

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. Ming Hang Ng

Case No. D2022-3019

### **1. The Parties**

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

The Respondent is Ming Hang Ng, Hong Kong, China.

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

The disputed domain name <metaverselego.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2022. On August 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 18, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 9, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on September 22, 2022. 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 in this proceeding is LEGO Juris A/S, a limited company incorporated in Denmark.

The Complainant is the owner of LEGO, and all other trademarks used in connection with the well-known trademark LEGO of construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in Hong Kong, China, and elsewhere. Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Hong Kong, China. Moreover, the Complainant is the owner of more than 5,000 domain names containing the term "lego".

The trademark LEGO is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. Indeed, the LEGO trademark and brand have been recognized as being famous.

The Complainant has expanded its use of the LEGO trademark to, *inter alia*, computer hardware and software, books, videos, and computer controlled robotic construction sets.

The Complainant has the official website under the domain name <lego.com>. As shown, the trademark LEGO is in possession of substantial inherent and acquired distinctiveness. The awareness of the trademark LEGO is considered globally to be significant.

The Complainant operates a business selling toys in more than 130 countries. The Complainant holds registrations for the LEGO trademark and variations of it in numerous jurisdictions including the United States of America ("United States"), which it uses to designate toy building blocks and connecting links. The United States trademark registration No. 1018875 for LEGO, has been in effect since 1975 and Hong Kong, China trademark registration No. 19640937 for LEGO, has been in effect since the year 1964.

The Complainant conducts business on the Internet using numerous domain names containing the word "lego", including <lego.com>, with a toy business website resolving from these domain names. The Complainant also owns more than 5,000 domain names comprising or containing the word "lego".

The disputed domain name was registered on November 14, 2021, which resolves to a webpage that provides pay-per-click links to other websites, these websites resolve to offer construction toys and related products for purchase.

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

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

The Complainant argues that the disputed domain name is confusingly similar to its trademark LEGO. Due to the fact that the trademark is included in its entirety with other word "metaverse". Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, that the Respondent registered and is using the disputed domain name in bad faith.

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

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Complainant is the owner of the trademark LEGO and has presented relevant evidence of this fact in the present case.

The Panel is satisfied that the Complainant has established its trademark rights on the LEGO trademark (the "Trademark"). The test that a panel must do in order to establish if a domain name is confusingly similar to a trademark involves the comparison between the trademark and the domain name.

In this case, the disputed domain name consists of a word "metaverse" with the inclusion of the Complainant's trademark LEGO.

The dominant part of the disputed domain name comprises the term "lego", identical to the registered trademark LEGO.

Regarding whether the disputed domain name is identical or confusingly similar to the LEGO trademark, this Panel observes that the disputed domain name is comprised of: (a) the Complainant's trademark LEGO; (b) with the word "metaverse"; (c) followed by the generic Top-Level Domain ("gTLD") ".com".

It is also well established that where a domain name incorporates a complainant's trademark in its entirety, the domain name will be normally considered confusingly similar to that mark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

In addition to the trademark LEGO, the disputed domain name also comprises the term "metaverse". Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), section 1.8.

The addition of the gTLD ".com" does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant to determine the confusing similarity between the trademark and the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

Even though the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#) that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant allegations and evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with arguments or evidence proving its rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the

complainant.

The Complainant contends that the Respondent is not commonly known by the disputed domain name or the Trademark. The Respondent has not been authorized by the Complainant to register or use the Trademark in any way including the disputed domain name. The website that is displayed on the disputed domain name does not show any *bona fide* offering of goods or services. The website displays some pay-per-click links that resolve to other websites that offers construction toys and related products for purchase. This does not confer any rights or legitimate interests.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been refuted by the Respondent.

