

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Wu Xiao Xia (吴晓霞)

Case No. D2023-4218

### **1. The Parties**

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

Respondent is Wu Xiao Xia (吴晓霞), China.

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

The disputed domain names <legoonlineinc.com>, <legooutletinc.com>, <legooutletonline.com>, <legooutletsale.com>, <legooutletshop.com>, <legorobotssale.com>, <legosaleinc.com> and <legostoreinc.com> (the “Domain Names”) are registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2023. On October 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On October 12, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (N/A) and contact information in the Complaint. The Center sent an email communication to Complainant on October 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint in English on October 20, 2023.

On October 18, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for each of the Domain Names is Chinese. On October 20, 2023, Complainant confirmed its request that English be the language of the proceeding. Respondent did not submit any comment on Complainant’s submission.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform 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 Respondent in Chinese and English of the Complaint, and the proceedings commenced on October 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 14, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on November 23, 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**

Complainant, based in Denmark, manufactures, and sells construction toys, computer hardware and software, books, videos, and robotic construction sets under the LEGO trademark. Complainant has subsidiaries and branches throughout the world, and Complainant's products are sold in more than 130 countries, including in China, where Respondent resides.

Complainant is the owner of numerous registered trademarks for the LEGO mark globally, including:

- Danish trademark registration No. VR195400604 for LEGO word mark, registered on May 1, 1954;
- United States of America registration number 1018875 for LEGO word mark, registered on August 26, 1975; and
- Chinese trademark registration No. 135134 for LEGO word and design mark, registered on January 5, 1980.

Complainant is also the owner of many domain names containing the LEGO mark, including <lego.com>.

The Domain Names were all registered on April 20, 2023 and at the time of the filing of the Complaint, each reverted to a commercial webpage offering Lego products. Several of the Domain Names, specifically, <legooutletonline.com>, <legorobotssale.com> and <legoonlineinc.com> - have been set up with mail exchanger (MX) records, indicating that these Domain Names may be actively used for email purposes.

On May 15, 2023, Complainant sent a cease-and-desist letter to Respondent, advising Respondent that the unauthorized use of the LEGO trademark within the Domain Names violated Complainant's trademark rights. Complainant requested a voluntary transfer of the Domain Names and offered compensation for the expenses of registration and transfer fees. Despite the cease-and-desist letter and its reminders, Respondent did not reply. Complainant then filed the current proceeding.

At the time of the Decision, each of the Domain Names reverted to an error or inactive page.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that (i) each of the Domain Names is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Names; and (iii) Respondent registered and is using the Domain Names in bad faith.

In particular, Complainant contends that it has trademark registrations for LEGO and that Respondent registered and is using the Domain Names with the intention to confuse Internet users looking for *bona fide* and well-known LEGO products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademark, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Names. Rather, Complainant contends that Respondent has acted in bad faith in registering and setting up the Domain Names, when Respondent clearly knew of Complainant's rights.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

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

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the 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.

Complainant submitted its original Complaint in English. In its Complaint, email dated October 20, 2023, and amended Complaint, Complainant confirmed its request that the language of the proceeding should be English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Names is Chinese.

Complainant asserts that they are unable to communicate in Chinese, that each of the Domain Names is registered in Latin characters, that the Domain Names each resolves to a website providing content in English, and that the term "lego" which is the dominant portion of each of the Domain Names, does not have any specific meaning in the Chinese language, that Respondent is using each of the Domain Names which include English dictionary terms such as "outlet", "online", "sale", "shop", "robots", "inc", and "store" in conjunction with its trademark LEGO—which is confusingly similar to Complainant's LEGO trademarks and targeting English speaking consumers seeking Complainant or its products. Complainant also contends that holding the proceeding in Chinese would cause undue delay, considerable expense, unfair disadvantage, and burden Complainant as well as the dispensation of the current matter. Complainant also contends that it had sent a cease and desist letter and reminders to Respondent with ample time for Respondent to request communications in Chinese, and Respondent did not reply.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Names, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding, nor did Respondent choose to file a Response.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

## 6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) states that failure to respond to the complainant’s contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

### A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the LEGO trademarks, as noted above. Complainant has also submitted evidence which supports that the LEGO trademarks are widely known and a source identifier of Complainant’s products and services. Complainant has therefore proven that it has the requisite rights in the LEGO trademarks.

