

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Paul Clark

Case No. D2024-0383

1. The Parties

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

The Respondent is Paul Clark, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <lego-blackfriday.shop>, <lego-blackfridays.shop>, and <lego-blackfriday.store> are registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 29, 2024. On January 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 30, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 31, 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 February 2, 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 February 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 6, 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 the well-known Denmark based company for LEGO construction toys and owns numerous trademarks and trade names for LEGO for decades in several jurisdictions around the world (Annexes 3 and 6 to the Complaint).

The Complainant owns inter alia the following LEGO trademark registrations:

- Canadian Trademark, Registration No. TMA106457, registered on April 26, 1957;
- Chinese Trademark, Registration No. 10176435, registered on March 7, 2014;
- United Kingdom Trademark, Registration No. UK00000754628, registered on June 11, 1956;
- United States Trademark, Registration No. 1018875, registered on August 26, 1975;
- German Trademark, Registration No. 772669, registered on April 22, 1963; and
- French Trademark, Registration No. 287932, registered on August 27, 1964 (Annex 3 to the Complaint).

The Complainant further owns (amongst many others) the domain name <lego.com> which addresses the official LEGO website (Annex 7 to the Complaint).

The disputed domain name <lego-blackfriday.shop> was registered on November 23, 2023; the disputed domain names <lego-blackfriday.store> and <lego-blackfridays.shop> were registered on November 24, 2023 (Annex 2 to the Complaint).

At the time of filing this Complaint, no website with active content was connected to the disputed domain names. However, on December 20, 2023 the disputed domain name <lego-blackfriday.store> resolved to a website which prominently displayed the Complainant's logo and purportedly offered LEGO products; there was no disclosure of a relationship to the Complainant on that website (Annex 8 to the Complaint).

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 names.

Notably, the Complainant contends that the LEGO trademark is distinctive, famous, and well known around the world. The Complainant notes that the disputed domain names contain the LEGO trademark in its entirety, simply adding the descriptive term "blackfriday" or "blackfridays". The Complainant submits that it is therefore inconceivable that the Respondent would not have been aware of the Complainant's trademark when registering the disputed domain names, or that there would be any legitimate use for the disputed domain names. Further, the Complainant has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the LEGO trademark in any manner.

The Complainant notes that at least the disputed domain name <lego-blackfriday.store> was used to address a website which contained the famous LEGO mark as well as pretended to sell the Complainant's products without any authorization by the Complainant. Regardless of this, passive holding of the disputed domain names is also within the concept of the Policy, especially when the disputed domain names contain famous trademarks as it is the case.

Hence, the Complainant contends, that based on the totality of these factors, it is clear that the Respondent is acting in bad faith with the intent to create a likelihood of confusion with the Complainant's mark and legitimate e-commerce website.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain names are 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 with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are 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 submitted evidence, which incontestably and conclusively establishes rights in the mark LEGO.

In the present case, the disputed domain names are confusingly similar to the LEGO mark in which the Complainant has rights since they incorporate the entirety of the mark LEGO and only add a hyphen followed by the terms "blackfriday" or "blackfridays" at the end.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of a hyphen followed by a term does not prevent a finding of confusing similarity under the first element of the Policy ([WIPO Overview 3.0](#), section 1.8). This is the case at present.

Finally, it has also long been held that generic Top-Level-Domains ("gTLDs") (in this case ".shop" and ".store") are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.1.

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.

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. 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 record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names, since it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the LEGO trademark in any manner.

The Respondent is not an authorized dealer of the Complainant's products. Although, at least the disputed domain name <lego-blackfriday.store> initially resolved to a website which displayed prominently the Complainant's logo and purportedly offered LEGO products, the Respondent cannot show a right or legitimate interest in that disputed domain name: As outlined in the "Oki Data test", for showing a right or legitimate interest the respondent must, inter alia, accurately and prominently disclose its relationship with the trademark holder. The Panel notes, that the Respondent's use of the disputed domain name <lego-blackfriday.store> clearly fails to meet at least this criteria since there was no disclosure in this respect.

Furthermore, the nature of the disputed domain names, comprising the Complainant's mark in its entirety together with the terms "blackfriday" or "blackfridays", cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist. [WIPO Overview 3.0](#), section 2.5.

The Respondent did not reply and hence has not rebutted the Complainant's contentions.

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

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain names were registered by the Respondent in bad faith; and
- the disputed domain names are being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark LEGO, long before the registration of the disputed domain names. Further, the trademark LEGO is distinctive, well known and famous around the world.

Because of the fame of the LEGO mark, it is inconceivable for this Panel that the Respondent has registered and used the disputed domain names without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain names entirely incorporate the Complainant's distinctive and registered trademark LEGO together with a hyphen and the terms "blackfriday" or "blackfridays" and the gTLDs ".shop" and ".store" which strongly indicates that the Respondent was aware of the Complainant and its LEGO mark at the time of registration of the disputed domain names.

All of these facts indicate that the Respondent must have been aware of the Complainant's business and trademark when registering the disputed domain names.

Therefore, the Panel is convinced that the disputed domain names were registered in bad faith by the Respondent.

(ii) Further, the Complainant put forward evidence that the disputed domain name <lego-blackfriday.store> initially resolved to a website which displayed prominently the Complainant's logo and purportedly offered LEGO products.

In doing so, the Respondent has intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website according to paragraph 4(b)(iv) of the Policy which constitutes bad faith registration and use of the disputed domain name <lego-blackfriday.store>.

Although there is no evidence that the disputed domain names <lego-blackfriday.shop> and <lego-blackfridays.shop> are being actively used or resolved to a website with substantive content, previous UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding (see especially *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3 and *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#)).

This Panel concludes that the non-use of the disputed domain names does not prevent a finding of bad faith, especially putting emphasis on the following:

- the Complainant's trademark LEGO is distinctive, well known globally with a strong Internet presence;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain names;
- the disputed domain names are inherently misleading, and are thus suited to divert or mislead potential Internet users from the website they are actually trying to visit (the Complainant's site) and giving the false impression that the Respondent must be in some way related with the Complainant which is not the case; and
- there is no conceivable plausible good faith use with regard to the disputed domain names.

The evidence and documents produced and put forward by the Complainant together with the fact that the Respondent has failed to present any evidence of any good faith registration and use with regard to the disputed domain names further supports the 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 names <lego-blackfriday.shop>, <lego-blackfridays.shop>, and <lego-blackfriday.store> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: March 16, 2024