

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Ryan Dirks, Royal Enterprise Lmtd.
Case No. D2023-0230

1. The Parties

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

The Respondent is Ryan Dirks, Royal Enterprise Lmtd., United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <homealonelego.com>, <homealonelegos.com>, and <legohomealone.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 18, 2023. On January 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 27, 2023, 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 February 1, 2023.

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 February 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2023.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on March 15, 2023. 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 owns Registration No. 1018875 for the mark “LEGO” (word) in Class 28 in the United States since September 17, 1974. The Complainant, based in Denmark, is the owner of LEGO, and all other trademarks used in connection with the Lego brands of construction toys and other Lego branded products. The Complainant has subsidiaries and branches throughout the world, and Lego products are sold in more than 130 countries, including in the United States. The Complainant is the owner of close to 5,000 domain names containing the term “lego”. The Respondent is based in the United States.

According to the Complainant, the mark LEGO has been recognized as No. 1 Consumer Superbrand and included in the Top 10 Consumer Superbrands for 2019, provided by Superbrands United Kingdom, and No. 8 in the Consumer Relevancy Index. The Reputation Institute recognized the Lego Group as No. 1 on its list of the world’s Top 10 Most Reputable Global Companies of 2020, and applauded the Lego Group’s strong reputation, having been on its top 10 list for 10 consecutive years. In 2014, TIME also announced Lego to be the Most Influential Toy of All Time.

The disputed domain names were registered on October 22, 2021, and are resolving to parking pages with sponsored links.

5. Parties’ Contentions

A. Complainant

The Complainant claims that the mark LEGO is entitled to protection as a well-known trademark. The disputed domain names incorporate the term “lego”, identical to the registered trademark LEGO, registered by the Complainant as trademarks and domain names in numerous countries all over the world, including in the United States.

The Complainant also alleges that the disputed domain names are confusingly similar to the Complainant’s world-famous trademark LEGO. The Complainant has relied upon the past WIPO UDRP cases, to emphasize on the fame of the trademark, including the *LEGO Juris A/S v. Michael Longo*, WIPO Case No. [D2008-1715](#) where it was stated that, “The Panel finds, as numerous panels have found before, that the Complainant has established that LEGO is a well-known trademark and that the trademark is distinctive and famous”.

In addition to the trademark LEGO, the disputed domain names also comprise terms “homealone”, which, the Complainant states only serves to underscore and increase the confusing similarity between the disputed domain names and the Complainant’s trademark. The Complainant has stated further that it in fact produces the LEGO® Ideas Home Alone building set.

The Complainant states that there is a likelihood of confusion, including an obvious association with the trademark as well as some kind of commercial relation with the Complainant.

The Complainant states that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services. Instead, the Respondent has intentionally chosen disputed domain names based on a registered trademark in order to generate traffic and income through websites with sponsored links and to mislead Internet users to commercial websites. No evidence has been found that the Respondent uses the name Lego as a company name or has any other legal rights in the name. It is alleged that the Respondent is trying to benefit from the Complainant’s world famous trademark.

The Complainant contends that LEGO is a famous trademark worldwide and that the Respondent was aware of the rights that the Complainant has in the trademark and the value of said trademark, at the point of registration. There is no connection between the Respondent and the Complainant. By using the disputed domain names, the Respondent is not making a legitimate noncommercial or fair use but is misleadingly diverting consumers for commercial gain. The Complainant also issued a Cease & Desist notice and called upon the Respondent to transfer the disputed domain names voluntarily, but the Respondent did not respond.

B. Respondent

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

6. Discussion and Findings

To transfer the disputed domain names from the Respondent, the Complainant must prove the following element as per paragraph 4(a) of the Policy:

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

Paragraph 15(a) of the Rules instructs the Panel to 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."

Further, since the Respondent has not submitted its reply in the case at hand, this Panel finds it appropriate case to "decide the dispute based upon the complaint" as per paragraphs 15(f) read with paragraphs 14(a) and 14 (b) of the Rules.

Having considered the Complainant's case and the evidence available, the Panel finds as follows:

A. Identical or Confusingly Similar

As stated above, the Complainant has established its rights in and to the trademark LEGO (word) and it is the registrant of 5,000 domain names, including <lego.com> domain name. The Complainant's trademark registration constitutes "*prima facie* evidence of the validity of the trademark", as held in *Backstreet Prods., v. John Zuccarini, CupcakeParty, Cupcake Real Video, Cupcake-Show and Cupcakes-First Patrol*, WIPO Case No. [D2001-0654](#).

