

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Nguyen Xuan Hau

Case No. D2023-4439

1. The Parties

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

The Respondent is Nguyen Xuan Hau, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <legoshopvn.online> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 26, 2023. On October 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 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 (GMO-Z.com RUNSYSTEM, GMO-Z.com RUNSYSTEM JSC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 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 November 1, 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2023.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on November 24, 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, a Danish company, owns a worldwide portfolio of LEGO trademarks used in connection with construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in Viet Nam, Japan, and elsewhere.

Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Viet Nam and Japan.

The Complainant has a large portfolio of trademarks consisting of "Lego", in several jurisdictions worldwide, including the following:

- International Trademark Registration for LEGO No. 287932, designating several jurisdictions for protection, among which Viet Nam, registered on August 27, 1964, for goods in class 28;
- National Trademark for LEGO No. 4-0060988-000, registered in Viet Nam, on March 14, 2005, for goods in classes 9, 16, 20, 25, 28, and 41; and
- National Trademark for LEGO No. 520470, registered in Japan, on May 21, 1958, for goods in classes 20 and 28.

Moreover, the Complainant is the owner of close to 5,000 domain names containing the term "Lego".

The trademark LEGO is among the best-known trademarks in the world also due to extensive advertising. The Complainant has provided as an annex to the Complaint with a list of the official Top 10 Consumer Superbrands for 2019, provided by Superbrands UK, showing LEGO as number 1 Consumer Superbrand and number 8 in the Consumer Relevancy Index. Also, the Reputation Institute recognized the LEGO Group as number 1 on its list of the world's Top 10 Most Reputable Global Companies of 2020, and applauded the LEGO Group's strong reputation, having been on its top 10 list for 10 consecutive years. In addition, in 2014, TIME also announced LEGO to be the Most Influential Toy of All Time.

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 LEGO Group also maintains an extensive website under the domain name <lego.com>.

The disputed domain name <legoshopvn.online> was registered on October 12, 2023. According to the evidence filed by the Complainant, at the time of filing the Complaint, the disputed domain name resolved to an active website prominently displaying the Complainant's LEGO mark and purportedly offering the Complainant's products for sale, and also mail exchange ("MX") records were configured in relation to the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

(i) the LEGO mark is very well-known;

(ii) the disputed domain name is confusingly similar to the Complainant's LEGO mark as it incorporates the LEGO trademark followed by the suffix "shop" and the letters "vn" which does not diminish the confusing similarity between the disputed domain name and the Complainant's trademark, while the addition of the generic Top-Level Domain ("gTLD") ".online" does not have any impact on the overall impression and is therefore irrelevant to determine the confusing similarity between the trademark and the disputed domain name;

(iii) the Respondent has no rights or legitimate interests in respect of the disputed domain name for a number of reasons, among which that, the Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name, no license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the LEGO trademark, the Respondent is not an authorized dealer of the Complainant's products, and has never had a business relationship with the Complainant, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, but to mislead Internet users to his commercial website, that the Respondent does not adequately disclose the lack of relationship between the Respondent and the Complainant on the website associated with the disputed domain name, and that;

(iv) the disputed domain name was registered and is being used in bad faith for a number of reasons, among which that, the LEGO trademark is a well-known and reputable trademark with a substantial and widespread goodwill throughout the world, the disputed domain name registration is subsequent to the registration of the LEGO trademark in Viet Nam, Japan, and elsewhere, by decades, that the disputed domain name was connected at the time of filing the Complaint to an unauthorized commercial website offering LEGO products, that there is no connection between the Respondent and the Complainant, that the Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity, that the disputed domain name has been set up with MX records which shows that the disputed domain name may be actively used for email purposes. In the Complainant's view, emails emanating from the disputed domain name could not reasonably be used for any good faith purpose given the close similarity to the Complainant's trademark and that it is likely that the disputed domain name may be actively used to facilitate fraudulent activities such as phishing, impersonating, or passing off as the Complainant.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to succeed, such must prove, according to paragraph 4(a) of the Policy, that:

(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 with respect to the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

In case all three element above have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. Thus, the Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the LEGO mark is recognizable within the disputed domain name. The entirety of the LEGO mark is reproduced within the disputed domain name followed by the addition of the terms "shop" and "vn", which does not avoid a finding of confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the terms "shop" and "vn", the last one which might correspond to the abbreviation of the geographical term Viet Nam, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy, as the LEGO trademark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.8.

