

ADMINISTRATIVE PANEL DECISION

**LEGO Juris A/S v. Chau Thanh Hao, CÔNG TY TNHH GẠCH BÊ TÔNG
LEGO**

Case No. D2022-2139

1. The Parties

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

The Respondent is Chau Thanh Hao, CÔNG TY TNHH GẠCH BÊ TÔNG LEGO, Viet Nam.

2. The Domain Names and Registrar

The disputed domain names <gachbetonglego.com> and <legocobi.com> (the “Disputed Domain Names”) are registered with Nhan Hoa Software Company Ltd. (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2022. On June 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On June 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On June 15, 2022, the Center sent an email in English and Vietnamese to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding and submitted an amended Complaint in English on June 17, 2022. 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 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 in English and Vietnamese of the Complaint, and the proceedings commenced on June 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 12, 2022. The Respondent did not submit any

response. Accordingly, the Center notified the Respondent's default on July 13, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on July 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, LEGO Juris A/S, is a Denmark-based corporation that owns the LEGO trademark and other trademarks used in connection with construction toys and other LEGO branded products. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Viet Nam.

According to Superbrands UK, the LEGO brand was ranked as number 1 in Top 10 Consumer Superbrands and number 8 in the Consumer Relevancy Index in the year 2019. 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 Complainant's strong reputation, having been on its top 10 list for 10 consecutive years. In 2014, Time also announced LEGO to be the Most Influential Toy of All Time.

The Complainant has rights in numerous trademark registrations for LEGO trademark in various jurisdictions throughout the world, including in Viet Nam, where the Respondent resides, with Vietnamese Registration No. 4-60988-000 registered on March 14, 2005 and International Registration No. 287932 registered on August 27, 1964 designating, among others, Viet Nam, for toy products in Class 28.

The Complainant also owns numerous domain names featuring the LEGO trademark, among which the notable one is <lego.com> registered on August 22, 1995. The Complainant also maintains an extensive website under the domain name <lego.com>.

The Disputed Domain Names were registered on April 12, 2021 and November 4, 2020, respectively. As of the date of this Decision, the Disputed Domain Names are resolving to active websites, in which the Respondent advertises and sells the building brick products under the names "LEGO" and "LEGOCOB1".

As indicated in the Complaint, the Complainant's attorneys sent to the Respondent a cease and desist letter with regard to the Disputed Domain Names on February 17, 2022, in which the Complainant asked for, amongst others, a voluntary transfer of such Disputed Domain Names. However, the Respondent did not reply.

5. Parties' Contentions

A. Complainant

(i) The Disputed Domain Names are identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

First, the Complainant contends that the Complainant is the registered owner of LEGO trademark in numerous jurisdictions around the world. Further, the Complainant asserts that the LEGO trademark is well-known and famous, which has been confirmed in previous UDRP decisions.

Second, the Complainant contends that the Disputed Domain Names are confusingly similar to the trademark owned by the Complainant since the Disputed Domain Names incorporate the Complainant's LEGO trademark in its entirety, and the addition of the terms "cobi" and "gachbetong" – both used as references to "concrete brick", could not dispel any likelihood of confusion.

Finally, the Complainant submits that the addition of the generic Top-Level Domain (“gTLD”) suffix “.com” in the Disputed Domain Names does not add any distinctiveness to the Disputed Domain Names.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Complainant submits that the elements set forth in the Policy, paragraph 4(c) are not fulfilled.

First, the Complainant contends that, since LEGO is a famous trademark worldwide, any use of such a trademark in a domain name would violate the exclusive trademark rights of the Complainant.

Second, the Complainant submits that the Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the above-mentioned trademark. Further, the Respondent is not an authorized dealer of the Complainant’s products, and has never had a business relationship with the Complainant. Nevertheless, there is no disclaimer on the website to explain the lack of relationship to the Complainant.

Third, the Complainant submits that the Respondent has no registered trademark corresponding to the Disputed Domain Names. The Respondent purports to be trading under the name “LEGO CONCRETE BRICK CO., LTD.”; however, that does not grant the Respondent automatic rights or legitimate interests over the Disputed Domain Names for the following reasons:

(i) The Respondent’s choice to use “lego” as the dominant portion of its company name is simply not by chance. The Respondent adopted the Complainant’s famous LEGO trademark in its company name in 2020 and registered Disputed Domain Names in April 2021 and November 2020, respectively, when the Complainant’s LEGO trademark and domain name have become well-known all over the world. Moreover, the term “lego” is not in any way generic and has no meaning in Vietnamese which correlates with the remaining portion of the Respondent’s company name. Therefore, it defies common sense to believe that the Respondent coincidentally selected the precise company name without any knowledge of the Complainant.

