

## **.hk Domain Name Dispute Resolution** **ARBITRATION PANEL DECISION**

Complainant: LEGO Hong Kong Limited

Respondent: ITRAVEL Limited

Case Number: DHK- 1400110

Contested Domain Name: <LEGOLAND.COM.HK>

Panel Member: Ike Ehiribe

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### **1. Parties and Contested Domain Name**

1.1 The Complainant in this matter is Lego Hong Kong Limited a company incorporated in Hong Kong with its registered office at Units 1607-11, 16/F, Miramar Tower, 132 Nathan Road Tsim Sha Tsui Kowloon Hong Kong (the “Complainant”) and represented by CSC Digital Brand Services AB based in Stockholm.

1.2 The Respondent is ITravel Limited; a company incorporated in Hong Kong with its registered office at Flat 1703, Free Trade Centre, 49 Tsun Yip Street, Kwun Tong, KLN in Hong Kong (the “Respondent”) and represented by Mr Lee Ho Yin a systems analyst.

1.3 The disputed domain name is <LEGOLAND.COM.HK> (the “disputed Domain Name”), which was registered by the Respondent with the Hong Kong Domain Name Registration Company Limited (the “Registrar”).

### **2. Procedural History**

2.1 The Complaint in this matter was filed with the Hong Kong International Arbitration Centre (the “HKIAC”) on September 25, 2014. The HKIAC thereafter lodged a request for registrar verification in connection with the disputed Domain Name on September 26, 2014. The Registrar emailed a response on the same date to the HKIAC confirming that the Respondent is listed as the registrant and also providing the registrant’s contact details.

2.2 The HKIAC formally notified the Respondent of the Complaint and the Respondent filed a response on October 29, 2014.

2.3 By email of November 11, 2014 the HKIAC advised the parties that Ike Ehiribe had been appointed as a sole panelist in this matter.

### **3. Factual Background**

#### For the Complainant

3.1 The Complainant is a company incorporated in Hong Kong with its registered office at 16/F, Miramar Tower, 132 Nathan Road, Tsim Sha Tsui Kowloon and together with LEGO Juris A/S based in Denmark, both belong to the same LEGO Group of companies. LEGO Juris A/S is the owner of LEGO, LEGOLAND, and all other trademarks used in connection with the famous LEGO brands of construction toys and other LEGO branded products. For the purposes of this complaint, the Complainant is authorized to represent LEGO Juris A/S as evidenced by a Power of Attorney granted to the Complainant by LEGO Juris A/S and dated October 7, 2014. The LEGO trademark with registration number 199501785 is registered in Hong Kong under class 28 (toys, games and playthings). The LEGOLAND trademark with registration numbers 19740492 and 301940120 are registered under class 28 (toys for educational, instructional and entertainment purposes) and class 41 (education; providing of training; entertainment; sporting and cultural activities; video tape and film production; amusement parks; publication of books and of texts (other than publicity texts)). The LEGO group is said to have subsidiaries and branches throughout the world and LEGO products are said to be sold in more than 130 countries, including in Hong Kong. The LEGO trademark is said to be among the best-known trademarks in the world due in part to decades of extensive advertising, which prominently shows the LEGO mark on all products, packaging, displays and promotional materials. The LEGO Group is also said to be the owner of more than 2400 domain names containing the mark LEGO and also maintains several websites under the domain name <LEGO.COM> and <LEGOLAND.COM>.

#### For the Respondent

3.2 The Respondent is a company incorporated in Hong Kong with its registered office situate at Flat 1703, Free Trade Centre, 49 Tsun Yip Street, KwunTong KLN and is described as a licensed travel company authorized to organize tour products. The Respondent registered the disputed Domain Name <LEGOLAND.COM.HK> on March 10, 2014 according to the WhoIs search report attached to these proceedings. The Respondent has received a number of letters from the Complainant demanding the voluntary transfer of the disputed Domain Name to the Complainant including a cease and desist letter dated April 7, 2014. The Respondent has refused to transfer the disputed Domain Name on the grounds that it does not believe that it has engaged in the infringement of the Complainant's trademark, amongst other

grounds, as the Respondent is not advertising the disputed Domain Name for sale.

