

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Ivan Ivanov, LLC “artistnft”
Case No. D2022-3035

1. The Parties

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

The Respondent is Ivan Ivanov, LLC “artistnft”, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <legometaworld.com> is 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 August 17, 2022. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 19, 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 August 25, 2022, the Center sent an email communication to the Parties in both English and Russian regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on August 25, 2022. The Respondents did not comment on the language of the proceeding.

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 September 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on October 3, 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 makes and sells LEGO-branded toys and has subsidiaries and branches throughout the world. Its LEGO products are sold in more than 130 countries, including the Russian Federation.

The Complainant is the registered owner of the LEGO trademark in numerous jurisdictions. The Complainant has submitted a schedule of all its registrations as an Annex to the Complaint. However, relevantly for present purposes it has registered the LEGO trademark in the Russian Federation, No. 280003, registered December 10, 2004, in relation to goods in Class 16, and No. 42932, registered on December 10, 1971 for goods in Class 28. International trademark registration No. 869258, registered on November 11, 2005, also claims protection for LEGO in the Russian Federation under the Madrid Protocol.

The disputed domain name was registered on January 1, 2022 and currently does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant says that the trademark LEGO is one of 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. It says that the LEGO mark has substantial inherent and acquired distinctiveness. The Complainant also points out that it has expanded its use of the LEGO trademark to, *inter alia*, computer hardware and software, books, videos, and computer controlled robotic construction sets. It also maintains an extensive website under the domain name <lego.com>.

The Complainant submits that the disputed domain name incorporates its LEGO trademark, which forms its dominant part. The addition of the terms "metaworld" do not diminish the confusing similarity of the disputed domain name and the LEGO trademark. The Complainant maintains that it is a long-established precedent that confusing similarity is recognized when well-known trademarks are paired with various generic prefixes and suffixes. A consumer would mistakenly conclude that there is some official connection between the disputed domain name and the Complainant.

The Complainant says that it has not identified any registered trademarks or trade names corresponding to the disputed domain name in the name of the Respondent, nor is there anything that would suggest that the Respondent has been using LEGO in any way that would give them any legitimate rights. The Complainant has not granted any license or authorization of any other kind to the Respondent, in relation to the trademark LEGO. The Respondent is not an authorized dealer of LEGO products. Accordingly, it is quite clear that the Respondent is simply trying to benefit from the Complainant's world famous trademark, the latter maintains. The fact that the Respondent has not demonstrated any attempt to make legitimate use of the disputed domain name evidences an absence of rights or legitimate interest, something the Complainant says has been confirmed by numerous past UDRP panels.

According to the Complainant, the LEGO trademark in respect of toys has the status of a well-known and reputable trademark with substantial and widespread goodwill throughout the world. The extensive goodwill adhering to the LEGO mark is what motivated the Respondent to register the disputed domain name, or so the Complainant says. The date of registration of the disputed domain name falls more than 50 years after the initial registration of the LEGO mark in the Russian Federation. In the circumstances, the Respondent

cannot have been unaware of the rights the Complainant has in the LEGO mark and the goodwill that attaches to it. The Complainant argues that the incorporation of a well-known trademark in a domain name may be an indication of bad faith.

The Complainant points out that the disputed domain name currently resolves to an inactive parking site and is not being used. However, past Panels have noted that the word bad faith “use” in the context of paragraph 4(a)(iii) of the Policy, does not require a positive act on the part of the Respondent – instead, passively holding a domain name can constitute a factor supporting a finding of bad faith registration and use. Moreover, the Complainant contends where a disputed domain name is identical to a Complainant’s trademark, there is no plausible good-faith reason or logic for a Respondent to have registered it, but rather, it is indicative of an intention to hold the disputed domain name for some future active use that would be detrimental to the Complainant.

Furthermore, the Complainant says that this matter demonstrates a pattern of bad faith registrations, in other words of systematic cybersquatting by the Respondent. The Complainant points to past UDRP decisions in which the present Respondent had registered other domain names incorporating highly reputed trademarks, and which he was ordered to transfer to the relevant Complainants (five different matters are listed). The Complainant maintains that the Respondent currently holds registrations for other domain names that misappropriate the trademarks of well-known brands and businesses, further demonstrating the pattern of cybersquatting that demonstrates that the Respondent registered and used the disputed domain name in bad faith in the present case.

The Complainant further stresses that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, but is misleadingly diverting consumers for his own commercial gain.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

The registration agreement for the disputed domain name is in Russian. However, the Complainant requests that this proceeding be conducted in English. The Complainant points out that it cannot communicate in Russian and would have to avail itself of translation services, a burden and disadvantage that would also delay the proceedings. Analogous proceedings against the same Respondent have been conducted in English on at least eight occasions. The Complainant’s trademark benefits from very wide notoriety around the globe. The LEGO mark is in the present disputed domain name conjoined to terms that are English (“world”) or commonly used in English expression (“meta”). To allow the Respondent who has not reacted to either the Complaint or the letter of demand of the Complainant, to impose considerable cost, risk (while the disputed domain name would remain active), and delay would be unfairly burdensome, and is not demanded by considerations of fairness.

Taking all the circumstances into account and in the interest of due expedition, the Panel determines that the present proceeding be conducted in English.

6.2 Substantive Elements of the Policy

A. Identical or Confusingly Similar

The disputed domain name is not identical with the LEGO trademark of the Complainant. However, the LEGO trademark is wholly incorporated and immediately recognizable within the disputed domain name. The addition of the terms “meta” and “world” does not prevent a finding of confusing similarity.

Therefore, the Panel holds that the disputed domain name is confusingly similar to the LEGO trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent did not reply to any the contentions of the Complainant, nor did he react to the letter of demand the latter forwarded to him. There is nothing before the Panel to indicate that the Respondent is known by the disputed domain name or the Complainant's trademark. Nothing before the Panel indicates that the Respondent has any registered or recognized rights in LEGO as a mark, a business name, or any other denominator.

The Complainant has not authorized the Respondent to use the LEGO trademark or incorporate it in any registered domain name, and the Respondent is not an authorized reseller of LEGO trademarked goods. It appears that the Respondent has simply availed himself of the opportunity to incorporate a notorious mark with a world-wide reputation in a domain name with an eye to some future profit or return. The disputed domain name does not resolve to an active website and there is nothing in the record to suggest any kind of legitimate noncommercial or fair activity, or *bona fide* offering of goods or services, that may result in the recognition of rights or legitimate interests vesting in the person who engages in it.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant's material indicates that the LEGO trademark is one of the most distinctive and widely recognized in the world, and that it has been for decades before the registration of the disputed domain name. It is inconceivable that the Respondent was not aware of these facts, and his demonstrated tendency to register domain names incorporating well-established global marks further supports that conclusion. The disputed domain name was carefully chosen and composed indicating a registrant who knew full well what he was doing; in other words, a clear example of cybersquatting.

That the Respondent has not in fact made any website-related use of the disputed domain name does not prevent a finding of bad faith: clearly almost any use imaginable of the disputed domain name would be abusive of the Complainant's trademark and tending to mislead consumers. In any case, it is well established by consistent decisions by previous UDRP panels that passive holding of a domain name can constitute use in bad faith. That is all the more the case where the domain name concerned incorporates a widely recognized and well-reputed mark, as here, that a Respondent has no rights or legitimate interests in.

Therefore, the Panel holds that the disputed domain name was 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 <legometaworld.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: October 16, 2022