

**REGIONAL CENTRE
FOR ARBITRATION KUALA LUMPUR**



FORM H

**NOTIFICATION OF DECISION BY THE PANEL TO THE
REGIONAL CENTRE FOR ARBITRATION KUALA LUMPUR**

1. DETAILS OF THE CASE: Lego Juris A/S v Natah Media

CASE NUMBER: rca/dndr/2009/18

DISPUTED DOMAIN NAME(S): www.legoland.com.my and www.legoland.my

CASE ADMINISTRATOR: Olivia Tan Swee Leng

PARTIES NAME:

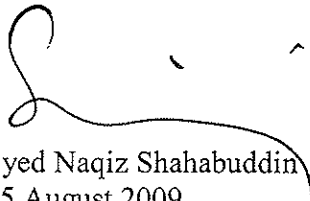
a) Complainant: Lego Juris A/S

b) Respondent: Natah Media

2. NAME OF PANELLIST(S):

Syed Naqiz Shahabuddin

Pursuant to Rule 17.3, the Panel hereby forwards its decision for the above-referenced case.

Signature : 
Name of Panellist(s) : Syed Naqiz Shahabuddin
Date : 25 August 2009

ADMINISTRATIVE PANEL DECISION

In the matter of

Between

Lego Juris A/S (Complainant)

And

Natah Media (Respondent)

Case No: rca/dndr/2009/18

1. The Parties

The Complainant is Lego Juris A/S of Billund, Denmark. For the purposes of local presence requirements, the Complainant has also identified a local presence registrant, IP Mirror Sdn Bhd.

The Respondent is Natah Media of Perak, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <legoland.com.my> and <legoland.my> are registered with MYNIC Berhad.

3. Procedural History

The Complaint was filed with the Kuala Lumpur Regional Centre for Arbitration (the "Center") on May 11, 2009. On May 12, 2009, the Center conducted a verification exercise in connection with the domain names and confirmed that the Respondent is listed as the registrant. The Center verified that the Complaint satisfied the formal requirements of the MYNIC Domain Name Dispute Resolution Policy (the "Policy"), the MYNIC Rules for Domain Name Dispute Resolution Policy (the "Rules"), and the Kuala Lumpur Regional Centre for Arbitration's Supplemental Rules to MYNIC's Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 5.2 and 5.3, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 14, 2009. In accordance with the Rules, paragraph 6.1, the initial due date for Response was June 4, 2009. However, there was a request for temporary suspension of the proceedings. The proceedings were subsequently re-initiated on July 9, 2009 with a revised due date of July 30, 2009 for the Response. The Respondent did not submit a response.

The Center appointed Syed Naqiz Shahabuddin as the sole panelist in this matter on August 6, 2009. The Panel finds that it was properly constituted. The Panel has submitted the Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 9.3.

4. Factual Background

The following summary sets out the uncontested factual submissions made by the Complainant:

- 4.1 The Complainant, based in Denmark, is the owner of the trademark LEGOLAND and all other trademarks used in connection with the LEGO brand of construction toys and other LEGO branded products.
- 4.2 The Complainant and its licensees (the "LEGO Group"), through their predecessors, commenced use of the LEGO mark in the United States of America during 1953, to identify construction toys made and sold by them. The growth of the business with sales of LEGO construction toys in the United States of America alone, exceeded \$1 billion over the last 10 years.
- 4.3 The LEGO Group has procured the registration of many variations of the LEGO trademark on a worldwide basis. Although the LEGOLAND parks are today owned by Merlin Entertainments (in which the LEGO Group owns 20%), all rights to the trademark LEGOLAND are still owned by the LEGO Group, including the trademark LEGOLAND in Malaysia.
- 4.4 The Complainant is also the owner of more than 100 domain names containing the term LEGOLAND, among them, legolandmalaysia.com.my and legolandmalaysia.my.
- 4.5 The Respondent registered the domain names in dispute on December 5, 2008, which is subsequent to the vast majority of the trademark registrations of LEGOLAND in the world including Malaysia. The domain names in dispute were registered in the same year and month after the news that the LEGOLAND theme park in Malaysia, which will be ready in 2013, was made public.
- 4.6 The Complainant first tried to contact the Respondent on January 9, 2009 through a cease and desist letter. On January 29, 2009 the Respondent replied saying that it had just started a web project for the disputed domain names and was going to discuss with Mr Raymond, who the Complainant understood it, is a partner/colleague with the Complainant. The Complainant replied the same day informing the Respondent they are the only ones to grant permission for use of the domain names and explained that the domain names had to be transferred to the Complainant. On February 5, 2009, the Respondent reverted saying that they were going to have a meeting with Mr Raymond and would get back later the same day. The next day, on February 6, 2009, the Respondent came back stating that he is an authorised reseller of LEGO products in Malaysia since 2003, which the Complainant contends is false. Further, the Respondent stated that it could let go of the domain names if compensated with \$2000. The Complainant replied and referred to the LEGO Group's fair play policy and explained that they could only reimburse the Respondent for the registration fees the Respondent had incurred. The Complainant did not receive a response from the Respondent. A reminder was sent on March 5, but still no response was forthcoming whereupon

