

ADMINISTRATIVE PANEL DECISION

Hill's Pet Nutrition, Inc. v. mike simon
Case No. D2024-2553

1. The Parties

The Complainant is Hill's Pet Nutrition, Inc., United States of America ("United States"), represented by Fross Zelnick Lehrman & Zissu, PC, United States.

The Respondent is mike simon, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <hillspetstore.shop> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 21, 2024. On June 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 24, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 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 July 3, 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 July 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 13, 2024.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on August 19, 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

In the late 1930s, Dr. Morris Frank, developed Raritan Ration B, a pet food that was the forerunner of Hill's Prescription Diet k/d Canine that was developed for dogs with renal failure and insufficiency. In 1948, Dr. Morris contracted with Burton Hill of the Hill Packing Company in Topeka, Kansas, to can the food with a new name, Canine k/d, and licensed Hill to produce his pet food formulas. In the following years, the partnership between Dr. Morris and the Hill Packing Company evolved into Hill's Pet Nutrition, and it continued to grow and add formulas of therapeutic pet food to its Prescription Diet line of products. The line has continued to expand, and today includes more than 50 pet foods formulated for many lifestages and special needs in healthy pets. In 1976, the Colgate-Palmolive Company purchased the Complainant, Hill's Pet Nutrition.

The Complainant is the owner of several trademarks for HILL'S ("HILL'S trademark"), including:

- United States Trademark Registration HILL'S No. 955,342, registered on March 13, 1973,
- United States Trademark Registration HILL'S No. 1,417,169, registered on November 18, 1986, and
- United States Trademark Registration HILL'S No. 2,060,554, registered on May 13, 1997.

The Complainant is also owner of several domain names including the HILL'S trademark, such as the domain name <hillspet.com>, registered on April 2, 1995.

The disputed domain name was registered on April 8, 2024. At the time of decision and when the Complaint was filed, the disputed domain name resolved to a website, which purports to be for Pawsible Pet Emporium and offering pet accessories. Further, the Complainant has provided evidence showing that the disputed domain name previously resolved to a website offering pet food products bearing the HILL'S trademark and displaying product images of the Complainant's.

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.

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the HILL'S trademark. The disputed domain contains the HILL'S trademark, merely adding the non-distinctive terms "pet" and "store" and the generic Top-Level Domain ("gTLD") ".shop". The gTLD indicator ".shop" cannot be taken into consideration when judging confusing similarity. That the disputed domain name does not include the apostrophe found in the HILL'S trademark is irrelevant for purposes of determining similarity since it is impossible to include an apostrophe in a domain name given ICANN limitations. The Respondent cannot avoid an adverse finding simply because it added terms like "pet" and "store" to the Complainant's well-known HILL'S trademark. UDRP panels also have held, repeatedly, that the addition of descriptive terms does not alleviate any confusion between the disputed domain name and the HILL'S trademark. In fact, given that the Complainant is a leading pet food retailer and that the disputed domain name redirects to a website that previously used many of the Complainant's product images to purportedly sell the Complainant's products, the addition of the terms "pet" and "store," to the HILL'S trademark in the disputed domain name makes confusion more likely.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent registered the disputed domain name long after the Complainant had established rights in its HILL'S trademark through extensive use of the mark around the world for decades. Given that the Complainant's adoption and extensive use of the HILL'S trademark predates the Respondent's registration of the disputed domain name, the burden is on the Respondent to establish its rights or legitimate interests in the disputed domain name. Further, no relationship exists between the Respondent and the Complainant or any of the Complainant's licensees, agents or affiliated companies that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name, which incorporates and is confusingly similar to the Complainant's HILL'S names and the HILL'S trademark. The Respondent is not commonly known by the disputed domain name, as shown by its registration information and website. Since the HILL'S trademark is so well-known and the Respondent has no rights therein, the only reason that the Respondent could have for registering and using the disputed domain name is that the Respondent knew of the HILL'S trademark and wanted to trade on the Complainant's renown to misdirect the Complainant's customers to the Respondent's unofficial website. The website associated with the disputed domain name was previously passing itself off as the Complainant's own website, purportedly offering the Complainant's pet food products and stealing the Complainant's images to do so. The Respondent's websites trade on the fame of the HILL'S trademark and as such could not constitute a bona fide use. Further, there is no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name or operate a website that mimics the Complainant's own website. The Complainant has never authorized the Respondent to use the HILL'S trademark, or any marks confusingly similar thereto, for any purpose, including as a domain name. Consequently, the Respondent's use of the HILL'S trademark in the disputed domain name cannot be bona fide. Moreover, even if the goods being sold at the Respondent's websites were genuine HILL'S merchandise (and there is no evidence that this is the case), the Respondent's use of the disputed domain name would still not be bona fide. Under the majority view, for a reseller to make a bona fide use of a trademarked term in a domain name, the Respondent must inter alia: (1) sell only the trademarked goods or services; and (2) accurately disclose the Respondent's relationship with the trademark owner. Even if the Respondent sold only genuine HILL'S products through the website associated with the disputed domain name, the website fails to disclose the lack of any relationship between the Complainant and the Respondent and therefore the Respondent has failed to demonstrate a legitimate interest in the disputed domain name through its use. In sum, it is clear that the Respondent is trading on the fame and goodwill of the HILL'S trademark without authorization, and thus there is no basis for the Respondent to claim that it has legitimately registered and used the disputed domain name.

