



தமிழ்நாடு தமில்நாடு TAMILNADU

AD 292341

10065
- 7 MAR 2012

D. SARAVANAN
Arbitrator, Arbitrator & Mediator
Civilian Chamber No. 80 (Old No. 73)
4th & 5th Floor, Arundhanai Street,
Chennai - 600 021.
Phone : 944 - 1206 2001

S. SHANMUGA SUNDARAM
STAMP VENDOR,
L No B4 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: www.legoland.in

LEGO Juris A/s
Koldingvej 2, 7190
Billund, Denmark
anna.mejlero@melbourneitdbs.com

Complainant

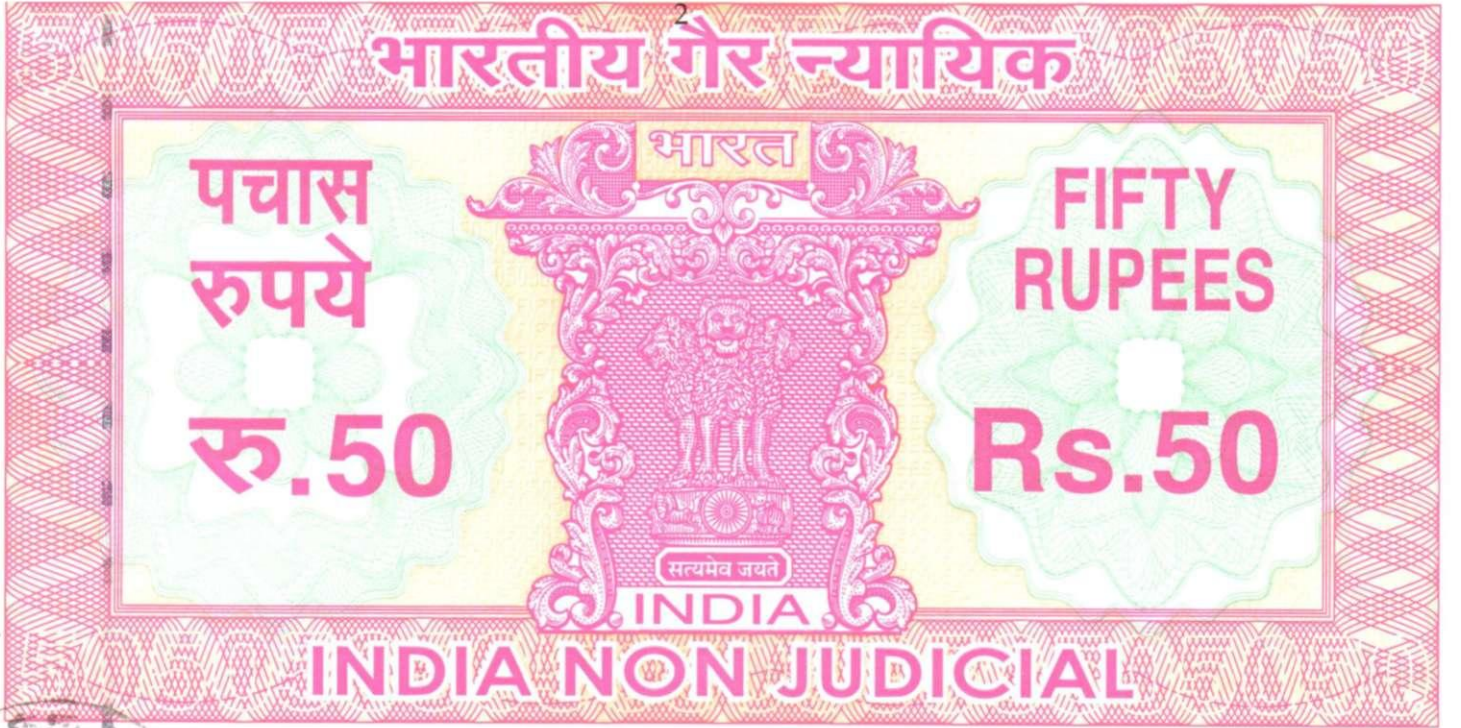
Vs.

Peter Chang
8 Fordham Rd Lewes East Sussex
BN8 6FL GP
eu@ynyn.net

Respondent

..2.





