

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Privacy service provided by Withheld for Privacy ehf /
Nguyen Vu, Timo Digital
Case No. D2022-1733

1. The Parties

The Complainant is LEGO Juris A/S, Denmark, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Nguyen Vu, Timo Digital, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <secondlego.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 12, 2022. On May 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 16, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 17, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 8, 2022.

The Center appointed Andrew F. Christie as the sole panelist in this matter on June 17, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant's business is the making and selling of LEGO-branded toys. It is based in Denmark and has subsidiaries and branches throughout the world. The Complainant's LEGO products are sold in more than 130 countries, including Viet Nam. In 2019, Superbrands UK listed LEGO as the number one Consumer Superbrand and number eight in the Consumer Relevancy Index.

The Complainant and its related entities are the owner of numerous trademark registrations throughout the world for the trademark LEGO. The Complainant is the owner of Viet Nam Trademark Registration no. 4-0013197-000 (registered on September 1, 1994) for a stylized LEGO trademark; and Lego GmbH is the owner of International Trademark LEGO no. 287932 (registered on August 27, 1964, and protected especially in Viet Nam) for the word trademark LEGO.

The Complainant is the owner of close to 5,000 domain names containing the term "lego".

The disputed domain name was registered on August 25, 2021. The Complainant has provided undated screenshots showing that the disputed domain name resolved to a website that purportedly offered the Complainant's LEGO products for sale under the heading "Used Like New SecondLego – With Better Price". At the time of this decision, the disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The dominant part of the disputed domain name comprises the term "lego", identical to the Complainant's registered trademark LEGO, whose fame has been confirmed in numerous previous UDRP decisions. In addition to the trademark LEGO, the disputed domain name contains the preceding word "second", which does not diminish the confusing similarity between the disputed domain name and the Complainant's trademark. The addition of the generic Top-Level Domain ("gTLD") ".com" is irrelevant in determining the confusing similarity between the trademark and the disputed domain name. With reference to the reputation of the trademark LEGO, there is a considerable risk that the trade public will perceive the disputed domain name either as a domain name owned by the Complainant, or that there is some kind of commercial relationship with the Complainant. By using the trademark as a dominant part of the disputed domain name, the Respondent exploits the goodwill and image of the Complainant's trademark, which may result in dilution and other damage for the trademark.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. Neither has the Complainant found anything, including in the Whois details, that would suggest that the Respondent has been using the term "lego" in any other way that would give them any legitimate rights in the disputed domain name. No license or authorization of any other kind has been given by the Complainant to the Respondent to use the LEGO trademark. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. The Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through an unauthorized website offering LEGO products. There is no visible disclaimer stating that the website is not endorsed or sponsored by the Complainant, to explain the non-existing relationship with the trademark

holder. Instead, the website resolving from the disputed domain name uses a logo that looks like a LEGO brick and features images of LEGO products, including many boxes that also display the Complainant's logo. The Respondent's "About Us" page implies that it is an authorized distributor, who takes pride in offering "better prices than the market", even though it is not an authorized reseller. The Respondent's use of the disputed domain name does not satisfy the criteria set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The Complainant made the following contentions to establish that the disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name on August 25, 2021, decades after the Complainant registered the trademark LEGO in Viet Nam, where the Respondent presumably resides. It is obvious that the fame of the trademark has motivated the Respondent to register the disputed domain name. The disputed domain name is currently connected to an unauthorized commercial website offering LEGO products, with the Complainant's logo prominently displayed on the website, within its images of LEGO products. Consequently, the Respondent is using the disputed domain name to intentionally attempt to attract Internet users to a website for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. There is no connection between the Respondent and the Complainant. By using the disputed domain name the Respondent is not making a legitimate noncommercial or fair use, but is misleadingly diverting consumers for his own commercial gain. The Respondent has been involved in another case under the Policy, suggesting a pattern of cybersquatting. The Respondent, at the time of the initial filing of the complaint, had employed a privacy service to hide its identity, which past panels have held serves as further evidence of bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Once the generic Top-Level Domain ("gTLD") ".com" is ignored (which is appropriate in this case), the disputed domain name consists of the textual component of the Complainant's stylized LEGO trademark, preceded by the word "second". The Complainant's trademark is clearly recognizable within the disputed domain name. The addition of the word "second" does not avoid a finding of confusing similarity of the disputed domain name with the trademark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its LEGO trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name. The evidence provided by the Complainant shows that the disputed domain name has been used to resolve to a website displaying the LEGO name and trademark, and purporting to offer the Complainant's LEGO products for sale. The contents of the website are such that many Internet users will form the false belief that the website is affiliated with the Complainant. Given the confusing similarity of the disputed domain name to the Complainant's trademark, the absence of any relationship between the Respondent and the Complainant, and the failure to avoid the implied false affiliation with the Complainant, the Respondent's use of the disputed domain name is neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The disputed domain name was registered many decades after the Complainant first registered its LEGO trademark. It is inconceivable that the Respondent registered the disputed domain name ignorant of the existence of the Complainant's trademark, given the renown of the Complainant's trademark, that the disputed domain name consists of the Complainant's trademark merely preceded by the word "second", and that the Respondent used the disputed domain name to resolve to a website that displays the Complainant's LEGO trademark and purports to sell the Complainant's products in a "like-new" condition at "better prices than the market".

Given the Respondent's lack of rights or legitimate interests in the disputed domain name and the confusing similarity of the disputed domain name to the Complainant's trademark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain name in these circumstances is a bad faith registration.

Furthermore, the evidence on the record provided by the Complainant indicates that the Respondent has used the disputed domain name in an attempt to attract, for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainant. The Respondent's use of the disputed domain name in this manner is a bad faith use.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <secondlego.com>, be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: July 1, 2022