

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Nathan Hernandez, My Store
Case No. D2024-1662

1. The Parties

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

The Respondent is Nathan Hernandez, My Store, United States of America (“United States”).

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2024. On April 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 22, 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 0169952742) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 25, 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 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 April 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2024. The Respondent did not submit any formal response but send an informal email communication on April 29, 2024. The Center informed the Parties on the same day that if they wished to explore settlement options, the Complainant should submit a request for suspension. The Complainant did not request to suspend the proceedings. Accordingly, the Center notified the Parties on May 24, 2024 that it would proceed to panel appointment.

The Center appointed Andrea Cappai as the sole panelist in this matter on May 29, 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 toy company renowned for its interlocking plastic bricks, which can be assembled into various structures, vehicles, and figures (including flowers and plants). The Complainant has subsidiaries and branches worldwide, with Lego products sold in over 130 countries, including the United States.

The Complainant owns several trademark registrations for LEGO, including:

- United States Trademark Registration No. 1018875 for LEGO, registered on August 26, 1975;
- Canada Trademark Registration No. TMA106457 for LEGO, registered on April 26, 1957.

The Complainant has also submitted significant listings of marks registered in jurisdictions around the world. The Complainant operates an extensive website under the domain name <lego.com>, as well as numerous other generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”) incorporating the LEGO trademark.

The Complainant claims that the LEGO trademark has well-established notoriety and, among various pieces of evidence, cites the following recognitions:

- Top Consumer Superbrand 2019: Ranked number 1 by Superbrands UK.
- Consumer Relevancy Index 2019: Ranked number 8 by Superbrands UK.
- Most Reputable Global Company 2020: Ranked number 1 by the Reputation Institute, maintaining a top 10 position for 10 consecutive years.
- Most Influential Toy of All Time 2014: Recognized by TIME magazine.

According to Whois records, the disputed domain name was registered on January 20, 2024. Initially, it resolved to a website where flowers, seemingly made from plastic bricks and marketed as “Legó Flowers,” were offered for sale. On February 16, 23, and March 1, 2024, the Complainant’s legal representatives sent cease-and-desist letters by email to the Respondent but did not receive any reply. However, after these cease-and-desist letters, the disputed domain name redirects to a page indicating that “this store is currently unavailable.”

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 name is confusingly similar to the LEGO trademark, and that the Respondent lacks any rights or legitimate interests in the disputed domain name. The Respondent has neither been authorized by the Complainant to register the disputed domain name nor to use the Complainant's trademark within it. Furthermore, the Respondent is not commonly known by the disputed domain name and is neither making a bona fide offering of goods or services nor engaging in legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the Respondent registered the disputed domain name in bad faith, as the LEGO trademark is well known. The Respondent specifically targeted the Complainant's trademark at the time of registration. The Complainant argues that using the disputed domain name to impersonate the Complainant and attract Internet users to the Respondent's website for commercial gain, thereby creating a likelihood of confusion regarding the source, sponsorship, affiliation, or endorsement of the Respondent's website, constitutes bad faith registration and use.

Lastly, the Complainant expresses concerns that the Respondent may utilise the disputed domain name for phishing or fraudulent email activities, given that the mail exchanger (MX) records associated with the disputed domain name have been activated.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. However, on April 29, 2024, the Respondent sent an email communication stating: "This domain name was a misspelled domain that was made for a website that was never even in use or used for anything. The store was deactivated".

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 Panel finds the mark is recognisable 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 such as "flowers" may bear on 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 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 recognised 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 name. The Respondent has not successfully 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 name such as those enumerated in the Policy or otherwise.

Although the Respondent asserts that the disputed domain name is made for a website that has "never even in use or used for anything", the Panel notes that the disputed domain name previously resolved to a website where flowers, seemingly made from plastic bricks and marketed as "Legó Flowers", were offered for sale. While the true nature of the products remains unclear, various indicators – such as the use of an accented version of the LEGO trademark, which deviates from the Complainant's usual branding – alongside the Respondent's general behaviour, cast a shadow of doubt over the origin of the goods. Nonetheless, it is certain that the Respondent failed to prominently and accurately disclose the lack of affiliation with the Complainant, thereby fostering a false impression of association or endorsement. Moreover, considering the Complainant itself sells various LEGO flowers and plants, the composition of the disputed domain name is inherently misleading, which carries a risk of implied affiliation with the Complainant.

Additionally, the Panel notes that the Respondent failed to respond to the Complainant's cease-and-desist letters, but as indicated by the Respondent that "the store was deactivated."

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 reputation of the Complainant's trademark LEGO is well established, as evidenced by its nearly 50-year registration and global recognition. A simple online search would reveal the extensive use of the LEGO trademark by the Complainant. Therefore, it is inconceivable that the Respondent registered the disputed domain name without knowledge of the Complainant or the LEGO trademark. The Respondent clearly knew of the Complainant and deliberately registered the confusingly similar disputed domain name, especially since the website at the disputed domain name seemingly offered for sale flowers made from plastic bricks and marketed as "Legó Flowers".

Moreover, the disputed domain name is being used in bad faith. The Respondent is intentionally creating a likelihood of confusion regarding the disputed domain name's source, sponsorship, affiliation, or endorsement, for possible commercial gain. This misleading use to market products similar to those of the Complainant further underscores the Respondent's bad faith.

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.

Additionally, the Complainant provides evidence that the disputed domain name's MX servers are configured, suggesting the website may be a facade and the disputed domain name might be used for fraudulent activities such as phishing.

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 <legoflowers.store> be transferred to the Complainant.

/Andrea Cappai/

Andrea Cappai

Sole Panelist

Date: June 12, 2024