

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. 户起龙

Case No. D2023-0869

1. The Parties

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

The Respondent is 户起龙, China.

2. The Domain Name and Registrar

The disputed domain name <elego.top> (the “Disputed Domain Name”) is registered with Eranet International Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2023. On March 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 4, 2023, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 8, 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 on March 9, 2023.

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 March 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 6, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on April 26, 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 Danish company. It manufactures and sells one of the most popular children's toys in the world, namely a range of interconnecting building bricks, although its products have expanded widely beyond that concept. Its products are marketed under the name Lego, and it is the owner of trademark registrations for the LEGO and stylised LEGO trademarks in numerous jurisdictions worldwide - see for example United States of America trademark registration no. 1018875 for LEGO, registered on August 26, 1975 (these trademarks are referred to in this decision as the "LEGO trademark"). Such registrations predate the date of registration of the Disputed Domain Name. The Complainant has been very successful, carries on business on a very substantial scale and its products and the Lego name are very widely known and recognised.

The Complainant is the owner of approximately 5,000 domain names containing the term "lego".

The LEGO Group has expanded its use of the LEGO trademark to, *inter alia*, computer hardware and software, books, videos, and computer controlled robotic construction sets. The Complainant also maintains an extensive website linked to the domain name <lego.com>, which features its various toy products.

The Disputed Domain Name was registered on August 5, 2022. The filed evidence establishes that the Disputed Domain Name resolves to a website which contains sexually explicit content (the "Respondent's Website").

The Complainant has sent "cease and desist" correspondence to the Respondent but no reply has been received.

5. Parties' Contentions

A. Complainant

The Complainant has filed lengthy submissions and cited numerous previous UDRP decisions in support of its arguments. The Panel does not feel it necessary to repeat all that material here. So far as the Policy is concerned, the Complainant's main contentions can be summarised as follows.

The Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights - LEGO is the predominant part of the Disputed Domain Name. The addition of the Top-Level Domain ("TLD") ".top" does not distinguish the Disputed Domain Name from the Complainant's LEGO trademark. Anyone who sees the Disputed Domain Name is bound to mistake it for a name related to the Complainant. The likelihood of confusion includes an obvious association with the LEGO trademark. With reference to the reputation of the LEGO trademark there is a considerable risk that the trade public will perceive the Disputed Domain Name either as a domain name owned by the Complainant or that there is some kind of commercial relation with the Complainant. The LEGO trademark also risks being tarnished by being associated with the Respondent's Website. By using the trademark LEGO as a dominant part of the Disputed Domain Name, the Respondent exploits the goodwill and the image of the LEGO trademark, which may result in dilution and other damage for the LEGO trademark. Persons seeing the Disputed Domain Name even without being aware of the content of the Respondent's Website, are likely to think that the Disputed Domain Name is in some way connected to the Complainant.

The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant says that the Respondent does not have any registered trademarks or trade names

corresponding to the Disputed Domain Name. The Complainant has also not found anything that would suggest that the Respondent has been using LEGO in any other way that would give it any legitimate rights in the name. No licence or authorisation of any other kind has been given by the Complainant to the Respondent to use the LEGO trademark. The Respondent is not an authorised dealer of the Complainant's products and has never had a business relationship with the Complainant. The mere registration of a domain name does not give the owner a right or a legitimate interest in respect of the domain name.

The Complainant says that LEGO is a famous trademark worldwide and an extremely valuable asset. It is highly unlikely that the Respondent would not have known of the Complainant's legal rights in the name at the time of registration. It is obvious that it is the fame of the LEGO trademark that has motivated the Respondent to register the Disputed Domain Name. That is, the Respondent cannot claim to have been using LEGO, without being aware of the Complainant's rights to it. This, among other facts, proves that the Respondent's interests cannot have been legitimate.

The Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Use which intentionally trades on the fame of another cannot constitute a *bona fide* offering of goods or services. To conclude otherwise would mean that a respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy. The Respondent cannot plausibly argue that it did not intentionally adopt the Disputed Domain Name so as to benefit from the goodwill of the LEGO trademark.

