

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. David

Case No. D2023-0609

### **1. The Parties**

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

The Respondent is David, Türkiye.

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

The disputed domain name <wishlego.com> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2023. On February 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 11, 2023, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 14, 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 15, 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 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 9, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on March 14, 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 in this proceeding is Lego Juris A/S, the owner of the trade marks LEGO identifying in particular the well-known construction toys. Few brands in the world enjoy a reputation as strong as LEGO, and this is confirmed by numerous studies, some of which are annexed to the Complaint. For example, LEGO ranked as number 1 Consumer Superbrand and number 8 in the Consumer Relevancy Index of the Top 10 Consumer Superbrands for 2019, provided by Superbrands UK. Besides, the magazine Time has classified LEGO as the no. 1 among the most influential toys of all time, in an article published in 2014.

The trade mark LEGO is registered worldwide. The Complainant has submitted a whole trade mark portfolio and extracts relating to registrations of LEGO in Türkiye (registration no. 119057 granted in August 2, 1990).

The disputed domain name <wishlego.com> was registered on June 27, 2022, through a privacy shield service. The identity of the Respondent, an individual allegedly domiciled in Türkiye, was disclosed by the Registrar in the course of this proceeding.

The disputed domain name is used to host a website offering minifigures for sale, and operating under the name "WishLego". It displays a number of pictures and articles which do clearly recall the Lego toys and figurines and the universes for which the Complainant has obtained licenses, including Star Wars and Batman models. While this website displays many different product categories, in reality few items seem to be offered for sale: these are figurines which bear the brand "POGO".

Several cease and desist letters and reminders were sent by the legal representative of the Complainant to the Respondent as of July 14, 2022. They remained unanswered.

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

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

The arguments of the Complainant on the three elements of the Policy can be summarized as follows:

On the first element of the Policy, the Complainant highlights that the disputed domain name comprises the word "lego", which reproduces its well-known trade mark. It also contains the prefix "wish", which does not diminish the confusing similarity between the disputed domain name and the trade mark LEGO. In fact, the Complainant argues that "it is a long-established precedent that confusing similarity is generally recognized when well-known trade marks are paired up with different kinds of generic prefixes and suffixes. In this case, the prefix does not detract from the overall impression".

On the second element of the Policy, the Complainant alleges that the Respondent has no rights or legitimate interests over the disputed domain name: it does not own corresponding trade mark rights, and his name differs also from the disputed domain name. The Complainant indicates also that the Respondent has not been authorized in any manner to register and use the disputed domain name. Rather, the Complainant contends that the Respondent is simply trying to benefit from its well-known trade mark, and "is today not using the [disputed] domain name in connection with a *bona fide* offering of goods or services. Instead the Respondent has intentionally chosen a domain name based on a registered trade mark in order to generate traffic and income through an unauthorised website offering LEGO® products". The Complainant went on arguing that the website hosted by the Respondent does not comply with the Oki Data test, insofar – in particular – it does not accurately disclose the (lack of) Respondent's relationship with the

Complainant, or displays also products which are totally unrelated to the Complainant's business.

On the third element of the Policy, the Complainant argues that its trade mark LEGO is well known and that it precedes the registration of the disputed domain name by decades. It then alleges that the disputed domain name "is currently connected to an unauthorized commercial website offering LEGO products. The Complainant's product images are displayed on the website, contributing to create a confusing similarity with the Complainant. 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".

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires that the Complainant prove all of the following three elements in order to be successful in these proceedings:

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

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

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trade mark or a service mark in which it has rights. The first criterion is perceived primarily as a standing requirement for the Complainant.

The Complainant has shown that it holds numerous rights over the trade mark LEGO.

The disputed domain name <wishlego.com> reproduces the Complainant's trade mark LEGO in its entirety, with the addition of the prefix "wish". This addition does not prevent the disputed domain name from being confusingly similar to trade mark LEGO: the trade mark LEGO is immediately recognizable.

Hence, the first criteria element set out in paragraph 4(a) of the Policy is satisfied.

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

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- i. before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- ii. the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trade mark or service mark rights; or
- iii. the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or

service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent which has not been commonly known by the disputed domain name and is not affiliated with the Complainant nor has it been licensed or otherwise permitted to use any of the Complainant's trade marks or to register a domain name incorporating any of those trade marks.

The Panel is also of the view that the Respondent is not making a *bona fide* use of the disputed domain name, as it offers for sale competing products which bear a different brand. Contrary to the assertion made by the Complainant, the Panel is unable to confirm that the Respondent is selling authentic LEGO goods: the Respondent uses images corresponding to products of the Complainant to promote its activities - simply to attract users and create confusion as to the source of the products, but it actually offers competing goods. Accordingly, it is not necessary to perform an analysis of the Oki Data test here. Moreover, the disputed domain name is inherently misleading, as it creates a false impression of, or association with the Complainant, which cannot constitute fair use.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

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

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or
- (ii) [the respondent has] registered the domain name in order to prevent the complainant from reflecting the complainant's trade mark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted 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.

The facts of this case leave little doubt as to the intentions of the Respondent when registering and using the disputed domain name.

The Respondent deliberately elected a domain name that incorporated the famous brand LEGO of the Complainant, and which would be directly associated to it. By doing so, the Respondent has created initial confusion in order to attract users to its commercial website. And the Respondent did so using a privacy service, in order to conceal his identity.

The disputed domain name is also used in bad faith, as the Respondent reproduces on its website images that correspond to toys of the Complainant, in order to create at least an initial confusion as to the source of the website. But in fact it solely sells competing products bearing a third party brand.

Accordingly, the third criteria element set out in paragraph 4(a) of the Policy is also satisfied and the Complaint succeeds.

## **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, <wishlego.com>, be transferred to the Complainant.

*/Benjamin Fontaine/*

**Benjamin Fontaine**

Sole Panelist

Date: March 23, 2023