

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Isaac Goldstein, DOMAIN FOR SALE CHECK AFTERNIC.COM

Case No. D2023-0607

1. The Parties

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

The Respondent is Isaac Goldstein, DOMAIN FOR SALE CHECK AFTERNIC.COM, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <starwarslego.com> is registered with DropCatch.com 1138 LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2023. On February 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 13, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2023.

The Center appointed Kaya Köklü as the sole panelist in this matter on March 14, 2023. 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 LEGO trademark commonly known in relation to construction toys. The Complainant has subsidiaries and branches throughout the world and its products are sold in more than 130 countries.

The Complainant owns a large number of word and figurative LEGO trademark registrations around the globe (Annex 3.1 to the Complaint). According to the Complaint, the Complainant is, *among others*, the registered owner of the Hong Kong, China Trademark Registration No. 19640937 (registered on August 21, 1964) for LEGO, covering protection for games and playthings (Annex 3.2 to the Complaint).

The Complainant further holds a license in the STAR WARS trademark granted by Lucasfilm Ltd. to develop, manufacture and sell its construction toys as part of a partnership with Lucasfilm Ltd. (Annex 12 to the Complaint).

The Complainant additionally owns almost 5,000 domain names comprising the trademark LEGO (Annex 5 to the Complaint).

The disputed domain name was created on March 14, 2022.

The Respondent is reportedly from Hong Kong, China and has previously been involved in many UDRP disputes as a respondent, all of which decided against the Respondent (Annex 10 to the Complaint).

Since its registration, visitors of the disputed domain name are redirected to a landing page with related pay-per-click ("PPC") links (Annex 8 to the Complaint).

On May 18, May 31 and June 8, 2022, the Complainant sent cease-and-desist letters to the Respondent and tried in vain to solve the dispute amicably by requesting a transfer of the disputed domain name (Annex 9 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name.

The Complainant is of the opinion that the disputed domain name is confusingly similar to its LEGO trademark.

It further argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Finally, the Complainant is convinced that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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.

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

For the evaluation of this case, the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views stated therein.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has registered trademark rights in the mark LEGO by virtue of various trademark registrations, including in Hong Kong, China, where the Respondent is reportedly located at (Annex 3.2 to the Complaint).

The Panel further finds that the disputed domain name is confusingly similar to the Complainant's registered LEGO trademark, as it fully incorporates the trademark. As stated at section 1.12 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other third-party trademarks, is insufficient in itself to avoid a finding of confusing similarity. Here, the addition of the third-party trademark "STAR WARS" does not, in view of the Panel, serve to prevent a finding of confusing similarity between the disputed domain name and the Complainant's LEGO trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel further finds that the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name.

While the burden of proof on this element remains with the Complainant, previous UDRP panels have recognized that this would result in the often impossible task of proving a negative, in particular as the evidence in this regard is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name in order to meet the requirements of paragraph 4(a)(ii) of the Policy. See, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

The Panel finds that the Complainant has satisfied this requirement, while the Respondent has failed to file any evidence or make any convincing argument to demonstrate rights or legitimate interests in the disputed domain name according to the Policy, paragraphs 4(a)(ii) and 4(c).

In its Complaint, the Complainant has provided uncontested *prima facie* evidence that the Respondent has no rights or legitimate interests to use the Complainant's trademark LEGO in a confusingly similar way within the disputed domain name.

The Respondent has not submitted any evidence or arguments demonstrating relevant rights or legitimate interests, nor has it rebutted any of the Complainant's contentions. There is also no evidence in the case record showing that the Respondent is commonly known by the disputed domain name, nor that there are any circumstances or activities that would establish the Respondent's rights or legitimate interests therein. Rather, the disputed domain name, which contains the Complainant's mark in its entirety in combination with another third-party trademark with which the Complainant has a license agreement, resolves to a parking page featuring PPC links that are related to the respective construction toys offered by the Complainant, and therefore that compete with or capitalize upon the Complainant's goodwill and reputation. Such use *per se* cannot establish rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.9.

Consequently, 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

In the Panel's view, the Respondent has registered and is using the disputed domain name in bad faith.

The Panel is convinced that the Respondent must have had the Complainant's trademark in mind when registering the disputed domain name. At the date of registration, the Complainant's LEGO trademark was already registered and widely used for many decades, including in Hong Kong, China.

With respect to the use of the disputed domain name in bad faith, it is noted that the disputed domain name is not used with any substantive content, except for redirecting Internet users to a landing page with PPC links. Therefore, the Panel is convinced that the Respondent has intentionally registered and used the disputed domain name to generate traffic to its own website for illegitimate commercial gain by creating a likelihood of confusion with the Complainant's mark.

Furthermore, the Panel accepts that the failure of the Respondent to respond to the Complainant's cease-and-desist letters and its contentions in the Complaint as an additional indication for bad faith.

The Panel therefore concludes that the disputed domain name was registered and is being used in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(iii) of the Policy.

D. Requested Remedy

As to the findings above, the Complainant has satisfied all three requirements of paragraph 4(a) of the Policy.

As regards the requested remedy by the Complainant, the Panel once again notes that the disputed domain name incorporates not only the Complainant's trademark LEGO but also the trademark "STAR WARS", owned by another entity, which is not a party to the present administrative proceeding.

In line with section 4.13 of the [WIPO Overview 3.0](#) and numerous UDRP decisions, the Panel believes that a transfer of a domain name incorporating not only the Complainant's trademark but also a trademark of another company may be reasonable, if (1) the Complainant has satisfied all three requirements of paragraph 4(a) of the Policy, and (2) such transfer order is efficient and appropriate.

In the present case, the Panel confirms that the Complainant has satisfied the UDRP's three-step test (as discussed above). Further, the Complainant holds a license agreement which allows the Complainant to develop, manufacture and sell LEGO Star Wars construction toys (Annex 12 to the Complaint).

Even if the provided license agreement document by the Complainant does not explicitly mention that the disputed domain name may be transferred to the Complainant, the Panel highlights that any such transfer will not prejudice any potential rights of the third party in the disputed domain name.

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 <starwarslego.com> be transferred to the Complainant.

/Kaya Köklü/

Kaya Köklü

Sole Panelist

Date: March 28, 2023