

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. xiang shuai liu, gg00hu

Case No. D2023-2709

1. The Parties

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

The Respondent is xiang shuai liu, gg00hu, China.

2. The Domain Name and Registrar

The disputed domain name <china-lego.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 23, 2023. On June 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 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 (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 30, 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 July 5, 2023.

On June 30, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 5, 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 Japanese of the Complaint, and the proceedings commenced on July 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 27, 2023.

The Center appointed Keiji Kondo as the sole panelist in this matter on August 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 the owner of the trademark LEGO, and all other trademarks used in connection with the LEGO brands of construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in China and Japan, and elsewhere.

The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in China and Japan. 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. The Complainant's trademark has been recognized as being famous, and is often included in a list of famous brands.

The Complainant has trademark registrations for LEGO in many countries in the world, and the following Japanese trademark registration is included in the list of the Complainant's trademark registrations:

- Japanese Trademark Registration No. 520470, for Toys, etc., registered on May 21, 1958;
- Chinese Trademark Registration No. 75682, for Toys, etc., which is valid from December 22, 2016 to December 21, 2026.

The disputed domain name is <china-lego.com>. The disputed domain name was registered on March 12, 2023. The disputed domain name is used to redirect to a website which displays predominantly pornographic content with third-party advertisements related to gaming and gambling.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (Policy, paragraph 4(a)(i); Rules, paragraphs 3(b)(viii), (b)(ix)(1)).

The dominant part of the disputed domain name comprises the term Lego, identical to the registered trademark LEGO. In addition to the trademark LEGO, the disputed domain name also comprises a hyphen and the geographical location, "china" which does not diminish the confusing similarity between the disputed domain name and the Complainant's trademark.

In *Dr. Ing. h.c. F. Porsche AG v. Rojeen Rayaneh*, WIPO case No. [D2004-0488](#), it was stated that 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, neither the hyphen nor the suffix "china" detract from the overall impression. On the contrary, the conjunction of the geographic location China, with the Complainant's trademark would likely heighten confusion in the minds of internet users as those familiar with the Complainant's services would reasonably believe the disputed domain name is associated with the Complainant's operations in China.

The addition of the generic Top-Level Domain ("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 Complainant's trademark and the disputed domain name.

The Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii); Rules, paragraph 3(b)(ix)(2)).

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 the term Lego in any other way that would give the Respondent any legitimate rights in the disputed domain name. Consequently, the Respondent may not claim any rights established by common usage.

In the instant case, the Respondent is identified as "Xiang Shuai Liu", 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 within the meaning of paragraph 4(c)(ii) of the Policy.

The Complainant has given the Respondent no license or authorization of any other kind to use the Complainant's trademark LEGO.

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 commercial website displaying content unrelated to the Complainant. Specifically, the disputed domain name is used to redirect to a website which displays predominantly pornographic content. The website at the disputed domain name additionally advertises links that redirect users to the websites of third-party services not related to the Complainant in anyway.

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 goodwill and reputation attached to the Complainant's brand.

As no evidence has been found that the Respondent is using the term Lego as a company name or has any other legal rights in the name, it is quite clear that the Respondent is simply trying to benefit from the Complainant's world famous trademark. In *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#), the Panel stated that "rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant".

The disputed domain name was registered and is being used in bad faith (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3)).

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.

The Respondent registered the disputed domain name on March 12, 2023. This date is subsequent to when the Complainant registered the trademark LEGO in China, Japan, and elsewhere. It is quite obvious that it is the fame of the trademark that has motivated the Respondent to register the disputed domain name. That is, the Respondent cannot claim to have been using the trademark LEGO, without being aware of the Complainant's rights to it.

As mentioned above, the disputed domain name is connected to a commercial website displaying adult related content, not related to the Complainant in any way. Nevertheless, no disclaimer is found on the website. This is particularly egregious as the Respondent has chosen a trademark, which is world famous

for its construction toys, to attract visitors to the website hosting adult / pornographic content. Consequently, 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 at the disputed domain name features sexually explicit and pornographic content, which provides evidence of the Respondent's bad faith registration and use of the disputed domain name. Past UDRP panels have consistently held that a respondent's use of a confusingly similar domain name to direct unsuspecting Internet users to a website with adult content, as here, is evidence of bad faith registration and use of that domain name. See *Microsoft Corp. v. Horner*, WIPO Case No. [D2002-0029](#) (holding the respondent's use of the complainant's mark to post adult-oriented photographs and publish links to additional adult-oriented websites evidenced bad faith use and registration).

The Complainant submits that although pornographic content is not prohibited, condemnation is directed at the Respondent that divert Internet users to such website by fostering a belief that the disputed domain name belongs to, is associated with, or connected to the Complainant. The same view was accepted in *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a "Nelly" v. Patrick Vanderhorst*, WIPO Case No. [D2005-0636](#), with the panel noting "bad faith under the Policy may very well arise where a domain name, which infringes on the mark of another by virtue of being identical or confusingly similar to that mark, is used by a respondent as an instrumentality to intentionally link and direct unsuspecting users, who seek information on a good or service associated with that mark, to a pornographic site instead. In such instances, those users would not be exposed to a respondent's pornographic content but for that linkage".

