

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Mudasser Akram
Case No. D2022-4707

1. The Parties

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

The Respondent is Mudasser Akram, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <legopokemon.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2022. On December 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended Complaint. The Complainant filed an amended Complaint on December 14, 2022.

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”).

On December 14, 2022, the Center was informed of communications between Parties. On December 14, 2022, the Center sent the possible settlement mail. However, the Complainant did not suspend the proceeding.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 22, 2022. In accordance with the Rules,

paragraph 5, the due date for Response was January 11, 2023. On January 16, 2023, the Center received an informal communication from the Respondent to which the Center acknowledged receipt.

The Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on January 16, 2023.

The Center appointed John Swinson as the sole panelist in this matter on January 23, 2023. 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 a company based in Denmark that produces construction toys under the brand LEGO. The Complainant has numerous trademarks for LEGO, including United States Trademark Registration No. 1018875 registered August 26, 1975 and registrations in many other countries including in the United Kingdom. LEGO is a very well-known brand, with LEGO products sold in many countries around the world including in the United Kingdom. The LEGO brand is recognized by people of all ages. The LEGO brand is also used for related products, such as the very successful Star Wars Lego computer games which involves characters made from LEGO bricks re-enacting Star Wars adventures.

The Respondent did not file a response, so little information is known about the Respondent. According to the Registrar's records, the Respondent is an individual with an address in York, England, United Kingdom.

The disputed domain name was registered on December 15, 2021.

The disputed domain name resolves to a website titled LEGO POKEMON that is an online store selling what appears to be POKEMON products, such as POKEMON cards, POKEMON figures, POKEMON pajamas and POKEMON building blocks. The description metatag for the website states "Lego Pokemon is an online store of pokemon toys and figures, we offer the best and latest collection of Lego pokemon toys for children and pokemon lovers". The website does not appear to sell or promote LEGO products. Some of the links on the website do not function correctly (e.g. the FAQ link does not work correctly) and there are textual spelling mistakes (e.g. "Whishlist").

The Complainant first tried to contact the Respondent on April 11, 2022 through a cease and desist letter sent via the Registrar's contact webform. The Complainant thereafter filed this Complaint.

After the Complaint was filed, the parties had an exchange of correspondence. The Respondent appeared to offer to transfer the disputed domain name to the Complainant, possibly for payment. The Complainant offered to pay the Respondent the registration fees for the disputed domain name. The matter did not resolve in any agreement.

5. Parties' Contentions

A. Complainant

In summary, the Complainant made the following submissions:

The LEGO trademark is among the best-known trademarks in the world, due in part to decades of extensive advertising, which depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials.

The Complainant's LEGO trademark is recognizable within the disputed domain name despite the addition of POKEMON trademark - as such, the disputed domain name must be considered confusingly similar to the Complainant's LEGO trademark

The Complainant has not found that the Respondent has any registered trademarks corresponding to the disputed domain name. No license or authorization of any other kind has been given by the Complainant to the Respondent to use the LEGO trademark.

The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. There is no evidence to show that the Respondent has ever been commonly known by the moniker "Lego Pokemon", apart from the disputed domain name. The Complainant did not find any registered business by the name of "Lego Pokemon" in the business registry website of the United Kingdom. The Respondent's name does not resemble the disputed domain name.

The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, the Respondent has intentionally chosen a domain name based on registered trademarks to generate traffic and income through a website which promotes POKEMON toy products for sale, several of which are toy brick products, which compete with the Complainant's business.

B. Respondent

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

The Respondent sent an email on January 16, 2023 that stated: "i want to share the domain with you permanently. but i'm not getting any positive response from your side."

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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 has been registered and is being used in bad faith.

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The disputed domain name includes the Complainant's famous LEGO trademark in its entirety.

The disputed domain name also includes the POKEMON trademark. Where the Complainant's trademark is recognizable within the disputed domain name, the addition of another third-party trademark in the disputed domain name is of itself insufficient to avoid a finding of confusing similarity to the Complainant's trademark

under the first element of the Policy. *Aldi GmbH & Co. KG, Aldi Stores Limited v. Ronan Barrett*, WIPO Case No. [D2016-2219](#); *Sodexo v. Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-2216](#); and *LEGO Juris A/S v. eres syafei*, WIPO Case No. [D2011-1589](#).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's LEGO trademark.

The Complainant succeeds in respect of the first element of the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

(iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant's allegations to support the Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above in section 5A. The Panel finds that the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the burden shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain name.

The Respondent has chosen not to file a formal Response. The Respondent has not produced any evidence to establish its rights or legitimate interests in the disputed domain name.

Accordingly, none of the circumstances listed in paragraph 4(c) apply in the present circumstances. The Panel finds on the evidence before the Panel that the Respondent has no rights or any legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith. These are conjunctive requirements; both must be satisfied for a successful complaint.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by the complainant.

The disputed domain name is currently connected to a commercial website offering for sale POKEMON toy products. This is clearly a commercial purpose. There is no obvious reason for the Respondent to register the disputed domain name other than for the purpose of attempting to trade off the Complainant's goodwill in its famous LEGO trademark.

The Panel finds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website under paragraph 4(b)(iv) of the Policy.

The Complainant succeeds on the third element of the Policy in relation to the disputed domain name.

D. Appropriate Remedy

This Panel adopts the consensus view that there is no basis for denying the Complainant the remedy of transfer merely because the disputed domain name contains, in addition to the Complainant's LEGO trademark, a trademark owned by a third party. This transfer does not preclude the third-party trademark owner from bringing an action under the Policy or relevant law against the Complainant if that trademark owner considers the Complainant's holding of the disputed domain name to be in violation of the Policy or applicable law. See, for example, *Ulysses GmbH & Co. KG v. Domain Protection Services, Inc. / Catalina DC*, WIPO Case No. [D2020-3240](#).

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 <legopokemon.com> be transferred to the Complainant.

The transfer of the disputed domain name without prejudice to any rights of the owner of the POKEMON trademark.

/John Swinson/

John Swinson

Sole Panelist

Date: January 31, 2023