

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Paul Gauvreau, Androux Reabow
Case No. D2024-1725

1. The Parties

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

The Respondent is Paul Gauvreau, United States of America (“United States”), Androux Reabow, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <lego.box> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 24, 2024. On April 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 25, 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 (WHOIS Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 26, 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 May 1, 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 May 3, 2024. In accordance with the Rules, paragraph 5, the due date for the Response was June 16, 2024. A third party sent email communications to the Center on May 10, 14, 20, 21, 24 and 26, 2024. The Respondent sent an email communication to the Center on May 17, 2024. In light of the email communications from the third party and the Respondent, the Center granted a request from the third party for an extension of time to file a Response. The new due date for the

Response was June 16, 2024. No formal Response was submitted by the Respondent or the third party. Accordingly, the Center notified the Commencement of Panel appointment process on June 19, 2024.

The Center appointed Adam Taylor as the sole panelist in this matter on June 26, 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 has supplied construction toys and related products under the mark LEGO since the 1930s.

The Complainant owns many registered trade marks for LEGO including United States trade mark No. 1018875, registered on August 26, 1975, in class 28.

The Complainant operates a website at "www.lego.com".

The disputed domain name was registered on January 26, 2024, in the .box Top-Level Domain, which combines the current "traditional" Internet known as "Web2" with the new world of "Web3" involving decentralization, blockchain, tokenization etc.

The person identified by the Registrar as the registrant of the disputed domain name, and therefore named as Respondent, is Paul Gauvreau. However, Paul Gauvreau has informed the Center that he is an officer of the 3DNS, the reseller of the disputed domain name, and that it is unclear how he came to be named as registrant. Mr. Gauvreau has forwarded the Complaint to a third party, Androux Reabow, with an address in the United Kingdom, who Mr. Gauvreau has identified as the registrant of the disputed domain name in 3DNS's system. Furthermore, Androux Reabow has communicated with the Center in a manner that presupposes his ownership and control of the disputed domain name. In these circumstances, references to "the Respondent" in this decision should be treated as including Androux Reabow.

The disputed domain name does not currently resolve to an active website. However, the Complainant submitted evidence showing that, as of April 16, 2024, the disputed domain name was being used in connection with an apparent Web3 page (likely a profile connected to <lego.box>) including a "Connect Wallet" button in the header, plus the following list: "food.box", "pocketpair.box", "merch.box", "virtual.box", "roux.box". The website also referred to "ETH" holdings of USD 20.92 and included a list of "Recent Activity" comprising actions such as "Minted a token".

The Respondent did not reply to the Complainant's cease and desist letters sent on February 13, 20, and 27, 2024.

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.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. In the course of a number of informal emails to the Center, the Respondent stated that:

- the reseller 3DNS had "tokenized the asset and made it available to [M]y.box";

- the Respondent had “purchased the tokenized domain through [M]y.box who run the online marketplace”;
- the Respondent was “the holder of the NFT”;
- the Respondent was willing to discuss the matter with the Complainant to find a resolution;
- the case appeared to be directed not at the Respondent, but at “previous parties”, making it unjust; and
- the Respondent requested the full 20-day post-notification period to respond¹.

The Respondent also stated that he had offered a solution to My.box (which the Panel understands is connected with the .box registry InterCap Registry, Inc), offering a one-to-one trade of the disputed domain name for another domain name. An email response from My.box stated that they had already offered the Respondent a refund which the Respondent could use to buy any available domain name.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

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 trade mark 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 trade mark 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 name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

¹ The Center duly granted this request, but no formal Response was filed.

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 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.

As to paragraph 4(c)(i) of the Policy, and as further discussed in section 6C below, the Panel considers that the Respondent registered a disputed domain name reproducing the Complainant's famous trade mark in its entirety, and has used the disputed domain name to intentionally attempt to attract users to an NFT wallet. Such use of the disputed domain name could not be said to be bona fide under the Policy.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy are relevant in the circumstances of this case.

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, despite being granted the requested extension, the Respondent has failed to file a Response rebutting the Complainant's assertions in detail. Furthermore, neither party has fully addressed/explained the "Web3" context of this case, let alone contended that this might involve different considerations to those that would arise on a "traditional" UDRP analysis, which the Panel proposes to apply.

Noting that the Complainant's marks are well-known, and in the circumstances of the case, the Panel finds it more likely than not that the Respondent was aware of the LEGO mark when it registered the disputed domain name. The Panel considers that the Respondent has intentionally attempted to attract Internet users to its website or another online location, likely for commercial gain, by creating a likelihood of confusion with the Complainant's trade mark in accordance with paragraph 4(b)(iv) of the Policy.

The likelihood of confusion is not diminished by the probability that users arriving at the Respondent's site will realise that the site is not connected with the Complainant. Paragraph 4(b)(iv) of the Policy is concerned with the intentional attracting of Internet users to a website or another online location. Here, the disputed domain name creates a risk of implied affiliation with the Complainant, and the Respondent has not provided any reasonable explanation for the registration of the disputed domain name.

The gist of the Respondent's position, as set out the Respondent's informal emails, is apparently to seek to shift the blame to My.box and/or 3DNS (see section 4 above) for having "tokenized" the disputed domain name, and/or made it available for sale, in the first place. That contention receives some limited support from the fact that My.box offered the Respondent a refund.

However, the fact remains that the Respondent chose to acquire the disputed domain name, which reflects the Complainant's famous mark. The Respondent has not denied knowledge of the Complainant, nor sought to explain or justify the Respondent's registration and use of the disputed domain name.

Accordingly, 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 <lego.box> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: July 10, 2024