

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Lyka Santos

Case No. D2023-0434

1. The Parties

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

The Respondent is Lyka Santos, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <legowars.beauty>, <legowars.club>, <legowars.ink>, <legowars.live>, <legowars.one>, <legowars.shop>, <legowars.wiki>, <legowars.world>, and <legowars.xyz> are registered with NameCheap, Inc. (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 names. On January 31, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names 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 February 8, 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 February 10, 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 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 9, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on March 17, 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 in this proceeding is Lego Juris A/S, the owner of the trade marks LEGO identifying in particular the well known construction toys. Few brands in the world enjoy a reputation as strong as LEGO, and this 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 trade mark LEGO is registered worldwide. The Complainant has submitted a whole trade mark portfolio and extracts relating to registrations of LEGO in the United States. For example, United States trade mark registration No. 1018875 for LEGO, registered on August 26, 1975.

The disputed domain names <legowars.beauty>, <legowars.club>, <legowars.ink>, <legowars.live>, <legowars.one>, <legowars.shop>, <legowars.wiki>, <legowars.world>, and <legowars.xyz> were all registered on July 12, 2022, through a privacy shield service. The identity of the Respondent, an individual allegedly domiciled in the United States, was disclosed by the Registrar in the course of this proceeding.

The disputed domain names are used for a Pay-Per-Click (“PPC”) scheme. The links differ from disputed domain name to disputed domain name, and some of them refer to toys and bricks.

5. Parties’ Contentions

A. Complainant

The arguments of the Complainant on the three elements of the Policy can be summarized as follows:

On the first element of the Policy, the Complainant highlights that the disputed domain names comprise the word “lego”, which reproduces its well known trade mark. They also contain the suffix “wars”, which does not diminish the confusing similarity between the disputed domain names and the trade mark LEGO. In fact, the Complainant argues that “[i]t is a long-established precedent that confusing similarity is generally recognized when well known trade marks are paired up with different kinds of generic prefixes and suffixes”. The Complainant also stresses that “[t]he addition of said trade mark is rather fitted to create an impression that the domain name is associated with Complainant as it holds license to develop, manufacture, and sell LEGO Star Wars products as part of a partnership with Lucas film Ltd”.

On the second element of the Policy, the Complainant alleges that the Respondent has no rights or legitimate interests over the disputed domain names: it does not own corresponding trade mark rights, and his name differs also from the disputed domain names. The Complainant indicates also that the Respondent has not been authorized in any manner to register and use the disputed domain names. Rather, the Complainant contends that the Respondent is simply trying to benefit from its well known trade mark, and is not using the disputed domain names in connection with a *bona fide* offering of goods and services: “[i]nstead, the Respondent has intentionally chosen domain names based on a registered trade mark in order to generate traffic and income through websites with sponsored links. By this, the Respondent is using the LEGO trade mark in order to mislead Internet users to commercial websites”.

On the third element of the Policy, the Complainant argues that its trade mark LEGO is well known and that this circumstance explains what motivated the Respondent in registering a series of the disputed domain

names that reflect it. In addition, “[t]he number of infringing domain names registered by the Respondent demonstrates that the Respondent is engaging in a pattern of cybersquatting, which is evidence of bad faith registration and use”. On bad faith use, the Complainant refers to the PPC scheme and adds that “[w]hether or not the Respondent had influenced what links should be included is irrelevant for the finding of bad faith in this case. It is also without relevance whether or not the Respondent was actually getting revenue from the websites himself”.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove all of the following three elements in order to be successful in the proceeding:

- (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 were registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain names are identical or confusingly similar to a trade mark or a service mark in which it has rights. The first criterion is perceived primarily as a standing requirement for the Complainant.

The Complainant has shown that it holds numerous rights over the trade mark LEGO.

The disputed domain names are all configured in the same way: they consist in the association of the words “lego” and “wars”, which are both recognizable even if they are not separated. The fact that the word “lego” is recognizable, in that it is immediately perceived, is sufficient for a finding of confusing similarity. The impact of the word “wars” will be assessed under paragraph 4(a)(iii), and the Top-Level Domains play no role in the comparison.

Hence, the first criteria element set out in paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent’s rights or legitimate interests in the disputed domain names. These circumstances are:

- i. before any notice of the dispute, the Respondent’s use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names 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 names, in spite of not having acquired trade mark or service mark rights; or
- iii. the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made out a *prima facie* case against the Respondent which has not been commonly known by the disputed domain names and is not affiliated with the Complainant nor has it been licensed or otherwise permitted to use any of the Complainant's trade marks or to register a domain name incorporating any of those trade marks.

The Panel is also of the view that the Respondent is not making a *bona fide* use of the disputed domain names, as the PPC links offered to Internet users are, to a large extent, based on the reputation of the trade mark LEGO. This is true at least for the links proposed in connection with "toys", "bricks", and "lego" themselves.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain names have been registered and are being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or
- (ii) [the respondent has] registered the domain name in order to prevent the complainant from reflecting the complainant's trade mark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) 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.

The Respondent deliberately elected a series of domain names that incorporate the famous brand LEGO of the Complainant, and which would be directly associated to it. By doing so, the Respondent has sought to create confusion in order to attract Internet users to his commercial websites. Such confusion is reinforced here by the addition of the suffix "wars", which is very likely to be perceived by Internet users as a shortened reference to the universe of "Star Wars", for which the Complainant holds a license. The Star Wars range of LEGO is among the most popular within the catalogue of the Complainant.

Likewise, the operation of PPC links which direct Internet users to competitors of the Complainant also characterizes the bad faith of the Respondent. This is true even if the content of these links is generated automatically. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition

(“[WIPO Overview 3.0](#)”), section 3.5, which states that “[p]articularly with respect to ‘automatically’ generated PPC links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links *ipso facto* vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith”.

Accordingly, the third criteria element set out in paragraph 4(a) of the Policy is also satisfied and the Complaint succeeds.

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 <legowars.beauty>, <legowars.club>, <legowars.ink>, <legowars.live>, <legowars.one>, <legowars.shop>, <legowars.wiki>, <legowars.world>, and <legowars.xyz> be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: March 31, 2023