

ADMINISTRATIVE PANEL DECISION

Hes-Pro (Finland) Oy and AS Hesburger v. Allans Smirnovs
Case No. D2022-0840

1. The Parties

The Complainants are Hes-Pro (Finland) Oy, Finland, and AS Hesburger, Estonia, represented by Kolster Oy Ab, Finland (collectively referred to as “the Complainants”).

The Respondent is Allans Smirnovs, Finland.

2. The Domain Name and Registrar

The disputed domain name <hesprofinland.com> is registered with EuroDNS S.A. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 10, 2022. On March 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 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 March 18, 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 March 23, 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 March 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 21, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on May 10, 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 Complainants are Hes-Pro (Finland) Oy (“the First Complainant”) and AS Hesburger (“the Second Complainant”).

The First Complainant is a Finnish company founded and owned by the Salmela family. The First Complainant’s business is among others in producing mayonnaises, salad dressings, and sauces that are heart of products served at Hesburger restaurants and distributed all over Finland and abroad.

The Second Complainant, also owned by the Salmela family, operates the leading fast-food restaurant chain in Finland and Baltic countries under the name Hesburger.

The First Complainant owns the European Union Trade Mark Registration (“EUTM”) No. 018235144 for the figurative mark HESPROFOODS, registered since October 8, 2020, for goods and services in Classes 5, 29, 30, 35, and 43, of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks (the “Nice Classification”).

The Second Complainant owns the International Trademark No. 018485106 for the figurative mark HESBURGER, designating the European Union, registered since October 9, 2021, for goods and services in Classes 25, 29, 30, and 43, of the Nice Classification.

The disputed domain name was registered on December 19, 2021, and resolved to a website reproducing the Second Complainant’s layout official website at “www.hesburger.fi”, including the HESBURGER figurative trademark and other design elements.

5. Procedural Issue – Consolidation of Multiple Complainants

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes.

According to section 4.11.1. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation”.

The Respondent incorporates the First Complainant’s trademark in the disputed domain name and reproduces the Second Complainant’s trademark on its website under the disputed domain name, as well as texts, photographs, designs and product images copied from the Second Complainants’ official website.

These facts in view of the Panel establishes that the Complainants have common grievance against the Respondent and common interest in the disputed domain name, which warrants permitting consolidation in this proceeding as a procedurally equitable and efficient action.

6. Parties’ Contentions

A. Complainants

The First Complainant contends that the disputed domain name is confusingly similar to its trademark since it incorporates the word HESPRO, the dominant, distinctive portion of its HESPROFOODS trademark, with the

addition of the word “Finland”.

The Complainants allege that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) of the Policy.

The Complainants claim that the Respondent’s use of the disputed domain name in connection with a website that falsely purports to be a website for the Hesburger-branded restaurants amounts to bad faith registration and use of the disputed domain name.

In addition, the Respondent has impersonated Mr. Salmela, manager of the First Complainant, and placed a fraudulent order to a Polish company for meat products, which is further indicative of bad faith.

The Complainants request that the disputed domain name be transferred from the Respondent to the First Complainant.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

7. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel’s decision be made “on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

It has been a consensus view in UDRP decisions that a respondent’s default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The First Complainant produced proper evidence of having registered rights in the HESPROFOODS trademark, and for the purpose of this proceeding, the Panel establishes that the Complainant satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the First Complainant's trademark rights, the Panel considers whether the disputed domain name <hesprofinland.com> is identical or confusingly similar to the Complainant's HESPROFOODS trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark, and where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable generic Top-Level Domain ("gTLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The First Complainant's trademark consists of the word elements HESPRO and FOODS in between two blue stars. The design elements of the trademark do not convey any relevant information for the purpose of this proceeding. It's the word components that stand out in the First Complainant's trademark, particularly the word component HESPRO, which the Respondent fully incorporated in the disputed domain name. The omission of the other word element in the trademark, "foods" is not detrimental for the first element finding here.

The disputed domain name consists of the term "Hespro", the distinctive word element of the First Complainant's HESPROFOODS trademark, and the term "Finland", which is descriptive for both the First Complainant's and the Respondent's location, as well as for the Complainants' principal market and the market to which the website under the disputed domain name was directed to.

The distinctive element "Hespro" of the First Complainant's trademark is evidently recognizable within the disputed domain name and the addition of the geographical term "Finland" does not prevent a finding of confusing similarity.

The Panel finds that the disputed domain name <hesprofinland.com> is confusingly similar to the First Complainant's HESPROFOODS trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainants have submitted sufficient and uncontested evidence that they hold well-established rights in the HESPROFOODS and HESBURGER trademarks.

The Complainants have never authorized the Respondent to use their trademarks, or any elements of them in any way, and their prior rights in the trademarks precede the date of registration of the disputed domain name.

According to section 2.1 of the [WIPO Overview 3.0](#), 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 the 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.

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant's *prima facie* case.

The website to which the disputed domain name resolved reproduced the exact official website of the Second Complainant and its trademark. Furthermore, the Respondent has further impersonated one of the First Complainant's managers and placed a fraudulent order for basic products of the Complainants.

UDRP panels have categorically held that use of a domain name for impersonation or other types of fraud can never confer rights or legitimate interests on a respondent (see section 2.13.1. of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The website to which the disputed domain name pointed was an exact copy of the Second Complainant's official website, including its HESBURGER trademark, text and product images.

In the Panel's opinion, this demonstrates that the Respondent evidently knew of the Complainants' businesses and trademarks and chose to register and use the disputed domain name to target their

businesses and trademark rights within the meaning of paragraph 4(b)(iv) of the Policy.

The Respondent's impersonation of the Complainants' executives and use of the disputed domain name as the origin of the emails in placing fraudulent orders on their behalf also constitutes bad faith under the Policy (see section 3.4 of the [WIPO Overview 3.0](#) and *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#)).

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

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 <hesprofinland.com> be transferred to the First Complainant, Hes-Pro (Finland) Oy.

/Zoltán Takács /

Zoltán Takács

Sole Panelist

Date: May 24, 2022