

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Buffalo 716

Case No. D2023-2296

1. The Parties

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

The Respondent is Buffalo 716, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <l-e-g-o.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 May 31, 2023. On June 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 1, 2023, 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 (Domains By Proxy, LLC), and contact information in the Complaint. The Center sent an email communication to the Complainant on July 4, 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 July 4, 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 July 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 25, 2023. The Respondent filed informal communications with the Center from July 4, 2023 to August 1, 2023.

The Center appointed Christopher J. Pibus as the sole panelist in this matter on August 1, 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 carries on business in the field of construction toys and related products. The trademark LEGO was adopted as early as 1953 and the Complainant currently holds multiple registrations for the mark around the world. Detailed evidence of the global trademark portfolio has been provided, including United States registration no. 1018875 for LEGO, dated August 26, 1975, covering International class 28.

The Complainant also owns a portfolio of more than 6000 LEGO formative domain names, including <lego.com> which is used for its main online portal.

The disputed domain name was registered on November 17, 2022 and reverts to a web page promoting audio mixes.

5. Parties' Contentions

A. Complainant

The Complainant submits that it is the owner of well-established registered rights in the trademark LEGO in more than 130 countries around the world where it sells its products. The Complainant has provided evidence of its substantial worldwide reputation, including surveys which consistently rank its brand in the top ten brands in the world. The disputed domain name is confusingly similar to the Complainant's registered trademark as it replicates the entirety of the mark, differing only by inserting hyphens between each letter, which does not prevent a finding of confusion.

With respect to the absence of rights or legitimate interests, the Complainant asserts that the Respondent has never been authorized to engage in this conduct or to adopt a confusingly similar domain name. It further submits that the Respondent is not making a *bona fide* offering of services but rather is using the disputed domain name to deceive unknowing Internet users through its association with the well-known LEGO mark. The Complainant submits that it has put forward clear evidence of the absence of rights or legitimate interests.

With respect to bad faith, the Complainant relies on evidence of the Respondent's adoption of the famous LEGO mark to establish that the Respondent has deliberately targeted the Complainant's business, to generate Internet traffic for commercial gain. Based on this misconduct, the Complainant submits that there is sufficient evidence to support a finding of bad faith.

B. Respondent

The Respondent made an informal response to the Complainant's contentions, by way of emails.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

- (i) The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interest in respect of the disputed domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant clearly owns rights in its LEGO trademark, established through long-term use and its portfolio of registrations in the United States (where the Respondent appears to be located) and internationally where it carries on its business. The Panel notes that the mark has actually been used and registered in a number of countries for more than 65 years. It has been recognized as a famous or well-known trademark in courts of various jurisdictions and in many UDRP decisions, including the recent case *LEGO Juris A/S v. Burak yildirim*, WIPO Case No. [D2023-1942](#).

The test for confusing similarity is described as a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name” in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s well-known registered trademark. The disputed domain name includes the entirety of the distinctive LEGO mark with the addition of hyphens between the letters. This addition does not prevent a finding of confusing similarity under the first element. The Complainant’s trademark is clearly recognizable as the distinctive element within the disputed domain name ([WIPO Overview 3.0](#), section 1.8).

In reaching this conclusion, the Panel has carefully reviewed the informal submissions made by the Respondent by way of multiple brief emails. The most relevant submission was an argument that the Complainant “never once spelled l-e-g-o that way”. This submission does not address the critical issues under the first element, namely whether the Complainant owns relevant rights to the trademark in question and whether the disputed domain name is confusingly similar to that trademark. The Complainant has clearly established broad rights to the LEGO trademark and a correspondingly broad ambit of protection for its mark. The Complainant’s case for confusing similarity is also well-founded, in accordance with the principles set out above. Prior panels have considered similar fact situations and concluded the addition of hyphens does not serve to distinguish disputed domain names from the complainant’s trademarks in any legally meaningful way (*Accor v. This Domain May be for Sale or Lease*, WIPO Case No. [D2008-0420](#)).

The Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Although the Policy places on the Complainant the burden of proof to establish the absence of rights or legitimate interests, the practice now recognizes that it is often sufficient for the Complainant to make out a *prima facie* case, which then shifts the burden of production to the Respondent to bring forward evidence to demonstrate the relevant rights or interests. Where the Respondent fails to produce such evidence, the Complainant will be deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

In this proceeding, the Complainant has provided evidence of the Respondent’s misconduct in misappropriating the Complainant’s famous LEGO trademark and creating a confusingly similar domain name, for purposes of attracting unsuspecting Internet users. The Respondent is not affiliated or related to the Complainant in any way, and it has never been licensed or authorized to use the LEGO mark for any purpose. The Respondent has never been commonly known by the disputed domain name and has never acquired any trademark rights in that name.

At the time of filing the Complaint, the disputed domain name redirects to a webpage related to the promotion of musical mixes. In his email responses the Respondent has never articulated any reason why or how this could possibly constitute a *bona fide* or legitimate use. The Respondent’s statement that it “purchased and own” the disputed domain name is insufficient to establish that it has a recognizable right or legitimate interest, having regard to all the circumstances of this matter.

The totality of the evidence is sufficient to establish the absence of rights or legitimate interests on the part of the Respondent.

In the absence of any substantive response from the Respondent, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the disputed domain name constitutes an abusive registration which is being used in bad faith. The Respondent clearly set out to target the Complainant, to deceive users into believing that his confusingly similar domain name was in fact associated with the Complainant, to thereby attract Internet traffic for commercial gain.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith, see [WIPO Overview 3.0](#), section 3.1.4.

The Panel also identifies several facts and several aspects of the Respondent's conduct as probative evidence of bad faith:

- (1) the fact that LEGO is a world-famous trademark, domain name component, and business name, with broad international reputation in as many as 130 countries;
- (2) the fact that LEGO is a highly distinctive term, which is connected exclusively with the Complainant;
- (3) the fact that there is no reason for the Respondent to use a hyphenated version of LEGO as its domain name except to trade on the Complainant's reputation and thereby to attract Internet users to his confusingly similar domain name for purposes of commercial gain, and;
- (4) the failure of the Respondent to submit a substantive response or to provide any evidence of actual or contemplated good faith use, and in particular the failure to deny awareness of the Complainant's trademark rights.

The Complainant has satisfied paragraph 4(a)(iii) of the Policy.

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, <l-e-g-o.com>, be transferred to the Complainant.

/Christopher J. Pibus/

Christopher J. Pibus

Sole Panelist

Date: August 14, 2023