



महाराष्ट्र MAHARASHTRA

2017

AF 129726

अनु. क्र. २००५/८२२२७७ सु. शु. रकम. ५०० रु. २५००

दस्तावा प्रकार दिवस

दस्ता नोंदणी करणारा पत्ते ? होय/नाही.

मिळवणीचे वर्ग

मुद्रांक १० रु. देणारा देणारा दिवस चिंतामणी कर्नाटक

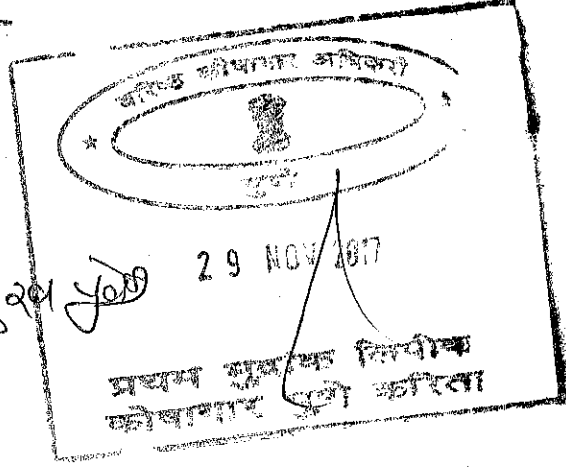
पत्ता २००७ २१, निवाड, पुणे, महाराष्ट्र

दुसऱ्या पक्षाचा पत्ता दिवस

हस्त लिखिते या दिवस शिंदे साहित्य माते - पिंपरीचूर जिल्हा

मुद्रांक देणारा देणारा दिवस रति. नरनी लिजिद वेळसरे

पत्रांक क्र. २२०१०११ ४२५ ब, शांतिवार पेठ पुणे-३८



**AWARD  
IN ARBITRATION**

**LEGOEDUCATION.IN**

**INDRP CASE NO.926**

**LEGO Juris A/S.**  
Koldingvej  
2, 7190 Billund  
Denmark.

**THE COMPLAINANT**

**AND**

**Virginia Barham**  
419, Wetzel Lane, Merritt  
Michigan 49667  
United States of America

**THE RESPONDENT /  
THE REGISTRANT**

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**IN THE MATTER OF DISPUTED DOMAIN NAME: -  
'LEGOEDUCATION.IN'**  
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**ARBITRATION PANEL: - MR.S.C.INAMDAR, B.COM. LL.B., F.C.S.  
SOLE ARBITRATOR**

**DELIVERED ON THIS 5th DAY OF DECEMBER TWO THOUSAND  
SEVENTEEN AT PUNE, INDIA.**

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**I] SUMMARISED INFORMATION ABOUT THE DISPUTE: -**  
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| <b>SR. NO.</b> | <b>PARTY TO THE DISPUTE</b>                  | <b>NAME</b>   | <b>ADDRESS</b>   |
|----------------|--|---|--|
| 01             | COMPLAINANT                                  | LEGO Juris A/S  | Koldingvej 2, 7190, Billund, Denmark   |
| 02             | AUTHORISED REPRESENTATIVE OF THE COMPLAINANT | CSC Digital Brand Services Group AB                   | Natalie Leroy, Saltmatargatan 7<br>SE-113 59 Stockholm, Sweden   |
| 03             | REGISTRANT / RESPONDENT                      | Virginia Barham                                       | 419 Wetzel Lane, Merritt, Michigan, 49667, U.S.  |
| 04             | DOMAIN NAME REGISTRAR                        | Endurance Domains Technology Pvt. Ltd. (R 173 - AFIN) | Unit No.501, 5th Floor & Unit No.402, 4th Floor, IT Building, NESCO IT Park, NESCO Complex, Western Express Highway, Goregaon (East) Mumbai. 400063. Maharashtra, India. |