See *LEGO Juris A/S v. Chau Thanh Hao, CÔNG TY TNHH GẠCH BÊ TÔNG LEGO*, WIPO Case No. [D2022-2139](#), which states “paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant’s asserted facts, that no license, permission, or authorization of any kind to use the Complainant’s trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the LEGO trademark. Further, the Panel finds that: (i) ‘lego’ is a coined word, neither having any dictionary meaning in English, nor being transliterations of any words in Vietnamese; (ii) the LEGO trademark is inherently distinctive and has been widely used and become famous by the Complainant in numerous countries including in Viet Nam before the registrations of the Disputed Domain Names and the Respondent’s company name; and (iii) the websites associated with the Disputed Domain Names are offering concrete building bricks which have a similar look and mechanism to the Complainant’s LEGO building bricks and blocks with intertwining pieces”.

In the present case, the Panel has the view that the Respondent, by using the famous LEGO trademark in the disputed domain name for pay-per-click links that leads to websites promoting concrete brick products and intends to ride on the reputation of the LEGO trademark. Such use does not constitute a *bona fide* offering goods or services or legitimate noncommercial or fair use within paragraphs 4(c)(i) and (iii) of the Policy. Regarding paragraph 4(c)(ii) of the Policy, the Panel notes that the Respondent has not been commonly known by the term “lego” or the disputed domain name.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant has complied with the second element of the Policy. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

To prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith. It is a cumulative requirement.

The Panel is satisfied that the Respondent must have been aware of the Trademark when it registered the disputed domain name as the disputed domain name contains the Trademark in its entirety.

The Panel finds that the evidence in the case shows the Respondent registered and has used the disputed domain name in bad faith.

On the issue of registration, the trademark LEGO is such a famous mark for toy building blocks and connecting links that it would be inconceivable that the Respondent might have registered the disputed domain name unaware of it.

Further, a gap of years between registration of a complainant’s trademark and a respondent’s registration of a domain name (containing the trademark) can indicate bad faith registration, see *Asian World of Martial Arts*

*Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#). In this case, the Respondent registered the disputed domain name 58 years after the Complainant established registered trademark rights in the LEGO mark in Hong Kong, China. In the present case, the disputed domain name was registered a long time after the trademark and also the official LEGO website.

Further, the use of the disputed domain name is also in bad faith

The considerable value and goodwill associated with the mark LEGO is proportionate to the amount of infringement it is subject to, and most certainly what motivated the Respondent to register the disputed domain name at issue here. The Respondent registered the disputed domain name on November 14, 2021, this date is subsequent to when the Complainant registered the trademark LEGO in Hong Kong, China where the Respondent resides, and elsewhere, by more than five decades. It is obvious that it is the fame of the trademark that has motivated the Respondent to register the disputed domain name. In the present case, the Respondent did not answer and did not prove to have been using the trademark LEGO, without being aware of the Complainant's rights to it.

Consequently, the Respondent is using the disputed domain name to intentionally attempt to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. By using the disputed domain name, the Respondent is not making a legitimate noncommercial or fair use, but is misleadingly diverting consumers for commercial gain. It has been well established by other UDRP panelists found bad faith hinges directly on the probability that it was more likely than not that the respondent knew of, and targeted, the complainant's trademarks.

Section 3.1.4 of [WIPO Overview 3.0](#) further states:

"Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant's (or a competitor's) website, and (vi) absence of any conceivable good faith use."

In the present case, the Panel finds that the Respondent is using the disputed domain name in bad faith due to the fact that at the date of this Decision, the disputed domain name is resolving to a website displaying pay-per-click links that leads to commercial websites offering building bricks which essentially adopt the same mechanism as the Complainant's LEGO building bricks and blocks with intertwining pieces. The Panel concludes that the Respondent has intentionally attempted to ride on the reputation of the Complainant and the LEGO trademark, to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark, which supports a finding of bad faith under paragraph 4(b)(iv) of the Policy.

In the absence of any evidence to the contrary, this Panel finds that the Respondent has taken the Complainant's well known trademark LEGO and incorporated it in the disputed domain name without the Complainant's consent or authorization to disrupt the business of the Complainant.

For all the foregoing reasons the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <metaverselego.com> be transferred to the Complainant.

*/Ada L. Redondo Aguilera/*

**Ada L. Redondo Aguilera**

Sole Panelist

Date: October 6, 2022