

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Dan Wei
Case No. D2023-0771

1. The Parties

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

The Respondent is Dan Wei, China.

2. The Domain Name and Registrar

The disputed domain name <thelego.space> is registered with Dynadot LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2023. On February 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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, Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 1, 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 March 2, 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 March 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 28, 2023.

The Center appointed Cherise Valles as the sole panelist in this matter on April 4, 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

LEGO Juris A/S (hereinafter referred to as the Complainant), based in Denmark, is the owner of LEGO, and all other trademarks used in connection with the LEGO brands of 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 the United States of America ("United States"). The Complainant is the owner of close to 5,000 domain names containing the mark LEGO.

Annex 3 of the Complaint lists the registered trademarks on which this Complaint is based, for example, United States Trademark Registration No. 1018875 for LEGO in Class 28, registered on September 17, 1974, and Chinese Trademark Registration No. 75682 for LEGO in Class 28, registered on December 22, 1976. The list is divided by country, and includes the United States and China, in which the Respondent's privacy service and Respondent himself are based.

The disputed domain name was registered on July 16, 2022.

The website associated with the disputed domain name is used to offer a number of products, including LEGO toy products.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the trademark LEGO is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. According to the provisions of Article 6*bis* of the Paris Convention for protection of Industrial Property, confirmed and extended by Article 16.2 and Article 16.3 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, the statute of a well-known trademark provides the owner of such a trademark with the right to prevent any use of the well-known trademark or a confusingly similar denomination in connection with any products or services (*i.e.*, regardless of the list of the products and services for which the trademark is registered). Thus, the protection for the LEGO mark goes far beyond toys and goods.

The Complainant further asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

- The disputed domain name is confusingly similar to the Complainant's registered LEGO trademark, in light of the fact that it wholly incorporates the Complainant's mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

- The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that include its trademarks.

The disputed domain name has been registered and is being used in bad faith.

- The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a Complaint to succeed, the Complainant must prove each of the following 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.

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

A. Identical or Confusingly Similar

To prove this element, the Complainant must have relevant rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

The Complainant submits that the disputed domain name is confusingly similar to the trademark in which it has rights. The disputed domain name incorporates the LEGO trademark in its entirety with the addition of the prefix "the", followed by the Top-Level Domain ("TLD") ".space". Given the Complainant's trademark registration as detailed above, the Panel finds that the Complainant has established its trademark rights in the term "Lego" for the purposes of paragraph 4(a)(i) of the Policy.

The Complainant asserts that the disputed domain name is confusing similar to its registered trademark. It argues that the dominant part of the disputed domain name comprises the term "Lego", which is identical to the registered trademark LEGO. It states that the fame of the trademark has been confirmed in numerous previous UDRP decisions, such as *LEGO Juris A/S v. Michael Longo*, WIPO Case No. [D2008-1715](#). As stated in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

Further, as stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[w]here 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". Thus, the inclusion of the prefix "the" in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's LEGO trademark.

The Complainant similarly argues that the addition of the TLD “.space” 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. It is standard practice when comparing a disputed domain name to a complainant’s trademark not to take the TLD into account. See section 1.11.1 of the [WIPO Overview 3.0](#), which states that the “applicable [TLD] in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element of the confusing similarity test”. In this case, the TLD “.space” is disregarded under the first element of the confusing similarity test.

In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trademark and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent’s rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

“[a]ny of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (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 Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name (see, for example, *Paris Saint-Germain Football v. Daniel Macias Barajas, International Camps Network*, WIPO Case No. [D2021-0019](#); *Spinrite Inc. v. WhoisGuard, Inc. / Gabriella Garlo*, WIPO Case No. [D2021-0012](#); and the discussion in section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent is not licensed, or otherwise authorized, be it directly or indirectly, to register or use the Complainant’s LEGO trademark in any manner, including in, or as part of, the disputed domain name. Moreover, the Complainant has indicated that it has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. The

Complainant has made clear that the Respondent is not a licensee, authorized agent of the Complainant, or in any other way authorized to use the Complainant's trademark. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name.

The Complainant also notes that the public Whois information identifies the registrant as "REDACTED FOR PRIVACY / Dynadot Privacy Service", which is not similar to the disputed domain name. The Respondent "Dan Wei" disclosed by the Registrar does not resemble the disputed domain name in any manner either.

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, the Respondent cannot assert that, prior to any notice of this dispute, he was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy because the website associated with the disputed domain name is used to offer a number of products, including LEGO toy products.

Furthermore, the nature of the disputed domain name, consisting of the Complainant's trademark with the addition of the prefix "the", carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

In light of the foregoing, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it is being used in bad faith. The term "bad faith" is "broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses, a complainant's mark". See section 3.1 of the [WIPO Overview 3.0](#). Paragraph 4(b) of the Policy sets out four non-exhaustive examples of 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, namely:

- (i) circumstances indicating that the respondent registered or 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 the documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the 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 the respondent's website or location or of a product or service on its website or location.

In the present case, the Complainant's submissions relate to paragraph 4(b)(iv) of the Policy.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Respondent registered the disputed domain name on July 16, 2022 (Annex 2.1 to the Complaint). This date is considerably later than the date when the Complainant had registered the trademark LEGO (Annex 3 to the Complaint). It seems clear that it is the fame of the trademark that has motivated the Respondent to register the disputed domain name. The Respondent's use of the disputed domain name for a website offering a number of products, including LEGO toy products, is not legitimate noncommercial or fair use, but to mislead and divert consumers for his own commercial gain by creating a likelihood of confusion with the Complainant's trademark.

The Respondent has not participated in the administrative proceeding and has not answered the Complainant's contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration or use of the disputed domain name in the face of the Complainant's contentions can be regarded as an indicator of bad faith (see, for example, *Novartis AG. v. Mathew French*, WIPO Case No. [DIO2020-0011](#)).

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under paragraph 4(a)(iii) 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 <thelego.space> be transferred to the Complainant.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: April 18, 2023