

## ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Domain Administrator, Matthew Griffith  
Case No. D2011-1263

### 1. The Parties

The Complainant is LEGO Juris A/S, Billund, Denmark, represented by Melbourne IT Digital Brand Services, Sweden.

The Respondent is Domain Administrator, Matthew Griffith, North Carolina, United States of America (the "United States", with Mr. Griffith self represented).

### 2. The Domain Name and Registrar

The disputed domain name <legoworkshop.com> is registered with DomainName, Inc. d/b/a domainname.com.

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 22, 2011. On July 22, 2011, the Center transmitted by email to DomainName, Inc. d/b/a domainname.com a request for registrar verification in connection with the disputed domain name. On July 27, 2011, DomainName, Inc. d/b/a domainname.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details (even though the public Whois data confirmed to identify those of Domain Administrator). The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 1, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was August 21, 2011. The Response (filed by Matthew Griffith) was filed with the Center on August 19, 2011<sup>1</sup>.

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<sup>1</sup> The Panel notes that the Response contained the following statement in paragraph 10 of the Response "[10]. A copy of this Response is being sent or transmitted to the Complainant on [Complainant's email] by email."

The Center appointed Staniforth Ricketson as the sole panelist in this matter on September 20, 2011. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant, a Danish company, is the owner of the LEGO and associated brands used in relation to construction toys and other related products. It commenced use of the LEGO mark in the United States in 1953 and since then the sale of LEGO products throughout the world and through licensees has grown, with sales in more than 130 countries and more than US \$2.8 million revenue for the LEGO Group in 2009.

The Complainant has a number of registered trade marks for, and comprising, the word LEGO in many jurisdictions, including in the United States and Europe (see Annexes 6 and 7 of the Complaint). It is also the owner of more than 1,000 registered domains comprising the word LEGO alone and in multiple word combinations (Annex 8). It is rated as eighth in the top 500 "superbrands" for 2009/10, according to the list provided by Superbrands UK (Annex 9 of the Complaint).

According to a Whois database search (Annex 2 of the Complaint), the Respondent registered the disputed domain name LEGOworkshop.com on February 25, 2011. Shortly after this, the Complainant wrote to the Respondent, drawing attention to its registered trade marks, and requesting that the Respondent transfer the disputed domain name to it, upon payment of the necessary costs involved (Annex 12 of the Complaint). There is some uncertainty as to the exact date on which this letter was sent, as the Complaint states that it was sent on March 4, 2011, but the letter itself bears the date April 11, 2011. Irrespective of which is the correct date, it seems clear that the Complainant followed up its letter by email on May 17, 2011 (Annex 12 of the Complaint).

No response to these communications was received, and the Complainant accordingly instituted the present proceeding.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that each of the requirements of paragraph 4(a) of the Policy are made out.

As to sub-paragraph (a)(i), the Complainant refers to its registered trade marks and domain name registrations comprising the word LEGO and combinations thereof. It also asserts that the mark LEGO is a famous mark, noting here its inclusion in the Superbrands UK list (see Annex 9 of the Complaint) and points here, in addition, to the recognition of the need to protect such marks under both article 6bis of the *Paris Convention for the Protection of Industrial Property* and articles 16.2 and 16.3 of the *TRIPS Agreement*. It then argues that not only is the disputed domain name identical in that it comprises the term "lego", but is, any event, confusingly similar in that the suffix "workshop" is to be disregarded and has no impact on the overall impression of the dominant part of the name, with LEGO being "instantly recognizable as a world famous trademark". In the same way, the .com suffix is to be disregarded and has no impact on this overall impression.

As to paragraph 4(a)(ii), the Complainant argues that it has not found that the Respondent has any registered trade marks or trade names corresponding to the dispute domain name. Further, the Respondent has no business connection or licence from the Complainant to use the "Lego" name, and that no legitimate right or interest in the disputed domain name can be created by the "mere registration" of the name. In this regard, it asserts that, because of the fame of its mark, the Respondent must have been aware of the Complainant's registered mark and that this was the motivation for registering the disputed domain name.

None of this, in the Complainant's view can be a *bona fide* use of the domain name and it alleges that the Respondent has intentionally chosen a domain name based on a registered trade mark in order to generate traffic to a website displaying sponsored links both related and unrelated to the Complainant. These factors indicate that the Respondent can have no rights or legitimate interest in respect of the disputed domain.

