

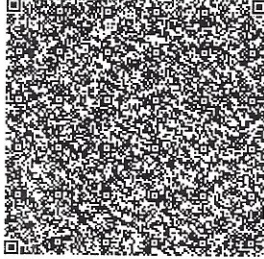
सत्यमेव जयते

INDIA NON JUDICIAL

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e-Stamp

Certificate No.	: IN-DL668719830618710
Certificate Issued Date	: 05-Jul-2016 01:18 PM
Account Reference	: IMPACC (SH)/ dlshimp17/ SUPREME COURT/ DL-DLH
Unique Doc. Reference	: SUBIN-DLDSLHIMP17331695758086660
Purchased by	: DIVYABALASUNDARAM
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	: 0 (Zero)
First Party	: DIVYABALASUNDARAM
Second Party	: Not Applicable
Stamp Duty Paid By	: DIVYABALASUNDARAM
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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Before the Sole Arbitrator, Divya Balasundaram
C/o National Internet Exchange of India

In the matter of :

Lego Juris A/S Vs. Immanuel Robert

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as available on the website renders it invalid.
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Divya

**BEFORE THE SOLE ARBITRATOR, DIVYA BALASUNDARAM
.IN REGISTRY
C/o NATIONAL INTERNET EXCHANGE OF INDIA**

ARBITRATION AWARD

LEGO Juris A/S
Koldingvej 2
7190 Billund
Denmark

...Complainant

Versus

Immanuel Robert
RobertIndia Technologies Pvt. Ltd.
#2,SMS Arcade, Varmavoo
Bangalore
Karnataka 560043
India

... Respondent

1. The Parties

- 1.1 The Complainant is LEGO Juris A/S of the address Koldingvej 2, 7190 Billund, Denmark, represented by CSC Digital Brand Services, AB, Helena Myrin, Saltmätargatan 7, Box 3396 103 68 Stockholm, Sweden.
- 1.2 The Respondent is Immanuel Robert, Robert India Technologies Pvt. Ltd., #2,SMS Arcade, Varmavoo, Bangalore, Karnataka 560043, India.

2. The Domain Name and Registrar

- 2.1 The disputed domain name is <legohouse.in> registered with Webiq Domains Solutions Pvt. Ltd. The said domain name was registered on October 13, 2015.

3. Procedural History

- 3.1 Arbitrator received an email on June 30, 2016 inquiring if NIXI can avail its services as an arbitrator for the dispute pertaining to the domain name legohouse.in. Arbitrator confirmed availability by email of July 01, 2016 and also sent the signed Statement of Acceptance and Declaration of Impartiality and Independence as required by the Rules.

- 3.2 The .IN Registry appointed Divya Balasundaram as the Sole Arbitrator on July 8, 2016 and Arbitrator received soft copy of the Complaint along with Annexures as well as hard copy.
- 3.3 Arbitral proceedings were commenced by Arbitrator on July 11, 2016 by issuance of a notice by email to the Respondent directing him to file his reply to the Complaint within 15 days. Arbitrator addressed an email to the Respondent on August 8, 2016 stating that since no response was received within the stipulated time frame, the arbitral proceedings shall continue ex-parte and order would be passed accordingly.
- 3.4 The Arbitrator received a phone call from the Respondent on August 12, 2016 stating that the impugned domain name was purchased by him on behalf of his client as the same was available for sale. Arbitrator requested Respondent to present his submissions in writing. On August 19th, Arbitrator sent an email to Respondent asking for a written response by August 22nd. Additional time was granted to the Respondent in the interest of justice to present his case. Arbitrator received an email on August 22, 2016 from Respondent stating its case. Subsequent to receiving the email from the Respondent, the Arbitrator has reviewed the Complaint and Respondent's submissions before passing this award.
- 3.5 The language of these proceedings in English.

4. **Background of the Complainant and its rights in the trademark LEGO as stated in the Complaint**

- 4.1 The Complainant is the owner of the LEGO trademark, and all other trademarks used in connection with the LEGO brands of construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit its intellectual property rights, including its trademark rights. Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and its products are sold in more than 130 countries, including in India.
- 4.2 The Complainant is also the owner of more than 4000 domain names containing the term LEGO. It is the strict policy of the Complainant that all domain names taking an unfair commercial advantage of the LEGO trademark should be recovered by the Complainant.

