

ADMINISTRATIVE PANEL DECISION

LEGO Juris A/S v. ayoub lagnadi
Case No. D2022-3337

1. The Parties

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

Respondent is ayoub lagnadi, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names are <anylego.com> and <golego.shop>, which are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 7, 2022. On September 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from those in the Complaint. The Center sent an email communication to Complainant on September 12, 2022, 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 on September 15, 2022.¹

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 of the Complaint, and the proceedings commenced on September 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 11, 2022.

¹ The original Complaint was filed against Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf, which appeared as registrant in the corresponding Whois report. The amended Complaint was filed against Respondent, as per the information disclosed by the Registrar.

The Center appointed Gerardo Saavedra as the sole panelist in this matter on October 18, 2022. This Panel finds that it was properly constituted. This 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 is a Danish company and the owner of certain LEGO brands used in construction toys and other products.

Complainant has rights over the LEGO mark for which it holds, among others, registration No. UK00000844309 with the Intellectual Property Office of the United Kingdom, granted on January 25, 1963.

The disputed domain names were both registered on December 24, 2021.

Before the Complaint was filed, the website associated with the disputed domain name <anylego.com> showed, among others, “FREE SHIPPING WITHIN US”, “ANYLEGO”, “SHOP”, “TRACK YOUR ORDER”, “CART / \$0.00”, “ANYLEGO SPREAD JOY”, images showing figures very similar to Complainant’s LEGO branded products, “Carefree shopping”, “About AnyLego AnyLego was born out of a love for legos [...] Office Address: [...] TX [...] Phone number: +1 602 [...]”, “Copyrigh 2022 © AnyLego”. By the time the Complaint was filed, the website associated with this disputed domain name displayed an error message showing, among others, “Website not found...”.

Before the Complaint was filed, the website associated with the disputed domain name <golego.shop> showed, among others, “FREE SHIPPING WITHIN US”, “GOLEGO”, “SHOP”, “TRACK YOUR ORDER”, “CART / \$0.00”, “The Best Choice To Spread Joy” with a background image showing figures very similar to Complainant’s LEGO branded products, “Carefree shopping”, “About GoLego Golego was born out of a love for legos [...] Office Address: [...] TX [...] Phone number: +1 304 [...]”, “Copyrigh 2022 © GoLego”. By the time the Complaint was filed, the website associated with this disputed domain name displayed an error message showing, among others, “This site can’t be reached [...] golego.shop%20’s server IP address could not be found”.

5. Parties’ Contentions

A. Complainant

Complainant’s assertions may be summarized as follows.

Complainant is the owner of the LEGO mark used in connection with the famous LEGO construction toys and other LEGO branded products. Over the years, the business of making and selling LEGO branded toys has grown remarkably. Complainant’s group has expanded its use of the LEGO mark to, *inter alia*, computer hardware and software, books, videos, and computer-controlled robotic construction sets. Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries.

The LEGO mark 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. The LEGO mark and brand have been recognized as being famous; for instance, in the list of the official Top 10 Consumer Superbrands for 2019, provided by Superbrands UK, LEGO appears as the number 1 Consumer Superbrand and number 8 in the Consumer Relevancy Index. In 2014, Time featured LEGO as the Most Influential Toy of All Time.

Complainant is the owner of more than 5,000 domain names containing the term LEGO. Complainant’s group also maintains an extensive website linked to the domain name <lego.com>.

The disputed domain names are confusingly similar to Complainant's LEGO mark. The dominant part of each disputed domain name identically comprises such mark; the prefixes "go" and "any" do not detract from the overall impression of the dominant part of each disputed domain name and do not diminish the confusing similarity between each disputed domain name and Complainant's mark.

Respondent has no rights or legitimate interests in respect of the disputed domain names. Respondent has no registered trademarks or trade names corresponding to the disputed domain names. Complainant has not granted any license or authorization to Respondent to use the LEGO mark, and Respondent is not an authorized dealer of Complainant's products and has never had a business relationship with Complainant. There is no evidence that Respondent is commonly known by the disputed domain names and Respondent's name does not resemble the disputed domain names in any manner.