The same matters are also relevant to paragraph 4(a)(iii) which deals specifically with the issues of bad faith in registration and use of the disputed domain name. In this regard, the Complainant points again to the fame of its mark as indicating bad faith on the Respondent in registering the domain name, and argues that this bad faith is further reflected in the Respondent's failure to respond to the Complainant's attempts to contact him and resolve the matter amicably. Another matter going to bad faith in use of the disputed domain name is the presence of sponsored links on the website connected to the Respondent's domain name (Annex 11 of the Complaint). In this regard, the Complainant argues that the website is being used to intentionally attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its website. Accordingly, the Complainant argues that the Respondent both registered and is using the disputed domain name in bad faith.

## **B. Respondent**

The Respondent (and the Panel accepts Mr. Griffith as an appropriate Respondent in the circumstances of these proceedings) does not address the specific parts of par 4(a) of the Policy, but provides the following explanation of the reasons for the registration and use of the disputed domain name. He says this was registered on behalf of his 15 year old 10th grade son who has been a LEGO enthusiast since he was 3 years old. His intent was to create a website that showed off the creations that he (the son) has built over the years in "both photographs and occasional video while also showing steps to build his creations". He states that this is part of a high school project that his son is doing and that will earn him credit towards his final graduation, and says further that he (the son) has "chosen this to be his project as it allows his passion for the product, the creativity of building using the product and the programming technology required to create and maintain the site to flourish while helping other kids to build creations that they might not be able to dream up on their own and to share building ideas".

The Respondent goes on to state that he regards this as a "fair use" of the domain name, arguing that there is no use of the LEGO logo on the site, there is no intention to profit from this, and that there is no confusion that the site might be owned or endorsed by the Complainant and that there is a disclaimer to this on the website. He states further that the domain name has never been listed for sale and two previously emailed offers have been ignored. He also asserts that the web page screenshot annexed to the Complaint is not his, but "is the page that a registrar shows until you do something with the domain". A copy of the actual web page is annexed to the Response.

Overall, the Respondent's position is that its use of the domain name was fair and done in good faith by his son in order to "represent his love for building with the Complainant's product while sharing with the world. His building techniques, ideas and how he has built different creations". Reference is also made to a statement on the LEGO website which he obviously believes is consistent with his son's usage, namely that "If the LEGO trademark is used at all, it should always be used as an adjective, not as a noun".

## **6. Discussion and Findings**

Each of the requirements in paragraph 4(a) needs to be considered in turn, noting that the Complainant must satisfy the Panel that each of them is present before an order for transfer or cancellation may be made.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) requires that the Complainant establish that the disputed domain name is "identical or confusingly similar to a trademark or service mark in which the complainant has rights". There are therefore two limbs of paragraph 4(a)(i) that the Complainant must satisfy: first, that it has "rights in a trade or service

mark” (this need not be a registered mark), and, secondly, that the disputed domain name is “identical or confusingly similar” to that mark.

As to the first of these requirements, the Complainant has shown that it has rights in a number of registered United States and other trade marks that consist of the term “Lego” registered in respect of toy building blocks and like products. The dates of these registrations precede the date of registration of the disputed domain name. Although not relevant for this aspect of paragraph 4(a)(i), there can be little doubt that LEGO is a well known mark and brand, as indicated by the Superbrands UK listing.

As to the second of these requirements, the Panel has no difficulty in concluding that the disputed domain name is confusingly similar to the LEGO marks as it begins with, and incorporates the whole of, the Complainant’s trade mark. This is the first thing that any internet user will see when he or she encounters the disputed domain name. The Panel also accepts that the addition of the descriptive suffix “workshop” does little, if anything, to dispel the likelihood of confusing similarity arising; if anything, it increases this possibility on the basis that a person viewing the name will be led to think that this is the Complainant’s mark coupled with a direct reference to activities associated with its products. The Panel also accepts that the addition of the “.com” suffix is to be disregarded in its assessment of confusing similarity.

The Panel therefore finds that the requirements under paragraph 4(a)(i) of the Policy are made out.

### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant is required to show that the Respondent has “no rights or legitimate interests in respect of the domain name”. Further assistance as to the meaning of this requirement is given in paragraph 4(c) of the Policy, which provides that:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your [the Respondent’s] rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) You are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Essentially, these are matters for a respondent to put forward for the Panel’s consideration, as they are often difficult for a Complainant to disprove directly. In the present case, there is nothing on the record to suggest that the circumstances referred to in either sub-paragraphs 4(c)((i) or (ii) are present. The main focus is therefore upon the matters referred to in sub-paragraph 4(c)(iii) and here it becomes critical to consider carefully the submissions of both Complainant and Respondent. So far as the Complainant’s position is concerned, the following may be stated:

- (i) There is no doubt that the Respondent’s use of the disputed domain name has not been authorized or licensed by it.
- (ii) Likewise, there can be doubt that the Respondent was clearly aware of the Complainant’s famous mark at the time of registration of the dispute domain name – it is obvious that the purpose of the website associated with the domain name was to represent his son’s love for the Lego products.

So far as the Respondent is concerned, his stated reasons for adopting the disputed domain name are as follows:

- (i) There was nothing commercial in his registration and the use of the disputed domain name – it was motivated by his son’s “love” for Lego products and his involvement in a school project that was intended to reflect this.
- (ii) There is nothing on the website impressions exhibited by the Respondent that suggests any commercial activity, either by way of advertising competing products or providing sponsored links to other competitors of the Complainant. This was confirmed by the Panel which visited the Respondent’s website on October 1, 2011.
- (iii) There is a disclaimer of any affiliation or link to the Complainant that now appears on the Respondent’s website.

If the above was solely how matters stood, the Panel would be inclined to find that the Respondent comes within sub-paragraph 4(c)(iii): as a general matter, use of a disputed domain name for a homage (or criticism) site will indicate that the Respondent has sufficient rights or legitimate interest in its use of the name so long as this is of a non-commercial character and does not purport to be officially sanctioned or authorized by the Complainant. However, before reaching this conclusion in the present proceeding, it is necessary to consider the Complainant’s allegation that the Respondent’s website contained sponsored links to other sites and was being used to attract advertising and commercial benefit. While evidence of such matters would usually undercut any claim of non-commercial fair use, the sole piece of evidence produced in the present proceeding (Annex 11 of the Complaint) is somewhat ambiguous:

- (i) While there are links here that refer to “Lego toys”, “Lego guns” and “Star Wars Lego”, there are also links of a more descriptive kind, such as “online computer training”, “maths games”, “photography school” and so on. There is no evidence of where these links went or with whom they were associated. It is difficult to draw an inference of commercial gain to the Respondent from any of this.
- (ii) It appears that the date of this screen printout is April 15 (presumably 2011, as the disputed domain name was only registered this year). However, it is no longer present on the Respondent’s website, as the annex to the Response shows (and as confirmed by the Panel’s visit to the site on 1 October 2011). Accordingly, no links of any kind are now to be found on the Respondent’s website which appears to be just what the Respondent says it is: a place for his son to display representations of his LEGO creations and to seek responses from other interested parties.
- (iii) The Respondent’s explanation for the webpage as it originally appeared (and as displayed in Annex 11) is that this “is the page that a registrar shows until you do something with the domain”. In the absence of any further evidence one way or the other on this point, the Panel is inclined to accept the Respondent’s explanation and further support for this conclusion is to be drawn from the fact the present webpage clearly reflects the stated purpose behind the registration and use of the disputed domain name.

In light of the above, the Panel is confirmed in its view that the Respondent has shown that the circumstances specified in paragraph 4(a)(ii) exist. In so doing, it notes that there has been something of a split among panels on this question in the past: see generally WIPO Decision Overview 2.0, § 2.5, and see, for example, *Chivas USA Enterprises, LLC, et al. v. Cesar Carbajal*, WIPO Case No. D2006-0551; *2001 White Castle Way, Inc. v. Glyn O. Jacobs*, WIPO Case No. D2004-0001; *Estate of Gary Jennings and Joyce O. Servis v. Submachine and Joe Ross*, WIPO Case No. D2001-1042; *Besiktas Jimnastik Kulubu Dernegi v. Mehmet Tolga Avcioglu*, WIPO Case No. D2003-0035, where such rights and legitimate interests were held to apply, and contrast the findings in, for example, *David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla*, WIPO Case No. D2000-1459; *(1) Galatasaray Spor Kulubu Dernegi, (2) Galatasaray Pazarlama A.S. and (3) Galatasaray Sportif Sinai Ve Ticari Yatirimlar A.S. v. Maksimum Iletisim A.S.*, WIPO Case No. D2002-0726; *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case No. D2000-0299; *Nintendo of America Inc. v. Alex Jones*, WIPO Case No. D2000-0998.

