

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Kalysta Vasquez, LegoLandLuxury
Case No. D2024-0772

1. The Parties

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

The Respondent is Kalysta Vasquez, LegoLandLuxury, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <legotreasure.store> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 20, 2024. On February 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 21, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 0168973414) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 22, 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 26, 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 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 19, 2024.

The Center appointed Nicholas Smith as the sole panelist in this matter on March 25, 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 Danish company best known for the design and production of a range of children's toys and products, including a significant and well-known range of toys consisting of interlocking plastic bricks. The Complainant's LEGO brand has been recognised by third parties as a well-known brand and the Complainant owns close to 5,000 domain names containing the word "lego".

The Complainant is the owner of numerous trademark registrations for LEGO (the "LEGO Mark") in numerous jurisdictions including the registrations for the LEGO Mark in the United States, registered on August 26, 1975, and December 9, 1975, (registration numbers 1018875 and 1026871) for goods in international class 28.

The Domain Name was registered on October 15, 2023. The Domain Name resolves to a website ("Respondent's Website") purportedly offering art made with Complainant's products (specifically mosaic style art works crafted from Lego bricks).

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 Domain Name.

Notably, the Complainant contends that:

- a) It is the owner of the LEGO Mark, having registered the LEGO Mark in the United States and various other jurisdictions. The Domain Name is confusingly similar to the LEGO Mark as it reproduces the LEGO Mark and adds the additional element "treasure" (along with the "store" generic Top-Level Domain).
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the LEGO Mark. The Respondent is not commonly known by the Domain Name, nor does it use the Domain Name in connection with a bona fide offering of goods or services. Instead, the Respondent uses the Domain Name to take advantage of the reputation of the Complainant's LEGO Mark to drive traffic to a commercial site where the Respondent seeks to benefit from its association with the Complainant's LEGO Mark in a manner that is not fair use. Such use of the Domain Name cannot and does not constitute bona fide commercial use, sufficient to legitimize any rights or interests the Respondent might have in the Domain Name and therefore the Respondent has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.
- 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 Domain Name. By using the Domain Name to resolve to a commercial website for which it likely receives revenue, the Respondent is using the Domain Name to divert Internet users searching for the Complainant for commercial gain. Such conduct amounts to registration and use of the Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

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 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, "treasure" 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 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. [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 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 Domain Name such as those enumerated in the Policy or otherwise.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Name.

The Whois record lists “LegoLandLuxury” as the Respondent’s organization name. However, the Panel is not satisfied that the Respondent is actually commonly known under this name as opposed to simply registering the Domain Name under a pseudonym for the purpose of asserting rights or legitimate interests. The Respondent has provided no evidence that an entity known as “LegoLandLuxury” exists and is actively trading. Even if a respondent’s name appears from the Whois record to correspond to the domain name, without additional affirmative evidence, it can be concluded that such a respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy. For the reasons discussed in relation to bad faith below, it is likely that the Respondent adopted this name and registered the Domain Name in order to benefit from confusion with the Complainant, which cannot give rise to rights or legitimate interests.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use or a bona fide offering of goods and services. The Domain Name resolves to a website purportedly offering art made with the Complainant’s products (specifically mosaic style art works crafted from Lego bricks). In certain circumstances the use of a trademark to describe a product can be fair use however in assessing the Respondent’s purported use it is necessary to consider [WIPO Overview 3.0](#), section 2.5, which sets out the core factors that UDRP panels must consider in assessing fair use. It states:

“Fundamentally, a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.”

...

“Generally speaking, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation.

...

Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.”

and

“Beyond looking at the domain name and the nature of any additional terms appended to it (whether descriptive, laudatory, derogatory, etc.), panels assess whether the overall facts and circumstances of the case support a claimed fair use.

To facilitate this assessment, panels have found the following factors illustrative: (i) whether the domain name has been registered and is being used for legitimate purposes and not as a pretext for commercial gain or other such purposes inhering to the respondent’s benefit, (ii) whether the respondent reasonably believes its use (whether referential, or for praise or criticism) to be truthful and well-founded, (iii) whether it is clear to Internet users visiting the respondent’s website that it is not operated by the complainant, (iv) whether the respondent has refrained from engaging in a pattern of registering domain names corresponding to marks held by the complainant or third parties, (v) where appropriate, whether a prominent link (including with explanatory text) is provided to the relevant trademark owner’s website, (vi) whether senders of email intended for the complainant but (because of user confusion) directed to the respondent are alerted that their message has been misdirected, (vii) whether there is an actual connection between the complainant’s trademark in the disputed domain name and the corresponding website content, and not to a competitor, or an entire industry, group, or individual, and (viii) whether the domain name registration and use by the respondent is consistent with a pattern of bona fide activity (whether online or offline).”

In the present case the nature of the Domain Name, being the LEGO Mark and the word “treasure” (a word commonly used by the Complainant in respect of a number of their offerings, including various pirate themed offerings), both suggests affiliation and does not describe the purported offerings of the Respondent's Website.

Furthermore, in considering the overall facts and circumstances, the Panel notes that the Respondent has not participated in the proceeding or provided any evidence of its business and its legitimacy. The Respondent's Website does not contain a disclaimer or any other information explaining its (lack of a) relationship with the Complainant. Finally, the Complainant provides evidence that the Domain Name's MX servers have been configured, suggesting that the purported use for the Respondent's Website may be window-dressing and that the Domain Name may be actively used for e-mail purposes to facilitate fraudulent activities such as phishing, impersonating or passing off as the Complainant.

Given the evidence before the Panel, and the lack of an explanation for its activities, the Panel is not satisfied that the Respondent is commonly known by a name corresponding to the Domain Name or is making a fair use of the Domain Name. Rather the Panel considers that it is likely that, given the nature of the Domain Name, the Respondent has registered the Domain name to take advantage of the Complainant's reputation in the LEGO Mark and both the purported name of the Respondent and the Respondent's Website were created to provide a veneer of legitimacy to this activity. The Panel finds that the Respondent's conduct does not, absent further explanation, amount to use for a bona fide offering of goods and services.

Based on the available record, 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.

The Domain Name, which wholly incorporates the coined and well-known LEGO Mark, resolves to a page purporting to offer mosaics made from the Complainant's products. As discussed under the heading “Rights or Legitimate Interests” the Panel is unpersuaded that the Respondent's Website, or any other aspect of the Respondent's conduct, provides a basis to infer that the Respondent has registered or used the Domain Name in good faith. Rather, the Panel is prepared to infer, based on the conduct of the Respondent, including:

- the nature of the Domain Name;
- the configuration of MX servers for the Domain Name;
- the failure of the Respondent to include a disclaimer, link or any attempt to clarify the relationship between it and the Complainant on the Respondent's Website, and
- the failure by the Respondent to participate in this proceeding or otherwise provide any explanation of its conduct;

that the Respondent was most likely aware of the Complainant at the time of registration and is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the LEGO Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

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 Domain Name <legotreasure.store> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: April 4, 2024