

ADMINISTRATIVE PANEL DECISION

Build-A-Bear Workshop, Inc. v. Milen Radumilo
Case No. D2022-2145

1. The Parties

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

The Respondent is Milen Radumilo, Romania.

2. The Domain Name and Registrar

The disputed domain name <buildabearafterdark.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2022. On June 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 15, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 15, 2022, 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 17, 2022.

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 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2022.

The Center appointed Andrew Brown Q.C. as the sole panelist in this matter on July 18, 2022. 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 Build-A-Bear Workshop, Inc., a United States-based corporation, which has used the BUILD-A-BEAR trademark since 1997 to provide children and adults the opportunity to create their own personalized stuffed animals through bear-making stations at the Complainant's own or franchised stores. The Complainant states that it has 346 corporately-managed stores in the United States, Canada, the United Kingdom, and Ireland as well as franchised stores across Europe, Asia, Australia, Africa, and the Middle East.

The Complainant or its affiliates are the proprietors of trademark registrations in the European Union ("EU") and United States. The actual registrations date variously from 2007 as follows:

| Trademark | Jurisdiction | Registration Number | Registration Date | IC Class |
|--------------|--------------|---------------------|-------------------|----------|
| BUILD-A-BEAR | EU | 004872479 | October 10, 2007 | 28, 35 |
| BUILD-A-BEAR | EU | 009660812 | June 21, 2011 | 9 |
| BUILD-A-BEAR | EU | 014760748 | March 02, 2016 | 28, 35 |
| BUILD-A-BEAR | US | 3741249 | January 19, 2010 | 35 |
| BUILD-A-BEAR | US | 3966451 | May 24, 2011 | 9 |
| BUILD-A-BEAR | US | 4901084 | February 16, 2016 | 28 |

The Complainant claims that it has a strong Internet and retail presence through its primary website "www.buildabear.com" with its website receiving 1.7 million visits in April 2022 alone. It claims a strong presence on social media platforms with 2.783 million followers on Facebook, 93,800 followers on Twitter, and 466,000 followers on Instagram.

The disputed domain name was registered on May 6, 2022. The Complainant provided evidence that the disputed domain name resolves to a parking page with pay-per-click links related to the Complainant's area of activity.

5. Parties' Contentions

A. Complainant

The Complainant asserts its rights in the BUILD-A-BEAR trademark. The Complainant contends that the disputed domain name is confusingly similar to its BUILD-A-BEAR trademark. Further the disputed domain name adds the term "after dark". The Complainant states that this term is closely linked to and associated with its BUILD-A-BEAR trademark because in early 2022, it launched a new "After Dark" collection of stuffed animals for adults. It contends that the disputed domain name that consists of the Complainant's trademark and an additional term that closely relates to and describes that business is confusingly similar to the Complainant's trademark. It therefore asserts that the disputed domain name is confusingly similar to its trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard the Complainant states that it has not given the Respondent permission to use its trademark in any manner including in domain names. Nor has it licensed, authorized, or permitted the Respondent to register domain names incorporating its trademark.

Further, the Complainant states that the Respondent is not commonly known by the disputed domain name. The Respondent's name does not resemble the disputed domain name in any manner. In circumstances where there is no evidence that the Respondent is commonly known by the disputed domain name, then the

Complainant asserts that the Respondent cannot be regarded as having required rights to or legitimate interests in the disputed domain name.

The Complainant also notes that the Respondent has used a privacy Whois service and claims that use of such services has been found to equate to a lack of legitimate interests.

In relation to any possible claim by the Respondent to a *bona fide* offering of goods and services, the Complainant asserts that 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. The Complainant asserts that respondents who monetize domain names using pay-per-click links are not making *bona fide* offering of goods and services so as to give rise to rights or legitimate interests in a disputed domain name.

