

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Stacey Buckley

Case No. D2022-5014

1. The Parties

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

The Respondent is Stacey Buckley, United States of America (“US”).

2. The Domain Name and Registrar

The disputed domain name <legolanditaly.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 28, 2022. On December 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 30, 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 and contact information already mentioned in the Complaint.

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 January 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 15, 2023.

The Center appointed Geert Glas as the sole panelist in this matter on February 22, 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 toy company based in Denmark selling interlocking plastic bricks in more than 130 countries. The protection of the LEGO trademark goes far beyond toys, as the Complainant has extended its use to computer hardware and software, books, videos and computer controlled robotic construction sets. Its LEGOLAND trademark is used for theme parks, hotels, entertainment, sporting and cultural activities. Yearly, LEGOLAND theme parks have about 1.4 million visitors.

The Complainant is the owner of close to 5,000 domain names containing the terms LEGO and LEGOLAND, including <lego.com>. The Complainant owns many international and national trademark rights, including:

The US word mark LEGO, registration no. 2065901, registered on May 27, 1997.

The US word mark LEGO, registration no. 2189528, registered on September 15, 1998.

The US word mark LEGOLAND, registration no. 3446087, registered on June 10, 2008.

The US word mark LEGOLAND, registration no. 2334535, registered on March 28, 2000.

The Danish word mark LEGO, registration no. VR196300094, registered on January 12, 1963.

The Danish word mark LEGO, registration no. VR195400604, registered on May 1, 1954.

The disputed domain name was registered on January 15, 2022, and leads to a pay-per-click website displaying related sponsored links, titled "Hotel Accommodation", "Lego Toys on Sale" and "Adult Lego Sets".

On April 22, 2022, the Complainant sent a cease and desist letter to the Respondent in which a transfer of the disputed domain name was requested. The Complainant sent two reminder correspondences on April 29, 2022 and May 9, 2022. No reply was received to any of these letters.

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The Complainant requests that the disputed domain name be transferred to it on the following grounds:

The Complainant claims that the disputed domain name is confusingly similar to its LEGO and LEGOLAND trademarks, regardless of the addition of the geographical suffix "italy" and the generic Top-Level Domain ("TLD") ".com". The Complainant considers that the Respondent is voluntarily exploiting the goodwill and the image of its LEGO and LEGOLAND trademarks by registering a domain name that is confusingly similar to its trademarks.

Subsequently, the Complainant argues that the Respondent does not have rights or legitimate interests in respect of the disputed domain name. It argues that the Respondent has not been authorized nor licensed by the Complainant to use the trademarks. Moreover, it asserts that the Whois information suggests that the Respondent is not commonly known by the disputed domain name. The Complainant claims that the website to which the disputed domain name leads shows the Respondent's intention of taking unfair advantage of the reputation of the Complainant's trademarks.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, it is obvious that the Respondent is intentionally attempting to take

advantage of the Complainant's trademarks to generate profits by misleading consumers with a domain name confusingly similar to the Complainant's trademarks.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The first element of paragraph 4(a) refers to the question of whether the disputed domain is identical or confusingly similar with the Complainant's trademark.

In a side-by-side comparison of the disputed domain name and the textual components of the relevant trademarks, the Panel observes that the disputed domain name comprises the Complainant's LEGOLAND word trademark, with as only differences the addition of the geographical term "italy" and the TLD ".com".

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that "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 (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional terms may however bear on assessment of the second and third elements (section 1.8 [WIPO Overview 3.0](#)). The addition of the geographical term "italy" does not dispel the confusing similarity between the disputed domain name and the Complainant's trademarks.

Finally, it is a well-established principle that the use of a TLD is considered as a standard registration requirement and as such is to be disregarded in the confusing similarity test (section 1.11.1 [WIPO Overview 3.0](#)). The addition of the TLD ".com" in the disputed domain name <legolanditaly.com> does not prevent a finding of confusing similarity with the LEGOLAND trademark.

Accordingly, the Panel finds that the first element under paragraph 4(a)(i) of the Policy has been established in respect of the Domain Name.

