Panel Decision for dispute CAC-ADREU-006757

Case number	CAC-ADREU-006757
Time of filing	2014-12-12 16:45:40
Domain names	LEGOminifigures.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	LEGO Juris A/S

Respondent

Organization	Blacklemon S.r.l.

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

Not applicable

FACTUAL BACKGROUND

Complainant is a company having its seat in Denmark mainly renowned for construction of toys and other branded products.

The Complainant has provided evidence of a number of registered trademarks for the term Lego (the Complainant is inter alia owner of European Community trademark for term Lego with registration number 39800).

The Complainant has also provided evidence of ownership of over than 2400 domain names containing the term Lego.

The Complainant argues that the disputed domain name "LEGOminifigures", which thereby contains the word Lego, is identical to the trademark Lego registered by the Complainant as trademarks and domain names in numerous countries all over the world, including in Italy where the Respondent is seated.

The Respondent is a company having its seat in Italy and failed to file its reply to the alleged claims purported to it within the timeframes permitted.

The disputed domain name was registered on 23 January 2014 and was not in active use when the decision of the single-panel dispute was handed.

The Complainant requested that the disputed domain name is transferred to it.

A. COMPLAINANT

The Complainant is the owner of the Lego brand, which is recognised through trademarks. The Lego group of companies or through their predecessors commenced use of the Lego mark in the US during 1953, to identify construction toys made and sold by them. The Complainant has subsidiaries and branches throughout the world, and Lego products are sold in more than 130 countries, including Italy (being the country of the Respondent).

The Lego group has extended its use of the Lego trademark to inter alia computer hardware and software, books, videos, and computer controlled robotic construction sets. The Lego group also maintains an extensive web site under the domain name Lego.com.

The Lego brand is a well known mark and its fame has been previously affirmed through a CAC decision 06183 in the case of "Lego Juris

A/S vs Paisiy Aleksandrov" dated 21 November 2011. In addition, the fame of the trademark has been confirmed in numerous previous UDRP decisions, such as decision D2008-1962 in the names of "Lego Juris A/S vs Level 5 Corp", and also decision D2009-0680 in the names of "Lego Juris A/S vs Reginald Hastings Jr."

The dispute forwarded by the Complainant relates to a domain name "www.legominifigures.eu", whereby the Complainant suggests that the disputed domain name is (i) identical or confusingly similar, (ii) registered by its holder without rights or legitimate interests, and (iii) registered or used in bad faith.

The Complainant in synthesis submits that Lego is a famous trademark worldwide. It further suggests that the Respondent was aware of the Complainant's rights in the trademark and its value when the registration of the domain name was affected. It subsequently holds that there is no connection between the Respondent and the Complainant. It continues by suggesting that by using the disputed domain name, the Respondent made an illegitimate non-commercial and unfair use of the domain name. It further submitted that the Respondent should be considered to have registered and used the disputed domain name in bad faith.

In substantiating its claims, the Complainant did not only provide a list of factual statements, but did also cite and made reference to previous decided domain name disputes.

B. RESPONDENT

The Respondent did not file any response within the prescribed time.

DISCUSSION AND FINDINGS

The legal basis for requesting the transfer of the disputed domain name is inter alia article 21 of the Regulation (EC) 874/2004 which prohibits speculative and abusive registrations. A domain name is susceptible for revocation if it is identical or confusingly similar to a name in respect of which a right is recognised or established. It is important to establish whether its holder registered the domain name without rights or legitimate interest in the name or if it is registered or is being used in bad faith.

(i) Identical or confusingly similar

The Complainant suggested that the contested domain name "www.LEGOminifigures.eu" is virtually identical to domain names, to the well-known trademarks and the distinctive business trade usage of
the globally known brand of Lego;

The Complainant held that the suffix minifigures does not detract from the overall impression, instead the suffix is contributing to create a link to the Complainant.

It also transpires that the Complainant´s company uses the term "minifigures" to refer to its products. In fact, one of its sites it suggests "Welcome to the LEGO® Minifigures website."

Similar arguments were brought forward in other previous decisions of CAC, whereby in case no. 06641 in the names of “Amazon Europe Holding Technologies SCS vs Jack Solomon” the single-member panel was asked to determine whether the disputed name being "amazon-it" was irregularly registered. In this case, the CAC held that,

“… this Panel finds that designation “-it” additionally contributes to the confusing similarity of the contested domain name in relation to the Complainant’s rights, given the fact the Complainant already holds domain name “amazon.it”.

Likewise, the CAC case no. 06629 in the names of “National Westminister Bank PLC., vs Andrew Culloo” concluded that the disputed domain name “natwestplc” was irregularly registered and used. It was held that,

“… the Panel agrees with the Complainant that the use of this generic term simply serves to strengthen the impression that the domain name belongs to or is affiliated with the Complainant and is not sufficient to distinguish the domain name from the complainant’s mark … The domain name is confusingly similar to the complainants’ Natwest trade mark within article 21(1) of the regulation.”