the Complainant issued an email on March 24, informing the Respondent that it would bring the matter for dispute resolution in accordance with the Policy and offered USD500 to settle the matter amicably.

- 4.7 The domain names in dispute are currently connected to parked websites and no content has been placed at these sites since the domain names were registered.
- 4.8 The Respondent has not been licensed or authorised by the Complainant to use the trademark LEGOLAND and neither has the Respondent any business relationship with the Complainant.

5. Parties' Contentions

5.1 Complainant

- (a) The Complainant asserts that the mark LEGOLAND is in possession of substantial inherent and acquired distinctiveness and is a famous trademark worldwide with substantial and widespread reputation and goodwill. The Complainant contends that the disputed domain names <legoland.com.my> and <legoland.my> are identical to the Complainant's LEGOLAND trademark for the following reasons:-
 - (i) the domain names contain the Complainant's trademark as its dominant feature.
 - (ii) the inclusion of the ccTLDs ".my" and ".com.my" are inconsequential when determining similarities between domain names and trademarks.
- (b) The Complainant further contends that the Respondent registered and/or used the domain names in dispute in bad faith and relies on the following:
 - (i) the Respondent is preventing the Complainant from using the domain names in dispute, which are identical to the Complainant's trademark and is consequently disrupting the business of the Complainant. In this regard, the Complainant has not found any evidence to suggest that the Respondent has any legitimate rights or interests to the mark LEGOLAND including any licences or authorisations from the Complainant or the LEGO Group.
 - (ii) the Respondent registered the domain names in dispute with the knowledge about the opening of the LEGOLAND theme park in Malaysia given the timing of the registrations of the domain names which post-dates the public announcement on the opening of the theme parks.
 - (iii) given the notoriety of the LEGO trademark, it is highly unlikely that the Respondent would not have known of the Complainant's legal rights in the name at the time of the registration.
 - (iv) the Respondent is not using the domain names in connection with a bona fide offering of goods or services but is instead seeking to ride on and usurp the Complainant's reputation and goodwill in the mark LEGOLAND. There is no evidence to suggest that the domain names are being used as company names or that the Respondent has any other legal rights in the name

LEGOLAND. On the contrary, the domain names are connected to parked websites.

- (v) the Respondent sought to sell the domain names in dispute to the Complainant for an amount far exceeding its out of pocket expenses.

5.2 Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 17 of the Rules instruct the Panel to decide the proceedings based on the documents and evidence submitted by the Parties, the Policy and the Rules as well as any other rules or principles of law which are applied in Malaysia.

Paragraph 5.2 of the Policy provides that the Complainant must establish BOTH of the following elements in the Complaint:

- (i) the domain name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (ii) the Respondent has registered and/or used the domain name in bad faith.

