

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

Domain Name: legomaniac.ca
Complainant: LEGO Juris A/S
Registrant: James Carswell
Registrar: Domain People, Inc.
Panelist: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, LEGO Juris A/S is a company based in Denmark.
2. The Registrant for the domain name is James Carswell.

B. The Domain Name and Registrar

3. The disputed domain name is legomaniac.ca. The Registrar for this domain name is Domain People, Inc. The disputed domain name was registered on January 7, 2009.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.1) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.2) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint (the “Complaint”) against the Registrant with Resolution Canada, Inc. on March 25, 2010, requesting that the current registration of the domain name legomaniac.ca be transferred to LEGO Juris A/S.
6. Resolution Canada, Inc. served notice of the Complaint to the Registrant as required by paragraph 4.3 of the Rules. Service of the Complaint was made by e mail on March 25, 2010 and by courier on the same day. It was received by the Registrant on March 30, 2010.

7. The Registrant had twenty (20) days from the date the Complaint was filed to file a Response, but no Response from the Registrant was ever filed.

8. The Complainant has elected to proceed before a panel consisting of only one panelist.

D. Panelist Impartiality and Independence

9. As required by paragraph 7 of the Rules, the panelist has submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

10. The Complainant, LEGO Juris A/S is the owner of the Canadian registered trade-mark LEGO, Registration No. 106,457. This mark is included in its entirety in the domain name legomaniac.ca, the subject of this dispute. As such it meets the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

11. The Complainant is the owner of the trade-mark LEGO and has registered this trade-mark in numerous countries throughout the world, including Canada, for use in association with various toys, books, furniture and educational materials. The LEGO mark is used in more than 130 countries and the Complainant is the owner of over 1000 domain names containing the term LEGO.

12. The Canadian trade-mark registration for LEGO, Registration No. 106,457, claims use in association with toys in Canada since as early as 1954 and the mark became registered in 1957. Therefore there has been over 50 years of use of the mark LEGO in Canada.

13. The Complainant wrote to the Registrant at the Registrar's homepage on October 5, 2009 requesting that the domain name be transferred to it and offering to pay the Registrant's out of pocket expenses in registering the domain name. No response was received so a reminder was sent on November 24, 2009 via a CIRA online form. No response was received to that message either.

G. CIRA Domain Name Dispute Resolution Policy

14. Under paragraph 3.1 of the Policy it requires that the Complainant establish 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 no legitimate interest in the domain name as described in section 3.6; and

c) the Registrant has registered the domain name in bad faith as described in section 3.7.

15. According to paragraph 4.1 of the Policy the Complainant must establish points (a) and (c) above on the balance of probabilities and for point (b) it must provide some evidence that the Registrant has no legitimate interest in the domain name.

H. Analysis

Confusingly Similar

16. The Complainant has to show that it has rights in a mark that is confusingly similar to the domain name, that these rights pre-date the date of registration of the disputed domain name and that the rights continue to exist.

17. The date of registration of the domain name is January 7, 2009, therefore this is the relevant date for this analysis.

18. The Complainant has provided evidence that it is the owner of a Canadian trade-mark registration for the word LEGO which was based on use since 1954 and registered in 1957. The criteria for determining whether a Complainant has “rights” in a mark are set out in paragraph 3.3 of the Policy and in this case I find that the Complainant does have rights in the mark LEGO pursuant to paragraph 3.3(b) as the mark is registered in CIPO in the name of the Complainant. It is also evident that these rights predate the date of the registration of the domain name which is 2009.

19. The Complainant has also produced excerpts from a report by Superbrands UK from 2009 indicating that LEGO is the 8th most powerful brand in a list of 1400. When one couples that with the fact that LEGO has been used in Canada since 1954, and the revenue for the LEGO group in 2008 worldwide was more than \$1.8 billion, it appears to be safe to say that LEGO is a famous mark that is still in use, is very distinctive and is therefore entitled to a wide ambit of protection.

