

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Joe Soto

Case No. D2023-4527

### **1. The Parties**

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

The Respondent is Joe Soto, United States of America (“United States”).

### **2. The Domain Name and Registrar**

The disputed domain name <lego-sale.shop> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2023. On October 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 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 (AZ US) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 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 November 2, 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 November 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2023.

The Center appointed Alissia Shchichka as the sole panelist in this matter on December 5, 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 a company organized under the laws of Denmark that is the worldwide well-known producer of LEGO branded construction toys and related LEGO products. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the United States.

The Complainant has evidenced to be the registered owner of numerous trademarks worldwide relating to its brand LEGO, including, but not limited, to the following:

- United States Patent and Trademark Office (“USPTO”) registration No. 1,018,875, registered on August 26, 1975, for the word mark LEGO, in class 28;
- USPTO registration No. 1,026,871, registered on December 9, 1975, for the figurative mark LEGO, in class 28;
- USPTO registration No. 1,248,936, registered on August 23, 1983, for the word mark LEGO, in classes 16, 20, 22 and 25.

Moreover, the Complainant has evidenced to own of nearly 5,000 domain names containing the term LEGO.

The Respondent, as per the disclosed Whois information for the disputed domain name, is a resident of the United States and registered the disputed domain name on June 25, 2023.

The disputed domain name currently displays an inactive webpage. According to the evidence provided by the Complainant, the Respondent has used the disputed domain name to resolve to a website featuring the Complainant’s LEGO trademark and logo and offering LEGO toys for sale.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant asserts that the LEGO trademark has achieved global recognition as one of the most well-known trademarks. The brand’s outstanding reputation is reflected in its consistent top rankings, such as being the number 1 Consumer Superbrand in 2019 and the Most Reputable Global Company in 2020. With a century-long legacy of delivering high-quality goods and services, LEGO stands as a world-famous and widely acknowledged trademark.

According to the Complainant, the disputed domain name is confusingly similar to the Complainant’s trademark LEGO as it incorporates the entire trademark. The addition of a hyphen and the suffix “sale” to the LEGO trademark does not alter the overall impression that the disputed domain name is associated with the Complainant’s trademark or prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademarks. The generic suffix “.shop” is not sufficient to prevent confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name since (1) the Complainant has never licensed, contracted, or otherwise permitted the Respondent to

apply to register the disputed domain name, (2) the Respondent is not commonly known by the disputed domain name, and has not used or prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services, (3) the Respondent has misused the disputed domain name, currently redirecting users to an error page and previously using it to lead to a website featuring the Complainant's LEGO trademark and logo to commercialize the LEGO products, (4) the Respondent failed to disclose the non-existing relationship with the Complainant, therefore failing to satisfy at least one criterion of the Ok! Data test;

Finally, the Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) the Complainant's LEGO trademark is well known and famous worldwide, (2) the Respondent's use of the disputed domain name which featured the Complainant's LEGO trademark to sell the Complainant's products shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted the Complainant's prior registered and famous LEGO trademark in order to generate traffic and income.

The Complainant requests that the disputed domain name be transferred to 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 carries the burden of proving:

- (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.

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, the term “sale”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s LEGO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the LEGO trademarks or to seek registration of any domain name incorporating the trademark. The Respondent is also not known to be associated with the LEGO trademarks, and there is no evidence showing that the Respondent has been commonly known by the disputed domain name. [WIPO Overview 3.0](#), section 2.3.

Based on the available record, the Panel finds that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. [WIPO Overview 3.0](#), section 2.4.

Indeed, currently, the disputed domain name merely resolves to inactive page. Before, as the Complainant has demonstrated on record, the disputed domain name has resolved to a website featuring the Complainant’s LEGO trademark and logo and commercializing LEGO products. The Panel has well noted that the Respondent, while using the disputed domain name to offer the Complainant’s LEGO products for online sale, has failed to disclose the non-existing relationship with the Complainant. Consequently, the Respondent did not fulfill at least one criterion of the Oki Data test, which establishes nominative (fair) use by resellers. [WIPO Overview 3.0](#), section 2.8.

Moreover, the Panel also notes that the composition of the disputed domain name, carries a risk of implied affiliation or suggests sponsorship and/or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Therefore, the Panel concludes that the Respondent does not have any rights or legitimate interests in the disputed domain name and the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's well-known LEGO trademarks substantially predates the Respondent's registration of the disputed domain name. Therefore, the Respondent knew or should have known of the Complainant's trademarks at the time of registering the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

Further, the mere registration of the disputed domain name that is confusingly similar to the Complainant's widely known trademarks by the Respondent, who is unaffiliated with the Complainant, can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Moreover, the Respondent's knowledge of the Complainant and its trademarks can be readily inferred from the Respondent's prior use of the disputed domain name, which resolved to a website featuring the Complainant's LEGO trademark and logo and commercializing LEGO products. Panels have consistently ruled that under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

Therefore, in the Panel's view, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's LEGO trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. [WIPO Overview 3.0](#), section 3.1.4.

The current non-use of the disputed domain name does not prevent a finding of bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element 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-sale.shop> be transferred to the Complainant.

*/Alissia Shchichka/*

**Alissia Shchichka**

Sole Panelist

Date: December 18, 2023