

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Mr. Rahul, Bhatia General Contracting Company LLC Case No. D2022-4207

1. The Parties.

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

The Respondent is Mr. Rahul, Bhatia General Contracting Company LLC, United Arab Emirates (“UAE”).

2. The Domain Name and Registrar

The disputed domain name <legoprecast.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 7, 2022. On November 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 November 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 1, 2022. The Respondent did not submit a formal response, however it sent email communications to the Center on November 17, December 10, and December 17, 2022. The Center informed the Parties that it will proceed to panel appointment on December 6, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on December 13, 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 is LEGO Juris A/S, a worldwide known toymaker. LEGO branded products are marketed and sold for decades in more than 130 countries worldwide, through authorized licensees.

The Complainant expanded its use of the LEGO mark to, *inter alia*, computer hardware and software, books, videos and computer controlled robotic construction sets.

The Complainant holds numerous trademark registrations for LEGO, such as the following:

- the UAE trademark registration No. 8265, filed on October 26, 1994 and registered on May 14, 1997 for goods in class 28; and

- the United States of America trademark No. 1018875 filed on September 17, 1974 and registered on August 26, 1975 for goods in class 28.

The LEGO trademark is among the best known trademarks in the world, its well-known status being acknowledged by numerous tops and rankings, such as the Consumer Superbrands 2019 listing LEGO to various category winners; the Reputation Institute listing the Complainant as the number one brand of the list of world's Top 10 Most Reputable Global Companies of 2020 and applauded the Complainant's strong reputation having been on its top 10 list for ten consecutive years; as well as by numerous previous UDRP proceedings involving the Complainant.

The Complainant owns close to 5,000 domain names incorporating the mark LEGO, the main one being <lego.com>.

The disputed domain name was registered on March 28, 2017 and, at the time of filing the Complaint, it resolved to a website which promoted precast concrete manufacturing and property construction services.

From the Complainant's searches provided as Annex 9 to Complaint, it results that the Respondent holds a trade name in Dubai for "Lego Precast Manufacturing L.L.C."

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its well-known trademark LEGO, the Respondent has no rights or legitimate interests in the disputed domain name, and the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

On November 17, 2022, the Center received an email communication from the Respondent asking the case file documents. Further, on December 10, 2022, a third party using the email address corresponding to the disputed domain name, [...]@legoprecast.com, sent another email communication stating that it does not recognize the UDRP procedure as it did not sign any arbitration agreement, its activity is different from the Complainant's business and "Third and finally: As a gesture of goodwill on our part and to avoid any dispute between the parties, we request you to hold the matter for 10 working days from this e-mail to change our domain name and stop using the disputed domain name".

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

6. Discussion and Findings

In view of the absence of a formal Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

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

The Panel will further analyze the potential concurrence of the above circumstances.

The Panel moreover notes that the Registrar has confirmed that the disputed domain name is subject to the UDRP via its registration agreement with the Respondent.

A. Identical or Confusingly Similar

The Complainant holds rights in the LEGO trademark.

The disputed domain name incorporates the Complainant's trademark LEGO with an additional suffix, "precast". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether descriptive pejorative, meaningless or otherwise) to trademarks in a domain name is not sufficient to prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the Top-Level Domain ("TLD") (e.g., ".com", ".org", ".net") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark LEGO, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license, or authorization whatsoever to use the mark LEGO, that the Respondent is not commonly known by the disputed domain name and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element". See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant found that the Respondent holds a trade name in Dubai, incorporating its LEGO trademark. However, the disputed domain name was registered in the name of another entity and, having in view the significant reputation of the Complainant's mark, the fact that the Respondent has not come forward with relevant evidence to demonstrate its rights or legitimate interests in the disputed domain name, and based on all the other circumstances of this case – the Respondent does not claim for example that the term

“lego” would be an acronym wholly unrelated to the Complainant (and if it did, this would be a claim treated with care or even suspicion), it is more likely than not that the trade name was registered in an deceiving attempt to legitimize the Respondent’s use of the LEGO mark.

In the second communication received by the Center in the name of the Respondent, the Respondent claims (as an apparent act of “goodwill”) that it will cease from using the disputed domain name. This, together with all the other evidence in this case, amounts with an acknowledgement of its bad faith behavior. Further, when the Panel visited the webpage under the disputed domain name, its content was not changed nor removed.

In addition, and without prejudice to the above, the nature of the disputed domain name, comprising the Complainant’s well-known trademark in its entirety in combination with other terms, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds trademark rights for LEGO since at least 1964. Due to its extensive use and marketing, the LEGO trademark has become highly distinctive and among the best known trademarks in the world.

The disputed domain name was created in 2017 and incorporates the Complainant’s mark with an additional suffix “precast”. Further, the Respondent is using the disputed domain name, incorporating the Complainant’s world-famous trademark for construction toys for promoting the Respondent’s concrete manufacturing and construction services.

For the above, the Panel finds that the disputed domain name was, most likely, registered in bad faith, knowing the Complainant and targeting its trademark.

The Respondent is using without permission the Complainant’s well-known trademark in order to get traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant’s trademark in the disputed domain name and the lack of any disclaimer on this website.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt “to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location” is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant’s trademark and the website operated under the disputed domain name display the Complainant’s trademark and has no disclaimer, indeed in this Panel’s view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain. Even if the Respondent nominally targets a different group of customers than the Complainant, it is obvious to the Panel that the Respondent intentionally attempted to freeride on the goodwill of the Complainant’s famous LEGO trademark and, hence, to create a likelihood of confusion among customers.

The Complainant’s trademark is well-known worldwide for decades and there is no plausible logic for the Respondent to choose and register such name other than to create confusion or association with the Complainant and its LEGO mark.

Furthermore, it has been consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <legoprecast.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: December 27, 2022