

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. John Thompson

Case No. D2023-0105

### **1. The Parties**

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

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

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

The disputed domain name <legobrick.club> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 10, 2023. On January 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 10, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 11, 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 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 the Respondent of the Complaint, and the proceedings commenced on January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 6, 2023.

The Center appointed José Pio Tamassia Santos as the sole panelist in this matter on February 13, 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**

4.1. The Complainant in this administrative proceeding is LEGO Juris A/S, a limited company incorporated in Denmark, with its principal place of business in Denmark.

4.2. The Complainant is the owner of LEGO, and all other trademarks used in connection with the famous LEGO brands of construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in the United States and elsewhere. Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the United States.

4.3. The Complainant holds various registrations for the LEGO trademark and variations of it in numerous countries including the United States Registration No. 73032292, registered on December 9, 1975, and the European Union Registration No. 000039800, registered on October 5, 1998. The Complainant is the owner of close to 5,000 domain names containing its LEGO trademark.

4.4. The trademark LEGO is among the best-known trademarks 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.

4.5. The LEGO Group has expanded its use of the LEGO trademark to, *inter alia*, computer hardware and software, books, videos, and computer controlled robotic construction sets. The LEGO Group also maintains an extensive website under the domain name <lego.com>.

4.6. The Domain Name was registered by the Respondent on June 8, 2022, and resolves to a parking page displaying Pay-Per-Click ("PPC") links, some of which are directly related to the Complainant's business.

#### **5. Parties' Contentions**

##### **A. Complainant**

5.1. The Complainant states that the Respondent registered without authorization the Domain Name on June 8, 2022.

5.2. The Complainant submits that the Respondent lacks rights or legitimate interests in the Domain Name.

5.3. The Complainant states that the unauthorized registration of the Domain Name by the Respondent and its use in connection with a site displaying sponsored PPC links are for the purpose of commercial gain and constitute bad faith registration and use.

##### **B. Respondent**

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

## 6. Discussion and Findings

6.1. Paragraph 4(a) of the Policy provides specific remedies to trade mark owners against registrants of domain names where the owner of the mark (*i.e.*, the complainant) proves each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

6.2. The Complainant has the burden of proof, by a preponderance of the evidence, in respect to each element in paragraph 4(a) of the Policy.

6.3. The Respondent, having failed to respond in the present proceeding, is in default, and in accordance with paragraph 14(b) of the Rules, “the panel shall draw such inferences [...] as it considers appropriate”.

### A. Identical or Confusingly Similar

6.4. The dominant part of the Domain Name comprises the term “lego”, identical to the registered trademark LEGO, registered by the Complainant as trademarks and domain names in numerous countries all over the world.

6.5. The Domain Name is confusingly similar to the Complainant’s trademark LEGO. The fame of the trademark has been confirmed in numerous previous UDRP decisions. For an example, in *LEGO Juris A/S v. Level 5 Corp.*, WIPO Case No. [D2008-1692](#), the Panel held: “The Panel finds that the Complainant has established that LEGO and LEGOLAND are well-recognized and world-famous trademarks and that the trademarks are distinctive”. The Complainant also refers to *LEGO Juris A/S v. Michael Longo*, WIPO Case No. [D2008-1715](#): “The Panel finds, as numerous panels have found before, that the Complainant has established that LEGO is a well-known trademark and that the trademark is distinctive and famous”, and *LEGO Juris A/S v. Reginald Hastings Jr*, WIPO Case No. [D2009-0680](#): “LEGO is a mark enjoying high reputation as construction toys popular with children”.

6.6. In addition to the trademark LEGO, the Domain Name also comprises a term closely connected to the Complainant, namely: “brick”. In WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8, it is stated that, “[w]here 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”. In the present case, the suffix “brick” does not prevent a finding of confusing similarity between the Complainant’s trademark LEGO and the Domain Name.

6.7. The addition of the generic Top-Level Domains (“gTLD”) “.club” does not have any impact on the overall impression of the dominant portion of the Domain Name and is therefore irrelevant to determine the confusing similarity between the trademark and the Domain Name.

6.8. Summarizing this, the Complainant is the owner of the very well-known trademark LEGO. The Domain Name in question is clearly confusingly similar to said trademark.

6.9. The first element of the Policy, therefore, has been met.

### B. Rights or Legitimate Interests

6.10. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name. Neither has the Complainant found anything, including the Whols

details, that would suggest that the Respondent has been using, or is commonly known by, the Domain Name in any other way that would give them any rights or legitimate interests in the Domain Name. Consequently, the Respondent may not claim any rights established by common usage.

6.11. No license or authorization of any other kind has been given by the Complainant to the Respondent, to use the trademark LEGO. Further, the Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. Accordingly, the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name.

6.12 Further to [WIPO Overview 3.0](#), section 2.1, “[w]hile 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”.

6.13. LEGO is a famous trademark worldwide. As no evidence has been found that the Respondent is using the name LEGO as a company name or has any other legal rights in the name, it is quite clear that the Respondent is simply trying to benefit from the Complainant's world-famous trademark. The Domain Name consists of the LEGO mark and the term “brick”, which is closely associated with the Complainant's goods, and thus the composition of the Domain Name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1

6.14. The Respondent is not using the Domain Name in connection with a *bona fide* offering of goods or services. Instead, the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through a website that is commercial through sponsored links. Consequently, the Domain Name is being used for a commercial purpose.

