

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Karol Kruszyniewicz, VEG KING EUROPE LTD
Case No. D2024-3065

1. The Parties

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

Respondent is Karol Kruszyniewicz, VEG KING EUROPE LTD, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <legowallpannels.com> (the “Domain Name”) 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 July 26, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 26, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 to Complainant on July 29, 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 August 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 Respondent of the Complaint, and the proceedings commenced on August 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2024. The Response was filed with the Center on August 19, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 12, 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 alleges that it is a Denmark-based manufacturer of construction toys and related products, including wall and floor coverings. Complainant's LEGO trademark is registered in numerous jurisdictions throughout the world. Annexed to the Complaint is a list of Complainant's hundreds of registered trademarks around the world.

Complainant asserts that its licensees "are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in the United Kingdom, Europe and elsewhere."

According to the Complaint:

"Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the United Kingdom, and Europe."

With respect to the fame of the LEGO mark, Complainant annexes to the Complaint a list of "the official Top 10 Consumer Superbrands for 2019, provided by Superbrands UK, showing LEGO as number 1 Consumer Superbrand and number 8 in the Consumer Relevancy Index." Moreover, Complainant asserts (and supports with annexes), the Reputation Institute "recognized the LEGO Group as number 1 on its list of the world's Top 10 Most Reputable Global Companies of 2020." In 2014, Complainant states, TIME "announced LEGO to be the Most Influential Toy of All Time." (This assertion is also supported by evidence submitted with the Complaint.)

Complainant's main commercial website is located at "www.lego.com."

The Domain Name was registered on February 23, 2024, decades after Complainant began using the LEGO mark in commerce.

According to Complainant:

"Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through an unauthorised website offering products inspired by the Complainant's own LEGO® products. [...] In particular, the Respondent is using the Domain Name to host a website that offers for sale "Lego wall panels", which is not an official LEGO product but is designed to look like Complainant's famous LEGO bricks while appealing to customers of the Complainant's LEGO® brand."

Complainant annexes to the Complaint a screenshot of Respondent's website to corroborate the foregoing allegations.

Complainant sent Respondent a cease-and-desist letter on March 8, 2024. Complainant received no reply to that letter.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent's entire substantive reply to the Complaint is as follows: "We do not use this domain for commercial purposes; it is solely employed for the testing of software." While this communication was

submitted by an individual with a name different from the Respondent's name, the Panel notes that the email address used seems to be connected to the registrant organization confirmed by the Registrar.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel finds that Complainant has rights in the mark LEGO through registration and use demonstrated in the record. The Panel also finds that the Domain Name is confusingly similar to the LEGO mark.

Notwithstanding the additional words "wall" and "pannels" (sic), the LEGO mark is clearly recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Apart from a single, uncorroborated sentence, Respondent has not come forward in this proceeding to explain any possible bona fides it may have vis-à-vis the Domain Name. Respondent's claim to be using the Domain Name for a mere testing site, and not for a commercial site impersonating Complainant, is unsupported and implausible, given the nature of the website to which the Domain Name resolves. The Panel notes that Respondent could have cleared up any misunderstanding about the Domain Name and the corresponding website by replying to Complainant's cease-and-desist letter, but Respondent did not reply. This is not to suggest that replying to that letter would have justified Respondent's registration and use of the Domain Name, but the point here is that Respondent's silence in response to that letter tends to belie Respondent's claim in this proceeding to have had more innocuous motives. Furthermore, the composition of the Domain Name creates a risk of implied affiliation.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent 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 its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section. On this record, the Panel finds it clear that Respondent targeted Complainant’s famous LEGO mark when registering the Domain Name and has used the Domain Names for illegitimate commercial gain by seeking to divert Internet traffic by impersonating Complainant. This constitutes bad faith registration and use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <legowallpanels.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: September 19, 2024