

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Brandee Carr, Legohouseproperties
Case No. D2023-0790

1. The Parties

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

The Respondent is Brandee Carr, Legohouseproperties, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <legohouseproperties.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 February 22, 2023. On February 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 23, 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 (REDACTED FOR PRIVACY / Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 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 March 1, 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 March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 22, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on March 29, 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 part of the LEGO Group, one of the world's largest manufacturers of toys.

The LEGO Group has subsidiaries and branches throughout the world, selling its products in more than 130 countries.

The Complainant owns numerous trademarks around the world consisting of or comprising the term "Lego", including the United States Trademark Registration No. 1018875 for the word mark LEGO, registered since August 26, 1975 for toy building blocks.

The Complainant also owns close to 5,000 domain names containing the term "Lego", including the domain name <lego.com>, which links to its corporate website; that domain name was registered on August 22, 1995.

The disputed domain name that is currently inactive was registered on January 31, 2022, and has resolved to website that offered property rental services.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its LEGO trademark because it reproduces the trademark in its entirety with the addition of the terms "house" and "properties".

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. Given the famous status of its LEGO trademark, the Respondent certainly had knowledge of it at the time of registration and obtained the disputed domain name to unlawfully benefit from the goodwill built up by the Complainant in its LEGO trademark.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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 complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced proper evidence of having registered rights in the LEGO trademark, and for the purpose of this proceeding the Panel establishes that the United States Trademark Registration No. 1018875 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), 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.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's LEGO trademark is clearly recognizable in the disputed domain name. The only difference between the Complainant's trademark and the disputed domain name is the Respondent's addition of the terms "house" and "properties" to the trademark in the disputed domain name, which in view of the Panel does not prevent a finding of confusing similarity.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), 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 the 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.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in the LEGO trademark.

The Complainant has never authorized the Respondent to use its LEGO trademark, in a domain name, or otherwise.

There being no Response, there is no evidence that the Respondent is commonly known by the disputed domain name – which in any event it is noted incorporates the Complainant’s famous mark and is unlikely to have been independently derived.

The disputed domain name was linked to a website that offered property rental services. Although the website at the disputed domain name featured information unrelated to the Complainant, the Panel finds that the Respondent has in all likelihood selected the disputed domain name to attract Internet users to its website by misappropriation of the goodwill associated with the Complainant’s well-known LEGO trademark and misleadingly diverting consumers to its website. Such use is not *bona fide* and does not establish rights or legitimate interests in the disputed domain name under the Policy.

The Respondent failed to respond, and by doing so failed to offer the Panel any explanation for its registration and use of the disputed domain name, or any type of evidence set forth in paragraph 4(c) of the Policy.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name and the Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The LEGO trademark, which the disputed domain name incorporates in its entirety, has no dictionary meaning and is highly distinctive for the corresponding services.

The prestigious Time Magazine has ranked the LEGO toy "The Most Influential Toy of All Time" and previous UDRP panels have also recognized the well-known status of the LEGO trademark, in particular in the United States, where the Respondent is located (see *LEGO Juris A/S v. Execucorp Management One, Inc.*, WIPO Case No. [D2012-0062](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can itself create a presumption of bad faith.

Also, given the well-known status of the LEGO trademark, it is implausible to presume that the Respondent chose to incorporate it in the disputed domain name for any other reason than to create a false impression of an association with the Complainants and trade off of the goodwill the Complainant has established in the LEGO trademark. This qualifies as bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

The fact that at the time of rendering of this decision the disputed domain name did not resolve to active website does not alter the Panel's findings (see section 3.3 of the [WIPO Overview 3.0](#)).

For the reasons set out above, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

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 <legohouseproperties.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: April 11, 2023