

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Paul Clark

Case No. D2024-1106

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 Name and Registrar

The disputed domain name <lego-toys.shop> is 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 March 14, 2024. On March 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 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 (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 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 March 19, 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 March 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2024.

The Center appointed Alfred Meijboom as the sole panelist in this matter on April 18, 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 owner of many “Lego” trademarks worldwide, including the word mark LEGO registered in the United States (e.g., Reg. No. 1,018,875 of August 26, 1975) in class 28 for, inter alia, construction toys (the “LEGO mark”). The Complainant is also the owner of nearly 5,000 domain names containing the term “Lego”. 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 Respondent registered the disputed domain name on December 4, 2023. The disputed domain name is currently passively held. However, the Complainant submitted evidence that the disputed domain name resolved to a website which was used to offer “Lego” products for sale, without the website disclosing the relationship with the Complainant. The Complainant’s evidence indicates that the Respondent’s website offering “Lego” products for sale was available on December 5, 2023, and that the disputed domain name no longer resolved to an active website as of March 1, 2024.

The Complainant alleged that the Respondent intentionally provided false details in the Whois record upon registration because the physical address listed in the disclosed Whois record does not point to a searchable location.

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 disputed domain name is confusingly similar to the well-known LEGO trademark, and that the addition of the word “toys” to the LEGO trademark in the disputed domain name does not diminish the confusing similarity between the disputed domain name and the LEGO trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name because the Respondent is not known under the disputed domain name, is not a distributor of the Complainant, was not licensed or authorized to use the LEGO mark in a domain name, and did not use the disputed domain name in connection with a bona fide offering of goods or services. If the Oki Data test (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.8.1) were to be applied, the Complainant alleges that the Respondent’s website did not accurately and prominently disclose the relationship with the Complainant. Further, the Complainant alleged that at present the disputed domain name resolves to an inactive page and lacks content, and the Respondent still fails to use the disputed domain name in connection with a bona fide offering of goods or services.

According to the Complainant the disputed domain name was registered in bad faith, because the Respondent must have been aware of the LEGO trademark in respect of toys at the time of registration of the disputed domain name, as the LEGO trademark has the status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world. Furthermore, the Complainant alleges that the Respondent’s use of the disputed domain name to offer “Lego” products for sale was an intentional attempt to attract Internet users to a website for commercial gain, by creating a likelihood of confusion with the LEGO trademark as to the source, sponsorship, affiliation or endorsement of the website. According to the Complainant, the current use of the disputed domain name, resolving to an inactive page, amounts to the disputed domain name being used in bad faith, just as the Respondent’s provision of a false address in the Whois record contributes to the finding of bad faith.

B. Respondent

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

6. Discussion and Findings

The Respondent did not file a Response. However, as set out in the [WIPO Overview 3.0](#), section 4.3, the consensus view of UDRP panels is that the respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still establish each of the three elements required by paragraph 4(a) of the Policy. Although the Panel may draw appropriate inferences from the Respondent's default, paragraph 4(a) of the Policy requires the Complainant to support its assertions with actual evidence in order to succeed in this proceeding. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, the panel shall draw such inferences as it considers appropriate from a failure of a party to comply with a provision or requirement of the Rules. The Panel finds that in this case there are no such exceptional circumstances.

Under the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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

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 LEGO trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established. The Panel finds the LEGO trademark is wholly incorporated and recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the LEGO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The addition of the hyphen and the term "toys" 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 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.

More notably, the Respondent has not refuted the Complainant's allegations that the Respondent has not been commonly known by the disputed domain name, that the Respondent's use of the LEGO trademark was not authorized or licensed by the Complainant, and that the Respondent had not been a distributor of the Complainant.

The Panel is further satisfied that the Respondent's temporary use of the disputed domain name reverting to a website which offered "Lego" products for sale failed the Oki Data test already because this website undisputedly did not disclose the relationship of the Respondent and the Complainant, whereas the Respondent's website rather made the false impression that it originated from, linked to, or was authorized by the Complainant, which does not constitute a bona fide offering of goods and services.

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 finds that the Respondent, when it registered the disputed domain name, must have been aware of the LEGO trademark, which, as many UDRP panels have found, has a worldwide reputation, especially for constructions toys. Moreover, the Panel infers from the fact that the disputed domain name resolved to a website prominently displaying the famous stylized LEGO trademark and offering "Lego" products for sale, at least as from the day following the registration of the disputed domain name, that the Respondent must have intentionally registered the disputed domain name with the LEGO trademark in mind. This constitutes registration of the disputed domain name in bad faith, and said offering of "Lego" products under the circumstances as set forth in Section 6B also constitutes use of the disputed domain name in bad faith.

In view of the Respondent's current inactive use of the disputed domain name, panels have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the LEGO trademark, and the composition of the disputed domain name, as well as the Respondent's use of false contact details, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of 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 <lego-toys.shop> be transferred to the Complainant.

/Alfred Meijboom/

Alfred Meijboom

Sole Panelist

Date: April 29, 2024