

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Nyai tongkok
Case No. D2024-2302

1. The Parties

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

The Respondent is Nyai tongkok, Indonesia.

2. The Domain Name and Registrar

The disputed domain name <legolego.site> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 5, 2024. On June 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 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 (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 7, 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 June 12, 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 June 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 3, 2024. The Respondent sent two email communications to the Center on June 25, 2024, generally asking about the dispute (“How do I solve it” and “Thank you for the information.”).

The Center appointed Tobias Malte Müller as the sole panelist in this matter on July 16, 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 based in Denmark and is the owner of the trademark LEGO and all other trademarks used in connection with the LEGO branded construction toys and LEGO branded products. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries. It has expanded its use of the LEGO trademark to, inter alia, computer hardware and software, books, videos, and computer controlled robotic construction sets.

The Complainant is the registered owner of several trademarks worldwide consisting of or containing the term LEGO, e.g., European Union Trade Mark no. 000039800 LEGO (word), registered on October 5, 1998, for goods and services in classes 3, 9, 14, 16, 20, 24, 25, 28, 38, 41, and 42.

In addition, the Complainant operates the domain name <lego.com> for its official website.

The disputed domain name was registered on October 24, 2023. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name has resolved to a commercial website allegedly offering to distribute pirated movies.

Finally, the Complainant sent a cease-and-desist letter to the Respondent on November 23, 2023, and many reminders. The Respondent did not reply to any of them.

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 its well-known trademark LEGO, since the dominant part of the disputed domain name comprises the term "lego", identical to the registered trademark LEGO. The Second Level Domain of the disputed domain name consists solely of the Complainant's LEGO trademark, twice, resulting in a domain name that is identical to the Complainant's LEGO trademark, or at least confusingly similar.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain names. According to the Complainant, the Respondent is not commonly known by the disputed domain name. No license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. Instead, the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through a commercial website that offers to distribute pirated movies and is not related to the Complainant in any way. This activity does not constitute a legitimate business noncommercial enterprise and is, in fact, illegal. The Complainant contends the Respondent has taken unfair commercial advantage of the Complainant's trademark by using a domain name so closely similar to the Complainant's trademark to redirect users – who intend for the services of the Complainant – to a website offering services unconnected to the Complainant. Such use does not confer a genuine offering.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, it is inconceivable that the Respondent was unaware of the Complainant's registered trademarks when registering the disputed domain name, given that they are well-known and reputable. The disputed domain name is connected to a commercial website offering pirate movies, not related to the Complainant in any way. Nevertheless, no disclaimer is found on the website. Thereby, it is quite clear that the Respondent has chosen a trademark, which is world famous for its construction toys, to attract visitors to its website offering unrelated services. Consequently, the Respondent is using the disputed domain name to intentionally attempt to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. In addition to the above, the disputed domain name is also currently set up with mail exchanger ("MX") records. It is likely that the disputed domain name may be actively used to facilitate fraudulent activities such as phishing, impersonating, or passing off as the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

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

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 entirety of the mark is reproduced within the disputed domain name, even twice. Accordingly, the disputed domain name is identical or confusingly similar 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.

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.

Moreover, the Panel notes that the disputed domain name contains the Complainant’s registered and well-known trademark LEGO, and that more likely than not, this trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain name with the intention to mislead Internet users by taking advantage of the reputation and goodwill inherent in the Complainant’s trademark.

Panels have held that the use of a domain name for illegal activity here, offering to distribute pirated movies, can never confer rights or legitimate interests on a respondent, [WIPO Overview 3.0](#), section 2.13.1.

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 shares the view of other UDRP panels and finds that the Complainant’s trademark LEGO is well-known. Therefore, this Panel has no doubt that the Respondent positively knew or should have known the Complainant’s trademark when registering the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant’s trademark, which has simply been reproduced in its entirety twice. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith, [WIPO Overview 3.0](#) section 3.1.4. The Panel shares this view.

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.

In this regard, the further circumstances surrounding the disputed domain name’s registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith:

- (1) the nature of the disputed domain name, i.e., incorporating the Complainant's well-known trademark LEGO, which has been reproduced twice;
- (2) the content of the website to which the disputed domain name resolves (i.e., website allegedly offering to distribute pirated movies);
- (3) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name;
- (4) the Respondent did not reply to the Complainant's cease-and-desist letter and following reminders;
- (5) the disputed domain name has been set up with MX records, suggesting that the Respondent intended to create email addresses; and
- (6) the Respondent's use of a privacy service to conceal its identity.

Panels have held that the use of a domain name for illegal activity here, offering to distribute pirated movies, constitutes bad faith, [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 name <legolego.site> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: July 30, 2024