

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. christian na

Case No. D2022-4856

1. The Parties

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

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

2. The Domain Names and Registrars

The disputed domain names <builtlego.com>, <legobuilt.com>, and <legosbuilt.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 19, 2022. On December 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing Registration Private, Domains By Proxy, LLC as the registrant for the disputed domain names. Following a clarification request from the Center, on January 24, 2023, the Registrar transmitted by email to the Center a new verification response in which it disclosed the underlying registrant and contact information for the disputed domain names which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 26, 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 January 31, 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 February 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on March 6, 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 makes and sells LEGO-branded toys and has subsidiaries and branches throughout the world. The LEGO trademark of the Complainant is registered in many jurisdictions in relation to toys. The Complainant provides a tabulated list of all trademark registrations in multiple jurisdictions, as well as a copy of the United States Trademark Office registration certificate for the typed drawing mark LEGO, No. 73032295, registered on August 26, 1975 in relation to toy building blocks and associated articles.

All three disputed domain names were registered by the Respondent on February 9, 2022, by the Respondent Christian Na, with the aid of a privacy protection service. The disputed domain names <builtLEGO.com> and <LEGOsbuilt.com> resolve to free parking pages with sponsored links. The disputed domain name <LEGObuilt.com> resolves to an inactive site.

5. Parties' Contentions

A. Complainant

The Complainant says that although the disputed domain names were registered with the aid of a privacy protection service it is clear that they are all controlled by the Respondent. All the disputed domain names in this proceeding were registered on the same date with the same Registrar, GoDaddy.com, LLC, and the Complainant says that they are all used in a similar manner.

The Complainant is the owner of the LEGO trademarks registered in relation to construction toys and other branded products which are sold in more than 130 countries including the United States. The Complainant also owns over 5000 registered domain names.

The Complainant says that its LEGO trademark is one of the best-known marks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. It has extended its use of the LEGO mark to computer hardware and software, books, videos and the like and operates the lego.com website. The Complainant maintains that due to its status as a well-known mark, LEGO is protected beyond the goods and services specified in its trademark registrations.

The Complainant points out that additionally to its mark LEGO, each of the disputed domain names also comprises a term closely connected to the Complainant, namely "built". The term "built" (past participle for build) is intrinsic to the Complainant's offering, as its products consist of colored interlocking pieces that can be assembled, connected and built in many ways. The Complainant says that the fact that "built" is so closely linked and associated with the Complainant's brand and trademark only serves to underscore the confusing similarity between the disputed domain names and the Complainant's trademark LEGO.

According to the Complainant's searches, the Respondent has no registered trademarks or trade names corresponding to the disputed domain names, nor has it used the LEGO mark in any other way that would support any claim to legitimate rights in it. Therefore, the Respondent cannot claim any rights established by common usage, nor can it claim such rights based on a business relationship with, or authorization or license from the Complainant, since no legal or business connection has never existed. Further, the Complainant says that given the fame inherent in its LEGO trademarks, the Respondent must have been aware of the Complainant's legal rights at the time of registration of the disputed domain names. The Respondent is not using <builtlego.com> and <legosbuilt.com> in connection with any *bona fide* offering of goods or services.

Rather, the Complainant points out that the Respondent is attempting to generate traffic and income with sponsored links, thus using the LEGO trademark to mislead Internet users towards commercial websites. The Complainant also says that the Respondent is using <legobuilt.com> to redirect Internet users to a website that resolves to a blank page and lacks content, and has thus not demonstrated any attempt to make legitimate use of any of that particular disputed domain name, which evinces a lack of rights or legitimate interests in it.

