

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. 石磊 (Lei Shi)

Case No. D2024-1663

1. The Parties

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

The Respondent is 石磊 (Lei Shi), China.

2. The Domain Names and Registrar

The disputed domain names <legofornite.com> and <legofortnight.com> are 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 April 19, 2024. On April 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 23, 2024, 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 April 24, 2024, 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 April 26, 2024.

On April 24, 2024, the Center informed the Parties in Chinese and English, that the language of the registration agreement for the disputed domain names is Chinese. On April 26, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the 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 the Respondent in English and Chinese of the Complaint, and the proceedings commenced on May 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 23, 2024.

The Center appointed Jacob Changjie Chen as the sole panelist in this matter on May 29, 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

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

The Complainant holds numerous registrations of LEGO trademark, including No. 75682 Chinese trademark, registered on December 22, 2016; No. 000039966 European Union trademark, registered on June 11, 2001; and No. 4395578 the United States of America trademark, registered on September 3, 2013.

The Complainant also owns numerous domain names incorporating its LEGO trademark, including <lego.com>, registered on August 22, 1995, and has been resolving the domain name as its official website.

According to the information disclosed by the Registrar, the Respondent is 石磊 (Lei Shi), located in China.

The disputed domain names <legofornite.com> and <legofortnight.com> were both registered on December 5, 2023. The disputed domain names currently resolve to blank webpages, but according to the evidence provided by the Complainant, the disputed domain names both resolved to websites displaying sponsored links redirecting to third-party websites.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to its LEGO trademark. The disputed domain names capture and combine the Complainant's LEGO trademark and misspellings of the third-party trademark FORTNITE. The Complainant's trademark is recognizable in the disputed domain names, and the addition of other third-party's trademark is insufficient to avoid the finding of confusing similarity to the Complainant's trademark. The generic Top-Level Domain ("gTLD") ".com" is disregarded under the first element confusing similarity test. Thus, the disputed domain names are confusingly similar to the Complainant's LEGO trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent has no relationship with the Complainant, and the Complainant has not licensed or otherwise permitted the Respondent to use the LEGO trademark or to register a domain name incorporating this trademark. At the time of filing the Complaint, the Respondent was using a privacy service, which could be found to equate to a lack of rights or legitimate interests. Furthermore, the Respondent is not using the disputed domain names in connection with making a bona fide offering of goods or services.

The Complainant finally contends that the disputed domain names were registered and are being used in bad faith. The Complainant and its LEGO trademark has gained a high reputation worldwide. The Respondent should have awareness of the Complainant and its LEGO trademark when registering the disputed domain names. The Respondent resolves the disputed domain names to websites displaying sponsored links redirecting to third-party websites and offers the disputed domain names for sale, which indicates that the Respondent is using the disputed domain names to intentionally attempt to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its websites, and has intention to sell, rent, or otherwise transfer the disputed domain names for valuable consideration in excess of his out-of-pocket expenses. The Respondent previously involved in several domain name disputes which provides evidence of the pattern of cybersquatting in which the Respondent is engaging. In addition, the Respondent registered several other domain names incorporating other third parties' trademarks.

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 language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that: 1) the Complainant is unable to communicate in Chinese, and using Chinese as language of the proceeding would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter; 2) the disputed domain names are comprised of Latin characters, and the content at the website associated with the disputed domain names was in English, indicating that the Respondent is able to understand English; 3) the Respondent registered other domain names comprising of Latin characters, indicating that the Respondent is able to understand English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, 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 (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms “fornite” and “fortnite” may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

According to the Complainant’s evidence, the disputed domain names resolved to websites displaying sponsored links related to the Complainant’s goods and services and redirecting to third-party websites. Such use of the disputed domain name cannot be deemed as a bona fide offering of goods or services, or a legitimate noncommercial or fair use. The disputed domain names currently resolve to blank webpages. The Complainant and its LEGO trademark have gained a certain degree of reputation and recognition worldwide, without any evidence from the Respondent, there is no element from which the Panel could infer the Respondent’s rights or legitimate interests over the disputed domain names.

In addition, the nature of the disputed domain names, comprising the LEGO trademark and the additional terms “fornite” and “fortnite”, carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that that the disputed domain names were registered far after the Complainant’s registrations of the LEGO trademark. According to the Complainant’s evidence, the Panel

accepts that the Complainant and its LEGO trademark have gained a certain degree of reputation and recognition among relevant consumers worldwide. Thus, the Panel views that the Respondent should have been aware of the Complainant and the LEGO trademark.

According to the Complainant's evidence, the Respondent resolved the disputed domain names to websites displaying sponsored links redirecting to third-party websites. Such use of the disputed domain names indicates the Respondent's intention to attempt to attract Internet users to its websites for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its websites.

The Respondent currently passively holds the disputed domain names. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

In addition, according to the Complainant's evidence, the Respondent has been involved in several domain name disputes where the Respondent used other third parties' trademarks to register domain names at disputes, and the domain names at disputes were ordered to be transferred to the Complainant. For example, see, *ZipRecruiter, Inc. v. 石磊 (Lei Shi)*, WIPO Case No. [D2024-0728](#), *Syngenta Participations AG v. 石磊 (Lei Shi)*, WIPO Case No. [D2023-0494](#), and *Sodexo v. 石磊 (Lei Shi)*, WIPO Case No. [D2021-1747](#). Furthermore, the Respondent also registered other domain names incorporating other third parties' trademarks. Given that, the Panel views that the Respondent has illustrated a pattern of conduct of preventing a trademark holder from reflecting its mark in a domain name, which further proves the bad faith of the Respondent.

The Panel finds that the Complainant has established 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 names <legofornite.com> and <legofortnight.com> be transferred to the Complainant.

/Jacob Changjie Chen/

Jacob Changjie Chen

Sole Panelist

Date: June 12, 2024