

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Chi Ray Jasa

Case No. D2023-2725

1. The Parties

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

The Respondent is Chi Ray Jasa, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <lego-land.shop> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 26, 2023. On June 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 27, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on August 10, 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 operates a business selling toys in more than 130 countries. The Complainant holds registrations for the LEGO trademark and variations of it, such as LEGOLAND, in numerous countries including United States trademark registration no. 1018875, for the mark LEGO, registered on August 26, 1975; and United States trademark registration no. 75504012, for the mark LEGOLAND, registered on March 28, 2000 in classes 35, 41 and 42.

The Complainant conducts business on the Internet using numerous domain names containing the word “lego”, including <lego.com>, with a toy business website resolving from these domains. The Complainant also owns more than 5,000 domain names comprising or containing the word “lego”.

The Disputed Domain Name <lego-land.shop> was registered on March 9, 2023 and resolves to an online store that allegedly sells products that resemble or compete with the Complainant’s products.

5. Parties’ Contentions

A. Complainant

The Complainant cites its trademark registrations in numerous countries for the marks LEGO and LEGOLAND, as *prima facie* evidence of ownership.

The Complainant submits that the marks LEGO and LEGOLAND are well known and that its rights in those marks predate the Respondent’s registration of the Disputed Domain Name. It submits that the Disputed Domain Name is almost identical to its trademark LEGOLAND because the Disputed Domain Name is comprised of the entirety of the Complainant’s LEGOLAND trademark with the addition of a hyphen between terms. The addition of a hyphen does not have any impact on the overall impression of the dominant part of the name, LEGOLAND, recognizable as a world famous trademark and the generic Top-Level Domain (“gTLD”) “.shop” is therefore irrelevant to determine the confusing similarity between the trademark and the Domain Name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because “[n]o license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark[s] LEGO or LEGOLAND” and none of the circumstances set out in paragraph 4(c) of the Policy apply. The Complainant also submits that the Respondent “the Respondent is not an authorized reseller” and would be unable to avail itself of the safe harbor to be found in the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) that is in some circumstances available to *bona fide* resellers of genuine branded goods.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and well-known nature of the Complainant’s trademarks LEGO and LEGOLAND, and advances the argument “the selection of a domain name which is so obviously connected to a complainant’s trademark strongly suggests ‘opportunistic bad faith’, particularly where it is used by someone with no affiliation with the Complainant”.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the marks LEGO and LEGOLAND in numerous countries including the United States where the Respondent is located. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the LEGOLAND trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant’s trademark LEGOLAND; (b) with an additional hyphen between these words; (c) followed by the gTLD “.shop”.

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11.1). The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: “lego-land”.

As the relevant mark is incorporated in its entirety and as such is recognizable in the Disputed Domain Name, in line with previous UDRP decisions, the additional hyphen would not prevent a finding of confusing similarity under the first element. This Panel therefore finds that the Disputed Domain Name is confusingly similar to the Complainant’s LEGO trademark for purposes of UDRP standing (see [WIPO Overview 3.0](#), sections 1.7 and 1.8).

Accordingly, the Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent’s rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because it has not licensed, permitted or authorized the Respondent to use the Complainant’s trademark or to sell its products and for those reasons, the Respondent is not making a *bona fide* offering of goods or services. The Complainant submits that “the Respondent does not adequately disclose the relationship, or lack thereof, between the Respondent and the Complainant, and does therefore convey the false impression that the Respondent is authorized to use the Complainant’s trademark. There is no visible disclaimer stating that the website is not endorsed or sponsored by the Complainant to explain the nonexisting relationship with the trademark holder. As stated above, the Respondent is not an authorized reseller. Had the Respondent been an authorized licensee or reseller, such document would have been easy to obtain as proof when sending the cease and desist letter.”

Furthermore, this Panel accepts the uncontested *prima facie* evidence that the Respondent is not an authorized reseller with a legitimate interest in a domain name incorporating a Complainant’s mark, and

there is no disclaimer on the website the Disputed Domain Name resolves to, therefore it cannot meet the tests set out in *Oki Data Americas, Inc. v. ASD, Inc.*, *supra*. Nor, alternatively, the Respondent is not commonly known by the Disputed Domain Name.

This Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is engaging in an illegitimate commercial use of the Disputed Domain Name by suggesting some association with the Complainant and misleading consumers who are seeking out the Complainant's mark LEGOLAND to opportunistically divert Internet traffic to its web page.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the well-known nature of the Complainant's trademarks LEGO and LEGOLAND, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademarks LEGO and LEGOLAND when it registered the Disputed Domain Name (see *LEGO Juris A/S v. LogoFusion*, WIPO Case No. [D2006-0270](#) ("the worldwide fame of the Complainant's trademark"); *Lego Juris A/S v. Synergy Management, Fred Shear*, WIPO Case No. [D2007-1028](#) ("LEGO is well-known in the United States"); *LEGO Juris A/S v. Chung Hong Phil*, WIPO Case No. [D2009-1288](#) ("the Complainant's trademarks are very well-known worldwide"); *Lego Juris A/S v. Level 5 Corp.*, WIPO Case No. [D2008-1692](#) ("LEGO and LEGOLAND are well-recognized and world famous trademarks"))).

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to trade off the reputation and goodwill of the Complainant's well-known trademark (see [WIPO Overview 3.0](#), section 3.1.4).

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration (see *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Respondent registered the Disputed Domain Name some 48 years after the Complainant established registered trademark rights in the LEGO mark in the United States and more than 22 years after the Complainant established registered trademark rights in the LEGOLAND mark in the United States.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name diverts to a web store that allegedly offers the Complainant's products and, possibly fake competitor products, for sale. This Panel finds such conduct is an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (see [WIPO Overview 3.0](#), sections 3.1.4 and 3.4, and paragraph 4(b)(iv) of the Policy).

In the absence of any evidence to the contrary, this Panel accepts the Complainant's evidence, and also finds that the Respondent has taken the Complainant's trademarks LEGO and LEGOLAND and incorporated them into the Disputed Domain Name along with a hyphen, without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the trademarks to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <lego-land.shop> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: August 24, 2023