20. The domain name registered by the Registrant is legomaniac.ca. This domain name incorporates the whole of the Complainant’s mark LEGO and pairs it with the word “maniac”. Given the fact that the mark LEGO is so well known, the reproduction of this mark in the domain name, even when combined with other words, is likely to lead to confusion. The average person, on seeing the word LEGO, is going to assume that there is some connection to the LEGO brand toys. This is especially so when the word that it is paired with is a non-distinctive word such as “maniac”, which in this context merely seems to suggest someone who is a fan of LEGO brand toys.

21. Therefore, I find that the Complainant has demonstrated rights in a mark that is confusingly similar to the domain name, and that these rights pre-date the date of registration of the domain name. I also find that these rights are still in existence.

Legitimate Interest

22. Paragraph 3.6 of the Policy provides six possible ways in which a Registrant may have a legitimate interest in a domain name. The submissions made by the Complainant indicate that the domain name resolved to a website that provided links to other LEGO websites, other shopping sites, photography sites, some anti-Google sites and some sponsored links. The caption for the site read "Are you a LEGO maniac?" Currently the domain name resolves to the LEGO.com website.

23. The domain name was therefore not being used as a mark, prior to receiving the notice from the Complainant, to identify any wares or services being provided by the Registrant. Therefore paragraph 3.6(a) is not satisfied. Also, the Registrant does not appear to have used the domain name in good faith in association with any wares, services or business for which the domain name was clearly descriptive or the generic term (3.6(b) and (c)). The domain name was not used in good faith in association with criticism, review or news reporting (3.6(d)). Finally, the domain name was not the legal name or other identifier of the Registrant (3.6(e)), and it was not the geographical name of the location of the Registrant's place of business (3.6(f)). Therefore, none of the criteria in paragraph 3.6 have been satisfied and I find that the Registrant had no legitimate interest in the domain name.

Bad Faith

24. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.7 of the Policy deals with the grounds which constitute bad faith. I do not find any evidence that the Registrant's activities support bad faith under paragraph 3.7(a) as there is no evidence that the Registrant offered to sell the domain name to the Complainant for more than the Registrant's actual costs in registering it. The Complainant did not receive any response from the Registrant when it contacted the Registrant in an attempt to buy the domain name.

25. With regard to paragraph 3.7(b), we do not have any evidence that the Registrant has a pattern of registering domain names to prevent persons who have rights in marks from registering the marks as domain names. Therefore, even if the Registrant did register the domain name to prevent the Complainant from doing so, the Complainant's evidence does not support the second part of this ground.

26. With regard to paragraph 3.7(c), the Complainant has demonstrated that the LEGO brand is very well known, and I have found that the use of this mark in the current domain name is likely to cause confusion. Therefore it appears evident that the use of the mark LEGO in the domain name legomaniac.ca is going to disrupt the business of the Complainant because it is going to cause confusion amongst the Complainant's customers when searching the internet. People coming across this site are going to assume that it is sponsored or endorsed by the Complainant. Given the fame associated with the LEGO brand, the Registrant must have known that this confusion was going to result, therefore I find that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant. With regard to the criteria that the Registrant be a competitor of the Complainant, the Registrant's actions make it a competitor in that it is competing for the web traffic that would otherwise go to the Complainant

by utilizing the Complainant's well known trade-mark in its domain name. The diversion of web traffic from the legitimate LEGO sites to its own site creates revenue for the Registrant through the sponsored links, at the expense of the Complainant. I therefore find that the Complainant has shown, on the balance of probabilities, that the Registrant has registered the domain name in bad faith.

I. Conclusion and Decision

27. In conclusion, I find that the Complainant has rights in the mark LEGO which predate the registration of the domain name. I also find that the domain name is confusingly similar to the Complainant's mark and that the Registrant had no legitimate interest in the domain name. Finally, I find that the Complainant has shown that the Registrant registered the domain name in bad faith.

28. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name legomaniac.ca be transferred to the Complainant, LEGO Juris A/S.

Dated May 7, 2010

Sharon Groom



Sharon Groom
May 7, 2010