

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Gruenewald Stephanie; Engel Dominik; Koch Anja; and Client Care, Web Commerce Communications Limited
Case No. D2023-2881

1. The Parties

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

Respondents are Gruenewald Stephanie, Germany; Engel Dominik, Germany; Koch Anja, Germany; and Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrars

The disputed domain names <legoargentina.com>, <legobelgium.com>, <legodanmark.com>, <legodeutschland.com>, <legogreece.com>, <legohungary.com>, <legoireland.com>, <legonederland.com>, <legonorge.com>, <legoromania.com>, <legosaleuk.com>, <legoschweiz.com>, <legosenmexico.com>, <legoshopcz.com>, <legoshopitalia.com>, <legoshopphilippines.com>, <legoshopusa.com>, <legoslovensko.com>, <legosrbija.com>, <legostoreaustralia.com>, <legostorecanada.com>, <legostoremalaysia.com>, <legostorenz.com>, <legostorepolska.com>, <legostoresingapore.com>, <legosuomi.com>, and <legosverige.com> are registered with Alibaba.com Singapore E-Commerce Private Limited. The disputed domain names <legoespaña.com>, <legoösterreich.com>, and <legostoretürkiye.com> are registered with Gransy, s.r.o. d/b/a subreg.cz (collectively, the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 6 and July 7, 2023, respectively, 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 Respondents (Not Disclosed) and contact information in the Complaint. The Center sent an email to Complainant on July 7, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 12, 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 Respondents of the Complaint, and the proceedings commenced on August 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2023. Respondents did not submit any response. Accordingly, the Center notified Respondents’ default on August 25, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 11, 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

Complainant has manufactured toys for more than 60 years under the trademark LEGO. The LEGO mark is registered in numerous jurisdictions, including the European Union (Reg. No. 000039800, registered on October 5, 1998 for, among other things, “toys and playthings”), Germany (Reg. No. 287932, registered on April 17, 1964), and Malaysia (App. No. 08025143, registered on December 23, 2008).

Complainant alleges, and provides ample evidence in the record (such as survey results from Superbrand), to establish that LEGO is a very well known trademark around the world. For instance, in 2014 TIME magazine called LEGO “the Most Influential Toy of All time.” Numerous prior UDRP decisions have also found the LEGO mark to be famous.

Complainant owns hundreds of domain names containing its LEGO mark. Complainant’s main website is located at the domain name <lego.com>.

The disputed domain names were registered at various points between December 19, 2022 and May 23, 2023. A handful of the disputed domain names do not resolve to an active website. The vast majority of the disputed domain names resolve to websites purporting to sell Complainant’s LEGO products. According to Complainant, these websites are unauthorized.

Respondents’ websites make liberal use of Complainant’s trademark and logo, and do not disclaim any affiliation with Complainant. The look and feel of Respondents’ sites is strikingly similar to Complainant’s own site.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

B. Respondents

Respondents did not reply to Complainant’s contentions.

6. Discussion and Findings

6.1. Consolidation – Multiple Underlying Respondents

The key considerations in determining whether cases should be consolidated where they involve multiple respondents are identified at section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), as being whether: (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency is also noted as being a relevant consideration.

In this case, there are numerous similarities between the disputed domain names themselves and the websites to which they resolve. To begin with, the composition of all 30 disputed domain names is very similar - all follow the same pattern, with Complainant's LEGO trademark followed by a country name and sometimes a dictionary term such as "sale" or "store". In addition, 27 out of 30 disputed domain names all resolve to geo-restricted websites that are only accessible from the country indicated in each disputed domain name. All of these websites follow the same layout, displaying the LEGO logo throughout as well as on their favicons and pictures of LEGO products.

Complainant has submitted that the addresses of the registrants of <legoösterreich.com>, <legoespaña.com>, and <legostoretürkiye.com> are all located in Germany. Complainant also submits that the email address for them is from the "@yeah.net" email server.

Overall, there is a high level of similarity between the format of the disputed domain names, and also between the format and content of the websites to which they resolve. Coupled with the fact that certain of the German registrant addresses are obviously false and that it appears likely that the various registrant details provided for registration do not correspond to the actual underlying registrant of the disputed domain names, the Panel finds that it is most likely that they are under common control. None of Respondents have challenged Complainant's request for consolidation, and it is clearly most procedurally efficient, and in all the circumstances, fair and equitable for the disputed domain names to be included together in this one case. Respondents will be hereinafter referred to as "Respondent".

6.2. Substantive Issues

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to each of the disputed domain names:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark LEGO through longstanding and widespread registration and use demonstrated in the record. The Panel also concludes that each of the disputed domain names is confusingly similar to the famous and distinctive LEGO mark. The various geographical terms and/or descriptive terms (such as "deals", "store", or "sets") added to the mark do not overcome the fact that the LEGO mark remains clearly recognizable within each of the disputed domain names.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

For each of the disputed domain names, pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the disputed domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the [disputed domain name], even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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 trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the disputed domain names. Respondent has not come forward to articulate or prove any *bona fide* regarding any of the 30 disputed domain names. On the undisputed record, Respondent has registered, without authority from Complainant, 30 disputed domain names incorporating Complainant's famous LEGO mark, and used most of those disputed domain names for websites clearly attempting to impersonate Complainant's own website and thereby derive income through misleading consumers. With regard to the disputed domain names that do not resolve to an active website at this time, the Panel concludes that Respondent's overall conduct *vis-à-vis* the entirety of the 30 disputed domain names is sufficiently tainted to cover the "inactive" disputed domain names as well.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

For each of the disputed domain names, paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the domain name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the disputed domain name; or
- (ii) that Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding disputed domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used each of the disputed domain names in bad faith under the Policy. On the undisputed record, it is obvious that Respondent targeted Complainant's famous LEGO trademark in order to derive commercial gain by misleading consumers into the belief that Respondent's websites are affiliated with, or authorized by, Complainant. This conduct runs afoul of the above-quoted Policy, paragraph 4(b)(iv).

Furthermore, the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#).

In addition, the Panel finds that Respondent is in violation of the above-quoted Policy, paragraph 4(b)(ii), inasmuch as Respondent has engaged in a pattern of preclusive registrations.

Complainant has established 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 names <legoargentina.com>, <legobelgium.com>, <legodanmark.com>, <legodeutschland.com>, <legoespaña.com>, <legogreece.com>, <legohungary.com>, <legoireland.com>, <legonederland.com>, <legonorge.com>, <legoösterreich.com>, <legoromania.com>, <legosaleuk.com>, <legoschweiz.com>, <legosenmexico.com>, <legoshopcz.com>, <legoshopitalia.com>, <legoshopphilippines.com>, <legoshopusa.com>, <legoslovensko.com>, <legosrbija.com>, <legostoreaustralia.com>, <legostorecanada.com>, <legostoremalaysia.com>, <legostorenz.com>, <legostorepolska.com>, <legostoresingapore.com>, <legostoretürkiye.com>, <legosuomi.com>, and <legosverige.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: September 15, 2023