

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Janice Carroll

Case No. D2024-2084

1. The Parties

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

The Respondent is Janice Carroll, United States of America ("United States").

2. The Domain Names and Registrar

The disputed domain names <legocompany.com>, <legocorporation.com>, and <legocorporations.com> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 17, 2024. On May 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 21, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC, DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 22, 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 28, 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 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 25, 2024.

The Center appointed Ahmet Akgüloğlu as the sole panelist in this matter on July 2, 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, Lego Juris A/S is a limited company based in Denmark and manufactures toys and playing materials worldwide. The Complainant has subsidiaries and branches throughout the world and is widely known.

The Complainant is the owner of LEGO trademark numbered 73032295 in the United States registered on August 26, 1975, and other trademark registrations in multiple countries presented in Annex 3 to the Complaint. The Complainant is also the owner of numerous domain names containing the term “lego” presented in Annex 5.

The disputed domain names were registered on December 1, 2023.

The disputed domain names consist of “lego”, “company”, “corporation”, and “corporations”. As submitted by the Complainant, the disputed domain names resolve to parking webpages containing pay-per-click (“PPC”) links.

On January 11, 2024, the Complainant sent a cease and desist letter to the Respondent asking for the transfer of the disputed domain names and sent second and third notices on January 18, 2024 and January 25, 2024. The Complainant did not receive any reply.

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 names.

Notably, the Complainant contends that:

- (a) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights.

The Complainant argues that the disputed domain names are confusingly similar to the Complainant's trademark LEGO since the dominant part of the disputed domain names lie in the term “lego”, which are identical to the registered trademark LEGO. Moreover, the addition of suffixes “company”, “corporations” and “corporation” will not have any impact on the overall impression since dominant part of the disputed domain names being LEGO mark is instantly recognizable as a world-famous trademark. The Complainant also asserts that the addition of the generic Top-Level Domain (“gTLD”) being “.com” does not have any impact on the overall impression of the dominant portion of the disputed domain names and is therefore irrelevant to determine the confusing similarity between the trademark and the disputed domain names at issue. The Complainant also underlines that anyone who sees the disputed domain names are bound to mistake them related to the Complainant. The likelihood of confusion includes an obvious association with the Complainant's trademark.

- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant submits that the Respondent is not commonly known by the disputed domain names. Further, the Respondent is not licensed by the Complainant for the use of LEGO trademarks, and the

Complainant did not grant the Respondent any right, authorization, or permission to use the Complainant's LEGO trademarks in domain names or any other capacity. The Complainant also claims that the Registrant of the disputed domain names was "redacted for privacy" and later on identified as "Janice Carroll" which do not resemble with the disputed domain names. Additionally, the Complainant highlighted that the Respondent is not using the disputed domain names and, on the contrary, chose them in order to attract commercial income and generate traffic, which shows that the purpose of use as commercial.

(c) The disputed domain name was registered and is being used in bad faith.

The Complainant submit that the Respondent has registered the disputed domain names in bad faith, given that the Respondent fails to make an active use of the disputed domain names. Additionally, considering the worldwide reputation of the Complainant and their trademarks and the fact that the disputed domain names incorporate the trademark as a whole, it is clear that the Respondent has knowledge of the Complainant and their trademarks. Moreover, the Complainant explains that they have requested Respondent to transfer the disputed domain names by sending cease and desist letters, however, did not receive any reply. Additionally, the Complainant also mentioned that the Respondent has series of domain name registrations that includes other well-known trademarks and the Respondent is participating in cybersquatting activity. Therefore, should be ruled as in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the 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 that the complainant prove each of the following three elements to obtain an order that the disputed domain name should 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;
- (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 proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

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. It is uncontested to the Panel that the Complainant also has rights to LEGO trademark as a result of acquired reputation throughout the usage of the trademark globally.

The Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The disputed domain names composed of “lego”, “company”, “corporation”, “corporations”, and “.com”. The disputed domain names include the Complainant’s LEGO trademark in its entirety. When a domain name wholly incorporates a Complainant’s registered trademark that is sufficient to establish confusing similarity for purposes of the Policy. (See *Montblanc Simplo GmbH, Compagnie Financiere Richemont SA v. Privacy Service Provided by Withheld For Privacy Ehf / Ieyr Raich*, WIPO Case No. [D2022-3318](#)).

The Panel also ignored the gTLD since it is viewed as a standard registration requirement and suggested as disregarded under the first element similarity test. (See [WIPO Overview 3.0](#), section 1.11.1.)

Although the addition of other terms, here: “company”, “corporation”, or “corporations” 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 names 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 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.

It is accepted by the Panel that the Complainant has not licensed nor authorized the use of its trademark to the Respondent, and the Panel finds no indication that the Respondent is commonly known by the disputed domain names and the Respondent has not submitted any response to the Complaint in terms of any rights or legitimate interests in the disputed domain names or the registered LEGO trademarks. There is no evidence that either the Respondent’s activity through the disputed domain names constitutes fair use or the Respondent’s is making legitimate noncommercial or fair use of the disputed domain names. Considering that the Respondent is also not actively using the disputed domain names and also concealed its name under privacy, the Panel did not find sufficient evidence which shows legitimate interests or rights of the Respondent on disputed domain names.

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 the Respondent registered the disputed domain names primarily for the purpose of use with the intention to attract Internet users for commercial gain by creating a likelihood of confusion which is an indicator of bad faith according to the paragraph 4(b)(iv) of the Policy.

According to the evidence provided by the Complainant, the Panel notes that, the Complainant has provided evidence of the reputation of the LEGO trademark due to its longstanding and widespread use and the relevant amount of promotional investment made in the trademark. The reputation of the LEGO mark is in part supported by written evidence. The Complainant has supported the reputation of the LEGO mark with additional information such as media advertising expenditures and the sales of LEGO construction toy. Finally, the Respondent did not object to the reputation of the LEGO trademark and submit any counterarguments. Under certain circumstances, the registration of a domain name containing a well-known and highly recognizable trademark constitutes a bad faith registration, even if accompanied by another term, as it is highly likely that at the time of the registration of the domain name, the registrant knew that the well-known trademark he/she was including in the domain name, belonged to a third party. (See *PJ Hungary Szolgáltató Korlátolt Felelősségű Társaság v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-1345](#).)

Additionally, considering the list of other domain names registered in the name of the Respondent containing other well-known trademarks, the Panel notes that; according to [WIPO Overview 3.0](#) “business of cybersquatting often seeks to exploit the global reach of the Internet, and may in fact purposefully target a location other than that in which the respondent may be ‘present’” and actions of the Respondent is in fact an indicator of Respondent’s bad faith.

The Complainant proved that the disputed domain name <legocorporation.com> directs Internet users to a parked registrar website and, as such, is not being used while the disputed domain names <legocompany.com> and <legocorporations.com> are connected to websites displaying sponsored links. Currently, it is understood by the Panel that two of the disputed domain names resolve to a PPC advertising webpage. Therefore, the Panel notes that the Respondent also registered the disputed domain name for the purpose of attracting Internet users for commercial gain by creating a likelihood of confusion which is an indicator of bad faith according to the paragraph 4(b)(iv) of the Policy.

Panels have found that the non-use of a domain name (as a parked page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

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 <legocompany.com>, <legocorporation.com>, and <legocorporations.com> be transferred to the Complainant.

/Ahmet Akgüloğlu/

Ahmet Akgüloğlu

Sole Panelist

Date: July 18, 2024