

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Le Nam, assafoushop

Case No. D2022-3083

1. The Parties

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

Respondent is Le Nam, assafoushop, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name is <legosticker.site> which is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 19, 2022. On August 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from those in the Complaint. The Center sent an email communication to Complainant on August 29, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 29, 2022.¹

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 Respondent of the Complaint, and the proceedings commenced on September 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 25, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 26, 2022.

¹ The original Complaint was filed against Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf, which appeared as registrant in the corresponding Whois report. The amended Complaint was filed against Respondent, as per the information disclosed by the Registrar.

The Center appointed Gerardo Saavedra as the sole panelist in this matter on October 10, 2022. This Panel finds that it was properly constituted. This 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

Complainant is a Danish company and the owner of certain LEGO brands used in construction toys and other products.

Complainant has rights over the LEGO mark for which it holds, among others, United States of America registrations No. 1018875, granted on August 26, 1975, in class 28, and No. 1248936, granted on August 23, 1983, in classes 16, 20, 22 and 25. Complainant also has rights over the LEGO and design mark for which it holds, among others, Vietnamese registration No. 4-0060988-000, granted on March 14, 2005, in classes 9, 16, 20, 25, 28 and 41.

The disputed domain name was registered on August 16, 2021. Before the Complaint was filed, the website associated with the disputed domain name showed, among others, “LEGO sticker Hotline : 083 523 [...]”, some characters (apparently in Vietnamese) followed by a stylized figure followed by “Lego Uoremon”, a stylized figure followed by “Lego Pikacnu”, and some other characters. Complainant claimed that said characters appearing in such website were in Vietnamese language and provided an automated Google English translation thereof showing, among others: “Lego sets help to develop thinking, creativity – Increase baby’s hands and foot motor ability and visual development during assembling process”, followed by those stylized figures with the legends “Lego Doraemon See details” and “Lego Pikachu See details”, respectively, “Safe virgin ABS plastic”, “High quality piece processing, precisely fit together”.² By the time the Complaint was filed, the website associated with the disputed domain name showed, among others, “legosticker.site”, “Related searches”, followed by apparent hyperlinks such as “Custom Stickers >”, “Shop Lego Us >”, “Custom Window Stickers >”.

5. Parties’ Contentions

A. Complainant

Complainant’s assertions may be summarized as follows.

Complainant is the owner of the LEGO mark used in connection with the famous LEGO construction toys and other LEGO branded products. Over the years, the business of making and selling LEGO branded toys has grown remarkably. Complainant’s group has expanded its use of the LEGO mark to, *inter alia*, computer hardware and software, books, videos and computer controlled robotic construction sets. Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Viet Nam and the United States of America.

The LEGO mark is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. The LEGO mark and brand have been recognized as being famous; for instance, in the list of the official Top 10 Consumer Superbrands for 2019, provided by Superbrands UK, LEGO appears as number 1 Consumer Superbrand and number 8 in the Consumer Relevancy Index. In 2014, Time featured LEGO as the Most Influential Toy of All Time.

² This Panel notes that Doraemon is a fictional character in the Japanese manga and animated series of the same name, while Pikachu is a fictional character in the Pokémon media franchise of video games, manga and animated series, and that those stylized figures closely resemble such fictional characters.

Complainant is the owner of more than 5,000 domain names containing the term LEGO. The Complainant's group also maintains an extensive website linked to the domain name <lego.com>.

The disputed domain name is confusingly similar to Complainant's LEGO mark. The dominant part of the disputed domain name identically comprises such mark; the suffix "sticker" does not diminish the confusing similarity between the disputed domain name and Complainant's mark.

Respondent has no rights or legitimate interests in respect of the disputed domain name. Respondent has no registered trademarks or trade names corresponding to the disputed domain name. Complainant has not granted any license or authorization to Respondent to use the LEGO mark, and Respondent is not an authorized dealer of Complainant's products and has never had a business relationship with Complainant.

Respondent is not making a *bona fide* offering of goods or services or a legitimate, noncommercial fair use of the disputed domain name. Respondent is simply trying to benefit from Complainant's world famous mark. On the website previously linked to the disputed domain name Respondent prominently featured Complainant's LEGO mark in a similar font while referring to themselves as "LEGO", which was a direct effort to take advantage of the fame and goodwill that Complainant has built in its brand. Respondent is not only using the confusingly similar disputed domain name, but is also imitating Complainant by displaying Complainant's logo.³

Respondent had been using the disputed domain name and corresponding website to sell brick building kits – products that directly compete with, and could be confused for, Complainant's own products. Past UDRP decisions have consistently held that selling competing goods, coupled with the unauthorized use of a complainant's trademarks in a confusingly similar domain name, does not qualify as a *bona fide* offering of goods or services. Respondent today is using the disputed domain name in order to generate traffic and income through a website that is commercial through sponsored links, some of which directly reference Complainant's LEGO mark. Respondent was and still is, using the LEGO mark in order to mislead Internet users to its commercial website.

Respondent should be considered to have registered and to be using the disputed domain name in bad faith.

The LEGO mark in respect of toys has the status of a well-known and reputable mark with a substantial and widespread goodwill throughout the world. The number of third party domain name registrations comprising the LEGO mark in combination with other words has always been attractive to domain name infringers. The considerable value and goodwill associated with the LEGO mark is most certainly what motivated Respondent to register the disputed domain name. Respondent registered the disputed domain name in August 2021, that is, more than four decades after Complainant registered LEGO in the United States of America and other jurisdictions.

Complainant first tried to contact Respondent on December 21, 2021, through a cease and desist letter sent by email. In spite of the reminders sent, no reply was ever received.⁴ Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file the Complaint under the UDRP.

