

## **ADMINISTRATIVE PANEL DECISION**

Hershey Chocolate & Confectionery LLC v. Steps 4 Success, Steps 4 Success Inc.

Case No. D2024-3873

### **1. The Parties**

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

The Respondent is Steps 4 Success, Steps 4 Success Inc., Puerto Rico, United States.

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

The disputed domain name <hersheypuertorico.com> is registered with Amazon Registrar, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 23, 2024. On September 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 27, 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 (On behalf of hersheypuertorico.com owner) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 1, 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 October 4, 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 October 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 28, 2024.

On October 31, 2024, the Center suspended the proceedings following the Complainant's request. On February 24, 2025, the Complainant requested that the Center reinstitute the proceedings. On February 25, 2025, the Center sent an email communication to the Parties and the proceedings were reinstituted as of February 25, 2025.

The Center appointed Gary Saposnik as the sole panelist in this matter on February 26, 2025. 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 Delaware limited liability company and is a major manufacturer and seller of chocolate and confectionery products and snacks, including a variety of chocolate and confectionery products as well as related products, which bear the Complainant's HERSHEY and HERSHEY'S marks.

The Complainant's HERSHEY'S trademark has been used in connection with candy, chocolate and confectionery products since 1894. The Complainant and its affiliated companies are the owner of numerous trademark registrations in the United States and throughout the world for the mark HERSHEY'S, including the following:

- HERSHEY'S, United States Registration No. 54041, registered June 19, 1906, in class 30, first use date of January 1, 1894, for "chocolate, cocoa, sweet chocolate, milk chocolate, chocolate coatings, chocolate liquors, and chocolate powder"
- HERSHEY'S, United States Registration No. 863592, registered January 14, 1969, in class 30;
- HERSHEY, United States Registration No. 1455684, registered September 1, 1987, in classes 35, 37, 39, 40, 41 and 42;

The Complainant's licensees use the Complainant's HERSHEY and HERSHEY's marks in connection with the sale of HERSHEY'S chocolate products and other products. The Complainant operates various websites and uses domain names with the marks HERSHEY'S and HERSHEY in the domain name, such as <hersheys.com>, which it uses to provide information about the Complainant and its HERSHEY'S PRODUCTS.

The Complainant and its licensee have achieved billions of dollars of sales under the HERSHEY marks throughout the United States and the world.

The disputed domain name was registered by the Respondent on October 21, 2020. The disputed domain name resolves to a website which includes (i) the HERSHEY's trademark in the same stylized format as the Complainant's mark; (ii) an image of the Complainant's HERSHEY'S chocolate bar; and (iii) numerous images of the Complainant's products. It also includes a submission form, in Spanish, soliciting personal information from Internet users, for what appears to be a webpage related to fundraising. The resolving site also includes language of "Our Mission", "127 Years working for you", and "Use the power of our brand to your advantage to raise funds in Puerto Rico", all in Spanish.

#### **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 subject domain name is identical or confusingly similar to the Complainant's HERSHEY mark. The disputed domain name (i) merely adds the geographic term "PUERTO RICO" to the end of "HERSHEY", (ii) wholly incorporates the registered and well-known HERSHEY trademark, and (iii) is so similar to the Complainant's HERSHEY mark that it is likely to cause, and is intended to cause, confusion among members of the public and others. Numerous UDRP decisions have held that a domain name incorporating the entirety or dominant feature of the relevant mark and including a geographically descriptive term is sufficient to establish confusing similarity. *Hyundai Motor Company and Hyundai Motor America v. Jorge De Los Rios*, WIPO Case No. [D2021-2307](#).

The Complainant avers that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant is not affiliated in any way with the Respondent and has never authorized the Respondent to register or use the domain name at issue or the HERSHEY or HERSHEY'S marks. Upon information and belief, the Respondent is not commonly known by the name "hersheypuertorico" or any variation thereof.

The Complainant's adoption and registration of the marks HERSHEY and HERSHEY'S in the United States and elsewhere precedes the Respondent's registration of the disputed domain name. Moreover, given the widespread publicity and fame of the HERSHEY and HERSHEY'S marks, and the Respondent's deceptive use of the website at the subject domain name, it is indisputable that the Respondent had knowledge of the Complainant's famous marks prior to the registration of the disputed domain name.

The Respondent cannot demonstrate any rights or legitimate interests in the disputed domain name, as the Respondent is not using the subject domain name in connection with a bona fide offering of goods or services within the meaning of Paragraph 4(c)(i) of the Policy. To the contrary, the Respondent has intentionally registered the disputed domain name explicitly for the purpose of making an illegitimate or unfair use of the Complainant's mark by posing as a legitimate domain name of the Complainant, likely in order to engage in a fraudulent scheme and/or activities.

Based on the Respondent's statements on the website, and request for information, the Respondent registered and uses the subject domain name in a fraudulent scheme to falsely hold itself out as the Complainant, and/or to phish and collect personal information from Internet users, falsely posing as the Complainant. By using the subject domain name, the Respondent is attempting to trick users into submitting their personal information based upon the belief that the user will be participating in a Complainant's fundraising campaign or a lottery raffle upon submission of their personal information.

