

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Name Redacted

Case No. D2024-0385

1. The Parties

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

The Respondent is Name Redacted¹.

2. The Domain Name and Registrar

The disputed domain name <legobrick.shop> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 29, 2024. On January 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 29, 2024, 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 (Contact Privacy Inc. Customer 0168246503) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 31, 2024, 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 2, 2024.

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”).

¹ The Complainant requested for the redaction of the Respondent’s name. In light of the potential confusion regarding the non-existing connection between the Complainant and the Respondent, the Panel orders that the Respondent’s name be redacted from this decision. The Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision should not be published due to the exceptional circumstances of this case.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 28, 2024.

The Center appointed Theda König Horowicz as the sole panelist in this matter on March 13, 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 part of the LEGO Group with headquarters in Denmark. The LEGO Group is well known for producing construction toys including plastic molded brick available in a wide assortment of colors, sizes, and shapes. It has expanded over the years into computer hardware and software, books, videos, and computer controlled robotic construction sets. The LEGO goods are sold worldwide through licensee's who are authorized to exploit the Complainant's intellectual property rights and through subsidiaries and branches established throughout the world.

The Complainant holds trademark registrations for LEGO in multiple jurisdictions, including the European Union Trade Mark Registration No. 000039800, in classes 3, 9, 14, 16, 20, 24, 25, 28, 38, 41, and 42, registered on October 5, 1998 ("LEGO Mark"). The trademark has been recognized as famous in surveys.

The Complainant has also registered over 5,000 domain names that incorporate "lego", including <lego.com>, which it uses in connection with a website where it provides information about itself and its products.

The Respondent is apparently an individual resident in the Czech Republic. The disputed domain name was registered on August 21, 2023, and was linked to a website purportedly offering for sale LEGO miniature sports cars. The website is currently inactive.

The Complainant tried to contact the Respondent on September 20, 2023, through a cease-and-desist letter sent by email. The Complainant advised the Respondent of the unauthorized registration and use of the LEGO trademark within the disputed domain name. In spite of this letter, no reply was ever received.

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 contends that:

a) It is the owner of the LEGO Mark, having registered the LEGO Mark in the European Union and various other jurisdictions. The disputed domain name is confusingly similar to the famous LEGO Mark as it reproduces the LEGO Mark and adds the additional element "brick" which is intrinsic to the Complainant's goods (along with the ".shop" generic Top-Level Domain).

b) There are no rights or legitimate interests held by the Respondent in respect of the disputed domain name. The Complainant has not granted any license or authorization for the Respondent to use the LEGO Mark. The Respondent has no any registered trademarks or trade names corresponding to the disputed domain name. There is no evidence that the Respondent is commonly known by the disputed domain name,

being underlined that LEGO is a well-known trademark worldwide on which the Complainant has exclusive rights. Additionally, the Respondent does not use the disputed domain name in connection with a bona fide offering of goods or services. Indeed, the Respondent initially redirected the disputed domain name to its own commercial website. Its current passive holding of the disputed domain name lacks of rights or legitimate interests notably considering the famous character of the LEGO brand. Furthermore, the disputed domain name was set up by the Respondent with an email enabling Mail Exchange ("MX") record which is another indication that the Respondent lacks rights or legitimate interests in the disputed domain name.

c) Given the reputation of the Complainant and the LEGO Mark, the Respondent must have been aware of the Complainant at the time it registered the disputed domain name. The lack of response to the Complainant's cease-and-desist letter along with the use of the disputed domain name which was resolving to a commercial website for which it likely received revenue, the Respondent was using the disputed domain name to divert Internet users searching for the Complainant for commercial gain. Such conduct amounts to registration and use of the disputed domain name in bad faith. The current passive holding does also qualify as a bad faith use in the context of the case. Furthermore, the disputed domain name appears to be present with MX records and the Respondent employed a privacy service to hide his identity when registering the disputed domain name. These elements are additional indications of bad faith use under the Policy.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements with respect to the disputed domain name:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

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 the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "brick" may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

In the present case, the Complainant established that it has not granted any license or authorization for the Respondent to use the well-known LEGO Mark. It also established that the Respondent did use the disputed domain name in order to commercialize products by using the LEGO brand without authorization. Furthermore, the disputed domain name was set up by the Respondent with an email enabling MX records.

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

The Respondent did not respond to the Complaint. The Respondent did consequently not provide any evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. In particular, the Respondent did not show that he would have legitimately acquired any registered trademarks or trade names corresponding to the disputed domain name or that he would be commonly known by the disputed domain name.

As a matter of fact, the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

Based on these circumstances, 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 disputed domain name was registered in 2023, years after the registration of the Complainant’s LEGO trademark, including in the European Union, where the Respondent is apparently located. The disputed domain name wholly incorporates the LEGO trademark as its initial element, in combination with the word “brick” as a direct reference to the Complainant’s goods. Along with the well-known character of the LEGO trademark, this combination demonstrates an awareness by the Respondent of the Complainant, its mark, and its operations. Accordingly, the Panel finds that the Respondent registered the disputed domain name with the LEGO mark in bad faith.

The disputed domain name resolved to a website purportedly commercializing LEGO miniature sports car without any prominent or accurate disclaimer. The Respondent was thus using the disputed domain name to divert Internet users searching for the Complainant for commercial gain. The current passive holding of the disputed domain name does also qualify as a bad faith use in the context of this case, notably due to the unauthorized use of the Complainant’s well-known LEGO Mark.

The lack of response to the Complainant's cease-and-desist letter along with the facts that the disputed domain name appears to have MX records activated and that the Respondent employed a privacy service to hide his identity when registering the disputed domain name are additional indications of registration and use in bad faith under the Policy.

Therefore, 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 <legobrick.shop> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: April 15, 2024