

## ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. 石磊 (Lei Shi or Shi Lei)

Case No. D2024-0576

### 1. The Parties

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

The Respondent is 石磊 (Lei Shi or Shi Lei), China.

### 2. The Domain Names and Registrar

The disputed domain names <legoinsiders.com> and <legoinsidersfortnite.com> are registered with Dynadot Inc. The disputed domain name <legoinsidersclub.com> is registered with Cloud Yuqu LLC.

Dynadot Inc. and Cloud Yuqu LLC are jointly and separately referred to below as the “Registrar”.

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2024, including the disputed domain names and one additional domain name. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the following day, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the disputed domain names that differed from the named Respondent (Redacted for Privacy, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name <legoinsidersclub.com> is Chinese. The Complainant filed an amended Complaint in English on February 13, 2024, including a request that English be the language of the proceeding. The Respondent did not submit any comment on the language of the proceeding. On the same day, the Complainant also filed a request to withdraw one domain name with different underlying registrant details from the Complaint. The partial withdrawal was duly notified on February 13, 2024.

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 English and Chinese of the Complaint, and the proceedings commenced on February 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 13, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on March 19, 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 part of the LEGO Group, which produces construction toys, and has expanded into computer hardware and software, books, videos, and computer controlled robotic construction sets. The Complainant holds 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 has also registered over 5,000 domain names that incorporate “lego”, including <lego.com>, which it uses in connection with a website where it provides information about itself and its products. According to evidence presented by the Complainant, it operates a membership rewards program named “LEGO Insiders” or “LEGO Insiders Club”. Further, on December 2, 2023, the Complainant announced the launch of a video game named “LEGO Fortnite”, in collaboration with Epic Games, Inc., which markets an online video game as FORTNITE.

The Respondent is an individual resident in China. According to evidence presented by the Complainant, the Respondent has registered other domain names that incorporate third party trademarks.

The disputed domain names <legoinsiders.com> and <legoinsidersfortnite.com> were registered on December 3, 2023. The disputed domain name <legoinsidersclub.com> was registered on December 5, 2023. Each disputed domain name resolves to a landing page displaying Pay-Per-Click (“PPC”) links related to, among other things, toys or Epic Games.

#### **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 names are confusingly similar to its LEGO mark. The Respondent has no rights or legitimate interests in respect of the disputed domain names. No license or authorization of any kind has been given by the Complainant to the Respondent to use the LEGO trademark. The Respondent is not an authorized dealer in the Complainant’s products and has never had a business relationship with the Complainant. The disputed domain names have been registered and are being used in bad faith. The fame of the LEGO trademark has motivated the Respondent to register the disputed domain names. The disputed domain names resolve to landing pages displaying PPC links.

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

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issues**

#### **A. Consolidation**

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In the present case, the Panel notes that the Complaint relates to three disputed domain names. The name of the registrant is variously listed in the Registrar's Whois database as "石磊 / Lei Shi" for the disputed domain name <legoinsidersclub.com> or "Shi Lei" (which is a transcription of "石磊") for the other two disputed domain names. The contact information is essentially the same for all three disputed domain names. In these circumstances, the Panel finds that all three disputed domain names are registered by the same domain name holder and that it is appropriate to consolidate the complaints regarding each of them.

#### **B. Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name <legoinsidersclub.com> is Chinese and for the other two disputed domain names is English. 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 the amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that it is unable to communicate in Chinese and translation of the Complaint would unfairly burden the Complainant and delay the proceeding; the websites associated with the disputed domain names feature various English words; and the term "lego" has no meaning in Chinese.

The Respondent did not comment on the language of the proceeding. Given that the language of the Registration Agreements for two of the disputed domain names is English, it is reasonable to infer that the Respondent understands 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.

### **6.2 Substantive Issues**

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements with respect to each disputed domain name:

- (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.

The burden of proof of each element is borne by the Complainant.

### **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 each disputed domain name as its initial element. Each disputed domain name adds the word "insiders" and, in two cases, includes either the word "club" or "fortnite", but the LEGO mark remains clearly recognizable within all the disputed domain names. The only additional element in each disputed domain name 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. Accordingly, the disputed domain names are confusingly similar to the LEGO mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, and 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 names resolve to landing pages displaying PPC links, including links that relate to the Complainant's product category (toys) or the Complainant's collaborator (Epic Games). The PPC links operate for the benefit of the Respondent, if he is paid to direct traffic to the linked websites, or the benefit of the operators of the linked websites, or both. The Panel does not consider that this demonstrates a use of the disputed domain names in connection with a bona fide offering of goods or services for the purposes of the Policy, nor is it a legitimate noncommercial or fair use of the disputed domain names.

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 names. 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 names 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] website or location.”

In the present case, the disputed domain names were registered in 2023, years after the registration of the Complainant’s LEGO trademark, including in China, where the Respondent is resident. The disputed domain names wholly incorporate the LEGO trademark as their respective initial element, in combination with the word “insiders”. That combination forms the name of the Complainant’s membership rewards program (“LEGO Insiders”). One disputed domain name adds the word “club”, which is also used in the name of the same program (“LEGO Insiders Club”) while another adds the word “fortnite”, which is used in the name of one of the Complainant’s games (“LEGO Fortnite”). These combinations demonstrate an awareness of the Complainant, its mark, and its operations. Accordingly, the Panel finds that the Respondent registered the disputed domain names with the LEGO mark in mind.

The disputed domain names resolve to landing pages displaying PPC links, including links that relate to the Complainant’s product category (toys) or the Complainant’s collaborator (Epic Games). The disputed domain names operate by attracting Internet users searching for the Complainant’s LEGO Insiders or LEGO Insiders Club membership loyalty program or its LEGO Fortnite video game and diverting them to the PPC landing pages. For the reasons given in section 6.2B above, the PPC links operate for commercial gain. In these circumstances, the Panel finds that the facts fall within the circumstances set out in paragraph 4(b)(iv) of the Policy.

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 names <legoinsiders.com>, <legoinsidersclub.com> and <legoinsidersfortnite.com> be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: March 25, 2024