

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. yeon kwa, Emperor
Case No. D2024-1333

1. The Parties

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

The Respondent is yeon kwa, Emperor, Singapore.

2. The Domain Names and Registrar

The disputed domain names <legoland88.com>, <lego88sg.com>, and <lego88sg.toys> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed as regards the disputed domain name <legoland88.com> with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2024. On March 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 28, 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, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 6, 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 April 9, 2024, in which the Complainant requested for addition of the disputed domain names <lego88sg.com> and <lego88sg.toys> into the proceeding. On April 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain names. On April 16, 2024, the Registrar transmitted by email to the Center its verification response confirming that the registrant is listed as the Respondent in the amended Complaint.

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 April 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 15, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on May 22, 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, with its principal place of business in Denmark, mainly selling construction toys and other LEGO branded products. The Complainant has subsidiaries throughout the world, and the Complainant's products are sold in more than 130 countries. The Complainant also has LEGOLAND theme parks, with about 1.4 million visitors per year.

The Complainant is the owner of numerous LEGO, LEGOLAND, and other trademarks throughout the world, used in connection with its LEGO branded products, including the following registrations:

- LEGO, United States of America ("United States") Trademark Registration No. 1018875, registered August 8, 1975, in class 28;
- LEGO, Singaporean Trademark Registration No. T6435007D, registered May 23, 1964, in class 28;
- LEGOLAND, Singaporean Trademark Registration No. T7357709D, registered February 24, 1975, in Class 28
- LEGOLAND, United States Trademark Registration No. 2334535, registered March 28, 2000, in classes 35, 41, and 42

The Complainant operates its main websites at "www.lego.com" and "www.legoland.com", as well as being the registrant of close to 5,000 domain names containing the terms "Lego" and/or "Legoland", in numerous generic Top-Level Domains ("gTLDs"), and country code Top-Level Domains ("ccTLDs").

The Respondent appears to be an individual located in Singapore. The Respondent registered the disputed domain names <legoland88.com> on February 19, 2024, <lego88sg.com> on March 14, 2024, and <lego88sg.toys> on March 14, 2024. Prior to the Complainant's partners requesting a takedown of the websites at the disputed domain names, the Respondent was operating unauthorized commercial websites claiming to offer unrelated services, including online gambling, while utilizing the Complainant's LEGO logo type in the header of the websites. At the time of the UDRP Complaint, the websites were changed to resolve to inactive pages.

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 names.

Notably, the Complainant contends that the disputed domain names contain the Complainant's identical LEGO and LEGOLAND registered trademarks, and as a whole, are confusingly to the Complainant's trademarks. The disputed domain names contain the Complainant's LEGOLAND and LEGO trademarks, and simply add the numbers "88" and/or the letters "sg" to the end of the trademark. The Complainant states the mere addition of these numbers and letters does not negate the confusing similarity with its trademarks. The addition of the gTLDs ".com" and ".toys" does not have any impact on the overall impression of the

dominant portion of the domain names, and should therefore be irrelevant to determining the confusing similarity between the trademarks and disputed domain names.

The Complainant submits evidence that its LEGO trademark is world famous and well-known. It was listed in 2019 amongst a list of Top 10 Consumer Superbrands, by Superbrands UK, with LEGO as number 1 Consumer Superbrand, and number 8 in the Consumer Relevancy Index. The Reputation Institute recognized the LEGO Group as number 1 on its list of the world's Top 10 Most Reputable Global Companies of 2020, and noted that the LEGO Group had been on its top 10 list for 10 consecutive years. In 2014, TIME magazine announced LEGO to be the Most Influential Toy of All Time.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed names. The Complainant has not given any license, permission or authorization of any kind to use the LEGO or LEGOLAND trademarks. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. It is highly unlikely that the Respondent did not know of the Complainant's legal rights in LEGO and LEGOLAND at the time of the registrations. Rather, the Respondent was motivated by the fame of the Complainant's marks when it registered the disputed domain names.

