

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Lego LEGO

Case No. D2022-3335

1. The Parties

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

The Respondent is Lego LEGO, Benin.

2. The Domain Name and Registrar

The Disputed Domain Name <de-lego.site> is registered with Ligne Web Services SARL (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 7, 2022. On September 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 9, 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 the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 12, 2022, 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 September 16, 2022.

The Registrar also indicated that the language of the Registration Agreement was French. The Complaint was filed in English. The Center sent an email communication to the Complainant on September 12, 2022, inviting the Complainant to provide sufficient evidence of an agreement between the Parties for English to be the language of proceeding, a Complaint translated into French, or a request for English to be the language of proceedings. The Complainant filed a request for English to be the language of proceedings on September 16, 2022. The Respondent did not submit any arguments.

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 in French and in English, and the proceedings commenced on September 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 11, 2022.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on October 18, 2022. 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 world-famous company specialized in the making and selling of toys well-known across the world. Indeed, the Complainant's products are sold in more than 130 countries across the world.

The Complainant is the owner of many trademarks in the world, including in particular the following trademarks (the "LEGO Trademarks"):

- The Zambian wordmark LEGO, No. 1970/000583 registered on November 11, 1970, and regularly renewed for products and services in class 28;
- The United States of America wordmark LEGO, No. 2245652 registered on May 18, 1999, and regularly renewed for products and services in class 28;
- The European Union wordmark LEGO No. 000039800 registered on October 5, 1998, and regularly renewed for products and services in class 3, 9, 14, 16, 20, 24, 25, 28, 38, 41 and 42;
- The International wordmark LEGO No. 287932, designating among others France, registered on August 27, 1964, for products and services in class 28.

The Complainant has also registered more than 5 000 domain names containing the LEGO Trademarks.

The Disputed Domain Name was registered by the Respondent on December 24, 2021, and used to revert to an ecommerce website using the Complainant's LEGO Trademarks and logo to sell products identical and/or similar to those of the Complainant's. At the time of the filing of Complaint and at the date of the decision, the Disputed Domain Name resolves to an inactive website.

5. Parties' Contentions

A. Complainant

First, the Complainant stands that the proceedings should be conducted in English despite the registration agreement being in French. The Complainant explains that it is unable to communicate in French and that the translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings. The Complainant highlights the obviously abusive nature of the Disputed Domain Name and demonstrates that the previous website linked to the Disputed Domain Name used to feature various English phrases. The Complainant states that the term "lego" does not have any meaning in French.

Then the Complainant stands that the Disputed Domain Name is identical to its LEGO Trademarks. The Complainant highlights the fame of its LEGO Trademarks that have been recognized in many other UDRP proceedings. The Complainant explains that anyone who sees the Disputed Domain Name is bound to

mistake it for a name related to the Complainant which is aggravated by how the Disputed Domain Name was used by the Respondent.

Furthermore, the Complainant states that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name given that it was not authorized to use the LEGO Trademarks by the Complainant. The Complainant explains that the Respondent is only using the LEGO Trademarks to benefit from their fame. The Complainant highlights the fact that the Respondent has falsely identified itself with the Registrar and has not registered any trademark comprising the Disputed Domain Name.

Lastly, the Complainant stands that the Disputed Domain Name was registered and is being used in bad faith. The Complainant brings many previous UDRP decisions to evidence that the use of the LEGO Trademarks in combination with other words has always been attractive to domain name infringers. The Complainant declares that the Disputed Domain Name was registered well after the registration of the LEGO Trademarks and that the fame of the LEGO Trademarks has motivated the Respondent to register the Disputed Domain Name. The Complainant stands that the use of its LEGO Trademarks is a disruption of business which qualifies as bad faith. Finally, the Complainant highlights the fact that at the time of the Complaint the Disputed Domain Name resolves to an inactive website.

B. Respondent

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

6. Discussion and Findings

6.1. Language of the Proceedings

Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement. However, panels have the possibility to choose another language for the proceedings but only if it enables the parties to be treated equally and if they both have a fair opportunity to present their case.

Against this background, panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) currencies accepted on the webpage under the disputed domain name, or (viii) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement (see section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Prior UDRP panel decisions have also found that the lack of response of the respondent and lack of objection to the proceeding being conducted in another language is another scenario that may justify the proceeding being conducted in the different language than the one of the registration agreement (see *Volkswagen AG v. Song Hai Tao*, WIPO Case No. [D2015-0006](#) and *Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack*, WIPO Case No. [D2015-0070](#)).

The Panel finds that the Complaint was written in English whereas the registration agreement is in French. However, the Panel notes that French is not the mother language of the Complainant. Moreover, the previous version of the website linked to the Disputed Domain Name used to contain some words in English. The Internet users also have the possibility to change the language of the website linked to the Disputed Domain Name. All those elements show that the Respondent has the possibility to understand English.

Furthermore, the Respondent did not reply to the Complainant's contentions and to the Center's communication sent in English and in French.

Requiring the translation of the Complaint by the Complainant would create unwarranted delay in this proceeding.

Therefore, the Panel accepts the request of the Complainant for the proceedings to be conducted in English.

6.2. On the Merits

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the LEGO Trademarks and has provided evidence of the fame of its LEGO Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially 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.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it is composed of (i) the LEGO Trademarks and (ii) the two letters "d" and "e" which do not prevent a finding of confusing similarity.

The Panel also points out that generic Top-Level Domain ("gTLD") in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, the Panel holds that the Complainant has established the first element of paragraph 4(a) of the Policy and that the Disputed Domain Name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while 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 often-impossible 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 *prima facie* 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Respondent has no connection or affiliation with the Complainant and has not received any authorization, license or consent, whether expressed or implied, to use the Complainant's LEGO Trademarks in the Disputed Domain Name or in any other manner.

Furthermore, the Panel finds that there is no evidence that the Respondent is known by the term of the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods and services. Indeed, the Disputed Domain Name used to resolve to an e-commerce website using the logo and the LEGO Trademarks of the Complainant to sell identical and similar products.

In any case, the Respondent did not reply to the Complainant's contentions.

Therefore, according to the Policy, paragraph 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have rights or legitimate interests in the Disputed Domain Name <de-lego.site>.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of

the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

First, the Panel considers that it is established that the Complainant's LEGO Trademarks were registered before the registration of the Disputed Domain Name and the Complainant also owns several domain names and company names comprising the LEGO Trademarks. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name, given the fact that the Disputed Domain Name wholly reproduces the LEGO Trademarks.

Moreover, the Complainant has provided evidence that its LEGO Trademarks are well-known trademarks across the world. The Complainant has also demonstrated that the Respondent intended to use the Disputed Domain Name to benefit from the fame and reputation of the LEGO Trademarks since it notably used these trademarks and the Complainant's logos on the Disputed Domain Name's website.

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 (see section 3.1.4 of the [WIPO Overview 3.0](#)).

The Panel finds that the following circumstances reinforce the fact that the Respondent has registered and is using the Disputed Domain Name in bad faith:

- the Complainant has provided evidence that the LEGO trademarks are well known across the world;
- the Respondent has not provided any answer to the Complainant's contentions;
- the Disputed Domain Name at the time of the filing of Complaint and at the time of the decision resolves to an inactive website.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraph 4(a)(iii) and 4(b).

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 <de-lego.site> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: November 1, 2022