

ADMINISTRATIVE PANEL DECISION

Build-A-Bear Workshop, Inc. v. Internet Services, ICS inc
Case No. D2024-3312

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 Internet Services, ICS inc, Cayman Islands, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <buildabearvillege.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 13, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 13, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 14, 2024, 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 August 15, 2024.

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 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 6, 2024.

The Center appointed Edoardo Fano as the sole panelist in this matter on September 13, 2024. 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), “to employ reasonably available means calculated to achieve actual notice to [the] Respondent”. Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules, and the Supplemental Rules and without the benefit of a response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Build-A-Bear Workshop, Inc., a United States company offering a teddy-bear themed retail-entertainment experience, and owning several trademark registrations for BUILD-A-BEAR and BUILD-A-BEARVILLE, among which:

- European Union Trademark Registration No. 004872479 for BUILD-A-BEAR, registered on October 10, 2007;
- United Kingdom Trademark Registration No. UK00904872479 for BUILD-A-BEAR, registered on October 10, 2007;
- United States Trademark Registration No. 3741249 for BUILD-A-BEAR, registered on January 19, 2010;
- Canadian Trademark Registration No. TMA763218 for BUILD-A-BEARVILLE, registered on March 31, 2010.

The Complainant also operates on the Internet, its main website being “www.buildabear.com”, and having registered the domain name <buildabear.com> on March 13, 1997.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on March 16, 2008, and it resolves to a parking page with pay-per-click (“PPC”) links mostly related to the Complainant’s sector, that is teddy-bears, some of them redirecting to websites of the Complainant’s competitors. On the same parking page, the disputed domain name is also offered for sale for USD 299 .

On May 31, 2024, June 10, 2024, and June 20, 2024, the Complainant’s legal representatives sent a cease-and-desist letter to the Respondent, without receiving any reply.

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 states that the disputed domain name is confusingly similar to its trademarks BUILD-A-BEAR and BUILD-A-BEARVILLE, as the disputed domain name wholly incorporates the Complainant's trademarks, with the addition of the term "villegge" to the former and of the letters "ge" to the latter.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademarks within the disputed domain name, it is not commonly known by the disputed domain name, and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name resolves to a parking page with PPC links mostly related to the Complainant's sector, some of them also redirecting to websites of the Complainant's competitors.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademarks BUILD-A-BEAR and BUILD-A-BEARVILLE are distinctive and well known in the field of teddy-bears. Therefore, the Respondent targeted the Complainant's trademarks at the time of registration of the disputed domain name and the Complainant contends that, by resolving to a parking page with PPC links mostly related to the Complainant's sector, the use of the disputed domain name to attract, for commercial gain, Internet users to the Respondent's website, creating a likelihood of confusion with the Complainant's trademarks, qualifies as bad faith registration and use.

Moreover, the Complainant asserts that the Respondent is offering to sell the disputed domain name for valuable consideration in excess of its out-of-pocket expenses.

Finally, the Complainant submits that the Respondent is engaged in a pattern of registering other abusive domain names.

B. Respondent

The Respondent has made no reply to the Complainant's contentions and is in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.3.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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.

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 trademarks and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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 entirety of the marks are reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here “villegé” (as far as the Complainant’s trademark BUILD-A-BEAR is concerned) or “ge” (as far as the Complainant’s trademark BUILD-A-BEARVILLE is concerned), may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain, in this case “.com”, is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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 present 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 such as those enumerated in the Policy or otherwise. The disputed domain name resolves to a parking page with PPC links mostly related to the Complainant’s sector, some of them redirecting to websites of the Complainant’s competitors. The use of a disputed 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 trademarks. [WIPO Overview 3.0](#), section 2.9.

Moreover, the Panel finds that the composition of the disputed domain name carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademark BUILD-A-BEAR in the field of teddy-bears is clearly established, and the Panel finds that the Respondent must have known of the Complainant, and deliberately registered the disputed domain name in bad faith.

The Panel notes the content of the parking page to which the disputed domain name resolves, which consists of PPC links mostly related to the Complainant's sector, some of them redirecting to websites of the Complainant's competitors. The Panel finds that the disputed domain name is used in bad faith since in the relevant parking page there are PPC links, even in the case where they were automatically generated, referring to the teddy-bears' field, that is to the same field of activity as the Complainant, some of them redirecting to websites of the Complainant's competitors, and the Respondent cannot disclaim responsibility for the parking page content. See [WIPO Overview 3.0](#), section 3.5.

The Panel therefore notes that the disputed domain name is being used in bad faith since the Respondent is trying to attract Internet users to its website by creating likelihood of confusion with the Complainant's trademarks as to the disputed domain name's source, sponsorship, affiliation or endorsement, an activity clearly detrimental to the Complainant's business.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order both to disrupt the Complainant's business, and to attract Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith, also taking into consideration the fact that the Respondent is offering to sell the disputed domain name for valuable consideration in excess of its out-of-pocket expenses (absent any evidence from the Respondent to the contrary), as well as the pattern of conduct of the Respondent in other cases of abusive domain name registration against third parties.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain name, further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Based on the available record, 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, <buildabearville.com>, be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: September 18, 2024