#### 4. Parties' Contentions

##### The Complainant

4.1 The Complainant asserts that the dominant parts of the disputed Domain Name being LEGO and LEGOLAND are identical or confusingly similar to the Complainant's registered trademarks, as appears in the Complainant's trademarks and domain names in numerous countries all over the world, including in Hong Kong where the Respondent is based. The Complainant submits further that the fame of the Complainant's trademarks has been recognized and confirmed in numerous previous UDRP decisions. See for instance the decision in *LEGO Juris A/S v. Level 5 Corp*, WIPO Case No. D2008-1692 and *LEGO Juris A/S v. Reginald Hastings Jr*, WIPO Case No. D2009-0680 amongst other decisions cited by the Complainant. The Complainant states that the addition of the country code top-level domain (ccTLD) “.COM.HK” to the disputed Domain Name does nothing to impact on the confusing similarity between the Complainant's trademarks and the disputed Domain Name. In support of this contention, the Complainant refers to *WhatsApp Inc. v. GOIP Holdings Limited*, HKIAC Case No. DHK-1300095.

4.2 With reference to the decision in *Mattel, Inc. v. Kristopher –Kent Harris*, HKIAC Case No. DHK -1000059 the Complainant argues that in the light of the reputation of the Complainant's trademarks, there is considerable risk that the public will perceive the disputed Domain Name to be owned by the Complainant or that there is some kind of commercial relationship between the Respondent and the Complainant.

4.3 The Complainant further asserts that it has discovered the Respondent does not have any trademarks or trade names corresponding to the disputed Domain Name nor any evidence of common usage and therefore concludes that the Respondent does not possess any rights or legitimate interests in respect of the disputed Domain Name. In support of this assertion, the Complainant cites a number of previous decisions including *Gaulme v. Oriental Industries Overseas (Group) Ltd*, HKIAC Case No. DHK 1100071 and *Alcoholics Anonymous World Services Inc. v. Lauren Raymond*, WIPO Case No. D2000-0007 etc. The Complainant also asserts that: (i) no license or authorization has been granted to the Respondent by the Complainant to use the LEGO or LEGOLAND trademark; (ii) the Respondent is not an authorized dealer of the Complainant's products; and (iii) the Respondent has never had a business relationship with the Complainant. Thus, it is

submitted following *WhatsApp Inc. v. GOIP Holdings Limited, supra*, unauthorized usage can never be described as a bona fide offering of goods and services nor a legitimate non - commercial or fair use of the disputed Domain Name. The Complainant also states that there is no disclaimer to be found on the Respondent's website to which the disputed Domain Name resolves, thereby, increasing the likelihood of Internet users believing that there is a strong link between the Complainant and the Respondent's travel and language education business. Therefore, the Complainant submits that where an abbreviation or a disputed domain name incorporates a registered trademark, that in itself, does not automatically provide legitimate rights in that disputed domain name following *PepsiCo, Inc. v. "null", aka Alexander Zhavoronkov*, WIPO Case No. D2002-0562. The Complainant therefore concludes that the Respondent is not using the disputed Domain Name in connection with a *bona fide* offering of goods or services, instead the Respondent has intentionally chosen to register the disputed Domain Name in order as to generate traffic and income through a commercial website.

4.4 On the question of bad faith use and registration, the Complainant observes that the Respondent registered the disputed Domain Name on March 10, 2014 subsequent to the registration of the Complainant's trademarks including those registered in Hong Kong by several years, the Complainant therefore submits that following the decision in *WhatsApp Inc. v. GOIP Holding Limited, supra*, the Respondent must have known or ought to have known of the Complainant's extensive rights in the LEGO and LEGOLAND trademarks. Secondly, the Complainant alludes to the various responses given by the Respondent following the service of the Complainant's cease and desist letter dated April 04, 2014 whereby the Respondent refused to voluntarily transfer the disputed Domain Name as requested and actually asked the Complainant to provide evidence of infringement, as further evidence of bad faith use. Thirdly, the Complainant asserts that since the disputed Domain Name is connected to a commercial website offering study tour products for language development and there being no disclaimer declaring the lack of a commercial relationship between the Respondent and the Complainant, such unauthorized usage is further evidence of bad faith registration and bad faith use. Fourthly, the Complainant asserts that the Respondent's use of the disputed Domain Name to intentionally attempt to attract for commercial gain Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website is further evidence of bad faith use and bad faith registration according to the Dispute Resolution Policy following *Philip Morris Inc. v. Alex Tsypkin*, WIPO Case No. D2002 - 0946.

