

ADMINISTRATIVE PANEL DECISION

Hershey Chocolate & Confectionery LLC v. Domain Admin, NoWhois LLC
(nowhois.org)

Case No. D2023-1408

1. The Parties

The Complainant is Hershey Chocolate & Confectionery LLC, United States of America (“United States” or “U.S.”), represented by Arnold & Porter Kaye Scholer LLP, United States.

The Respondent is Domain Admin, NoWhois LLC (nowhois.org), United States.

2. The Domain Name and Registrar

The Disputed Domain Name <hersheymx.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2023. On April 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 9, 2023.

The Center appointed Colin T. O’Brien as the sole panelist in this matter on May 11, 2023. 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, including a variety of chocolate and confectionery products as well as related products.

The Complainant's HERSHEY'S trademark has been used in connection with candy, chocolate and confectionery products since 1894. The Complainant owns numerous trademark registrations in the United States and other countries for the HERSHEY'S mark, including U.S. Trademark Registrations 54,041, registered, June 19, 1906, and 863,592, registered January 14, 1969, each with a first use date of January 1, 1894, as well as hundreds of other registrations worldwide covering the HERSHEY'S mark for various goods and services. The Complainant also owns U.S. Trademark Registrations No. 1,455,684 for the mark HERSHEY and 2,649,859 for the mark HERSHEY'S.COM for, *inter alia*, "computer services, namely, providing on-line information through web sites on global computer networks in the field of food, food preparation, food distribution, recipes, and information and news about chocolate, candy, confectionery, baking, and sweet snack food."

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

The Complainant owns the domain names <hersheys.com>, <hersheyland.com>, <hersheyland.mx>, and <hersheys.mx>, among others, which are used to communicate with the public about the Complainant's products.

The disputed domain name was registered on December 13, 2022, and as claimed by the Complainant, used to mimic the Complainant's own website at "www.hersheyland.mx".

5. Parties' Contentions

A. Complainant

The disputed domain name (1) merely adds the letters "mx", a well-known abbreviation for the country Mexico, to the end of "hersheys," (2) wholly incorporates the Complainant's registered and well-known HERSHEY'S trademark, and (3) is so clearly similar to the Complainant's HERSHEY'S mark that it is likely to cause, and plainly is intended to cause, confusion among members of the public and others.

The Complainant has well-established trademark rights throughout the world in the HERSHEY and HERSHEY'S mark. Because the disputed domain name identically replicates those marks, the disputed domain name is confusingly similar to the Complainant's marks.

The Complainant is not affiliated in any way with the Respondent and has never authorized the Respondent to register or use the disputed domain name or the HERSHEY or HERSHEY'S marks. The Respondent has no right or legitimate interest in the marks HERSHEY or HERSHEY'S, or in the disputed domain name. Upon information and belief, the Respondent is not commonly known by the name "hersheysmx" 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, as set forth more fully below, given the widespread publicity and fame of the HERSHEY and HERSHEY'S marks, and the Respondent's deceptive use of the website at the disputed 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.

It is apparent that the Respondent has intentionally registered the disputed domain name explicitly for the purpose of making an illegitimate or unfair use of HERSHEY'S marks by misleading and diverting Internet

users who are seeking information about the Complainant and its products to the Respondent's for-profit web site.

The Respondent is using the disputed domain name for a counterfeit website posing as a genuine website of the Complainant; the Respondent's website mimics the appearance of the Complainant's own website at "www.hersheyland.mx", including use of the well-known HERSHEY'S logo and trade dress throughout, and the general appearance of the site.

The Respondent's website also includes product pages and descriptions for various of the Complainant's products offered for sale, and contains historical information regarding the Complainant as a company and other elements that are also found on the Complainant's own website. As a result, the Respondent's use of the disputed domain name leads visitors to falsely believe that the website at the disputed domain name is a genuine website of the Complainant and demonstrates bad faith use and registration.

The Respondent has registered the disputed domain name in bad faith by doing so with full knowledge of the Complainant's rights in the HERSHEY and HERSHEY'S marks. This is readily apparent from the above counterfeit use of the Respondent's website as well as the longstanding and widespread use and registration of HERSHEY'S marks, which far pre-date the Respondent's registration of the disputed domain name.

Given the international fame of the mark 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.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the famous HERSHEY mark and has shown that no other entity has rights in or uses the Complainant's mark. The addition of "mx" does not prevent the Complainant's trademark from being recognizable in the disputed domain name. The disputed domain name remains phonetically identical to the Complainant's trademark. The Top-Level domain ("TLD") ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the disputed domain name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name and has not been commonly known by the disputed domain name. The fact that the Respondent obtained the disputed domain name over 125 years after the Complainant had begun using its HERSHEY mark, indicates that the Respondent sought to piggyback on the HERSHEY mark for illegitimate reasons.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. Moreover, the evidence provided by the Complainant shows that the disputed domain name resolved to an active website seemingly impersonating the Complainant's website at <hersheyland.mx>. 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 and similarly, the lack of any information on the disputed domain name as to the website's lack of authorization or relation to the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Irrespective of the disputed domain name satisfying the so-called *Oki Data* test, the nature of the disputed domain name, encompassing the Complainant's trademark in its entirety save the apostrophe which is not a permitted symbol in a domain name, and the addition of "mx" which is commonly known as the abbreviation for Mexico, carries a high risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has satisfied its burden of proof in establishing the Respondent's bad faith in registration and use of the disputed domain name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the renown and uniqueness of the HERSHEY mark, it is inconceivable that the Respondent registered the disputed domain name without knowledge of the Complainant. The disputed domain name was used for a website that was mirroring a website operated by the Complainant but the Complainant has established that the Respondent's use is not authorized, nor is affiliated with the Complainant in any way. 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 (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the disputed domain name was registered and used in bad faith.

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 <hersheysmx.com>, be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: May 24, 2023