

ADMINISTRATIVE PANEL DECISION

Hemsö Fastighets AB v. da da
Case No. D2022-3738

1. The Parties

The Complainant is Hemsö Fastighets AB, Sweden, represented by Ports Group AB, Sweden.

The Respondent is da da, China.

2. The Domain Name and Registrar

The disputed domain name <hemso.homes> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 6, 2022. On October 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 6, 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 October 10, 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 October 28, 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 October 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 22, 2022.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on November 28, 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 Complainant is a limited liability company incorporated in Stockholm, Sweden, in 2009. The Complainant is a property developer that manages and develops community properties as well as properties for nursing homes, education, health care and the judiciary. The Complainant operates the official website under the domain name <hemso.se>, created on November 15, 2008.

The Complainant is the owner of a number of trademark registrations around the world for the HEMSÖ trademark, including:

- European Union Trademark Registration No. 011377884 for HEMSÖ, registered on March 31, 2013;
- United Kingdom Trademark Registration No. UK00911377884 for HEMSÖ, registered on March 31, 2013;
- European Union Trademark Registration No. 014636369 for HEMSÖ, registered on January 18, 2016;
- United Kingdom Trademark Registration No. UK00914636369 for HEMSÖ, registered on January 18, 2016;
- European Union Trademark Registration No. 014696546 for HEMSÖ (stylized), registered on February 3, 2016;
- United Kingdom Trademark Registration No. UK00914696546 for HEMSÖ (stylized), registered on February 3, 2016.

The disputed domain name <hemso.homes> was created on May 6, 2022, and used to refer to the website with a tool for a free URL shortener. On the date of filing the Complaint, the disputed domain name did not resolve to an active website.

On August 29, 2022, the cease-and-desist letter was sent to the Respondent via the Registrar. The Registrar provided the response and suggested to resolve the domain name dispute under the UDRP.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant asserts registered rights in the HEMSÖ trademark. The Complainant submits that the disputed domain name is confusingly similar to the HEMSÖ trademark.

The Complainant contends that the disputed domain name incorporates the HEMSÖ trademark, substituting the letter "ö" at the end by "o" due to technological limitation.

The Complainant submits that the applicable Top-Level Domain ("TLD") in the disputed domain name should be viewed as a standard registration requirement and as such should be disregarded under the first element confusing similarity test. The addition of the TLD ".homes" to the disputed domain name increases the likelihood of confusion given that the Complainant's business activities are solely pertaining to properties.

No rights or legitimate Interests

The Complainant submits that disputed domain name was registered on May 6, 2022, many years after the first registrations of the Complainant's HEMSÖ trademark.

The Complainant claims that it has not licensed or authorized the Respondent to register or use the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks.

The disputed domain name is passively held. It does not resolve to an active website. Earlier the disputed domain name used to refer to the website with a tool for a free URL shortener, and the website was classified as a malware. The Complainant submits that there is no evidence showing that the Respondent has been using, or preparing to use, the disputed domain name in connection with a *bona fide* offering of goods and services or has made a legitimate noncommercial or fair use of the disputed domain name.

Thus, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Registered and used in bad faith

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant asserts that the Respondent must have had knowledge of the Complainant's rights in the HEMSÖ trademark when registering the disputed domain name. The Complainant submits that the Respondent's non-use of the disputed domain name amounts to use of the disputed domain name in bad faith, under the doctrine of passive holding.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint 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."

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under the first element the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainant submitted evidence that the HEMSÖ trademark enjoys protection under national and regional trademark registrations. Thus, the Panel finds that the Complainant's rights in the HEMSÖ trademark have been established pursuant to the first element of the Policy.

The disputed domain name fully incorporates the Complainant's HEMSÖ trademark, substituting the letter "ö" at the end by "o". This leads to the finding that the disputed domain name is considered identical to the Complainant's trademark for purposes of the UDRP (section 1.7. of the [WIPO Overview 3.0](#)).

The applicable TLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (section 1.11.1. of the [WIPO Overview 3.0](#)). The meaning of the TLD ".homes" does not impact assessment of the first element, but will be relevant to panel assessment of the second and third elements. See section 1.11.2 of [WIPO Overview 3.0](#).

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its HEMSÖ trademark.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use – neither commercial nor noncommercial, of the same.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The disputed domain name does not resolve to an active website. Prior UDRP panels have found that the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#), *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#), "The passive holding of the disputed domain name does not amount to use or preparations to use it in connection with a *bona fide* offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.").

The Panel agrees and holds the passive holding of the disputed domain name by the Respondent in this case as evidence that the Respondent has not registered the disputed domain name in connection with any *bona fide* offering of goods or services.

Previous UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. The structure of the disputed domain name reflects the Respondent's intention to

create an association, and a subsequent likelihood of confusion, with the Complainant and their HEMSÖ trademark in Internet users' mind as the TLD ".homes" in the disputed domain name triggers the inference of affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel finds that the composition of the disputed domain name effectively impersonates or suggests sponsorship or endorsement by the Complainant which cannot constitute fair use.

By not submitting a Response, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Under such circumstances the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

The disputed domain name was created on May 6, 2022, and is passively held by the Respondent. The only known use of the disputed domain name has been to resolve to a website with a tool for a free URL shortener, and the website has been classified as malware.

The Complainant has produced evidence showing that it owns registrations for the HEMSÖ trademark, of which registration dates significantly precede the creation date of the disputed domain name. In addition, the Complainant has credibly submitted that over the years it has developed substantial goodwill in the HEMSÖ trademark.

As stated above, the structure of the disputed domain name shows that the Respondent registered it having the Complainant and their HEMSÖ trademark in mind. It reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind. Internet users may believe that it is directly connected to or authorized by the Complainant.

The registration of a domain name with the knowledge of the complainant's trademark registration amounts to bad faith (see, *Herbalife International, Inc. v. Surinder S. Farmaha*, WIPO Case No. [D2005-0765](#)).

The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. Under section 3.3 of the [WIPO Overview 3.0](#), the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding.

While panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See, *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. / Armando Machado*, WIPO Case No. [D2018-0082](#), *Carrefour SA v. Dexter Turner*, WIPO Case No. [D2022-2032](#), see also *Skandinaviska Enskilda Banken AB v. Nick Jones*, WIPO Case No. [D2021-0703](#).

Each of these considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically: (i) the Complainant's HEMSÖ mark is distinctive and well-established, (ii) the Respondent has failed to submit a response to the Complaint or provide any evidence of good-faith use, (iii) there is no conceivable good faith use to which the disputed domain name could be put by the Respondent (see, e.g. *Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), which stated that "it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith").

The third element of paragraph 4(a) of the Policy is therefore 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 <hemso.homes> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: December 12, 2022