### The Respondent

4.5 The Respondent states that the disputed Domain Name <LEGOLAND.COM.HK> is a sub-project owned by iTravel, the Respondent, and dedicated entirely to the activities of the Language Education Global (LEG) section of iTravel. The Respondent states further that iTravel is a licensed Travel company in Hong Kong and authorized to organize Tour products. The Respondent states further that the disputed Domain Name <LEGOLAND.COM.HK> is not available for sale so the LEG slogan has been added as part of the disputed Domain Name, namely "One-stop Language Advancement And Development (OLAND) that becomes <LEGOLAND.COM.HK>.

4.6 The Respondent further asserts that in the internet world abbreviation is commonly used for shortening a domain name. The Respondent refers to a good example provided by the authorized representative of the Complainant – CSC. The Respondent states that the full name of CSC is Corporation Service Company (CSC), whereas CSC is the abbreviation of another company named Computer Sciences Corporation and therefore, Computer Sciences Corporation (CSC) occupies the <CSC.com> domain. The Respondent therefore refers to a number of screen shots and asserts that Corporation Service Company has appended part of their slogan to the domain name and has become <CSCglobal.com> as reflected in the screenshots attached to these proceedings.

4.7 The Respondent further asserts as follows: (i) the disputed Domain Name <LEGOLAND.COM.HK>; is purely selling education tours with a completely different look and feel; (ii) the disputed Domain Name does not contain any trademark or content relating to the Complainant; and (iii) the Respondent displays a clear message to remind the Internet users who enter the Respondent's website for the first time that it has no connection with the Complainant. The Respondent concludes that the Complainant has failed to provide reasonable and sufficient evidence to establish that the disputed Domain Name is being used by the Respondent in bad faith and in the absence of such evidence, the Complainant's arguments are invalid and the Respondent has the ultimate right to utilize the disputed Domain Name.

## **5. Findings**

According to Paragraph 4a of the HKDNR Domain Name Dispute Resolution Policy (the "Policy"), which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered and is being used in bad faith; and
- (iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name. (As the disputed Domain Name is registered by ITravel Limited and not registered by an individual person, this requirement does not apply in this case.)

**(1). Identical/confusing similarity**

1.1) This Panel finds that the Complainant has established long standing intellectual property rights in the trademarks ‘LEGO’ and ‘LEGOLAND’ in numerous jurisdictions including in Hong Kong where the Respondent is based and operates from. See in support a previous decision in *LEGO Juris A/S v. Michael Lingo*, WIPO Case No. D2008-1715, amongst numerous other decisions, affirming the worldwide fame and reputation of the Complainant’s trademarks. The Panel is also satisfied that on a careful comparison of the disputed Domain Name <LEGOLAND.COM.HK> with the Complaint’s trademarks, as aforesaid, one finds undoubtedly, that the disputed Domain Name is clearly identical or confusingly similar to the Complainant’s trademarks and indeed the Complainant’s numerous other domain names as listed in Annex 7 attached to these proceedings.

1.2) The Panel finds that the disputed Domain Name wholly incorporates the Complainant’s trademarks be it ‘LEGO’ or ‘LEGOLAND’ and as found and held in previous UDRP decisions the fact that the disputed Domain Name includes the generic top level domain “. com” and the country abbreviation “. HK” does absolutely nothing to prevent a finding of identical or confusing similarity. See in support previous decisions cited by the Complainant namely, *WhatsApp Inc.v. GOIP Holdings Limited, supra* and *Mattel, Inc. v. Kristopher –Kent Harris, supra*.

1.3) For the sake of completeness the Panel rejects entirely, the assertion made by the Respondent in its defence to the effect that the disputed Domain Name does not contain any trademark and or content relating to the Complainant. The Panel finds that by reason of incorporation of the Complainant’s trademarks the disputed Domain Name is confusingly similar and or identical, therefore the Respondent’s inaccurate assertion in that regard is wholly unsustainable.

1.4) Accordingly, the Panel finds that the requirements of paragraph 4(a)(i) of the Policy have been satisfied by the Complainant.

**(2). Rights or Legitimate Interests of Respondent**

2.1 The Panel in addition finds that the Respondent is not a licensee of, or authorized dealer of, or is it in any way affiliated to, the Complainant such as to infer that the Respondent has any rights or legitimate interests in the disputed Domain Name. In this regard, the Panel further finds that the Respondent has failed to provide any evidence to demonstrate that it is commonly known by, or has been making a *bona fide* use of the disputed Domain Name in connection with the offering of goods or services or has been making a legitimate non – commercial or fair use of the disputed Domain Name. In the circumstances, the Panel finds the website printouts of the Respondent’s website confirms unauthorized usage on the part of the Respondent. As found in *WhatsApp Inc v. GOIP Holdings Limited, supra* following generally *Oki Data Americas Inc. v. ASD Inc.*, WIPO Case No. D2001-0903; unauthorized usage can never be described as a *bona fide* offering of goods and services nor a legitimate non-commercial or fair use of the disputed Domain Name.

