

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: LEGOFURNITURE.CA

Complainant: LEGO Juris A/S

Registrant: Jason Abbott

Registrar: Go Daddy Domains Canada Inc

Panel: Jay Josefo (sole panelist)

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is LEGO Juris A/S ("LEGO" or "the Complainant"), a limited liability company registered in Billund, Denmark. Its corporate address is 7190 Billund, Denmark. The Complainant's authorized representative is Ms. Sandra Looft, of the firm of Melbourne IT Digital Brand Services AB, Saltmatargatan 7, SE 103 68, Stockholm, Sweden.

2. The Registrant is Mr. Jason Abbott. His address is listed at 150 Winston Road, Winnipeg, Manitoba R3J 1M9.

B. The Domain Name and Registrar

3. The domain name at issue is LEGOFURNITURE.CA.

4. The domain name is registered with Go Daddy Domains Canada Inc.

C. Procedural History

5. On May 15, 2012 the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada. The Provider served notice of the complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) ["Rules"].

6. No response was received from the Registrant.

7. The Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

E. Canadian Presence Requirement

9. LEGO's trademark "LEGO" is registered in Canada and thus satisfies the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"].

F. Factual Background

10. LEGO is an extremely well known maker of toy building blocks sets, including toy vehicles, toy boats, toy houses, traffic signs, and similar goods. The LEGO brand and mark is well known in Canada, and it would be not be an overstatement to say that many Canadian families have had LEGO products of one type or another in their home at one time or another. The Complainant has provided much evidence that the LEGO mark is quite well known, not only in Canada but elsewhere, and I conclude that the LEGO name is thus well known in Canada as a maker of many children's building block and related products.

11. LEGO's trademark registration is thus widely known and used in Canada and, indeed, was registered in Canada in 1957. The name and mark has been used in Canada, pursuant to the trademark filing, since March 1954. There is evidence before me that "LEGO is a super brand" indentified as the "8th most powerful brand in a list of 1,400" brands. The official LEGO website describes its featured products and the many uses to which these products may be put in children's play activities. The wares made by LEGO include building blocks sets of toys and also includes furniture, such as play tables and chairs, shelving and storage trays.

12. As LEGO has an official website, it clearly also conducts business on the internet. Its trademarks have a strong internet presence and it has registered various domain names around the world incorporating these marks.

13. The Registrant registered the domain name at issue in this matter on September 10, 2010. The domain name resolves to a “parking page” on which various services and products are advertised, with links to “pay-per-click” sites including links to the sale of the Complainant’s products.

14. The Complainant attempted to contact, on June 15, 2011, the respondent through the Registrant’s administrative contact via a CIRA web message using contact details provided by CIRA. No response was received.

15. The Complainant filed this complaint on May 15, 2012.

G. CIRA Domain Name Dispute Resolution Policy Requirements

16. The Policy defined earlier in these reasons sets out in paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name

17. I will deal with each of these factors in turn.

H. Is the Registrant's Domain Name Confusingly Similar in the Complainant's Mark?

18. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A "Mark" is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person;
- [and] (c) a trade-mark . . . that is registered in CIPO . . .

19. The Complainant must establish trademark rights which precede the domain name registration date. This the Complainant has easily done by showing that the registered mark LEGO long since preceded the Registrant's registration of the domain name. Moreover, the LEGO mark is extremely well known in Canada as has been discussed above.

20. Paragraph 3.3 of the Policy defines "confusingly similar" in the following terms:

In determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound, or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

21. For my purposes in this matter, it is without any doubt that the domain name at issue is confusingly similar with the Complainant's trademark. The domain name is composed of two words, one of which is the trademark of the Complainant running together with the generic word “furniture”. In my view, the addition of the suffix word “furniture” does not in any way alleviate the confusion caused by the use of the well recognized, indeed, as was submitted by the Complainant, “world famous”, trademark, “LEGO”.

22. Moreover, the Complainant makes products that use the word “furniture” in the product name; and it has also registered the Canadian trademark for LEGO as including “furniture, namely play tables and chairs, shelving and storage trays”. Therefore, the use of the domain name with the Complainant's name and the generic or

suffix word “furniture” does not only not alleviate any confusion; rather, it enhances the degree of confusion by creating the impression that the domain name belongs to or is affiliated with the Complainant.

23. I conclude that anyone who observes the domain name will very likely mistake it for a name related to or associated with the Complainant. The public would most likely conclude that the domain name is either owned by the Complainant or that the Complainant has a business relationship of some sort with the Registrant.

24. Accordingly, for all these reasons, the panel concludes that the Registrant’s domain name legofurniture.ca is confusingly similar with the Complainant’s registered mark LEGO in which the Complainant has had registered rights since 1957, thus long prior to the registration of the essentially identical and certainly confusingly similar domain name.

I. Was the Registration of the Domain Name Made in Bad Faith?

25. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy provides that the Registrant will be found to have registered the domain name in bad faith generally if one of the following four conditions is met:

For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a

domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;

- (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's 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 the Registrant's website or location or of a product or service on the Registrant's website or location.

