

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Simplicity Labs Private Limited, SIMPLICITYLABS PRIVATE LIMITED

Case No. D2023-4337

1. The Parties

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

The Respondent is Simplicity Labs Private Limited, SIMPLICITYLABS PRIVATE LIMITED, India.

2. The Domain Name and Registrar

The disputed domain name <legoleaks.online> and <legoleaks.store> are registered with HOSTINGER Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 18, 2023. On October 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 21, 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 (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 24, 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 October 26, 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 November 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 26, 2023. The Center received informal email communications from a third party on November 27 and 29, 2023. Pursuant to paragraph 6 of the Rules, on December 5, 2023, the Center informed the Parties that it would proceed with the panel appointment process.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on December 26, 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 is the owner of the trade marks LEGO identifying in particular the well-known construction toys. The Complainant's Group is one of the world's most renowned manufacturers of play materials and its strong reputation 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 Complainant submitted a whole portfolio of trade marks to demonstrate that LEGO is registered worldwide. With regards to India, where the Respondent is located, the Complainant presented extracts from the Indian trade marks registry, including Indian trade mark No. 240430 for the word LEGO, registered on February 7, 1967, in class 28, and Indian trade mark LEGO No. 293297, registered on January 3, 1974, in class 20.

Moreover, the Complainant is the owner of more than 5,000 domain names containing the term LEGO, for example <lego.com>.

The two disputed domain names <legoleaks.online> and <legoleaks.store> were both registered on May 24, 2023, through a privacy shield service. At the time of their detection, they were redirecting to a commercial website offering for sale NFT domain names.

On June 13, 2023, prior to the Complaint, the Complainant's representative tried to contact the Respondent sending an all-rights reserved letter by email and through the portal provided by PrivacyProtect.org, denouncing the reservation of the two disputed domain names and the unauthorized and unfair use of the trade mark LEGO belonging to the Complainant. No response was received.

The identity of the Respondent, a company domiciled in New Delhi, India, was disclosed by the Registrar in the course of this proceeding.

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain names are identical or confusingly similar to its well-known trade mark LEGO. The domain names both reproduce the Complainant's trade mark LEGO as a dominant and distinctive element. The addition of the generic suffix "leaks" in each domain name does not detract from the overall impression. Likewise, the addition of the generic Top-Level Domains ("gTLD") ".store" and ".online" have no impact either and should be disregarded for the comparison.

Second, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names. Indeed, the Respondent may not claim any rights established by common usage, as no evidence suggests that the Respondent has any registered trade marks or trade names corresponding

to the disputed domain names or has been using LEGO in any other way that would provide legitimate rights. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. In the absence of any license or permission from the Complainant to use the trade mark LEGO, no actual or contemplated *bona fide* or legitimate use of the domain names could be invoked by the Respondent. The disclosure of the Respondent's identity shows that it does not appear to be known under the sign LEGO. Moreover, the disputed domain names were redirecting to a third-party website offering NFT domains for sale. Such products are not related to the Complainant in any way, and this does not constitute legitimate noncommercial or fair use of the disputed domain names.

Third, the Complainant indicates that the disputed domain names were registered and used in bad faith. The Respondent, domiciled in India, registered the two disputed domain names several decades after the Complainant established rights in India in the term LEGO. Given the reputation and well-known status of the trade marks LEGO, it is highly unlikely that the Respondent did not know of the Complainant's legal rights at the time of the registration. Still, according to the Complainant, it is rather obvious that it is the fame of the trade mark that has motivated the registration of the disputed domain names. Moreover, the Respondent has employed a privacy service to hide its identity and ignored the Complainant's attempts to contact it before filing the Complaint. The Respondent was using the disputed domain names to redirect Internet users to a website selling NFT domains, creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation or endorsement of this website. Such technique is known as "bait and switch". This use does not constitute a *bona fide* offering of goods and services. Finally, the Complainant stresses that the Respondent is apparently engaged in a pattern of bad faith domain name registrations, as it has registered at least another domain name which incorporates a well-known trade mark of a third party.

B. Respondent

The Respondent did not reply to the Complainant's contentions. In email communications received on November 27 and 29, 2023, a third party contacted the Center via the email address "[...][@simplicitylabs.org](mailto:simplicitylabs.org)", which bears similarities to the email address used for registration of the disputed domain name, and expressed association with the disclosed Respondent company and awareness of the disputed domain name. In the email communications, the third party offered to "drop" the disputed domain names in exchange for a "favor".

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the suffix "leaks" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. In fact, the disputed domain names previously redirected to a third party commercial website offering NFTs and given the third party’s email and apparent connection to the Respondent, said party’s request for a “favor” in return for the transfer of the disputed domain name reinforces the Panel’s finding that the Respondent sought commercial gain from the registration of the disputed domain name, which cannot confer rights or legitimate interests upon the Respondent. [WIPO Overview 3.0](#), section 2.5.3.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered two domain names composed of the trade mark LEGO associated with the suffix “leaks” generally used by LEGO fans to refer to new products in development. The trade mark LEGO is extremely well known throughout the world, and is also highly distinctive as it is based on the Danish expression “LEG GODT” meaning “play well”. Thus composed, the disputed domain names will necessarily be perceived by the public as being affiliated with or authorized by the Complainant, which creates a risk of implied affiliation.

With regards to their use, the disputed domain names were redirected to a commercial website offering NFT domain names for sale. By using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users and LEGO fans to this website, by creating a likelihood of confusion with the Complainant’s trade mark as to the source, sponsorship, affiliation, or endorsement of this destination website. The Respondent concealed its identity at the time of registration and ignored the Complainant’s attempts to contact it. Even after notice of this proceeding, the Respondent, through the third party email sender, attempted to transfer the disputed domain names to the Complainant in exchange for “any favor”, causing an interruption in the proceedings, declining an amicable settlement of the dispute, and thus reinforcing to the bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element 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 names, <legoleaks.online> and <legoleaks.store>, be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: January 6, 2024