

## **ADMINISTRATIVE PANEL DECISION**

**LEGO Juris A/S v. Domain Administrator, Fundacion Privacy Services LTD**  
**Case No. D2022-1344**

### **1. The Parties**

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

The Respondent is Domain Administrator, Fundacion Privacy Services LTD, Panama.

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

The disputed domain names <dailybuglelego.com>, <honeylego.com>, <idearslego.com>, <legoavengerslego.com>, <legogamesonlego.com> are registered with Media Elite Holdings Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2022. On April 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same date, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 25, 2022.

The Center appointed Rosita Li as the sole panelist in this matter on June 16, 2022. 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 LEGO trade mark and all other trade marks that are used in connection with the Lego brand construction toys and other Lego branded products. The Complainant's Lego products are sold in more than 130 countries in the world, including the United States of America (the "United States").

The Complainant submits that its LEGO trade mark is among the best-known trade marks in the world. The Complainant's LEGO trade mark is registered in various jurisdictions including the United States and Panama. The LEGO trade mark has been extensively advertised and the LEGO trade mark and brand have been recognized by different organizations as one of the top consumer brands and the Complainant's group of companies have been ranked as one of the most reputable global companies.

The use of the Complainant's LEGO trade mark has extended from toys to other items including but not limited to computer hardware and software, books, videos and computer controlled robotic construction sets.

The Complainant owns nearly 5,000 domain names containing the term Lego and maintains an extensive website under the domain name <lego.com>.

The disputed domain names <dailybuglelego.com>, <honeylego.com> and <legoavengerslego.com> were registered on June 11, 2021; and the disputed domain names <idearslego.com> and <legogamesonlego.com> were registered on June 15, 2021. The abovementioned disputed domain names <dailybuglelego.com>, <honeylego.com>, <legoavengerslego.com>, <idearslego.com> and <legogamesonlego.com> are hereinafter referred to as the Disputed Domain Names. The Disputed Domain Names are connected to websites displaying sponsored links and are being offered to sell.

#### 5. Parties' Contentions

##### A. Complainant

Submissions were made by the Complainant to show that the three elements set out under paragraph 4(a) of the Policy in relation to domain name dispute have been satisfied. A summary of the Complainant's submissions are as follows.

The Complainant submits that the Disputed Domain Names are confusingly similar to the Complainant's trade mark LEGO. The dominant part of the Disputed Domain Names comprises the entire term Lego, which is identical to the Complainant's registered trade mark LEGO and the domain name <lego.com>. Although the Disputed Domain Names contain various terms such as "gameson", "avengers", "honey", "idears" and "dailybugle", pairing these generic prefixes and suffixes with the well-known LEGO trade mark does not detract from the overall impression that the Disputed Domain Names are confusingly similar to the LEGO trade mark in which the Complainant has rights. The addition of the generic Top-Level Domain (gTLD) ".com" does not have any impact on the overall impression of the dominant portion of the Disputed Domain Names and is therefore irrelevant for determining the confusing similarity between the Complainant's LEGO trade mark and the Disputed Domain Names.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant submits that it has given no license or authorization of any other kind to the Respondent to use the LEGO trade mark, neither has the Respondent been authorized as a dealer of the Complainant's products; there has never been a business relationship between them. The Complainant further submits that the Disputed Domain Names are not being used in connection with a *bona fide* offering of goods or services, but rather, the Disputed Domain Names are being offered for sale in amounts that far exceed the Respondent's out-of-pocket expenses in registering the Disputed Domain Names. The Disputed Domain Names are also connected to sponsored links, according to the evidence produced by the Complainant, which suggests that the Disputed Domain Names are registered by the

Respondent to generate traffic and income through websites for commercial purposes.

The Complainant further contends that the Disputed Domain Names were registered and are being used in bad faith. The Complainant submits that the LEGO trade mark is a well-known and reputable trade mark with substantial and widespread goodwill throughout the whole world. The trade mark has been registered in the United States and elsewhere by decades, whereas the Respondent has only registered the Disputed Domain Names on June 11 and 15, 2021 respectively, which are subsequent to the registration of the Complainant's LEGO trade mark. The Complainant had tried to resolve the matter amicably by sending a cease and desist letter to the Respondent, requesting a voluntary transfer and offered compensation for the expenses involved. However, no reply was ever received. The fact that the Disputed Domain Names are connected to websites displaying sponsored links and are being offered to sell shows that the Respondent is using the Disputed Domain Names to intentionally attempt to attract Internet users to its websites for commercial gain, and to seek to profit from the sale of a confusingly similar domain name. As such, the Respondent should be considered to have registered and to be using the Disputed Domain Names in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that a complainant must satisfy each of the following three elements in a complaint:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

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

It has been well established that a gTLD, such as ".com", in a disputed domain name does not typically form part of the relevant assessment. The Panel will accordingly consider the second level part of the Disputed Domain Names (*i.e.* "dailybuglelego", "honeylego", "idearslego", "legoavengerslego", and "legogamesonlego").