**III CALENDER OF MAJOR EVENTS:-**

| <b>Sr. No.</b> | <b>Particulars</b>   | <b>Date<br/>(Communications in electronic mode)</b> |
|----------------|--|---|
| 01             | Arbitration case referred to me by NIXI & Acceptance given by me   | 27.10.2017  |
| 02             | Electronic copy of complaint received & served on Registrant / Respondent  | 10.11.2017  |
| 03             | Notice of Arbitration issued, with the period to file reply, if any, latest by 21.11.2017  | 11.11.2017  |
| 04             | Period to file reply, if any, by the Registrant, extended by Arbitration Panel suo-motu till 28.11.2017  | 25.11.2017  |
| 05             | Mail received from NIXI stating that the postal address of the Registrant registered with NIXI is incorrect / incomplete and courier agency is | 27.11.2017  |

|    |  |            |
|----|--|------------|
|    | seeking instructions for either returning or destroying the courier. |            |
| 06 | Notice of closure of arbitration issued                              | 30.11.2017 |
| 07 | Award passed   | 05.12.2017 |

**III] PARTICULARS OF DISPUTED DOMAIN NAME & REGISTRATION:**

1. Disputed domain name is 'LEGOEDUCATION.IN'.
2. Date of registration is 10.05.2017
3. Registrar is Endurance Domains Technology Pvt. Ltd.. (R173-AFIN)  
Unit No.501, 5th Floor & Unit No.402, 4th Floor, IT Building, NESCO IT Park,  
NESCO Complex, Western Express Highway, Goregaon (East) Mumbai. 400063.  
Maharashtra, India.

**IV] PROCEDURE FOLLOWED IN ARBITRAION PROCEEDINGS: -**

- 1) Arbitration proceedings were carried out as per .In Domain Name Dispute Resolution Policy (INDRP) read with INDRP Rules of Procedure, Indian Arbitration Act, 1996 and Code of Civil Procedure, wherever necessary.
- 2) The parties were requested to expedite their submissions so as to enable this panel to pass award within the 60 days time frame prescribed.
- 3) Copies of all communications were marked to both the parties and NIXI.
- 4) No personal hearing was requested / granted / held.

**VI BRIEF INFORMATION ON THE COMPLAINANT: -**

The Complainant - Lego Juris A/S, is a Denmark based company and the owner of LEGO and all other trademarks used in connection with LEGO brands of construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights in the United States and elsewhere. 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 LEGO products are sold in more than 130 countries including United States.

The Complainant is the owner of close to 5000 domain names containing the term LEGO. The LEGO trademark is among the best known trademarks in the world due to the decades of extensive advertising which prominently depicts the LEGO mark on all products, packaging, displays, advertising and promotional materials.

**IV] SUMMARY OF THE COMPLAINT: -**

*The Complainant's Complaint is based on the following points, issues, representations or claims in brief:-*

**(A) CONTRAVENTION OF THE REGISTERED TRADEMARKS AND DOMAIN NAMES OF THE COMPLAINANT (CONTRAVENTION OF POLICY PARA 4(i) OF THE .IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP) :-**

The Complainant states that the domain name registered by the Respondent viz. LEGOEDUCATION.IN, is virtually identical to the trademark LEGO registered in India, vide Trademark Application No.240.330 in class 28 and a host of other trademarks registered in various countries across the world. The details of such registrations have been furnished by the Complainant in Annexure 5.1. The disputed domain name is confusingly similar to the Complainant's trademark LEGO. In support of his claim the Complainant has cited the following decided cases: -

- a. WIPO case - No. D 2008-1692 Lego Juris A/S V/s Level 5 Corp
- b. WIPO case - No. D 2008-1715 Lego Juris A/S V/s Michael Longo

The Complainant has also cited the UDRP Case No.D2004-0488 Dr.Ing.h.c. F Porsche AG V/s Rojeen Rayaneh, wherein it has been held that 'confusing similarity is generally recognised when well known trademarks are paired up with different kinds of generic prefixes and suffixes'. In the present case the term 'education' does not detract from the overall impression.