The Complainant, therefore, submits that the Respondent's use of the disputed domain name in this manner amounts to "porno-squatting". This is a practice where confusion with a well-known trademark is used to divert unsuspecting Internet users to a pornographic website for commercial purposes (see *Prada S.A. v. Roberto Baggio*, WIPO Case No. [D2009-1187](#)).

The Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity, which past UDRP panels have held serves as further evidence of bad faith registration and use. See *Dr. Ing. H.C. F. Porsche AG v. Domains by Proxy, Inc.*, WIPO Case No. [D2003-0230](#). See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 3.6 ("Panels have also viewed a respondent's use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith.").

To summarize, LEGO is a famous trademark worldwide. It is clear that the Respondent was aware of the rights the Complainant has in the trademark and the value of said trademark, at the point of the registration. There is no connection between the Respondent and the Complainant. By using the disputed domain name the Respondent is not making a legitimate noncommercial or fair use, but is misleadingly diverting consumers for commercial gain.

Consequently, by referring to the above, the Respondent should be considered to have registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The Complaint was filed in English, while the language of the Registration Agreement is in Japanese. In the amended Complaint, the Complainant states reasons why the Complaint was filed in English, implicitly

requesting the Panel to exercise the authority under paragraph 11 (a) of the Rules to determine the language of the proceeding.

On June 30, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 5, 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.

Considering the following circumstances, the Panel, exercising its authority to determine the language of the proceeding under paragraph 11(a) of the Rules, has decided English as the language of the proceeding:

- the Complaint was filed in English;
- the Complainant is a company in Denmark, and is represented by a Swedish firm;
- the Respondent's address is in China;
- the Complainant has submitted its request that English be the language of the proceeding, but the Respondent did not comment on the language of the proceeding;
- the Respondent did not reply to the Complainant's contentions in any manner either in English or Japanese despite that the Center notified the Respondent of the commencement of the proceeding in both English and Japanese;
- according to the evidence provided by the Complainant, many English words are used on the webpage at the disputed domain name, for example, under the caption "keyword search", many English words are listed. Although it is not clear to the Panel if the screenshot provided by the Complainant is in its original version or a machine translated version, in any event it would not have any impact on the Panel's determination on the language of the proceeding considering other circumstances of this case; and
- ordering the translation of the Complaint would only result in extra delay of the proceeding and additional cost for the Complainant.

6.2. Substantive Issues

A. Identical or Confusingly Similar

The first element functions primarily as a standing requirement. In this case, the disputed domain name is <china-lego.com>. The Complainant has many trademark registrations for the trademark LEGO, *inter alia*, the Japanese trademark registration registered in 1958.

The Complainant's trademark LEGO is incorporated into the disputed domain name in its entirety with the addition of "china-" and the gTLD ".com". The addition of the geographical term "China" with a hyphen does not affect the finding of confusing similarity, because the Complainant's trademark is recognizable in the disputed domain name. It is well-established that the gTLD ".com" is not relevant in the assessment of confusing similarity.

Therefore, the disputed domain name is confusingly similar to the Complainant's trademark LEGO.

Accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Respondent's name, Xiang Shuai Liu, with the organization name gg00hu is in no way similar to the

disputed domain name, nor is it similar to the Complainant's trademark LEGO. Therefore, it is inconceivable that the Respondent has been commonly known by the disputed domain name.

The disputed domain name is used to redirect to a website which displays predominantly pornographic content with third-party advertisements related to gaming and gambling. The Complainant has never had any business relationship with the Respondent. Therefore, the Respondent does not use the disputed domain name in connection with a *bona fide* offering of goods or services.

Use for leading Internet users to a website displaying predominantly pornographic content with gaming and gambling advertisements cannot be regarded as a legitimate noncommercial or fair use. Obviously, the Respondent has used the disputed domain name for commercial gain.

Therefore, the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, to which the Respondent has not rebutted.

Consequently, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Complainant's trademark LEGO is well known around the world. The Complainant's Japanese trademark registration for LEGO was registered in 1958 and the Complainant's Chinese trademark registration for LEGO has been valid from at least 2016, well before the disputed domain name was registered in March 2023. Therefore, it is inconceivable that the Respondent did not know the Complainant and its trademark when it registered the disputed domain name. It is obvious that the Respondent knew and targeted the Complainant at the time of registration of the disputed domain name.

Furthermore, the Respondent, at the time of registration of the disputed domain name, employed a privacy service to hide its identity. This fact, combined with the fact that the disputed domain name is used to redirect to a website which displays predominantly pornographic content with gaming and gambling advertisements, evidences that the Respondent has registered the disputed domain name intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The Respondent continues to use the disputed domain name in the same manner as intended.

Therefore, the Panel concludes that the disputed domain name has been registered and is being used in bad faith.

Accordingly, paragraph 4(a)(iii) of the Policy is satisfied.

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 <china-lego.com> be transferred to the Complainant.

/Keiji Kondo/

Keiji Kondo

Sole Panelist

Date: August 24, 2023