(ii) The Complainant contends that the Respondent misappropriated the engineering behind the Complainant’s LEGO building bricks to establish its own building system. Particularly, the concrete building products displayed on the Respondent’s websites associated with the Disputed Domain Names have a similar look and mechanism as to the Complainant’s LEGO building bricks and blocks with intertwining pieces. Hence, the Complainant argues that the Respondent incorporated the Complainant’s LEGO trademark in its company name with the intention to take unfair advantage of the reputation of the LEGO trademark.

Finally, The Complainant submits that the Respondent has intentionally chosen Disputed Domain Names based on a registered trademark in order to generate traffic and income through commercial websites offering concrete building bricks which are very similar in appearance to the Complainant’s famous LEGO building bricks. Thus, the Respondent is neither making a legitimate noncommercial or fair use of the Disputed Domain Names nor using the Disputed Domain Names in connection with a *bona fide* offering of goods or services.

(iii) The Disputed Domain Names have been registered and are being used in bad faith.

Firstly, the Complainant asserts that panel decisions under the Policy regularly recognize the well-known and reputable status of the Complainant’s LEGO trademark and the LEGO trademark has always been attractive to domain name infringers. Therefore, in the present case, the fame of the LEGO trademark has also motivated the Respondent to register the Disputed Domain Names, and the Respondent cannot claim to have been using the LEGO trademark without being aware of the Complainant’s rights to it.

Secondly, the Complainant contends that the failure of the Respondent to respond to the Complainant’s cease and desist letter, which was sent on February 17, 2022, or a similar attempt at contact, has been

considered relevant in a finding of bad faith.

Finally, the Complainant contends that the commercial websites associated with the Disputed Domain Names have offered concrete building bricks sharing the same mechanism as the Complainant's LEGO building bricks with intertwining pieces. The Respondent has chosen the LEGO trademark, which is world famous for its construction toys, to attract visitors to the websites of its suspiciously similar building brick systems. Consequently, the Complainant submits that the Respondent is using the Disputed Domain Names to intentionally attempt to attract Internet users to its website for commercial gain, by creating a likelihood of confusion – or at least an impression of association – with the LEGO trademark as to the source, sponsorship, affiliation or endorsement of its website.

With the said arguments, the Complainant requests that the Disputed Domain Names be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Procedural issues

(i) Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement was Vietnamese.

As the Complaint was filed in English, the Center, in its communication dated June 15, 2022, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding.

On June 17, 2022, the Complainant responded the Center along with the amended Complaint, confirming its request that English be the language of the proceeding as indicated in section IV of the amended Complaint.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) of the Rules is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

(i) the fact that the Complainant, a Denmark-based business entity, does not appear to be able to communicate in Vietnamese, and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;

(ii) the English language is quite popular in Viet Nam, where the Respondent is located, and the websites associated with the Disputed Domain Names contain the English words; these suggest that the Respondent appears to have knowledge of the English language and be able to communicate in English;

(iii) the Respondent did not object for English to be the language of the proceeding and did not submit a response in either English or Vietnamese, although the Center sent the emails of the language of the proceeding and notification of the Complaint in both English and Vietnamese.

Therefore, in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

(ii) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#), and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The Complainant is required to establish the following: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Names are identical or confusingly similar to its trademark.

First of all, the Panel finds that the Complainant has put up an extensive list of its registered trademark rights to LEGO (in many countries all over the world, and well before the Disputed Domain Names were registered).

In the case at hand, the Panel notes that the Complainant does not have a registered trademark for LEGO for concrete brick products in Class 19. However, it is well established that the goods and/or services for which the trademark is registered or used in commerce are irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP. See the section 1.1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Second, the Disputed Domain Names comprise the Complainant's LEGO trademark, in which its famous status has been confirmed in numerous previous UDRP decisions. The difference between the Disputed Domain Names and the trademark is the addition of the terms "cobi" and "gachbetong". Regarding the term "gachbetong", it means "concrete brick" in Vietnamese. Regarding the term "cobi", the Panel duly notes the Complainant's argument that such term is the short version for "concrete brick". On the other hand, conducting a search for the term "cobi" in the Internet, the Panel finds that COBI is a trademark for toy products owned by Cobi S.A., a competitor of the Complainant.

Above all, the Panel finds that the element "lego" remains clearly recognizable in the Disputed Domain Names as a core and distinctive element, and the addition of the terms "cobi" and "gachbetong" do not prevent confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Third, the Panel finds, similar to other UDRP panels, that the addition of the Top-Level Domain ("gTLD") ".com" to the Disputed Domain Names does not constitute an element that may help avoid confusing similarity for the Policy purposes (see, e.g., *LEGO Juris A/S v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-4146](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant's LEGO trademark, and the first element of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Names for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 Panel finds that the Complainant has made a *prima facie* evidence on that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the Complainant, once a *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating his rights or legitimate interests in the Disputed Domain Names (see *e.g.*, *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted for evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that no license, permission, or authorization of any kind to use the Complainant's trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the LEGO trademark.

