

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Zhichao Yang

Case No. D2023-2716

1. The Parties

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

The Respondent is Zhichao Yang, China.

2. The disputed domain name and Registrar

The disputed domain name <legospiderman.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 23, 2023. On June 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 26, 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 July 5, 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 July 7, 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 July 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 8, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on August 11, 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 that owns the famous LEGO brand of construction toys.

The Complainant has subsidiaries and branches throughout the world. LEGO products are sold in more than 130 countries, including in China.

The Complainant owns several LEGO trademark registrations in multiple countries, including the Chinese registration no. 75682, registered on December 22, 1976. The Complainant is also the owner of numerous domain names containing the term “lego”.

The disputed domain name was registered on February 18, 2023.

The disputed domain name resolves to a domain name e-commerce platform, where the disputed domain name is being offered for sale¹.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The dominant part of the disputed domain name comprises the term LEGO, identical to the registered trademark LEGO, registered by the Complainant as trademarks and domain names in numerous countries all over the world. The fame of the trademark has been confirmed in numerous previous UDRP decisions. In addition to the trademark LEGO, the disputed domain name also comprises the generic suffix “spiderman” which does not diminish the confusing similarity between the disputed domain name and the Complainant’s trademark. It is a long-established precedent that confusing similarity is generally recognized when well-known trademarks are paired up with different kinds of prefixes and suffixes. The addition of the Top-Level Domains (“TLD”) “.com” does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant to determine the confusing similarity between the trademark and the disputed domain name.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. Neither has the Complainant found anything, including the Whois details, that would suggest that the Respondent has been using LEGO in any other way that would give them any legitimate rights in the name. No license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. Further, the Respondent is not an authorized dealer of the Complainant’s products and has never had a business relationship with the Complainant. In the instant case, the pertinent WIPO Notice of Registrant Information identifies the Registrant as “Zhichao Yang”, which does not resemble the dispute domain name in any manner. Thus, where no evidence, including the Whois record for the dispute domain name, suggests that the Respondent is commonly known by the dispute domain name, then the Respondent cannot be regarded as having acquired rights to or legitimate interests in the dispute domain name. Furthermore, at the time of filing the Complaint, the Respondent was using a privacy

¹ Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8, “[n]oting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision... This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the disputed domain name...”.

Whols service, which past UDRP panels have also found to equate to a lack of legitimate interest. LEGO is a famous trademark worldwide and it is well established that any use of such a trademark in a domain name would violate the rights of the trademark owner. The Respondent has failed to make use of this dispute domain name's website and has not demonstrated any attempt to make legitimate use of the disputed domain name and website, which evinces a lack of rights or legitimate interests in the dispute domain name. The dispute domain name is being offered for sale in an amount that far exceeds the Respondent's out-of-pocket expenses in registering the domain name, which serves as further evidence of the Respondent's lack of rights and legitimate interests.

- The disputed domain name was registered and is being used in bad faith. The trademark LEGO in respect of toys belonging to the Complainant has the status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world. The Respondent registered the disputed domain name long after the Complainant registered the trademark LEGO in China, where the Respondent resides, and elsewhere. The Complainant tried to contact the Respondent through a cease and desist letter, but no reply was received. Furthermore, the Respondent is currently intending to sell, rent, or otherwise transfer the disputed domain name for valuable consideration in excess of his out-of-pocket expenses. It is well-established that seeking to profit from the sale of a confusingly similar domain name that incorporates a third party's trademark demonstrates bad faith. Also, the Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity, which past UDRP panels have held serves as further evidence of bad faith registration and use. In addition to the disputed domain name, the Respondent currently holds registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses. This fact demonstrates that the Respondent is engaging in a pattern of cybersquatting / typosquatting, which is evidence of bad faith registration and use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a 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; and
- (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 has no doubt that "LEGO" is a term directly connected with the Complainant's trademarks and construction toys.

Annex 3 to the Complaint shows trademark registrations for LEGO in China that date as early as in 1976.

The trademark LEGO is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark LEGO merely by the addition of the suffix "spiderman" and of the generic TLD ("gTLD") extension ".com".

Previous UDRP decisions have found that the mere addition of other terms (such as "Spider Man", a popular super-hero character among kids and teenagers) to a trademark in a domain name does not avoid a finding

of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well-established that the addition of a gTLD extension such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Complainant has showed that the confusingly similar disputed domain name has been offered for sale, for consideration presumably far in excess of its registration and maintenance costs.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed 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 documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding disputed domain name, provided that the respondent has engaged in a pattern of such conduct; or

- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2023), the trademark LEGO was already well-known worldwide and directly connected to the Complainant's construction toys.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.1.4, UDRP panels have consistently found that 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.

The Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's famous trademark, as well as that the adoption of the expression "legospiderman" together with the gTLD extension ".com" could be a mere coincidence.

Actually, the Panel considers that in the present case the addition to the Complainant's trademark of the term "spider man" may suggest that it is the Complainant's official online website of the construction toys version of the said super-hero character.

The non-collaborative posture of the Respondent, *i.e.*, (a) not at least replying to the cease-and-desist letter sent by the Complainant, (b) nor submitting a Response to this procedure or providing justifications for the use of a famous third party trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion. Such circumstances, together with (c) the lack of any plausible interpretation for the adoption of the term "legospiderman" by the Respondent, and (d) with the fact that the disputed domain name is being offered for sale for valuable consideration, presumably in excess of his out-of-pocket expenses, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <legospiderman.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: August 25, 2023