

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Raphael Haas, Melting Point Solutions Case No. D2023-0430

1. The Parties

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

The Respondent is Raphael Haas, Melting Point Solutions, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <brickolego.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2023. On January 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 1, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent an informal communication to the Center on February 2, 2023. The Complainant filed an amended Complaint on February 3, 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 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 23, 2023. The Respondent sent two additional informal communications to the Center on February 3, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on March 10, 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, through its subsidiaries and branches, sells “Lego” brand toys in more than 130 countries around the world including the United States. The range of products offered by the Complainant’s group under its LEGO trademark has expanded over time from toy building blocks and construction sets to include computer hardware and software, books, videos, and computer-controlled robotic construction sets.

The Complainant’s corporate group promotes its products from a website at “<https://www.lego.com/>”. According to the Complaint, the Complainant holds over 5,000 domain names.

As a result of its long use, and extensive advertising and promotion, the Complainant has developed a substantial and valuable reputation and goodwill in its LEGO trademark. For example, in 2014 *Time* magazine declared “Lego” to be the most influential toy of all time. Also, Superbrands UK in 2019 ranked the Complainant’s “Lego” brand as the number 1 consumer superbrand.

The Complaint includes a listing of numerous registered trademarks for LEGO owned by the Complainant around the world. The oldest claimed is a trademark registered in Denmark in 1934. Many others date from the 1950s and 1960s. In the United States, the Complainant owns a number of registered trademarks including:

- (a) Registered Trademark No. 1,018,875, LEGO, which has been registered since August 26, 1975, in respect of toy building blocks and related goods in International Class 28;
- (b) Registered Trademark No. 1,248,936, LEGO, which has been registered since August 23, 1983, in respect of a range of goods in International Classes 16, 20, 22, and 25; and
- (c) Registered Trademark No. 1,535,046, LEGO, which has been registered since January 24, 1989, in respect of computer peripherals and programs and plastic building units in International Class 9.

The disputed domain name was registered on December 20, 2021.

Until the Complainant sent the Respondent a cease and desist letter, the disputed domain name resolved to a website appearing to offer for sale various items such as a Christmas tree, a hat and CAD software or services using CAD software. The website featured a bold heading “Bricko - Building Creativity”. In the footer, in very small type it set out the legend “Bricko has no affiliation to LEGO the LEGO Group, and any related items, which are registered to LEGO Corporation” and then a search box.

On March 31, 2022, in response to a cease and desist letter from the Complainant, the Respondent sent an email which stated, “I am emailing you regarding the below inquiry. My 11-year-old son has set up a website called Brickolego with his friends. What seems to be the issue?”

In a subsequent letter on May 16, 2022, signed by Henry Haas and sent in response to an offer from the Complainant to pay the Respondent’s out-of-pocket costs in return for the transfer of the disputed domain name, the Respondent contested the Complainant’s demands but offered to transfer the disputed domain name in return for USD 6,380. This sum was said to constitute full reimbursement for:

Item	Value (\$ USD)
Domain Value	\$663
Cost of new Domain name	\$1,067
YTD marketing spend associated with “www.brickolego.com” [\$500/mo]	\$2,500
Lost branded inventory (t-shirts, hats)	\$650
Lost traffic associated with domain transfer	\$1,000
Re-coding website	\$500
Total	\$6,380

The Complainant did not accept this offer.

Currently, the disputed domain name resolves to a webpage: “404 Error – Page Not Found”.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the trademark LEGO.

Furthermore, the Panel accepts that the Complainant’s trademark is a famous or well-known trademark within the meaning of the Paris Convention for the Protection of Industrial Property, article 6*bis* and the Agreement on Trade-Related Aspects of Intellectual Property Rights, articles 16.2 and 16.3.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name consists of the Complainant’s registered trademark and the term “bricko”. As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) “before any notice to [the Respondent] of the dispute, [the Respondent’s] 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) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is 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.”