As indicated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". The mark LEGO is clearly recognizable in each of the disputed domain names in the present case.

Accordingly, the Panel finds that the addition of "homealone" to the disputed domain names is insufficient to avoid a finding of confusing similarity to the Complainant's mark.

Per section 1.11 of the [WIPO Overview 3.0](#), the applicable Top Level Domain ("TLD") in a domain name

(e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Given this, the Panel finds that the disputed domain names are identical and confusingly similar to the trademark LEGO, which is a well-known mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

See *Guccio Gucci S.p.A. v. Brenda Hawkins*, WIPO Case No. [D2013-0603](#) <gucciipadcase.net>; *Yahoo! Inc. v. CPIC NET and Syed Hussain*, WIPO Case No. [D2001-0195](#) <yahoobay.org>.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain names, by demonstrating the following:

- i) that the Respondent is not related in any way with the Complainant.
- ii) that the Complainant sent the Respondent a Cease & Desist notice, calling upon the Responding, to transfer the disputed domain names to the Complainant. In the said Cease & Desist notice, the Complainant highlighted the possibility of the Respondent creating a misleading impression of any connection with the Complainant, while specifically clarifying that that was being done in the absence of any authorization to use LEGO and the non-existence of any other kind of relationship with the Complainant. The Respondent used the domain name for a parking page with third party pay-per-click (“PPC”) links that divert traffic to third party websites not affiliated with the Complainant.

The Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use but instead the disputed domain names are resolving to parking page with PPC links. As per section 2.9 of [WIPO Overview 3.0](#), such links, which capitalize on the reputation and goodwill of the Complainant’s mark or mislead Internet users do not represent *bona fide* offering. See section 2.9 of [WIPO Overview 3.0](#).

The Panel finds the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The second requirement under paragraph 4(a) of the Policy, has been fulfilled by the Complainant.

C. Registered and Used in Bad Faith

The Respondent is today not using the disputed domain names in connection with a *bona fide* offering of goods or services. Instead, the Respondent has intentionally chosen domain names based on a registered trademark in order to generate traffic and income through websites with sponsored links. By this, the Respondent is using the LEGO trademark in order to mislead Internet users to commercial websites.

Further, the Panel found, through the basic Internet search, that the Complainant announced the launch of “Lego Ideas Home Alone” sets, inspired by the popular movie “Home Alone” series on October 21, 2021. The date of registration of the disputed domain names is also October 21, 2021. The date of registration each of these disputed domain names, using the words “homealone” alongside the Complainant’s LEGO trademark cannot be a mere coincidence. It is the view of the Panel that registration of the disputed domain names was deliberate, and the Respondent must have known about the launch of the new series proposed by the Complainant.

As per section 3.1.4 of the [WIPO Overview 3.0](#), mere registration of a domain name that is identical or confusingly similar (...) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel has no doubt that the Complainant’s registered trademark LEGO is famous and widely known globally. A basic Internet search revealed that the launch of the “Lego Ideas

Home Alone” series set was also publicized, which may have led to considerable anticipation amongst the interested customers regarding the said launch.

The Respondent has no relation whatsoever with the trademark LEGO and yet has obtained the registration of the disputed domain names, using the registered trademark LEGO in its entirety, which belongs to the Complainant. From the records of the file, the Panel is left with no doubt that by doing so, the Respondent has deliberately and knowingly attempted to trade upon the goodwill enjoyed by this famous and renowned trademark. For these forgoing reasons, the Panel finds that the Complainant has proven the third and final element of the Policy.

From the records of the file, it appears that the Respondent is using the disputed domain names for web portals providing sponsored links to websites referring to various products. It can thus be considered that the Respondent has set up this system in the expectation of some financial gain through a PPC or click-through system.

Therefore, the circumstances of this case lead the Panel to hold that the Respondent was obviously aware of the Complainant’s Trademark and thus registered the disputed domain names and uses them in bad faith, in order to attract Internet users by creating a likelihood of confusion with the Complainant’s Trademark for the Respondent’s commercial gain.

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 names <homealonelego.com>, <homealonelegos.com>, and <legohomealone.com> be transferred to the Complainant.

/Meera Chature Sankhari/

Meera Chature Sankhari

Sole Panelist

Date: March 30, 2023