

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Dmitriy Morozov
Case No. D2022-3185

1. The Parties

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

The Respondent is Dmitriy Morozov, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <лeгo.com> (xn--c1adro.com) is registered with Gransy, s.r.o. d/b/a subreg.cz (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 29, 2022. On August 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 31, 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 September 1, 2022 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 September 6, 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Respondent's default on November 9, 2022. The Respondent sent informal communication on November 13, 14, and 16, 2022.

Between November 13, 2022 and November 16, 2022 there were email communications between the Center and the parties regarding a possible amicable resolution. No resolution was reached between the parties.

The Center appointed John Swinson as the sole panelist in this matter on November 21, 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. Further Procedural Considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel notes that the Respondent has submitted several emails, which indicates that the Complaint was delivered to the Respondent's email address provided by the Registrar.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

5. Factual Background

The Complainant is an entity from Denmark that makes and sells toys.

The Complainant owns over 5,000 domain names containing the term "Lego".

The Complainant owns many registered trademarks LEGO in many countries, including, for example, Australian Trademark Registration No. 129258 for LEGO that was filed and registered on September 17, 1956.

Additionally, the Complainant owns registered trademarks for ЛЕГО, which is Cyrillic letter version of the LEGO trademark. An example is Ukrainian trademark No. 4184 filed on June 13, 1983, registered on March 31, 1994. Another example is the trademark ЛЕГО with Registration No. 74727 was filed June 13, 1983 and registered in the Russian Federation on January 30, 1984.

The disputed domain name was registered on October 31, 2021.

The disputed domain name is an internationalized domain name ("IDN") with the punycode translation of <xn--c1adro.com>, which translates to <lego.com> in English.

The Respondent is a person with an address in the Ukraine, disclosed by the Registrar.

The disputed domain name does not resolve to an active website. It resolves to an error page.

6. Parties' Contentions

A. Complainant

In summary, the Complainant made the following submissions:

The Complainant and its LEGO trademark are famous.

As an IDN that contains non-traditional, non-ASCII characters, the disputed domain name must be encoded into its punycode form. Past UDRP panels have found IDNs, their punycode translations, and the English translation to be equivalent for purposes of determining confusing similarity.

The Complainant owns registered trademarks for ЛЕГО, and LEGO. The disputed domain name is identical to the ЛЕГО trademark and confusingly similar to the LEGO trademark.

The Complainant has not found any registered trademarks or trade names corresponding to the disputed domain name owned by the Respondent. Neither has the Complainant found anything, including the Whois databases, that would suggest that the Respondent has been using trademarks LEGO or ЛЕГО in any other way that would give him any legitimate interests or rights in the disputed domain name.

No license or authorization of any other kind has been given by the Complainant to the Respondent, to use the trademarks ЛЕГО or LEGO. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant.

The Respondent has failed to make use of the disputed domain name and has not demonstrated any attempt to make legitimate use of the disputed domain name, which evinces a lack of rights or legitimate interests in the disputed domain name

The Respondent is simply trying to benefit from the Complainant's world-famous trademarks. The Respondent cannot claim to have been using the trademarks LEGO and ЛЕГО, without being aware of the Complainant's rights to them.

The Complainant first tried to contact the Respondent on January 20, 2022 through a cease and desist letter sent by email. Despite reminders, no response was received from the Respondent.

The disputed domain name currently resolves to an inactive site and is not being used. 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 in finding bad faith registration and use pursuant to the Policy.

It has been established that a "finding of bad faith hinges squarely on the probability that it was more likely than not that the respondent knew of, and targeted, the complainant's trademarks," and the Complaint should be taken as having met this standard.

B. Respondent

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

The Respondent sent several informal emails to the Center on November 13, 14, and 16, 2022, some of which appear to be contradictory, possibly because of issues with translation from Ukrainian to English. In summary, as best the Panel can understand, the emails state the following:

"Due to the martial law in the Ukraine, the letter with the Complaint was delivered to the Respondent's address after the deadline set for the Response.

The disputed domain name was acquired by the Respondent and has nothing to do with Lego.com.

This disputed domain name has not been used.”

The Respondent has not been the owner of the disputed domain name since October 30, 2022 and the Complainant does not claim it. (The Panel notes that October 30, 2022 is the first renewal deadline for the disputed domain name. During the pendency of this dispute, the Complainant’s agent paid the renewal fees for the disputed domain name.)