Finally, the Complainant asserts that the disputed domain name was registered and has been used in bad faith. It asserts that:

- (i) a finding of bad faith should be made where the disputed domain name was registered shortly after the Complainant announced its new BUILD-A-BEAR "After Dark" collection. The Complainant states that this shows that the Respondent had knowledge of and familiarity with the Complainant's brand. It claims that it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brand at the date of registration;
- (ii) the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement of the website located at the disputed domain name;
- (iii) the Respondent has engaged in a bad faith pattern of cybersquatting, having previously been involved in over 200 such UDRP cases;
- (iv) further the Respondent currently holds registration for several other domain names that misappropriate trademarks of well-known brands and businesses; and
- (v) The Respondent has ignored the Complainant's attempts to resolve the dispute and its cease and desist letters.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following elements with respect to the disputed domain name in order to succeed in this proceeding:

- (i) that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of its registration of BUILD-A-BEAR as a trademark in the EU and

in the United States. The Complainant has also provided evidence of its use of that BUILD-A-BEAR trademark beginning in 1997 in the United States with progressive use across large parts of the world. The Complainant has built a corporately-owned and franchised network of Build-A-Bear stores across Europe, Asia, Australia, Africa, and the Middle East. The Complainant has also provided evidence of a strong Internet presence, including on social media.

It is the Panel's view that the Complainant has clearly and sufficiently demonstrated its rights in the BUILD-A-BEAR trademark. The Panel finds that the disputed domain name contains, as the dominant element, the BUILD-A-BEAR trademark followed by the term "afterdark".

The Panel finds that the term "afterdark" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

The Panel finds the disputed domain name is confusingly similar to the Complainant's BUILD-A-BEAR trademark.

Therefore, the Panel finds that paragraph 4(a)(i) of the Policy is satisfied in favor of the Complainant.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish that it has rights or legitimate interests in the disputed domain name, among other circumstances, by showing any one of the following elements:

- (i) that before notice of the dispute, the Respondent used or 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; or
- (ii) that the Respondent has been commonly known by the disputed domain name, even if it had acquired no trademark or service rights; or
- (iii) that the Respondent is 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.

The overall burden of proof for establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

The Complainant has stated, and the Panel accepts, that it has never licensed or permitted the Respondent to use its trademarks in any manner including in domain names.

The Panel further accepts that the Respondent has never been commonly known by the disputed domain name or the BUILD-A-BEAR trademark. This is demonstrated by the fact that the Respondent's registration information for the disputed domain name does not mention the terms "build-a-bear" or "after dark".

The Panel further finds that 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. The Complainant states that presumably the Respondent receives pay-per-click revenue from this. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.9 states that "[p]anels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users."

In the absence of any claim to rights or legitimate interests in the disputed domain name, the Panel is also entitled to have regard to the lack of any response on this issue from the Respondent.

The Panel finds that the Complainant has met the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. This *prima facie* case has not been rebutted by the Respondent. The Panel accordingly finds that paragraph 4(a)(ii) of the Policy is satisfied in favor of the Complainant.

C. Registered and Used in Bad Faith

The Panel is satisfied that the disputed domain name has been registered in bad faith for the following reasons:

(i) the Panel is satisfied that the BUILD-A-BEAR trademark is well-known amongst the relevant public in relation to stuffed animals and retail services relating to stuffed animals. The Panel is also satisfied that at the time of registration of the disputed domain name, the Respondent was aware of the Complainant's BUILD-A-BEAR trademark and its After Dark collection prior to registering the disputed domain name on May 6, 2022. The Respondent's registration of the disputed domain name, which includes both trademark and related term, shows the deliberate targeting of the Complainant and the BUILD-A-BEAR trademark. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the trademark at the time of registration: see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#);

(ii) this finding is supported by the Respondent's use of 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 own business. The evidence points to the fact that the Respondent is able, in this way, to generate pay-per-click revenue from these links;

(iii) bad faith is established where it can be demonstrated that the Respondent has intentionally attempted to attract for commercial gain Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant's mark as to 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 (Policy, paragraph 4(b)(iv)); and

(iv) without any rights or legitimate interests, the Respondent's registration of the disputed domain name incorporating the Complainant's well-known trademark BUILD-A-BEAR clearly shows registration in bad faith.

The Panel is also satisfied that the disputed domain name has been used in bad faith for the following reasons:

(i) the redirection of Internet users to a website featuring links to third-party websites, some of which directly compete with the Complainant's own business and from which the Respondent is able to monetize use of the disputed domain name amounts to use in bad faith; and

(ii) further, the Respondent has made no submission in these proceedings and so (on all the facts in this case) the Panel is entitled to infer that the Respondent has intentionally used the disputed domain name with an intent to confuse Internet users into thinking that it is controlled by the Complainant or an entity affiliated with the Complainant.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied in favor of the Complainant.

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, <buildabearafterdark.com>, be transferred to the Complainant.

/Andrew Brown Q.C./

Andrew Brown Q.C.

Sole Panelist

Date: August 1, 2022