

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Robert Theimer

Case No. D2024-1709

1. The Parties

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

Respondent is Robert Theimer, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <lego-minifigs.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 23, 2024. On April 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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 (Registration Private/Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on April 25, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. 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 Respondent of the Complaint, and the proceedings commenced on May 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 22, 2024.

The Center appointed Stephanie G. Hartung 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

Complainant is a company organized under the laws of Denmark that is the worldwide well-known producer of LEGO branded construction toys and related LEGO products.

Complainant has provided evidence that it is the registered owner of numerous trademarks worldwide relating to its company name and brand LEGO, inter alia, but not limited to, the following:

- Word mark LEGO, United States Patent and Trademark Office (USPTO), registration number: 1018875, registration date: August 26, 1975, status: active.
- Word mark LEGO, European Union Intellectual Property Office (EUIPO), registration number: 000039800, registration date: October 5, 1998, status: active.

Moreover, Complainant has evidenced to own a vast number of domain names relating to its LEGO trademark, inter alia, the domain name <lego.com> which resolves to Complainant's official website at "www.lego.com", used to promote Complainant's LEGO products and related services worldwide, while other domain names also include the term "minifigs", such as since 2006 the domain name <legominifigs.com>.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of the United States. The disputed domain name was registered on November 30, 2023. By the time of the rendering of this decision, the disputed domain name does not resolve to any active website on the Internet. However, Complainant has provided evidence that, at some point before the filing of the Complaint, the disputed domain name redirected to a website at "etsy.com/shop/thebricksilo/..." which purported to offer Complainant's LEGO minifigures for online sale without any authorization to do so.

Complainant sent a cease-and-desist-letter dated January 10, 2024, to the email address provided at that time in the Whois information for the disputed domain name, which remained unanswered.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, Complainant contends that its LEGO trademark is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO trademark on all products, packaging, displays, advertising, and promotional materials.

Complainant submits that the disputed domain name is confusingly similar to Complainant's LEGO trademark, as the dominant part of the disputed domain name comprises the latter identically, and the addition of the term "minifigs", which is closely linked to and associated with Complainant, even increases such confusing similarity. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name, since (1) no license or authorization of any other kind has been given by Complainant to Respondent to use the LEGO trademark, (2) Respondent apparently has no rights in the term "lego", but is simply trying to benefit from Complainant's world famous LEGO trademark, and (3) there is no disclaimer on the website to which the disputed domain name redirects to explain the lack of relationship of Respondent to Complainant. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith, because (1) Complainant's LEGO trademark in respect of toys has a status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world, and it is obvious that such fame has motivated Respondent to register the disputed domain name, (2) it is clear that Respondent was aware of Complainant's rights in the valuable LEGO trademark at the point of the registration of the disputed domain name, (3) Complainant's registered LEGO trademark predates the registration of the disputed domain name by decades, (4) Complainant never

received a reply from Respondent to Complainant's cease-and-desist letter of January 10, 2024, and (5) Respondent was using the disputed domain name to intentionally attempt to attract Internet users to its website for commercial gain.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

First, 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 Complainant's LEGO 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.

Complainant has shown rights in respect of its LEGO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Also, the entirety of such trademark is reproduced within the disputed domain name, together with the term "minifigs" and a hyphen. Accordingly, the disputed domain name is confusingly similar to Complainant's LEGO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Although the addition of other terms (here, the term "minifigs") may bear on assessment of the second and third elements, it does not prevent a finding of confusing similarity between the disputed domain name and Complainant's well-known LEGO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel, therefore, holds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Second, paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

In particular, Respondent has not been authorized to use Complainant's LEGO trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the terms "lego" and/or "minifigs" on its own. To the contrary, the disputed domain name, at some point before the filing of the Complaint, redirected to a website at "etsy.com/shop/thebricksilo/..." which purported to offer Complainant's LEGO minifigures for online sale without any authorization to do so. Such use of the disputed domain name to redirect to a competing website neither qualifies as bona fide nor as legitimate noncommercial or fair within the meaning of the Policy. [WIPO Overview 3.0](#), section 2.5.3.

The Panel, therefore, holds the second element of the Policy has been established, too.

C. Registered and Used in Bad Faith

Third, 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 circumstances to this case leave no doubts that Respondent was fully aware of Complainant's rights in the undisputedly famous LEGO trademark when registering the disputed domain name and that the latter is clearly directed thereto. Moreover, using the disputed domain name, which is confusingly similar to Complainant's LEGO trademark, to redirect to a website at "etsy.com/shop/thebricksilo/..." which purported to offer Complainant's LEGO minifigures for online sale without any authorization to do so, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own Internet presence by creating a likelihood of confusion with Complainant's LEGO trademark as to the source, sponsorship, affiliation or endorsement of Respondent's Internet presence. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

In this context, it also carries weight in the eyes of the Panel that Respondent, according to the case file, refused delivery of the Written Notice of the Notification of Complaint sent to Respondent on May 1, 2024, at the postal contact information provided in the Whois information for the disputed domain name. Such refusal at least throws a light on Respondent's behavior which supports the Panel's bad faith finding.

The Panel, therefore, holds that Complainant has established the third element of the Policy, too.

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-minifigs.com> be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: June 12, 2024