

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Kristin Thakor

Case No. D2023-0599

1. The Parties

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

The Respondent is Kristin Thakor, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <lego1.net> 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 February 9, 2023. On February 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 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 13, 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 14, 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 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 12, 2023. The Respondent sent an email to the Center on February 27, 2023, but did not submit any formal response to the Complainant’s contentions. Accordingly, the Center notified the Parties on March 14, 2023 that it would proceed with the panel appointment.

The Center appointed Warwick Smith 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 is based in Denmark. It has subsidiaries and branches throughout the world, and its LEGO – branded construction toys and other LEGO – branded products are sold in more than 130 countries. One of those countries is the United States, where the Respondent resides.

The Complainant has produced evidence sufficiently establishing that its LEGO mark is famous around the world. Superbrands' list of the Official Top Ten Consumer Brands for 2019 showed LEGO as the number 1 consumer super brand. LEGO was number 8 in Superbrands' Consumer Relevancy Index. In 2014, Time announced that LEGO toys were the most influential toys of all time.

The Complainant is the owner of the mark LEGO in numerous countries around the world, in respect of construction toys, and various other products (now including computer hardware and software, books, videos, and computer – controlled robotic construction sets). It is not necessary to refer in this decision to all of the Complainant's trade mark registrations; it is enough for present purposes to record that the Complainant is the proprietor of the word (drawing) mark LEGO, registered on the Principal Register maintained by the United States Patent and Trademarks Office ("USPTO"), under number 1018875. The registration date was August 26, 1975, and the registration covers "toy building blocks and connecting links for the same", and various other goods in International Class 28.

The disputed domain name was registered on July 8, 2021. A screenshot of the website to which the disputed domain name resolves was produced by the Complainant. The website contained the statement "lego1.net is parked free courtesy of GoDaddy.com". There was a click-on link headed "Get this domain", and what appear to be Pay-Per-Click ("PPC") links headed "Lego building sets", "Toys", and "Lego Adult sets".

The Complainant sent cease and desist letters to the Respondent via the Registrar's online contact form, on September 4, 13, and 21, 2021. The Respondent did not reply.

5. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain name is confusingly similar to the mark LEGO, in which it has rights. It further says that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain was registered and is being used in bad faith.

On the "no rights or legitimate interests" issue, the Complainant says that it has not authorized the Respondent to use its LEGO mark, and there is nothing to suggest that the Respondent has been commonly known by the disputed domain name, or has any other claim to an interest in it. The Respondent has not been using the disputed domain name in connection with any *bona fide* offering of goods or services.

On the "registered and used in bad faith" issue, the Complainant says that it is obvious that it was the fame of the Complainant's LEGO mark that motivated the Respondent to register the disputed domain name. Anyone seeing the disputed domain name would assume that any website at the disputed domain name would be owned by or associated with the Complainant, and the disputed domain name resolves to a website displaying sponsored links that have obviously been provided for the purpose of deriving financial gain. The Respondent's registration and use of the disputed domain name fall within the category of bad faith registration and use described at paragraph 4(b)(iv) of the Policy – the Respondent has been using the

disputed domain name intentionally to attempt to attract Internet users to her website for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name.

The fact that the disputed domain name was registered using a privacy service, provides further evidence of bad faith registration and use.

B. Respondent

The Respondent did not formally reply to the Complaint. However, on February 27, 2023, she sent the following email to the Center:

"Good morning.

Our 7 yo must have set this up when playing around one day several years ago, we were unaware of this. However, after recovering our account and logging into our GoDaddy, our accounts, payments, etc have lapsed. Looking at the website per the photo below, GoDaddy seems to be the owner of the domain referenced.

Regards,
Kristin Thakor"

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to establish each of the following –

- (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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has proved this part of the Complaint.

The Complainant is the registered proprietor of the mark LEGO in the United States, and in numerous other jurisdictions around the world. That is sufficient for it to establish "rights" in that mark for the purposes of paragraph 4(a)(i) of the Policy.

The next issue is whether the disputed domain name is confusingly similar to the LEGO mark.

The consensus view of UDRP panels on the issue of confusing similarity where a complainant's mark is incorporated within a disputed domain name, is described as follows in the [WIPO Overview 3.0](#):¹

"Where 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 this case, the LEGO mark is incorporated in full within the disputed domain name, the only addition being

¹ WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.8.

the digit “1” immediately after the “lego”. The LEGO mark is clearly recognizable within the disputed domain name, and the level of visual similarity between the mark and the disputed domain name is very close. The confusing similarity between the disputed domain name and the LEGO mark is clear.

