

## **ADMINISTRATIVE PANEL DECISION**

Build-A-Bear Workshop, Inc. v. Matt Brown  
Case No. D2023-2590

### **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 Matt Brown, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <buildabear.space> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 16, 2023. On June 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 20, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent was listed as the registrant and providing the contact details.

The Center verified that the 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 July 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the default to the Respondent on July 26, 2023.

The Center appointed Iris Quadrio as the sole panelist in this matter on August 1, 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, Build-A-Bear Workshop, Inc., is a United States company operating since 1997, that offers a teddy-bear themed retail-entertainment experience.

Currently, the Complainant's business is established in the United States, Canada, the United Kingdom, and Ireland and it also has franchise stores across Europe, Asia, Australia, Africa, and the Middle East and claims to have cultivated a customer base which is reflected by its revenue of USD 411.5 million in Fiscal Year 2021.

At the same time, the Complainant asserts to have a strong presence on the Internet through its primary website "www.buildabear.com" (registered in 1997, and with 1.9 million visits during the period between February – April 2023, according to Similarweb.com) as well as through various social media platforms such as Facebook (with 2,875,95 Page Likes and 2,783,622 followers), Twitter (with 93.8K followers) and Instagram (with 466K followers).

Moreover, the Complainant is the owner of the trademark BUILD-A-BEAR in many jurisdictions, including Canada Reg. No. TMA712817 in cl. 9, 20, 28 and 35, registered on March 26, 2012; No. TMA958161 in cl. 28 and 35 registered on March 26, 2023; and No. TMA820698 in cl. 9, registered on March 25, 2012; United States Reg. No. 3741249 in cl. 35, registered on January 19, 2010; European Union Reg. No. 004872479 in cl. 28 and 35, registered on October 10, 2007. The Panel has confirmed that the referred registrations have been timely renewed.

The disputed domain name was registered on March 10, 2023, and initially resolved to a website that replicated the Complainant's official website "www.buildabear.com". The Complainant provided evidence of several cease-and-desist letters that were sent to the Respondent (on March 31, April 13, and April 24, 2023) and explained that, although the Respondent did not reply, after the letters were sent, the reachable content through the disputed domain name had been changed and redirected to a third party's website, "www.slotamba1.com", which appears to offer gambling services to registered users.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant claims that the disputed domain name is confusingly similar to its trademark BUILD-A-BEAR in which the Complainant has prior rights. The Complainant also claims that the Respondent has acted in bad faith as he holds no rights or legitimate interest in the disputed domain name, which was registered long after the Complainant's first use and registration of the trademark BUILD-A-BEAR in 1997.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. More specifically, the Respondent is not affiliated with the Complainant in any way. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark BUILD-A-BEAR or to apply for registration of the disputed domain name.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith. The Respondent has not used and/or has no demonstrable intention to use the disputed domain name except to create a likelihood of confusion with the Complainant's trademark. In fact, the Complainant claims that the Respondent has selected the disputed domain name only to intentionally lead Internet users to believe they are accessing the Complainant's website, when, in fact, they are redirected to a third party's gambling website that is unrelated to the Complainant.

Furthermore, the Complainant contends that the Respondent has ignored the Complainant's efforts to resolve the dispute outside the UDRP proceeding, which also demonstrates the Respondent's bad faith.

Finally, the Complainant has requested the Panel to issue a decision ordering the transfer of the disputed domain name to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

As set forth in Section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is virtually identical to the Complainant's BUILD-A-BEAR trademark since, even if it does not include the hyphens of the Complainant's mark, it incorporates the entirety of the letters of the Complainant's trademark.

Moreover, the ".space" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Based on the above, the Panel finds that the disputed domain name is confusingly similar to the trademark BUILD-A-BEAR in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name (section 2.1 of [WIPO Overview 3.0](#)). Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name and if the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Complainant has claimed not to have authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the BUILD-A-BEAR trademark nor is there any other evidence in the file suggesting that the Respondent has or could have rights or legitimate interests in the disputed domain name. Also, the Complainant has prior rights in the BUILD-A-BEAR trademark which clearly precede the Respondent's registration of the disputed domain name.

Likewise, it does not seem that the Respondent made nor is making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Complainant demonstrated that the Respondent initially used the disputed domain name to replicate the Complainant's official website "www.buildabear.com". This initial use of the disputed domain name by the Respondent appears to be merely intended to benefit from the Complainant's reputation by creating confusion to Internet users and leading them to believe that such site was an official site of the Complainant. Moreover, as established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry."

Subsequent to the Complainant's cease and desist letters, the reachable content through the disputed domain name was changed by the Respondent and currently redirects users to a third party's gambling website, "www.slotamba1.com". Even though the content of the disputed domain name was changed, it still demonstrates the Respondent's lack of *bona fide* in the offering of goods and services or legitimate noncommercial or fair use in the disputed domain name.

Given these circumstances, the Panel finds that the Complainant has made out a *prima facie* case. Having made such *prima facie* case, the burden of production then shifted to the Respondent to refute the Complainant's assertion or to demonstrate *bona fide* use of the disputed domain name. The Respondent has not submitted a reply, and the Panel is unable to consider any reasonable basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (see *Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy contains a non-exhaustive list of factors evidencing registration and use in bad faith. Among others, it states that it is sufficient to support a finding of bad faith the fact that, by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 website or location or of a product or service on the website or location.

In such connection, the Complainant has submitted evidence to support that the trademark BUILD-A-BEAR is widely known and was registered and used for many decades before the Respondent registered the disputed domain name. When registering the disputed domain name, the Respondent has targeted the Complainant's trademark BUILD-A-BEAR to generate confusion among Internet users and benefit from the Complainant's reputation.

Even more, it is reasonable to infer that the Respondent, who lives in Canada where the Complainant has developed its business, has registered the disputed domain name with full knowledge of the Complainant's trademark and with the intention to cause confusion among consumers who might think that the disputed domain name, and the website which the disputed domain name resolves to, pertain or are associated to the Complainant.

Therefore, the Panel is satisfied that the Respondent must have been aware of the Complainant and the Complainant's trademark BUILD-A-BEAR mentioned in Section 4 above (Factual Background) when the Respondent registered the disputed domain name on March 10, 2023. Consequently, and in accordance with section 3.1.4 of [WIPO Overview 3.0](#), in the circumstances of this case the Panel considers that the inclusion of the Complainant's widely known BUILD-A-BEAR trademark by the Respondent in the disputed domain name creates a presumption that the disputed domain name was registered in bad faith.

Additionally, the clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered in bad faith (see section 3.2.1 of [WIPO Overview 3.0](#)).

Finally, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's BUILD-A-BEAR trademark as to the source, sponsorship, affiliation, or endorsement of the website.

In view of the above given reasons, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

## **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.space>, be transferred to the Complainant.

*/Iris Quadrio/*

**Iris Quadrio**

Sole Panelist

Date: August 11, 2023