

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

**Domain Name:** LEGOSTORE.CA

**Complainant:** LEGO Juris A/S  
**Registrant:** Emma A. Lehmann  
**Registrar:** MyID.ca INC.

**Panel:** David Lametti (sole panelist)

**Service Provider:** Resolution Canada

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**DECISION**

**A. The Parties**

1. The Complainant is LEGO Juris A/S (LEGO). The Complainant is a limited liability company registered in Denmark. Its corporate address is Koldingvej 2, 7190 Billund, Denmark. The Complainant's authorized representative is Cecilia Borgenstam, Melbourne IT Digital Brand Services AB, Saltmätargatan 7, SE 103 68, Stockholm, Sweden.
2. The Registrant is Emma A. Lehmann. Her address is Karl-Marx Str. 122, Berlin, Germany, 12043. Her contact email address is emmaalehmann@gmail.com.

**B. The Domain Name and Registrar**

3. The domain name at issue is LEGOSTORE.CA.
4. The domain name is registered with MyID.ca INC. Its address is 33 Hazelton Avenue Suite 311, Toronto, Ontario, Canada, M5R 2E3.

**C. Procedural History**

5. On 19 October 2012, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. 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 single 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. The Complainant's trademark LEGO is registered in Canada and forms the dominant part of the domain name in question. The Complainant 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. The LEGO trademark and associated brand of building blocks and children's toys, books and related products is exceedingly famous; as pointed out by LEGO's representative, it is one of the most well known brands in the world.

11. The Complainant registered its Canadian Trademark LEGO, with the registration number TMA106457, on 26 April 1957. The Complainant's representative has provided ample evidence of the use of this trademark in Canada since that date, as well as its use throughout the world. It suffices to say that both the mark and the brand have been wildly successful in Canada and elsewhere.

12. The Complainant is also the owner of more than 2400 domain names containing the terms LEGO, including the domain name LEGO.CA and LEGOSTORE.COM. The Complainant also maintains an extensive web presence under the domain name LEGO.com, and has expanded its use of the LEGO trademark to, among other things, computer hardware and software, books, videos and computer controlled robotic construction sets. The Complainant has a policy that it should own all domain names containing the word LEGO.

13. A Whois search indicates that the domain name at issue was registered by the Registrant on 27 July 2012.

14. On 23 August 2012 the Complainant sent a cease and desist letter to the Registrant using the CIRA.ca homepage; a reminder was sent on 3 September 2012. The Complainant requested a voluntary transfer of the domain name and offered compensation for the expenses of registration and transfer fees not exceeding out of pocket expenses.

15. The Registrant replied on 4 September 2012, affirming that she was prepared to transfer the Domain Name for \$2500 CAD, plus escrow fees. The Complainant replied by stating their policy that they will not acquire domain names to which they are legally entitled.

However, they repeated their offer of compensation for the registration fee and related out of pocket expenses.

16. No response was received from the Registrant, and so another reminder was sent on 12 September 2012. The Registrant invited a counter offer via email on 13 September 2012. The Complainant sent a final email to the Registrant on 14 September 2012 once more explaining that the Complainant would only reimburse the fees and any out of pocket expenses.

17. No further reply was received from the Registrant. As all efforts to solve the matter amicably had been exhausted, the Complainant chose to file a complaint according to the CIRA domain dispute process.

18. The Complainant filed this Complaint on 19 October 2012.

### **G. CIRA Domain Name Dispute Resolution Policy Requirements**

19. It bears reiterating that all .ca domain name dispute resolutions shall be bound by CIRA policies, and in particular by the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”]. It would be well advised for Complainants and Registrants to frame their arguments in those terms in order to advance their claims – or those of their clients – with the greatest degree of potential success. In this manner, participants can be sure to have taken the appropriate avenues of inquiry and met the various burdens required under the Policy. It is also worth noting that while UDRP cases may be instructive from time to time, there are departures in the CIRA Policy from the UDRP, and hence URDP cases ought to be used with caution.

20. The Policy sets out at 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 . . .

21. The Panel will deal with each criterion in turn.

#### **H. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?**

22. 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 . . .

23. The Complainant must establish trademark rights that precede the domain name registration date. The Complainant has shown the date of the registration and widespread use of LEGO trademark in Canada in 1957, well before the registration of the domain name in 2012.

24. 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.

25. In this case, the domain name is composed of the registered trademark LEGO and the word "store". "Store" is a common, generic term evoking a place where one can purchase products.

