

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Privacy service provided by Withheld for Privacy ehf /  
Ayoub Iagnadi, Lagnadi LTD  
Case No. D2022-2584

### **1. The Parties**

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Ayoub Iagnadi, Lagnadi LTD, United Kingdom.

### **2. The Domain Name and Registrar**

The disputed domain name <mylego.shop> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 15, 2022. On July 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 15, 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 July 22, 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 July 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 July 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 17, 2022.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on August 24, 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 trademark LEGO, used and known for construction toys. The Complainant has subsidiaries and branches throughout the world, and its products are sold in more than 130 countries. The Complainant's trademark has been registered in several countries, including in the United Kingdom under no. 844309 as of January 25, 1963.

The disputed domain name was registered on January 20, 2022, and at the time of preparing this decision, resolved to an error page.

#### **5. Parties' Contentions**

##### **A. Complainant**

The dominant part of the disputed domain name comprises the trademark LEGO, identical to the Complainant's trademark. The prefix "my" does not diminish the confusing similarity between the disputed domain name and the Complainant's trademark.

Before the complaint was filed, the Respondent was using the disputed domain name to offer toy products for sale under the Complainant's trademark without authorization. The Complainant has not authorized the Respondent to use the Complainant's trademark and there is no relationship between the Complainant and the Respondent. The disputed domain name does not pass the "Oki Data test" because the Respondent has not disclosed his relationship with the Complainant.

The Complainant's trademark is a well-known trademark throughout the world. Because the disputed domain name was used to sell the Complainant's goods without authorization, there is no plausible good-faith reason or logic for the Respondent to have registered the disputed domain name. Currently the disputed domain name resolves to an inactive site and is not being used. Passive holding of a domain name can also constitute bad faith registration and use pursuant to the Policy.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

## A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain names are identical or confusingly similar to this trademark.

According to section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[t]he 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".

Furthermore, "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. The nature of such additional term(s) may however bear on assessment of the second and third elements". See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain name is confusingly similar to the Complainant's trademark as it includes the Complainant's trademark in its entirety combined with the word "my". This does not prevent confusing similarity between the Complainant's trademark and the disputed domain names.

This means that the disputed domain name is confusingly similar with the Complainant's trademark and hence the first element of the Policy has been fulfilled.

## B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain names.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* showing indicating the absence of the respondent's rights or legitimate interests in a disputed domain name the burden of proof shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

The disputed domain name has been used to sell the Complainant's goods without the Complainant's authorization. According to the "Oki Data test" (see section 2.8.1 of the [WIPO Overview 3.0](#)), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- i. the respondent must actually be offering the goods and services at issue;
- ii. the respondent must use the site to sell only the trademarked goods or services;
- iii. the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- iv. the respondent must not try to "corner the market" in domain names that reflect the trademark.

In this case, the Respondent has not disclosed his relationship, or lack thereof, with the Complainant, so the use of the disputed domain name before filing the complaint falls short of the "Oki Data test" and the disputed domain name has therefore not been used for the *bona fide* offering of goods or services. Rather, it

has been used to create an impression of association with the Complainant.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant's trademark. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Considering the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain name. Therefore, the Panel finds that the second element of the Policy is fulfilled.

### **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain names have been registered and are being used in bad faith. Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.”

Considering that the Complainant's trademark is well known and taking into account the activity to which the disputed domain name has been put, the Respondent must have been aware of the Complainant and its trademark when registering the disputed domain names. See section 3.1.4 of the [WIPO Overview 3.0](#).

The disputed domain name is currently not in use. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. This is particularly so with domain names incorporating the mark plus a descriptive term, as in this case. See section 3.1.4 of the [WIPO Overview 3.0](#).

Considering that the disputed domain name is confusingly similar to a well-known trademark, the Respondent has not responded to the Complaint, the Respondent has used a privacy protection service to conceal its identity, there are no obvious good faith or legitimate uses to which the disputed domain name may be put, the Panel considers, on balance, that the disputed domain name has been registered and is being used in bad faith. The current passive holding of the disputed domain name does not alter this finding, considering the totality of circumstances support a finding of the Respondent's bad faith. See section 3.3 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the third element of the Policy is fulfilled.

## 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, <mylego.shop>, be transferred to the Complainant.

*/Tuukka Airaksinen/*

**Tuukka Airaksinen**

Sole Panelist

Date: September 7, 2022