

ADMINISTRATIVE PANEL DECISION

Build-A-Bear Workshop, Inc. v. Jackson Steve
Case No. D2023-3167

1. The Parties

The Complainant is Build-A-Bear Workshop, Inc., United States of America, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Jackson Steve, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <buildabear-au.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 24, 2023. On July 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 24, 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 privacy service and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 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 July 28, 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 August 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 23, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on August 30, 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 registered owner of many trademarks in several jurisdictions containing or consisting of "BUILD-A-BEAR", e.g., European Union trademark registration No. 004872479 BUILD-A-BEAR (word) registered on October 10, 2007 for goods and services 28 and 35.

The disputed domain name was registered on October 4, 2022. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a parking page displaying Pay-Per-Click ("PPC") links.

Finally, the Complainant sent a cease and desist letter to the Respondent on November 10, 2022, followed by two notices on November 23, 2022 and December 7, 2022. The Respondent did not reply to it.

5. Parties' Contentions

A. The Complainant

It results from the Complainant's allegations that the Complainant is a global company that offers a teddy-bear themed retail-entertainment experience. Maxine Clark founded Build-A-Bear, and in 1997 opened the first Build-A-Bear store at Saint Louis Galleria, a shopping mall in St. Louis, Missouri. Since then, Build-A-Bear stores have continued to provide children and adults alike the opportunity to create their very own personalized stuffed animals through the stores' interactive bear-making stations. It has circa 1,000 full time employees and circa 2,700 part-time employees, located among its 346 corporately-managed locations in the United States of America, Canada, the United Kingdom and Ireland, as well as franchise stores across Europe, Asia, Australia, Africa and the Middle East.

The Complainant uses the domain name <buildabear.com>, created on March 13, 1997, which resolves to its official website. It also uses the domain name <buildabear.com.au>, providing information about its products and store locations in Australia.

The Complainant contends that its trademark is distinctive and well-known.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's trademark BUILD-A-BEAR as the disputed domain name incorporates the entirety of the Complainant's trademark. The addition of a hyphen and the geographical, descriptive term "au" (2-letter abbreviation for country Australia) are considered not sufficient to escape the finding that the disputed domain name is confusingly similar to its trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent is not sponsored by or affiliated with the Complainant in any way. The Complainant has not given the Respondent permission to use the Complainant's trademarks in any manner, including in domain names. The Respondent is not commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests. Furthermore, the Respondent is using the disputed domain name to redirect internet users to a website featuring links to third-party websites, some of which directly compete with the Complainant's business. For instance, the website at which the disputed domain name resolves features multiple third-party links for "Teddy Bears" and "Build Bear". Presumably, the Respondent receives pay-per-click fees from the linked websites that are listed at the disputed domain name's website. Prior UDRP decisions have consistently held that respondents that monetize domain names using pay-per-click links have not made a *bona fide* offering of goods or services that would give rise to rights or legitimate interests in a disputed domain name. As such, the Respondent is not using the disputed domain name to provide a *bona fide* offering of goods or services.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, by registering a domain name that comprises the Complainant's trademark in its entirety with a hyphen and the geographical term "au" where the Complainant operates in,

the Respondent has created a domain name that is confusingly similar to the Complainant's trademark. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. In addition, the Respondent is using the disputed domain name to confuse unsuspecting internet users looking for the Complainant's services, and to mislead internet users as to the source of the disputed domain name and website. By creating this likelihood of confusion between the Complainant's trademarks and the disputed domain name, leading to misperceptions as to the source, sponsorship, affiliation, or endorsement of the disputed domain name, the Respondent has demonstrated a nefarious intent to capitalize on the fame and goodwill of the Complainant's trademarks in order to increase traffic to the disputed domain name's website for the Respondent's own pecuniary gain, as evidenced by the presence of multiple pay-per-click links posted to the Respondent's website, some of which directly reference the Complainant and/or its competitors. The disputed domain name can only be taken as intending to cause confusion among internet users as to the source of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this 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". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of trademark registration for BUILD-A-BEAR as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark BUILD-A-BEAR is fully included in the disputed domain name, followed by the letters "au" and hyphen. Furthermore, it is the view of this Panel that the addition of the terms "au" and hyphens in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1). In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name. In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and, in particular, did not authorize the Respondent’s use of the trademark BUILD-A-BEAR, e.g., by registering the disputed domain name comprising the said trademark entirely.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation, since the disputed domain name contains the Complainant’s trademark BUILD-A-BEAR followed by the letters “au” - which are the geographical abbreviation for Australia (and hyphen). Geographical terms are seen as tending to suggest sponsorship or endorsement by the trademark owner, see [WIPO Overview 3.0](#) at section 2.5.1.

In addition, it results from the undisputed evidence before the Panel that the disputed domain name resolves to a parking website comprising PPC links that compete with or capitalize on the reputation and goodwill of the Complainant’s trademark or otherwise mislead Internet users. Prior UDRP panels have found that the use of a domain name to host a parked page comprising PPC links does not represent *bona fide* offering of goods or services, where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users (see [WIPO Overview 3.0](#) at section 2.9, with further references). This Panel shares this view. Therefore, such use can neither be considered as *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must, lastly, establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in its paragraph 4(b) may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith. One of these circumstances is that the respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand. The Complainant's trademarks have existed for many years. Further, the additional terms "au" in the disputed domain name are the geographical abbreviation for Australia. Therefore, this Panel has no doubt that the Respondent positively knew of the Complainant and its trademarks when the Respondent registered the disputed domain name. Registration of the disputed domain name by the Respondent in awareness of the BUILD-A-BEAR mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith.

In addition, the Complainant has proven that the disputed domain name resolved to a parking website comprising PPC links that compete with or capitalize on the reputation and goodwill of the Complainant's trademark or otherwise mislead Internet users, so that the Panel is satisfied that the disputed domain name, incorporating the Complainant's trademark in its entirety followed by the letter "au" (and hyphen), is being used to intentionally attempt 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.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (*i.e.* a domain name incorporating the Complainant's mark plus the addition of the letters "au", which are the geographical abbreviation for Australia);
- (ii) the content of the website to which the disputed domain name directs (*i.e.* a parking website comprising PPC links);
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.
- (iv) the Respondent's failure to reply to the cease and desist letter sent by the Complainant.

The Panel finds that the Complainant has therefore 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, the Panel orders that the disputed domain name, <buildabear-au.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: September 12, 2023