2.2 The Respondent has sought to argue that it is entitled to add the abbreviation LEG to its slogan “One –stop Language Advancement and Development” (OLAND) and is therefore entitled to the ultimate right to operate the LEG website with the disputed Domain Name <LEGOLAND.COM.UK>. As correctly asserted by the Complainant, an abbreviation or a name that incorporates a registered trademark does not automatically confer legitimate rights in that name, see *PepsiCo, Inc.v. “null” aka Alexander Zhavoronkov, supra*, where the respondent in that case who owned a company named “Precise Electronic Positioning Systems International Inc.” was found not to have legitimate rights in the disputed domain name <pepsi.biz> even though it was alleged to be an abbreviation of the respondent’s registered company name.

2.3) In view of the foregoing the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

(3). **Bad faith**

3.1) Finally on the question of bad faith use and registration, the Panel finds that the Respondent undoubtedly registered the disputed Domain Name in bad faith and has continued to engage in bad faith use. There are clearly a considerable number of factors that have enabled the Panel to so conclude. In the first instance, considering the world-wide fame and reputation of the Complainant's trademarks in numerous countries and in Hong Kong where the Respondent is based and operates from, the Respondent knew or ought to have known of the Complainant's prior and extensive exclusive rights in both the LEGO and LEGOLAND trademarks clearly registered in Hong Kong as far back as 1992 and 2011, respectively. According to the WhoIs Data base the Respondent decided to register the disputed Domain Name on March 14, 2014, the Panel therefore concludes that the Respondent intentionally registered the disputed Domain Name with full knowledge of the presence of the Complainant's trademarks and exclusive rights in Hong Kong and with the intention of exploiting the Complainant's goodwill in those trademarks following *WhatsApp Inc. v. GOIP Holdings Limited, supra* and *Arena Pharmaceuticals GMBH v. Qi Fei Gao*, Case No DHK -1300094.

3.2) Secondly, as contended by the Complainant, the Respondent has attempted to use the disputed Domain Name to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship affiliation or endorsement of that website. Undoubtedly, such conduct on its own is tantamount to clear evidence of bad faith use. See *Philip Morris Inc. v. Alex Tsyarkin, supra* cited by the Complainant. But the Respondent's response in its defence, is that it's website is used purely for selling education tours with a completely different look and feel and that there is a disclaimer on the Respondent's website. The Panel finds no merit whatsoever in these responses from the Respondent, for alleged inactivity as purportedly claimed by the Respondent and or the existence of a disclaimer as further claimed by the Respondent does not cure bad faith use. See paragraph 3.5 of the 2<sup>nd</sup> Edition of *WIPO Overview of selected UDRP Questions*, where it is stated as follows:

*“ The existence of a disclaimer cannot cure bad faith, when bad faith has been established by other factors. A disclaimer can also show that the respondent had prior knowledge of the complainant's trademark. However a disclaimer is sometimes found to support other factors indicating good faith or legitimate interest. ”*

The Panel in this particular case has not seen any evidence from the Respondent that demonstrates good faith use or legitimate interest. See also in this regard the decision in *AARC Inc. v. Jayashankar Balaraman*, WIPO Case No. D2007-0578.

3.3) Thirdly, the Panel has drawn grave adverse inferences from the Respondent's refusal to voluntarily transfer the disputed Domain Name to the Complainant upon receipt of the cease and desist letter in April 2014. The Panel finds that such refusal to voluntarily transfer the disputed Domain Name, in conjunction with the Respondent's latter demand from the Complainant for evidence of infringement and the Respondent's request for the recall of the cease and desist letter all amount to further evidence of continuing bad faith use. The Respondent's requests as aforesaid, are contained in an email addressed to the Complainant and dated April 12, 2014. See in this regard the decision in *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. D2005-0556 as is relevant to the Respondent's failure to transfer the disputed Domain Name to the Complainant.

3.4) The Panel therefore finds that the Complainant has satisfied the requirements of Paragraph 4(a)(iii) of the Policy.

## **6. Conclusions**

6.1 In the light of the foregoing paragraphs, and in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the disputed Domain Name <LEGOLAND.COM.HK> be transferred to the Complainant in Hong Kong being LEGO Hong Kong Limited.

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<Ike Ehiribe>

Dated: December 2, 2014