26. It has been well established in domain name arbitrations, many examples of which have been aptly cited by the Complainant's representative, that confusing similarity is generally recognized when well known trademarks or famous marks are paired up with different kinds of generic prefixes and suffixes in domain names. The dominant rationale for finding confusing similarity is the presumed link that the average internet user will make between the trademark and the domain name. A person who sees the domain name will likely mistake it for a product or service related to the trademark holder. Hence, the likelihood of confusion includes the obvious association of a domain name with a well-known trademark.

27. Given the widespread goodwill associated with the trademark LEGO, there is a considerable risk that the public will perceive the Registrant's domain name either as a domain name owned by the Complainant or think that there is some kind of authorized commercial relation with the Complainant. "Store" is effectively a generic term, which when coupled with LEGO, evokes the image of a place where LEGO products may be bought, perhaps even exclusively. Thus a sufficient link or association is created to confuse the average internet user of a formal connection between the domain name and the mark.

28. It is to be noted that LEGO already owns at least one such compounded mark using the word “store”: LEGOSTORE.COM. LEGO also owns a multitude of other such compounded domain names. This adds fuel to the fire of “confusingly similarity”.

29. Such a finding is consistent with a previous CIRA arbitration decisions concerning the compounding of the mark LEGO with another term: for example, “LEGOMANIAC”. In *LEGO Juris A/S v. James Carswell* (CIRA Case No. 00150, May 7, 2010), the panel considered the domain name LEGOMANIAC.CA to be confusingly similar to the LEGO mark: “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 finding coheres with that of the panel in the instant case, and perhaps even more so, as the generic word “store” is even more likely to be associated legitimately with LEGO products and services than the word “maniac”.

30. Thus, the Panel finds that the Registrant’s domain name LEGOSTORE.CA is confusingly similar with the Complainant’s registered mark in which the Complainant had rights well prior to the registration of the domain name.

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

31. 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 states that the Registrant will be considered 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.

32. As has now been noted in a number of decisions, there are two significant changes to be noted in this latest iteration of the Policy. First, the list of general criteria for bad faith behaviour is no longer closed. As with "legitimate interest", these four criteria are exemplars of certain kinds of behaviour, and thus make possible other acts demonstrating bad faith.

33. The second change is potentially relevant to this matter. Paragraph 3.5(d) adds *intentionally attempting to attract users for commercial gain* as a listed criterion of bad faith where 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 – it seems in the widest sense – on its website.

34. The Complainant's argument is effectively framed under paragraphs 3.5(a) and (d). As regards paragraph 3.5(a), the Registrant, upon receipt of the request to transfer the domain name to the Complainant, asked for \$2500 CAD plus escrow costs, a sum well in excess of her registration fees and out of pocket expenses. While there might be some question of "primarily" there is enough evidence on the facts to infer such a result in an uncontested proceeding such as this one: the registrant was trying to sell the domain name back to the Complainant for \$2500, or at the very least was trying to sell the domain name through the parking site for some non-specified amount. That finding would be enough to dispose of the bad faith criterion in this case.

35. The domain name at issue currently resolves to a "parking page" where the domain name is listed for sale where the minimum price is \$250 CAD. The website has links to the Registrars domain name marketplace where thousands of domain names are published for sale. This might be enough to claim bad faith under paragraph 3.5 (c), disrupting the business of the Complainant. However, the Complainant alleges that the Registrant is using the domain name to intentionally attempt to attract, for commercial gain, internet users to the websites, by creating a likelihood of confusion with the

Complainant's mark as to the source, sponsorship, affiliation or endorsement of the websites.

36. Given the distinctiveness of the LEGO mark, the Complainant argues that Registrant would have known of its existence prior to registering the domain name. It then becomes logical to reach the conclusion that the domain name was registered precisely to capitalize on the accumulated goodwill of the Complainant's marks by intentionally creating the impression of a false association, sponsorship or endorsement with or through them (paragraph 3.5(d)).

