

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Andres Conteris, Domains4Sale4All (at) gmail.com
Case No. D2022-1315

1. The Parties

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

The Respondent is Andres Conteris, Domains4Sale4All (at) gmail.com, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <thelego.group> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2022. On April 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Center received a communication from the Respondent on April 22, 2022 with a request for suspension of the proceeding to explore settlement. On April 26, 2022, the Complainant also requested the suspension of the proceeding. On April 26, 2022, the Center suspended the proceeding until May 26, 2022. On May 26, 2022, the Complainant requested the reinstatement of the proceeding. On the same date, the Center reinstated the proceeding and confirmed June 8, 2022 as the

new due date for Response. The Respondent did not send any further email communication. On June 9, 2022, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Assen Alexiev as the sole panelist in this matter on June 27, 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 the LEGO brand used in connection with construction toys and other LEGO branded products. Its licensees are authorized to exploit the Complainant's intellectual property rights in the United States and elsewhere. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the United States.

The Complainant is the owner of the following trademark registrations for the sign LEGO (the "LEGO trademark"):

- the Austrian trademark LEGO with registration No. 32809, registered on June 16, 1955 for goods in International Classes 3, 6, 7, 9, 11, 15, 16, 28, 19, 24, 26, 18, 27, 25, 20, and 30;
- the International trademark LEGO with registration No. 287932, registered on August 27, 1964 for goods in International Class 28;
- the United Kingdom trademark LEGO with registration No. UK00001022027, registered on December 11, 1973 for goods in International Classes 16, 20, and 28;
- the United States trademark LEGO with registration No. 1248936, registered on August 23, 1983 for goods in International Classes 16, 20, 22, and 25;
- the International trademark LEGO with registration No. 1006003, registered on June 17, 2009 for goods and services in International Classes 3, 14, 18, 20, 21, 24, 27, 30, and 43.

The LEGO trademark was listed as number 1 Consumer Superbrand in the Top 10 Consumer Superbrands for 2019, provided by Superbrands UK. 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, TIME announced LEGO to be the Most Influential Toy of All Time.

The Complainant maintains its official website at the domain name <lego.com>.

The disputed domain name was registered on July 2, 2021. It resolves to a website displaying sponsored links and is offered for sale for USD 348 on the platform "sedo.com".

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its LEGO trademark, because it incorporates the LEGO trademark with the addition of the prefix "the". According to the Complainant, when comparing the disputed domain name and the Complainant's trademark, the Top-Level Domain ("TLD") ".group" may properly be considered in assessing and determining confusing similarity between the disputed domain name and the Complainant's trademark. The Complainant notes in this regard that it and its various affiliates are collectively known as "The LEGO Group". The Complainant maintains that with reference to the reputation of the LEGO trademark there is a considerable risk that the trade public will

perceive the disputed domain name as a domain name owned by or related to the Complainant.

In the Complainant's submission, the Respondent has no rights or legitimate interests in respect of the disputed domain name, as it has no registered trademark or trade name corresponding to the disputed domain name and is not commonly known by it, and the Complainant has not licensed the Respondent to use the LEGO trademark. According to the Complainant, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, as it resolves to a website that contains sponsored third-party links and is being offered for sale for an amount that exceeds the Respondent's out-of-pocket expenses in registering the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It submits that the LEGO trademark is well known and refers to Article 6bis of the Paris Convention for protection of Industrial Property and Article 16.2 and Article 16.3 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, whereby the statute of a well-known trademark provides the owner of such a trademark with the right to prevent any use of the well-known trademark or a confusingly similar denomination in connection with any products or services.

The Complainant notes that the Respondent registered the disputed domain name on July 2, 2021, which date is subsequent by decades to the date when the Complainant registered the LEGO trademark in the United States where the Respondent resides. According to the Complainant, the fame of the LEGO trademark motivated the Respondent to register the disputed domain name. The Complainant points out that the disputed domain name is connected to a website that displays sponsored links. According to it, it is irrelevant whether or not the Respondent has influenced what links should be included on the website and whether or not the Respondent is actually itself getting revenue from the website.

The Complainant points out that the Respondent is currently offering to sell the disputed domain name for an amount in excess of its out-of-pocket expenses for the registration of the disputed domain name.

The Complainant states that it tried to contact the Respondent on August 31, 2021 through a cease-and-desist letter, but no reply was received.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions, except for an email communication requesting to suspend the proceeding for settlement talks.

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (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 was registered and is being used in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”.

The Respondent however did not submit any substantive Response in this proceeding.

A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of the LEGO trademark and has thus established its rights in this trademark for the purposes of the present proceeding.

The Panel notes that the applicable TLD in a domain name (in this case “.group”) is usually viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to new generic TLDs); the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element. The meaning of such TLD may however be relevant to panel assessment of the second and third elements. See section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

The relevant part of the disputed domain name incorporates the LEGO trademark entirely with the addition of the article “the”, and the trademark is easily recognizable in it. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the LEGO trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Complainant has not authorized the Respondent to use the well-known LEGO trademark and the Respondent is not commonly known under the disputed domain name. The Complainant adds that the disputed domain name resolves to a webpage containing sponsored third-party links and is being offered for sale. Thus, 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 submitted any substantive Response and has not alleged that it has rights or legitimate interests in the disputed domain name and has not disputed the Complainant’s allegations in this proceeding. The evidence in the case file shows that the well-known LEGO trademark was registered many years before the registration of the disputed domain name, and that it resolves to a parking webpage containing what appear to be pay-per-click links to third party websites related to the Complainant’s offerings and to games.

The disputed domain name is confusingly similar to the LEGO trademark and its composition, including the “.group” TLD, coincides with the name “The LEGO Group” under which the Complainant’s business group is known.

In view of the above and in the lack of any evidence to the contrary, the Panel is satisfied that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s LEGO trademark, has registered and used the disputed domain name in an attempt to exploit the trademark’s goodwill to attract Internet users who may believe that the disputed domain name is an official online location of the Complainant, and then expose them to the commercial links featured on the associated website. To the Panel, such conduct does not appear to be legitimate nor giving rise to rights or legitimate interests on the Respondent in the disputed domain name.

In view of the above, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

As discussed above, the disputed domain name is confusingly similar to the LEGO trademark and was registered many years after it. Its composition, including the “.group” TLD, coincides with the name “The LEGO Group” under which the Complainant and its affiliates are jointly known. This may well create an impression in Internet users that the disputed domain name belongs to the Complainant and represents an official online location where sponsored links are related to the Complainant’s products. Further, the website at “www.sedo.com” mentions that the disputed domain name is offered for sale for USD 348.

Taking the above into account, the Panel accepts that it is more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the LEGO trademark in an attempt to attract Internet users for commercial gain by creating a likelihood of confusion with the LEGO trademark as to the affiliation of the disputed domain name. In the lack of any evidence to the contrary, the amount of USD 348, for which the Respondent offers the disputed domain name for sale, appears to be a valuable consideration in excess of the Respondent’s out-of-pocket costs directly related to the disputed domain name.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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 <thelego.group> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: July 11, 2022