

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Fil Rios

Case No. D2024-0102

1. The Parties

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

The Respondent is Fil Rios, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names <legolife.show> and <legolifeshow.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 11, 2024. On January 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, 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 (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 12, 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 January 16, 2024.

The Center verified that the Complaint together with 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 January 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2024. The Response was filed with the Center on January 30, 2024.

The Center appointed Edoardo Fano as the sole panelist in this matter on February 15, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is LEGO Juris A/S, a Danish company mainly operating in the field of construction toys and owning several trademark registrations for LEGO, among which:

- United States of America Trademark Registration No. 1018875 for LEGO, registered on August 26, 1975;
- European Union Trademark Registration No. 000039800 for LEGO, registered on October 5, 1998;
- United Kingdom Trademark Registration No. UK00000844309 for LEGO, registered on January 25, 1963;
- United Kingdom Trademark Registration No. UK00001283286 for LEGO, registered on August 9, 1991.

The Complainant operates on the Internet at the main website “www.lego.com”, as well as with many other generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”) including the trademark LEGO.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names were both registered on June 24, 2023, and the disputed domain name <legolife.show> is inactive, while the disputed domain name <legolifeshow.com> resolves to a parking page with pay-per-click (“PPC”) links.

On July 3, 11 and 19, 2023 the Complainant’s legal representatives sent a cease-and-desist letter by email to the Respondent, without receiving any reply.

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 states that the disputed domain names are confusingly similar to its trademark LEGO, as the disputed domain names wholly incorporate the Complainant’s trademark, with the addition of the terms “life” and “show”.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names. One of the disputed domain names is inactive, while the other resolves to a parking page with PPC links.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark LEGO is well-known. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that, by resolving to a parking page with PPC links, the use of the disputed domain name <legolifeshow.com> to attract, for commercial gain, Internet users to the Respondent's website, creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, qualifies as bad faith registration and use. Finally, the Complainant contends that the passive holding of the disputed domain name <legolife.show>, being inactive, qualifies as bad faith registration and use.

B. Respondent

The Respondent, in his Response, is making reference to only one disputed domain name, namely <legolifeshow.com>.

He asserts to be a Lego enthusiast and to own a YouTube channel where he is sharing his passion for building Lego. When he searched for a domain name with the same name, he found it available and he registered it.

The Respondent states to have the upmost respect for Lego, and to have no bad intentions or bought the disputed domain name in bad faith, but simply in order to have an opportunity to grow his YouTube channel alongside a website with the same name and to build an affiliate program through this or share his passion for Lego through this domain. The Complainant has proposed a settlement to the Respondent on January 31, 2024, February 15, 2024, respectively, but no reply was received from the Respondent.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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 in respect of 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 names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "life" and "show", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a gTLD, in this case ".com" and ".show", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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, UDRP 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 present 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.

The Respondent, in his Response referred only to the disputed domain name <legolifeshow.com>, has stated that he bought the disputed domain name in order to have an opportunity to grow his YouTube channel about building Lego alongside a website with the same name and to build an affiliate program through this or share his passion for Lego through this domain name.

For the purposes of the Policy, a respondent’s fan site must be active, genuinely noncommercial, and clearly distinct from any official complainant site. [WIPO Overview 3.0](#), section 2.7.1. The disputed domain name <legolifeshow.com>, on the contrary, resolves to a parking page with PPC links: the use of a disputed domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant’s trademark. [WIPO Overview 3.0](#), section 2.9.

Moreover, the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, 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, regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant’s trademark LEGO is clearly established, and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the confusingly similar disputed domain names, especially because the Respondent has declared to be a Lego enthusiast and to own a YouTube channel dedicated to building Lego.

As regards the use in bad faith of the disputed domain name <legolifeshow.com>, the Panel notes that the Respondent is trying to attract, for commercial gain, Internet users to his website by creating likelihood of confusion with the Complainant's trademark as to the disputed domain name's source, sponsorship, affiliation or endorsement.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order both to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to his website in accordance with paragraph 4(b)(iv) of the Policy.

As regards the disputed domain name <legolife.show>, 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. Having reviewed the 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. While 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant's trademark and the composition of the disputed domain name, 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.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain names, both of them including the Complainant's trademark in its entirety (with the mere addition of the terms "life" and "show"), further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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

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 <legolife.show> and <legolifeshow.com> be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: February 22, 2024