

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Chen BK

Case No. D2024-1734

### **1. The Parties**

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

The Respondent is Chen BK, Canada.

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

The disputed domain name <legostoreboston.com> is registered with CloudFlare, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 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 and April 26, 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 (Data Redacted) 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 April 29, 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 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 21, 2024.

On May 24, 2024, the Center resent the Written Notice by courier due to an administrative oversight, granting the Respondent a 10-day period, i.e., until June 2, 2024, to indicate whether it wishes to participate in the proceeding. The Respondent did not submit any response.

The Center appointed Catherine Slater as the sole panelist in this matter on June 11, 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. It manufactures and sells one of the most popular children's toys in the world, namely a range of interconnecting building bricks, although its products have expanded beyond that basic concept. Its products are marketed under the name LEGO and it is the owner of hundreds of trade mark registrations for the plain word LEGO and stylised word LEGO in numerous jurisdictions worldwide, including:

- Canadian Trade Mark TMA106457 for the plain word LEGO registered on April 26, 1957.

The afore-mentioned trade marks are referred to in this decision as the "LEGO trade mark".

The Complainant carries on business on a very substantial scale worldwide and its products and the LEGO trade mark are very widely known and recognised.

The Complainant is the owner of nearly 6,000 domain names containing the term "lego". It maintains a website at <lego.com>.

The disputed domain name was registered on March 26, 2024.

At the time of submission of this Complaint, the disputed domain name resolved to a website featuring the Complainant's trade mark and offering the Complainant's LEGO products for sale.

At the date of this Decision, the disputed domain name does not resolve to any website.

#### **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 fame of the LEGO trade mark has been confirmed in previous UDRP proceedings and the dominant part of the Disputed domain name is identical to that LEGO trade mark. Further, the disputed domain name is confusingly similar to the LEGO trade mark because it comprises a well-known trade mark paired with a generic suffix. Indeed, it says that the suffix is likely to create additional confusion for internet users and in particular those looking for the Complainant's LEGO store in Boston. It says that the fact that the website to which the disputed domain name pointed contained content that made it a "copycat" of the Complainant's own website is further evidence that the disputed domain name is confusingly similar to the LEGO trade mark.

The Complainant says that it has not found that the Respondent has any registered trade marks or trade names corresponding to the disputed domain name nor anything to suggest that the Respondent has been using LEGO in any way that would give them legitimate rights in the name. The Complainant has not provided authorization of any kind to the Respondent to use the LEGO trade mark. The Respondent is not an authorised dealer in the Complainant's products and there has been no business relationship between the parties. Further, the Respondent is simply trying to benefit from the Complainant's famous trade mark in which situation and is using it to generate traffic and income through an unauthorised website that mimics the Complainant's website through the use of the Complainant's logo, colour scheme and layout and offers the Complainant's products for sale. The Complainant contends that the criteria laid down in the "Oki Data"

case is applicable and in particular notes that the Respondent's website does not accurately disclose the relationship (or lack thereof) between the parties. The Complainant contends that the Respondent's website invites internet users to input their email address and password which amounts to obtaining personal information by appearing to be authorised by the Complainant. At minimum this increases traffic to the Respondent's website for personal gain and, at worst, is "phishing".

The Complainant contends that the Respondent registered the disputed domain name because of its fame which, without any plausible explanation for doing so may, in and of itself, be an indication of bad faith. The disputed domain name is being used to intentionally attempt to attract internet users to a website for commercial gain by creating a likelihood of confusion with the Complainant's LEGO mark as to the source, sponsorship, affiliation or endorsement of its website. The Respondent is also likely using the website to fraudulently pose as the Complainant for the purpose of a phishing attack. Finally, the use of a privacy service to hide the Respondent's identity is an indication of bad faith.

## **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 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 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, "storeboston", 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 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 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 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.

The Complainant's prima facie case shows evidence of how the Respondent was using the disputed domain name and the Panel finds that such use was not bona fide. The evidence establishes that the disputed domain name was linked to a website selling LEGO toys. The disputed domain name is in the Panel's opinion likely to give consumers the impression that it is a domain name owned by or affiliated with the Complainant and is likely to attract customers on that inaccurate basis. See WIPO Overview 3.0 at section 2.5:

"Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry."

And further, at section 2.5.1:

"Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner."

Applying those principles to this matter and taking into account the content of the relevant website which both appears to mimic to some extent the Complainant's website and fails to disclose the Respondent's relationship (or lack thereof) with the Complainant, the Panel does not consider that such use is bona fide.

The Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove both registration and use of the disputed domain name in bad faith. Paragraph 4(b) of the Policy provides an example of circumstances which shall be evidence of registration and use in bad faith:

- i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's website or location or of a product or service on the holder's website or location.

Consequently, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

Given the circumstances of the case, in particular the extent of use of the Complainant's trade mark and the reputation and the distinctive nature of it, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's trade mark. Further, the Panel finds that the Respondent could not have been unaware that the disputed domain name could attract internet users in a manner that is likely to create confusion for such users.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name was used for a website which, inter alia, by reproducing the Complainant's trade mark and mimicking the colour and layout of the Complainant's website, gives Internet users the impression that the website is an "official" website and that the website is either that of the Complainant or otherwise associated with it. This is not the case, and the Panel therefore finds that the Respondent by its registration and use of the disputed domain name intentionally creates a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the disputed domain name with the purpose of attracting Internet users to the website for commercial gain as per paragraph 4(b)(iv) of the Policy.

It is immaterial that the disputed domain name is now not being used. 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 name 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) and (iv) the implausibility of any good faith to which the domain name may be put. WIPO Overview 3.0, section 3.3.

Having reviewed the available record, the Panel notes that the Complainant's trade mark is distinctive, has a strong reputation, that the Respondent has failed to submit a response or to provide any evidence of actual or contemplated good-faith use, the previous use of the disputed domain name, and that it is impossible to conceive of any plausible use of the disputed domain name by the Respondent that would be ever be legitimate.

Both the Respondent's previous use of the disputed domain name amounts to bad faith use and the current non-use of it does not prevent a finding of 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 name <legostoreboston.com> be transferred to the Complainant.

*/Catherine Slater/*

**Catherine Slater**

Sole Panelist

Date: June 25, 2024