6.15. Further to [WIPO Overview 3.0](#), section 2.9, “[a]pplying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users”. Here, the Domain Name is used to host a website displaying sponsored PPC links relating to the Complainant's services and redirecting users to competing third party websites, which does not represent a *bona fide* offering of goods or services.

6.16. Referring to the above mentioned, the Respondent has no rights or legitimate interest in respect of the Domain Name.

6.17. Finally, the Respondent is not making any legitimate noncommercial or fair use of the Domain Name. Accordingly, the second element of the Policy has been established.

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

6.18. Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith”:

- (i) circumstances indicating that the respondent has registered or has 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 the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

- (ii) that the respondent has registered the domain name in order to prevent the owner of the trade mark 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) that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 the respondent's website or location.

6.19. The trademark LEGO has the status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world. The awareness of the trademark LEGO is considered to be significant and substantial. The number of third-party domain name registrations comprising the trademark LEGO in combination with other words has always been attractive to domain name infringers. The considerable value and goodwill associated with the mark LEGO is proportionate to the amount of infringement it is subject to, and most certainly, what motivated the Respondent to register the Domain Names at issue here.

6.20. The Respondent registered the Domain Name on June 8, 2022. This date is subsequent to the Complainant's registered trademark LEGO in the United States and elsewhere, by decades. It is obvious that it is the fame of the trademark that has motivated the Respondent to register the Domain Name. That is, the Respondent cannot claim to have been using the trademark LEGO, without being aware of the Complainant's rights to it. Further to [WIPO Overview 3.0](#), section 3.1.4, "[p]anel have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith".

6.21. Further, supporting the Respondent's prior knowledge is the fact that it registered the additional domain name <legobuilds.us> on the same day it registered the Domain Name. While this additional domain name cannot be included in the instant case, the Complainant contends that registration of two domain names, containing the LEGO trademark, on the same day, is further evidence that the Respondent was well aware of the Complainant's LEGO trademark, and their rights in said mark, at the time of registration.

6.22. The Complainant first tried to contact the Respondent on August 4, 2022, through a cease and desist letter sent by email. The Complainant advised the Respondent that the unauthorized use of the LEGO trademark within the Domain Name violated the Complainant's rights in said trademark. The Complainant requested a voluntary transfer of the Domain Name and offered compensation for the expenses of registration and transfer fees (not exceeding out of pocket expenses). In spite of the reminders sent, the Respondent did not comply with the request. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process.

6.23. The Domain Name is connected to a website displaying PPC links, some of which are directly referring to the Complainant's business. Whether or not the Respondent has influenced what links should be included on the website is irrelevant for the finding of bad faith in this case. It is also without relevance whether or not the Respondent is actually getting revenue from the website himself. In *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#), the Respondent claimed that the website was created by the registrar, that had no knowledge of the content and that he had actually not received any money from the website. The panel then stated that "these facts do not exclude bad faith under paragraph 4(b)(iv) for the following reasons: (i) paragraph 4(b)(iv) requires the Respondent to intend to attract Internet users 'for commercial gain', but this gain does not need to be derived by the Respondent himself. The Respondent cannot infringe the Complainant's rights with impunity on the basis that it is allowing a third party to reap the profits of its wrongful conduct; (ii) the Respondent has at all times been in contractual control of the content

of the website at the disputed domain name, and had the power to instruct the Registrar to remove the parking page”. The same reasoning applies here.

6.24. The Complainant further submits that the Domain Name appears to be present with mail exchanger (“MX”) records. This shows that the Domain Name may be actively used for email purposes. Emails emanating from the Domain Name could not reasonably be used for any good faith purpose given the close similarity to the Complainant’s trademark. Instead, it is likely that the Domain Name may be actively used to facilitate fraudulent activities such as phishing, impersonating or passing off as the Complainant.

6.25. Previous UDRP panel decisions have considered the presence of MX records to be indicative of bad faith registration and use. See *Alain Afflelou Franchiseur v. Lihongbo, Lihongbo*, WIPO Case No. [D2020-2075](#), which noted “the disputed domain names indicate that the Respondent has connected the disputed domain names to e-mail servers, which creates a serious risk that the Respondent may be using the disputed domain names, which are confusingly similar to the Complainant’s trademark, for misrepresentations and/or phishing and spamming activities”.

6.26. Finally, the Panel finds that the Respondent most likely had the Complainant in mind when registering the Domain Name and intentionally sought to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s mark. In light of the above, and in the absence of any response to the Complaint from the Respondent, the Panel concludes that the Respondent registered and is using the Domain Name 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 Domain Name <legobrick.club> be transferred to the Complainant.

*/José Pio Tamassia Santos/*

**José Pio Tamassia Santos**

Sole Panelist

Date: February 24, 2023.