

ADMINISTRATIVE PANEL DECISION

Build-A-Bear Workshop, Inc. v. Rogelio Abello Jr
Case No. D2023-2148

1. The Parties

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

Respondent is Rogelio Abello Jr, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <buildabeargs.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2023. On May 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 17, 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 on May 18, 2023.

On May 31, 2023, Respondent sent an informal email to the Center and to Complainant indicating that he can cancel the Domain Name. The Center acknowledged receipt of this email communication on June 2, 2023 and indicated that if the Parties wish to explore settlement options, Complainant should submit a request for suspension of the proceeding. On June 6, 2023 Complainant requested the suspension of this UDRP proceeding which was suspended on June 7, 2023. At the end of the suspension period, on July 5, 2023, the Center sent a reminder to the Parties and Complainant requested the reinstatement of the case in lieu of a lack of any response from Respondent. The case was reinstated on July 11, 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 Respondent of the Complaint, and the proceedings commenced on July 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2023. The Center notified the commencement of Panel appointment process on August 4, 2023.

The Center appointed Clive L. Elliott, K.C., as the sole panelist in this matter on August 10, 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 is a global company that offers a teddy-bear themed retail/entertainment experience. Founded by Maxine Clark in 1997, it 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.

Complainant, and its wholly owned subsidiary, Build-A-Bear Retail Management, Inc, are the registered owners of the BUILD-A-BEAR and BUILD-A-BEAR WORKSHOP trade marks ("Complainant's Marks") across various jurisdictions, including, but not limited to:

Trademark	Jurisdiction	Registration No.	Registration Date	Class(es)
BUILD-A-BEAR	EUIPO	004872479	October 10, 2007	28, 35
BUILD-A-BEAR	UKIPO	00904872479	October 10, 2007	28, 35
BUILD-A-BEAR	CIPO	TMA712817	April 25, 2008	9, 20, 28, 35
BUILD-A-BEAR	USPTO	3741249	January 19, 2010	35
	USPTO	4889678	January 19, 2016	35
	USPTO	4905206	February 23, 2016	28
	EUIPO	014760731	March 15, 2016	28, 35

Complainant currently has 1,000 full time employees and 2,700 part-time employees, located among its 346 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.

In addition, Complainant maintains a strong Internet and retail presence through its primary website “www.buildabear.com”.

According to the publicly available Whois, the Domain Name was registered on January 17, 2023, and as at the time of filing this Complaint, the Domain Name resolved to a website claiming to be “Build-A-Bear Workshop UAE” and featuring Complainant’s Marks and logo.

5. Parties’ Contentions

A. Complainant

Complainant states that the Domain Name is confusingly similar to Complainant’s Marks as it contains Complainant’s “Build-A-Bear” Mark in its entirety, with the removal of the hyphens and the addition of the term “gs”.

Further, Complainant states that Respondent’s use of the Domain Name contributes to the confusion, as Respondent is using the Domain Name to host a website featuring Complainant’s Marks and logo, while claiming to be “Build-A-Bear Workshop UAE”, all as a means of passing itself off as Complainant.

Complainant asserts that Respondent is not sponsored by or affiliated with Complainant in any way, nor has Complainant given Respondent permission to use Complainant’s Mark, including in domain names.

Complainant goes on to contend that Respondent is not commonly known by the Domain Name, which Complainant submits evidences a lack of rights or legitimate interests.

Additionally, Complainant claims that the Domain Name redirects Internet users to a website that copies and attempts to duplicate Complainant’s official website by featuring a similar blue/white colour scheme while also prominently displaying Complainant’s BUILD-A-BEAR Mark, in conjunction with Complainant’s BUILD-A-BEAR WORKSHOP Mark and logo, along with images pulled directly from Complainant’s own website. Complainant submits that the Domain Name’s website has purposely been designed to serve as an exact replica of Complainant’s website, as a means of deceiving Internet users into believing that the Domain Name and its website are associated with Complainant.

Furthermore, Complainant contends that as Respondent is using the Domain Name in connection with a commercial website, which offers and attempts to sell Complainant’s own products, there is potential that the products offered for sale could be counterfeits.

