

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Host Master, 1337 Services LLC
Case No. D2023-1334

1. The Parties

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

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Name and Registrar

The disputed domain name <legoland.top> is registered with Tucows, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2023. On March 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 29, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 30, 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 April 4, 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 April 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 26, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on May 2, 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, based in Denmark, is the owner of the famous LEGO trademarks (including the LEGOLAND trademark) used in particular for construction toys.

The Complainant is the owner of numerous registered trademarks worldwide consisting of the term “Lego”, amongst others United States of America (“United States”) Trademark Registration No. 1018875 for LEGO, registered on August 26, 1975, for goods in class 28, and United States Trademark Registration No. 2334535 for LEGOLAND, registered on March 28, 2000, for services in classes 35, 41, and 42.

The Respondent registered the disputed domain name on October 27, 2022. The language of the Registration Agreement is English.

It results from the Complainant’s documented evidence that it sent a cease and desist letter by email to the Respondent via the Registrar on November 21, 2022 and subsequent reminders, requesting a voluntary transfer of the disputed domain name. The Complainant even offered the Respondent a compensation for the expenses of registration and transfer fees (not exceeding out of pocket expenses). Nevertheless, no reply was received to this letter.

Finally, it also results from the Complainant’s documented evidence that the disputed domain name originally resolved to an unauthorized website purportedly offering for sale LEGO products. Following the Complainant’s cease and desist letter, the website content was taken down. Currently, the disputed domain name resolves to an error page.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name is identical to its LEGOLAND trademark. In particular, the trademark LEGOLAND is wholly and identically incorporated in the disputed domain name. The suffix does not detract from the overall impression.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainant has not given the Respondent any license or authorization of any other kind, to use the trademarks LEGO or LEGOLAND. Furthermore, the Respondent is not an authorized reseller. Additionally, the Complainant finds it highly unlikely that the Respondent did not know of the Complainant’s legal rights in the name Lego and/or Legoland at the time of the registration. 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. This infringing content was only taken down by the Respondent following the Complainant’s cease and desist letters.

Finally, the Complainant contends that the Respondent registered and is using the disputed domain name in bad faith. In its – undisputed – view, LEGO and LEGOLAND are famous trademarks worldwide. According to the Complainant, it is therefore clear that the Respondent was aware of the Complainant’s trademark rights and the value of said trademarks, at the point of the registration. There is no connection between the Respondent and the Complainant. By using the disputed domain name, the Respondent was therefore not making a legitimate noncommercial or fair use, but misleadingly diverting consumers for commercial gain.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this 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”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark 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 has been registered and is being used in bad faith.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainants must first establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to said mark.

It results from the evidence provided that the Complainant is the registered owner of various trademark registrations consisting of the verbal element “Legoland”. Reference is made, in particular to the United States Trademark Registration No. 2334535, registered on March 28, 2000, for services in classes 35, 41 and 42.

It is noted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), that the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. In the case at hand, the disputed domain name consists of the trademark LEGOLAND in its entirety.

Furthermore, it is acknowledged by UDRP panels, that the applicable Top-Level Domain (“TLD”) may be disregarded in determining identity or confusing similarity, as it is viewed as a standard registration requirement (see [WIPO Overview 3.0](#) at section 1.11.1).

Hence, this Panel finds that the disputed domain name is identical or confusingly similar to the trademark LEGOLAND pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name.

In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances under paragraph 4(c) of the Policy are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has thus remained unchallenged, the Complainant has not authorized the Respondent's use of the LEGO and/or LEGOLAND trademarks, e.g., by registering the disputed domain name consisting of said trademarks.

Furthermore, the Panel notes that there is no evidence in the record or Whois information showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's non-contested evidence that the disputed domain name originally resolved to a website on which the Complainant's LEGO goods were purportedly offered for sale. Since this use is clearly commercial, it cannot be considered a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. Furthermore, such use cannot be qualified a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy and the *Okidata* jurisprudence (*Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) as the website mislead consumers into believing that the Respondent is an authorized dealer, retailer, or reseller of LEGO products, and has been authorized to promote sales of LEGO products. This is reinforced by the following facts that: (1) the Respondent did not add any note, information or disclaimer pointing out that it has actually no relationship with the Complainant; (2) this website was accessible under a domain name that only consists of the Complainant's LEGOLAND trademark. Further, the nature of the disputed domain name, being identical to the Complainant's LEGOLAND trademark, carries a high risk of implied affiliation (see [WIPO Overview 3.0](#) at section 2.5.1).

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand has failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

The Complainant's trademarks LEGO and LEGOLAND have existed for decades and are widely known. In addition, the Panel notes that the disputed domain name consists of the LEGOLAND trademark in its entirety and on the website, to which the disputed domain name originally lead, LEGO products were purportedly offered for sale. Therefore, this Panel has no doubt that the Respondent had actual knowledge that the disputed domain name was consisted of the Complainant's LEGOLAND trademark when it registered the disputed domain name. Registration of the disputed domain name in awareness of the reputed LEGOLAND mark (and the LEGO products) and in the absence of rights or legitimate interests in this case amounts to

registration in bad faith (see, e.g., *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

According to the Complainant's documented evidence – which remained uncontested – the disputed domain name originally resolved to a commercial website on which the Complainant's LEGO goods were purportedly sold. This website therefore benefits from the confusion arising from the similarities between the disputed domain name and the Complainant's trademark. Therefore, it is highly likely that the Respondent received revenue from Internet users who came across the Respondent's website by means of confusion with the LEGOLAND trademark (see, e.g., *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, supra*). In view of the distinctive quality possessed by the well-known LEGOLAND trademark, the mere registration of the disputed domain name containing that mark in its entirety by the Respondent, who is not affiliated with the Complainant, can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#) at section 3.1.4.

The finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the high degree of distinctiveness and the worldwide reputation of the Complainant's LEGO and LEGOLAND marks;
- (ii) the clear absence of any rights or legitimate interests in the disputed domain name;
- (iii) the Respondent's failure to reply to the cease and desist letter sent by the Complainant before starting these UDRP proceedings;
- (iv) the Respondent's failure to submit a response with a credible evidence-backed rationale for registering the disputed domain name;
- (v) the Respondent's failure to provide any evidence of actual or contemplated good faith use;
- (vi) the implausibility of any good faith use to which the disputed domain name may be put.

Therefore, the current non-use of the disputed domain name does not change the Panel's finding of the Respondent's bad faith.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant 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 <legoland.top> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: May 15, 2023