

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. David

Case No. D2023-2519

### **1. The Parties**

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

The Respondent is David, United States of America (“United States”).

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

The disputed domain name <legosneakers.com> is registered with Hostinger, UAB (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 12, 2023. On June 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 12, 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 (Domain Admin / Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 13, 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 June 16, 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 sent notification to the Respondent of the Complaint, and the proceedings commenced on June 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2023. The Respondent did not submit any response. Accordingly, the Center sent the notification of the Respondent’s default on July 18, 2023.

The Center appointed Petra Pecar as the sole panelist in this matter on July 25, 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, LEGO Juris A/S, headquartered in Denmark, is the owner of LEGO trademarks, including those used in connection with construction toys and assorted products.

The Complainant has acquired a multitude of trademark registrations pertaining to LEGO in several jurisdictions, including the following:

- United States trademark registration LEGO (word) Number 1018875, registered on August 26, 1975 in Class 28;
- United States word trademark registration LEGO (word) Number 1248936, registered on August 23, 1983 in Classes 16, 20, 22, 25; and
- United States trademark registration LEGO (word) Number 1535046, registered on April 18, 1989 in Class 09.

The Complainant has granted licensees the right to exploit its intellectual property rights, such as trademark rights, and possesses nearly 5,000 domain names bearing the term “lego”. The Complainant’s business has grown remarkably and now extends to over 130 countries, including the United States. Furthermore, the use of the LEGO trademark has been expanded to include computer hardware and software, books, videos, and computer-controlled robotic construction sets.

The Respondent is an individual based in United States.

The disputed domain name was registered on November 24, 2022, and at the time the Complaint was filed, it redirected to a website that offers for sale brick sneakers.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant argues that the LEGO trademark is among the most recognized trademarks in the world, owing to decades of extensive advertising on products, packaging, displays, and other materials. The LEGO brand has received various accolades, such as being named number one Consumer Superbrand in 2019 by Superbrands United Kingdom, ranking first on the Reputation Institute’s list of the world’s Top 10 Most Reputable Global Companies of 2020, and being declared the Most Influential Toy of All Time by TIME in 2014. The LEGO trademark possesses substantial inherent and acquired distinctiveness, and its awareness is considered significant across the whole community. According to relevant international agreements, the status of LEGO as a well-known trademark gives its owner the right to prevent any use of the trademark, or any confusingly similar mark, in connection with any products or services, thereby extending protection beyond toys and similar goods.

The Complainant contends that the disputed domain name is confusingly similar to its trademark LEGO, registered in various countries worldwide. The fame of the trademark has been confirmed in previous decisions such as *LEGO Juris A/S v. Level 5 Corp.*, WIPO Case No. [D2008-1692](#), where the panel found that LEGO and LEGOLAND are well-recognized and world-famous trademarks; *LEGO Juris A/S v. Michael Longo*, WIPO Case No. [D2008-1715](#), where the panel recognized that LEGO is a well-known and distinctive trademark; and *LEGO Juris A/S v. Reginald Hastings Jr.*, WIPO Case No. [D2009-0680](#), where the mark LEGO was acknowledged as enjoying a high reputation as construction toys popular with children.

The Respondent’s registration of the disputed domain name includes the descriptive term “sneakers,” increasing the confusing similarity between the disputed domain name and the Complainant’s trademark. This connection is emphasized by the Complainant’s collaboration with Adidas to offer the LEGO Adidas

Originals Superstars sneakers. Past panels have reinforced that a domain name consisting of a complainant's trademark and a term related to its business is confusingly similar to the complainant's trademarks. The addition of Top-Level domains ("TLDs") like ".com" does not affect this similarity. There is a significant risk that the trade public might perceive the Respondent's disputed domain name as owned by the Complainant or related to it commercially. Furthermore, the use of the trademark as a dominant part of the disputed domain name could lead to dilution and other damage to the Complainant's trademarks.

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name containing the term "lego". The Respondent has no registered trademarks or trade names corresponding to the disputed domain name, and no evidence has been found to suggest that the Respondent has been using "lego" in a way that would provide legitimate rights in the disputed domain name.

The Respondent's Whois information does not resemble the disputed domain name, and the Respondent is identified merely as "David," with no connection to the disputed domain name. Furthermore, the Respondent's use of a privacy Whois service has previously been linked to a lack of legitimate interest.

No license or authorization has been provided by the Complainant to the Respondent to use the LEGO trademark. The Respondent has never been an authorized dealer of the Complainant's products or had a business relationship with the Complainant. It was also noted that the Respondent likely knew of the Complainant's legal rights to the name "lego" at the time of registration.

The LEGO trademark is renowned worldwide, and any use of it in a disputed domain name would violate the rights of the trademark owner. The Respondent is not using the disputed domain name for a *bona fide* offering of goods or services but instead has chosen the disputed domain name to generate traffic and income by misleading Internet users to its commercial website, which competes directly with the Complainant's business.

