

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. khaleel masri

Case No. D2023-2139

1. The Parties

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

The Respondent is khaleel masri, Jordan.

2. The Domain Names and Registrar

The disputed domain names <jordanlego.com>, <lego-jo.com>, <lego-jordan.com>, and <legojordan.com> are all registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 15, 2023. On May 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 26, 2023.

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, and the proceedings commenced on May 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 23, 2023.

The Center appointed Kaya Köklü as the sole panelist in this matter on July 26, 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 the owner of the LEGO trademark commonly known in relation to construction toys. The Complainant has subsidiaries and branches throughout the world and its products are sold in more than 130 countries, including in Jordan, where the Respondent is reportedly located.

The Complainant owns a large number of word and figurative LEGO trademark registrations around the world. According to the Complaint, the Complainant is, among many others, the registered owner of the Jordanian Trademark Registration No. 282885 (registered on August 23, 1978) for LEGO, *inter alia* covering protection for games and toys as covered in class 28 (Annex 3.1 to the Complaint).

The Complainant additionally owns almost 6,000 domain names comprising its LEGO trademark (Annex 5 to the Complaint).

All disputed domain names were created on January 22, 2023.

The screenshots, as provided by the Complainant, show that the disputed domain names <lego-jo.com> and <jordanlego.com> are connected to websites which offer no content (Annexes 8.3 and 8.4 to the Complaint). However, until recently, the disputed domain name <legojordan.com> was redirecting users to a website featuring a modified version of the LEGO figurative trademark and offering toys and toy sets for sale, without providing for a visible disclaimer describing the (lack of) relationship between the Parties (Annex 8.1. to the Complaint). The disputed domain name <lego-jordan.com> is still active at the time of the Decision through the inclusion of some sponsored links related to the Complainant's business (Annex 8.2 to the Complaint).

On February 17, 2023 (and followed by various reminders), the Complainant sent a cease-and-desist letter to the Respondent and tried to solve the dispute amicably by requesting a transfer of the disputed domain names (Annexes 9 and 10 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain names and contends that it has satisfied each of the elements required under the Policy.

B. Respondent

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

6. Discussion and Findings

According to paragraphs 14 and 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint where no substantive response has been submitted.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not substantively replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 4.3.

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. See [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in the LEGO trademark by virtue of various trademark registrations. See [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the LEGO mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the Complainant's LEGO trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "jordan" and "-jo", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's LEGO mark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, 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 [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. Furthermore, the nature of the disputed domain names, comprising the Complainant's trademark and additional terms, indicates an awareness of the Complainant and its trademark and intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests.

In the absence of a Response, the Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent must have had the Complainant and its widely-known LEGO trademark in mind when registering the disputed domain names. It is obvious to the Panel, that the Respondent has deliberately chosen the disputed domain names to target and mislead third parties. Consequently, the Panel is convinced that the Respondent has registered the disputed domain names in bad faith.

With respect to the use of the disputed domain names in bad faith, the Panel notes that <lego-jo.com> and <jordanlego.com> are connected to websites which offer no content (Annexes 8.3 and 8.4 to the Complaint), whereas until recently, users of the disputed domain name <legojordan.com> were redirected to a website featuring a modified version of the LEGO trademark and logo, where different kind of toys and toy sets were offered for sale (Annex 8.1 to the Complaint). At the time of the Decision, the disputed domain name <legojordan.com> is still active by the inclusion of sponsored links, which seem to be related to the Complainant's activities. Such use of the sponsored links cannot be in good faith since they capitalize on the Complainant's trademark.

In light of the above, the Panel is convinced that the Respondent has intentionally registered the disputed domain names in order to generate traffic to its own websites. The Panel particularly notes that the Respondent has not published a visible disclaimer on the website associated to the disputed domain name <legojordan.com> to explain that there is no existing relationship between the Respondent and the Complainant. Rather, the prominent use of the Complainant's LEGO wordmark together with a similar LEGO logo as well as the inherently misleading nature of the disputed domain names is, in view of the Panel, sufficient evidence that the Respondent intentionally tries to attract, for illegitimate commercial gain, Internet users by creating a likelihood of confusion with the Complainant.

The fact that two of the four disputed domain names currently do not resolve to an active website does not prevent a finding of bad faith, when considered the present circumstances of the case file, namely (i) the degree of distinctiveness or reputation of the Complainant's LEGO trademark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the Respondent's concealing its identity (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain names may be put.

Based on the available record, the Panel finds the third element 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 names <jordanlego.com>, <lego-jo.com>, <lego-jordan.com>, and <legojordan.com> be transferred to the Complainant.

/Kaya Köklü/

Kaya Köklü

Sole Panelist

Date: August 9, 2023