The Respondent was not using the disputed domain names in connection with a bona fide offering of goods or services, nor is it making a legitimate noncommercial or fair use. The Respondent intentionally chose the disputed domain names based on the Complainant's registered trademarks in order to generate traffic and income through an unauthorized website utilizing the Complainant's LEGO logo type in the website header and promoting online gambling. This use was intended to mislead Internet users to its own commercial website and trying to benefit from the Complainant's trademarks by creating a false link to the Complainant, thereby creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of its websites.

The Respondent's current use of the disputed domain names to inactive pages that lack content still fails to show a bona fide offering of goods or services. The Respondent has not made any attempt to make legitimate use of the disputed domain names and websites, which evinces a lack of rights or legitimate interests in the disputed domain names.

The Complainant submits that the disputed domain names were registered and are being used in bad faith, since the LEGO trademark is well-known. The Complainant's considerable value and associated with the LEGO mark is what motivated the Respondent to register the disputed domain names. The mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create the presumption of bad faith. The Respondent registered the disputed domain names on February 19, 2024, and March 14, 2024, many years subsequent to when the Complainant registered the LEGO and LEGOLAND trademarks in the United States, Singapore, and elsewhere around the world.

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 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 entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are 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, “88” and “sg”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a gTLD, in this case “.com” and “.toys”, is typically ignored when assessing similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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 names. 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 names such as those enumerated in the Policy or otherwise.

The Panel notes that the Complainant has not given any license, permission, or authorization of any kind to use the LEGO or LEGOLAND trademarks. The Respondent is not an authorized dealer of the Complainant’s products, and has never had a business relationship with the Complainant. Furthermore, the Respondent is not making any legitimate noncommercial or fair use of the disputed domain names. Rather, the Respondent was using the disputed domain names to promote gambling sites for commercial gain.

Additionally, UDRP panels have held that domain names consisting of a trademark plus an additional term (at the second- or top-level) cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1. The disputed domain names have added the additional terms “88” and/or “sg”, with “sg” being the country code for Singapore, a location where the Complainant has trademark rights, and where the Respondent is located. The disputed domain name <lego88sg.toys> also includes the gTLD “.toys”, which is related to the main area of the Complainant’s business. Combined with the use of the same logo type of the Complainant and other indicia of a relation to the Complainant’s products on the subject websites, it is clear that the Respondent is attempting to impersonate or suggest sponsorship or endorsement by the Complainant.

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 Respondent registered the disputed domain names many years after the Complainant acquired its trademark rights in LEGO and LEGOLAND. The Complainant's trademarks have been recognized as being well-known and famous, and the submitted evidence supports this conclusion. Although the websites associated with the disputed domain names did not resolve to content at the time of the filing of this UDRP Complaint, the Respondent had previously used the websites for gambling sites while utilizing the same logotype and other graphics related the Complainant. The Panel finds that the Respondent clearly knew of the Complainant and deliberately registered the confusingly similar disputed domain names, and attempted to attract, for commercial gain, Internet users to the associated websites, in accordance with paragraph 4(b)(iv) of the Policy.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. The Panel considered the disputed domain names contained the Complainant's marks in their entirety, with the addition of a number and a local geographic indicator where the Complainant operates, and the Respondent resides, along with the gTLD in the instance of ".toys", which is directly related to the Complainant's business. The totality of these circumstances is further support for a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. 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 distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy. Combined with the prior use of the disputed domain names to resolve to websites containing the Complainant's logo typeface and indicia of Complainant's products, while promoting gambling services, it is clear that the Respondent's use of the disputed domain names is a bad faith attempt to profit from or exploit the goodwill associated with the Complainant's trademarks. Therefore, the current non-use of the disputed domain names does not prevent a finding of the bad faith.

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 names <legoland88.com>, <lego88sg.com>, and <lego88sg.toys> be transferred to the Complainant.

/Gary Saposnik/

Gary Saposnik

Sole Panelist

Date: June 6, 2024