Respondent cannot claim to have been using LEGO without being aware of Complainant's rights to it. Moreover, Respondent is displaying numerous pictures of Complainant's LEGO products on the website connected to the disputed domain name.

The disputed domain name was previously linked to a website offering brick building sets under Complainant's LEGO mark. Complainant's mark was prominently displayed on the website contributing to create a confusing similarity with Complainant. Consequently, Respondent is using the disputed domain name to intentionally attempt to attract Internet users to a website for commercial gain, by creating a

³ In the screenshots of such website attached to the Complaint as annex 8, this Panel does not observe any LEGO logo or a font similar to that used in the LEGO registered mark.

⁴ Annex 9 of the Complaint contains copies of such cease and desist letters dated December 21 and 30, 2021, and January 5, 2022.

likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website.

At present, the disputed domain name is connected to a website displaying sponsored links. Whether or not Respondent has influenced what links should be included on the website is irrelevant for the finding of bad faith. It is also without relevance whether or not Respondent itself is actually getting revenue from such website.

Complainant requests that the disputed domain name be transferred to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

The lack of Response from Respondent does not automatically result in a favorable decision for Complainant (see *Berlitz Investment Corp. v. Stefan Tinculescu*, WIPO Case No. [D2003-0465](#), and section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The burden for Complainant, under paragraph 4(a) of the Policy, is to show: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) that 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 undisputed that Complainant has rights over the LEGO mark.

Since the addition of a generic Top-Level Domain ("gTLD") *i.e.* ".site", in a domain name is technically required, it is well established that such element may be disregarded where assessing whether a domain name is identical or confusingly similar to a mark. The disputed domain name reflects the LEGO mark in its entirety, albeit followed by "sticker". It is clear to this Panel that the LEGO mark is recognizable in the disputed domain name and that the addition of such characters in the disputed domain name does not avoid a finding of confusing similarity with said mark (see sections 1.7 and 1.8 of the [WIPO Overview 3.0](#)).

Thus, this Panel finds that Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant has alleged and Respondent has failed to deny that Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is uncontested that Complainant's LEGO mark is well known internationally. Complainant asserts that Respondent is not an authorized dealer of Complainant's products and has had no business relationship with Complainant, that Respondent has no registered trademarks or trade names corresponding to the disputed domain name, and that Complainant has not granted any authorization to Respondent to use its LEGO mark.⁵

⁵ See *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. [D2003-0400](#): "There is no evidence that the Complainant authorized the Respondent to register the disputed domain name or to use the CASIO trademark, with or

Complainant contends that Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain. This Panel notes, from the screenshots of the website associated with the disputed domain name, that Respondent seems to have been commercially operating such website firstly to feature apparent LEGO sets and some toys, and later on to feature apparent hyperlinks, at least one showing the LEGO mark of Complainant. In the case file there is no justification for Respondent to use Complainant's mark in the disputed domain name and to benefit therefrom. Moreover, it seems to this Panel that the nature of the disputed domain name carries a risk of confusion with Complainant's LEGO mark. All that demonstrates neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

This Panel considers that Complainant has established *prima facie* that Respondent has no rights or legitimate interests in the disputed domain name (see *Intocast AG v. Lee Daeyoon*, WIPO Case No. [D2000-1467](#), and section 2.1 of the [WIPO Overview 3.0](#)). In the case file there is no evidence of circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances, giving rise to rights or legitimate interests in the disputed domain name by Respondent.

Based on the aforesaid, this Panel concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Complainant contends that Respondent's registration and use of the disputed domain name is in bad faith, which Respondent chose not to rebut.

Taking into consideration that Complainant's registration and use of the LEGO mark preceded the creation of the disputed domain name by a number of years, Complainant's international presence, the international recognition of the LEGO mark, and the content of the websites linked to the disputed domain name, this Panel is of the view that Respondent should have been aware of the existence of Complainant's mark and the goods marketed thereunder at the time Respondent obtained the registration of the disputed domain name.

Complainant provided screenshots of the website associated with the disputed domain name, from which it is clear that Respondent has used it for commercial purposes. It seems to this Panel that Respondent has sought to divert Internet traffic looking for Complainant's LEGO products in order to commercially benefit therefrom.⁶

Further, Respondent's failure to reply to Complainant's cease and desist letters may also be indicative of bad faith (see *Ebay Inc. v. Ebay4sex.com and Tony Caranci*, WIPO Case No. [D2000-1632](#)). Such finding is still valid even where a privacy protection service is provided by a third party, since such third party provider would be expected to forward such cease and desist letter to its principal, *i.e.*, the underlying registrant (see *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. [D2007-0062](#)).

Thus the overall evidence in the file indicates that Respondent's choice of the disputed domain name was deliberate for its confusing similarity with, and with the intention to benefit from the reputation and goodwill of, Complainant's mark, which denotes bad faith.

without immaterial additions or variants. These circumstances are sufficient to constitute a *prima facie* showing by the Complainant of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent".

⁶ See *Lilly ICOS LLC v. East Coast Webs, Sean Lowery*, WIPO Case No. [D2004-1101](#): "registration of a domain name in order to utilize another's well-known trademark by attracting Internet users to a website for commercial gain constitutes a form of bad faith". See also *DaimlerChrysler Corporation v. Web4COKK SRL Romania*, WIPO Case No. [DRO2006-0003](#): "The registration and use in any form of a famous trademark which belongs to somebody else, without proving any rights or legitimate interests in it, represents bad faith registration and use".

In this Panel's view, the lack of response is also indicative that Respondent lacks arguments and evidence to support its holding of the disputed domain name.

In light of the above, this Panel finds that Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, this Panel orders that the disputed domain name <legosticker.site> be transferred to Complainant.

/Gerardo Saavedra/

Gerardo Saavedra

Sole Panelist

Date: October 24, 2022