

World Trademark Review Daily

Well-known marks may be used in domain names provided that use is not abusive **Cybersquatting Netherlands - Matheson Ormsby Prentice**

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In *LEGO Juris A/S v Stichting RIBW ZWWF* (WIPO Case DNL2011-0042), a WIPO panel has ruled that a non-profit organisation that sells models made from second-hand Lego products had a right or legitimate interest in the domain name 'gebruiktlego.nl', which translates as 'used Lego' in English.

The respondent, a not-for-profit mental healthcare organisation set up to help people with autistic spectrum disorder, had members construct Lego models from second-hand Lego pieces, which it then sold through its website at 'gebruiktlego.nl'. The **LEGO Group**, the owner of the well-known LEGO mark, brought this complaint under the '.nl' domain name dispute resolution policy, which is equivalent to the **Uniform Domain Name Dispute Resolution Policy** (UDRP), except that it does not have a conjunctive requirement in its third element.

The panel had no difficulty in finding confusing similarity on the basis that the addition of the term '*gebruikt*' did not prevent an association with the complainant in internet users' minds. Of more interest was its analysis on the second limb of the relevant test - that is, whether the respondent had "no rights or legitimate interests" in the domain name.

The panel noted that the outcome of the case would depend on the answer to the following question: whether "an entity can resell genuine trademarked goods for which the trademark rights are exhausted and use a domain name that incorporates an unauthorised use of such trademark for that purpose".

The majority view, as set out at Paragraph 2.3 of the **WIPO overview of WIPO Panel Views on Selected UDRP Questions, Second Edition**, is that a reseller can make a good-faith offering of goods and services and thus have a legitimate interest in a domain name if the use meets the *Okidata* criteria, as set out in *Okidata Americas Inc v ASD Inc* (WIPO Case D2001-0903). The panel observed that these criteria have generally been considered by past panels as applying whether the respondent is an authorised distributor or not.

While the domain name 'gebruiktlego.nl' wholly incorporated the complainant's trademark, the panel noted that it also featured the term '*gebruikt*', which it found to be a term that was intended to distinguish and, in fact, did distinguish, the domain name from the complainant's LEGO mark. In applying the *Okidata* factors, the panel went on to look at the use actually made of the domain name and the nature of the website that operated from it, to see whether the registration and/or use was abusive under the UDRP.

The panel found that the respondent was offering only Lego products on the site and that there was no evidence of an attempt to corner the market in domain names incorporating the LEGO mark. While factors 1, 2 and 4 were therefore met, there was no express disclaimer on the website in terms of factor 3. In this regard, the panel considered that it could not be said that the website would somehow create the impression of a commercial connection between the parties, as it did not use any LEGO figurative mark. Further, it contained nothing which might suggest that the respondent was an official reseller, that some kind of special relationship existed between the parties, or that the products were being sold by the complainant rather than by the respondent. As a result, the panel found that the complainant had not presented any evidence that would undermine the good-faith nature of the respondent's use and that the respondent thus had a legitimate interest in the domain name.

Although referring to relevant principles of European trademark law, the panel's approach was firmly grounded in UDRP principles and is consistent with the decision in *Research in Motion Limited v One Star Global LLC* (WIPO Case D2009-0227). The fact that the panel ultimately denied relief, by contrast with the transfer granted in the *Research in Motion* case, is a result of differing factual scenarios.

While trademark owners may not approve, these decisions underline the reality that, under the UDRP and equivalent policies, even well-known marks may be used with impunity as part of a domain name, provided always that such use is not abusive. Following these cases, the position has moved definitively beyond the limited context of legitimate non-commercial criticism sites, as found, for example, in the various 'sucks' cases, or in *Covance Inc v The Covance Campaign* (WIPO Case D2004-0206). In theory, any trademark could be incorporated together with an adequate distinguisher into a domain name, even where intended for commercial use, provided always that a panel would not conceive of such use as being abusive. In practice, however, the type of cases that will fall into this category is likely to be limited to commercial reseller cases, whether the reseller is authorised or not, but in which no products other than the trademark owner's are being sold from the respondent's website.

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