

## ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. 许效睿 (xu xiao rui)

Case No. D2024-3061

### 1. The Parties

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

The Respondent is 许效睿 (xu xiao rui), China.

### 2. The Domain Name and Registrar

The disputed domain name <legoify.com> is 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 July 26, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 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 (unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 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 the same day.

On July 31, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On July 31, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any 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 of the Complaint, and the proceedings commenced on August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. However, the Respondent sent four informal emails in Chinese to the Center on July 30, July 31, and August 1, 2024, requesting an explanation of this proceeding. Accordingly, the Center notified the Commencement of Panel Appointment Process on September 2, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on September 9, 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 produces construction toys, such as brick sets. The Complainant is the owner of multiple trademark registrations in multiple jurisdictions, including Chinese trademark registration number 1112413 for LEGO, registered from September 28, 1997, specifying goods in class 25. That trademark registration remains current. The Complainant is also the registrant of many domain names containing “lego”, including <lego.com>, which resolves to a website providing information about the Complainant’s construction toys such as brick sets, games, and other products.

The Respondent is an individual based in China.

The disputed domain name was registered on April 12, 2024. At the time when the Complaint was filed, it resolved to a website in English titled “Legoify” offering toys for sale, notably, brick sets. The About Us tab identified the operator as “Shanghai Zhaozhexuan Education Technology Co., Ltd”, a company established in 2023 that designs and produces toys. According to evidence presented by the Complainant, certain of the photographs on the website were photographs of the Complainant’s products and packaging, but they were presented as “Feifan Building Blocks”. Prices were displayed in USD. At the time of this decision, the disputed domain name no longer resolves to any active website; rather, it is passively held.

#### **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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the LEGO mark. The Respondent has no rights or legitimate interests in respect of the disputed domain name. No license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. The Respondent has intentionally chosen a domain name based on registered trademarks in order to generate traffic and income through a website that is offering for sale fake LEGO brick sets that are very similar in appearance to the Complainant’s actual products. The disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

Apart from informal emails requesting an explanation of this proceeding, the Respondent did not reply to the Complainant’s contentions.

## 6. Discussion and Findings

### 6.1. 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 and amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is unable to communicate in Chinese and translation of the Complaint would unfairly disadvantage and burden it and delay the proceedings; and the website found at the disputed domain name features various phrases and a page in English.

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

The Panel notes that the Respondent's website was in English, from which it can reasonably be inferred that the Respondent is able to communicate in that language.

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. The Panel would have accepted a Response in Chinese, but none was filed.

### 6.2. Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following 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

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. See [WIPO Overview 3.0](#), section 1.7.

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

The entirety of the LEGO mark is reproduced within the disputed domain name. Despite the addition of the suffix "ify", which is used to form verbs meaning "cause to be in (a stated condition)", the LEGO mark remains clearly recognizable within the disputed domain name. The only additional element is a generic Top-Level Domain ("gTLD") extension (".com") which, as a standard requirement of domain name registration, may be disregarded in the assessment of confusing similarity for the purposes of the Policy.

Accordingly, the disputed domain name is confusingly similar to the LEGO mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, 1.11.

Therefore, 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. See [WIPO Overview 3.0](#), section 2.1.

In the present case, the disputed domain name, which is confusingly similar to the Complainant’s LEGO mark, has been used to resolve to a website titled “Legoify” offering for sale toys of the same type as the Complainant’s. The Complainant submits that it has not given the Respondent any license or authorization of any other kind to use the trademark LEGO. The Respondent was using photographs of the Complainant’s products and packaging but offering for sale another brand. At the time of this Decision, the disputed domain name is passively held. In these circumstances, the Panel does not find that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. Given that the website offers goods for sale, this is not a legitimate, noncommercial or fair use of the disputed domain name either.

Further, the Registrar has verified that the Respondent’s name is “许效睿 (xu xiao rui)”. The Respondent’s website indicates that its company name is “Shanghai Zhaozhexuan Education Technology Co., Ltd” and it uses the brand “Feifan”, neither of which resembles the disputed domain name. Nothing on the record indicates that the Respondent has been commonly known by the disputed domain name.

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 name. 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 name such as those enumerated in the Policy or otherwise.

Based on the record, 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. The fourth of these is as follows:

“(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] 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 [the respondent’s] website or location or of a product or service on [the respondent’s] web site or location.”

In the present case, the Respondent registered the disputed domain name in 2024, long after the registration of the Complainant’s LEGO mark, including in China where the Respondent is based. The disputed domain

name wholly incorporates the LEGO mark as its initial element. The Complainant has gained a very strong reputation in its LEGO mark in the toy sector due to its longstanding and widespread use of that mark. The Respondent operates in the same sector, producing the same type of products and could be expected to be aware of the Complainant. Moreover, the Respondent was displaying photographs of the Complainant's products and packaging. In these circumstances, the Panel finds that the Respondent had the Complainant's LEGO mark in mind when it registered the disputed domain name.

As regards use, the disputed domain name operates by attempting to attract Internet users searching for the Complainant or its LEGO products and diverting them to the Respondent's website, which was offering goods of the same type for sale but of a different brand. The Panel finds that these circumstances fall within the terms of paragraph 4(b)(iv) of the Policy.

The Panel takes note that the use of the disputed domain name has now changed and that it no longer resolves to an active website. This change in use does not alter the Panel's conclusion; if anything, it may be a further indication of bad faith.

Therefore, 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 name <legoify.com> be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: September 14, 2024