

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Client Care, Web Commerce Communications Limited Case No. D2023-0915

1. The Parties

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

Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <legocanada.com>, <legochile.com>, <legocostarica.com>, <legodealsuk.com>, <legofactoryoutlet.com>, <legoinuk.com>, <lego-peru.com>, <legophilippines.com>, <legosaleclearanceuk.com>, <legosetsusa.com>, <legosouthafrica.com>, <legostorecostarica.com>, <legostorephilippines.com>, <legouae.com>, <legouruguay.com> (hereinafter the “Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 1, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On March 3, 2023, 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 (“Not Disclosed”) and contact information in the Complaint. The Center sent an email communication to Complainant on March 15, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 21, 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 Respondent of the Complaint, and the proceedings commenced on March 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 12, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 13, 2023.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on April 21, 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

Complainant manufactures, advertises, and sells its famous construction toys and related products under the LEGO mark worldwide. Complainant has continuously used the LEGO mark since at least as early as the 1950s and owns numerous trademark registrations in United States of America (“United States”) and internationally. Of relevance to this proceeding is Complainant’s United States trademark registration for LEGO (Registration Number 1,018,875) (Registered on August 26, 1975) (the “Mark”). Complainant also owns nearly 5,000 domain names incorporating the LEGO trademark.

Complainant’s LEGO products are sold in more than 130 countries worldwide, and through decades of use, the LEGO mark has become famous as evidenced by Complainant being named TIME’s Most Influential Toy of All Time.

Respondent registered the Disputed Domain Names between December 21, 2007 and January 25, 2023, long after Complainant registered its LEGO Mark. The evidence submitted with the Complaint establishes that -- at the time the Complaint was filed -- the Disputed Domain Names resolved to (1) inactive websites, and (2) websites selling LEGO products and purporting to be authorized resellers. Complainant sent a cease and desist letter to Respondent on January 9, 2023. Respondent never responded to the letter.

5. Parties’ Contentions

A. Complainant

Complainant asserts that its LEGO mark is famous as a result of its exclusive and continuous use of the mark and its decades of extensive advertising that prominently features the LEGO mark on all products, packaging, displays, and promotional materials. As such, Complainant contends it has established rights in the LEGO mark and that the Disputed Domain Names are confusingly similar thereto. Complainant claims that the inclusion of the generic terms “uae”, “canada”, “chile”, “costa rica”, “deals uk”, “factory outlet”, “in uk”, “-peru”, “philippines”, “sale clearance uk”, “sets usa”, “south africa”, “store costa rica”, “store Philippines”, and “uruguay” in the Disputed Domain Names does eliminate the confusing similarity between the Mark and the Disputed Domain Names.

Complainant further asserts that Respondent lacks rights or legitimate interests in the Disputed Domain Names because Complainant has not licensed or provided other authorization to Respondent to use the LEGO mark. With respect to the Disputed Domain Names that resolve to webpages of unauthorized resellers of LEGO products, Complainant states that Respondent does not adequately disclose the relationship, or lack thereof, between Respondent and Complainant, and therefore conveys the false impression that Respondent is authorized to use Complainant’s LEGO mark. As for the Disputed Domain Names that resolve to inactive webpages, Complainant argues that Respondent has failed to make use of these Disputed Domain Names and has not demonstrated any attempt to make legitimate use of them. According to Complainant, such conduct evinces a lack of rights or legitimate interests in the Disputed Domain Names. Complainant alleges such use does not amount to *bona fide* offering of goods or services.

Additionally, Complainant contends that Respondent registered and is using the Disputed Domain Names in bad faith because the fame of its LEGO mark makes it inconceivable that Respondent was unaware of Complainant and its earlier rights. Complainant claims Respondent’s choice of the Disputed Domain Names was not accidental and was influenced by the fame of Complainant’s LEGO mark. Additionally, Complainant alleges that the Disputed Domain Names that resolve to unauthorized reseller webpages were registered by