- 4.3 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. The LEGO trademark and brand have been recognized as being famous. The official top 500 Superbrands for 2015 provided by Superbrands UK, selected LEGO as winner in the category "Child Products - Toys and Education"; Brand Finance reported that the LEGO brand has replaced Ferrari as the most powerful brand in the world. Thus, the LEGO trademark is in possession of substantial inherent and acquired distinctiveness, and the LEGO mark and brand are well-recognized by consumers, industry peers, and the broader global community.
- 4.4 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 an extensive website under the domain name LEGO.com.
- 4.5 The awareness of the trademark LEGO is considered in the whole Community to be significant. The Complainant contends LEGO is a well-known mark and accordingly it has the right to prevent any use of the said mark or a confusingly similar denomination in connection with any products or services, regardless of the products and services for which the trademark is registered. The protection for LEGO goes far beyond toys and goods similar to toys.
- 4.6 The fame of the trademark has been confirmed in numerous previous UDRP decisions; for instance, in LEGO Juris A/S v. Level 5 Corp., in LEGO Juris A/S v. Michael Longo, and LEGO Juris A/S v. Reginald Hastings Jr.

5. **Contentions of the Complainant in establishing the 3 elements required under the INDRP**

Element 1 - In support of this element, i.e., the disputed domain name is identical or confusingly similar to Complainant's trademark, the Complainant has submitted that:

- 5.1 The dominant part of the disputed domain name comprises the term LEGO, identical to the trademark LEGO registered by the Complainant as trademarks and domain names in numerous countries all over the world including under the country code top level domain ".in", as well as

under the most popular generic TLD “.com”; which domain name string is identical to the disputed domain name registered by the Respondent.

- 5.2 The disputed domain name is confusingly similar to the Complainant's trademark LEGO. In addition, the disputed domain name has the generic term “house” added which does not detract from the overall impression. Considering that the Complainant has been working on a project for the last few years called LEGO House, a building intended to resemble a collection of stacked LEGO bricks expected to draw 250,000 visitors per year, which was announced to the public in 2013, the use of said term implies an obvious connection to the Complainant. The country code top level domain (cc TLD) “.in” can be disregarded for purposes of assessing similarity of the domain name to the trade mark.
- 5.3 Anyone who sees the disputed 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. With reference to the reputation of the trademark LEGO there is a considerable risk that the trade public will perceive the disputed domain name either as that of the Complainant, or that there is some kind of commercial relation with the Complainant. When performing a search of the domain name string of the disputed domain name (“LEGO house”) on Google most results are related to the Complainant and its LEGO products, strongly indicating a likelihood of Internet user confusion. By using the trademark as a dominant part of the disputed domain name, the Respondent exploits the goodwill and the image of the Complainant's trademark, which may result in dilution and other damage for the trademark.

Element 2 - In support of this element, i.e., the Respondent has no rights claims, or legitimate interests in respect of the disputed domain name, the Complainant has submitted that:

- 5.4 LEGO is a famous trademark worldwide and in case no. D2001-1314, Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc., it was established that any use of such a trademark in a domain name would violate the rights of the trademark owner. It is rather obvious that it is the fame of the trademark that has motivated the Respondent to register the Domain Name in the first place. That is, the Respondent cannot claim to have been using LEGO, without being aware of the Complainant's rights to it.

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- 5.5 The Respondent does not have any registered trademarks or trade names corresponding to the Domain Name. There is no evidence to suggest that the Respondent has been using LEGO in any other way that would give it any legitimate rights in the name. Consequently, the Respondent may not claim any rights established by common usage. In fact, when the Complainant was viewing the contact details stated on the website connected to the Domain Name, it noted that the Respondent had misleadingly incorporated the email address info@legohouse.com under the Complainant's <LEGOhouse.com> domain name mentioned above, which MX records the Respondent does not have any control over and could not possibly be using.
- 5.6 No license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. The Respondent has not disclosed the lack of relationship with the Complainant. Instead, the following statement is found on the impugned website "copyright © 2015 legohouse", which may give the misleading impression that the Respondent has rights to use the LEGO trademark, when in fact it has not.
- 5.7 The Respondent cannot claim to be using the Domain Name in connection with a bona fide 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 its own commercial website offering brand activation and promotions solutions. By this, the Respondent is using the LEGO trademark in order to mislead Internet users to its own commercial website.
- 5.8 No evidence has been found that the Respondent uses the name LEGO as a company name or has any other legal rights in the name. The Respondent is simply trying to sponge off the Complainant's world famous trademark.
- 5.9 The Registrant has had time to demonstrate its rights and/or legitimate interest in the Domain Name but has failed to do so. INDRP paragraph 3 clearly states that it is the responsibility of the Respondent to find out before the registration that the domain name he is going to register does not violate the rights of a third party.

