

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. 西安彼都人士电子商务有限公司  
(xianbidourenshidianzishangwuyouxiangongsi)

Case No. D2023-0433

### **1. The Parties**

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

The Respondent is 西安彼都人士电子商务有限公司 (xianbidourenshidianzishangwuyouxiangongsi), China.

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

The disputed domain names <stormslego.com> and <potterlego.com> are registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on January 31, 2023. On January 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 1, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 2023 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 in English on February 6, 2023.

On February 1, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 6, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Names Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Names Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Names Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on February 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 3, 2023.

The Center appointed Jonathan Agmon as the sole panelist in this matter on March 10, 2023. 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 well-known toy company based in Denmark. The Complainant's toys are sold under the LEGO mark in more than 130 countries around the world, including in China and the United States of America ("United States"). The LEGO brand is listed in the official Top 10 Consumer Superbrands for 2019, provided by Superbrands UK, showing LEGO as the number one Consumer Superbrand and number eight in the Consumer Relevancy Index.

The Complainant is the owner of the LEGO trademark, including but not limited to:

- China Trademark registration No.135134 for LEGO [figurative mark] registered on January 5, 1980;
- United States Trademark registration No. 1018875 for LEGO [typed drawing] registered on August 26, 1975.

The Complainant also states that it owns some 5,000 domain names containing the term "Lego" including the domain name <lego.com> registered on August 22, 1995.

The disputed domain names, <stormslego.com> and <potterlego.com>, were registered on February 24, 2022 and March 9, 2022, respectively. The disputed domain names currently resolve to inactive websites.

The Complainant sent a cease-and-desist letter to the Respondent concerning the <stormslego.com> website on May 26, 2022 with subsequent reminders in June, 2022 informing it of the unauthorized use of this disputed domain name and requesting a voluntary transfer. However, the Respondent did not reply.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant argues that the disputed domain names are confusingly similar to its LEGO mark as the disputed domain names, which incorporate the LEGO mark in their entirety with the addition of the prefixes "storms" and "potter" with a generic Top-Level Domain ("gTLD") ".com", which are insufficient to avoid confusing similarity.

The Complainant also argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names as it has not licensed or permitted the Respondent to use any of its trademarks or register the disputed domain names.

The Complainant further argues that the disputed domain names were registered and are being used in bad faith in order to intentionally attract, for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

Paragraph 11 of the Rules provides that:

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

The language of the Registration Agreement for the disputed domain names is Chinese.

The Complainant requested that the language of the proceeding be English for the following main reasons:

- (i) the disputed domain names are in the English language;
- (ii) the website under the disputed domain name <potterlego.com> previously presented information in the English language, including the name “stormslego”; and
- (iii) the Complainant is unable to communicate in Chinese, and translating the Complaint into Chinese would cause an undue burden on the Complainant and unnecessarily delay the proceeding.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval: “Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time, and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (See *Groupe Auchan v. xmxzl*, WIPO Case No. [DCC2006-0004](#)).

Having considered the above factors, the Panel determines that English should be the language of the proceeding. The Panel notes that at least one of the disputed domain names previously resolved to a website in English, that the Respondent has not participated in this proceeding, and that all of the Center’s communications with the Parties have been sent in English and Chinese. The Panel also needs to ensure the proceeding is conducted in a timely and cost-effective manner. In the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint into Chinese.

### **6.2 Substantive Analysis**

#### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark

certificate belong to its respective owner. The Complainant has provided evidence that it owns the LEGO mark.

The disputed domain names comprise the Complainant's LEGO mark in its entirety with the addition of the descriptive words "storms" and "potter".

It is well established that where the trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. The Complainant's LEGO mark is clearly recognizable in the disputed domain names.

Therefore, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights and the element under paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

Once the complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the domain names, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain names ([WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant has demonstrated *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests. The Complainant provided evidence that it owned the LEGO trademark registrations long before the dates that the disputed domain names were registered, and that it is not affiliated with nor has it licensed or otherwise permitted the Respondent to use the Complainant's trademark (see *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)). The Respondent is also not commonly known by the disputed domain names.

Even where a domain name consists of a trademark plus an additional descriptive term, panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see [WIPO Overview 3.0](#), section 2.5.1). In the present case, the evidence submitted by the Complainant suggests that the Respondent has attempted to impersonate the Complainant by purportedly offering for sale the Complainant's products on the websites under the disputed domain names. This Panel finds that such use of the disputed domain names is not considered fair use.

Further, the Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names sufficient to rebut the Complainant's *prima facie* case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

Based on the facts alleged and evidence provided by the Complainant, the Panel finds that the disputed domain names were registered and used in bad faith by the Respondent.

The Complainant has submitted evidence that the Respondent registered the disputed domain names long after the Complainant registered its LEGO trademark. Given the notoriety of the Complainant's LEGO mark in the field of toy products, and the fact that the Complainant's trademarks have been registered for a long time, it is highly unlikely that the Respondent did not know of the Complainant and its LEGO mark prior to the registration of the disputed domain names.

The Complainant provided evidence showing that at one point, the Respondent redirected traffic from the disputed domain name <stormslego.com> to a website under the disputed domain name <potterlego.com>, where the Respondent offered for sale what appears to be toys resembling Complainant's products. The webpage under the disputed domain name <potterlego.com> shows the words "stormslego".

The Complainant further argued that the term "storms" with the Complainant's LEGO trademark is likely to heighten confusion, as it is closely similar to the Complainant's "LEGO Mindstorms" product lines, while the addition of "potter" closely resembles the Complainant's "LEGO Harry Potter" line of toys.

In this case, the registration of the disputed domain names incorporating the Complainant's well-known LEGO trademark with prefixes that contain words which relate to the business and products of the Complainant is also evidence of the Respondent's bad faith registration and use of the disputed domain names. (See [WIPO Overview 3.0](#), section 3.1.4).

Further, the Complainant has provided evidence which shows that the websites under the disputed domain names are no longer active, and it appears that the content of the websites under the disputed domain names were removed in view of the demands issued by the Complainant. Such behavior further suggests a bad faith registration and use of the disputed domain names. See *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#) ("The incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith."); and *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) ("[The domain names] is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith.").

The Panel finds that the Respondent's registration and use of the disputed domain names, with actual or constructive knowledge of the Complainant's trademark rights, establishes the Respondent's registration and use of the disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the Policy. It is the Panel's finding that it is implausible that the Respondent can put the disputed domain names to any good faith use.

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain names and the Complainant's mark, the notoriety of the Complainant's mark, that no Response was submitted by the Respondent in response to the Complaint, and the implausibility of any good faith use to which the disputed domain names may be put, the Panel draws the inference that the disputed domain names were registered and are being used in bad faith.

## 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 names, <stormslego.com> and <potterlego.com>, be transferred to the Complainant.

*/Jonathan Agmon/*  
**Jonathan Agmon**  
Sole Panelist  
Date: April 1, 2023