



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

LEGO Juris AS / Domain Park Ltd.

Case no. 44259 / lego-starwars.be: lego-starwars.be

1. The parties

- 1.1. Complainant: LEGO Juris A/S;
with registered office at 7190, Billund, Koldingvej, 2;
listed in the Danish trade register under number 28122454.

Represented by:

Ms. Anna Mejlerö, Infringement Specialist,
Melbourne IT Digital Brand Services AB
with office at 1068, Stockholm, Saltmätargatan, 7, Box 3396.

- 1.2. Licensee: Domain Park Ltd;
with registered office at 10117, Berlin, Markgrafenstrasse, 55;

2. Domain name

Domain name: "lego-starwars.be"
Registered on: June 15, 2011

hereafter referred to as "the domain name".

3. Factual Background information

The Licensee registered the Domain Name on 15 June 2011.

The Complainant is the owner of the well-known LEGO trademarks, including Benelux trademark number 0054491 and community trademark number 39800. Complainant has subsidiaries and branches located throughout the world, and its LEGO products are sold in more than 130 countries, including Belgium.

Since 1999, the LEGO Group has a license agreement with Lucasfilm Ltd. concerning the use of the Star Wars trademark in relation with its LEGO products.

The Complainant sent on 1 December 2011 a cease and desist letter to the Licensee asserting that the Licensee's *"use of the LEGO mark as part of you domain name creates the false and misleading impression that you are authorized, licensed or approved to provide [...] goods or services with respect to LEGO [...] products"*.

The Complainant requested to transfer the domain. The letter stated that *"The LEGO Group will be of assistance in transferring the domain name and will reimburse the out of pocket expenses the registrar may charge for the transfer and the registration fee you have paid for the domain name."* Reminders were sent on 13 and 29 December 2011.

The Complaint was filed with CEPANI on 20 January 2012.

4. Position of the parties

4.1. Position of the Complainant

Complainant argues that: (i) the Disputed Domain Name is identical or confusingly similar to a mark in which the Complainant has rights; (ii) Licensee has no rights or legitimate interests in respect of the Disputed Domain Name; and (iii) the Disputed Domain Name was registered and is being used in bad faith.

Regarding the first part, the Complainant argues that the Domain Name is confusingly similar to its LEGO trademark. Additionally, the Domain Name also incorporates the Star Wars trademark. The Complainant argues that the addition of the "starwars" suffix strengthens the impression that the Domain Name belongs to or is affiliated with the Complainant.

Regarding the second part, the Complainant argues that no license or permission has been given to use the LEGO trademark. The Complainant argues that it is unlikely that the Licensee would not have known of Complainant's legal rights in the LEGO name at the time he registered the Domain Name. The Complainant argues that the Licensee was motivated to register the Disputed Domain Name based on the fame of the LEGO trademark. Finally, the Complainant contends that the Licensee is not using the Disputed Domain Name in connection with a bona fide offering of goods or services. Instead, Complainant argues that Licensee intentionally chose a domain name based on a registered trademark in order to generate traffic and income through sponsored links, and, ultimately to use the LEGO trademark to mislead Internet users, all of which tarnishes the LEGO trademark. Thus, Complainant contends that the Licensee has no rights or legitimate interest in respect of the Disputed Domain Name.

Regarding the third part, the Complainant argues that no replies were received to its attempts to contact the Licensee. The Complainant also argues that the Licensee is using the Domain Name to intentionally attempt to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

4.2. Position of the Licensee

The Licensee did not reply to the Complainant's submission.

Consequently, the dispute shall be decided on the basis of the Complaint (art. 5.4 of the CEPANI Rules for Domain Name Dispute Resolution).

5. Discussion and findings

Pursuant to Article 15.1 of the *CEPANI rules for domain name dispute resolution*, the Third-party decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

Pursuant to Article 10b(1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, the Complainant must provide evidence of the following:

- *"the Licensee's domain name is identical or confusingly similar to a trademark, a tradename, a social name or corporation name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and*
- *the Licensee has no rights or legitimate interests in the domain name; and*
- *the Licensee's domain name has been registered or is being used in bad faith."*

5.1. The Domain Name is identical or confusingly similar to trademarks in which the Complainant has rights

The Domain Name partly consists of the Complainant's LEGO trademark in its entirety. The addition of "starwars", referring to a very successful product line of the LEGO Group launched in 1999, only strengthens the impression that the Domain Name belongs to, or is affiliated with the Complainant and must therefore be considered to be confusingly similar with the Complainant's registered LEGO trademark.

In CEPANI Case No 44218, the Panelist stated regarding domain names which incorporated the Complainant's trademark (an online provider of online gaming services): *"the addition of the terms "BINGO", "CASINO" and "POKER" is not sufficient to obviate or even reduce the likelihood of confusion. On the contrary, these terms are so closely associated with the Complainant's core area of business that this likelihood of confusion is only enhanced"*.

With reference to the reputation of the trademark LEGO there is a considerable risk that the public will perceive the Licensee's Domain Name either as a domain name owned by the Complainant or that there is some kind of commercial relation with the Complainant. By using the trademark as a dominant part of the Domain Name, the Licensee exploits the goodwill and the image of the trademark, which may result in dilution and other damage for the Complainant's trademark.

5.2. The Licensee has no right or legitimate interests in the Domain Name

The Complainant has not given a license or permission of any other kind to the Licensee to use the trademark LEGO.

It is clear that the Licensee has no legitimate interest in the Domain Name, as it is not known or active under this domain name. The Licensee is merely displaying advertisements under the Domain Name, including an advertisement designed to harvest email addresses by promising a reward.

The use of the Domain Name to paid advertisements is not a bona fide use of the Domain Name, as noted in WIPO cases concerning the LEGO trademark, such as WIPO Case. No. D2010-1156: *"Further, Respondent's use of the Disputed Domain Name to sponsor links to paid advertising is not use of the Disputed Domain Name in connection with a bona fide offering of goods or services."*

In CEPANI Case No. 44202, the Panelist stated regarding utilisation of the notoriety of the complainant's trademarks that *"the use of the Domain Name for "pay-per-click" advertisements, without authorization, [...] is not a bona fide offering."*

The Licensee's use of a trademark to attract visitors to gain revenue by click-through advertisements is not a bona fide use of the Domain Name, and consequently the Licensee has no rights or legitimate interest with respect to the Domain Name.

5.3. The Licensee's Domain Name has been registered or is being used in bad faith

In CEPANI case No. 44171, the Panelist stated regarding the Complainant's well-known trademark: *"The registration of a well-known brand could be indicative of bad faith".* The Panelist concluded: *"The Domain Name chosen by the Licensee has a relatively high degree of distinctiveness. It is unlikely that the Licensee would have independently, without deliberately seeking a business opportunity, chosen and registered the name [...] It appears from the file that it is likely that the Licensee is using the Domain Name to take commercial advantage out of it, namely attracting for commercial gain..."*.

It is clear that the Licensee has registered the Domain Name in bad faith, as is described in article 10 of the Terms and Conditions of DNS BE. Indeed, the domain name is used intentionally to attract, for commercial gain, Internet users by creating confusion with the Complainant's trademarks.

6. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-party decider hereby rules that the domain name registration for the " **lego-starwars.be** " domain name is to be transferred to the complainant.

Brussels, 23 March 2012.

Renaud Dupont
The Third-party decider
(signature)