

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. wu si wei
Case No. D2023-0314

1. The Parties

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

The Respondent is wu si wei, China.

2. The Domain Name and Registrar

The disputed domain name <womenlego.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 29, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 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 in English on February 2, 2023.

On January 31, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 2, 2023, the Complainant submitted a 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 February 7, 2023. In accordance with

the Rules, paragraph 5, the due date for Response was February 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 28, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on March 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 is a multinational toy company headquartered in Denmark. The Complainant has a network of licensees, which are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in China and elsewhere. Over the years, the Complainant's business of making and selling Lego-branded toys has grown remarkably. The Complainant currently has subsidiaries and branches throughout the world, and Lego-branded products are currently sold in more than 130 countries, including in China. The Complainant provides evidence that its Lego brand has received an array of awards and prizes, including recognition as the "number 1 Consumer Superbrand" by Superbrands UK in 2019. The Complainant also provides evidence that the LEGO brand was recognized as a well-known trademark by panels in various prior UDRP cases, such as *LEGO Juris A/S v. Michael Longo*, WIPO Case No. [D2008-1715](#) and *LEGO Juris A/S v. Reginald Hastings Jr.*, WIPO Case No. [D2009-0680](#).

The Complainant provides evidence that it owns a large trademark portfolio for LEGO (word and logo marks), including, but not limited to, Chinese trademark registration number 1112413 for the LEGO word mark, registered on September 28, 1997, and Chinese trademark registration number 135134 for the LEGO logo mark registered on January 5, 1980. The Complainant also owns a large portfolio of approximately 5,000 official domain names, including, <lego.com>, registered on August 22, 1995.

The disputed domain name was registered on June 14, 2022, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name previously directed to an active webpage containing pornographic content. However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive webpage.

The Panel also notes that the Complainant attempted to settle this matter amicably by sending a cease-and-desist letter to the Respondent through the Registrar's web portal on August 3, 2022 and also sent a reminder, but received no response from the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its trademark for LEGO, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's webpage containing pornographic material.

The Complainant essentially contends that the disputed domain name is confusingly similar to the Complainant's internationally famous trademarks as it incorporates the Complainant's LEGO trademark in its entirety, with the only differing element being the addition of the word "women" to the disputed domain name. The Complainant also provides evidence that the disputed domain name is linked to an active webpage containing pornographic content, which, the Complainant argues, confers no rights or legitimate interests in the disputed domain name on the Respondent, and which means that the Respondent is tarnishing the Complainant's trademarks and gaining a commercial benefit through such use of the Complainant's marks. The Complainant also argues that the Respondent had or can be expected to have had prior notice of the

Complainant's trademarks at the time the disputed domain name was registered, since the Complainant registered its trademarks for LEGO many years prior to the registration of the disputed domain name and since these marks are internationally famous, including in the Respondent's jurisdiction China. The Complainant essentially contends that the registration and use of the disputed domain name in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the administrative proceeding

Pursuant to paragraph 11(a) of the Rules, 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.

According to the Registrar's verification response, the Registration Agreement for the disputed domain name is in Chinese. Nevertheless, the Complainant filed its Complaint and its amended Complaint in English, and requests that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

The Panel has carefully considered all elements of this case, and considers the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited in a timely manner by the Center to present its response and arguments in either English or Chinese, but chose not to do so); the fact that the disputed domain name contains the Complainant's trademark in its entirety and that the disputed domain name is written in Latin letters and not in Chinese characters; the fact that the disputed domain name contains the English word "women"; and, finally, the fact that Chinese as the language of this proceeding could lead to unwarranted delays and costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and the language of this administrative proceeding shall be English.

6.2. Discussion and Findings on the merits

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is identical 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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has shown that it has valid rights in the mark LEGO, based on its use and registration of the same as a trademark in multiple jurisdictions.

As to confusing similarity of the disputed domain name with the Complainant's marks, the Panel considers that the disputed domain name consists of the combination of two elements, respectively the Complainant's LEGO trademark combined with the term "women". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)"), section 1.8, "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". The Panel concludes that the disputed domain name contains the entirety of the Complainant's trademarks for LEGO, which remains easily recognizable, and that the addition of the term "women" therefore does not prevent a finding of confusing similarity. The Panel also notes that the applicable generic Top-Level Domain ("gTLD") (".com" in this case) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark for LEGO, and concludes that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a *bona fide* provider of goods or services under the disputed domain name and is not making legitimate noncommercial or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Moreover, upon review of the facts and evidence, the Panel notes that the disputed domain name resolved to an active webpage containing pornographic content. In the Panel's view, no rights or legitimate interests derive from using a third-party trademark to divert Internet users for commercial gain to a pornographic website, see in this regard also several prior UDRP decisions such as *Barnes Europe Consulting Kft., and Heidi Barnes-Watson v. jianhua Wang*, WIPO Case No. [D2022-3059](#), *Seintec Norte, S.L. v. Yu Liu, wangluochuanmei* WIPO Case No. [D2021-1815](#); *Andrey Ternovskiy dba Chatroulette v. Protection of Private Person / Aleksandr Katkov*, WIPO Case No. [D2017-0381](#); and *Averitt Express, Inc. v. Protection of Private Person / Roman Emec*, WIPO Case No. [D2018-0249](#). However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, also does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel considers that by registering the disputed domain name, which the Panel sees as a clear attempt to squat a domain name confusingly similar to the Complainant's internationally famous trademarks, the Respondent deliberately and consciously targeted the Complainant's prior trademarks for LEGO. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anel[s] have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a

presumption of bad faith.” Furthermore, the Panel also notes that the Complainant’s trademarks for LEGO were registered many decades before the registration date of the disputed domain name. The Panel deducts from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant’s trademarks at the time of registering the disputed domain name. The Panel also notes that even a cursory Internet search at the time of registration of the disputed domain name would have made it clear to the Respondent that the Complainant owned prior rights in its trademarks for LEGO and is also commercially active in the Respondent’s jurisdiction, China. In the Panel’s view, these elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the website linked to the disputed domain name displayed pornographic content, which shows that the Respondent was abusing the Complainant’s trademark to mislead and divert Internet users for commercial gain to such website, and thereby also tarnished the Complainant’s marks (see in this regard also previous UDRP decisions such as *Barnes Europe Consulting Kft.*, and *Heidi Barnes-Watson v. jianhua Wang*, WIPO Case No. [D2022-3059](#), *Seintec Norte, S.L. v. yu Liu, wangluochuanmei* WIPO Case No. [D2021-1815](#) and *Averitt Express, Inc. v. Protection of Private Person / Roman Emec*, WIPO Case No. [D2018-0249](#)). However, on the date of this Decision, the disputed domain name links to an inactive website. In this regard, the [WIPO Overview 3.0](#), section 3.3 provides: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding”. The Panel has reviewed all elements of this case, and attributes particular relevance to the following elements: the fact that the disputed domain name contains the entirety of the Complainant’s trademark, the high degree of distinctiveness, fame and intensive use of the Complainant’s trademark, the Respondent’s failure to respond to the Complainant’s cease-and-desist letter of August 3, 2022 and the subsequent Complaint, the change of the use of the disputed domain name from a website featuring pornographic content to an inactive website, and the unlikelihood of any good faith use to which the disputed domain name might be put by the Respondent. In these circumstances, the Panel considers that the passive holding of the disputed domain name by the Respondent does not prevent a finding of use of the disputed domain name in bad faith. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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, <womenlego.com>, be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: March 22, 2023