

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. chen bing

Case No. D2023-2692

1. The Parties

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

The Respondent is chen bing, China.

2. The Domain Name and Registrar

The disputed domain name <legobus.com> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 22, 2023. On June 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 26, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 26, 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 June 28, 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 June 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 19, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on August 2, 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 Danish company that owns the famous LEGO brand of construction toys.

The Complainant has subsidiaries and branches throughout the world. LEGO products are sold in more than 130 countries, including in China.

The Complainant owns several LEGO trademark registrations in multiple countries, including the Chinese registration no. 75682, registered on February 6, 1976. The Complainant is also the owner of numerous domain names containing the term “lego”.

The Respondent registered the disputed domain name on February 25, 2023.

The Panel accessed the disputed domain name on August 14, 2023, which resolved to a webpage containing pornographic content.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The dominant part of the disputed domain name comprises the term LEGO, identical to the registered trademark LEGO, registered by the Complainant as trademarks and domain names in numerous countries all over the world. The fame of the trademark has been confirmed in numerous previous UDRP decisions. In addition to the trademark LEGO, the disputed domain name also comprises the generic suffix “bus”. It is a long-established precedent that confusing similarity is generally recognized when well-known trademarks are paired up with different kinds of generic prefixes and suffixes. In this case, the suffix “bus” does not detract from the overall impression. The addition of the generic Top-Level Domains (Gtld) “.com” 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. Anyone who sees the disputed domain name is bound to mistake it for a name related to the Complainant.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. Neither has the Complainant found anything, including the Whois details, that would suggest that the Respondent has been using LEGO in any other way that would give them any legitimate rights in the name. Consequently, the Respondent may not claim any rights established by common usage. No license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. Further, the Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. In the instant case, the Registrar identified the Registrant as “Chen Bing”, which does not resemble the disputed domain name in any manner. Thus, where no evidence, including the Whois record for the disputed domain name, suggests that the Respondent is commonly known by the disputed domain name, then the Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name. LEGO is a famous trademark worldwide. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through a website that features adult content, not related to the Complainant in any way. Numerous past Panels have held that use of a disputed domain name that is confusingly similar to a complainant's trademarks to link to a website featuring pornographic or adult content evinces a lack of legitimate rights or interests. The

Respondent's use of the disputed domain name to host pornographic content is particularly egregious, as this is likely to alienate the Complainant's customers and have adverse effects on the Complainant's business as a result of the likely confusion. This has the real potential to tarnish the good will and reputation attached to the Complainant's brand.

- The disputed domain name was registered and is being used in bad faith. The trademark LEGO in respect of toys belonging to the Complainant has the status of a well-known and reputable trademark with a substantial and widespread goodwill throughout the world. At the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith *per se*. The Respondent registered the disputed domain name on February 25, 2023. This date is subsequent to when the Complainant registered the trademark LEGO in China, where the Respondent resides, and elsewhere, by decades. The Complainant first tried to contact the Respondent on March 21, 2023, through a cease and desist letter sent by e-mail. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process. The Respondent is using the disputed domain name to intentionally attempt to attract Internet users to its websites for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website. The website of the disputed domain name features sexually explicit, pornographic content, which provides evidence of the Respondent's bad faith registration and use of this domain. Although pornographic content is not prohibited, condemnation is directed at respondents that divert Internet users to such websites by fostering a belief that the domain names belongs to, is associated with, or connected to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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 in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel has no doubt that "LEGO" is a term directly connected with the Complainant's trademarks and construction toys.

Annex 3 to the Complaint shows trademark registrations for LEGO in China that date as early as in 1976.

The trademark LEGO is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark LEGO merely by the by the addition of the suffix "bus" and of the gTLD extension ".com".

Previous UDRP decisions have found that the mere addition of other terms (such as "bus") to a trademark in a domain name does not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British*

Broadcasting Corporation v. Jaime Renteria, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD extension such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is 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 at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is currently linked to a website containing adult and pornographic contents.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has 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 documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2023) the trademark LEGO was already well-known worldwide and directly connected to the Complainant's construction toys.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's famous trademark, as well as that the adoption of the expression "legobus" together with the gTLD extension ".com" could be a mere coincidence.

Also, previous UDRP decisions have already established that the redirection to pornographic sites from a domain name incorporating a well-known mark is evidence of bad faith (see *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. [D2003-0022](#)).

Such circumstances, associated with the failure to reply to the cease-and-desist letter sent by the Complainant, and to submit a Response to this procedure, as well as with the lack of any plausible interpretation for the adoption of the term "legobus" by the Respondent, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <legobus.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: August 18, 2023