

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Hilll Long
Case No. D2024-4472

1. The Parties

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

The Respondent is Hilll Long, United States of America (the “United States”).

2. The Domain Name and Registrar

The disputed domain name <legotv.shop> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 30, 2024. On October 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 2024, 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 (Registration Private / Domains By Proxy, LLC, DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 2024, 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 1, 2024.

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 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 29, 2024.

The Center appointed Gill Mansfield as the sole panelist in this matter on December 4, 2024. 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 based in Denmark and incorporated in 2005. It is the owner of rights in the LEGO brand of construction toys and other LEGO branded products. LEGO branded products are sold in more than 130 countries worldwide and the Complainant has subsidiaries and branches throughout the world. The use of the LEGO brand now extends to products such as computer hardware and software, books, videos, and computer controlled robotic construction sets. The Complainant's licensees are authorised to exploit the Complainant's intellectual property, including its trademarks, in the United States and elsewhere in the world.

The Complainant has an extensive international portfolio of registered LEGO trademarks including, inter alia, the following:

United States trademark registration number 1018875 for LEGO (word mark) registered on August 26, 1975 in class 28.

United States trademark registration number 1248936 for LEGO (word mark) registered on August 23, 1983 in classes 16, 20, 22 and 25.

The Republic of Korea trademark registration number 4000666770000 for LEGO (combined mark) registered on January 21, 1980 in (national) class 43.

The Complainant also holds an extensive portfolio of close to 5000 registered domain names incorporating the LEGO trademark, including inter alia the domain name <lego.com> which resolves to the LEGO group website.

The disputed domain name was registered on October 7, 2024 and is connected to a commercial website which appears to offer LEGO branded products 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 contends that the LEGO trademark is one of the best-known trademarks in the world. It points to the substantial inherent and acquired distinctiveness of the LEGO trademark and the fame of the trademark. It states that the disputed domain name is confusingly similar to the Complainant's trademark. It refers to the fact that the dominant part of the disputed domain name is the term LEGO which is identical to the Complainant's trademark. It submits that the addition of the suffix "tv" to the LEGO trademark does not diminish the confusing similarity. It further submits that the addition of the Top-Level domain ("TLD") ".shop" is not relevant in determining whether the disputed domain name is confusingly similar to the Complainant's trademark.

The Complainant states that the Respondent is using the disputed domain name to host a website that is an imitation of the Complainant's official website using the Complainant's logo, colour scheme and website layout throughout. It contends that there is a considerable risk that the public will assume that the disputed

domain name is either owned by the Complainant or that there is some commercial relationship between the Respondent and the Complainant.

The Complainant states that it has not found that the Respondent has any registered trademarks or trade names that correspond to the disputed domain name, or anything to suggest that the Respondent has been using LEGO in any other way that would give them any legitimate rights in the disputed domain name. It states that no licence or authorisation of any kind has been given by the Complainant to the Respondent to use the LEGO trademark, and that the Respondent is not an authorised dealer of the Complainant's products and has never had a business relationship with the Complainant. It further submits that no evidence has been found that the Respondent is using LEGO as a company name or has any other rights in the name. The Complainant contends that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services. It states that the Respondent is trying to benefit from the Complainant's world-famous trademark and has intentionally chosen a domain name based on the Complainant's registered trademark to generate traffic and income through an unauthorised website offering LEGO branded products. It also asserts out that The Respondent is not an authorised reseller and that the criteria set down *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and described in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") (at 2.8.1 the "Oki Data Test") do not apply.

Finally, it contends that the disputed domain name was registered and is being used in bad faith. It refers to the status of the LEGO trademark as well-known with substantial goodwill and awareness throughout the world. It points to the date of registration of the disputed domain name, decades after its own registrations in the United States and elsewhere and contends that the Respondent cannot claim to have been using the LEGO trademark without being aware of the Complainant's right in it. It also states that the disputed domain name is connected to an unauthorised commercial website offering LEGO products for sale and which prominently displays the Complainant's logo. It submits that the Respondent is using the disputed domain name to intentionally attract Internet users to a website for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website.

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.

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.

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 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.

Although the addition of other terms (here, the addition of the term “tv”) 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 mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 recognised 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 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.

In particular, no licence or authorisation of any kind has been given by the Complainant to the Respondent to use the LEGO trademark. The Respondent is not an authorised dealer of the Complainant’s products and has never had a business relationship with the Complainant. There is no evidence that the Respondent is commonly known by the disputed domain name. There is also no evidence of use, or demonstrable preparation to use, the disputed domain name for a bona fide offering of goods and services, or of any legitimate noncommercial or fair use of the disputed domain name.

On the contrary, the record shows that the disputed domain name directs to an active website that imitates the Complainant’s own website. It prominently features the Complainant’s well-known LEGO logo, and uses the colour scheme and layout of the Complainant’s own website. It also purports to sell LEGO branded products. Having regards to all the circumstances, the Panel finds that the use of the disputed domain name by the Respondent cannot be characterised as a bona fide offering of goods and services.

Moreover, the Panel finds that the construction of the disputed domain name which consists of the Complainant’s famous LEGO trademark combined with the word “tv” (a well-known abbreviation of the word “television” in English) is such as to carry a risk of implied affiliation which cannot constitute fair use, as it effectively impersonates the Complainant, or suggests affiliation with or sponsorship or endorsement by the Complainant. ([WIPO Overview 3.0](#), section 2.5.1)

Further, according to paragraph 14(b) of the rules, the Panel may draw from the lack of response of the Respondent such inferences as it considers appropriate. The Panel is of the view that the lack of response from the Respondent corroborates the absence of any rights or legitimate interests of the Respondent in the disputed domain name.

The Panel finds the second element of the Policy has been established.

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 disputed domain name was registered almost 50 years after the Complainant's first registration of the LEGO trademark. Having reviewed the available record, the Panel finds that the Complainant's mark has achieved significant goodwill and reputation. It is an instantly recognisable brand with a long history and worldwide fame. In view of the significant worldwide reputation in the Complainant's trademark it is inconceivable that the Respondent did not have knowledge of the trademark at the time that the disputed domain name was registered.

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 by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

As noted above, the disputed domain name resolves to a website that imitates the Complainant's own website. That copycat website uses the Complainant's famous LEGO logo and well as the colour and layout of the Complainant's own website. It appears to offer for sale goods which purport to be LEGO branded products. Having reviewed the available record the Panel finds that the Respondent's conduct demonstrates the Respondent's knowledge of the Complainant and the Complainant's brand and trademark, and that the Respondent in registering and using the disputed domain name targeted the Complainant and its famous LEGO trademark to generate traffic to an unauthorised website for commercial gain.

Consequently, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating the likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and products on the Respondent's website under Paragraph 4(b) of the Policy.

Having reviewed the available record, the Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the policy.

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 <legotv.shop> be transferred to the Complainant.

/Gill Mansfield/

Gill Mansfield

Sole Panelist

Date: December 18, 2024