

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. joao silva marcos, uf
Case No. D2024-4327

1. The Parties

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

The Respondent is joao silva marcos, uf, Brazil.

2. The Domain Name and Registrar

The disputed domain name <legoloja.online> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 21, 2024. On October 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 21, 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 (Registration Private) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 22, 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 October 25, 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 October 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 15, 2024.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on November 21, 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 Danish Company part of worldwide well-known group that produces and sells LEGO branded toys.

The Complainant is the owner of numerous registered trademarks incorporating its company name and term LEGO over the world, including the following (the “LEGO Trademarks”):

- the Brazilian word mark LEGO, No. 730130533, registered on January 16, 1982, and regularly renewed;
- the United States of America word mark LEGO, No. 1018875, registered on August 26, 1975, and regularly renewed;
- the European word mark LEGO, No. 000039800, registered on October 5, 1998, and regularly renewed.

The Complainant is also the owner of numerous domain names incorporating the LEGO Trademarks.

The disputed domain name was registered on September 19, 2024, and resolved to an unauthorized commercial website offering LEGO products, reproducing the Complainant’s logo. At the date of the Decision, the disputed domain name resolves to an inactive site.

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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its LEGO Trademarks. The Complainant highlights that the addition of the word “loja” (Portuguese for “store”) to its LEGO Trademarks increase the confusing similarity between the disputed domain name and its trademarks, since the Complainant maintains over 900 physical store locations globally, including 14 in Brazil.

Then, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since the Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. The Complainant adds that the Respondent is not commonly known by the disputed domain name. The Complainant also submits that no license or authorization of any other kind has been given by the Complainant to the Respondent, and that the Respondent is not an authorized reseller of the Complainant. The Complainant underlines that there was no visible disclaimer stating that the Respondent’s website was not endorsed or sponsored by the Complainant and that the Respondent has incorporated the Complainant’s logotype without consent, to create a false link to the Complainant. Finally, the Complainant points out that the Respondent is today not using the disputed domain name in connection with a bona fide offering of goods or services since it resolves to blank page and lacks content.

Finally, the Complainant submits the disputed domain name was registered and is being used in bad faith. The Complainant highlights that the LEGO Trademarks are well known and reputable trademarks with a substantial and widespread goodwill throughout the world. The Complainant contends that it is obvious that it is the fame of the LEGO Trademarks that has motivated the Respondent to register the disputed domain name. This fact is further proved by the fact that the disputed domain name was previously connected to an

unauthorized commercial website offering LEGO products, prominently displaying the Complainant's logo. The Complainant asserts the Respondent was using the disputed domain name to intentionally attempt to attract Internet users to a website for commercial gain, by creating a likelihood of confusion with the LEGO Trademarks as to the source, sponsorship, affiliation or endorsement of its website. The Complainant also highlights that even if the disputed domain name currently resolves to an inactive site and is not being used, passively holding a domain name can constitute a factor in finding bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

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.

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 LEGO Trademarks is recognizable within the disputed domain name. Indeed, the disputed domain name consists of:

- the LEGO Trademarks,
- the Brazilian word "loja" which means "store" in Portuguese, and
- the generic Top Level-Domain ("gTLD") ".online".

The Panel finds that these additions in the disputed domain name do not prevent a finding of confusing similarity since the Complainant's LEGO Trademarks are 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](#), sections 1.7 and 1.8.

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.

Indeed, it appears that the Respondent has no registered trademarks or trade names corresponding to the disputed domain name. The Respondent has not received any license or authorization of any other kind to use the LEGO Trademarks, nor is the Respondent an authorized reseller of the Complainant.

Moreover, the Complainant has demonstrated that the disputed domain name, which is inactive at the time of the Decision, was used to purportedly sell LEGO products, impersonating the Complainant through the reproduction of the Complainant's logo. The nature of the disputed domain name incorporating the Complainant's trademark with a related term carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

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 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 has targeted the Complainant's LEGO Trademarks on purpose and used the disputed domain name to purportedly sell LEGO products, without being an authorized reseller of the Complainant. The composition of the disputed domain name and the reproduction of the Complainant's logo on its website reflect the Respondent's intention to impersonate and mislead Internet users as to an association with the Complainant. Therefore, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's LEGO Trademarks as to the source, sponsorship, affiliation, or endorsement.

Moreover, 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. Indeed, 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. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness and reputation of the LEGO Trademarks, and the composition of the disputed domain name, and finds that in the circumstances of this case, the present passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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, <legoloja.online> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: December 4, 2024