The Disputed Domain Name was registered and is being used in bad faith. The Complainant says the Respondent registered the Disputed Domain Name in bad faith in full knowledge of the Lego brand. It says the Respondent's use of the Disputed Domain Name constitutes a disruption of the Complainant's business and qualifies as bad faith registration and use under Policy because the Disputed Domain Name is confusingly similar to the Complainant's trademarks and the Respondent's Website contains pornographic content. Past UDRP panels have confirmed that using a confusingly similar domain name to link to a website containing sexually explicit content is evidence of bad faith registration and use. Accordingly, the Complainant says the Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith.

B. Respondent

No Response has been received.

6. Discussion and Findings

Procedural Matters - Lack of Response

The Panel notes that no Response has been received from the Respondent. However, given that the notification of Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar then the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel in relation to the Disputed Domain Name that:

- (i) the Disputed Domain Name is identical with 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

The Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's LEGO trademark. The Respondent has simply taken the Complainant's trademark and combined it with the letter "e".

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable in a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

It is also established that the addition of a letter or term (such as here "e") to a disputed domain name does not prevent a finding of confusing similarity. See sections 1.8 and 1.9 of the [WIPO Overview 3.0](#).

It is also well established that the TLD, in this case ".top", does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#), and section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

The Panel finds the LEGO trademark is, on the evidence before the Panel, a term in which the Complainant has over many years developed a very significant reputation.

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, 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
- (ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) 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.

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use LEGO trademark. The Complainant has prior rights in the LEGO trademark which precede the Respondent's registration of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence

demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); and *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

In the present circumstances, the distinctive nature of the LEGO trademark, and the evidence as to the extent of the reputation the Complainant enjoys in the LEGO trademark, and the confusingly similar nature of the Disputed Domain Name to the LEGO trademark, and the lack of any explanation from the Respondent as to why it registered the Disputed Domain Name lead the Panel to conclude the registration and use were in bad faith.

Using the Disputed Domain Name to link to a website which contains sexually explicit content is not clearly within any of the sub sections (i) to (iv) of paragraph 4(b) of the Policy (above) although arguably subsections (iii) or (iv) may be applicable. However, those subsections are in any case a non-exhaustive list. It seems to the Panel the Respondent more likely than not selected the Disputed Domain Name precisely because of its association with the Complainant and presumably thought the name would be readily remembered and provide a convenient way to promote services and Internet traffic to the website connected to the confusingly similar Disputed Domain Name, even though those services are in a field of activity entirely unrelated to the Complainant's field of activity. This is conduct which amounts to bad faith registration and use. In this regard, the Panel adopts the reasoning of the panel in *Eidos Interactive Limited v. Moniker Privacy Services/Taranga Services Pty Ltd*, WIPO Case No. [D2009-0124](#): "With respect to the Respondent's use of the domain name to attract Internet users to an adult content website, it is commonly understood, under WIPO panel decisions and it is the Panel's view in the pending case, that, whatever might be the Respondent's motivation, the use of domain names to divert users to pornographic sites is itself certainly consistent with the finding that the domain name was registered and is being used in bad faith (see *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. [D2003-0022](#); *Caledonia Motor Group Limited v. Amizon*, WIPO Case No. [D2001-0860](#); *Bass Hotels & Resorts, Inc. v. Mike Rodgerall*, WIPO Case No. [D2000-0568](#))." See also *LEGO Juris A/S v. Zhangming Li*, WIPO Case No. [D2020-2350](#), where the

panel stated as follows “The Complainant’s LEGO trade mark is such a well-known mark that the Respondent could not by pure coincidence and without knowledge of the LEGO mark have registered the disputed domain name without the Complainant and/or its mark in mind”. The Panel finds that the Respondent’s use of the disputed domain name for the offering of pornographic content and the provision of links to gambling sites are strong indicators of bad faith use. As was stated in the case of *VIVENDI v. Guseva Svetlana*, WIPO Case No. [D2018-2631](#), “Numerous panels deciding cases under the Policy have held that pornographic content on a respondent’s website is in itself sufficient to support a finding of bad faith, irrespective of the respondent’s motivation [...]. In addition, the linking of the disputed domain name with a pornographic website might result in the tarnishing of the Complainant’s well-known trademark”. The same principles apply in the current case.

Further the Panel notes that the Respondent has not filed a Response and hence has not availed itself of the opportunity to present any case of good faith that it might have. The Panel infers that none exists.

As a result, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly, the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <elego.top> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: May 10, 2023