Respondent is not making a *bona fide* offering of goods or services or a legitimate, noncommercial fair use of the disputed domain names. Prior to Complainant's performing a takedown of the websites linked to the disputed domain names, the latter resolved to websites offering LEGO branded products for sale, which suggests that Respondent intended the disputed domain names to be confusingly similar to Complainant's mark as a means of furthering consumer confusion. Respondent was using Complainant's mark to mislead Internet users to its own commercial websites, thus trying to benefit from Complainant's world famous mark. At present, each disputed domain name resolves to a largely blank web page. Nevertheless, there is a considerable risk that the public will perceive the disputed domain names either as domain names owned by Complainant or that there is some kind of commercial relation with Complainant.

Respondent should be considered to have registered and to be using the disputed domain names in bad faith. The LEGO mark in respect of toys has the status of a well-known and reputable mark with a substantial and widespread goodwill throughout the world. The number of third party domain name registrations comprising the LEGO mark in combination with other words has always been attractive to domain name infringers. The considerable value and goodwill associated with the LEGO mark is most certainly what motivated Respondent to register the disputed domain names.

Respondent cannot claim to have been using LEGO without being aware of Complainant's rights to it. The disputed domain names were previously being used to resolve to commercial websites selling LEGO branded products. Consequently, Respondent was using the disputed domain names to intentionally attempt to attract Internet users to its own websites for commercial gain, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such websites.

The disputed domain names currently resolve to largely blank websites and are not actively being used, though past UDRP decisions have noted that bad faith use does not require a positive act on the part of Respondent; instead, passively holding a domain name can constitute a factor in finding bad faith registration and use pursuant to the Policy.

Respondent had hidden its identity, which past UDRP decisions have held serves as further evidence of bad faith registration and use. Complainant first tried to contact Respondent on February 10, 2022, through a cease and desist letter sent by email. In spite of the reminders sent, no reply was ever received.² Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file the Complaint under the UDRP.

Evidence of prior UDRP decisions in which a domain name has been transferred away from Respondent to complaining parties supports a finding that Respondent has engaged in a bad faith pattern of cybersquatting. Respondent has previously been involved in a UDRP case (*Vorwerk International AG v. ayoub lagnadi, Lagnadi LTD*, WIPO Case No. [D2022-1592](#)) which evidences the pattern of cybersquatting in which Respondent is engaging.

Complainant requests that the disputed domain names be transferred to Complainant.

² Annex 9 of the Complaint contains copies of such cease and desist letters dated February 10, 17, and 24, 2022.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

The lack of Response from Respondent does not automatically result in a favorable decision for Complainant (see *Berlitz Investment Corp. v. Stefan Tinculescu*, WIPO Case No. [D2003-0465](#), and section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The burden for Complainant, under paragraph 4(a) of the Policy, is to show: (i) that each disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain names; and (iii) each disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is undisputed that Complainant has rights over the LEGO mark.

Since the addition of a generic Top-Level Domain (*i.e.* ".com" and ".shop") in a domain name is technically required, it is well established that such element may be disregarded where assessing whether a domain name is identical or confusingly similar to a mark. Each disputed domain name reflects the LEGO mark in its entirety, albeit preceded by "any" and "go", respectively. It is clear to this Panel that the LEGO mark is recognizable in the disputed domain names and that the addition of such terms in the disputed domain names, respectively, does not avoid a finding of confusing similarity with said mark (see sections 1.7 and 1.8 of the [WIPO Overview 3.0](#)).

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

B. Rights or Legitimate Interests

Complainant has alleged and Respondent has failed to deny that Respondent has no rights or legitimate interests in respect of the disputed domain names.

It is uncontested that Complainant's LEGO mark is well known internationally. Complainant asserts that Respondent is not an authorized dealer of Complainant's products and has had no business relationship with Complainant, that Respondent is not commonly known by the disputed domain names, that Respondent has no registered trademarks or trade names corresponding to the disputed domain names, and that Complainant has not granted any authorization to Respondent to use its LEGO mark.³

Complainant contends that Respondent is not using the disputed domain names in connection with any legitimate noncommercial or fair use without intent for commercial gain. This Panel notes, from the screenshots of the websites associated with the disputed domain names, that Respondent seems to have been commercially operating such websites to feature apparent LEGO branded products, without showing the identity of the operator thereof, and there appears to be no disclaimer as regards Complainant, thus leading consumers to believe that such websites may be somehow associated with Complainant. All that

³ See *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. [D2003-0400](#): "There is no evidence that the Complainant authorized the Respondent to register the disputed domain name or to use the CASIO trademark, with or without immaterial additions or variants. These circumstances are sufficient to constitute a *prima facie* showing by the Complainant of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent".

demonstrates neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names.