B. Rights or Legitimate Interests

The second element of paragraph 4(a) refers to the question of whether the Respondent has rights or legitimate interests in respect of the disputed domain name.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, the consensus view is that, once the Complainant has made 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 disputed domain name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (section 2.1 [WIPO Overview 3.0](#); *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Dow Jones & Company, Inc., (First Complainant) and Dow Jones LP (Second Complainant) v. The Hephzibah Intro-Net Project Limited* (Respondent), WIPO Case No. [D2000-0704](#)).

Based on the evidence submitted by the Complainant, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Such finding is based on the following observations:

- i. The Respondent has not received any authorization, license or permit from the Complainant to use its LEGO and LEGOLAND trademarks in association with the registration of the disputed domain name.
- ii. There is no indication that the Respondent holds trademark rights on the words “legoland” or “legolanditaly”, nor that the Respondent is commonly known by the names “lego”, “legoland” or “legolanditaly”; in particular because the information about the Respondent’s identity provided by the Registrar does not suggest any correlation with the words “lego”, “legoland” and “legolanditaly” (section 2.3 [WIPO Overview 3.0](#)).
- iii. There is no indication that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or is using the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, the disputed domain name resolves to a pay-per-click website generating income through sponsored links. That said, panels have held that the use of a domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering where such links capitalize on the reputation and goodwill of the complainant’s trademark or otherwise mislead Internet users (section 2.9 [WIPO Overview 3.0](#)). In this case, “the sole purpose of the disputed domain name is to resolve to pay-per-click advertising websites and collect click-through revenue from advertising links.” (*Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#)). Such use demonstrates that the Respondent has used the disputed domain name as a pretext for commercial gain (section 2.5.3 [WIPO Overview 3.0](#)).
- iv. The Respondent did not reply to the cease and desist letter from the Complainant dated April 22, 2022, nor to the reminder correspondences dated April 29, 2022 and May 9, 2022.
- v. The Respondent did not file a Response and by doing so failed to provide any evidence of any rights or legitimate interests it would claim to have in the disputed domain name.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the second element under paragraph 4(a)(ii) of the Policy has been established.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) refers to the question of whether the disputed domain name has been registered and is being used in bad faith by the Respondent.

Paragraph 4(b) of the Policy describes some circumstances which, if found to exist, will be evidence of the registration and use of a domain name in bad faith. Among these circumstances is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location (paragraph 4(b)(iv) of the Policy).

(a) Registered in bad faith

The Complainant has been benefitting from US trademark protection from 1997 onwards for its LEGO trademark and from 2000 onwards for its LEGOLAND trademark. In Denmark, the LEGO trademark protection goes even back to 1954. The disputed domain name was registered on January 15, 2022. Panels have consistently found that the mere registration of a domain name that is confusingly similar to a

widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (section 3.1.4 [WIPO Overview 3.0](#)). This is particularly true when the trademark has a distinctive character and has acquired a worldwide reputation.

A simple search in any search engine would have informed the Respondent of the existence of the Complainant's brand and the corresponding LEGO and LEGOLAND trademarks (section 3.2. [WIPO Overview 3.0](#)). Therefore, the Respondent cannot reasonably dispute that it knew, or should have known, the Complainant's trademarks when registering the disputed domain name. The fact that the Respondent chose to register the disputed domain name anyway and did not reply to the Complainant's contentions, strongly suggests that the decision to register the disputed domain name was made in bad faith with the Complainant and its famous trademarks in mind.

In light of the above, the Panel finds that the Respondent registered the disputed domain name in bad faith.

(b) Used in bad faith

The disputed domain name resolves to a pay-per-click website on which Internet users can click on sponsored links, which will generate revenues. The LEGO and LEGOLAND trademarks are used to attract more traffic on the website. Moreover, the displayed sponsored links contain terms, such as "Hotel Accommodation", "Lego Toys on Sale" and "Adult Lego Sets", based on which Internet users might form the assumption that there is an association between the website and the Complainant. As such, the Respondent is deliberately using the disputed domain name to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website. This strongly suggests that the disputed domain name is used in bad faith (*SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*, WIPO Case No. [D2016-2497](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#)).

Consequently, the Panel finds that the Respondent has also been using the disputed domain name in bad faith.

Therefore, the Panel concludes that the disputed domain name was registered and is being used in bad faith by the Respondent and that the third element under paragraph 4(a)(ii) of the Policy has been established.

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, <legolanditaly.com> be transferred to the Complainant.

/Geert Glas/

Geert Glas

Sole Panelist

Date: March 8, 2023