

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Jonas Boe, My Store

Case No. D2024-2300

1. The Parties

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

The Respondent is Jonas Boe, My Store, Norway.

2. The Domain Name and Registrar

The disputed domain name <pokemonlego.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 5, 2024. On June 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 6, 2024, 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 (Contact Privacy Inc. Customer 0170384186) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 7, 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 June 10, 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 June 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 15, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on July 22, 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 has supplied construction toys and related products under the trademark LEGO for decades. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Norway.

The Complainant owns many registered trademarks for LEGO including the United States of America trademark No. 1018875, registered on August 26, 1975, in class 28 or the Norwegian trademark No. 94028, registered on June 5, 1975, in classes 16, 20, 28.

The Complainant operates a website at “www.lego.com” and is the owner of many domain names containing the term LEGO.

The disputed domain name was registered on February 28, 2024, and it resolves to an inactive Shopify web page.

The Complainant has sent a cease-and-desist letter to the Respondent on March 19, 2024, but in spite of the reminders sent, no reply was received.

There is no information known on the Respondent apart from the details as they appear on the Whois record.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark LEGO, as the dominant part of the disputed domain name comprises the term LEGO, identical to the registered trademark LEGO of the Complainant. In creating the disputed domain name, the Respondent has added the third-party trademark “POKEMON” to the Complainant's LEGO trademark, thereby making the disputed domain name confusingly similar to the Complainant's trademark.

As regards the second element, the Complainant argues that no license or authorization of any kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. The Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. Instead, the Respondent uses the disputed domain name to host a closed Shopify web page. The Respondent is identified as “Jonas Boe, My Store”, which does not resemble the disputed domain name in any manner.

With respect to the third element, the Complainant argues that the trademark LEGO in respect of toys belonging to the Complainant has the status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world. The Respondent registered the disputed domain name on February 28, 2024, which is after when the Complainant registered the trademark LEGO in Norway, where the Respondent resides, and elsewhere, by decades. The disputed domain name is used to host a closed Shopify page which suggests the Respondent's intention to host a commercial website offering. Also, the disputed domain name has been set up with mail exchanger (MX) records which shows that the disputed domain name may be actively used for email purposes.

B. Respondent

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

6. Discussion and Findings

Although duly notified, no response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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

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 3.0](#), section 1.7.

The Complainant has shown rights in respect of the trademark LEGO 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 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 other terms (here, "pokemon") 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. According to the un rebutted statements of the Complainant, "pokemon" is the trademark of a third party. It is well established that the addition of other third-party trademarks is insufficient to avoid a finding of confusing similarity to the Complainant's trademark since the Complainant's registered trademark is still recognizable within the disputed domain name under the first element of the UDRP (see section 1.12 of the [WIPO Overview 3.0](#)).

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.

There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. Rather, according to the unrebutted evidence provided by the Complainant, the disputed domain name resolves to a "under construction" Shopify page. The Panel considers that the use of the disputed domain name to resolve to a landing page for an inactive Shopify webpage does not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant's trademark or capacity to otherwise mislead Internet users.

Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

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, the Panel notes that the Respondent registered and used the disputed domain name in bad faith. The Complainant's trademark is distinctive and well-known. Under such circumstances, it is implausible that the Respondent was unaware of the Complainant and its trademark when registering the disputed domain name. The Respondent has failed to provide any response to the Complaint and has therefore failed to provide any justification for the registration and use of the disputed domain name.

With respect to the use, according to the unrebutted evidence in the case file, the disputed domain name resolves to a landing page for an inactive Shopify webpage. 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark, and the composition of the disputed domain name, and lack of a response from the Respondent 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.

An additional element is the DNS setup of the disputed domain name (with active MX records). Furthermore, the Respondent has not replied to the Complainant's cease and desist letter or to the contentions in these proceedings and used a privacy service when registering the disputed domain name. These circumstances are further indications of bad faith.

The Panel finds that the Complainant has established the third element of the Policy.

It is the consensus view among UDRP panelists that neither the Policy nor the Rules expressly require the consent of a third party and previous panels have accepted complaints request that a domain name may be

transferred to the complainant, noting that such decision would be expressly without prejudice to any rights, which may be asserted by third party trademark holder. See e.g. *Decathlon SAS v. Nadia Michalski*, WIPO Case No. [D2014-1996](#).

Having the previous panel decisions in mind and the consensus view that neither the Policy nor the Rules expressly require the consent of a third party, this transfer is without prejudice to any rights that might be asserted by third-party holder of the POKEMON trademark with regard to 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 <pokemonlego.com> be transferred to the Complainant.

The transfer of the disputed domain name shall be ordered without prejudice to any rights of the third-party holder of the POKEMON trademark in the disputed domain name.

/Mihaela Maravela

Mihaela Maravela

Sole Panelist

Date: August 5, 2024