Obviously, each case will depend on its particular facts, but one earlier decision with somewhat similar facts to those in the present case is *Estate of Francis Newton Souza v. ZWYX.org Ltd*, WIPO Case No. D2007-0221, where the panel stated:

...that genuine noncommercial fan sites may indeed give rise to a legitimate interest. Paragraph 4(c)(iii) of the Policy provides as an example of how to demonstrate rights or legitimate interests in a domain name that the registrant is “making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”. This language makes it clear that the operator of a noncommercial fan site can take advantage of this provision unless the operator, with an intent for commercial gain, is misleadingly diverting consumers or tarnishing the mark. Here, even if consumers might be confused as to whether the site is an official site of F.N.Souza or his former curator or his estate, the fact is that there is no showing that any of this is being done with an “intent for commercial gain”, and thus the Policy mandates a finding that the noncommercial fan site operator has a legitimate interest under Section 4(c)(iii) *Cf. Ryanair Ltd. v. Michael Coulston*, WIPO Case No. D2006-1194 (in case involving criticism cite, concluding that, “if the diversion of traffic was not made misleadingly with an intention of realizing some commercial gain, it does not fall under the language of the Policy, which is intended to address commercial diversions”); *Xtraplus Corp. v. Flawless Computers*, WIPO Case No. D2007-0070:

This Panel therefore concludes that the present case is very similar to that in *Souza* and that the Complainant has therefore failed to establish that the Respondent had no rights or legitimate interest in its registration and use of the disputed domain name as required under paragraph 7(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

In view of its finding under the preceding paragraph, it is unnecessary for the Panel to consider this part of paragraph 4(a) of the Policy. However, the same matters that have been discussed are relevant to this heading as well. Thus, to succeed under paragraph 4(a)(iii), the Complainant must show that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy then provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you [the Respondent] have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you [the Respondent] have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you [the Respondent] have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you [the Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

It will be noted that, under paragraph 4(a)(iii) of the Policy, both registration and use of the disputed domain name in bad faith are required. Of the factors listed in paragraph 4(b) above, (i)-(iii) relate specifically to

registration of the disputed domain name, while (iv) relates to use following registration. However, in view of the fact that these factors are stated to be inclusive, it follows that there can be other factors that can be relied upon to point to bad faith, both in registration and in use. In this regard, it is worth noting an early decision of a UDRP panel to the effect that registration in bad faith, followed by a passive holding of a domain name when there is no way in which it could be used legitimately, can also amount to use in bad faith, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. In addition, it would be both mistaken and artificial to confine sub-paragraphs (i)-(iii) solely to the time of registration; presumably, the sub-paragraphs would also apply to a bad faith use of a disputed after registration, with one of the purposes outlined in those paragraphs. Support for this view is to be found in several UDRP decisions; see, for example, *Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869; and *E. & J. Gallo Winery v. Hanna Law Firm*, WIPO Case No. D2000-0615.

In the present proceeding, there is nothing in the record to suggest that any of the circumstances referred to in paragraphs 4(b)(i) or (ii) arise. Nor, in the absence of evidence that the Complainant and Respondent are in competition with each, do the circumstances referred to in paragraph 4(b)(iii) arise. It is only paragraph 4(b)(iv) that can be relevant, coupled with any other fact that points to bad faith on the Respondent's part in registering and using the domain name (bearing mind that bad faith at both stages needs to be shown). Enough has been said above to indicate the Panel's view that the Respondent's use of the disputed domain name appears to be a non-commercial or fair use, by way of homage or approbation of the Complainant's products by a young and enthusiastic user: hence, it would be difficult to find that the circumstances referred to in paragraph 4(b)(iv) arise.

On the other hand, the question of bad faith in the actual registration of the disputed domain name arises, given that the Respondent clearly knew of the Complainant's well known mark – why, otherwise set up the website? In many circumstances, bad faith registration in the face of such knowledge can be readily inferred. However, the record here would suggest that, notwithstanding such knowledge the Respondent and his son did not intend to cause any confusion or diversion of custom and did not, indeed, believe this to be likely, given the nature of their intended website. While the facts of each case will differ, in the present case the Panel accepts that this is sufficient to dispel the inference of bad faith registration that might otherwise arise.

If it were necessary, therefore, to determine this question, the Panel would find that the requirements of paragraph 4(a)(iii) of the Policy had not been made out.

## **7. Decision**

For all the foregoing reasons, the Complaint is denied.

**Staniforth Ricketson**

Sole Panelist

Dated: October 1, 2011