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AA 691230

No. 6378 Dt. 2/2/2010 Rs. 100/-

K. Rama Chandravathi

Sold To: *Harini*

K. RAMA CHANDRAVATHI

Off. No. 10/19. *Narayan Swamy R/o Hyd*

STAMP VENDOR / L. No. 199, R.L.No. 16/2008
6-3-387, Beside Rajaraj Dabbar Hotel, Panjagut
HYDERABAD - 500 852. Phone. No. 23351

To Whom: *Self*

**BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD**

In The Matter Between

LEGO Juris A/S

Complainant

Versus.

Robert Martin

Respondent

Narasi Narayana

1. The Parties

The Complainant. Lego Juris A/S is a Swiss corporation and is represented in these proceedings by M/s Lal Lahiri and Salhotra of India.

The Respondent is Robert Martin of the United States of America.

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <lego.co.in>. The registrar for the disputed domain name is [Name.com](#) LLC.

The Arbitration Proceeding is conducted in accordance with the **Arbitration** and Conciliation Act of 1996 (India), the current .IN Domain Name Dispute Resolution Policy (the "INDRP Policy"), and the INDRP Rules of Procedure (the "Rules").

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of **Impartiality** and Independence, in compliance with the Rules.

The Arbitrator received the hard copy of the Complaint from the .IN Registry on January 2, 2010. On January 4, 2010 the Arbitrator transmitted by email a notification of commencement of the arbitration proceedings to the Respondent under paragraph 5 (c) of the INDRP Rules, and copies by email to other interested parties to the dispute.

The Respondent was given twenty-one days time from the date of the notification to file a Response. The Respondent did not file a formal response in these proceedings. The Arbitrator proceeds under paragraph 11 of the Rules, to determine the case on its merits based on the submissions made by the Complainant and the documents on record.

Factual Back ground

The Complainant is a leading toy manufacturer that markets its products in several countries and uses the trademark LEGO in connection with its products. It owns numerous trademark registrations in several countries and its Indian trademarks are:

TRADEMARK	REGISTRATION NUMBER	CLASS	GOODS	DATE OF REGISTRATION
LEGO	293298	28	Games and Playthings (not being ordinary playing cards)	January 3, 1974

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LEGO	240430	28	Games and Playthings (Not being ordinary playing cards)	February 7, 1967
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The Complainant owns about one thousand domain names that include and incorporate its LEGO mark.

4. Parties contentions

A. Complainant

The Complainant states that word LEGO was coined by its founder Mr. Ole Kirk Christiansen in the year 1932 by combining the first two letters of the Danish words "LEG" and "GOT" which means, "*play well*". The word "LEGO" in Latin means, "*I put together*". Presently, **LEGO** is a well-known trademark associated with good quality toys manufactured and sold by the Complainant and is part of the Complainant's corporate name and its distinctive style of trading. The artistic work of the Complainant's logo containing the word LEGO was created 1972, the copyright for it vests with the Complainant.

The Complainant states it sells its goods in more than 130 countries around the world and is the registered proprietor of the LEGO trademark in numerous countries including Denmark, Australia, Switzerland, Jordan, Indonesia, Britain. It has filed a representative selection of copies of its trademark registrations in different countries including India and copies of invoices of its goods sold in India for the period 1996 to 2001. Figures of its worldwide turnover for the period 2004 - 2008 and expenses for promoting its LEGO brand for the years 2004 - 2008 have also been filed.

The Complainant has filed copies of articles, advertisements, brochures and print outs from its website at <lego.com> as evidence of the popularity of its mark and its products. The Complainant states it has zealously protected its mark and has filed copies of court judgments and decisions that have recognized the fame, goodwill and reputation associated with its mark. The Complainant claims that due to its continued use of the **LEGO** mark since the year 1934, it has acquired substantial reputation and its mark can be termed a well-known brand. Its main website at <lego.com> was created on Aug 22, 1995, which it uses for selling and advertising its products.

The Complainant states that when it came to know of the disputed domain name in October 2009, it sent a Cease and Desist letter dated November 11, 2009 to the Respondent by courier and email. The courier company did not find the address mentioned in the Whois database, but the Respondent sent an email response that states:

" We tire very sorry to offend your client, but we just think the domain might he valuable when we register it. we would make some concession as our regrets.

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" we are very sorry to offend your client, but we just think the domain might be valuable when we register it. we would make some concession as our regrets, please to convey the means. I hope we can find one win-win solution friendly and benefit for both of us."

The Complainant states the disputed domain name is confusingly similar to its trademark LEGO for which it has provided registration certificates as *prima facie* evidence of its validity. Its domain name <lego.com> is distinctive and the Complainant owns one thousand other domain names with its LEGO mark. The disputed domain name incorporates the mark in its entirety and is therefore substantially and phonetic similar to its mark except for the top level domain (TLD) extension ".co.in".

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name as he has no relationship with the Complainant's business and is not authorized or licensed to use the mark, nor is he known by the disputed domain name. The Complainant's use of its mark dates back to 1934 and its website was constructed in 1994. whereas the Respondent's registered the domain name in 2009. The Respondent is based in USA and appears to have no links with India and is not using the disputed domain name for legitimate fair use purposes, but uses it to bait the Complainant's customers. The Respondent must bring evidence before the forum to show that the disputed domain name is used in a manner that satisfies factors enumerated in the *OKI Data Americas Inc. v ASD Inc.* WIPO Case No D2001 -0930 case to establish any rights.

