

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Contact Privacy Inc. Customer 0163125175 / Daniel Perez, Lego and Jewelry Queen
Case No. D2022-3025

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 0163125175, Canada / Daniel Perez, Lego and Jewelry Queen, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <shoppinglego.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2022. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 19, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 23, 2022, 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 August 26, 2022.

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 September 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 10, 2022.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on October 18, 2022. 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 the owner of the mark LEGO and of all trademarks used in connection with the famous LEGO branded construction toys and other LEGO branded products. The Complainant has subsidiaries and branches worldwide and LEGO products are sold in more than 130 countries.

The trademark LEGO has often been recognized as being among the best-known trademarks in the world.

Among other registrations, the Complainant owns the following registration for the mark LEGO:

- United States trademark registration LEGO No. 1018875 registered on August 26, 1975 in class 28.

The Complainant is also the owner of close to 5,000 domain names containing the term “lego”.

The Respondent registered the disputed domain name on November 18, 2021, it currently resolves to an inactive website. The Complainant has provided evidence showing that it resolved to an online shop offering for sale LEGO branded products.

5. Parties' Contentions

A. Complainant

The arguments put forward by the Complainant can be summarized as follows:

On the first element of the Policy, the Complainant claims that the disputed domain name incorporates the Complainant's LEGO mark in its entirety with the addition of the term “shopping” and the generic Top-Level Domain (“gTLD”) “.com”.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent uses the disputed domain name to suggest sponsorship or endorsement by the Complainant. The Respondent has not been authorized, licensed, or permitted by the Complainant to do so.

On the third element of the Policy, the Complainant asserts that LEGO is a world-famous trademark. Consequently, the Respondent was aware of the rights the Complainant has in the LEGO trademark, and of the value of the said trademark, at the time of the registration.

The Complainant then claims that the Respondent was using the Complainant's trademark to mislead Internet users to go to its own commercial website, where LEGO branded products were sold.

The Complainant thus concludes that the Respondent was trying to benefit from the Complainant's world-famous trademark and that the disputed domain name has been registered and has been used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

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

A. Identical or Confusingly Similar

The Complainant has established rights in the LEGO trademark.

The disputed domain name contains the Complainant's LEGO mark with the addition of the term "shopping" and the gTLD ".com".

The applicable Top-Level Domain ("TLD") in a domain name (*e.g.*, ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see section 1.11.1 of [WIPO Overview 3.0](#)).

Also, the addition of the term "shopping" is insufficient to prevent a finding of confusing similarity with the renowned LEGO trademark. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of [WIPO Overview 3.0](#)).

The disputed domain name is a combination of the Complainant's mark "LEGO" and the term "shopping". The Panel finds that the inclusion of the word "shopping" does not prevent the Complainant's mark from being recognizable in the disputed domain name.

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

B. Rights or Legitimate Interests

The second element that the Complainant must satisfy to prevail is established within paragraph 4(a)(ii) of the Policy.

While 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 often impossible 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

The Complainant has provided evidence that the disputed domain name previously resolved to a website displaying the Complainant's LEGO mark and purportedly offering the Complainant's products for sale. When applying the principles established under *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), the Panel finds that the Respondent's offering of goods or services was not *bona fide*. The Respondent used the website also to offer services other than the trademarked goods and services of the Complainant (some links to blogs for example). Furthermore, the Respondent failed to accurately and prominently disclose its lack of relationship with the Complainant.

The Panel also notes that the nature of the disputed domain name, incorporating the Complainant's well-known trademark with the term "shopping", carries a risk of implied affiliation (see section 2.5.1 of [WIPO Overview 3.0](#)).

Furthermore, allegedly after the Complainant had sent the cease and desist letters, the Respondent no longer uses the disputed domain name to offer the goods at issue.

Furthermore, the Panel finds that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy. Despite Respondent's listing in the Whois information as 'Daniel Perez, Lego and Jewelry Queen', there is no corroborating evidence that would demonstrate that the Respondent is indeed commonly known by the disputed domain name or as "Lego and Jewelry Queen". To the contrary, the Complainant provided evidence suggesting that the Respondent does not operate a legitimate business under or is otherwise commonly known by a name containing the LEGO mark. Moreover, the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademarks or otherwise use the Complainant's trademarks.

Therefore, the Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent was aware of the Complainant and its reputation in the LEGO mark at the time the disputed domain name was registered. The Respondent's website previously contained numerous references to the Complainant, including reproducing the LEGO Mark in the exact manner used by the Complainant. The registration of the disputed domain name in awareness of the LEGO mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Panel finds that the Respondent's intention has been to use the disputed domain name to intentionally attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location (see paragraph 4(b)(iv) of the Policy).

At the time of the Decision, the disputed domain name does not resolve to an active website; however, the passive holding of a website can be also considered as a factor in finding bad faith registration and use (see section 3.3 of the [WIPO Overview 3.0](#)).

Lastly, the Respondent hid its identity by using a privacy/proxy registration service. This is an additional indicator of bad faith in the circumstances of this case (see section 3.6 of the [WIPO Overview 3.0](#)).

Under these circumstances, the Panel therefore finds that the Respondent registered and is using the disputed domain name in bad faith.

Thus, 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, <shoppinglego.com>, be transferred to the Complainant.

/Christian Gassauer-Fleissner/

Christian Gassauer-Fleissner

Sole Panelist

Date: October 31, 2022