In what concerns the addition of the gTLD ".online", this is not to be taken into consideration when examining the confusing similarity between the Complainant's trademarks and the disputed domain name, as such is viewed as a standard registration requirement and such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 a *prima facie* case 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Thus, based on the available evidence, the Respondent does not appear to be known by "Lego" nor does it own any trademark incorporating the term "Lego". The Respondent is not a licensee of, nor an authorized reseller of, nor has any kind of business relationship with the Complainant. The Complainant has never authorised the Respondent to make use of its LEGO trademarks in the disputed domain name.

The disputed domain name comprises the Complainant's LEGO mark in its entirety in combination with the terms "shop" and "vn", the last one which might correspond to the abbreviation of the geographical term Viet Nam, conveying to Internet users that this is a Vietnamese shop for Lego products, leading thus to confusion and misleading Internet users into believing that the website is operated by the Complainant or by an affiliated entity with the Complainant's consent. Generally speaking, UDRP panels have found that domain names confusingly similar to a complainant's trademark carry a risk of implied affiliation.

Moreover, at the time when the Complaint was filed, the disputed domain name resolved to an active website which incorporated the Complainant's logo, trademark, and imagery all over the website with no disclaimers as to the lack of any relationship with the Complainant, which suggests that the Respondent intended to attract Internet users to a false website looking like an official website of the Complainant.

The above does not amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's rights to the LEGO trademark predate the registration date of the disputed domain name.

The LEGO trademark enjoys of a well-known character, recognized by earlier UDRP panels as well (see *LEGO Juris A/S v. Michael Longo*, WIPO Case No. [D2008-1715](#); *LEGO Juris A/S v. Level 5 Corp*, WIPO Case No. [D2008-1692](#); *VLEGO Juris A/S v. Reginald Hastings Jr*, WIPO Case No. [D2009-0680](#)).

In light of the well-known character of the LEGO trademarks, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the disputed domain name without knowledge of the Complainant's LEGO mark, which supports a finding of bad faith registration. [WIPO Overview 3.0](#), section 3.2.2.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

The Respondent's incorporation into the disputed domain name of the Complainant's LEGO mark in its entirety, followed by the addition of the terms "shop" and "vn", the last one which might correspond to the abbreviation of the geographical term Viet Nam, conveying to Internet users that this is a Vietnamese shop for Lego products, the use of the disputed domain name at the time when the Complaint was filed, in relation to an active website which incorporated the Complainant's logo, trademark, and imagery all over the website with no disclaimers as to the lack of any relationship with the Complainant, which suggests that the Respondent intended to attract Internet users to a false website looking like an official website of the Complainant by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website and the goods offered and promoted through said website, support a finding of bad faith registration and use according to paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), sections 3.1.4.

Given the fact that the disputed domain name is confusingly similar to the LEGO mark and also based on the evidence from the file that, such is configured with MX records, therefore, capable of email communication, it is reasonable to infer that anyone receiving an email originating from the disputed domain name would reasonably assume that it was sent by the Complainant. The Respondent's action in this regard further

supports a finding of bad faith use according to paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.4.

Finally, the fact that the disputed domain name was registered with a privacy service which leads to the assumption that it was made in order to hide the Respondent's identity and also to prevent the Complainant from contacting him considering also all the above, further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.6.

Based on the available record, the Panel finds that the Complainant has established 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 <legoshopvn.online> be transferred to the Complainant.

/Delia-Mihaela Belciu/

Delia-Mihaela Belciu

Sole Panelist

Date: December 8, 2023