“Due to the war in our country, I did not have access to my mail. I am ready for a peaceful settlement.”

In Ukrainian, Lego.com is “Логістично економічна галузева обробка” that is short “ЛЕГО”. The Panel noted that the English translation of the short version of the Respondent’s Lego is logistically economical industry processing, the first letters of these words create the term “леро”.

“This domain was not involved in my activities. If you need to own this domain name, I am ready to assign it to you and we can agree on its transfer to your possession.”

“It took a lot of time and effort and financial resources to develop and purchase a domain address, consulting and marketing, preparing primary documentation for opening a company, developing a logo, making business cards, developing a site in a steel-stick with the logo of our future company. Since we deeply respect the work of the plaintiff, we are ready to meet the plaintiff. Due to the full-scale war in Ukraine and specifically in our city for 265 days, the opening of the company was postponed indefinitely until the end of the war. If the plaintiff wants to own this domain, we are ready to transfer the domain if the plaintiff compensates for the money and time spent by us on the above points, since we will be forced to develop everything from the company name, documentation, logo, website, marketing, business cards and everything else. The minimum cost is \$ USA 4740.”

7. 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; and
- (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 each of 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. Procedural Issue – Language of the Proceedings

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain name is English.

Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests that the language of the proceedings be English.

The Respondent has not sent communication considering language of the proceedings.

The Panel decides that the language of this administrative proceeding will be English.

B. 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 is identical to the Complainant's registered trademark for ЛЕГО. See also *LEGO Juris A/S v. Reg Com*, WIPO Case No. [D2022-1562](#).

The Complainant succeeds on the first element of the Policy.

C. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, [WIPO Overview 3.0](#), section 2.1.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Complainant has not authorized the Respondent to use the well-known LEGO trademark and the Respondent is not commonly known by the disputed domain name. The Complainant conducted trademark searches and did not find a trademark owned by the Respondent that corresponds to the disputed domain name. The Respondent is not an authorized dealer of the Complainant. The Complainant adds that the disputed domain name is inactive and that there has been no use of the disputed domain name by the Respondent. Thus, the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent sent informal emails to the Center and the Complainant that suggest that the Respondent is intending to use and has commenced preparations to use the disputed domain name for a business in Ukraine that is not associated with the Complainant. However, the Respondent provided no evidence to support his email statements.

An asserting party needs to establish that it is more likely than not that the claimed fact is true. An asserting party cannot meet its burden by simply making conclusory statements unsupported by evidence. To allow a party to merely make factual claims without any supporting evidence would essentially eviscerate the requirements of the Policy as both complainants or respondents could simply claim anything without any proof. For this reason, UDRP panels have generally dismissed factual allegations that are not supported by any *bona fide* documentary or other credible evidence. See *Professor Nelson Rose v. Domain Manager, Star Enterprises LTD S.A.*, WIPO Case No. [D2021-2918](#).

The Panel finds, as numerous panels have found before, that the Complainant has established that LEGO is a well-known trademark and that the trademark is distinctive and famous. It is unlikely that the Respondent was unaware of the Complainant and its trademarks. It is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

In view of the above and in the lack of any evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy.

D. 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.

As stated above, it is unlikely that the Respondent was unaware of the Complainant and its famous trademarks. The Panel finds and concludes that the Respondent registered the disputed domain name in bad faith.

The disputed domain name has not been used. The Complainant relies upon the “passive holding” doctrine first discussed in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel has considered whether, in the circumstances of this case, the passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith. The Panel concludes that it does.

The circumstances of this case which lead to this conclusion are:

- (i) the Complainant’s trademark has a strong reputation and is widely known,
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name,
- (iii) the Respondent has not responded to correspondence from the Complainant regarding this issue, and
- (iv) considering all the above, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

Considering these circumstances, the Panel concludes that the Respondent’s passive holding of the disputed domain name in this case satisfies the requirement of paragraph 4(a)(iii) that the disputed domain name “is being used in bad faith” by the Respondent.

The Complainant succeeds on the third element of the Policy.

8. 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, <лepo.com> (xn--c1adro.com), be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: December 5, 2022