This Panel considers that Complainant has established *prima facie* that Respondent has no rights or legitimate interests in the disputed domain names (see *Intocast AG v. Lee Daeyoon*, WIPO Case No. [D2000-1467](#), and section 2.1 of the [WIPO Overview 3.0](#)). In the case file there is no evidence of circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances, giving rise to rights or legitimate interests in the disputed domain names by Respondent.

Based on the aforesaid, this Panel concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The overall evidence indicates that Respondent's choice of the disputed domain names was deliberate, with the intention to benefit from the reputation and goodwill of Complainant's LEGO mark, which denotes bad faith.

Taking into consideration that Complainant's registration and use of the LEGO mark preceded the creation of the disputed domain names by a number of years, Complainant's international presence, the international recognition of the LEGO mark, and the content of the websites previously linked to the disputed domain names, this Panel is of the view that Respondent should have been aware of the existence of Complainant's mark and the goods marketed thereunder at the time Respondent obtained the registration of the disputed domain names.

Complainant provided screenshots of said websites, from which it is clear that Respondent used the disputed domain names for commercial purposes. It seems to this Panel that Respondent sought to divert Internet traffic looking for Complainant's LEGO products in order to commercially benefit therefrom.⁴ As set forth above, the websites previously linked to the disputed domain names conveyed the impression that they were somewhat associated with Complainant, and there is no evidence that they displayed a disclaimer disassociating such websites from Complainant. Those factors alone are generally deemed as showings of bad faith for purposes of the Policy. Given such prior use, the fact that afterwards said websites were taken down does not prevent such a finding of bad faith.

Further, Respondent's failure to reply to Complainant's cease and desist letters, may also be indicative of bad faith (see *Ebay Inc. v. Ebay4sex.com and Tony Caranci*, WIPO Case No. [D2000-1632](#)). Such finding is still valid even where a privacy protection service is provided by a third party, since such third party provider would be expected to forward such cease and desist letters to its principal, *i.e.*, the underlying registrant (see *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. [D2007-0062](#)).

This Panel also notices that there is another UDRP case involving Respondent and the LEGO mark (*LEGO Juris A/S v. Privacy service provided by Withheld for Privacy ehf / Ayoub Iagnadi, Lagnadi LTD*, WIPO Case No. [D2022-2584](#)), in addition to the UDRP case cited by Complainant (see *supra*). Such prior UDRP decisions against Respondent suggest a pattern of cybersquatting on the part of Respondent, which constitutes a further indication of bad faith.⁵

⁴ See *Lilly ICOS LLC v. East Coast Webs, Sean Lowery*, WIPO Case No. [D2004-1101](#): "registration of a domain name in order to utilize another's well-known trademark by attracting Internet users to a website for commercial gain constitutes a form of bad faith". See also *DaimlerChrysler Corporation v. Web4COKK SRL Romania*, WIPO Case No. [DRO2006-0003](#): "The registration and use in any form of a famous trademark which belongs to somebody else, without proving any rights or legitimate interests in it, represents bad faith registration and use".

⁵ See sections 3.1.2 and 4.8 of the [WIPO Overview 3.0](#). See also *Verizon Trademark Services LLC v. Osman Khan, NutriGold Inc.*, WIPO Case No. [D2015-1651](#): "Registering three domain names incorporating trademarks of third parties is sufficient to constitute a "pattern" of conduct evidencing bad faith".

Thus the overall evidence shows that Respondent registered and used the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to Respondent's websites by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of such websites, which denotes bad faith.

In this Panel's view, the lack of response is also indicative that Respondent lacks arguments and evidence to support its holding of the disputed domain names.

In light of the above, this Panel finds that Complainant has satisfied 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, this Panel orders that the disputed domain names <anylego.com> and <golego.shop> be transferred to Complainant.

/Gerardo Saavedra/

Gerardo Saavedra

Sole Panelist

Date: November 1, 2022