For completeness, the Panel notes that generic Top-Level Domains (“gTLDs”) such as “.net” are not normally taken into account in the comparison that is required by paragraph 4(a)(i) of the Policy. The gTLD is a technical requirement of registration, and is not normally considered to have legal significance in applying paragraph 4(a)(i) of the Policy.²

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy set out a number of circumstances which, without limitation, may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a domain name for the purposes of paragraph 4(a)(ii) of the Policy. The circumstances are –

- (i) Before any notice to [the respondent] of the dispute, use by [the respondent] 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) Where [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 trade mark or service mark rights; or
- (iii) Where [the respondent is] making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly direct consumers or to tarnish the trade mark or service mark at issue.

[WIPO Overview 3.0](#) states the following on the burden of proof under paragraph 4(a)(ii) of the Policy:

“While 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.”³

In this case, the disputed domain name is confusingly similar to the Complainant’s LEGO mark, which the Panel accepts was well known around the world when the disputed domain name was registered. The Respondent has not been licensed or otherwise authorized to use the Complainant’s LEGO mark, or any confusingly similar expression. The disputed domain name has not been used in connection with any *bona fide* offering of goods or services, and there is nothing to suggest that the Respondent is or has been commonly known by the disputed domain name.

There was nothing in the evidence produced by the Complainant to suggest that the Respondent might have a claim to a right or legitimate interest in respect of the disputed domain name, and the absence of any such rights or interests was effectively acknowledged by the Respondent in her email to the Center dated February 27, 2023 (in which she contended that the disputed domain name must have been registered, inferentially without the Respondent’s authority, by the Respondent’s seven-year-old child).

² [WIPO Overview 3.0](#), section 1.11.

³ [WIPO Overview 3.0](#), section 2.1.

Those matters in combination are sufficient to establish a *prima facie* case under paragraph 4(a)(ii) of the Policy. The evidential burden of showing rights or legitimate interests in respect of the disputed domain name therefore moves to the Respondent. In the absence of any Response, the Respondent has failed to discharge that evidential burden, and the Complainant's *prima facie* proof must prevail. The Complainant has made out its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, the following circumstances, without limitation, are deemed (if found by the Panel to be present) to be evidence of the registration and use of a domain name in bad faith –

- (i) Circumstances indicating that the holder 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 trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) The holder 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 holder has engaged in a pattern of such conduct; or
- (iii) The holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder'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 holder's website or location or of a product or service on the holder's website or location.

The Complainant has also sufficiently proved this part of the Complaint.

By July 2021, when the disputed domain name was registered, the fame of the Complainant's LEGO mark around the world was such that it is virtually certain that the Respondent would have been aware of it. Consistent with that, the Respondent did not deny knowledge of the Complainant and its mark when she sent her email to the Center on February 27, 2023.

Any domain name registrant who had heard of the Complainant and its LEGO construction toys could not have failed to appreciate that, if the disputed domain name were registered, many Internet users coming across it would wrongly assume that it must be owned (or at least endorsed) by the owner of the famous LEGO mark. In the absence of a Response, the Panel concludes that creating confusion of that sort was precisely what the registrant intended, and that the registration of the disputed domain name was motivated by a bad faith desire to trade off the Complainant's reputation in the LEGO mark, with a few to attracting Internet users to a website to be established at the disputed domain name.

The Respondent's email to the Center dated February 27, 2023, appears to suggest that the disputed domain name was somehow registered by her seven-year-old child. That appears to be an implausible explanation, and in the absence of a properly certified Response explaining how that could have occurred without the Respondent's knowledge and approval, the Panel rejects it.

For the above reasons, the Panel concludes that the disputed domain name was registered, by the Respondent, in bad faith.

The Complainant is also required to show that the disputed domain name is being used in bad faith. The evidence clearly shows that it is. The disputed domain name resolves to a website containing what appear to be PPC sponsored links to third party websites, under headings that include "Lego building sets", "Toys",

and “Lego Adult sets”. The links use the Complainant’s LEGO mark without its consent, and they are obviously intended to create an impression of endorsement or association with the Complainant and its products.

The circumstances fall squarely within paragraph 4(b)(iv) of the Policy. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant’s LEGO mark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name.

The sponsored links would not have been placed on the website at the disputed domain name if the intention were not to derive financial benefit, and it does not matter if the links were placed on the website by the Registrar, or by some other party. UDRP panels have consistently held that a respondent cannot disclaim responsibility for such content appearing on its website.⁴

That is enough to resolve the Complaint in the Complainant’s favor. The Complainant has successfully established that the disputed domain name was registered and is being used in bad faith. For the reasons set out above, there will be an order transferring the disputed domain name to the Complainant.

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 name <lego1.net> be transferred to the Complainant.

/Warwick Smith/

Warwick Smith

Sole Panelist

Date: March 22, 2023

⁴ [WIPO Overview 3.0](#), section 3.5. See also *Villeroy & Bosch AG v. Mario Pingerna*, WIPO Case [D2007-1912](#).