There is no evidence to suggest that the Respondent has any legal right to the name "lego". The Respondent is attempting to benefit from the Complainant's world-famous trademarks without any legitimate basis. Therefore, the Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name.

The Complainant contends that the LEGO trademark is widely recognized and reputable, with considerable goodwill globally. Given its value, the trademark has been attractive to domain name infringers. The Respondent's registration of the disputed domain name on November 24, 2022, came after the Complainant's longstanding registration of the trademark.

After unsuccessful attempts to contact the Respondent to cease and desist the unauthorized use, the Complainant filed a complaint under the UDRP process. Several legal cases suggest that using a well-known trademark without explanation in a domain name may indicate bad faith.

The Respondent's disputed domain name, which redirects to a site selling products that compete with the Complainant's, appears to be a deliberate attempt to attract users for commercial gain, creating confusion with the Complainant's mark. The use of a privacy service to hide the Respondent's identity has been seen by past UDRP panels as additional evidence of bad faith.

## **B. Respondent**

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

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- 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 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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The disputed domain name comprises the Complainant's registered trademark LEGO.

The disputed domain name reproduces the Complainant's LEGO trademark in its entirety. The adjunction of the term "sneakers," does not prevent a finding of confusing similarity. According to 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. Similarly, the generic Top Level Domain ("gTLD") ".com" does not preclude a finding of confusing similarity between the disputed domain name and the Complainant's trademarks in accordance with well-established practice of previous UDRP panels. The Panel, therefore, finds that the disputed domain name is confusingly similar to the Complainant's LEGO trademark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence to rebut that presumption. If the respondent fails to do so, a complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also the section 2.1 of the [WIPO Overview 3.0](#)).

The Respondent failed to provide any evidence of authorization to use the LEGO trademark or to register a domain name containing the LEGO trademark.

The Panel determines, *inter alia*, that it has not authorized the Respondent, to use the LEGO trademark, and that there is no relationship between the parties. Additionally, the Panel observes that the Respondent is not known by the name "lego" nor has any connection with such name. The Panel notes that the Respondent has no registered trademarks or trade names corresponding to the disputed domain name. Furthermore, the Panel ascertains that there is nothing to suggest that the Respondent has been using LEGO in any other way that would provide rights or legitimate interests in the disputed domain name.

No license or authorization of any other kind has been given by the Complainant to the Respondent to use the trademark LEGO. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. The Respondent is 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 the Complainant's registered trademarks in order to generate traffic and

income through redirecting to a website, which offers for sale brick sneakers, which directly competes with the Complainant's business for the LEGO Adidas Originals Superstar sneakers. Selling competing goods, coupled with the unauthorized use of a complainant's trademark in a confusingly similar domain name, does not qualify as a *bona fide* offering of goods or services under Policy 4(c)(iii).

Consequently, the Panel concludes that the Complainant has satisfied the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, as it has used the same to generate traffic to its website to which the disputed domain name redirected. Therefore, the Panel asserts that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt 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 the respondent's website or location or of a product or service on its website or location.

The date of the disputed domain name registration, November 24, 2022, is subsequent to when the Complainant registered the trademark LEGO in the United States and elsewhere, by decades. The considerable value and goodwill associated with the LEGO trademark, along with its worldwide fame, clearly motivated the Respondent's registration. The Respondent's awareness of the Complainant's rights to the LEGO trademark at the time of registration is further evidenced by the trademark's widespread recognition. The Respondent's lack of connection with the Complainant and the use of a privacy service to hide its identity further underline the bad faith at the time of registration.

The Panel also finds that the Respondent's use of the disputed domain name has been in bad faith. The disputed domain name was redirected to a website that offers products directly competing with the Complainant's offerings. This not only disrupts the Complainant's business but also qualifies as bad faith use. The Respondent's intentional attempt to attract Internet users to a competing website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark, further exemplifies bad faith use pursuant to paragraph 4(b)(iv) of the Policy. The Respondent's failure to respond to the Complainant's cease and desist letters, and the use of a privacy service known to block or intentionally delay disclosure, adds to the evidence of bad faith in its use.

The timing and context of the Respondent's registration of the disputed domain name, as well as the manner in which the Respondent has used the disputed domain name, unequivocally point to bad faith. The Respondent was clearly motivated by the LEGO trademark's fame and used the disputed domain name to mislead and divert consumers for commercial gain.

Consequently, the Respondent should be considered to have registered and to be using the disputed domain name in bad faith.

Accordingly, the Panel holds that the Complainant has satisfied the requirements of 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 <legosneakers.com> be transferred to the Complainant.

*/Petra Pecar/*

**Petra Pecar**

Sole Panelist

Date: August 8, 2023