

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. 王先生 (Wang Xian Sheng)

Case No. D2022-4189

### **1. The Parties**

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

The Respondent is 王先生 (Wang Xian Sheng), China.

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

The disputed domain names <lego-game.com>, <legoheadhelmets.com>, <legoscans.com>, <lego12.com>, <technic-lego.com>, <toplegotoys.com>, and <88lego.com> are registered with Hongkong Domain Name Information Management Co., Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) involving the disputed domain names and another two domain names on November 4, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 11, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 11, 2022, 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 November 14, 2022, removing one domain name from the proceeding. On November 28, 2022, the Complainant informed the Center that it wished to remove another domain name from the proceeding.

On November 11, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On November 11, 2022, the Complainant confirmed its 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 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 Chinese of the Complaint, and the proceedings commenced on December 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 23, 2022.

The Center appointed Sok Ling MOI as the sole panelist in this matter on January 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, established and headquartered in Denmark, is in the business of making and selling LEGO branded construction toys and other products. In particular, the Complainant markets a range of construction toy sets that allow people to build advanced models (such as sports cars, tractors, fork trucks) under the LEGO Technic brand. Although the LEGO brand is well known throughout the world for its construction toys, the Complainant has expanded its use of the LEGO brand to, *inter alia*, computer hardware and software, books, videos, and computer controlled robotic construction sets. The Complainant has subsidiaries and branches throughout the world, and its LEGO branded construction toys and other products are sold in more than 130 countries, including China.

The Complainant is the owner of numerous trade mark registrations for LEGO, LEGO TECHNIC, and other LEGO-formative marks in many jurisdictions worldwide, including the following:

Jurisdiction	Mark	Registration No.	Registration Date
China	LEGO	75682	December 22, 1976
Denmark	LEGO	VR195400604	May 1, 1954
Singapore	LEGO	T6435007D	May 23, 1964
China	LEGO TECHNIC	24929883	June 21, 2018

The Complainant is the owner of close to 5,000 domain names containing the mark LEGO. The Complainant maintains an official website under the domain name <lego.com>.

The Respondent registered the disputed domain names on the following dates:

- <technic-lego.com> - November 15, 2021;
- <88lego.com> - June 4, 2022;
- <lego12.com> - June 3, 2022;
- <legoscans.com> - March 16, 2022;
- <toplegotoys.com> - March 27, 2022;
- <lego-game.com> - November 7, 2021; and
- <legoheadhelmets.com> - November 10, 2021.

According to the evidence submitted by the Complainant:

- (a) the disputed domain name <technic-lego.com> resolved to a website displaying a gambling link;
- (b) the disputed domain names <88lego.com>, <lego12.com>, and <legoscans.com> resolved to websites displaying sexually-explicit pornographic contents and gambling advertisements;
- (c) the disputed domain name <toplegotoys.com> resolved to a blank page with no content;
- (d) the disputed domain name <lego-game.com> resolved to an inactive website; and
- (e) the disputed domain name <legoheadhelmets.com> resolved to a website indicating "Access to legoheadhelmets.com was denied".

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that the disputed domain names are confusingly similar to its world famous trade mark LEGO, the Respondent has no rights or legitimate interests in respect of the disputed domain names, and the disputed domain names have been registered and are being used in bad faith.

The Complainant requests for the transfer of the disputed domain names.

### **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Procedural Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, 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. Paragraphs 10(b) and (c) of the Rules requires the Panel to ensure that the proceeding takes place with due expedition and that the Parties are treated fairly and given a fair opportunity to present their respective case.

The language of the Registration Agreements for the disputed domain names is Chinese. From the evidence on record, no agreement appears to have been entered into between the Complainant and the Respondent regarding the language issue. The Complainant filed its Complaint in English and has requested that English be the language of the proceeding. The Respondent did not respond on the language issue.

On the record, the Respondent appears to be a Chinese individual. However, the Panel finds sufficient evidence in the present proceeding to suggest that the Respondent has knowledge of English. In particular, the Panel notes that:

- (a) the disputed domain names are registered in Latin characters, rather than Chinese script;
- (b) the disputed domain names consist of the English words, such as, "game", "head helmets", "top", and "toys"; and
- (c) some of the websites to which the disputed domain names resolve have words in English.

