

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. jiarong tang
Case No. D2023-0432

1. The Parties

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

The Respondent is jiarong tang, China.

2. The Domain Name and Registrar

The disputed domain name <legocase.com> is registered with Dynadot3 LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2023. On January 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 2023 and February 2, 2023, the Registrar transmitted by email to the Center its verification responses 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 February 3, 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 February 8, 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 February 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 2, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 9, 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 owner of LEGO, and all other trademarks used in connection with the LEGO brands of construction toys and other LEGO branded products; the LEGO trademark is registered around the world, including China, the United States of America (“United States”) and the European Union, for example Chinese trademark Registration No. 75682, registered on December 22, 1976 (Annexes 3.1 – 3.3 to the Complaint).

Moreover, the Complainant is the owner of a wide range of domain names containing the trademark LEGO (Annex 5 to the Complaint).

The Complainant tried to contact the Respondent on August 8, 2022, through a cease-and-desist letter sent via the Registrar contact form (Annex 9 to the Complaint). The Respondent did not respond.

The Respondent registered the disputed domain name on June 3, 2022 (Annex 2 to the Complaint).

The disputed domain name was connected to a commercial website displaying adult related and pornographic content with gambling advertisements, not related to the Complainant in any way. Moreover, no disclaimer was found on the website (Annex 8 to the Complaint).

At the time of this decision, the disputed domain name is not actively used. It resolves to a website stating “this website is not available”.

5. Parties’ Contentions

A. Complainant

The Complainant, based in Denmark, is the owner of LEGO, and all other trademarks used in connection with the famous LEGO brands 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 China, the United States 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 China and the United States. Moreover, the Complainant is the owner of close to 5,000 domain names containing the mark LEGO. It is the strict policy of the Complainant that all domain names taking an unfair commercial advantage of the LEGO trademark should be recovered by the Complainant. 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 disputed domain name is confusingly similar to the Complainant’s trademark LEGO, since it only adds the descriptive term “case” to the well-known LEGO mark which does not diminish the confusing similarity between the disputed domain name and the Complainant’s trademark.

The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. Neither has the Complainant found anything, including the Whois details, that would suggest that the Respondent has been using LEGO in any other way that would give them any legitimate rights in the name. Consequently, the Respondent may not claim any rights established by common usage. Further, the Respondent is not an authorized dealer of the Complainant’s

products and has never had a business relationship with the Complainant. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through a commercial website which displays content unrelated to the Complainant. Specifically, the disputed domain name is used to display predominantly pornographic content with advertisement links that redirect users to websites of third-party services not related to the Complainant in anyway. Hence, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent registered the disputed domain name on June 3, 2022. This date is subsequent to when the Complainant registered the trademark LEGO in China, the United States, and elsewhere, by decades. It is quite obvious that it is the fame of the trademark that has motivated the Respondent to register the disputed domain name. The Respondent cannot claim to have been using the trademark LEGO, without being aware of the Complainant's rights to it.

The Complainant first tried to contact the Respondent on August 8, 2022, through a cease and desist letter sent via the Registrar contact form. No reply was ever received. Moreover, the disputed domain name is connected to a commercial website displaying adult related pornographic content, not related to the Complainant in any way.

Therefore, the disputed domain name was registered and is being used in bad faith under the Policy.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark LEGO.

In the present case, the disputed domain name <legocase.com> is confusingly similar to the LEGO mark in which the Complainant has rights since the Complainant's LEGO mark is clearly recognizable in the disputed domain name. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). This is the case at present. The addition of the term "case" in the disputed domain name does not prevent a finding of confusing similarity.

Finally, it has also long been held that generic or country-code Top-Level Domains are generally disregarded when evaluating the confusing similarity under the first element.

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

B. Rights or Legitimate Interests

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant’s famous and distinctive mark in its entirety together with the term “case”, cannot be considered fair use as it falsely suggests an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above and the Panel’s findings below, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g., *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has rights and is the owner of the well-known, famous and highly distinctive registered trademark LEGO, which is registered and used in many jurisdictions around the world long before the registration of the disputed domain name. Moreover, the Complainant registered and is using various domain names containing the mark LEGO, e.g., <lego.com> and maintains an extensive website under the domain name <lego.com>.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant’s distinctive trademark LEGO entirely and that the LEGO mark is used intensively worldwide for decades.

(ii) Although the disputed domain name currently is not actively used, the Complainant put forward evidence that the disputed domain name was used for presenting pornographic content with gambling advertisements (Annex 8 to the Complaint). By using the disputed domain name to resolve to a website containing pornographic content with gambling advertisements and where confusion with a well-known trademark is used to divert unsuspecting Internet users to such website for commercial purposes by fostering a belief that the disputed domain name belongs to, is associated with, or connected to the Complainant, amounts to bad faith.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and has been using the disputed domain name in bad faith according to paragraph 4(b)(iv) of the Policy.

Hence, the Complainant has also proven that the Respondent registered and has been using the disputed domain name in bad faith according to 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 <legocase.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: March 22, 2023