6.1 Identical or Confusingly Similar Trade Mark

The various trademark and domain name registrations and the evidence of reputation and goodwill adduced by the Complainant, amply evidences the Complainant's rights to the mark LEGO and its variation LEGOLAND in various countries. In fact, in Malaysia, the Complainant is the registered proprietor of the LEGOLAND service mark in Class 41 (registration No: 97019211) which covers the following services:

"theme park and amusement park services; entertainment services in the nature of providing facilities for playing computer games; educational services provided for children and for teachers of children; arranging and conducting workshops; entertainment services in the nature of providing exhibitions of models made of toy building elements, conducting model building contests and organising clubs featuring the building models; publication of books, magazines, manuals and texts; production of radio and television programmes, video tapes, sound recordings, cd-roms and of cine films; all included in class 41."

The domain names in dispute are phonetically and visually identical to the mark LEGOLAND as they incorporate the Complainant's mark in its entirety. The addition of g TLDs or ccTLDs are inconsequential when determining whether a domain name in dispute is identical or confusingly similar to a trademark. This is a well established principle in domain name disputes (see *Ticketmaster Corporation v Discover net, Inc.*, WIPO Case No: D2001-0252; *The Channel Tunnel Group Ltd v John Powell*, WIPO Case No: D2000-0038). If it were otherwise, then the opportunity for domain name dispute resolution would be lost as almost all domain names require such descriptive suffices to operate in the context of the worldwide web.

Accordingly, this Panel concludes that the domain names in dispute are identical to the Complainant's LEGOLAND mark and is satisfied that the first element of paragraph 5

of the Policy has been proven by the Complainant.

6.2 Registration and/or Use in Bad Faith

Having reviewed the evidence adduced by the Complainant, the Panel could not find any justifiable link between the Respondent and the LEGOLAND mark. As in *Volkswagen Group Singapore Pte Ltd v Webmotion Design Case*, RCAKL Case No: rca/dndr/2003/01(int), this Panel finds that the Respondent was not commonly known by the domain names in dispute and was not a licensee of the Complainant or was otherwise authorised to use the Complainant's trademark. In the absence of a justifiable link, the Panel is unable to conclude that the Respondent has legitimate rights to the domain names or whether it is using the domain names for a bona fide or legitimate purpose (see *Chinatrust Commercial Bank, Ltd. And Chinatrust Bank (USA) v China Holding Company, Incorporated*, WIPO Case No: D2001-0826; *Guerlain S.A. v Peikang*, WIPO Case No: D2000-0055; *Dr. Ing.h.c. F. Prosche AG v Ron Anderson*, WIPO Case No: D2004-0312).

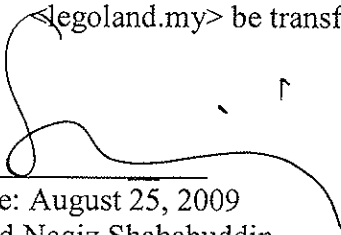
The absence of such a link suggests that the LEGOLAND mark was calculatively selected by the Respondent to form the domain names in dispute in order to disrupt the Complainant's preparations and/or operations of a LEGOLAND theme park in Malaysia, scheduled for opening in 2013. As contended by the Complainant, it is highly probable that the intent of the Respondent in registering the domain names, which post-dates the registration of the Complainant's trademarks in Malaysia and coincided with the public announcement of the opening of the theme parks in Malaysia, was to extract some form of direct or indirect commercial gain or to otherwise ride on the established goodwill of the Complainant. Evidence of direct and indirect commercial gain was also led by the Complainant in the form of an email from the Respondent to the Complainant on February 6, 2009 whereby:

- (i) a request was made by the Respondent for the sum of \$2000 as compensation for the expenses incurred by the Respondent. This amount far exceeds the out-of-pocket expenses incurred for registering a ".my" domain name; and
- (ii) a solicitation was made by the Respondent to the Complainant to provide website design services to support legoland club forums and blogs for the local community.

Accordingly, the Panel is also satisfied that the second element of paragraph 5 of the Policy has been satisfactorily proven by the Complainant in that the domain names in issue were registered and used in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 12 of the Policy and 17.1 of the Rules, the Panel orders that the domain names, <legoland.com.my> and <legoland.my> be transferred to the Complainant.


Date: August 25, 2009
Syed Naqiz Shahabuddin
Sole Panelist