தமிழ்நாடு தமிலநாடு TAMILNADU

10125

- 7 MAR 2012

D. SARAVANAN

Advocate, Arbitrator & Mediator
"Orient Chambers" No. 90 (Old No. 73),
4th & 8th Floor, Armenton Street,
Chennai - 600 001,
Phone : 044 - 4205 3051

V 638241

PS. SHANMUGA SUNDARAM,
STAMP VENDOR,
L No. P47/109 / 88
HIGH COURT COMPLEX,
CHENNAI 600 101 (TAMIL NADU)

-2-

1. The Parties:

The complainant is LEGO Juris A/s, Koldingvej 2, 7190, Billund, Denmark, Rep. by its
Authorised Representative Anna Mejlero.

The respondent is Peter Chang, 8 Fordham Rd Lewes East Sussex, BN8 6FL GP.

2. The Domain Name and Registrar:

The disputed domain name:

www.legoland.in

The domain name registered with .IN REGISTRY



3. Procedural History:

- January 13, 2012 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- January 24, 2012 : Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant, Complainant's authorized representative and .IN REGISTRY.
- February 03, 2012 : Due date for filing Response by Respondent.
- February 10, 2012 : Arbitrator sent an e-mail to Respondent notifying his default, a copy of which was marked to Complainant's authorised representative and the .IN REGISTRY.
- February 10, 2012 : The Respondent sent an email stating that "*Can the two sides reach a compromise?*" which email was forwarded to the Claimant marking a copy to all the concerned.
- February 13, 2012 : The Claimant sent a reply stating that "*We request that the domain name is transferred to the Complainant. This is why we filed a complaint, after attempts to have a voluntarily solution. We sent a cease and desist letter to the registrant, however without any friendly solution. The Complainant is not interested in any compromises, but a transfer of the domain name to the Complainant.*" To which, the reply mail sent by the respondent using offensive language was forwarded by the Claimant to the Arbitrator and all the concerned.

The language of the proceedings in English.

4. Factual Background:

4.1 The Complainant:

The complainant is LEGO Juris A/s, Koldingvej 2, 7190, Billund, Dermark, Rep. by its Authorised Representative Anna Mejlero.



Complainant's Activities and Complainant's Trading Name:

The Complainant states inter-alia that it has European Union trademark with registration number 000054205 (CTM) for LEGOLAND; Complainant LEGO Juris A/S 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 which includes the trademark LEGOLAND; this complaint is based on both the trademark LEGO and the whole LEGOLAND trademark; the Complainant's licensees are authorized to exploit their intellectual property rights, including its trademark rights, in India and elsewhere; Complainant and its licensees, through their predecessors, commenced use of the LEGO mark in the U.S. during 1953, to identify construction toys made and sold by them; their use of the LEGO mark has been extensive, exclusive and continuous since 1953; over the years, the business of making and selling LEGO branded toys has grown remarkably; by way of example, the revenue for the LEGO Group in 2009, was more than \$2.8 billion; its global market share rose from 4.8% at the close of 2009 to approx. 5.9% at the end of 2010; the Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in India; the Complainant is also the owner of more than 1000 domain names containing the term LEGO and LEGOLAND (**Annex 6**); 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; indeed, the LEGO trademark and brand have been recognized as being famous; for instance **Annex 9**, is a list of the official top 500 super brands 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; the LEGO Group also maintains extensive Web sites under the domain names LEGO.com and LEGOLAND.com (**Annex 8**); the LEGOLAND parks are today owned by Merlin Entertainments; however, all rights to the trademark LEGOLAND are still owned by the LEGO Group (**Annex 4**) and only Merlin has a license to use the trademark in connection with the parks; the mark LEGO is in possession of substantial inherent and acquired distinctiveness; 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 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 regardless of the list of the products and services for which the trademark is registered; thus, the protection for LEGO goes far beyond toys and goods similar to toys.

4.2 Respondent's Identity and activities:

The Respondent is Peter Chang, 8 Fordham Rd Lewes East Sussex, BN8 6FL GP who is the registrant of the Domain Name www.legoland.in which is registered with .IN REGISTRY, National Internet Exchange of India, New Delhi. Neither the Respondent represented himself nor represented by any one.

