

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Tiffany Freund

Case No. D2024-0105

1. The Parties

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

The Respondent is Tiffany Freund, United States of America (“U.S.”).

2. The Domain Name and Registrar

The disputed domain name <legochristmas.shop> is registered with NameSilo, 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 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 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 18, 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 January 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 9, 2024.

The Center appointed Hong Yang as the sole panelist in this matter on February 13, 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 a company based in Denmark and is the owner of LEGO and relevant trademarks, used in connection with the construction toys and other relevant products. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in the U.S.

The Complainant is the owner of trademark registrations in jurisdictions around the world for the mark LEGO, such as the following:

- the U.S. trademark registration No.1018875, registered on August 26, 1975, for the word mark LEGO, in international class 28;
- the U.S. trademark registration No.1026871, registered on December 9, 1975, for the figurative-word combined mark LEGO, in international class 28;
- the U.S. trademark registration No.1248936, registered on August 23, 1983, for the word mark LEGO, in international classes 16, 20, 22, and 25.

The Complainant has a network of authorized licensees, and the LEGO brand has received various awards and prizes recognizing its high reputation. The Complainant is the owner of close to 5,000 domain names containing the trademark LEGO. Particularly, the Complainant offers in its official website brick sets and kits including LEGO Seasonal Sets and Christmas-themed gifts.

The disputed domain name was registered on December 17, 2023. According to the evidence provided by the Complainant, which is not rebutted by the Respondent, the disputed domain name previously directed to a website offering LEGO toys for sale, particularly with a page for Christmas edition. The main parts of the website prominently displayed the Complainant's marks, layouts, logotypes, images, and other copyrightable contents, mostly taken from the Complainant's official website without any consent from the Complainant, and without any statement about the existing/lack of relationship with the Complaint. The Panel also notes that at time of filing of the Complaint and on the date of this decision, the disputed domain name resolves to an inactive webpage.

The Respondent, according to the disclosed Whois information, is a resident of the U.S.

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. Particularly, the Complainant contends that the Respondent has registered and used the disputed domain name in bad faith, involving not only circumstance listed under paragraph 4(b)iv, but also under the doctrine of "passive holding" which may also constitute bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which the Complainant must satisfy with respect to the disputed domain name in this case:

- (i) The disputed domain name is 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 name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

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

Having reviewed the available record, the Panel finds that:

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 Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the other term "christmas" may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

Moreover, the applicable generic Top-level Domain ("gTLD"), ".shop" in the disputed domain name does not change this finding, since the gTLD (including with regard to "new gTLDs"), as a standard registration requirement, is generally disregarded in such an assessment of confusingly similarity. [WIPO Overview 3.0](#), section 1.11.

Based on the available record, 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.

The Panel notes that the disputed domain name previously resolved to a website prominently displaying the Complainant's trademarks, color scheme, as well as copyrightable contents including images, layouts, and designed logotypes, without any consent or approval. The Respondent has neither any connection/affiliation with the Complainant nor any license/authorization from the Complainant. The Respondent offered on the website the Complainant's LEGO branded products, accompanied by preset prices and payment-delivery button, without any statement adequately disclosing its existing (or lack of) relationship with the Complainant, or any disclaimer clarifying that the website is not endorsed or sponsored by the Complainant. The Panel is convinced that the Respondent has conveyed the false impression about the relationship with or endorsement from the Complainant, and effectively impersonated the Complainant's well-known trademark. Moreover, the Panel notes that the composition of the disputed domain name itself carries a risk of implied affiliation. Particularly, the Complainant provided evidence that it promoted on its official website gifts specially for Christmas, which has been used by the Respondent as the additional term in the disputed domain name. Where a domain name consists of a trademark plus an additional term, panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1

Panels have held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, 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.

In the present case, the Panel notes that the Respondent registered the disputed domain name in bad faith by using the Complainant's highly distinctive and well-known trademark in its entirety in the disputed domain name, combined with a purely descriptive term. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4

The available record shows that the disputed domain name previously directed to a website offering products identical or similar to those of the Complainant, making no disclaimer clarifying lack of affiliation with or sponsorship from the Complainant. In this Panel's opinion, the Respondent indeed intentionally attempted to attract for commercial gain Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The disputed domain name was thus registered and used in bad faith, according to paragraph 4(b)(iv) of the Policy.

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.

Taking into account those relevant circumstances, the Panel notes that the Respondent uses in the disputed domain name the additional descriptive term of "christmas", which exactly relates to an important area of the Complainant's business activity regarding seasonal gifts. The particularly chosen gTLD, ".shop", further corresponds to that area of the Complainant. The website content prominently displayed multiple protected factors of the Complainant, including without limitation the trademarks, color scheme, designed logotypes, images, and other copyrighted materials, without any consent. Moreover, the timing of the Respondent's registration was close to the advent of Christmas in 2023. It's apparent that the Respondent's website targeted the Complainant with intention to take unfair advantage of the Complainant's trademarks. Importantly, with the reputation of the LEGO marks, as well as the much later registration of the disputed domain name

by the Respondent, it may be inferred that the Respondent knew or at least should have known about the existence of the Complainant's mark. The Panel is thus in the view that those circumstances further corroborate the finding that the disputed domain name was registered and used in bad faith.

Panels have held that the use of a domain name for illegal activity, here claimed as impersonation, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

On the date of this decision, the disputed domain name resolves to an inactive website. In this regard, panels have found that the non-use of a domain name 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. The Panel notes the high degree of the distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name. Moreover, the Respondent failed to respond to any contention or evidence from the Complainant. The Panel finds that in the circumstances of this case, the current passive holding of the disputed domain name also does not prevent a finding of bad faith under the Policy.

Based on the available record, 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 <legochristmas.shop> be transferred to the Complainant.

/Hong Yang/

Hong Yang

Sole Panelist

Date: February 27, 2024