

## **ADMINISTRATIVE PANEL DECISION**

LEGO Juris A/S v. LIU FEN

Case No. D2023-0069

### **1. The Parties**

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

The Respondent is LIU FEN, China.

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

The disputed domain name <legoduplo.xyz> is registered with Sav.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2023. On January 6 and 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 6 and 10, 2023, 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 (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 11, 2023, 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 on January 13, 2023.

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 January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 3, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on February 10, 2023. 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 Danish owner of the global Lego construction toy business with products sold in more than 130 countries including China. The Complainant owns numerous trade mark registrations for its LEGO word mark including in particular United States of America registration 1018875 registered on August 26, 1975, and Chinese trade mark registration 75682 registered on December 22, 1976. In addition it owns various device mark registrations with the word DUPLO as the dominant element, including Chinese trade mark registration 1214436 registered on October 14, 1998. The Complainant also owns close to 5,000 domain names containing the LEGO mark and operates an extensive website for its business at <lego.com>.

The disputed domain name was registered on January 2, 2022. It resolves to a page on Dan.com, a domain name marketplace, where the disputed domain name is listed as being for sale for USD 1,455.

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

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

The Complainant submits that it owns registered trade mark rights for its LEGO and DUPLO marks as noted above. It says that its LEGO mark is one of the best known marks in the world and which has been recognised as such by a number of organisations that review brands and corporate reputation. It says that the disputed domain name wholly incorporates the LEGO and DUPLO marks and that this supports a finding that the disputed domain name is confusingly similar to each of its registered trade marks and that the Top-Level Domain ".xyz" does not have any impact on the overall impression given by the disputed domain name which is that it is bound to be confused as being related to the Complainant.

The Complainant submits that the Respondent has no registered trade marks or trade names corresponding to the disputed domain name and that the Registrant information which identifies the Respondent as "LIU FEN" does not correspond to the disputed domain name. The Complainant says that it has given no licence or authorisation of any kind to the Complainant to use the LEGO trade mark and that the Respondent is not an authorised dealer of the Complainant's products and has never had a business relationship with the Complainant. The Complainant says further that the disputed domain name currently redirects Internet users to a page on the third-party website Dan.com that is a domain name marketplace listing the disputed domain name for sale for an amount that is far in excess of the Respondent's out-of-pocket expenses. The Complainant says that this is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use under the Policy.

In terms of registration in bad faith the Complainant says that the Respondent registered the disputed domain name on January 2, 2022, which is subsequent to the date on which the Complainant registered the trade mark LEGO or DUPLO marks by many years. The Complainant submits that it is obvious that it is the fame of the LEGO trade mark that has motivated the Respondent to register the disputed domain name and that the Respondent must have been aware of the Complainant's rights in the LEGO and DUPLO trade marks when it registered the disputed domain name.

The Complainant submits that the Respondent is currently offering to sell the disputed domain name for an amount well in excess of its out-of-pocket costs, which constitutes bad faith under section 4(b)(i) of the Policy. In addition, say the Complainant, the Respondent's attempt to mask its identity by using a privacy service and its failure to respond to the Complainant's agent's cease and desist letter dated April 7, 2022,

which was sent by email through the registrar and requested a voluntary transfer of the disputed domain name and offered compensation for the Respondent's out-of-pocket expenses.

The Complainant also submits that the Respondent has previously been involved in UDRP cases, which provides evidence of the pattern of cybersquatting in which the Respondent is engaging, some of which include:

- *TEVA Pharmaceuticals International GmbH v. Privacy Protection/ LIU FEN*, WIPO Case No. [D2022-0034](#).

- *Landesbank Baden- Württemberg (LBBW) v. Privacy Protection / Liu Fen*, WIPO Case No. [D2021-3992](#).

Further, says the Complainant, the Respondent currently holds registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses. It says that this fact demonstrates that the Respondent is engaging in a pattern of cybersquatting/typosquatting, which is evidence of bad faith registration and use of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant has demonstrated that it owns registered trade mark rights in various countries for its LEGO word mark and device mark registrations featuring the word DUPLO as the dominant element.

The disputed domain name wholly incorporates the LEGO word mark and the Panel therefore finds that it is confusingly similar to the Complainant's registered trade mark rights for LEGO. It also wholly incorporates the Complainant's DUPLO mark. As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered LEGO and DUPLO marks and that the Complaint succeeds under the first element of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant's LEGO mark is highly distinctive and a household name on a global basis and has enjoyed a very significant reputation for many years prior to the registration of the disputed domain name. The Complainant has submitted that it has given no licence or authorisation of any kind to the Complainant to use the LEGO or DUPLO trade marks and that the Respondent is not an authorised dealer of the Complainant's products and has never had a business relationship with the Complainant. It has asserted that the Respondent is not commonly known by the disputed domain name and has noted that the registrar verification identified the registrant as "LIU FEN" which has no resemblance to the disputed domain name.

The Complainant has submitted further that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services and has failed to make any legitimate use of the website to which it resolves. It has submitted that on the contrary, the disputed domain name redirects Internet users to a page on the third-party website Dan.com that is a domain name marketplace listing at which the disputed domain name is advertised for sale in the amount of USD 1,455, that is likely in excess of the Respondent's out-of-pocket expenses in registering the disputed domain name.

Moreover, given that the disputed domain name is composed of two of the Complainant's marks coupled together, the Panel finds that the composition of the disputed domain name carries a risk of implied affiliation, contrary to the fact, which cannot constitute fair use.

In these circumstances, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to or to rebut the Complainant's case and for these reasons the Panel finds that the Complaint also succeeds under this element of the Policy.

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

The Respondent registered the disputed domain name on January 2, 2022, which is many decades after the date on which the Complainant registered the trade marks LEGO or its combined word and device mark featuring DUPLO in China. The LEGO mark is highly distinctive and extremely well reputed globally, it is implausible that the Chinese-based Respondent could not have been aware of the Complainant's very well-known LEGO mark and business when he registered the disputed domain name.

Under section 4(b)(i) of the Policy there is evidence of registration and use in bad faith where there are circumstances indicating that a respondent has registered or acquired a domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to a complainant who is the owner of the trademark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the complainant's documented out-of-pocket costs directly related to the domain name.

The disputed domain name in this case, redirects Internet users to a page on the third-party website Dan.com that is a domain name marketplace listing for an amount more than USD 1400 which is likely in excess of the Respondent's out-of-pocket expenses. The disputed domain name also incorporates the Complainant's DUPLO mark. It is most likely that the Respondent considered that he could sell this domain name to the Complainant, or a competitor, or someone who wanted to use it to attract Internet users and then redirect them to its own website.

The Complainant has noted that the Respondent has previously been involved in a number of UDRP cases as a respondent in relation to domain names containing very well-reputed marks which the Panel agrees is indicative of a pattern of cybersquatting. Further, according to the Complainant, it appears that the Respondent may also own other domain names that contain well-reputed trade marks. In addition, the Panel notes that the Respondent has attempted to mask its identity in this case, using a privacy service and has failed to explain its conduct following the Complainant's cease and desist letter, or receipt of the Complaint in these proceedings. This conduct only serves to reinforce the Panel's view of the Respondent's bad faith.

In these circumstances the Panel finds that the requirements of section 4(b)(i) of the Policy have been made out. As the disputed domain name has both been registered and used in bad faith, the Complaint also succeeds under this 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, <legoduplo.xyz>, be transferred to the Complainant.

*/Alistair Payne/*

**Alistair Payne**

Sole Panelist

Date: February 24, 2023