

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Reg Walters
Case No. D2023-3063

1. The Parties

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

The Respondent is Reg Walters, Australia.

2. The Domain Name and Registrar

The disputed domain name <legomasters.online> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 24, 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 July 26, 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 August 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2023. On August 9, September 15 and September 18, 2023, the Center received several email communications from one of the email addresses provided by the Complainant for the Respondent.

The Center appointed Steven A. Maier as the sole panelist in this matter on September 25, 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 a company located in Denmark. It is a manufacturer of construction toys under the name and trademark LEGO.

The Complainant is the owner of numerous registrations for the trademark LEGO, including for example:

- European Union Trade Mark registration number 000039800 for the word mark LEGO, registered on October 5, 1998; and
- Australia Trademark registration number 129258 for the word mark LEGO, registered on September 17, 1956.

The disputed domain name was registered on March 18, 2023.

The Complainant provides evidence that the disputed domain name has resolved to a website at "www.legomasters.online", headed "Lego Masters" and offering the Complainant's products for sale online.

At the dates of the Complaint and of this Decision, the disputed domain name did not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant submits that its trademark LEGO is among the world's best known trademarks and that its products are sold in over 130 countries worldwide. It submits evidence of a portfolio comprising hundreds of trademarks for LEGO and states that it owns over 5,000 domain name registrations including that term. The Complainant also provides evidence of the recognition of its brand and trademark by, e.g., Superbrands UK, the Reputation Institute and others.

The Complainant submits that the disputed domain name is identical or confusingly similar to its LEGO trademark. It contends that the disputed domain name comprises that trademark together with the dictionary term "masters", which does not prevent the disputed domain name from being confusingly similar to its trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has not authorized the Respondent to use its LEGO trademark, that the Respondent is not one of its authorized dealers, and that the Respondent has no independent trademark or other rights in respect of the LEGO name.

As to the Respondent's use of the disputed domain name, the Complainant submits that the Respondent cannot meet the criteria set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), for the legitimate use of a third-party trademark within a domain name. It states in particular that the Respondent's website fails adequately to disclose its relationship, or the lack thereof, with the Complainant and therefore conveys the false impression that it is legitimately affiliated with the Complainant. The Complainant exhibits a passage headed "Disclaimer" on the Respondent's website, which states that the Respondent is an Amazon Associate and that customers of the website are customers of Amazon rather than the Respondent.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It states that its trademark LEGO is a well-known trademark and cites numerous prior cases under the UDRP as having made findings to that effect.

The Complainant further submits that it is a participant in a reality television show named “Lego Masters”, in which teams compete in various challenges to build LEGO creations. The Complainant states that the TV show is currently airing in Australia, where the Respondent resides, amongst other countries.

The Complainant submits that the Respondent was obviously aware of its LEGO trademark when it registered the disputed domain name, since it has used the disputed domain name for the unauthorized sale of the Complainant’s products.

The Complainant exhibits correspondence between itself and an individual purporting to be the owner of the disputed domain name in April and May 2023. The correspondence includes intemperate and at times abusive responses from that individual, referencing the “Lego Masters” TV show in Australia and making clear that the disputed domain name will not be transferred. The Complainant submits that it is clear from this correspondence that the Respondent was aware of its use of “Lego Masters” as well as the LEGO trademark.

The Complainant contends that, since the disputed domain name is liable to mislead Internet users into believing that it must be legitimately associated with the Complainant, the Respondent has used the disputed domain name intentionally to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant’s LEGO trademark as to the source, sponsorship, affiliation or endorsement of that website.

The Complainant submits that the Respondent’s subsequent non-use of the disputed domain name does not prevent a finding of bad faith in the proceeding, and relies in this regard upon *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not file a Response in the proceeding. In the emails received by the Center referenced above, the sender (being the same individual with whom the Complainant had been in correspondence) indicated that he was no longer the owner of the disputed domain name.

In the view of the Panel, the Registrar-disclosed registrant remains the proper Respondent in the proceeding and the Panel does not consider the correspondence and emails referenced above to be material to this Decision.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 established that it is the owner of registered trademark rights in the mark LEGO. The disputed domain name incorporates that trademark, together with the word “masters”, which does not prevent the Complainant’s trademark from being recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent has used the disputed domain name for the purpose of a website offering the Complainant’s products for sale. The Panel finds that the Respondent was not authorized by the Complainant to do so, or otherwise to use its LEGO trademark. Nevertheless, in certain limited circumstances, it may be permissible for an unauthorized supplier of goods or services to use a domain name which incorporates another party’s trademark for the purpose of offering that trademark owner’s goods or services. The criteria accepted by previous UDRP panels for such legitimate use are set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and are further discussed in section 2.8.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Those criteria include the requirements that:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder;
and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

While the Panel finds that the first, second and fourth criteria may have been satisfied in this case, the Panel accepts the Complainant’s submission that the Respondent’s website has failed accurately or prominently to disclose the Respondent’s relationship with the Complainant, *i.e.*, that the Respondent is not an authorized dealer for the Complainant’s products and that there is no commercial relationship between them. The supposed “disclaimer” on the website, referring to Amazon, does not address this issue and the Panel has seen no evidence of any other material on the Respondent’s website that would make the position clear to Internet users.

In the circumstances of the Respondent having used the disputed domain name for the resale of the Complainant’s goods, but in a manner that does not satisfy the *Oki Data* criteria, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Panel infers from the Respondent’s use of the disputed domain name that it was aware of the Complainant’s LEGO trademark at the date it registered the disputed domain name. Even if disregarding the prior use (given the present inactive state of the disputed domain name) the fame of the Complainant’s LEGO trademark and its use of the “Lego Masters” name for a competition in Australia, where the Respondent is reportedly located, makes it more likely than not that the Respondent was aware of the Complainant at the time the disputed domain name was registered.

The Respondent has adopted of the Complainant’s LEGO trademark within the disputed domain name for the purposes of selling the Complainant’s products. However, the Respondent is neither authorized by the Complainant to use its LEGO trademark, nor has the Respondent made clear by way of any adequate disclaimer that it is unauthorized by, and commercially independent of, the Complainant. The Panel finds in those circumstances that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel accepts the Complainant's submission that the Respondent's subsequent non-use of the disputed domain name does not preclude a finding of bad faith in these circumstances. The Panel finds that the Respondent registered and has used the disputed domain name in bad faith and that its continued holding of the disputed domain name constitutes a threat to continue to make improper use of it.

The Panel finds in the circumstances that the disputed domain name has been registered and is being used 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 disputed domain name <legomasters.online> be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: October 9, 2023