

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. 曹梦容 (Banks Michelle)

Case No. D2024-0427

1. The Parties

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

The Respondent is 曹梦容 (Banks Michelle), United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <france-lego.com> is registered with West263 International Limited (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 30, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 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 January 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 February 2, 2024.

On January 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 February 2, 2024, the Complainant confirmed its request that English 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 Chinese and English of the Complaint, and the proceedings commenced on February 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 6, 2024.

The Center appointed C. K. Kwong as the sole panelist in this matter on March 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

The Complainant is the registered owner of trademarks consisting of or embodying the word "lego". These registrations include:-

Jurisdiction	Registration No.	Date of registration	International Classification of goods/services
United States	1018875 (word LEGO)	August 26, 1975	28
United States	1026871 (word LEGO and device)	December 9, 1975	28
China	7756055 (word (LEGO)	December 21, 2010	15
China	3850442 (word LEGO and device)	April 21, 2007	16

The Complainant has subsidiaries, branches and licensees throughout the world, with products bearing the mark LEGO being sold in more than 130 countries, including the United States and China. Its business in making and selling Lego branded toys including construction toys has grown remarkably and has expanded to computer hardware and software, books, videos and computer controlled robotic construction set.

The Complainant is the owner of close to 5,000 domain names embodying the word "lego" (Annex 5 to the Amended Complaint) and operates an official site using the domain name <lego.com> (Annex 7 to the Amended Complaint).

The uncontradicted evidence produced by the Complainant shows that the use and registration of its LEGO mark occurred well over 20 years before the registration of the disputed domain name <france-lego.com> on December 8, 2023. The disputed domain name resolved to a website at which toys bearing or being marketed under or by reference to the mark LEGO were offered for sale.

Other than the particulars shown in the printout of the database searches conducted by the Complainant on the WhoIs Database (as provided in Annex 2 to the Amended Complaint) and the website page as shown in Annex 8 of the Amended Complaint), there is no evidence concerning the background, businesses or activities of the Respondent.

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.

The LEGO trademark is a well-known trademark. LEGO is listed as the number 1 Consumer Superbrand 2019, number 1 on the list of the world's Top 10 Most Reputable Global Companies of 2020 and the Most Influential Toy of All Times announced by TIME in 2014.

The dominant part of the disputed domain name comprises the word LEGO which is identical to the registered trademark of the Complainant.

The disputed domain name has included a hyphen and the geographical description "france" which do not reduce the confusing similarity between the disputed domain name and the Complainant's trademark.

The public will be misled into believing that the disputed domain name has some commercial relationship with the Complainant.

The Respondent has not registered any trademarks or trade names corresponding to the disputed domain name. The Respondent was using a privacy Whois service, and cannot be commonly known by the disputed domain name.

No license or authorization has been given by the Complainant to the Respondent, to use the trademark LEGO. The Respondent is not an authorized dealer of the Complainant's products.

The Respondent has not indicated that it is an unauthorized reseller or that it is not sponsored or endorsed by the Complainant. It was not making a bona fide offering of goods.

The Respondent has incorporated the Complainant's logotype in the disputed domain name without its consent. The Respondent is using the LEGO trademark in order to mislead Internet users to her commercial website. The Respondent cannot claim to have registered or used the trademark LEGO, without being aware of the Complainant's well-known mark LEGO and can have no plausible explanation for doing so.

B. Respondent

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

6. Discussion and Findings

Having considered the records in the case file, the Panel is satisfied that the Center has discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint. It is further noted that records of Delivery of the Notification of Complaint and Commencement of Administrative Proceedings under DHL Waybill No. 8719394644 as shown in the case file indicated the documents as delivered.

A. 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. These reasons include:

1. The disputed domain name is comprised of Latin characters.
2. The website to which the disputed domain name resolves features various phrases in English.
3. The Respondent is located in the United States. It is fair to presume that the Respondent understands and is able to communicate in English.
4. The translation of the Complaint would unfairly burden the Complainant and delay the proceedings.

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.

B. The Three Elements

In rendering its decision, the Panel must adjudicate the dispute in accordance with paragraph 15(a) of the Rules which provides that, "[t]he Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 14(b) of the Rules further provides that, "if a Party, in the absence of exceptional circumstances, does not comply with any provisions of, or requirement under these Rules or any requests from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate".

The said three elements are considered below.

1. Identical or Confusingly Similar

(a) 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

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

(c) The entirety of the mark LEGO is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The additions of the non-distinctive element of a hyphen "-" and the geographical name or description of "france" do not diminish the similarity of the disputed domain name and the Complainant's LEGO trademark.

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

2. 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.

There is no legitimate explanation on the record as to why it was necessary for the Respondent to adopt the word “lego” in its domain name.

The Complainant has also confirmed that it has not licensed the Respondent to use its trademark LEGO in any way.

The Complainant’s LEGO trademark plus “france-” as a prefix in the disputed domain name cannot constitute fair use as it suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1

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 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.

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

3. 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Complainant has registered its LEGO trademark as detailed in Section 4 above and has been using it for at least 20 years before the registration of the disputed domain name by the Respondent in 2023.

The incorporation of the unique LEGO trademark entirely letter by letter as part of the disputed domain name without any explanation and the prior substantial and extensive use of the Complainant’s LEGO mark worldwide including the United States where the Respondent resides, lead to the conclusion that the Respondent must have been aware of the existence of the Complainant and its trademark LEGO at the time of the registration of the disputed domain name.

The Panel finds the Respondent is passing itself off as the Complainant. The contents of the website to which the disputed domain name resolves show that the Respondent is marketing toys bearing or by reference to the mark LEGO, being exactly the Complainant’s house mark and principle line of goods of the Complainant.

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

/C. K. Kwong/

C. K. Kwong

Sole Panelist

Date: March 26, 2024