

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Rum Bar

Case No. D2024-1545

### **1. The Parties**

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

The Respondent is Rum Bar, France.

### **2. The Domain Name and Registrar**

The disputed domain names <roselego.com> and <roselego.shop> are registered with Tucows Inc. Tucows Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 11, 2024. On April 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 12, 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.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 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 17, 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 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 10, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on May 27, 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 based in Denmark and is the owner of LEGO and all other trademarks used in connection with the LEGO branded construction toys and other LEGO branded products. Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries. It has expanded its use of the LEGO trademark to, inter alia, computer hardware and software, books, videos and computer controlled robotic construction sets.

The Complainant is the registered owner of several trademarks worldwide consisting of or containing LEGO, e.g., European Union trademark registration no. 000039800 LEGO (word) registered on October 5, 1998, for goods and services in classes 3, 9, 14, 16, 20, 24, 25, 28, 38, 41, and 42.

In addition, it operates the domain name <lego.com> for its official website.

The disputed domain names <roselego.com> and <roselego.shop> were both registered on January 26, 2024. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain names initially redirected Internet users to the website “www.bricksflowers.com” selling teddy bears made of roses, later redirected to the website “www.pickstild.com” which sold a variety of merchandise (also unrelated to the Complainant), and then to Shopify holding pages that lack content. Both currently resolve to inactive webpages.

Finally, the Complainant sent a cease-and-desist letter to the Respondent on February 13, 2024, and many reminders. The Respondent did not reply to any of them.

#### **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 disputed domain names are confusingly similar to its well-known trademark LEGO, since they comprise in their entirety, the Complainant's LEGO trademark. The mere addition of the generic term “rose” to the Complainant's trademark does not negate the confusing similarity between the disputed domain names and the Complainant's trademark. In addition, the Complainant contends that its trademark LEGO is distinctive and well-known worldwide.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain names. According to the Complainant, the Respondent is not commonly known by the domain names. No license or authorization of any other kind has been given by the Complainant to the Respondent, to use the trademark LEGO. It is highly unlikely that the Respondent did not know of the Complainant's legal rights in the name LEGO at the time of the domain name registration. In fact, it is rather obvious that it is the fame of the trademark that has motivated the Respondent to register the domain names. The Respondent was not using the domain names in connection with a bona fide offering of goods or services. Instead, the Respondent has intentionally chosen domain names based on a registered trademark in order to generate traffic and income through a website selling products unrelated to Complainant. Specifically, the Respondent was initially using the domain names to redirect Internet users to the website “www.bricksflowers.com” selling teddy bears made of roses and then it was using the domain names to redirect to the website

“www.pickstild.com” which sold a variety of merchandise, also unrelated to the Complainant and then to Shopify holding pages that lack content. In doing so, the Respondent was using the Complainant’s trademark to mislead Internet users to its own commercial websites.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, it is inconceivable that the Respondent was unaware of the Complainant’s registered trademarks when registering the disputed domain names, given that they are well-known and reputable. It is clear that the Respondent selected the disputed domain names to intentionally confuse unsuspecting internet users into visiting its website. As such, it must be held that the Respondent has intentionally misappropriated the Complainant’s trademark as a way of redirecting internet users searching for the Complainant to the websites which the disputed domain names resolved to.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

- (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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### **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 trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “rose”, may bear on the assessment of the second and third elements, the Panel finds the addition of such term 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.

Finally, the applicable Top-Level Domains (“TLDs”) “.com” and “.shop” of the disputed domain names may be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#) at 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.

Moreover, the Panel notes that the disputed domain names contain the Complainant’s registered and well-known trademark LEGO, and that more likely than not, this trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain names with the intention to mislead Internet users by taking advantage of the reputation and goodwill inherent in the Complainant’s trademark. Given the commercially oriented nature of the website to which the disputed domain names resolved, it seems clear that the Respondent sought to use the confusingly similar disputed domain names for its commercial gain, which cannot vest in the Respondent rights or legitimate interests.

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 shares the view of other UDRP panels and finds that the Complainant’s trademark LEGO is well known. Therefore, this Panel has no doubt that the Respondent positively knew or should have known the Complainant’s trademark when registering the disputed domain names. This is underlined by the fact that the disputed domain names are clearly constituted by the Complainant’s trademark preceded by the term “rose”. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith, [WIPO Overview 3.0](#) section 3.1.4. The Panel shares this view.

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. [WIPO Overview 3.0](#), section 3.2.1. In this regard, the further circumstances surrounding the disputed domain names’ registration and use confirm the findings that the Respondent has registered and is using the disputed domain names in bad faith:

- (1) the nature of the disputed domain names, i.e., incorporating the Complainant's well-known trademark LEGO;
- (2) the content of any website to which the disputed domain names direct, including any changes in such content and the timing thereof, i.e., the change in the content of the websites is highly likely due to the cease-and-desist letter sent by the Complainant;
- (3) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain names;
- (4) the Respondent did not reply to the cease-and-desist letter;
- (5) the Respondent's use of a privacy service to conceal its identity.

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 <roselego.com> and <roselego.shop> be transferred to the Complainant.

*/Federica Togo/*

**Federica Togo**

Sole Panelist

Date: June 10, 2024