5. Parties contentions:

A. Complainant:

(a) The Domain Name is identical or confusingly similar to a Trademark or service mark of the Complainant has rights:

The complainant states that the dominant part of the domain name LEGOLAND.in comprises the word LEGOLAND, which is confusingly similar as well as identical to the registered trademarks LEGO and LEGOLAND, which have been registered by the Complainant as trademarks and domain names in numerous countries all over the world as evidenced under **Annex. 4 and 6** the fame of the trademark has been confirmed in numerous previous UDRP decisions; case No.D2008-1692 LEGO Juris A/S v. Level 5 Corp. *"The Panel finds that the Complainant has established that LEGO and LEGOLAND are well-recognized and world famous trademarks and that the trademarks are distinctive"*, case No.D2008-1715 LEGO Juris A/S v. Michael Longo; *"The Panel finds, as numerous panels have found before, that the Complainant has established that LEGO is a well-known trademark and that the trademark is distinctive and famous"* and case No.D2009-0680 LEGO Juris A/S v. Reginald Hastings Jr; *"LEGO is a mark enjoying high reputation as construction toys popular with children"*. In Case No.D2011-1304 LEGO Juris A/S v. Colin Heggie regarding the domain name LEGOLAND-



villa-florida.com, the Panelist stated: *"The suffix '-villa-florida' does not detract from the overall impression that the disputed domain name is confusingly similar to Complainants well-known registered trademark LEGO and LEGOLAND"*. Panels have numerous times stated that it is a long-established precedent that confusing similarity is generally recognized when well-known trademarks are paired up with different kinds of generic prefixes and suffixes, e.g. Case No.D2004-0488 Dr. Ing. h.c. F.Porsche AG v. Rojeen Rayaneh; in the Indian decision M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004(5) SC 541, the Panel stated that a Domain name has all characteristics of a trademark and as such, principles applicable to trademark are applicable to domain names also. In case INDRP/125 in regards of the domain name LEGO.co.in, the Panel stated that the Domain Name was confusingly similar to the Complainants trademark; the addition of the country code top-level domain (ccTld) "IN" does not have any impact on the overall impression of the dominant portion of the Domain Name and is therefore irrelevant to determine the confusing similarity between the trademark and Domain Name; anyone who sees the Domain Name is bound to mistake it for a name related to the Complainant; the likelihood of confusion includes an obvious association with the trademark of the Complainant; regarding the reputation of the trademark LEGO there is a considerable risk that the trade public will perceive the Respondent's Domain Name either as a domain name owned by the Complainant or that there is some kind of commercial relation with the Complainant; the trademark also risk being tarnished by being connected to a website; by using the trademark as a dominant part of the Domain Name, the Respondent exploits the goodwill and the image of the trademark, which may result in dilution and other damage for the Complainant's trademark; persons seeing the Domain Name at issue, even without being aware of the content, are likely to think that the Domain Name is in some way connected to the Complainant, ("initial interest confusion"); the Complainant is the owner of the well known trademarks LEGO and LEGOLAND; the Domain Name in question is identical to the Complainant's registered trademark LEGOLAND and the Domain Name must therefore be considered to be confusingly similar with the Complainant's trademark.

(b) Respondent has no rights or legitimate interests in the domain name:

The complainant states that they have not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Names and that they



have also not found anything that would suggest that the Respondent has been using LEGOLAND in any other way that would give them any legitimate rights in the name and consequently, the Respondent may not claim any rights established by common usage; it is also clear that no license or authorization of any other kind has been given by the Complainant to the Respondent, to use the trademarks LEGOLAND or LEGO in case D2000-0055 Guerlain S.A. v. Peikang the panel stated that, “in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bonafide or legitimate use of the domain name could be claimed by Respondent”; the Respondent is not an authorized dealer of the Complainant’s products and has never had a business relationship with the Complainant which was stated by the panel as a factor in the finding of non legitimate interest with the Respondent in Case No. D2004-0312 Dr. Ing. h.c. F.Porsche AG. Ron Anderson; Respondent has registered the Domain Name on May 20, 2011 and the mere registration of a domain name does not give the owner a right or a legitimate interest in respect of the domain name; it is highly unlikely that the Respondent would not have known of the Complainant’s legal rights in the name LEGO at the time of the registration; it is rather obvious that it is the fame of the trademark that has motivated the Respondent to register the Domain Name, hence the Respondent cannot claim to have been using LEGO or LEGOLAND, without being aware of the Complainant’s rights to it; in the earlier cited Case No.D2011-1304 LEGO Juris A/S v. Colin Heggie, the Panelist stated: *“The trademarks LEGO and LEGOLAND are among the leading brand names in the world. Respondent cannot claim to have been using LEGOLAND, without being aware of Complainant’s rights to it. The disputed domain name <legoland-villa-florida.com> in which LEGOLAND is the distinguishing element implies some association of the disputed domain name with Complainant’s trademark LEGOLAND. There is a public attraction associated with very well known trademarks. This, among other facts, supports an inference that Respondent’s interests cannot have been legitimate.”*; the Respondent is today not using the Domain Name in connection with a bonafide offering of goods or services, instead the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic to his web site; the site display sponsored links, related to LEGOLAND parks and LEGO products, as well as to competitors’ products as well as to companies and products unrelated to the Complainant as evidenced under **Annex 9**. the use of the Domain Name to sponsored links is not a bonafide use of the Domain Name, see earlier WIPO cases including the LEGO trademark, Case No.D2010-1156;