Complainant goes on to state that Complainant’s Marks are well known and it already had a worldwide reputation prior to Respondent registering the Domain Name on January 17, 2023, therefore suggesting that Respondent has registered and is using the Domain Name in bad faith. Finally, Complainant submits that Respondent at the time of initial filing of the Complaint, had employed a privacy service to hide its identity and that this is further evidence of bad faith.

B. Respondent

Respondent sent an informal communication on May 31, 2023 suggesting that it hosted the Domain Name and also proposed to delete the Domain Name. Respondent asked what it needed to do on a communication dated June 6, 2023. The proceeding was suspended at the request of Complainant for purposes of settlement discussions between the Parties. However, Respondent never replied to

Complainant regarding settlement purposes and Complainant requested the case to be reinstated on July 6, 2023. Respondent did not formally reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant has since 1997 provided what it describes as a teddy-bear themed retail/entertainment experience, whereby customers create their own personalized stuffed animals through the stores' interactive bear-making stations. Complainant operates through 346 locations in the United States, Canada, the United Kingdom and Ireland, and has franchise stores in Europe, Asia, Australia, Africa and the Middle East. Complainant has registered trade marks comprising or containing the words BUILD-A-BEAR, referred to and listed above as Complainant's Marks.

Complainant has therefore established it is the owner of Complainant's Marks.

The Domain Name reproduces Complainant's Marks, containing the words "build", "a" and "bear" in their entirety, minus the hyphens, but with the addition of the letters "gr". Relevantly, the addition of these letters does not prevent a finding of confusing similarity. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In addition, Complainant's Marks are clearly recognizable in the Domain Name, notwithstanding the addition of the letters and the removal of the hyphens. See section 1.7 of [WIPO Overview 3.0](#).

The Domain Name is therefore confusingly similar to Complainant's Marks.

The first ground under the Policy is made out.

B. Rights or Legitimate Interests

Complainant argues that Respondent has no rights or legitimate interests in the Domain Name, and that it has not authorised or permitted Respondent to use Complainant's Marks.

In terms of assessing whether Respondent might have rights or legitimate interests in the Domain Name an important consideration is that it appears Respondent is using the Domain Name to host a website featuring Complainant's Marks and logo. That is, while claiming to be "Build-A-Bear Workshop UAE". Further, it is alleged that Respondent has duplicated Complainant's website by featuring a similar blue/white colour scheme, and marks, along with images taken from Complainant's own website. Complainant submits that Respondent's website has purposely been designed to serve as an exact replica of Complainant's website.

In light of the above and in the absence of any denial by Respondent, the Panel has no difficulty in concluding that Respondent has deliberately set out to pass itself off as Complainant or as somehow associated with or authorised by Complainant. Accordingly, the Panel finds that Respondent has not established relevant rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy and that the Domain Name is inherently misleading. See section 2.5.1 of [WIPO Overview 3.0](#).

Complainant has established the second ground under the Policy.

C. Registered and Used in Bad Faith

Given the findings above, the Panel is satisfied that the Domain Name was registered and used in bad faith and that it is proper to infer that Respondent had actual knowledge of Complainant and its trade mark rights.

The Panel does so on the following basis:

- (i) The fact that Complainant's Marks have been registered and used since 2007;
- (ii) That Respondent has taken and used marks, colour schemes and content from Complainant's website;
- (iii) Respondent's failure to put forward any plausible explanation for its conduct; and
- (iv) Respondent's use of a privacy service to hide its identity.

The Panel finds that the Domain Name was registered with the knowledge of Respondent and has been used in a manner to mislead consumers into believing that the Domain Name was associated with Complainant. See section 3.1.4 of [WIPO Overview 3.0](#) and paragraph 4(b (iv) of the Policy. Accordingly, the Panel finds that the Domain Name was registered and used in bad faith.

Complainant has therefore established the third ground under 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 <buildabears.com> be transferred to the Complainant.

/Clive L. Elliott/

Clive L. Elliott

Sole Panelist

Date: August 27, 2023