Here, each of the Domain Names is confusingly similar to Complainant’s LEGO trademark. The LEGO trademark is recognizable in the Domain Names. In particular, the Domain Names’ inclusion of Complainant’s trademark LEGO in its entirety, with the addition of the terms “outlet”, “online”, “sale”, “shop”, “robots”, “inc” (where “inc” is a common industrial abbreviation to the term “incorporation”), and “store” in the respective Domain Names (either alone or in combination), as follows:

Domain Name	Terms in addition to the LEGO mark
<legoonlineinc.com>	“online” and “inc”
<legooutletinc.com>	“outlet” and “inc”
<legooutletonline.com>	“outlet” and “online”
<legooutletsale.com>	“outlet” and “sale”
<legooutletshop.com>	“outlet” and “shop”
<legorobotssale.com>	“robots” and “sale”
<legosaleinc.com>	“sale” and “inc”
<legostoreinc.com>	“store” and “inc”

does not prevent a finding of confusing similarity between the Domain Names and the LEGO trademark. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

## B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a Domain Name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its LEGO trademarks, and does not have any rights or legitimate interests in the Domain Names. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the LEGO trademarks or to seek registration of any domain names incorporating the trademarks. Respondent is also not known to be associated with the LEGO trademarks, and there is no evidence showing that Respondent has been commonly known by the Domain Names.

In addition, Respondent has not used the Domain Names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of the filing of the Complaint, each reverts to a webpage featuring Complainant's LEGO trademark, claiming to be an "official LEGO outlet store" and offering LEGO branded products for sale, while Complainant has indicated that Respondent is not an authorized dealer or reseller of Complainant's products and has never had a business relationship with Complainant and each of the websites does not provide any disclaimers stating that the websites are not endorsed or sponsored by Complainant. At the time of the Decision, each of the Domain Names reverts to an error or inactive page. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Names. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Names. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Names and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Names in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or  
(ii) you have 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 you have engaged in a pattern of such conduct; or  
(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or  
(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location."

The Panel finds that Complainant has provided ample evidence to show that registration and use of the LEGO trademarks long predate the registration of the Domain Names. Complainant is also well established and known. Indeed, the record shows that Complainant's LEGO trademarks and related products and services are widely known and recognized. Therefore, Respondent was likely aware of the LEGO trademarks when it registered the Domain Names or knew or should have known that each of the Domain Names was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Names incorporating Complainant's LEGO trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the LEGO trademarks at the time of registration of the Domain Names. The addition of the terms "outlet", "online", "sale", "shop", "robots", "inc", and "store" (either alone or in combination, as noted above) in the respective Domain Names only reinforces the fact that Respondent was aware of Complainant's LEGO trademark and its reputation at the time of registration and Respondent's effort to opportunistically capitalize on the registration and its use of the Domain Names.

Moreover, at the time of the filing of the Complaint, each of the Domain Names reverts to an unauthorized commercial webpage featuring Complainant's logo, offering LEGO-branded products and claiming to be the "official Lego outlet store", when Complainant has indicated that Respondent is not an authorized dealer or reseller of Complainant's products and has never had a business relationship with Complainant. At the time of the Decision, each of the Domain Names reverts to an error or inactive page.

In addition, a number of the Domain Names, specifically, <legooutletonline.com>, <legorobotssale.com> and <legoonlineinc.com> - have been set up with mail exchanger (MX) records, indicating that these Domain Names may be actively used for email purposes, potentially providing the ability to facilitate fraudulent activities such as phishing, impersonating or passing off as Complainant. Such use of the Domain Names demonstrates that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online locations, by creating a likelihood of confusion with Complainant's LEGO trademark.

Finally, the Panel also notes the reputation of the LEGO trademarks, and the failure of Respondent to submit a response to the cease and desist letter or the Complaint, or to provide any evidence of actual or contemplated good-faith use, and the implausibility of any good-faith use to which the Domain Names may be put.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Names in bad faith and Complainant succeeds under the third element of 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 Domain Names <legoonlineinc.com>, <legooutletinc.com>, <legooutletonline.com>, <legooutletsale.com>, <legooutletshop.com>, <legorobotssale.com>, <legosaleinc.com>, and <legostoreinc.com> be transferred to Complainant.

*/Kimberley Chen Nobles/*

**Kimberley Chen Nobles**

Sole Panelist

Date: December 7, 2023