Element 3 – in support of this element, that the disputed domain name was registered and is being used in bad faith, the Complainant contends that:

- 5.10 The Complainant's trademark LEGO in respect of toys 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 number of third party domain name registrations comprising the trademark LEGO in combination with other words has skyrocketed the last years.
- 5.11 The Respondent registered the disputed domain name on 13 October, 2015. This date is subsequent to when the Complainant registered the trademark LEGO in India, China and elsewhere, by several decades. The LEGO brand has grown remarkably in Asia over the last years and the sales of LEGO products to consumers increased by 35% in this area in 2013, outperforming the Asian toy market by a factor of five. Considering that LEGO is a famous trademark and that the website connected to the Domain Name displays LEGO products, it is clear that the Respondent knew of the Complainant's rights in the name LEGO at the time of the registration.
- 5.12 On October 28, 2015, a Cease and Desist letter was sent to the Respondent by e-mail. In the Cease and Desist letter, the Respondent was advised that the unauthorised use of the trademark LEGO within the disputed domain name violated the rights in the Complainant's trademarks and an immediate transfer of the same was requested. However, despite several reminders were being sent, no response was ever received. Since the efforts of trying to solve the matter amicably were unsuccessful, and the website is still active, the Complainant chose to file a complaint according to the INDRP process.
- 5.13 The Respondent is today not using the disputed domain name in connection with a bona fide offering of goods or services. The Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic to a commercial website by creating a likelihood of confusion with the Complainant and its famous LEGO trademark. Under Paragraph 6 (iii) of the Policy, such use is considered evidence of bad faith.



6. Contentions of the Respondent

The Respondent has responded by email stating that he understands the word LEGO is a trademark by the company registered in Denmark. However, he points out that legohouse is a single word in small letters and not in capital which is a trademark. The Respondent also states that before registering the disouted domain name, he has checked with the authorities and only after getting a clearance on availability of the name, purchased the same under the internet act.

7. Discussions

- 7.1 At the outset, it is to be mentioned that the Arbitral Tribunal has been properly constituted.
- 7.2 From a detailed reading of the Complaint and supporting annexures, the Arbitrator finds that each of the three elements required under paragraph 4 of the INDRP are established by the Complainant. The finding is made keeping in mind these specific aspects:
- 7.3 The Complainant is the prior owner and user of the LEGO trademark and domain names containing the term LEGO;
- 7.4 The LEGO mark is distinctive both inherently and through use; it has the status of a well-known mark and hence, can be protected even for products other than toys;
- 7.5 The dominant part of the disputed domain name LEGO brings to mind the Complainant's mark; and use of the term 'house' by the Respondent brings to mind Complainant's Lego House project; any person seeing the disputed domain name would naturally associate it with the Complainant;
- 7.6 The Respondent does not own any registrations in trademark or domain names for the term LEGO or containing LEGO and is not authorised by Complainant to use the same. The Respondent is not otherwise known by the name LEGO nor uses it as a company name nor has any other legal rights in the same;
- 7.7 The Respondent would have been aware of Complainant's rights in LEGO and this has been categorically admitted by the Respondent; further the

Complainant had sent several cease and desist letters to the Respondent also to which the Respondent did not reply;

- 7.8 The Respondent admits knowledge that LEGO belongs to the company registered in Denmark. He then tries to justify adopting the same on the ground that legohouse is a single word in small letters and not in capital which is a trademark. This is completely misconceived and unsustainable. The Respondent has only checked the availability of the disputed domain name and he is not absolved of the responsibility to find out if the said domain name violates the rights of any third party or not;
- 7.9 Considering the fame of the LEGO mark and keeping in mind that the Respondent had no rights in the same, the only reason Respondent could have adopted the said name was to attract Internet users to its website, by creating a likelihood of confusion with the Complainant's mark or a connection with the Complainant where none existed. This is substantiated by Respondent's use of the email address info@legohouse.com not belonging to it, and the copyright notice on its website. Hence, the bad faith on part of Respondent is established.

8. Decision

- 8.1 For all the foregoing reasons, the Complaint is allowed.
- 8.2 It is hereby ordered in accordance with paragraph 10 of the INDRP that the disputed domain name <legohouse.in> be transferred to the Complainant.
- 8.3 The Parties shall bear their own costs.



DIVYA BALASUNDARAM
ARBITRATOR

Date: September 23, 2016
Place: New Delhi, India