

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. Yang Zhi Chao (杨智超)

Case No. D2023-0056

1. The Parties

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

Respondent is Yang Zhi Chao (杨智超), China.

2. The Domain Name and Registrar

The disputed domain name <legostarwas.com> (the “Domain Name”) is registered with eName Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2023. On January 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on January 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint in English on January 18, 2023.

On January 13, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On January 18, 2023, Complainant confirmed its request that English be the language of the proceeding. Respondent did not comment on the language of the proceeding.

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 Respondent in English and Chinese of the Complaint, and the proceedings commenced on January 19, 2023. In accordance with the

Rules, paragraph 5, the due date for Response was February 8, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on February 10, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on February 20, 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

Complainant, based in Denmark, manufactures and sells construction toys, computer hardware and software, books, videos, and robotic construction sets under the LEGO trademark. Complainant has subsidiaries and branches throughout the world, and Complainant's products are sold in more than 130 countries, including in China, where Respondent resides.

Complainant is the owner of numerous registered trademarks for the LEGO mark globally, including:

- Danish trademark registration No. VR195400604 for LEGO word mark, registered on May 1, 1954; and
- Chinese trademark registration No. 135134 for LEGO word mark, registered on January 5, 1980.

Complainant is also the owner of many domain names containing the LEGO mark, including <lego.com>.

The Domain Name was registered on May 20, 2022 and reverts to a webpage with commercial Pay-Per-Click ("PPC") advertising page links, such as: "Lego Star Wars", "Star Wars Lego Sets", and "Lego Star Wars at At". The Domain Name is also being offered for sale on the domain marketplace site "Afternic" for USD 7,999.

On July 1, 2022, Complainant sent a cease-and-desist letter to Respondent through the Registrar's contact form. Complainant notified Respondent that the unauthorized use of the LEGO trademark within the Domain Name violated Complainant's trademark rights. Complainant requested a voluntary transfer of the Domain Name and offered compensation for the expenses of registration and transfer fees. Despite of the cease and desist letter and its reminders, Respondent did not reply. Complainant then filed the current proceeding.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for LEGO and that Respondent registered and is using the Domain Name with the intention to confuse Internet users looking for *bona fide* and well-known LEGO products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademark, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in registering and setting up the Domain Name, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Complainant submitted its original Complaint in English. In its email dated January 18, 2023, and amended Complaint, Complainant confirmed its request that the language of the proceeding should be English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Name is Chinese.

Complainant asserts that they are unable to communicate in Chinese, that the Domain Name is registered in Latin characters, that the Domain Name resolves to a website providing content in English, and that the term "lego" which is the dominant portion of the Domain Name, does not have any specific meaning in the Chinese language, that Respondent is using the Domain Name which is confusingly similar to Complainant's LEGO trademarks and targeting English speaking consumers seeking Complainant or its products. Complainant also contends that any holding the proceeding in Chinese would cause undue delay, considerable expense, unfair disadvantage, and burden Complainant as well as the dispensation of the current matter. Complainant also contends that it had sent a cease and desist letter to Respondent with ample time for Respondent to request communications in Chinese, and Respondent did not reply.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Name, 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.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding, nor did Respondent choose to file a Response.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the LEGO trademarks, as noted above. Complainant has also submitted evidence which supports that the LEGO trademarks are widely known and a source identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the LEGO trademarks.

In addition to the trademark LEGO, the Domain Name also comprises a misspelling of the third-party trademark STAR WARS (with the omission of the letter "r" in "wars"). The addition of other third-party marks does not prevent a finding of confusing similarity to the complainant's mark. See [WIPO Overview 3.0](#), section 1.7. However, Complainant's LEGO trademark is recognizable within the domain name despite the addition of the misspelled STAR WARS trademark - as such, the resulting Disputed Domain Name must be considered confusingly similar to Complainant's LEGO trademark.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its LEGO trademarks, and does not have any rights or legitimate interests in the Domain Name. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the LEGO trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the LEGO trademarks, and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, it reverts to a webpage with commercial PPC advertising page links. The Domain Name is also being offered for sale on the domain marketplace site "Afternic" for USD 7,999. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence

of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The Panel finds that Complainant has provided ample evidence to show that registration and use of the LEGO trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's LEGO trademarks and related products and services are widely known and recognized. Therefore, Respondent was likely aware of the LEGO trademarks when it registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's LEGO trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the LEGO trademarks at the time of registration of the Domain Name and its effort to opportunistically capitalize on the registration and use of the Domain Name.

Moreover, the Domain Name reverts to a webpage with commercial PPC advertising page links. The Domain Name is also being offered for sale on the domain marketplace site “Afternic” for USD 7,999. Such use of the Domain Name demonstrates that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online locations, by creating a likelihood of confusion with Complainant's LEGO trademark.

Finally, the Panel also notes the reputation of the LEGO trademarks, Respondent's history of engaging in a pattern of cybersquatting and the failure of Respondent to submit a response to the cease and desist letter, any of the corresponding reminders and the Complaint.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Name, <legostarwas.com>, be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: March 2, 2023