Additionally, the Panel notes that:

- (a) the Center has notified the Respondent of the language of the proceeding and commencement of the proceeding in both Chinese and English;
- (b) the Respondent has been given the opportunity to present his case in this proceeding and to respond on the issue of the language of the proceeding, but he has not done so; and
- (c) the Center has informed the Respondent that it would accept a response in either English or Chinese, but the Respondent has not filed a response.

The Panel finds the choice of English as the language of the present proceeding is fair to both Parties and is not prejudicial to either one of the Parties in his or her ability to articulate the arguments for this case. The Panel is also of the view that to require the Complaint to be translated into Chinese would in the circumstances of this case cause an unnecessary cost burden to the Complainant and unfairly disadvantage

the Complainant. The proceeding would also be unnecessarily delayed.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that (i) it shall accept the Complaint as filed in English, (ii) English shall be the language of the proceeding, and (iii) the decision will be rendered in English.

## **6.2. Substantive Issue: Three Elements**

Paragraph 4(a) of the Policy directs that the complainant must prove each of the following three elements to obtain an order for the disputed domain name to be cancelled or transferred:

- (i) the disputed domain name registered by the respondent is identical or confusingly similar to a trade mark 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.

On the basis of the evidence introduced by the Complainant, the Panel concludes as follows:

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

The Panel accepts that the Complainant has trade mark rights in LEGO by virtue of use and registration. Each of the disputed domain names incorporates the Complainant's trade mark in its entirety. Neither the addition of the words "game", "head helmets", "scans", "technic", "top", "toys", nor the numerals "12", "88", nor the hyphen sign "-", prevent a finding of confusingly similarity between each of the disputed domain names and the Complainant's trade mark, since the Complainant's LEGO trade mark is clearly recognisable within the disputed domain names.

The addition of the generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement and is generally disregarded for the purpose of the confusing similarity assessment.

Consequently, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's trade mark.

Accordingly, the Complainant has satisfied the requirements of the first element under paragraph 4(a) of the Policy.

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

Under paragraph 4(a)(ii) of the Policy, the complainant bears the burden of establishing that the respondent lacks rights or legitimate interests in the disputed domain name. However, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, the burden of production shifts to the respondent to establish its rights or legitimate interests in the disputed domain name by demonstrating any of the following, without limitation, under paragraph 4(c) of the Policy:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to 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, even if it has acquired no trade mark or service mark rights; 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 trade mark or service mark at issue.

(See *Taylor Wimpey PLC, Taylor Wimpey Holdings Limited v. honghao internet foshan co, ltd*, WIPO Case No. [D2013-0974](#).)

The Respondent's name does not bear any resemblance to the term "Lego". There is no evidence suggesting that the Respondent is commonly known by any of the disputed domain names or that he has any rights in the term "Lego" or in the disputed domain names. The Complainant has confirmed that the Respondent is not an authorised dealer of the Complainant's products and has never had a business relationship with the Complainant, and is not in any way related to or affiliated with the Complainant or otherwise authorized or licensed to use the LEGO trade mark or to seek registration of any domain name incorporating the trade mark.

According to the evidence submitted by the Complainant, the disputed domain name <technic-lego.com> resolved to a website displaying a gambling link while the disputed domain names <88lego.com>, <lego12.com>, and <legoscans.com> resolved to websites displaying sexually-explicit pornographic contents and gambling advertisements. These contents are likely to generate revenue for the Respondent. Using a domain name which incorporates a trade mark to divert Internet traffic to websites featuring gambling or pornographic contents does not constitute a *bona fide* offering of goods or services.

According to the evidence submitted by the Complainant, the disputed domain names <tolegotoys.com>, <lego-game.com>, and <legoheadhelmets.com> resolved to inactive websites. There is no evidence to suggest that the Respondent has made any preparations to use these disputed domain names in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use purpose.

The Panel is therefore satisfied that the Complainant has made out a *prima facie* case showing that the Respondent lacks rights or legitimate interests in the disputed domain names. The burden of production thus shifts to the Respondent to establish his rights or legitimate interests in the disputed domain names. Since the Respondent has failed to respond, the *prima facie* case has not been rebutted.