The Complainant contends that the LEGO trademark in respect of toys has the status of a well-known and reputable trademark with substantial and widespread goodwill throughout the world. The Complainant points out that the large number of third party domain name registrations including the trademark LEGO in combination with other words demonstrates how attractive the said mark is to infringers. Clearly, the Complainant says, the Respondent was motivated by the fame of the LEGO mark, whose registrations date back decades, to register the disputed domain names. The fact that the Respondent registered three domain names that incorporate the LEGO mark almost simultaneously is further evidence of bad faith registration and use, according to the Complainant. The disputed domain names <builtlego.com> and <legosbuilt.com> are connected to websites which appear to still be under construction to some extent but have been commercial until recently through the inclusion of sponsored links. Whether the respondent actually chose the linked websites or derived any revenue from this linking practice is irrelevant, according to the complainant, as past panels have held. The <legobuilt.com> disputed domain name does not currently resolve to an active site and is not being used, but the Complainant points out that bad faith “use” does not require a positive act on the part of the Respondent – passively holding a domain name can constitute a factor in finding bad faith registration and use.

Given the reputation of the LEGO trademarks, the Complainant says no good faith use of the disputed domain names by the Respondent is possible. Further, the efforts of the Complainant to contact the Respondent went without reply, and the Complainant says that earlier Panels have found that the failure to respond to a cease-and-desist letter, or a similar attempt at contact, is relevant to a finding of bad faith. Furthermore, the use of a privacy service to hide the Respondent’s identity, has also been held by prior Panels to be evidence of bad faith registration and use.

Finally, the Complainant asserts that the Respondent is using the disputed domain names to intentionally attempt to attract Internet users to websites for commercial gain, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the websites.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

None of the disputed domain names are identical to any of the LEGO registered trademarks of the Complainant. However, that mark is clearly and immediately recognizable within each of the disputed domain names. This is sufficient to meet the requirements of Paragraph 4(a)(i) of the Policy, as has been consistently held. The inclusion of the term “built” and the addition of the letter “s”, rendering the Complainant’s mark to its plural form, has no impact on this conclusion.

Therefore the Panel holds that each of the disputed domain names is confusingly similar to the LEGO registered trademark of the Complainant.

B. Rights or Legitimate Interests

There is no evidence before the Panel that the Respondent has any rights to or legitimate interests in LEGO

trademarks, or in any of the disputed domain names. The Respondent is not known by the disputed domain names or “LEGO”, has not reacted to any of the contentions of the Complainant, used a privacy shield service to hide its identity initially, and did not react to the Complainant’s attempts to contact him. The Respondent was never authorized to use the LEGO mark in any way by the Complainant, nor to include it in a domain name, nor is the Respondent an authorized distributor. Nothing indicates that the Respondent has made any legitimate use of, or acquired any rights in the word mark LEGO or anything similar. The disputed domain names were all registered on the same day, by inference with the common intention of using them to generate click through revenue by deceiving consumers into thinking the Complainant was legitimately connected related websites. None of this activity gives rise to rights or any semblance of a legitimate interest in the disputed domain names.

Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

As already pointed out, the Respondent used a privacy service to shield his identity and also did not respond to any attempt by the Complainant to contact him. The LEGO marks relate to building blocks as toys, and it is thus highly unlikely that the Respondent did not know of the Complainant’s exclusive rights in those marks when he registered the disputed domain names which include both the LEGO mark and the term ‘built’. In any case, as the Complainant points out, the LEGO marks have a very widespread and longstanding reputation, and the mark itself is very distinctive.

It is also almost impossible to imagine any use of the disputed domain names outside of the control of the Complainant, that would not mislead and deceive Internet users. The composition of the disputed domain names concerned suggests a legitimate connection between them and the Complainant, which does not in fact exist in relation to any of the three disputed domain names at issue. There is evidence that the Respondent was out to gain financial advantage from click-through links, engendering and relying on the deception or confusion of Internet users. This is a classic case of abusive registration of domain names that incorporate a trademark to which the registrant has no rights whatsoever.

Therefore the Panel holds that the disputed domain names were registered and used in bad faith.

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, <builtlego.com>, <legobuilt.com> and <legosbuilt.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: March 20, 2023