"Further, Respondent's use of the disputed Domain Name to sponsor links to paid advertising is not use of the Disputed Domain Name in connection with a bonafide offering of goods or services", this was also discussed in Case No.D2010-0707; the Respondent is using the LEGOLAND and LEGO trademarks and misleading Internet users to commercial web sites for own commercial gain; the Respondent is trying to sponge off the Complainant's world famous trademark; in case, D2001-0067; Drexel University v.David Brouda, the Panel stated that "rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant" referring to the above mentioned the Claimant states that the Respondent has no rights or legitimate interest in respect of the Domain Name.

(c) Respondent has registered and is using the domain name in bad faith:

The complainant states that the trademark LEGO in respect of toys belonging to the Complainant has the status of a well-known and reputed trademark with a substantial and widespread reputation throughout the whole community and throughout the world; the awareness of the trademarks 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 trademarks LEGO and LEGOLAND in combination with other words has skyrocketed the last years e.g. WIPO cases D2011-1677, D2011-1589, D2011-1557, D2011-1555, D2011-1550, D2011-1526, D2011-1464, D2011-1444, D2011-1441, D2011-0617, D2011-0537, D2011-0505, D2011-0442, D2011-0226, D2010-2191, D2010-2178, D2010-2042, D2010-2030, D2010-0835, D2010-0839, D2010-0840, D2010-0881, D2010-0660, D2010-0545; the Complainant first tried to contact the earlier registrant on May 05, 2010 through a cease and desist letter by e-mail under **Annex 10**; the Respondent replied that the registration was lawful; a discussion followed regarding the compensation of costs, but the Respondent never came back with any receipt as asked by the Complainant, and he never replied on the reminder sent; in September 2010, the whois was updated and the Complainant sent a new cease and desist letter to the new email address; however, everything points to the fact that it is the same person behind both whoises as it is written in the from space in the emails "On Behalf of LEE" from both registrants addresses; this time the Registrant asked for 2,000 Euro in order to transfer the Domain Name; since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a



complaint according to the INDRP process; As the whois had been changed the Complainant first sent a new cease and desist letter on December 7, 2011 to the new registrant; no reply was received and the Complainant filed a complaint according to the INDRP process; the Domain Name is connected to a site with sponsored links related to LEGOLAND and LEGO products, products from its competitors as well as links to companies and products unrelated to the Complainant; the fame of the Complainant's mark is so well-known that any registration as recently as May 20, 2011 of a domain name incorporating that trademark must have been in bad faith; according to the INDRP Policy, it is sufficient if the Domain Name has been registered in bad faith. This case is similar to Case INDRP/125 regarding the domain name LEGO.co.in, where the Panel found that the usage of sponsored links for commercial gain under the circumstances discussed is evidence of bad faith use; LEGO and LEGOLAND are famous trademarks worldwide; there is no doubt that the Respondent was aware of the rights the Complainant had in the trademarks and the value of said trademarks, at the point of the registration; there is no connection between the Respondent and the Complainant. By using the Domain Name the Respondent is not making a legitimate non-commercial or fair use without intent for commercial gain but is misleadingly diverting consumers.

B. Respondent:

The Respondent did not submit any response.

6. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? And Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. However, the Respondent did not choose to submit any response on merits of the complaint and that non-submission of the Response by the Respondent had also been notified to the Respondent.



Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

(a) Identical or confusing similarity:

i) The Arbitral Tribunal finds that the Complainant has provided evidences that it possesses registered Trade / Service Marks "LEGO" and "LEGOLAND" in various countries throughout the world including India under Annexure 4 and also possesses registered domain names consisting "lego" and "legoland" in various ccTLDs throughout the world under Annexure 6. The Respondent's domain name, <legoland.in>, consists of entirely Complainant's trademark, except ccTLD. Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <legoland.in> is confusingly similar or identical to the Complainant's marks.

ii) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support



of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response on merits of the complaint to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. The Complainant has established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

ii) Considering the above, and based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location.

ii) The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered



trademarks and trade names of the Complainant. The Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was no real purpose for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to reap unfair rewards through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

7. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <legoland.in> be transferred to the Complainant.

Dated at Chennai (India) on this 12th day of March, 2012.


(D.SARAVANAN)
Sole Arbitrator