Consequently, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain names.

Accordingly, the Complainant has satisfied the requirements of the second element under paragraph 4(a) of the Policy.

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

Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of a disputed domain name in bad faith, namely:

- (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 domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding 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 the respondent's 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 the respondent's website or location or of a product or service on the respondent's website or location.

According to the evidence submitted by the Complainant, the disputed domain name <technic-lego.com> resolved to a website displaying a gambling link while the disputed domain names <88lego.com>, <lego12.com>, and <legoscans.com> resolved to websites displaying sexually-explicit pornographic contents and gambling advertisements. The consensus view of previous UDRP panels is that a domain name registrant is normally deemed responsible for content appearing on a website at its domain name, even if such registrant may not be exercising direct control over such content – for example, in the case of advertising links appearing on an “automatically” generated basis. There is a presumption that the Respondent or a third party stands to profit or make a “commercial gain” from advertising revenue by such an arrangement trading on third-party trade marks. The Panel therefore determines that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement of the Respondent's website, and the Panel finds that the circumstances referred to in paragraph 4(b)(iv) of the Policy are applicable to the present case.

Furthermore, previous UDRP panels have held that pornographic contents on a respondent's website is in itself sufficient to support a finding of bad faith. Furthermore, the linking of the disputed domain names to pornographic websites might result in the tarnishing of the Complainant's well-known trade mark.

According to the evidence submitted by the Complainant, the disputed domain names <toplegotoys.com>, <lego-game.com>, and <legoheadhelmets.com> have not been actively used. Nevertheless, the consensus view of previous UDRP panels is that passive holding in itself does not preclude a finding of bad faith. UDRP panels must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 3.3. Considering the circumstances of this case, in particular the well-known nature of the Complainant's LEGO trade mark and the implausibility of any good faith use that the disputed domain names may be put, the Panel finds that the non-use of the disputed domain names <toplegotoys.com>, <lego-game.com>, and <legoheadhelmets.com> does not prevent a finding of bad faith.

The Respondent registered the disputed domain names between November 7, 2021 and June 4, 2022. This date range is subsequent to when the Complainant registered its LEGO trade mark in China. The Panel accepts that the Complainant's LEGO brand is a distinctive and well-known trade mark as a result of extensive use and advertisement over the past few decades. As the LEGO branded products are also marketed and sold in China, a strong presumption thus arises that the Respondent was aware of the Complainant and its trade mark rights when he registered the disputed domain names. Registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a complainant's well-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Although the Complainant submitted evidence to show that the disputed domain name <toplegotoys.com> is being offered for sale for the amount of USD 728 on another website, the Panel is unable to determine if the sale posting is made by the Respondent, or if this amount far exceeds the Respondent's documented out-of-pocket expense in registering the disputed domain name. Hence, the Panel is not prepared to make any finding on this point.

According to the evidence submitted by the Complainant, the Respondent was previously involved in other UDRP proceedings involving well-known third party trade marks, where the panels found bad faith and ordered a transfer, including the following:

- *Bulgari S.p.A. v. 王先生 (Wang Xian Sheng)*, WIPO Case No. [D2022-3054](#);
- *Bulgari S.p.A. v. 王先生 (Wang Xian Sheng)*, WIPO Case No. [D2021-3423](#);
- *Breitling SA v. 王先生 (Wang Xian Sheng)*, WIPO Case No. [D2022-0387](#); and

- *Compagnie Générale des Etablissements Michelin v. 王先生 (Wang Xian Sheng)*, WIPO Case No. [D2021-2583](#).

This clearly demonstrates that the Respondent is engaging in a pattern of cybersquatting.

The Respondent has not filed a response to deny the Complainant's allegations of bad faith. Taking into account all the circumstances, the Panel concludes that the Respondent has registered and is using the disputed domain names in bad faith.

Accordingly, the Complainant has satisfied the requirements of the third element under paragraph 4(a) 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 names <lego-game.com>, <legoheadhelmets.com>, <legoscans.com>, <lego12.com>, <technic-lego.com>, <toplegotoys.com>, and <88lego.com> be transferred to the Complainant.

*/Sok Ling MOI/*

**Sok Ling MOI**

Sole Panelist

Date: March 20, 2023