

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Privacy Service Provided by Withheld for Privacy ehf /  
Charles Semaan  
Case No. D2022-1989

### **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 / Charles Semaan, Lebanon.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2022. On June 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 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 June 3, 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 June 6, 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 June 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2022. The Respondent sent email communications to the Center on June 6, 2022, but did not submit any formal response. On July 1, 2022, the Center informed the Parties that it will proceed to panel appointment.

The Center appointed Luca Barbero as the sole panelist in this matter on July 6, 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 was founded in Denmark in 1932 and is one of the world's leading manufacturers of play materials. The use of the trademark LEGO has expanded in time to, *inter alia*, computer hardware and software, books, videos, and computer controlled robotic construction sets. In 2014, Time magazine announced LEGO to be the Most Influential Toy of All Time. In 2019, the Complainant was awarded the first place in the official Top 10 Consumer Superbrands, and number eight in the Consumer Relevancy Index.

In 2020, the Reputation Institute recognized the LEGO Group as number one on its list of the world's Top 10 Most Reputable Global Companies after the Complainant had been on this top 10 list for ten consecutive years. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Lebanon.

The Complainant is the owner of a large number of trademark registrations for LEGO, including the following:

- Lebanon trademark registration no. 62805 for LEGO (word mark), registered on March 11, 1994, in International class 28;
- Lebanon trademark registration No. 61467 for LEGO (figurative mark), registered on September 2, 1993 in International class 28.

The Complainant is also the owner of thousands of domain names containing the term LEGO, including <lego.com>, registered on August 22, 1995, which is used by the Complainant to promote its products under the trademark LEGO online.

The disputed domain name <legopop.art> was registered on October 20, 2021 and is pointed to a parking page with pay-per-click ("PPC") links some of which are related to the Complainant and its products.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to the trademark LEGO in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term "pop" and the generic Top Level Domain (gTLD) ".art".

The Complainant asserts that, combining its trademark LEGO with the term "pop" and the gTLD ".art" may actually increase the likelihood of confusion with the Complainant, since the Complainant produces and markets LEGO Art Sets, including iconic pop art images such as Andy Warhol's Marilyn Monroe.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name, since he is not commonly known by the disputed domain name and has in no way been licensed or authorized by the Complainant to use the trademark LEGO in any way.

The Complainant also highlights that, considering the content of the webpage to which the disputed domain name resolves, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services but, instead, has intentionally selected a domain name based on the Complainant's trademark in order to generate traffic to his commercial website, benefiting from the Complainant's world famous trademark.

With reference to the circumstances evidencing bad faith, the Complainant contends that the Respondent registered the disputed domain name due to the well-known character of the Complainant's trademark LEGO and highlights that the disputed domain name was registered years after the Complainant registered the trademark LEGO in Lebanon, where the Respondent is based.

The Complainant emphasizes that it first tried to contact the Respondent via a cease-and-desist letter sent by email, advising the Respondent that the unauthorized use of the trademark LEGO within the disputed domain name violated the Complainant's rights in said trademark. The Complainant thus requested a voluntary transfer of the disputed domain name and offered compensation for the expenses of registration and transfer fees, not exceeding the out-of-pocket expenses. The Respondent confirmed his awareness of the trademark LEGO but declined to cooperate, demanding payment in exchange of the disputed domain name and claiming to have registered "legopopart" as a trademark in Lebanon. The Complainant was unable to verify the existence of such a trademark registration and despite numerous emails the Respondent failed to provide any documentary evidence of such a trademark application or registration. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file the Complaint.

The Complainant underlines that the Respondent is using the disputed domain name to intentionally attempt to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of his website.

The Complainant concludes that the Respondent was undoubtedly aware of the rights the Complainant has in the trademark LEGO and of the value of said trademark when registering the disputed domain name and that, considering there is no connection between the Respondent and the Complainant, the Respondent was acting in bad faith to misleadingly divert consumers for commercial gain.

## **B. Respondent**

The Respondent did not file a formal Response but sent an informal email communication to the Center, on June 6, 2022, in which he denied all the Complainant's allegations, stating that i) the Complainant wrote the disputed domain name with the LEGO trademark in capital letters in its Amended Complaint to emphasize on the word instead of writing the disputed domain name in full capital or minimal letters; ii) the gTLD ".art" in which the disputed domain name is registered plays an important role as many brands are using it as part of their name; iii) the Respondent filed a trademark – in an undisclosed jurisdiction – which would grant him protection based on prior use and irrespective of having a registered trademark or not; and iv) the only settlement he would accept would be for the Complainant to purchase the disputed domain name and any other takeover of the disputed domain name would result in further legal action against any entity involved.

## **6. Discussion and Findings**

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

## **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has established rights over the trademark LEGO based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as Annex 3 to the Complaint.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain names to assess whether the trademark is recognizable within the disputed domain names (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Moreover, where the relevant trademark is recognizable within the disputed domain name, the addition of a descriptive or other term does not prevent a finding of confusing similarity under the first element (section 1.8 of the [WIPO Overview 3.0](#)).

In the case at hand, the Panel finds that the disputed domain name is confusingly similar to the trademark LEGO as it reproduces the trademark in its entirety with the mere addition of the word "pop", which does not prevent a finding of confusing similarity. Moreover, the gTLD ".art" can be disregarded when comparing the similarities between a domain name and a trademark (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy for the following reasons.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent, might be commonly known by the disputed domain name.

Indeed, in his informal communication to the Center, the Respondent does not mention the reason for which he registered the disputed domain name, but only claims he owns trademark rights and asserts to have applied for the registration of the trademark "legopopart", failing to provide any proof to substantiate his allegations.

In addition, as shown in Annex 8 to the Complaint and confirmed by the Panel's review of the website to which the disputed domain name resolves, the disputed domain name is pointed to a parking page with commercial links some of which are clearly associated to the Complainant. As stated in section 2.9 of the

[WIPO Overview 3.0](#), “the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users”.

In view of the above, the Panel finds that the Respondent’s use of the disputed domain name does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. Moreover, the Respondent’s use of the disputed domain name is, and has been, clearly commercial in nature, as the Respondent has clearly aimed at gaining revenues from the sponsored advertisements published on the parking page to which the disputed domain name resolves.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to bad faith at the time of the registration, the Panel finds that, in light of i) the prior registration and use of the Complainant’s trademark LEGO in connection with the Complainant’s products, ii) the well-known character of the trademark, recognized also in a number of prior panel decisions and iii) the clear confusing similarity of the disputed domain name with the Complainant’s trademark, the Respondent registered the disputed domain name having the Complainant’s trademark in mind.

Furthermore, the Panel notes that the disputed domain name is pointed to a parking page where the Complainant’s trademark is referenced and where sponsored links related to the Complainant’s products are displayed, a circumstance which further indicates that the Respondent was aware of the Complainant’s trademarks.

Moreover, in view of the well-known character of the Complainant’s trademark, the Panel finds that the Respondent acted in opportunistic bad faith at the time of registration, since the disputed domain name is so obviously connected with the Complainant that its very selection by the Respondent, who has no connection with the Complainant, suggests the disputed domain name was registered with a deliberate intent to create an impression of an association with the Complainant.

In light of the above-described redirection of the disputed domain name, the Panel finds that the Respondent intentionally attempted to attract Internet users to his website for commercial gain, by causing a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation or endorsement of his website, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) of the Policy.

## **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 <legopop.art> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: July 21, 2022