

ADMINISTRATIVE PANEL DECISION

Hero GmbH & Co. KG v. Theresa W Chavez
Case No. D2024-1582

1. The Parties

The Complainant is Hero GmbH & Co. KG, Germany, represented by Boehmert & Boehmert, Germany.

The Respondent is Theresa W Chavez, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <haixsa.top> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 15, 2024. On April 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 22, 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 amendment to the Complaint April 23, 2024.

The Center verified that the Complaint together with the amendment to 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 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2024.

The Center appointed Rodrigo Velasco Santelices as the sole panelist in this matter on May 27, 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 German manufacturer of footwear, in particular functional footwear for the fire brigade, military, forestry, rescue services, hunting, and police, as well as casual footwear for the streetwear sector. The company was founded in 1948 and has since developed into a global manufacturer.

The Complainant has always marketed its products under the trademark HAIX. The brand name is derived from the name of the founder, Xaver Haimerl. He added the “x” of his first name to the first three letters of his surname and created Haimerl Xaver Shoe manufacturing: Haix.

The Complainant has registered the trademark HAIX in various jurisdictions for its wide range of footwear. Among them, but by no means limited to, are the following trademark registrations (referred as “HAIX trademarks”):

- European Union Trademark No. 007156235: HAIX (word), registered on April 23, 2009; and
- International Registration Trademark No. 634715: HAIX (word), registered on March 21, 1995, designating Australia, Colombia, Iceland, Mexico, Norway, New Zealand, Singapore, Bosnia and Herzegovina, Switzerland, Croatia, Russian Federation, and Ukraine.

Printouts from the official trademark databases for these trademark registrations were attached as Annex 4.

As can be seen from the lists of goods, the Complainant sells not only shoes but also related products. Its product range also includes clothing, sporting goods, and much more.

The disputed domain name <haixsa.top> was registered on February 21, 2024. At the time of filing the Complaint, it resolved to a website prominently displaying the Complainant’s trademarks and purportedly selling the Complainant’s branded products at discounted prices. A screenshot of the homepage of said website was attached as Annex 6.

The Respondent is reportedly located in the United States.

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 is the registered owner of the HAIX trademarks in numerous jurisdictions, including, but not limited to the European Union. Thus, it cannot be questioned that the disputed domain name is confusingly similar to the trademark registrations of the Complainant.

The disputed domain name identically adopts the Complainant’s HAIX trademarks. Further, the disputed domain name reproduces the HAIX trademarks in its entirety in addition to the letters “sa”. This addition is not sufficient to remove the disputed domain name from the area of similarity to the Complainant’s trademarks. In particular, the pronunciation of the domain name is still highly similar to the HAIX trademarks. If a consumer is told about the Complainant’s HAIX trademarks, he/she may misspell the corresponding domain name and end up with the disputed domain name. In certain circumstances, the ending “sa” may also be perceived as merely a non-distinctive geographical indication, for example for South Africa (SA).

Accordingly, any Internet user when visiting a website provided under the disputed domain name will reasonably expect to find a website commercially linked to the owner of the HAIX trademarks.

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 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.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy.

Although the addition of other terms, in this case the letters "sa", may bear on assessment of the second and third elements, the Panel finds the addition of such 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. Further, the addition of the letters "sa" to the registered trademark HAIX may also be perceived as merely a geographical indication, for example for South Africa (SA) or South America (SA). Thus, any Internet user when visiting a website provided under the disputed domain name will reasonably expect to find a website commercially linked to the Complainant, which was clearly the intent of the Respondent given the impersonating nature of the webstore to which the disputed domain name resolves (e.g., featuring the Complainant's trademark and goods, yet no disclaimer as to the lack of relationship is displayed).

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: impersonation/passing off, 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 has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, UDRP paragraph 4(b)(iv). There is in fact no such connection between the website and the Complainant.

The Complainant's trademarks were registered 28 years prior to the registration of the disputed domain name. At the time of filing the Complaint, the disputed domain name resolved to a website prominently displaying the Complainant's trademarks and purportedly selling the Complainant's branded products at discounted prices.

Consequently, it is evident that the Respondent was well aware of the Complainant when registering the disputed domain name.

The Complainant's HAIX trademark is well known and has no descriptive meaning for the goods in question. Thus, the adoption by the Respondent can therefore not be a coincidence.

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.

Panels have held that the use of a domain name for illegal activity, here, claimed as applicable to this case, impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. 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 <haiksa.top> be transferred to the Complainant.

/Rodrigo Velasco Santelices/

Rodrigo Velasco Santelices

Sole Panelist

Date: June 10, 2024