

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Domain Privacy, Domain Name Privacy Inc  
Case No. DCO2024-0081

### **1. The Parties**

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

The Respondent is Domain Privacy, Domain Name Privacy Inc, Cyprus.

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

The disputed domain name <legoshop.co> is registered with Communigal Communications Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 1, 2024. On November 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 6, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which partly differed from the named Respondent (REDACTED FOR PRIVACY, Domain Name Privacy Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 6, 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 November 6, 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 November 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 28, 2024.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on December 2, 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” all over the world, including the following (the “LEGO Trademarks”):

- the Cyprus word mark LEGO ΛΕΓΚΟ, No. 23823, registered on June 25, 1984, and regularly renewed;
- the European Union 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 July 24, 2024, and resolves to a website displaying sponsored pay-per-click (“PPC”) links, all referencing the Complainant’s LEGO products . It has also been set up with mail exchanger (MX) records.

The Complainant tried to contact the Respondent on August 14, 2024, through a cease-and-desist letter sent by e-mail, but did not receive 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 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 term “shop” to its LEGO Trademarks heightens confusion in the mind of Internet users as the term “shop” is intrinsic to the Complainant’s services under the LEGO Trademarks.

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 also submits that no license or authorization of any other kind has been given by the Complainant to the Respondent to use the LEGO Trademarks, and that the Respondent is not an authorized reseller of the Complainant. The Complainant underlines that the Respondent was using a privacy service. Furthermore, the Complainant points out that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services since it resolves to sponsored links.

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 is further proved by the fact that the disputed domain name is connected to a website displaying sponsored links. The Complainant asserts the Respondent is 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 the disputed domain name is currently used to host a PPC advertising page. The Complainant notes that it has also been set up with MX records. Therefore, the Complainant considers that this shows that the disputed domain name may be actively used for email purposes and that it is likely that the disputed domain name may be actively used to facilitate fraudulent activities such as phishing, impersonating or passing off as the Complainant.

## **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 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, "shop", 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.

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.

Indeed, it appears that the Respondent has not received any license or authorization to use the LEGO Trademarks in any manner, and that the Respondent is not affiliated with nor authorized by the Complainant in any way. Moreover, the Panel finds that the Respondent is not commonly known by the disputed domain name and that nothing on the record indicates the Respondent intends to use the disputed domain name in connection with a bona fide offering of goods or services. On the contrary, the disputed domain name resolves to a parked page comprising PPC links, including links related to the Complainant or its products. Such use does not represent a bona fide offering where the links compete with or capitalize on the reputation and goodwill of the Complainant's trademarks. [WIPO Overview 3.0](#), section 2.9.

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 intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the LEGO Trademarks. Noting the distinctiveness and reputation of these trademarks, the Panel considers that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademarks.

According to prior UDRP panel decisions, the mere registration of a domain name that is identical or confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Indeed, the Panel considers that it is established that the LEGO Trademarks were registered and used well before the registration of the disputed domain name. By adding an additional term "shop" to the LEGO Trademarks which might suggest a connection to the Complainant's sale efforts, the Respondent has intentionally attempted to attract Internet users and capitalize on the fame of the LEGO Trademarks. This further supports a finding of bad faith registration of the disputed domain name.

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, the disputed domain name resolves to a website featuring PPC links to third-party websites, all of which directly reference the Complainant or its products and, as such, capitalize on the goodwill of the LEGO Trademarks. The Panel therefore notes that the disputed domain name is being used in bad faith since the Respondent attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the website source, sponsorship, affiliation, or endorsement; an activity clearly detrimental to the Complainant's business under paragraph 4(b)(iv) of the Policy.

Indeed, the Panel points out that the Complainant has demonstrated that the disputed domain name has been set up with MX records, suggesting an intention to use the disputed domain name for illegal purposes. Even if the record in this case contains no evidence of illegal behavior, the Panel considers that the configuration of (MX) records presents the potential for an email phishing scheme impersonating the Complainant, especially in view of the registration of the disputed domain name through a privacy service provider to conceal the Respondent's identity.

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 <legoshop.co> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: December 11, 2024