

ADMINISTRATIVE PANEL DECISION

Build-A-Bear Workshop, Inc. v. Herr Norbert Kurzmeier, KUNO GmbH
Case No. D2023-2515

1. The Parties

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

The Respondent is Herr Norbert Kurzmeier, KUNO GmbH, Germany.

2. The Domain Name and Registrar

The disputed domain name <build-a-bear.online> is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2023. On June 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 13, 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 Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 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 June 16, 2023.

On June 14, 2023, the Center informed the parties in German and English, that the language of the registration agreement for the disputed domain name is German. On June 16, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent objected to the Complainant’s request.

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 June 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 12, 2023. The Respondent sent an email communication to the Center on July 6, 2023.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on July 17, 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 following facts are undisputed.

The Complainant is a global company that offers a teddy bear themed retail-entertainment experience. In 1997 the first Build-A-Bear store was opened at Saint Louis Galleria, a shopping mall in St. Louis, Missouri, United States. Since then, Build-A-Bear stores have continued to provide children and adults alike the opportunity to create their own personalized stuffed animals (soft toy) through the stores' interactive bear-making stations. The Complainant had a revenue of USD 411.5 million in 2021. The Complainant currently has 1,000 full time employees and 2,700 part-time employees, located among its 346 corporately-managed locations in the United States, Canada, the United Kingdom and Ireland, as well as franchise stores across Europe, Asia, Australia, Africa, and the Middle East.

The Complainant and its wholly owned subsidiary Build-A-Bear Retail Management, Inc. own several trademark registrations in different jurisdictions, including the European Union trademark registration No. 004872479 BUILD-A-BEAR, filed on February 1, 2006, and registered on October 10, 2007, in classes 18 and 35.

In addition, the Complainant maintains Internet and retail presence through its website located at its domain name <buildabear.com>.

The disputed domain name was registered on February 25, 2023, and it resolves to a website (the "Website") in German "www.baerchenmacher.de", ("Baerchenmacher" translates in English to "little bear maker"), that offers consumers the possibility to order a kit to create their own personalized stuffed animal.

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 name is identical to its trademark BUILD-A-BEAR.

The Complainant furthermore contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The granting of registrations by the various IP offices to the Complainant for the BUILD-A-BEAR trademark is *prima facie* evidence of the validity of the term "build-a-bear" as a trademark, of the Complainant's ownership of this trademark, and of the Complainant's exclusive right to use the BUILD-A-BEAR trademark in commerce on or in connection with the goods and/or services specified in the registration certificates. 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 also not commonly known by the disputed domain name. Furthermore, the Complainant has not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademark. Also, at the time of filing the complaint, the

Respondent was using a privacy WHOIS service, which past panels have also found to equate to a lack of legitimate interest.

The Respondent is making neither a *bona fide* offering of goods or services nor a legitimate, noncommercial fair use of the disputed domain name. The disputed domain name is used to redirect Internet users to the Website, which offers services directly competitive to that which the Complainant offers under the BUILD-A-BEAR trademark. The Respondent registered the disputed domain name significantly after the Complainant filed for registration of its BUILD-A-BEAR trademark with the various offices and also significantly after the Complainant's first use in commerce of its trademark in 1997. This date is also subsequent to when the Complainant registered its <buildabear.com> primary domain name on March 13, 1997. As such, by the time the Respondent registered the disputed domain name, the Complainant already had a worldwide reputation in its trademark. It is evident that the disputed domain name carries a high risk of implied affiliation with the Complainant, which cannot be considered a fair use of the disputed domain name.

The Complainant finally contends that the disputed domain name was registered and is being used in bad faith. The Complainant and its BUILD-A-BEAR trademark are known internationally. By registering a domain name that comprises the Complainant's trademark in its entirety, the Respondent has created a domain name that is identical to the Complainant's trademark, as well as its <buildabear.com> domain name. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. Moreover, the Respondent's use of the disputed domain name to redirect to the Website that offers directly competing services further evinces the Respondent's knowledge of the Complainant's BUILD-A-BEAR mark.

In light of the facts set forth within this complaint, it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time the disputed domain name was registered".

B. Respondent

The Respondent did not file a formal Response, but informed the Center – in German – that it objects to the Complaint and that it has applied properly for the disputed domain name and was also granted ownership of the disputed domain name. According to the Respondent, the Complainant is no longer active on the German market. Therefore, the Complainant has no right to object against the registration of the disputed domain name in the name of the Respondent. The Respondent invites the Complainant to present an offer for the purchase of the disputed domain name. The Respondent requests for the complaint to be denied.

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is German. 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 was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the facts that (1) the Complainant is unable to communicate in German and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings; (2) such additional delay, considering the obviously abusive nature of the disputed domain name and the Website poses continuing risk to the Complainant and unsuspecting consumers seeking the Complainant or its products; (3) disputed domain name is comprised of English language terms "build a bear online", none of which carry any specific meaning in the German language; (4) the Complainant previously sent a cease-and-desist letter to the Respondent and the Respondent had ample time and

opportunity to respond to such letter and request that communications continue in German. The Respondent neither issued such a request nor responded to the Complainant in any matter whatsoever.

The Respondent requested that the language of the proceeding be German, without any providing any comments or argumentation.

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, in particular as the Respondent has given the impression having understood the complaint, not explicitly requested for a translation of the complaint into German, and has not taken the effort of filing a detailed response.

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. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, 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.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the

disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.

- the Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making 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. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record also contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

The disputed domain name is used to redirect Internet users the Website, which offers services that are competitive to that which the Complainant offers under the BUILD-A-BEAR trademark. Such use would not support a claim to rights or legitimate interests. See WIPO Jurisdictional Overview 3.0, section 2.5.3.

The Respondent's contention that the Complainant is no longer active on the German market, does not create a right or legitimate interest for the Respondent.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel refers to its considerations under 6.B.

The Panel furthermore 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 Panel considers that the record of this case reflects that:

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

In light of the facts of this matter, the Panel finds it implausible that the Respondent, who offers competing products, was not aware of the existence of the Complainant and its BUILD-A-BEAR trademark. In addition, the Respondent in his email in which he objected against the complaint, has not rebutted this knowledge of the Complainant and its BUILD-A-BEAR trademark. In that sense when registering and using the disputed domain name for redirecting it to the competitive Website, the Respondent clearly acted in bad faith.

Therefore, the Panel finds the third element of the Policy has been established.

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, <build-a-bear.online> be transferred to the Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: July 31, 2023