

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Vasilij Kozmin

Case No. D2023-1134

### **1. The Parties**

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

The Respondent is Vasilij Kozmin, United Kingdom.

### **2. The Domain Names and Registrars**

The disputed domain names <legoglym.site>, <legokpvnq.site>, <legolertl.site>, <legoonvrp.site>, <legoqaiyn.site>, and <legosbmid.site> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 15, 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 (“GDPR Masked”) and contact information in the Complaint.

The Center sent an email communication to the Complainant also on March 15, 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 March 17, 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 March 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on April 19, 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 uses the LEGO trademark to identify *inter alia* construction toys, computer hardware and software, books, videos and computer controlled robotic construction sets.

The Complainant is the owner of hundreds of trademark registrations for LEGO around the world (Annex 3 to the Amended Complaint) amongst which the United Kingdom trademark registration No. UK00000844309 for LEGO, registered on January 25, 1963, and Canadian trademark registration No. 236250 for the word mark LEGO, filed on June 14, 1956, registered on April 26, 1957 and subsequently renewed.

The disputed domain names are the following:

Disputed domain name	Registration Date	Present Use
<legoglym.site>	January 30, 2023	Active website reproducing the Complainant's product and offering links to an online shop.
<legokpvnq.site>	January 30, 2023	No active webpage.
<legolertl.site>	January 30, 2023	No active webpage.
<legoonvrp.site>	January 27, 2023	No active webpage.
<legoqaiyn.site>	January 27, 2023	No active webpage.
<legosbmid.site>	January 30, 2023	No active webpage.

As evidenced by the Complainant, all the disputed domain names with the exception of <legolertl.site> resolved to an active website reproducing the Complainant's products offering links to an online shop.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant asserts to own one of the best-known trademarks in the world, having been ranked number 1 at the top 20 Consumer Superbrands for 2019 by Superbrands United Kingdom in the category "Child Products – Toys and Education" (Annex 6.1 to the Amended Complaint), as well as having been announced by Time as the "Most Influential Toy of All Time" (Annex 6.3 to the Amended Complaint). The Complainant further asserts that its group sells LEGO products in more than 130 countries, having the LEGO trademark acquired substantial inherent distinctiveness, deserving the special protection awarded to well-known trademarks foreseen in the Paris Convention and the TRIPs Agreement.

According to the Complainant, the dominant part of the disputed domain names comprises the registered and very well-known trademark LEGO and the addition of the suffixes "qaiyn", "glylm", "kpvnpq", "lertl", "onvrp" and "sbmid" do not diminish the confusing similarity between the disputed domain names and the Complainant's trademark.

As to the absence of rights or legitimate interests, the Complainant argues that:

- (i) it has not found any trademarks or trade names registered by the Respondent corresponding to the disputed domain names, nor has it found anything that would suggest the Respondent's legitimate interests or rights in the disputed domain names;

- (ii) no license or authorization of any kind has been given by the Complainant to the Respondent to register the disputed domain names, not ever having the Respondent been in a business relationship with the Complainant; and
- (iii) the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services given that previous websites available at <legoqaiyn.site>, <legoglylm.site>, <legoonvrp.site> and <legosbmid.site> reproduced the Complainant's logotype without consent, as well as the website at <legosbmid.site> features prices for the LEGO Eiffel Tower product it advertises in it, what cannot be considered a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain names.

Lastly, the Complainant points out that given the fame of the LEGO trademark worldwide, including in the United Kingdom, the Respondent chose the disputed domain names to attract visitors to websites to generate traffic and income, not being the present passive holding of part of the disputed domain names capable of eluding the Respondent's bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain names transferred to it, according to paragraph 4(a) of the Policy.

In accordance with paragraph 14(b) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

### **A. Identical or Confusingly Similar**

The Complainant has established its rights in the trademark LEGO duly registered in several jurisdictions around the world.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". ([WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#), section 1.7).

The Complainant's famous trademark is entirely reproduced in the disputed domain names and the addition of the suffixes "qaiyn", "glylm", "kpvnc", "lertl", "onvrp", and "sbmid", in this Panel's point of view, does not prevent a finding of confusing similarity between the disputed domain names and the trademark.

For the reasons above, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate the Respondent's rights to 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, even if it has acquired no trademark 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 trademark or service mark at issue.

The Panel notes that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The burden of production has therefore shifted to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests.

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 such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules.

As seen above, most of the disputed domain names are presently passively held whereas one of them is still used in connection with an active website reproducing the Complainant's product and offering links to an online shop, as had taken place with the majority of the disputed domain names in the past. Indeed such use cannot be considered here a *bona fide* offering of goods or services nor legitimate noncommercial or fair use under the Policy. The Panel notes that the website has a blog format, showing different type of products along with the Complainant's products, and a link to an online shop for gardening and outdoor products (apparently unrelated to the Complainant's products). The Panel considers that the reproduction of the Complainant's trademark in its entirety within the disputed domain names, along with their use, shows the Respondent's attempt to attract Internet users taking an unfair advantage of the Complainant's trademark.

In addition to that, the Complainant indeed states that no authorization, license, permission or consent was granted for the use of LEGO in the disputed domain names.

Furthermore, the absence of any trademarks registered by the Respondents corresponding to the disputed domain names corroborates with the indication of the absence of a right or legitimate interest.

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.

The second element of the Policy has also been met.

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

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant who is the owner of a trademark relating to the disputed domain names or to a competitor of the

Complainant, for valuable consideration in excess of the Respondents' documented out-of-pocket costs directly related to the disputed domain names; or

- (ii) the Respondent has registered the disputed domain names in order to prevent the owner of the trademark 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) the Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other 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 registration and use of the disputed domain names in bad faith can be found in the present case in view of the following circumstances:

- (i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain names;
- (ii) the well-known status of the Complainant's trademark and the nature of the disputed domain names;
- (iii) at least five of the disputed domain names resolved to almost identical webpages, along with the potential use in connection with online shops reproducing the Complainant's trademark and products, along with products of third parties; and
- (iv) the indication of a faulty address in the Whois data and, consequently, the Center not being able to have the Written Notice fully delivered to the Respondent.

Further, the Panel finds that the current non-use of five of the disputed domain names does not prevent a finding of bad faith.

For the reasons stated above, the Panel finds that the disputed domain names were registered and are being used in bad faith.

The Panel finds that the disputed domain names were registered and are being used in bad faith. The third element of the Policy has therefore been met.

## **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 <legoglylm.site>, <legokpvnq.site>, <legolertl.site>, <legoonvrp.site>, <legoqaiyn.site>, and <legosbmid.site> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: May 3, 2023