Registration (para 8.1.2).

Discussion on Abusive Registration

It can be seen that, at the heart of the DRS Policy, is the requirement to prove unfairness: for a registration to be considered 'abusive' there should be something unfair in the object or effect of the respondent's behaviour.

There can be little doubt that a domain name which incorporates a famous trade mark, even if combined with generic or descriptive terms, may cause confusion as to the identity of the entity behind the Domain Name. This is particularly so if one or more of the generic or descriptive terms is indicative or reminiscent of the trade mark owner's products i.e. blocks. However, it does not follow that in such circumstances, a finding of Abusive Registration for the purposes of the DRS Policy must always be made. Unfairness in the object or effect of the respondent's behaviour must be established.

Turning to the present circumstances, the Respondent clearly knew of the Complainant, its products and trade mark at the time of registration of the Domain Name. The Respondent's use of the LEGO trade mark in the Domain Name (and to describe products available on its website i.e. 'Concrete Lego Blocks') is no coincidence. There can be little doubt that the Respondent included the trade mark LEGO in the Domain Name to take advantage of the fame and goodwill associated with it. The Respondent is not known by a name or legitimately connected with a mark which is identical or similar to the Domain Name, did not seek permission to use the LEGO trade mark and failed to engage with the Complainant prior to or after the commencement of these proceedings. Whilst the Respondent obviously recognises the benefits of association with the Complainant's famous LEGO trade mark, including the inherent confusion its use in the Domain Name is likely to cause and the advantages that might flow (for instance, potentially increasing traffic to its own website), it appears content to ignore the Complainant's rights associated with the mark or any possible harm that could be caused to the Complainant. In fact, the Respondent appears content to ignore the Complainant all

together, including the investment it has and continues to make in its LEGO trade mark which has given rise to the very fame and goodwill associated therewith on which the Respondent seeks to take a free ride.

Even if an Internet user ending up at the website to which the Domain Name resolves immediately realises that it is not a website of the Complainant (having thought it might be initially), it will be a nuisance for the Internet user, who will likely be a customer or potential customer of the Complainant looking to buy or receive information about the Complainant or its products. This may well be disruptive to the Complainant's business and, ultimately, detrimental to it.

The Complainant has made out a case of Abusive Registration in that it has demonstrated that there are circumstances suggesting that the Respondent has acted in a manner which has taken unfair advantage of, or which has perhaps been unfairly detrimental to the Complainant's Rights. It now therefore falls to be decided if the Respondent has an answer to the case. Whilst the Respondent has not taken any part in these proceedings or indicated its position in any other way (apart from ignoring the Complaint and Complainant), the Expert must still be satisfied on the balance of probabilities that the Domain Name is, in the hands of the Respondent, an Abusive Registration.

In the circumstances described, the use to which the Respondent has put the Domain Name could not be considered *fair use* for the purposes of paragraph 8 of the DRS Policy (or, for that matter, *legitimate non-commercial use*). Moreover, the Respondent's use could not be regarded as a *genuine offering of goods or services* – its offering clearly takes unfair advantage of the Complainant's LEGO trade mark and may well cause detriment to it (given the likelihood of confusion). In any event, the Respondent did or should have known of the Complainant's cause for complaint at the outset, given its intention to free-ride on the fame and goodwill of the LEGO trade mark.

In all the circumstances, there would appear to be very little that the Respondent could say in answer to the Complaint and the Expert concludes that the Domain Name was and is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has Rights in a name or mark that is similar to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, <concretelegoblock.uk> be transferred to the Complainant.

Signed:

Jon Lang

Dated: 4 June 2018