The Panel is of the opinion that it should be emphasized that the disputed domain name fully incorporates term Lego which is in fact the Complainant’s registered trademark which is distinctive and recognized worldwide. In other words, the disputed domain name is comprised of (i) the Complainant’s registered trademark and (ii) term “minifigures”. According to the Panel, adding such a generic term as “minifigures” does not distinguish the disputed domain name from the Complainant’s trademark. Therefore, the Panel finds the

disputed domain name to be confusingly similar to the Complainant's trademark Lego in the sense of Article 21 (i) of the Regulation (EC) 874/2004.

(ii) Registered without rights or legitimate interests

The very principle that the Respondent registered that domain name does not grant a right or legitimate interest to do so. Clearly the name with which the Respondent operates its operation is different completely than the domain name used.

Moreover, it does not appear that the Respondent is commonly known by this name.

Article 21(2) of the EC Regulation includes a non-exhaustive list of how legitimate interest in registration of a particular domain name can be made and shown. Clearly each and every point included within this article is not only non-demonstrable but clearly in defiance of legislation.

(ii.i) POINT 1 Provision 21[2](a)
"Prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so"

It appears that prima facie (and even more so due to the failure to submit a reply) the disputed domain name has been used irregularly and without having the necessary rights or interests in doing so.

(ii.ii) POINT 2 Provision 21[2](b)
"the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law"

The Respondent company seems to have no connection whatsoever with Lego, and has never been known or remotely known with the name it purports through the disputed domain name.

(ii.iii) POINT 3 Provision 21[2](c)
"the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or community law."

It seems that the aim of the Respondent was to take an unfair advantage and mislead consumers, by integrating the brand name of the Complainant within its domain name.

The failure to demonstrate any legitimate right or interest will presumably lead to registration without legitimate interest as has been claimed within CAC case no. 06544 in the names of, "Swarovski Aktiengesellschaft vs Marcel Hertz". In other words, The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. The Respondent has made no attempt to do so. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

(iii) Registered and/or used in bad faith

For the Panel is of the opinion that the Respondent has no rights or legitimate interests in the disputed domain name it is no longer necessary to examine whether the Respondent lacks good faith or not. However, in any case the Panel points out that the Respondent seems to have an aim of creating a likelihood of confusion with a name on which a right is recognized or established, by national and European Union law, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent. Considering that the disputed domain name was registered on 23 January 2014 and that the registration date for the Complainant's CTM Lego is 5 October 1998 as well as the reputation of the Complainant's trademark, in the Panel's view the Respondent was or should have been aware of the Complainant's trademarks when registering the disputed domain name. It follows that the disputed domain name is being used in bad faith.

These same principles have been pronounced and established in a previous CAC case no. 06183 in the names of "Lego Juris A/S vs Company, Paisiy Aleksandrov".

Although not decided by the CAC, other decisions tackled mala fide registrations of domain names. In the case, “Exxon Mobil Corporation vs Wally Akhras”, bad faith registration and use of the domain name "mobil1lubeexpress.ca" was alleged and ultimately a panel deemed that the disputed domain name was maliciously registered by a respondent, with the CDRP ultimately determining that the disputed domain name should be transferred unto the complainant.

Similarly, the same procedures were made us in the CDRP case “Oakley, Inc. vs Zhou yayang6” whereby mala fide registration was alleged and subsequently determined. In both instances, it was established that the disputed domain names were registered by the holder without the necessary interest and rights, and were only made as to illicitly free ride and gain from the pursuits of the rightful owners of the generic name.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that:

the domain name www.LEGOMINIFIGURES.eu be transferred to the Complainant

PANELISTS

Name	**Dr. Matthew Paris**

DATE OF PANEL DECISION 2014-12-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: www.legominifigures.eu

II. Country of the Complainant: Denmark, country of the Respondent: Italy

III. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. [Lego trademark registered in Italy, reg. No. 1211959,in respect of goods and services in classes 28
2. [Lego trademark registered in Italy, reg. No. CTM39800 ,in respect of goods and services in classes 3, 9 ,14,16 20, 24, 25, 28, 38, 41, 42

V. Response submitted: [No]

VI. Domain name is [identical/confusingly similar] to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. [No]
2. Why: As explained within the decision, the respondent has no rights, and failed to provide any evidence to sustain any rights whatsoever

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. [Yes]
2. Why: Given that there has been prior use by Lego, it is clear that the aim was to churn clients of the Complainant

IX. Dispute Result: [Transfer of the disputed domain name]

X. [If transfer to Complainant] Is Complainant eligible? [Yes]