

Decision for dispute CAC-UDRP-108758

Case number **CAC-UDRP-108758**

Time of filing **2026-06-24 08:21:47**

Domain names **americangirldolloutlet.com, matteloutlet.com**

Case administrator

Organization **Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization **MATTEL, INC.**

Complainant representative

Organization **Convey srl**

Respondents

Organization **black horse company**

Organization **black horse company**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous trademark registrations for the MATTEL trademark, including in particular:

- European Union Trademark No. 000169920 for MATTEL (figurative), in Classes 3, 9, 14, 16, 25, 28 and 41, registered on 28 June 1999;
- European Union Trademark No. 013037072 for MATTEL (word), in Class 35, registered on 18 November 2014;
- United States Trademark No. 3165874 for MATTEL (word), in Class 35, registered on 31 October 2006; and
- United States Trademark No. 3041794 for MATTEL (word), in Class 36, registered on 10 January 2006.

The Complainant is also the owner of numerous trademark registrations for the AMERICAN GIRL trademark, including in particular:

- European Union Trademark No. 005925961 for AMERICAN GIRL (word), in Classes 16, 25 and 28, registered on 27 February 2008;
- United States Trademark No. 3116340 for AMERICAN GIRL (combined), in Class 28, registered on 18 July 2006; and
- United States Trademark No. 3185615 for AMERICAN GIRL (combined), in Class 35, registered on 19 December 2006.

The Complainant also owns numerous domain names incorporating the MATTEL and AMERICAN GIRL trademarks, including <mattel.com>, registered since 5 June 1995, <americangirl.com>, registered since 25 March 1997, and <americangirl.org>, registered

since 6 October 1999. The websites associated with these domain names promote and commercialize products and services in connection with the Complainant's trademarks.

The Complainant's above-mentioned rights are hereinafter collectively referred to as the Complainant's Trademarks.

FACTUAL BACKGROUND

The Complainant, Mattel, Inc., is a global toy and entertainment company founded in 1945 and headquartered in El Segundo, California, United States. It is one of the world's leading manufacturers of toys and consumer products and owns a portfolio of well-known trademarks used in connection with toys, dolls, children's products, entertainment content and related retail services, including the MATTEL and AMERICAN GIRL trademarks.

The disputed domain names <matteloutlet.com> and <americangirldolloutlet.com> were registered on 11 April 2025 and 18 April 2025, respectively.

According to the Registrar Verification, both disputed domain names are registered in the name of black horse company. The Registrar Verification contains slightly different registrant details for each disputed domain name, including the name "jack kee" for one of the registrations, and indicates registrant addresses in Taiwan and China, respectively.

Prior to the filing of the Complaint, the disputed domain names resolved to websites reproducing the Complainant's Trademarks and imitating the layout and visual appearance of the Complainant's official websites, while offering for sale products presented as products bearing the Complainant's Trademarks. At the time of filing of the Complaint, both disputed domain names resolved to HTTP 403 error pages.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Complaint concerns two disputed domain names. The Complainant requested consolidation of the proceedings on the ground that both disputed domain names are under common control.

The Panel notes that the disputed domain names were registered only one week apart with the same Registrar. The evidence further shows that they used the same hosting infrastructure and nameservers, followed the same naming pattern by incorporating the Complainant's Trademarks together with descriptive terms, and resolved to websites displaying highly similar layouts and offering

products presented as products bearing the Complainant's Trademarks.

More importantly, following the submission of the Complaint, the Registrar confirmed that both disputed domain names are registered in the name of the same organisation, black horse company, notwithstanding certain differences in the registrant details associated with each registration.

In these circumstances, the Panel is satisfied that the disputed domain names are under common control. The Panel further considers that consolidation is fair and procedurally efficient and does not prejudice the Respondent.

Accordingly, the Panel grants the Complainant's request for consolidation.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

- (i) the disputed domain names are identical or confusingly similar to a trade mark 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 names; and
- (iii) the disputed domain names have been registered and are being used by the Respondent in bad faith.

I. COMPLAINANT'S RIGHTS AND THE CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S MARKS

The first element of the Policy serves essentially as a standing requirement.

The test for identity or confusing similarity involves a straightforward, reasoned comparison between the complainant's trademark and the disputed domain name. This typically entails a side-by-side evaluation of the domain name and the textual elements of the relevant trademark to determine if the mark is recognizable within the domain name. When a domain name fully incorporates a trademark, or at least a dominant feature of it is evident in the domain name, the domain name is generally deemed confusingly similar to the mark for the purposes of the first element.

The top-level domain (TLD) is usually disregarded in determining identity or similarity, as it is simply a technical aspect of registration.

The Complainant has established rights in the MATTEL trademark and the AMERICAN GIRL trademark.