Respondent intentionally to attract Internet users to the websites for commercial gain, by creating a likelihood of confusion with Complainant's Mark as to the source, sponsorship, affiliation or endorsement of its website, which constitutes bad faith use and registration. As for the inactive Disputed Domain Names, Complainant argues that bad faith use does not require a positive act on the part of Respondent. Specifically, Respondent's passive holding of these Disputed Domain Names is evidence of bad faith use and registration.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that Complainant's trademark registrations establish that it has rights in the LEGO mark. The Panel further finds that, because the Disputed Domain Names incorporate Complainant's Mark entirely, it is confusingly similar to Complainant's registered Mark. Respondent's addition of generic terms "deals", "factory outlet", "sale clearance", "sets", and "store", as well as the geographic terms "uk", "uae", "canada", "chile", "costa rica", "peru", "philippines", "usa", "south africa", and "uruguay" does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; see also *Birkenstock IP GmbH v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-2049](#), (finding <birkenstockargentinaonline.com>, <birkenstockargentinaoutlet.com>, <birkenstockbelgie.com>, <birkenstockbelgium.com>, <birkenstockoutletportugal.com>, <birkenstock-portugal.com>, <birkenstockportugalonline.com>, <birkenstock-romania.com>, <birkenstockromania-ro.com>, and <birkenstockslovensko.com> confusingly similar to complainant's BIRKENSTOCK mark). A side-by-side comparison of the Mark and the Disputed Domain Names reveals that the Mark is easily identifiable and recognizable within the Disputed Domain Names.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant has presented a *prima facie* case for Respondent's lack of rights or legitimate interests in the Disputed Domain Names, which Respondent has not rebutted. Complainant has not authorized Respondent to use its LEGO mark. Respondent also has not answered this Complaint and there is no evidence or reason to suggest that Respondent is, in fact, commonly known by the Disputed Domain Names or that Respondent is using the Disputed Domain Names in connection with a *bona fide* offering of goods or services. Rather, at the time of the filing of the Complaint, several of the Disputed Domain Names¹ resolved to inactive websites as opposed to a website offering any goods or services, legitimate or otherwise.

Additionally, Complainant's evidence shows that Respondent has used some of the Disputed Domain Names² with the intent to divert and mislead Internet users for its commercial gain; specifically, Respondent has held itself out to be an authorized reseller of Complainant. Without any disclaimers, Respondent's websites prominently display the LEGO mark as well as Complainant's logotype. [WIPO Overview 3.0](#), section 2.8. In the absence of a response and contrary evidence, the Panel finds that Respondent is using the Disputed Domain Names for illegitimate purposes. This supports a finding that Respondent has no

¹ <legophilippines.com>, <legostorecostarica.com>, <legostorephilippines.com> (collectively the "Inactive Domain Names").

² <legouae.com>, <legocanada.com>, <legochile.com>, <legocostarica.com>, <legodealsuk.com>, <legofactoryoutlet.com>, <legoinuk.com>, <lego-peru.com>, <legosaleclearanceuk.com>, <legosetusa.com>, <legosouthafrica.com>, <legouruguay.com>, (collectively the "Reseller Domain Names")

rights or legitimate interests in Disputed Domain Names. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and *Lululemon Athletica Canada Inc. v. Withheld for Privacy Purposes, Privacy Service Provided by Withheld for Privacy ehf / Ma Chaw*, WIPO Case No. [D2021-3252](#).

Accordingly, Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent acquired the Disputed Domain Names fully aware of Complainant's rights in the LEGO mark. As Respondent has not denied Complainant's allegations, the Panel infers that Respondent most likely knew of Complainant's world-famous LEGO mark when Respondent registered the Disputed Domain Names, particularly in light of Respondent's unauthorized reselling of Complainant's products. See *Dominique Baudoux v. SA Cybertech Corporation*, WIPO Case No. [D2007-1267](#). As such, Respondent registered the Disputed Domain Names in bad faith. See *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) (bad faith is found where a domain name "is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith").

With respect to the Reseller Domain Names, Respondent is using these Disputed Domain Names to hold itself out as Complainant, to offer for sale Complainant's LEGO products without authorization. Use of a domain name for this per se illegitimate activity is manifestly considered evidence of bad faith; see [WIPO Overview 3.0](#), section 3.1.4. Moreover, Internet users viewing Respondent's website are likely to be misled into believing that the Disputed Domain Names and the associated websites are operated or authorized by Complainant. The Panel finds that by using the Disputed Domain Names in the manner described above, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant's LEGO trademark.

Finally, with respect to the remaining Inactive Domain Names, the Respondent's passive use is bad faith given the indisputable fame of the LEGO trademark, the implausibility of any claim of good faith use, the absence of a response and the pattern of abusive registrations, as reflected in the finding of bad faith as to the other Disputed Domain Names at issue in these proceedings. See [WIPO Overview 3.0](#), section 3.3; see also *Volkswagen AG v. Brad Hanson, tradessupersite*, WIPO Case No. [D2016-0429](#).

In light of the foregoing, 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 Names <legocanada.com>, <legochile.com>, <legocostarica.com>, <legodealsuk.com>, <legofactoryoutlet.com>, <legoinuk.com>, <lego-peru.com>, <legophilippines.com>, <legosaleclearanceuk.com>, <legosetsusa.com>, <legosouthafrica.com>, <legostorecostarica.com>, <legostorephilippines.com>, <legouae.com>, <legouruguay.com> be transferred to Complainant.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: May 5, 2023