

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. 王子

Case No. D2023-2392

### **1. The Parties**

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

The Respondent is 王子, China.

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

The disputed domain name <shopping-lego.com> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 2, 2023. On June 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 2023, 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 (Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 5, 2023 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 June 7, 2023.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 13, 2023. In accordance with paragraph 5 of the Rules, the due date for Response was July 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 5, 2023.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on July 11, 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 paragraph 7 of the

Rules.

#### **4. Factual Background**

The Complainant, based in Denmark, has subsidiaries and branches throughout the world, and the LEGO brand construction toys and other LEGO branded products (the “LEGO Products”) are sold in more than 130 countries. The Complainant is the owner of LEGO trademarks (the “LEGO Trademarks” or “LEGO Trademark”) registered in numerous countries all over the world including the United States of America (“United States”) trademark No. 1018875 (registered on August 26, 1975) and Chinese trademark No. 75682 (registered on December 22, 1976) used in connection with the LEGO Products. The Complainant’s group has expanded its use of the LEGO Trademarks to, *inter alia*, computer hardware and software, books, videos and computer controlled robotic construction sets.

The Complainant’s group maintains an extensive website under the domain name <lego.com>. Moreover, the Complainant is the owner of close to 5,000 domain names containing the LEGO Trademarks.

The disputed domain name was registered on March 13, 2023. The Respondent is using the disputed domain name to direct Internet users to a website that resolves to a blank page and lacks content.

#### **5. Parties’ Contentions**

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

The Complainant’s contentions may be summarized as follows:

The term “shopping” in conjunction with the Complainant’s LEGO Trademark is likely to heighten confusion in the minds of Internet users, as those familiar with the Complainant’s services would reasonably believe that the disputed domain name is associated with an online shop for the Complainant’s LEGO Products. The fact that such a term is closely linked and associated with the Complainant’s services only serves to underscore and increase the confusing similarity between the disputed domain name and the Complainant’s LEGO Trademark. The likelihood of confusion includes an obvious association with the Complainant’s trademark. With reference to the reputation of the LEGO Trademark there is a considerable risk that the trade public will perceive the Respondent’s dispute domain name either as a domain name owned by the Complainant, or that there is some kind of commercial relation with the Complainant. By using the trademark as a dominant part of the disputed domain name, the Respondent exploits the goodwill and the image of the Complainant’s LEGO Trademark, which may result in dilution and other damage for the trademark.

The Respondent neither has any registered trademarks or trade names corresponding to the disputed domain name, nor has been using the name LEGO in any other way. The Registrant is identified as “王子”, which does not resemble the disputed domain name in any manner. The Respondent is not commonly known by the disputed domain name. No license or authorization of any other kind has been given by the Complainant to the Respondent, to use the LEGO Trademark. Further, the Respondent is not an authorized dealer of the Complainant’s LEGO Products and has never had a business relationship with the Complainant. In addition, there is no disclaimer on the website to explain the lack of relationship to the Complainant.

The Complainant’s LEGO Trademark has the status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world. The fame of the trademark has motivated the Respondent to register the disputed domain name. By sending a cease and desist letter on April 18, 2023, the Complainant advised the Respondent that the unauthorized use of the LEGO Trademark within the disputed domain name violated the Complainant’s rights in the LEGO Trademark and requested a voluntary transfer of the disputed domain name and offered compensation for the expenses of registration and transfer fees (not exceeding out-of-pocket expenses). In spite of the cease and desist letter, no reply was ever

received. By using the disputed domain name, the Respondent is not making a legitimate noncommercial or fair use, but is misleadingly diverting consumers for commercial gain.

## **B. Respondent**

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

## **6. Discussion and Findings**

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (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**

The disputed domain name comprises the term "shopping" and the LEGO Trademark in its entirety, which are connected by a hyphen, along with the generic Top-Level Domain ("gTLD") ".com".

It is well established that 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 the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The addition of the term "shopping" does not prevent a finding of confusing similarity with the renowned LEGO Trademark (see *LEGO Juris A/S v. Contact Privacy Inc. Customer 0163125175 / Daniel Perez, Lego and Jewelry Queen*, WIPO Case No. [D2022-3025](#) (<shoppinglego.com>); see also *LEGO Juris A/S v. I Made Irawan, - DRI-110993*, WIPO Case No. [D2014-1538](#) (<lego-shopping.com>); and *LEGO Juris A/S v. Tech Domain Services Private Limited*, WIPO Case No. [D2009-1617](#) (<legoshopping.com>)).

The addition of gTLD ".com" does not have any impact on the overall impression of the disputed domain name and is therefore irrelevant to determine the confusing similarity between the Complainant's trademark and the disputed domain name. See also section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant's LEGO Trademark.

### **B. Rights or Legitimate Interests**

The composition of the disputed domain name carries a risk of implied affiliation with the Complainant. As the Complainant asserts, no evidence can be found indicating that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name or has been using the name LEGO. The Complainant also does not grant any license or authorization to use the LEGO Trademarks to the Respondent. The disputed domain name currently resolves to an inactive site and is not being used by the Respondent. Therefore, the Respondent has failed to make use of the disputed domain name's website and has not demonstrated any attempt to make a legitimate use of the disputed domain name.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and then the burden of production is shifted to the Respondent. However, the Respondent neither submitted any response in this proceeding nor replied to the

Complainant's cease and desist letters sent on April 18, 2023.

Consequently, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

Since the Complainant's LEGO Trademark is internationally famous and ranked as one of the global top brands in some rankings, the Respondent was aware or should have known of the LEGO Trademark and must have had some intention to benefit from the goodwill of the Complainant's LEGO Trademark at the time of the registration of the disputed domain name.

Although the Respondent merely passively hold the disputed domain name which currently resolves to an inactive site and is not used, it does not prevent a finding of bad faith registration and use under the doctrine of passive holding in this case, in consideration of the totality of the circumstances including (i) the degree of distinctiveness or reputation of the Complainant's LEGO Trademark, (ii) the failure of the Respondent to submit a response in this proceeding as well as against the Complainant's cease and desist letter sent on April 18, 2023 or to provide any evidence of actual or contemplated good faith use, (iii) the Respondent's use of a privacy service to concealing its identity, and (iv) the implausibility of any good faith use to which the disputed domain name may be put (see section 3.3 of the [WIPO Overview 3.0](#)).

The Respondent has employed a privacy service to hide its real identity at the time of initial filing of the Complaint, and moreover the Respondent's address disclosed by the Registrar is “北京 (Beijing)” only and lacks detailed street number and the Respondent's name disclosed by the Registrar might be a fictitious name “王子”, which means “prince”. Although mere use of a privacy service does not, standing alone, demonstrate bad faith, since such services have come to be accepted nowadays as capable of serving legitimate interests of privacy and spam protection, the concealment of the Respondent's real identity and contact information, when coupled with the Respondent's exploitation of the Complainant's LEGO Trademark for commercial gain, does constitute further evidence of bad faith registration and use (see *Jay Leno v. St. Kitts Registry, Domain Names Administration*, WIPO Case No. [D2009-0571](#); and *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#); see also section 3.6 of [WIPO Overview 3.0](#)).

For the reasons set out above, the Panel reached the conclusion that the Respondent has registered and used the disputed domain name in bad faith and is entitled to the remedy requested, namely that the disputed domain name be transferred to the Complainant.

### **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 <shopping-lego.com> be transferred to the Complainant.

*/Yuji Yamaguchi/*

**Yuji Yamaguchi**

Sole Panelist

Date: July 24, 2023