

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Stanley Gromer
Case No. D2024-0575

1. The Parties

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

The Respondent is Stanley Gromer, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <lego.wales> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 8, 2024. On February 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 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 13, 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 13, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 18, 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 the well-known Denmark based company for LEGO construction toys and owns numerous trademarks for LEGO for decades in several jurisdictions around the world (Annexes 3 and 6 to the Complaint).

The Complainant owns, inter alia, the following LEGO trademark registrations:

- United Kingdom Trademark, Registration No. UK00000844309, registered on January 25, 1963;
- United States Trademark, Registration No. 1018875, registered on August 26, 1975;
- European Union Trademark, Registration No 39800, registered October 5, 1998.

The Complainant further owns (amongst many others) the domain name <lego.com> which addresses the official LEGO website (Annex 5 and 7 to the Complaint).

The disputed domain name was registered on November 30, 2023 (Annex 2 to the Complaint).

At the time of filing this Complaint, no website with active content was connected to the disputed domain name; however, the Respondent has established MX records for the disputed domain name (Annex 8 to the Complaint).

A cease-and-desist letter was sent by the Complainant on December 15, 2023 (Annex 9 to the Complaint), in which the Complainant requested the transfer of the disputed domain name, and offered to reimburse the Respondent for any fees directly related to the transfer. The Respondent replied to the cease-and-desist letter and agreed to transfer the disputed domain name to the Complainant, if the Complainant makes a “generous donation to an unrelated entity. The Complainant merely offered to reimburse the fees directly related to the registration of the disputed domain name; the Respondent denied to transfer the disputed domain name (Annex 10 to the Complaint).

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 the LEGO trademark is distinctive, famous, and well-known around the world. The Complainant notes that the disputed domain name contains the LEGO trademark in its entirety. The Complainant submits that it is therefore inconceivable that the Respondent would not have been aware of the Complainant's trademark when registering the disputed domain name, or that there would be any legitimate use for the disputed domain name. Further, the Complainant has never assigned, granted, licensed, or in any way authorized the Respondent to register or use the LEGO trademark in any manner.

Further, the Complainant notes that the disputed domain name does not resolve to an active website, and is therefore not used for a bona fide offering of goods or services. Moreover, the passive holding of a domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark.

Finally, the Complainant asserts that the Respondent has established MX records for the disputed domain name, which strongly implies that the disputed domain name could be used as part of an email phishing scheme in the future.

Hence, the Complainant contends, that based on the totality of these factors, it is clear that the Respondent is acting in bad faith with the intent to create a likelihood of confusion with the Complainant's mark and legitimate website.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (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 with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered or 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.

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

The Top-Level Domain ("TLD") is typically viewed as a standard registration requirement and as such is disregarded under the first element identity or confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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.

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

Having reviewed the 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, since it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the LEGO trademark in any manner.

The Respondent is not known under the disputed domain name and the disputed domain name is not being used for a bona fide offering of goods or services.

Furthermore, the nature of the disputed domain name, and the fact that the entirety of the mark LEGO is reproduced within and is identical to the Complainant's mark, cannot be considered fair use as these falsely suggest an affiliation with the Complainant that does not exist. [WIPO Overview 3.0](#), section 2.5.

The Respondent did not reply and hence has not rebutted the Complainant's contentions.

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

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy, both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith; and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark LEGO, long before the registration of the disputed domain name. Further, the trademark LEGO is distinctive, well-known and famous around the word.

Because of the fame of the LEGO mark, it is inconceivable for this Panel that the Respondent has registered and used the disputed domain name without knowledge of the Complainant's rights. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity (as it is in the present case) can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The disputed domain name is also being used in bad faith: Although there is no evidence that the disputed domain name is being actively used or resolved to a website with substantive content, Panels have found that the non-use of a domain name (including a blank or "coming soon" or "parking" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

The distinctiveness and reputation of the Complainant's trademark, and the nature of the disputed domain name support the finding 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.

Furthermore, this Panel concludes that the disputed domain name is being used in bad faith, putting emphasis on the following:

- the Complainant's trademark LEGO is distinctive, well-known globally with a strong Internet presence;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;

- the disputed domain name is inherently misleading, and is thus suited to divert or mislead potential Internet users from the website they are trying to visit (the Complainant's site) and giving the false impression that the Respondent must be in some way related with the Complainant which is not the case;
- the disputed domain name has active MX (mail exchange) records, as shown in the MX records lookup, which indicates a possible use for email services;
- the Respondent refused to transfer the disputed domain name after a cease-and-desist letter was filed by the Complainant; and
- there is no conceivable plausible good faith use with regard to the disputed domain name.

The evidence and documents produced and put forward by the Complainant together with the fact that the Respondent has failed to present any evidence of any good faith registration and use with regard to the disputed domain name further supports the finding of bad faith.

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 <lego.wales> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: March 25, 2024