37. While it may very be possible to conclude in some preliminary way that the potential for such a situation here exists, especially given the notoriety of the LEGO mark, the Panel would still need more precise evidence to reach the actual conclusion in this case. In particular, it would need more information on the manner in which revenue was generated on the parking website (i.e., simply through traffic, through advertising, by pay-per-click, etc.), as well as the *confusing* manner in which the domain name *used* the goodwill in the complainant's mark to "attract, for commercial gain". Parking websites are not *per se* illegitimate. Indeed, paragraph 3.5(d) appears to imply that while some degree of initial interest confusion might still be tolerated (i.e., when *not* intentional and not done "by creating a likelihood of confusion"), such initial interest confusion will only be tolerated where it is clear on reaching the site of the domain name in question that the use of the domain name was done effectively in good faith and not done to simply piggyback on the domain name's popularity for the purposes of financial gain. Thus there is a conceptual link between this new criterion of good faith to some sort of legitimate interest or legitimately-believed interest in using the domain name to attract traffic. The Panel would also note that some of the decisions decided under the UDRP are neither binding nor compelling. The simple application of some of these findings would render virtually any use of a famous mark to be in bad faith.

38. Without knowing more about the website and its funding model, it would be premature to draw any further inferences. However, given the finding of bad faith under paragraph 3.5(a), such a finding is not required here.

39. Therefore this Panel concludes that the Registrant acquired the domain name LEGOSTORE.CA in bad faith under paragraph 3.5(a) of the Policy.

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

40. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which is legitimate. Paragraph 3.4 of the Policy", as revised, now states:

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.

41. The first four criteria contain an element of good faith in assessing the behaviour of the Registrant, while the last three point to more objective facts linking the domain name to the Registrant. It is to be noted that this definition is also no longer a closed, restrictive list that was the case in the previous version of the Policy, but rather illustrates the primary examples of the kinds of association between a registrant and the domain name that would be found legitimate. It may now be appropriate for parties or for a panel to look beyond these stated criteria in determining the kinds of facts and behaviour that constitute a legitimate interest.

42. In terms of the procedure required under the Policy, a complainant must provide some evidence that none of these or similar interests can reasonably apply to the registrant. A panel must be cognizant of the fact that a complainant may not have any incentive to best identify and characterize a registrant's possible legitimate links, and examine the facts



accordingly. The burden would then shift to the registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs, as well as, in the amended version, other legitimate interests not so listed.

43. The Panel notes at the outset that a registrant is in a more difficult position as regards a well known trademark: it is, in practice, simply much more difficult for a registrant to claim any sort of legitimate interest in a famous mark.

44. The Complainant has introduced some evidence of the Registrant having no legitimate interest as exemplified under any of the listed heads. The Complainant has not been able to identify any manner in which the Registrant might have a legitimate interest in the domain name. In particular:

- the Registrant had neither permission or license, express or implied to use the marks, nor authorization, nor was there acquiescence on the part of the Complainant; and
- the Registrant does not use the domain name in a bona fide offering of goods and services

45. Regarding the offering of bona fide goods and services there is a growing consensus in domain name dispute resolution under the CIRA Policy that incorporating trademarks and domain names belonging to others into domain names in a manner likely to cause confusion or raise presumptive associations are *not* bona fide offerings of goods and services. The practice of using “parking pages” with “pay-per-click” remuneration has been singled out as a non-bona fide practice where the intent was simply to capitalize on the goodwill of a popular trademark. While the practice of “pay-per-click” or “click-through” remuneration models are not illegitimate business models in and of themselves, it is rather the confusion or illegitimate association that one uses to get the user to the desired site that is not bona fide. This is consequently not capable of constituting a legitimate interest in the name. [See generally *Weekday Brands AB v. Whitfield Leslie - CHEAPMONDAY.CA* (CIRA case No 00201, 12 October 2012.)]

46. As seen in the above discussion on bad faith, that may have been the case here. Yet, while there was not enough evidence in the facts as presented to find conclusively that the offering was in bad faith under paragraph 3.5(d), there is enough evidence to say that this business model was not sufficient grounds for finding a legitimate interest in favour of the Registrant, as here the Complainant need only offer *some* evidence (which the Registrant can then choose to rebut).

47. The Complainant having thus satisfied its initial burden of showing “some evidence” of “no legitimate interest” puts the onus on the Registrant to show a legitimate interest.

48. The Registrant has not responded, and thus fails to meet its burden of showing any legitimate interest in the domain name.

49. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name LEGOSTORE.CA under paragraph 3.4 of the Policy.

#### **K. Conclusion and Decision**

50. The Complainant has established that the Registrant's domain name LEGOSTORE.CA is confusingly similar to the Complainant's registered Canadian trademarks.

51. The Complainant has established that the Registrant registered the domain name LEGOSTORE.CA in bad faith, as defined in the Policy.

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

53. For these reasons, the Complaint regarding the domain name LEGOSTORE.CA is successful.

#### **L. Remedy**

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



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David Lametti  
Sole Panelist

December 28, 2012