The disputed domain name was registered and is used in bad faith, states the Complainant, as it creates a likelihood of confusion with the Complainant's mark as to its source, sponsorship, affiliation or endorsement and exploits the fame associated with its **LEGO** mark, which is likely to mislead consumers and tarnish its well-known mark. The website linked to the disputed domain name has sponsored links from which the Respondent attempts to attract Internet users to generate unjustified revenue. The Respondent's email reply to the Complainant's letter shows his intention to extract money, states the Complainant. The disputed domain name generates traffic and revenue based on the good will and fame associated with its LEGO trademark and is likely to disrupt its business as it diverts users seeking information relating to Complainant to its competitors and prevents the Complainant from reflecting its mark in a corresponding domain name. The Complainant therefore requests for transfer of disputed domain name and for the costs of the proceedings.

1. Discussion and Findings

Under the .IN Policy, the Registrant of the domain name is required to submit to a mandatory Arbitration proceeding in the event that a Complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

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

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which it has rights.

The Arbitrator finds the Complainant has provided ample evidence demonstrating its registered rights in the LEGO trademark. The Complainant has also furnished documents showing use of its LEGO mark in India and articles and media coverage regarding its international fame. It has established its prior adoption of the LEGO mark and its use for a period of about eight decades.

The disputed domain name incorporates the LEGO trademark in its entirety. It is well recognized that incorporating a trademark in its entirety, particularly if the mark is an internationally well-known mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark. See for instance *Viacom International Inc. v. MTV ALBUMS- Mega Top Video Albums Peter Mladshi*. WIPO Case No.D2002-0196, and also see INDRP decision regarding the SONYERRISION mark.

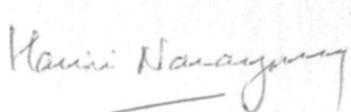
Accordingly, the Arbitrator finds that the disputed domain name <lego.co.in> is identical and confusingly similar to the Complainant's trademarks except for the TLD ".co.in" identifier. The TED can be disregarded for purposes of assessing similarity of the domain name to the trademark see INDRP decision INDRP/118 (November 26, 2009) pertaining to domain name <starbucks.co.in> ,

For the reasons discussed, the Arbitrator finds that the disputed domain name <lego.co.in> is confusingly similar to the Complainant's LEGO trademark

Rights and Legitimate interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

'available at <http://www.inregistry.in/Polieies/DisputeCaseDecisions>(last visited on February 14, 2010).

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The Complainant has asserted that it has not authorized the Respondent to use its marks in any manner and has no relationship with the Complainant's business. Under paragraph 7 of the Policy, the registrant's rights can be found from the material on record, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the Registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The Registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain. The Arbitrator finds there is no evidence on record to show that Respondent is known by the disputed domain name or that he has used the disputed domain name in connection with a *bona fide* offering of goods or has any rights in the disputed domain name.

The Complainant has submitted printouts of the Respondent's websites and its featured links, which redirects Internet users to other sites. The use of the disputed domain name by the Respondent using the Complainant's well known trademark to redirect Internet users to other websites is not a *bona-fide* use and does not confer rights or legitimate interests; See *Factory Mutual Insurance Company v. Rhianna Leatherwood* WIPO Case No.D2009- 0144. The Arbitrator finds merit in the Complainant's arguments that the Respondent has registered the disputed domain name, based on its trademark value, in order to generate Internet traffic to derive income; and such use is not recognized as *bona fide* use under the Policy.

The Arbitrator finds the Respondent has no rights or legitimate interests in the disputed domain name.

Bad Faith

Under the INDRP Policy the Complainant is required to prove that the domain name was registered and is being used in bad faith.

Under paragraph 6 (iii) of the Policy, if the registrant has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the mark, it is considered evidence of bad faith. The Arbitrator finds that the Respondent has registered the domain name with knowledge of the Complainant's trademark and uses it with the intention of attracting Internet users to its website.

Given the distinctiveness of the Complainant's mark it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's marks and uses it for the purpose of misleading and diverting Internet traffic. Where a domain name is found to have been registered with an intention to attract Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration; See for instance *Ferrari S.p.A v. American Entertainment Group. Inc.* ,WIPO Case No.D2004-0673.

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The Respondent ought to have been aware when he registered the disputed domain name that such registration would impede the use of the domain name by the legitimate owner of the trademark: such practice is found to be bad faith, see *Ferrai S.p.A v. Beryhold Bitchier*, WIPO Case No.D2003-0981. These factors clearly show the Respondent's bad faith in registering and using the disputed domain name.

The Policy makes reference to circumstances indicating bad faith registration and use of a domain name where the respondent engages in a pattern of registration of domain names to prevent the owner of the trademark from reflecting its mark in a corresponding domain name. The Arbitrator finds the evidence on record shows the Respondent has registered other domain names bearing the Complainant's trademark and finds that the Respondent has registered the disputed domain name and uses it in a manner that constitutes bad faith registration and use under the Policy.

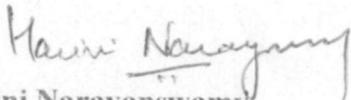
Using the domain name for the purposes of displaying links for commercial gain under the circumstances discussed is evidence of bad faith use. See *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*. WIPO Case No.D2006-0062.

The Arbitrator finds the disputed domain name has been registered and used in bad faith under paragraphs 4 and 6 the Policy.

2. Decision

For all the reasons discussed above the Arbitrator orders that the domain name <lego.co.in> be transferred to the Complainant.

No costs are awarded, as the Complainant has not demonstrated any actual loss due to the registration or use of the disputed domain name.


Harini Narayanswamy
Arbitrator
Date: February 14, 2010