

ADMINISTRATIVE PANEL DECISION

Hershey Chocolate & Confectionery LLC v. Host Master, 1337 Services LLC
Case No. D2024-3241

1. The Parties

The Complainant is Hershey Chocolate & Confectionery LLC, United States of America ("US"), represented by Arnold & Porter Kaye Scholer LLP, US.

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Name and Registrar

The disputed domain name <thehersheycompanys.com> is registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 7, 2024. On August 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 14, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 15, 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 16, 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 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 11, 2024.

The Center appointed Geert Glas as the sole panelist in this matter on September 23, 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.

4. Factual Background

The Complainant is a major manufacturer and seller of chocolate and confectionery products and snacks which are put on the market under the HERSHEY and HERSHEY's marks. The name "Hershey" and its possessive genitive "Hershey's" refer to the founder of the Complainant, Milton S. Hershey, who started in 1894 to put chocolate products on the market under his name.

The Complainant and its affiliates own a large number of trademark registrations for the HERSHEY and HERSHEY's marks throughout the world. These trademark registrations include:

- US Trademark No. 54041 for the HERSHEY's mark, registered on June 19, 1906 and with a first use date of January 1, 1894;
- US Trademark No. 1455684 for the HERSHEY mark, registered on September 1, 1987;
- Canada Trademark No. TMA488612 for the HERSHEY mark, registered on January 29, 1998;
- European Union Trademark No. 000381814 for the HERSHEY's mark, registered on June 4, 1999.

The Complainant's HERSHEY and HERSHEY'S marks have been widely advertised and promoted in television, print, online and other advertising, both in the US and elsewhere. As a result, both the HERSHEY and HERSHEY's marks enjoy a strong reputation and are well known throughout the US and the world, as has been confirmed by previous UDRP panels.

The Complainant also owns a domain name <thehersheycompany.com> which it registered in 2004. The Complainant uses this domain name to communicate with the public about its products.

The disputed domain name was registered on October 27, 2023.

It appears from the evidence provided by the Complainant that the disputed domain name redirected to the Complainant's official website at "www.thehersheycompany.com".

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 contends that the disputed domain name wholly incorporates its well-known HERSHEY mark which as such is likely to cause, and was plainly intended to cause, confusion among members of the public. The mere adding of the terms "the" and "company's" is not sufficient to avoid such confusion in view of their generic and descriptive nature. The Complainant also points out that the disputed domain name is identical to its domain name <thehersheycompany.com>, other than the "s" which was added at the end of the term/word "company".

The Complainant states that it is not affiliated in any way with the Respondent and has never authorized the Respondent to register or use the disputed domain name or any of its marks. According to the Complainant, the Respondent has no rights or legitimate interests in the signs Hershey, Hershey's or The Hershey Company and the Respondent is not commonly known by the name "thehersheycompany's" or any variation thereof. The Respondent also does not use the disputed domain name in connection with a bona fide offering of goods and services. To the contrary, it is apparent that the Respondent has intentionally registered the disputed domain name for the illegitimate purpose of posing as a legitimate domain name of the Complainant.

According to the Complainant, given the widespread publicity and fame of the HERSHEY and HERSHEY'S marks and given the Respondent's registration of the disputed domain name which wholly incorporates the

HERSHEY mark as well as the <thehersheycompany.com> domain name of the Complainant, it is indisputable that the Respondent had knowledge of the Complainant's famous marks prior to the registration of the disputed domain name.

To the extent that the Respondent were to claim to be merely holding the disputed domain name, such passive use of a domain name which is confusingly similar to a well-known mark does not constitute a legitimate use.

According to the Complainant, it is obvious that the Respondent knew the prior rights and wide use of the HERSHEY and HERSHEY's marks by the Complainant and as a result registered the disputed domain name in bad faith.

The Respondent also used the disputed domain name in bad faith by automatically redirecting it to the Complainant's "www.thehersheycompany.com" website which creates the false impression to consumers that the disputed domain name is a legitimate domain name of the Complainant, allowing the Respondent to engage in deceptive and fraudulent conduct.

B. Respondent

The Respondent did not reply to the Complainant's contentions

6. Discussion and Findings

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 trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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

Although the addition of the terms "the" and "company's" 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 HERSHEY mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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.

There is indeed no evidence whatsoever of the Respondent being permitted to use the disputed domain name, of the Respondent using the disputed domain name (or having demonstrable plans for such use) in the framework of a bona fide offering, of the Respondent being commonly known by the disputed domain name or of the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

To the contrary, the Respondent has used the disputed domain name to redirect Internet users to the "www.thehersheycompany.com" website which the Complainant registered in 2004 and uses to communicate with the public about its products. As the Complainant's domain name of this website is almost identical to the disputed domain name except for the letter "s" added after "company" in the disputed domain name, this creates the false impression that the disputed domain name is a legitimate domain name of the Complainant. Such attempt to pass off as the Complainant cannot constitute a legitimate or bona fide use of the disputed domain name.

UDRP panels have held that the use of a domain name for illegal activity, here claimed impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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.

As to the registration of the disputed domain name, it should be noted that panels have consistently found that the mere registration of a domain name which is confusingly similar to a famous or widely-known trademark by a non-affiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

This is clearly the case here, as HERSHEY had become a widely-known trademark long before the disputed domain name was registered. As a result, the Respondent knew or should have known the Complainant's HERSHEY mark at the time of registration of the disputed domain name. In addition, the disputed domain name is almost identical to the <thehersheycompany.com> domain name which the Complainant registered in 2004 and uses to communicate with the public about its products, and redirects to the Complainant's official website, which further demonstrates that the Respondent was targeting the Complainant and its marks when registering the disputed domain name.

Based on the available record, the Panel finds that the disputed domain name has been registered in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name is being used in bad faith, e.g., 4(b)(iv): by using the domain name the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other location, by creating a

likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or a product or service on its website or location.

As indicated, the disputed domain name is confusingly similar to the Complainant's HERSHEY mark and redirects to the Complainant's "www.thehersheycompany.com website". By using the disputed domain name in this way, the Respondent is creating the false impression that the disputed domain name is a legitimate domain name of the Complainant and thereby attempting to pass off as the Complainant for potential illegal activity.

The Panel considers this constitutes bad faith use of the disputed domain name by the Respondent. Panels have indeed held that the use of a domain name for illegal activity, here claimed impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element of 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 disputed domain name <thehersheycompanys.com> be transferred to the Complainant.

/Geert Glas/

Geert Glas

Sole Panelist

Date: October 7, 2024