

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Reg Com
Case No. D2022-1562

1. The Parties

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

The Respondent is Reg Com, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names <legoshops.com>, <legoshop.site>, <legoshops.online>, and <лepo.online> [xn--c1adro.online] are registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2022. On April 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 4, 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. On May 9, 2022, the Center to Parties a document in English and Russian in relation to the language of the proceeding. On May 13, 2022, the Complainant filed an amended Complaint with which it requested that the language of the proceeding be English. The Respondent did not submit any comments on the language of the 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 in English and Russian, and the proceedings commenced on May 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default in both English and Russian on June 10, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on June 21, 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, including its trademark rights in the Russian Federation and elsewhere. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including the Russian Federation.

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

- The trademark LEGO with registration No. 42932, registered in the Russian Federation on December 10, 1971 for goods in International Class 28. On March 26, 2013, this trademark was officially declared as well-known in the Russian Federation;
- The trademark LEGO with registration No. 59114, registered in the Russian Federation on August 25, 1977 for goods in International Class 28; and
- The trademark ЛЕГО (transliteration of "LEGO" in Cyrillic letters) with registration No. 74727, registered in the Russian Federation on January 30, 1984 for goods in International Class 28.

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 names were registered on June 20, 2021. They are inactive.

5. Parties' Contentions

A. Complainant

The Complainant 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 maintains that the disputed domain names are confusingly similar to the Complainant's LEGO trademark. The disputed domain names <legoshops.com>, <legoshop.site>, and <legoshops.online> reproduce the LEGO trademark, while the disputed domain name <лего.online> is an internationalized domain name ("IDN") with the punycode translation of [xn--c1adro.online], which translates as "lego.online" in English, so the LEGO trademark is incorporated into it as well in a transliterated form. According to the Complainant, with reference to the reputation of the LEGO trademark in the Russian Federation, there is a considerable risk that the public will perceive the disputed domain names as 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 names, as it has no registered trademarks or trade names corresponding to the disputed domain names and is not commonly known by them, 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 names in a way that would give rise to rights or legitimate interests in them, as the disputed domain names resolve to error pages and lack content.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. They were registered decades after the Complainant registered the LEGO trademark in the Russian Federation and elsewhere. According to the Complainant, the Respondent was aware of the Complainant's rights in the LEGO trademark, and the fame of this trademark motivated the Respondent to register the disputed domain names seeking to create an impression of association with the Complainant.

The Complainant notes that the disputed domain names resolve to inactive sites. However, "use" in the context of paragraph 4(a)(iii) of the Policy does not require a positive act on the part of the Respondent, and the passive holding of a domain name can constitute a factor in finding bad faith registration and use. In this case, the disputed domain names can only be taken as intending to cause confusion among Internet users as to their source, and no good faith use of them is possible. Rather, the circumstances of the case indicate that the Respondent is holding the disputed domain names for some future active use that would be competitive with or otherwise detrimental to the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural issue – Language of the proceeding

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain names is Russian. Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests that the language of the proceedings be English. In support of this request, the Complainant submits that it is unable to communicate in Russian and the translation of the Complaint would unfairly disadvantage and burden it and delay the proceedings. According to the Complainant, such additional delay poses continuing risk to it and to unsuspecting consumers seeking the Complainant or its products.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainants' request that the proceedings be held in English.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English.

6.2. Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the

transfer of the disputed domain names:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names were registered and are 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 a 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 his rights in this trademark for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain (“TLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com”, “.site”, and “.online” gTLDs of the disputed domain names.

The disputed domain names <legoshops.com>, <legoshop.site>, and <legoshops.online> incorporate the LEGO trademark entirely with the addition of the words “shop” or “shops”. The disputed domain name <лего.онлайн> incorporates the ЛЕГО trademark of the Complainant, which is the Cyrillic-letter version of the LEGO trademark, and it can also be said that this disputed domain name incorporates the LEGO trademark in a transliterated form, without the addition of other elements. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. 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 sections 1.7 and 1.8 of the [WIPO Overview 3.0](#).

In view of the above, the Panel finds that the disputed domain names are 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 names, 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 names. The Complainant adds that the disputed domain names are inactive, and the only purpose for their registration must have been to create an impression of association with the Complainant. 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 a Response and has not alleged that it has rights or legitimate interests in the disputed domain names and has not disputed the Complainant's allegations in this proceeding. The evidence in the case file shows that the LEGO trademark has been officially declared as well-known in the Russian Federation where the Respondent is located eight years before the registration of the disputed domain names, and that they are inactive.

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 the disputed domain names in an attempt to exploit the trademark's goodwill to attract Internet users. To the Panel, such conduct does not appear to be legitimate nor giving rise to rights or legitimate interests of the Respondent in the disputed domain names.

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

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 names are confusingly similar to the LEGO trademark and were registered many years after it. Three of them include the dictionary words "shop" or "shops". As already mentioned, the LEGO trademark has been declared as well-known in the Russian Federation, where the Respondent is located. These factors may create an impression in Internet users that the disputed domain names are affiliated to the Complainant and represent online locations where the Complainant's products are offered for sale.

Taking the above into account, the Panel accepts that it is more likely than not that the Respondent has registered the disputed domain names with knowledge of the Complainant and targeting the LEGO

trademark in order to take unfair advantage of, or otherwise abuse, such trademark. This conclusion supports a finding that the Respondent has registered the disputed domain names in bad faith.

The disputed domain names do not resolve to active websites. However, in view of the well-known status of the LEGO trademark and the confusing similarity between it and the disputed domain names, and the lack of any plausible explanation by the Respondent of the registration of the disputed domain names, the Panel is not aware of any legitimate use to which they may be put by the Respondent.

Therefore, the Panel finds that the disputed domain names have been registered and 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, <legoshops.com>, <legoshop.site>, <legoshops.online>, and <лeгo.online> [xn--c1adro.online], be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: June 23, 2022