The disputed domain name <matteloutlet.com> incorporates the MATTEL trademark in its entirety, merely adding the descriptive term "outlet". Likewise, the disputed domain name <americangirldolloutlet.com> incorporates the AMERICAN GIRL trademark in its entirety, merely adding the descriptive terms "doll" and "outlet".

The Panel finds that the additional terms do not prevent a finding of confusing similarity. On the contrary, the term "doll" directly refers to the Complainant's products, while the term "outlet" may increase the likelihood of confusion by suggesting an official outlet store operated or authorised by the Complainant.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant's Trademarks within the meaning of Paragraph 4(a)(i) of the Policy.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES

Under paragraph 4(a)(ii) of the Policy, the Complainant must establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Although the overall burden of proof rests with the Complainant, panels have consistently recognized that proving a respondent's lack of rights or legitimate interests may result in the difficult task of proving a negative. Accordingly, where a complainant establishes a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain names.

The Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in respect of the disputed domain names.

The Respondent is not affiliated with the Complainant and has not been licensed or otherwise authorised to use the Complainant's Trademarks or to register domain names incorporating them. There is also no evidence that the Respondent has been commonly known by the disputed domain names or has acquired any trademark rights corresponding to them.

The Panel notes that each disputed domain name wholly incorporates one of the Complainant's Trademarks and combines it with descriptive terms closely related to the Complainant's business. The composition of the disputed domain names carries a risk of implied affiliation with the Complainant, suggesting to Internet users that they are associated with official outlet stores of the Complainant.

The evidence further shows that the disputed domain names were used in connection with websites reproducing the Complainant's Trademarks and imitating the layout, visual identity and overall presentation of the Complainant's official websites, while offering for sale products presented as products bearing the Complainant's Trademarks. Such use was likely to mislead Internet users into believing that the disputed domain names and the associated websites were operated, authorised or endorsed by the Complainant. Such impersonation cannot confer rights or legitimate interests under the Policy.

The associated websites are currently inactive. Such current non-use does not establish any rights or legitimate interests on the part of the Respondent.

The Respondent has not submitted a Response and has therefore failed to rebut the Complainant's prima facie case or otherwise demonstrate any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES IN BAD FAITH

Under paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain names have been registered and are being used in bad faith.

The Complainant has sufficiently demonstrated rights in the prior and well-known MATTEL trademark and AMERICAN GIRL trademark. The disputed domain names are confusingly similar to the Complainant's Trademarks.

UDRP panels have consistently held that the mere registration of a domain name identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity may, in itself, constitute evidence of bad faith registration.

As for the bad faith registration, the Panel finds it inconceivable that the Respondent registered the disputed domain names without knowledge of the Complainant and its trademarks. Each disputed domain name wholly incorporates one of the Complainant's Trademarks and combines it with descriptive terms closely associated with the Complainant's business, namely "outlet" and, in one case, "doll". Such composition reinforces the false impression that the disputed domain names are associated with official outlet stores operated or authorised by the Complainant.

The Panel further notes that, according to the Registrar Verification, both disputed domain names are registered in the name of the same organisation, black horse company, while the associated registrant details differ, including the registrant's name and country. Moreover, the written notice sent by the CAC could not be delivered to the postal addresses provided by the Respondent, as they were found to be non-existent. These circumstances support the inference that the Respondent provided inaccurate registrant information, which constitutes an additional indication of bad faith.

As for the bad faith use, the evidence shows that, prior to the filing of the Complaint, the disputed domain names resolved to websites reproducing the Complainant's Trademarks and imitating the layout, visual identity and overall presentation of the Complainant's official websites, while offering for sale products presented as products bearing the Complainant's Trademarks. The Panel therefore finds that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation or endorsement of the associated websites and of the products offered thereon. Such conduct falls within the circumstances of paragraph 4(b)(iv) of the Policy.

The Panel further notes that the associated websites are currently inactive. According to the well-established passive holding doctrine (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003), the passive holding of a domain name does not preclude a finding of bad faith. In the circumstances of the present case, including (i) the well-known character of the Complainant's Trademarks, (ii) the Respondent's prior use of the disputed domain names to impersonate the Complainant, (iii) the absence of any conceivable good-faith use of the disputed domain names, (iv) the Respondent's failure to submit a Response or reply to the Complainant's cease-and-desist letters, and (v) the Respondent's provision of inaccurate registrant information, the Panel finds that the current passive holding supports a finding of bad faith.

Accordingly, the Panel finds that the disputed domain names have been registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **americangirldolloutlet.com**: Transferred
2. **matteloutlet.com**: Transferred

PANELLISTS

Name Ivett Paulovics

DATE OF PANEL DECISION 2026-07-21

Publish the Decision