The Complainant further contends that although some UDRP decisions hold that a reseller of genuine product can use a manufacturer's mark under certain narrow circumstances, even those decisions require that the site accurately disclose the registrant's relationship with the trademark owner, among other requirements. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). However, the Respondent not only fails to disclose the nature of a relationship with the Complainant (or lack thereof), but affirmatively mislead consumers by falsely masquerading as the Complainant on the Respondent's website, which, further does not in any way disclaim an affiliation with the Complainant.

The nature of the disputed domain name, with the Complainant's mark, followed by a geographic location, carries a risk of implied affiliation with the Complainant, further confirming the lack of rights or legitimate interests. [WIPO Overview 3.0](#), Section 2.5.1. The Respondent also cannot claim to be making any legitimate non-commercial use within the meaning of the Policy.

Lastly, the Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. This is apparent from the longstanding and widespread use and registration of the Complainant's marks which far pre-date the Respondent's registration of the disputed domain name. *Hershey Chocolate & Confectionery LLC v. Domain Name Admin, NoWhois LLC (nowhois.org)* WIPO Case No. [D2023-1408](#). Given the international fame of the marks and names HERSHEY and HERSHEY'S, it is inconceivable that the Respondent might have registered a domain name similar to or incorporating the mark without knowing of it, and it would be natural to conclude that the Respondent registered the disputed

domain name in order to take advantage of the Complainant's reputation and its trademarks, constituting opportunistic bad faith under the Policy.

Furthermore, the Respondent's bad faith is demonstrated by their registration and use of a domain name that consists wholly of the famous HERSHEY mark and the geographic description "Puerto Rico", which inevitably conveys that the domain name is owned or authorized by the Complainant. This is additionally demonstrated by their use of the disputed domain name for a website that masquerades as a Complainant's website and on which the Respondent literally claims to be the Complainant, even going as far to say "Utiliza el poder de nuestra marca a tu favor para recaudar fondos en Puerto Rico", i.e. "Use the power of our brand to your advantage to raise funds in Puerto Rico". The Respondent's affirmative false statements that it is the Complainant and the HERSHEY'S brand is its brand confirm the Respondent's bad faith.

## **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 a trademark or service mark 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 other terms here, "puertorico", may bear on assessment of the second and third elements, the Panel finds the addition of a geographical term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

The Complainant is not affiliated in any way with the Respondent and has never authorized the Respondent to register or use the domain name at issue or the HERSHEY or HERSHEY'S marks. The Respondent does not appear to be commonly known by the name "hersheypuertorico" or any variation thereof.

The disputed domain name resolves to a website with obvious inclusion of the Complainant's marks and images, along with requests for information from users of the website. It is an apparent attempt to solicit Internet users to purchase the Complainant's goods for use in fundraising efforts or for a sweepstakes, clearly for a commercial purpose.

The disputed domain name consists of the Complainant's well-known HERSHEY mark, along with a geographic term that would effectively suggest sponsorship or endorsement by the Complainant. UDRP panels have found that domain names identical to complainant's trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term, UDRP panels have held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), Section 2.5.1.

While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant, along with the lack of any information on the resolving website as to the website's lack of authorization or relation to the Complainant, renders any fair use safe haven inapplicable in this instance. *Hershey Chocolate & Confectionery LLC v. Domain Admin, NoWhois LLC (nowhois.org)*, WIPO Case No. [D2023-1408](#); [WIPO Overview 3.0](#), section 2.8.

The Respondent's website also includes a copyright notice attributed to "Hershey's Puerto Rico por Steps 4 Success, Inc. de San Juan, Puerto Rico". Combined with the other language and images on the website, along with a lack of disclaimer of affiliation with the Complainant, it is clear that the resolving website further impersonates or suggests sponsorship or endorsement by the Complainant, where such sponsorship or endorsement does not exist. Additionally, the solicitation of personal information and payment may be evidence of a phishing site.

Panels have held that the use of a domain name for illegitimate activity, here, claimed as applicable to this case: possible phishing, and impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, the Panel notes that the Respondent registered the disputed domain name more than 100 years after the Complainant began using and registered its well-known HERSHEY'S mark, and decades after registration and use of the HERSHEY marks. As previously discussed, the disputed domain name resolves to a website with images and use of the Complainant's famous HERSHEY'S marks and candy bars, while soliciting information for apparent fundraising purposes.

The Complainant has not authorized the registration or use of the disputed domain name nor use of its marks or images by the Respondent. Combined with the language on the website, and the lack of any language disclosing no affiliation with the Complainant, the facts establish a deliberate effort by the Respondent to

cause confusion with the Complainant for commercial gain. Such impersonation of the Complainant is sufficient to establish the Respondent's bad faith. Panel have also found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), Section 3.1.4.

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.

Additionally, Panels have held that the use of a domain name for illegitimate activity, here, claimed as applicable to this case: possible phishing of personal and financial information, and impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Respondent's registration and use of the disputed domain name was an obvious intentional attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's marks. Having reviewed the record, the Panel finds 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 <hersheypuertorico.com> be transferred to the Complainant.

*/Gary Saposnik/*

**Gary Saposnik**

Sole Panelist

Date: March 12, 2025