

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Domain Administrator

Case No. D2024-5118

1. The Parties

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

The Respondent is Domain Administrator, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <blackfridayslego.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 December 12, 2024. On December 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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, See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 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 December 17, 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 December 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 7, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 12, 2025.

The Center appointed Stefan Bojovic as the sole panelist in this matter on January 16, 2025. 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 Danish company which 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 also extends to products such as computer hardware and software, books, videos, and computer controlled robotic construction sets.

The Complainant is the owner of number of registered trademarks for the LEGO trademark, including the following:

- European Union trademark registration No. 000039800 for LEGO, registered on October 5, 1998;
- United States trademark registration No. 1018875 for LEGO, registered on August 26, 1975;
- International trademark registration No. 287932 for LEGO, registered on August 27, 1964.

Furthermore, the Complainant is the owner of a number of domain name registrations containing the LEGO trademark, such as <lego.com> registered on August 22, 1995.

The disputed domain name was registered on November 7, 2024 and at the time of filing of the Complaint, it resolved to an online store that purported to offer for sale the Complainant's LEGO toy products and which prominently displayed LEGO trademark and logo. The Complainant submitted the takedown notice in respect of this website. As a result, at the time of the Decision, the disputed domain name resolves to an inactive page.

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 it is the owner of the well-known LEGO trademark and that the disputed domain name is clearly confusingly similar to the Complainant's registered trademarks. The addition of the term "black fridays" does not diminish the overall similarity and the disputed domain name must therefore be considered confusingly similar to the Complainant's LEGO trademarks.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant contends that no license or authorization of any other kind, has been given by the Complainant to the Respondent to use its LEGO trademark. The Respondent should not be regarded as commonly known by the disputed domain name. The Respondent is not authorized reseller and even if the *Oki Data* test (laid down in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) would apply to the Respondent, they would not pass this test due to lack of accurate disclosure of the Respondent's relationship with the Complainant. The Respondent's use of the Complainant's logo, color scheme and website layout suggests relationship with the Complainant. Moreover, the "About Us" section of the website to which the disputed domain name used to resolve utilizes the Complainant's logo with nothing to indicate the lack of authorization.

With reference to the circumstances evidencing bad faith, the Complainant indicates that its LEGO trademark is well known and that the awareness of the trademark is considered, in the community in general, to be significant and substantial. The Complainant holds that goodwill associated with the LEGO trademark is what motivated the Respondent to register the disputed domain name. As the disputed domain name was previously connected to an unauthorized commercial website offering the Complainant's LEGO toy products for sale and predominantly displaying the Complainant's logo, the Complainant holds that the Respondent was using the disputed domain name to intentionally attempt to 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

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint 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."

Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

- (i) that the disputed domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (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 Complainant's LEGO trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "black fridays") 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 trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In addition, it is well established that the generic Top-Level Domain ".shop" can be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant's trademark. [WIPO Overview 3.0](#), section 1.11.1.

The Panel, therefore, finds that 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 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.

The Panel notes that there seems to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s LEGO trademark. The Respondent also does not appear to be commonly known by the disputed domain name

Based on the undisputed evidence provided by the Complainant, the Respondent has used the disputed domain name for an unauthorized online store that purported to offer for sale the Complainant’s LEGO toy products. The Panel holds that the Respondent’s use of the disputed domain name does not meet the Oki Data Test requirements (as established in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), because the website did not disclose the lack of relationship between the Respondent and the Complainant. [WIPO Overview 3.0](#), section 2.8. On the contrary, the prominent use of the Complainant’s LEGO trademark and logo on the website to which the disputed domain name used to resolve (including “About Us” section) is likely to reinforce the false impression of affiliation between the Complainant and the Respondent.

The Panel also finds that the structure of the disputed domain name, which contains the Complainant’s LEGO trademark in its entirety in combination with term “black fridays”, carries a risk of implied affiliation, especially having in mind the distinctiveness and well-known character of the Complainant’s LEGO trademark worldwide. [WIPO Overview 3.0](#), section 2.5.1

Having in mind the above, 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent must have been well aware of the Complainant and its LEGO trademark at the time of the registration of the disputed domain name. As noticed by a number of previous panels, the Complainant's LEGO trademark should be considered as a well-known trademark due to its exceptional presence in large part of the world for several decades. The Complainant's trademark is one of the most recognizable toy brands in the world and it would be rather unlikely that the Respondent was not aware of the Complainant's trademark at the time of the registration of the disputed domain name. Furthermore, the content of the website to which the disputed domain name used to resolve leaves no room for a doubt on the Respondent's knowledge of the Complainant and its LEGO trademark and evidences that the Respondent actually had the Complainant in mind when registering the disputed domain name. It should be also borne in mind that the registration and use of LEGO trademark predates the registration of the disputed domain name by around 60 years, making it unlikely that the Respondent was not aware of the Complainant's trademark at the time of registration of the disputed domain name.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

As previously indicated, based on the undisputed evidence provided by the Complainant, the disputed domain name was used for an unauthorized online store that purported to offer for sale the Complainant's LEGO toy products, and which was prominently using the Complainant's LEGO trademark and logo. The Panel considers such use of the disputed domain name as evidence of bad faith indicating that the Respondent has used confusingly similar disputed domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of such website, or of a product or service on such website.

While the disputed domain name no longer resolves to an active website, such inactivity does not prevent a finding of bad faith given the totality of the circumstances of the case at hand. [WIPO Overview 3.0](#), section 3.3.

Therefore, the Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently 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 <blackfridayslego.shop> be transferred to the Complainant.

/Stefan Bojovic/

Stefan Bojovic

Sole Panelist

Date: January 30, 2025