

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Thomas Ronk, Tendency LLC
Case No. D2022-1284

1. The Parties

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

The Respondent is Thomas Ronk, Tendency LLC , United States of America (“United States” or “U.S”).

2. The Domain Name and Registrar

The disputed domain names <legoartnft.com>, <legoartnfts.com> and <legosnfts.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 April 11, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 2022, 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 21, 2022, and requested to remove a fourth domain name from this administrative proceeding, which subsequently became part of another proceeding.

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 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2022. The Respondent did not submit any response.

The Center appointed Daniel Peña as the sole panelist in this matter on June 8, 2022. 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 the owner of LEGO and all other trademarks used in connection with the famous LEGO brand of construction toys and other LEGO branded products, including United States Registration No 73032292, registered on December 9, 1975, and European Union Registration No 000039800, registered on October 5, 1998

The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in the United States and elsewhere.

The Complainant and its licensees, through their predecessors commenced use of the LEGO mark in the United States in 1953, to identify construction toys made and sold by them.

Over the years, the business of making and selling LEGO branded toys has grown. For instance, the revenue for the LEGO Group in 2008, was more than USD 1.8 billion.

The Complainant has subsidiaries and branches throughout the world.

LEGO products are sold in more than 130 countries including the United States. The Complainant is also the owner of more than 1000 domain names containing the term LEGO.

The LEGO Group has expanded its use of the LEGO trademark to, *inter alia*, computer hardware and software, books, videos and computer controlled robotic construction sets.

The LEGO Group maintains an extensive website under the domain name <lego.com>.

The disputed domain names were registered on June 24, 2021. The disputed domain names used to resolve to a Registrar parking page.

5. Parties' Contentions

A. Complainant

The trademark LEGO is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. Indeed, the LEGO trademark and brand have been recognized as being famous. For instance, according to a list of the official top 500 Superbrands for 2009/10.

The disputed domain names are confusingly similar to the Complainant's world famous trademark LEGO, the Respondent has no rights or legitimate interests in the disputed domain names and the disputed domain names have been registered and are being used in bad faith.

The fame of the trademark LEGO has been confirmed in numerous previous UDRP decisions.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the disputed domain names transferred, the Complainant must show the following per the Policy, paragraph 4(a):

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant bears the burden of proof for each of these elements.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademarks LEGO on the basis of its multiple trademark registrations in the U.S. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see section 1.2.1, of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#). The Panel finds that the disputed domain names are confusingly similar to the Complainant's LEGO marks. The Respondent's incorporation of the Complainant's mark in full in the disputed domain names is evidence that the disputed domain names are confusingly similar to the Complainant's marks. Mere fact of the addition of the words "art" and the acronym "nfts" which corresponds to non fungible tokens, to the Complainant's trademark LEGO do not prevent a finding of confusing similarity with the Complainant's marks. Furthermore, the addition of the generic Top-Level Domains "(gTLD)" ".com" and ".org" does not prevent a finding of confusing similarity either.

The Panel is satisfied that the disputed domain names are identical or confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests the disputed domain names. The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain names. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner. Furthermore, the disputed domain names redirect Internet users to websites with sponsored links as well as to resolve to websites that state that the disputed domain names may be for sale, displaying a telephone number through which interested users may inquire about their purchase, without any disclaimer as to the relation with or authorization of the Complainant, exacerbating the user confusion as to

the website's affiliation to the Complainant. Such use for deliberately attracting Internet users to its website in the mistaken belief that it is a website of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain names. Moreover, the Complainant contends that the Respondent likely uses the website to collect personal and payment information from confused Internet users, which constitutes an illegal use that can never confer rights or legitimate interests upon a respondent.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain names and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) the 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 the respondent has engaged in a pattern of such conduct;
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the Complainant submits that at the date of registration of the disputed domain names the Respondent would have had constructive, if not actual knowledge of the Complainant's mark LEGO.

Furthermore, the disputed domain names redirect users to websites with sponsored links as well as to resolve to websites that state that the disputed domain names may be for sale, displaying a telephone number through which interested users may inquire about their purchase, without any disclaimer as to the relation with or authorization of the Complainant, exacerbating the user confusion as to the website's affiliation to the Complainant as well as the Respondent's bad faith..

The Panel takes into account the evidence of the use being made of the disputed domain names. It is apparent, as it is pointed out by the Complainant, that the Respondent registered the disputed domain names with the addition of expressions "nft" and "art" in an attempt to cause a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites.

In the absence of a rebuttal of these submissions in a full Response, the Panel finds that the disputed domain names were registered in bad faith.

The Complainant also relies upon the fact that the Respondent failed to respond to cease and desist letters sent by the Complainant's lawyers, in which the Complainant requested the Respondent should stop using and transfer the disputed domain names. The Panel follows earlier UDRP decisions and finds that a failure to respond to such a letter can be further *prima facie* evidence of bad faith.

Consequently, the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith within paragraph 4(a)(iii) 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, <legoartnft.com, legoartnfts.com, legosnfts.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: June 22, 2022