

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. 朱杰 (jie zhu)

Case No. D2023-5391

1. The Parties

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

The Respondent is 朱杰 (jie zhu), China.

2. The Domain Name and Registrar

The disputed domain name <legotoysfactory.com> (the “Domain Name”) is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 28, 2023. On January 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 3, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent ([REDACTED FOR PRIVACY]) and contact information in the Complaint. The Center sent an email communication to Complainant on January 3, 2024, 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 January 7, 2024.

On January 3, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the Domain Name is Chinese. On January 7, 2024, Complainant requested English to 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 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 Respondent in Chinese and English of the Complaint, and the proceedings commenced on January 9, 2024. In accordance with the

Rules, paragraph 5, the due date for Response was January 29, 2024. Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 31, 2024.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on February 12, 2024. 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; and
- Chinese trademark registration No. 75682 for LEGO word mark, registered December 22, 1976; and
- Chinese trademark registration No. 10176429 for LEGO word mark, registered on January 14, 2013.

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

The Domain Name was registered on November 5, 2023 and at the time of the filing of the Complaint, the Domain Name resolved to an unauthorized commercial webpage purportedly offering LEGO products for sale. At the time of the Decision, the Domain Name resolves to an error page.

5. Parties' Contentions

A. Complainant

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

In particular, Complainant contends that it has trademark registrations for LEGO and that Respondent registered and is using the Domain Name 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 Name. Rather, Complainant contends that Respondent has acted in bad faith in registering and setting up the Domain Name, 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 amended Complaint, sent by email on January 7, 2024, Complainant requested 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 Name is Chinese.

Complainant mainly asserts that they are unable to communicate in Chinese, that the Domain Name is registered in Latin characters and includes the English terms “toys” and “factory”, that the term “lego” which is the dominant portion of the Domain Name, does not have any specific meaning in the Chinese language, that Respondent is using the Domain Name which is confusingly similar to Complainant’s LEGO trademarks and targeting 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.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Name, 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.

With Complainant's rights in the LEGO trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case is, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's LEGO trademark. The LEGO trademark is recognizable in the Domain Name. In particular, the Domain Name's inclusion of Complainant's trademark LEGO in its entirety, with the addition of the term "toysfactory" does not prevent a finding of confusing similarity between the Domain Name 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 disputed 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 Name. 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 name 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 Name.

In addition, Respondent has not used the Domain Name 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, the Domain Name resolved to a website which prominently displays Complainant's LEGO logo, duplicated the touch and feel of Complainant's website, purportedly offered Complainant's LEGO branded products for sale without any disclaimer regarding the lack of relationship between Complainant and Respondent. At the time of the Decision, the Domain Name resolves to an error 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 Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does

not have any rights or legitimate interests in the Domain Name 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 Name 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 web site 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 web site 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 Name. 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. Moreover, the website at the Domain Name purportedly offered for sale Complainant's LEGO products. Therefore, Respondent was aware of Complainant's trademarks at the time of registration of the Domain Name. 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 Name 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 Name and its effort to opportunistically capitalize on the registration and use of the Domain Name. The addition of the term “toysfactory” after “lego” in the Domain Name 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 Name.

Moreover, at the time of the filing of the Complaint, the Domain Name resolved to a website which prominently displays Complainant's LEGO logo, duplicated the touch and feel of Complainant's website, purportedly offered Complainant's LEGO branded products for sale. Such use of the Domain Name 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, the failure of Respondent to submit a response to 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. Therefore, the current non-use of the Domain Name does not prevent a finding of bad faith.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Name 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 Name <legotoysfactory.com> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: February 26, 2024