

ADMINISTRATIVE PANEL DECISION

Hershey Chocolate & Confectionery LLC v. Samuel Smith
Case No. D2023-4647

1. The Parties

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

Respondent is Samuel Smith, United States.

2. The Domain Name and Registrar

The disputed domain name <chocolatereesessticks.info> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2023. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 9, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to Complainant on November 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 14, 2023.

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 Respondent of the Complaint, and the proceedings commenced on November 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 8, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on December 18, 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

Complainant, a Pennsylvania, United States company, sells chocolate and confectionery products, including REESE'S brand products throughout the United States and elsewhere in the world.

Complainant is the owner of several registered trademarks in the United States and other countries for the REESE'S marks and REESE'S STICKS marks, including:

- United States trademark registration number 1,074,163 for the REESE'S word mark, registered on September 27, 1977;
- United States trademark registration number 1,834,806 for the REESE'S word mark, registered on May 3, 1994; and
- United States trademark registration number 2,174,012 for the REESE'S STICKS word mark, registered on July 14, 1998.

Complainant and its authorized licensees use these marks in connection with the sale of REESE'S and REESE'S STICKS chocolate and confection products.

Complainant also owns and operates several websites with the mark REESE'S in the domain name, such as <reeses.com>, which it uses to provide information regarding its REESE'S products.

The Domain Name was registered on February 24, 2023 and at the time of the filing of the Complaint, resolved to an inactive site. At the time of the Decision, the Domain Name resolved to an unavailable website.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for REESE'S and REESE'S STICKS and that Respondent registered and is using the Domain Name with the intention to confuse Internet users looking for *bona fide* and well-known REESE'S and REESE'S STICKS products and services.

Complainant notes that it has no affiliation with Respondent and contends that Respondent is using the Domain Name as a tool to exploit Complainant's reputation for its own commercial gain, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name other than trademark infringement. Further, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) states that failure to respond to the complainant’s contentions would not by itself mean that the complainant is deemed to have prevailed; and a respondent’s default is not necessarily an admission that the complainant’s claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence of its rights in the REESE’S and REESE’S STICKS trademarks, as noted above under section 4. Complainant has also submitted evidence, which supports that the REESE’S and REESE’S STICKS trademarks are widely known and a distinctive identifier of Complainant’s products and services. Complainant has therefore proven that it has the requisite rights in the REESE’S and REESE’S STICKS trademarks.

With Complainant’s rights in the REESE’S and REESE’S STICKS trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain (“TLD”) in which it is registered (in this case is, “.info”), is identical or confusingly similar to Complainant’s trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant’s REESE’S and REESE’S STICKS trademarks. The REESE’S and REESE’S STICKS trademarks are recognizable in the Domain Name. In particular, the Domain Name’s inclusion of Complainant’s trademarks REESE’S and REESE’S STICKS in its entirety, with the addition of the term “chocolate”, absence of the apostrophe (’) between “e” and “s” in “REESE’S” and the additional absence of a space between “REESE’S” and “STICKS” in “REESE’S STICKS” does not prevent a finding of confusing similarity between the Domain Name and Complainant’s REESE’S and REESE’S STICKS trademarks. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make 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 relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its REESE'S and REESE'S STICKS trademarks, and does not have any rights or legitimate interests in the Domain Name. In addition, Complainant asserts that Respondent is not an authorized reseller and is not related to Complainant. Respondent is also not known to be associated with the REESE'S and REESE'S STICKS trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of filing of the Complaint, the Domain Name reverted to an inactive website. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Moreover, the nature of the Domain Name is inherently misleading, and carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

“(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 Panel finds that Complainant has provided ample evidence to show that registration and use of the REESE'S and REESE'S STICKS trademarks long predate the registration of the Domain Name.

Complainant is also well established and known. Indeed, the record shows that Complainant's REESE'S and REESE'S STICKS trademarks and related products and services are widely known and recognized. The evidence provided by Complainant with respect to the extent of use and global fame of its REESE'S and REESE'S STICKS mark combined with the absence of any evidence provided by Respondent to the

contrary, suggests to the Panel that, at the time the Domain Name was registered, Respondent was likely aware of the REESE'S and REESE'S STICKS trademarks and should have known that the Domain Name is confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; and see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

Moreover, the additional descriptive term "chocolate" in the Domain Name is also directly associated with Complainant's business activities in the field of chocolates and confection products, further indicating Respondent's actual knowledge of Complainant and its trademarks, and that Respondent's registration of the Domain Name was in bad faith.

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

The fact that the Domain Name does not resolve to a website and is in effect being passively held does not prevent a finding of bad faith. When a domain name is being passively held, the question of bad faith use does not squarely fall under one of the non-exhaustive factors set out in paragraph 4(b) of the Policy. However, section 3.3 of the [WIPO Overview 3.0](#), instructs that UDRP panels should examine the totality of the circumstances in each case and that the following factors that have been considered relevant in applying the passive holding doctrine: "(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."

Here Complainant has submitted evidence that its fanciful REESE'S and REESE'S STICKS mark has been used for many years globally before Respondent's registration of the Domain Name. Respondent has not offered any evidence to rebut this conclusion, nor has he provided any evidence of his intended good faith use of the Domain Name. Given these circumstances, the Panel finds that the Domain Name has been used in bad faith by Respondent.

Accordingly, the Panel finds that Respondent registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Name <chocolatereesessticks.info> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: December 26, 2023