**(B) NO RIGHT OR LEGITIMATE INTEREST IN DISPUTED DOMAIN NAME (PARA 4(ii) OF INDRP): -**

The Respondent has no registered trademark or trade name corresponding to the disputed domain name. Neither the Complainant has found anything, including whois details, that would suggest that the Respondent has been using LEGO in any other way that would give them any legitimate right in the name. 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 is not using the domain name in connection with any 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 and income through a website that is a commercial through sponsored links. As such the domain name is being used for a commercial purpose. Thus the Respondent is trying to benefit from the Complainant's world famous trademark.

**(C) REGISTRATION AND USE IN BAD FAITH (PARA 4(iii) OF INDRP): -**

The Respondent has registered domain name on May 10, 2017. The date is subsequent to when the Complainant has registered the trademark LEGO in the United States where the Respondent resides and elsewhere by decades. Thus the Respondent cannot claim that he has registered the domain name without being aware of the Complainant's rights to it. Moreover the Respondent is displaying numerous pictures of the Complainant's LEGO products on the website connected to the domain name.

The Complainant first tried to contact the Respondent on June 28, 2017 through a cease and desist letter sent by email. The Complainant also requested for voluntary transfer of the disputed domain name and also offered compensation for the expenses of registration and transfer fees, not exceeding out of pocket expenses. There was no reply to this letter and offer. The Complainant states further that in the decided case of

WIPO Case No. D2009-0273 it was held 'the incorporation of a well known trademark into a domain name by a registrant having no plausible explanation for doing so, may be in and of itself, an indication of bad faith.

**(D) REMEDIES SOUGHT BY THE COMPLAINANT: -**

On the above background of the Complaint and reasons described therein the Complainant has requested for transfer of the disputed domain name to it.

**VI REGISTRANT'S DEFENSE: -**

The Registrant has failed / neglected to file any reply, say, statement in response to the Complaint or Notice of Arbitration, even within the period extended suo-motu by this panel. The courier containing hard copy of the Complaint and all annexures to it, has been returned undelivered to NIXI with the remarks meaning that the addressee is not found on the address registered under whois details. However it is worth mentioning here that none of the emails sent to him on the email id registered under the whois details, has bounced.

**VI| REJOINDERS OF THE PARTIES: -**

In view of no response from the Registrant or non-filing of any say / reply, no rejoinder was called for.

**VII| EVIDENCE FURNISHED: -**

In support of its complaint, the Complainant has furnished the following evidences / details thereof: -

1. List of trademarks registered in various countries
2. List of domain names registered in the name of the Complainant
3. Screenshot of official LEGO website
4. Screenshot of disputed domain name
5. Copy of Cease and desist letter

From the above evidence following inferences are drawn for the purpose of Paragraph 4 of INDRP:-

1. The disputed domain name is explicitly put for sale. When I personally visited the domain name, it was found that there appears offer on the top of the webpage which reads as 'Buy this domain. The owner of legoeducation.in is offering it for sale for an asking price of 9999 USD.' Thus it is established beyond doubt that the Registrant has registered domain name for selling it to any interested party for the price, which is disproportionately huge considering the cost involved in its registration. Thus it is proved that the Registrant has registered it with the sole purpose of making money illegally and immorally.

2. There are also links provided for Lego Machines, Lego Mindstorm Robot etc. The Registrant must have been earning money through pay per click methodology.

3. The Complainant has confirmed that it has neither authorized the Registrant to use the term LEGO nor is he anyway concerned / connected with the Complainant in any other capacity such as dealer of his products etc. Thus the use of the term LEGO by the Registrant in disputed domain name is unauthorized.

4. It is very likely that when any internet user searching for LEGO official products, would accidently land on to this webpage.

#### **VIII] MERITS OF THE COMPLAINT: -**

On the basis of the documents and evidences furnished by the Complainant, I have no hesitation to say that the Complainant has established and proved that: -

1. The Registrant's domain name is identical or confusingly similar to a name, trademark in which the Complainant has rights.

