

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Oleg Budak
Case No. D2023-4950

1. The Parties

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

The Respondent is Oleg Budak, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <лего.site> (<xn--c1adro.site>) is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on November 28, 2023. On November 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 29, 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 (Protection of Private Person) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 5, 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 in English on December 6, 2023.

On December 5, 2023, the Center informed the Parties in Russian and English, that the language of the Registration Agreement for the disputed domain name is Russian. On December 6, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in both English and Russian of the Complaint, and the proceedings commenced on December 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 9, 2024.

The Center appointed Alissia Shchichka as the sole panelist in this matter on January 23, 2024. 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 organized under the laws of Denmark that is the worldwide well-known producer of LEGO branded construction toys and related LEGO products. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the Russian Federation.

The Complainant has evidenced to be the registered owner of numerous trademarks worldwide relating to its trademarks LEGO and ЛЕГО (LEGO in Cyrillic characters), including, but not limited, to the following:

- Russian Federation Trademark registration No. 74727, registered on January 30, 1984, for the word mark ЛЕГО, in class 28;
- Russian Federation Trademark registration No. 161589, registered on February 19, 1998, for the figurative mark ЛЕГО, in class 28;
- Russian Federation Trademark registration No. 42932, registered on December 10, 1971, for the word mark LEGO, in class 28.

Moreover, the Complainant has evidenced to own nearly 5,000 domain names containing the term "lego".

The Respondent, as per the disclosed by the Registrar, for the disputed domain name, is a resident of the Russian Federation and the disputed domain name was registered on October 12, 2023.

The disputed domain name currently displays an inactive webpage. According to the evidence provided by the Complainant, the Respondent has used the disputed domain name to resolve to a website where electronic products, not associated with the Complainant, were offered for sale.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant asserts that the LEGO trademark has achieved global recognition as one of the most well-known trademarks. The brand's outstanding reputation is reflected in its consistent top rankings, such as being the No. 1 Consumer Superbrand in 2019 and the Most Reputable Global Company in 2020. With a century-long legacy of delivering high-quality goods and services, LEGO stands as a world-famous and widely acknowledged trademark.

The Complainant asserts that the disputed domain name is an internationalized domain name (“IDN”) with the punycode translation of <xn--c1adro.site>, which translates to <лeгo.site>, and is considered to be confusingly similar to their LEGO and ЛЕГО trademarks. The generic suffix “.site” is deemed insufficient to prevent confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name since (1) the Complainant has never licensed, contracted, or otherwise permitted the Respondent to apply to register the disputed domain name, (2) the Respondent is not commonly known by the disputed domain name, and has not used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services, (3) the Respondent has misused the disputed domain name, currently redirecting users to an error page and previously using it to drive traffic and generate income through a commercial website selling electronic products unrelated to the Complainant.

Lastly, the Complainant argues that the Respondent has registered and is using the disputed domain name in bad faith due to the following reasons: (1) the Complainant’s LEGO trademark is well known and famous worldwide, (2) the Respondent’s use of the disputed domain name to attract visitors to its website indicates a deliberate targeting of the Complainant’s well-known LEGO trademark for commercial gain, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of its website.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is English. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons. Firstly, the Complainant is unable to communicate in Russian, and translating the Complaint would unfairly burden and disadvantage it, potentially causing delays in the proceedings. Secondly, given the abusive nature of the disputed domain name and website, any additional delay poses a continuing risk to the Complainant and unsuspecting consumers seeking its products.

Furthermore, the website associated with the disputed domain name contained phrases in English, and the term “лeгo” which is the dominant part of the disputed domain name, translates to “lego” in English without carrying any specific meaning in Russian. Lastly, the Complainant argues that, considering the circumstances and the Respondent’s behavior disrupting the Complainant’s business, it would unduly burden the Complainant to arrange and pay for translation.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

The Panel notes that the Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a response or any objections to the Complainant's request that the proceeding be conducted in English.

The Panel is proficient in both English and Russian, capable of reviewing all the documents and materials in both languages and giving full consideration to the Parties' respective arguments.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the disputed domain name incorporates the Complainant's ЛЕГО (LEGO in Cyrillic characters) trademark in its entirety. The Panel also considers that the Top-Level Domain ".site" shall be disregarded as it is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the LEGO and ЛЕГО trademarks or to seek registration of any domain name incorporating the trademarks. The Respondent is also not known to be associated with the LEGO and ЛЕГО trademarks, and there is no evidence showing that the Respondent has been commonly known by the disputed domain name. [WIPO Overview 3.0](#), section 2.3.

As evidenced by the Complainant, the disputed domain name was previously associated with a website that marketed various third party products. Therefore, the disputed domain name has not been used in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to profit from the goodwill of the Complainant's trademarks. Paragraphs 4(c)(ii) and 4(c)(iii) of the Policy and [WIPO Overview 3.0](#), sections 2.2 and 2.4.

Indeed, the disputed domain name, being pointed to an inactive page, is currently passively held. In view of the Respondent's default and given the substantial reputation and goodwill of the Complainant's trademark, the Panel shares the view held in *Teachers Insurance and Annuity Association of America v. Wrecks Communications Group*, WIPO Case No. [D2006-0483](#), where the panel found that, absent some contrary evidence from a respondent, the passive holding of a domain name does not constitute legitimate noncommercial or fair use.

Finally, the Panel also notes that the composition of the disputed domain name, carries a high risk of implied affiliation as it effectively impersonates the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Complainant has provided evidence supporting its prima facie claim that Respondent lacks any rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Therefore, the Panel concludes that the Respondent does not have any rights or legitimate interests in the disputed domain name and the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's well-known LEGO and ЛЕГО trademarks substantially predate the Respondent's registration of the disputed domain name. Therefore, the Respondent knew or should have known of the Complainant's trademarks at the time of registering the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

Further, the mere registration of the disputed domain name that is identical to the Complainant's widely known trademarks by the Respondent, who is unaffiliated with the Complainant, can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

As regards the use in bad faith of the disputed domain name, the Respondent has previously 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. Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Upon reviewing the available evidence, the Panel concludes that the current non-use of the disputed domain name does not preclude a finding of bad faith, as established in the landmark UDRP decision *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

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 <лeгo.site> (<xn--c1adro.site>) be transferred to the Complainant.

/Alissia Shchichka/

Alissia Shchichka

Sole Panelist

Date: February 6, 2024