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name many years after the Complainant began using its trademark and also many years after the Complainant had registered its trademark, even in the United States. He (or his son) did so at a time when the trademark had achieved very well-known status.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. When it was active, the website to which the disputed domain name resolved appeared to be the website of someone called “Bricko”. That might explain the first two syllables of the disputed domain

name but it gives no warrant for the use of “lego”. The Respondent does not appear to hold any trademarks for the disputed domain name.

Having regard to the fame of the Complainant’s trademark and the apparent lack of any connection with the term “lego”, the Panel accepts the Complainant’s contention that the disputed domain name was being used before the Complainant’s cease and desist letters to attract the public to the Respondent’s website through its association with the Complainant’s trademark. That conclusion is reinforced by the resemblance of the “bricko” element of the disputed domain name to the name of the elements of the Complainant’s physical products – toy or model “bricks”.

That kind of opportunistic targeting of the Complainant’s trademark does not qualify as a good faith offering of goods or services under the Policy. See *e.g.*, paragraph 4(c)(iv) of the Policy.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

The basis on which the Respondent has adopted the disputed domain name, therefore, calls for explanation or justification. The Respondent, however, has not sought to rebut that *prima facie* case or advance any claimed entitlement. In its communications to the Center on February 3, 2023, the Respondent merely stated “We do not operate the website any longer. Why don’t you go check the url and get back to me.”

However, the fact that the Respondent took its website down only after receiving the cease and desist demands from the Complainant cannot exonerate the Respondent or provide a claim to rights or legitimate interests.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent: see *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Paragraph 4(b) identifies situations, which may demonstrate that registration or use of a disputed domain name was not in bad faith under the Policy. For present purposes, it is sufficient to note that the examples given in paragraph 4(b) include:

“(i) circumstances indicating that [the Respondent] has registered or [the Respondent has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of [the Respondent’s] documented out-of-pocket costs directly related to the [disputed] domain name; or ...”

and:

“(iv) by using the [disputed] domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent’s] web site or other on-line 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] web site or location.”

(The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which are caught by the Policy. See *Do The Hustle, LLC v Tropic Web*, WIPO Case No. [D2000-0624](#).)

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

There cannot be any real doubt about that in the present case having regard to:

- (a) the fame of the Complainant's trademark;
- (b) the inventive and distinctive nature of the term "lego";
- (c) the apparent lack of any connection of the Respondent with the term "lego"; and
- (d) the disclaimer on the Respondent's website.

The Panel does not accept the claim in the Respondent's email on March 31, 2022, that his son registered the disputed domain name with a number of friends. If by that claim the Respondent was intending to suggest some innocent noncommercial use, that is inconsistent with the way the disputed domain name was used. It is also inconsistent with the claim for out-of-pocket "expenses" to transfer the disputed domain name, which indicates (if accepted) that the disputed domain name was registered for a clear commercial purpose.

Whether it was the Respondent or the Respondent's son who registered the disputed domain name, therefore, its registration in the circumstances outlined in section 5B above brings the matter squarely within paragraph 4(b)(iv) and constitutes registration and use in bad faith under the Policy.

Further, even assuming the costs claimed in the Respondent's letter dated May 16, 2022, are genuine costs (which the Panel would not be prepared to do in the absence of corroborating objective documentation), they are not costs directly related to the disputed domain name itself. Moreover, paragraph 4(b)(i) of the Policy provides an example of registration and use in bad faith as such conduct leads to an inference that the disputed domain name was registered to profit from its resemblance to another person's trademark. Paragraph 4(b)(i) does not in terms provide a "defence" for someone who seeks to recover direct "out-of-pocket" costs.

Although it is not strictly necessary in these circumstances, the fact that the disputed domain name does not currently resolve to an active website does not assist the Respondent. As the Complainant contends, it has long been accepted that such passive holding of a domain name so closely resembling a well-known trademark constitutes both registration and, as in this case, use in bad faith. See *e.g.*, *Telstra Corporation v Nuclear Marshmallows* WIPO Case No. [D2000-0003](#).

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 name, <bricklego.com>, be transferred to the Complainant.

/Warwick A. Rothnie/
Warwick A. Rothnie
Sole Panelist
Date: March 24, 2023