26. As was stated in case number CHE-031212-00209, "...the list of general criteria for bad faith behavior is no longer closed". The four criteria are examples of behavior, yet other acts may also demonstrate bad faith. Moreover, pursuant to paragraph 3.5(d), if a Registrant "intentionally attempted to attract, for commercial gain, internet users to the Registrant's website", this in and of itself I find is an example of bad faith when such is done "by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement" of what the Registrant has to offer on its website.

27. The Complainant seemingly relies in its well written submissions on paragraph 3.5(c) and (d) of the Policy. Since the LEGO mark is well known in Canada, and indeed elsewhere, I find that the Registrant had clear (at least constructive) notice of its existence prior to the Registrant registering the domain name. Accordingly, the logical inference is that the domain name was registered specifically in order to take advantage of and capitalize upon the accumulated goodwill of the Complainant's marks by deliberately creating the impression of a false association with the Complainant. It also can be concluded, pursuant to 3.5(c), that the registration was "primarily for the purpose of disrupting the business of the Complainant".

28. The examples of the Registrant's site in the materials before me are absent any effort to avoid any confusion or the above-noted logical inference which I find would be drawn by a viewer of the site that there is a link with LEGO. This link was created due to the Registrant's improper use of trademarks of the Complainant and in the misappropriation of its name. This thus inexorably leads me to find that there was bad faith on the part of the Registrant.

29. It could be fairly stated that the Registrant was well aware of the Complainant's rights in the trademark, which has existed for 55 years, and the value of that trademark when the Registrant registered his domain name. Clearly, there is no other reason for the Registrant's choice of this particular domain name using the Complainant's trademark, other than to attempt to improperly mislead consumers and divert them for the Registrant's commercial gain.

30. On the evidence before the panel, the only reason for the Registrant to use the domain name which would, to anyone, lead to confusion, was for the improper purpose to lure traffic to that website for the Registrant's commercial profit, thus intentionally taking advantage of and profiting from the LEGO mark in a fashion that knowingly would cause confusion.

31. Accordingly, the panel concludes that the Registrant acquired the domain name legofurniture.ca in bad faith pursuant to paragraph 3.5(c) and 3.5(d) of the Policy.

J. Does the Registrant Have a "Legitimate Interest" In the Domain Name?

32. The third element of the test described in paragraph 4.1 of the Policy is to decide if the Registrant has a legitimate interest in the domain name. Can it be said that there is some objective or ascertainable link between the Registrant and the domain name in question, beyond mere registration, which is legitimate? Paragraph 3.4 of the Policy, as revised, states as follows:

For the purposes of paragraphs 3.1(b) and 4.1(c), 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 that the Registrant has a legitimate interest in a domain name:

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

- (b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

33. In my view, the Complainant has introduced more than sufficient evidence of the Registrant having no legitimate interest as exemplified under any of the above-listed parts of the Policy. The Complainant has not been able to identify any manner of how the Registrant could have any kind of legitimate interest in the domain name. The Registrant had no permission, nor license, nor expressed or implied right to use the trademark. Nor was there any acquiescence on the part of the Complainant.

34. Indeed, when the Complainant became aware of the Registrant's use, or misuse, of the trademark, a "cease and desist" letter was sent to the Registrant, which letter was ignored. It is clear that the

Registrant does not use the domain name in any kind of a legitimate offering of goods and services. Rather, the Registrant is attempting to capitalize on the inherent value in the Complainant's trademark.

35. It cannot be said that the domain name was understood in Canada "to be the generic name thereof". The trademark LEGO is well understood not to be a generic name. It is clear from the materials before the panel that the Complainant takes great pains to ensure that its trademark is well protected.

36. It is also clear that the Registrant did not register the domain name in Canada "in good faith in association with any wares, services or business". It is fair to observe that this consensus has emerged in domain name disputes: the use of trademarks which belong to others in domain names in a manner that is likely to cause confusion or lead to a false conclusion that there is a relationship between the parties, cannot be a *bona fide* offering. Moreover using "parking pages" with "pay-per-click" remuneration to whomever might be profiting at the end is clearly not a *bona fide* practice when, as is in this matter, the intention is simply to take advantage of the goodwill of a well known and long established trademark.

37. Having satisfied its initial burden of showing "some evidence" of "no legitimate interest", the burden now shifts from the Complainant to the Registrant to show a legitimate interest.

38. Yet the Registrant failed to respond to this proceeding. Thus, the Registrant obviously does not meet its onus of demonstrating any kind of legitimate interest in the domain name.

39. The panel therefore concludes that it is abundantly clear that the Registrant did not have a legitimate interest in the domain name legofurniture.ca under paragraph 3.4 of the Policy.

K. Conclusion and Decision

40. The Complainant has established that the Registrant's domain name LEGOFURNITURE.CA is confusingly similar to the Complainant's registered Canadian trademark.

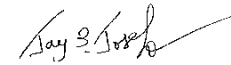
41. The Complainant has established that the Registrant registered the domain name LEGOFURNITURE.CA in bad faith, as defined in the applicable Policy.

42. The Complainant has provided some (compelling) evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name LEGOPURNITURE.CA. The Registrant has not established, as set out in the Policy, that it does have a legitimate interest.

43. Accordingly, for these reasons, the Complaint regarding the domain name LEGOPURNITURE.CA is successful.

I. Remedy

44. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.



Jay Joseph
Sole Panelist

July 6, 2012