It is a well settled legal position in many decided cases so far that, the mere addition and difference in top level domain name of the words like *'.in'* does not differentiate the domain name from the registered trademarks or websites of the Complainant.

The Complainant has relied upon the decided case UDRP Case No.D2004-0488 Dr.Ing.h.c. F Porsche AG V/s Rojeen Rayaneh, wherein it is laid down that mere pairing of some generic work with the trademark does not differentiate it. I concur with this ratio laid down and also with the claim of the Complainant in this behalf since the word education is generic term.

2. The Registrant has no rights or legitimate interests in respect of the domain name. The Registrant is not known by the word LEGO. He has not come out with any defense to prove that his business entity has been known by this word or has any legitimate interest in it.

3. The Registrant's domain name is being used in bad faith. The links provided on the parked disputed domain name suggest that the Registrant is using this webpage for earning through pay per click.

The Registrant has registered the disputed domain name very recently in May 2017, while the Complainant has registered trademarks with this term LEGO many years prior to it, in different countries. Importantly the Complainant also has trademark registered in United States where according to whois details the Registrant resides. The Registrant cannot claim that he was not aware of any registered trademark in the name of the Complainant, since the procedure of registration of trademark in itself is a public notice. On this presumption it is also established that the Registrant has registered disputed domain name with mala fides and without any right or legitimate interests.

Moreover the Registrant has not been using the registered domain name for any legitimate or charitable purpose. He is trying to earn unlawfully out of the registration of disputed domain name, by taking disadvantage of similarity of disputed domain name with the Complainant's name, fame, goodwill and global recognition.

4. It is the duty cast by INDRP read with INDRP Rules, on every person aspiring to register any domain name: -

*(i) to verify whether any similar domain name exists, before registration of proposed domain name,*

*(ii) whether any registered trademark exists similar to the proposed domain name,*

*(iii) whether said domain name or registered trademark, has been in prior use by others*

If he fails or neglects to check on above points, he is registering domain name with the risks of infringing other's rights, interests and claims. In the case of such infringement having proved, his domain name is required to be transferred to genuine owner / stakeholder. Further he may be liable for other civil and / or criminal consequences including monetary losses.

5. The disputed domain name is not only identical or confusingly similar to registered trademarks, registered in India as well as various parts of the globe and the websites in which the Complainant has rights according to the requirement of Para 4(a)(i) of the INDRP Rules, but also contains the trade name LEGO of the Complainant, in its entirety.

6. If use of disputed domain name by the Registrant / Respondent is allowed to continue, the same would be sold at unreasonable consideration to any other party including the competitors of the Complainant. The Respondent would also continue to gain illegally and immorally, by misusing the reputation, goodwill and business ties of the Complainant. This would also lead to loss of business as well reputation of the Complainant.

7. Any genuine person would come out with some reply or say in response to the communications made by the Complainant, the complaint, or Notice or Arbitration. Importantly, the Respondent has failed / neglected to respond to any of these even within the extended period. Thus he has failed to establish his bona fides, legitimacy, legal rights, prior use of the domain name for lawful purpose or any other type of nexus between him and the registered domain name. He is neither licensed or permitted to use the disputed domain name by the Complainant or any of its group companies.

Above facts and discussion lead to the conclusion that the Registrant has registered domain name without having any right, legitimacy or interest and that the registered domain name is being used in bad faith. The Complainant thus has proved his case.

Due to above findings, it can be concluded that the Complainant has proved its case for the entitlement to the disputed domain name.

**IXI AWARD: -**

On the basis of my findings on issues and foregoing discussion, I pass the following award: -

[1] **The Complainant is entitled to the disputed domain name 'LEGOEDUCATION.IN and hence the same be transferred to the Complainant.**

No order as to the costs.

Dated: - 05.12.2017

Place: - Pune

  
(S.C.INAMDAR)  
SOLE ARBITRATOR