The Complainant demonstrated that it is the proprietor of the trade mark LEGO.

As put forward by the Complainant, each of the Disputed Domain Names incorporates the trade mark LEGO in its entirety. Any additional words, such as "dailybugle", "honey", "idears", "avengers", and "gameson", do not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant's LEGO trade mark.

Accordingly, the Panel is of the view that the Disputed Domain Names are confusingly similar to the Complainant's trade marks and the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1, "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". If the respondent is unable to come forward with such evidence, the complainant is deemed to have satisfied the second element under paragraph 4(a) of the Policy.

The Panel notes that the Complainant did not license or authorize the Respondent to use the trade mark LEGO, nor did the Complainant has any business relationship with the Respondent which would allow the Respondent to use the LEGO trade mark of the Complainant for purposes such as registering the Disputed Domain Names.

The Panel notes that the Complainant provided evidence showing the Disputed Domain Names are being offered for sale on <sedo.com>, with minimum offers starting at USD 899 for each Disputed Domain Name, which the Panel considers an amount that presumably exceeds the Respondent's out-of-pocket expenses in registering the Disputed Domain Names. Also, the websites under the Disputed Domain Names contain sponsored links. The Panel agrees with the Complainant's contention that the use of the Disputed Domain Names is not in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use of the Disputed Domain Names.

In the present case, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests.

The Panel also notes that the Respondent has failed to provide any evidence or submit any arguments to demonstrate that it has any rights or legitimate interests in the Disputed Domain Names or to rebut the Complainant's *prima facie* case.

Having considered all circumstances, the Panel considers that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

Accordingly, the Panel is of the view that paragraph 4(a)(ii) of the Policy has been satisfied.

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

Paragraph 4(b) of the Policy sets out several scenarios where, if such evidence is found by the Panel to be present, the respondent shall be found to have registered and used the disputed domain names in bad faith.

As mentioned in the previous section, the Panel notes that there is evidence showing the Disputed Domain Names are being offered for sale and in such amount that the Panel considers exceeding the out-of-pocket expenses directly related to the registration of the Disputed Domain Names. This amounts to evidence of registration and use of the Disputed Domain Names in bad faith under paragraph 4(b)(i) of the Policy.

Also, as seen from the evidence provided by the Complainant, the websites under the Disputed Domain Names do not have any specific content or make any reference to the Respondent, but merely display sponsored links. Given that the Complainant's LEGO trade mark is a well-known trade mark and a well-recognized brand name, the Panel is of the view that the Disputed Domain Names, each of them having incorporated the Complainant's LEGO trade mark in its entirety, are to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's LEGO trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites. The Panel is therefore satisfied that evidence of registration and use in bad faith as described under paragraph 4(b)(iv) of the Policy is found.

In addition, the Panel finds that at the time of registration of the Disputed Domain Names in June 2021, the Complainant already had its LEGO trade mark registered in various parts of the world, including the United States and Panama, where the Respondent is located. The Panel agrees that the LEGO trade mark is well-known and reputable amongst the general public. This well-known status has been considered and confirmed in numerous previous UDRP decisions, such as *LEGO Juris A/S v. Level 5 Corp.*, WIPO Case No. [D2008-1692](#). It would not be plausible for the Respondent to claim that they are unaware of the Complainant's LEGO trade mark. The Panel is prepared to infer that the Respondent knew or should have

known that its registration would be identical or confusingly similar to the Complainant's LEGO trade mark ([WIPO Overview 3.0](#), section 3.2). In view of the foregoing, the Panel finds that at the time of registration of the Disputed Domain Names, the Respondent must have been aware of the existence, goodwill, and reputation of the Complainant and its trade marks. The Respondent should be considered to have registered and to be using the Disputed Domain Names in bad faith.

Accordingly, the Panel is of the view that paragraph 4(a)(iii) of the Policy has been satisfied.

## **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 <dailybuglelego.com>, <honeylego.com>, <idearslego.com>, <legoavengerslego.com>, and <legogamesonlego.com> be transferred to the Complainant.

*/Rosita Li/*

**Rosita Li**

Sole Panelist

Date: June 30, 2022