Further, the Panel finds that: (i) “lego” is a coined word, neither having any dictionary meaning in English, nor being transliterations of any words in Vietnamese; (ii) the LEGO trademark is inherently distinctive and has been widely used and become famous by the Complainant in numerous countries including in Viet Nam before the registrations of the Disputed Domain Names and the Respondent's company name; and (iii) the websites associated with the Disputed Domain Names are offering concrete building bricks which have a similar look and mechanism to the Complainant's LEGO building bricks and blocks with intertwining pieces. Hence, the Panel is of the view that the Respondent, by using the famous LEGO mark in the Disputed Domain Names for websites promoting concrete brick products without any accurate and prominent disclaimer of relationship with the Complainants, intends to ride on the reputation of the LEGO trademark. Such use does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraph 4(c)(ii) of the Policy, the Panel notes that the Respondent purports to operate under the company name “LEGO CONCRETE BRICK CO., LTD.”, which was established on November 3, 2020. However, given that (i) the Complainant's LEGO trademark has been used widely in numerous countries worldwide, including in Viet Nam – where the Respondent resides, before the Respondent's business was registered, (ii) the use by the Respondent of its company name and Disputed Domain Names does not constitute a *bona fide* use under paragraph 4(c)(i) of the Policy as mentioned above, the Panel is of the view

that any renown attributable to the Respondent is not acquired on good faith. Thus, the Panel rejects such renown (if any), and on that basis, does not consider the Respondent as commonly known within the meaning of paragraph 4(c)(ii) of the Policy.

Regarding paragraph 4(c)(iii) of the Policy, it is quite clear to the Panel that the Respondent is doing business in selling building bricks. Hence, the Panel finds that there is no evidence that would suggest that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names. In fact, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Names, the Respondent had full knowledge of the LEGO trademark and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names, and the second element under paragraph 4(a)(ii) of the Policy is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular, but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(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”.

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Names in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel further finds that the Complainant's LEGO trademark has been registered in numerous countries, including in Viet Nam, where the Respondent resides. According to what the Complainant established and similar to previous UDRP panels' decisions, the Panel finds that the LEGO trademark is famous throughout the world, including in Viet Nam (see e.g. *LEGO Juris A/S v. Henry Jufri, Bayao Studio*, WIPO Case No. [D2021-2246](#); *LEGO Juris A/S v. WhoisGuard Protected, WhoisGuard, Inc./Truong Bui*, WIPO Case No. [D2020-2457](#); *LEGO Juris A/S v. Contact Privacy Inc. Customer 1246240368 / Nguyen Anh Duy*, WIPO Case No. [D2020-0822](#); *LEGO Juris A/S v. lin zhang*, WIPO Case No. [D2020-0675](#); *LEGO Juris A/S v. WhoisGuard Protected, WhoisGuard, Inc. / Eric Meals*, WIPO Case No. [D2020-0823](#); *LEGO Juris A/S v. Nadir Boukeraa*, WIPO Case No. [D2020-0874](#); and *LEGO Juris A/S v. Wu Zhang*, WIPO Case No. [D2020-0914](#)).

Given the famous nature and wide use of the LEGO trademark by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, and well predated the registration dates of the Disputed Domain Names, it is very unlikely that the Respondent registered the Disputed Domain Names in a fortuity. Also, the Panel is of the view that the nature of Disputed Domain Names, incorporating the Complaint well-known trademark, indicates themselves that the Registrant deliberately selected the Disputed Domain Names, in order to somehow confuse Internet users that the Disputed Domain Names may have a connection with the Complainant. Further, the Respondent failed to submit a response and/or to provide any evidence of actual or contemplated good faith use of the Disputed Domain Names. Therefore, the Panel considers the registration an attempt by the Respondent to take advantage of the Complainant's goodwill and reputation. See the section 3.2.1 of the [WIPO Overview 3.0](#).

It is further noted that as of the date of this Decision, the Disputed Domain Names are resolving to commercial websites offering building bricks which essentially adopt the same mechanism as the Complainant's LEGO building bricks and blocks with intertwining pieces. The said websites also present images of concrete building bricks which are almost identical with LEGO building bricks. The Panel takes the view that the Respondent has intentionally attempted to ride on the reputation of the Complainant and the LEGO trademark, to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark, which supports a finding of bad faith under paragraph 4(b)(iv) of the Policy.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Names were registered and used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is established.

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, <gachbetonglego.com> and <legocobi.com>, be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: August 1, 2022