On the third element of the Policy, the Complainant asserts that the Respondent has registered and used the disputed domain name in bad faith. First, there can be no dispute that the HILL'S trademark is immediately recognizable and famous. The Respondent's adoption and use of the HILL'S trademark in the disputed domain name and in connection with the previous website that obviously traded on the goodwill of the HILL'S trademark shows both the Respondent's familiarity with the HILL'S trademark and the Respondent's recognition of the fame of the mark. There is no reason for the Respondent to have chosen the disputed domain name unless the Respondent was seeking to create an association with the Complainant. Since the Respondent has no connection with the Complainant and has never been authorized by the Complainant to use or register the disputed domain name, the very fact that the Respondent has registered the disputed domain name establishes opportunistic bad faith use and registration. Second, the disputed domain name incorporates the HILL'S trademark and is confusingly similar to the HILL'S trademark, as discussed above. Given the fame of the HILL'S trademark, consumers are likely to believe, mistakenly, that the disputed domain name is related to or associated with the Complainant. Because the ultimate effect of any use of the disputed domain name will be to cause confusion with the Complainant, the use and registration of the disputed domain name must be considered to be in bad faith. Third, the disputed domain name was being used in connection with a website that mimicked the Complainant's own and used the Complainant's own product images without authorization. Such activities have repeatedly been found to constitute bad faith use. Indeed, the Respondent's activity is in direct violation of paragraph 4(b)(iv) of the Policy, which prohibits use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the site. In

sum, the only reason for the Respondent's use of the HILL'S trademark in the disputed domain name and at the corresponding website is to intentionally confuse consumers, to trade on the Complainant's rights and reputation, and to drive traffic to the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

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

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 3.0](#), section 1.7.

The applicable Top-Level Domain ("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. [WIPO Overview 3.0](#), section 1.11.1.

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, except for the apostrophe within the HILL'S trademark due to technical reasons. As the mark is recognizable within the disputed domain name, the absence of the apostrophe does not prevent a finding of confusing similarity. 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, "pet" and store") 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.

The Complainant has provided evidence showing that the disputed domain name resolved to a website offering pet food products bearing the HILL’S trademark and displaying product images of the Complainant.

The Panel is of the opinion that even if the goods being sold at the Respondent’s websites were genuine HILL’S merchandise, the Respondent’s use of the disputed domain name would still not be bona fide as the Respondent cannot be assessed as a legitimate dealer for the Complainant’s products in light of *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). The website linked to the disputed domain name does not accurately and prominently disclose the relationship, or rather the lack thereof, between the Respondent and the Complainant, thus creating the false impression that the Respondent might be an official and/or authorized reseller/distributor for the Complainant’s products. This assessment is further supported by the nature of the disputed domain name, which in view of the Panel carries a risk of implied affiliation or association, as stated in section 2.5.1 of the [WIPO Overview 3.0](#).

The change of the use after the Respondent was contacted by the Complainant does not change the Panel’s findings due to the misleading nature of the disputed domain name.

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.

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.

The Panel notes that the HILL’S trademark was registered before the disputed domain name, and particularly considering the previous use to which the disputed domain name was put, the Panel finds that it is more likely than not that the Respondent registered the disputed domain name with knowledge of the Complainant’s trademark, which indicates registration in bad faith.

Further, the Complainant has provided evidence showing that the disputed domain name resolved to a website offering pet food products bearing the HILL'S trademark and displaying product images of the Complainant. The Panel finds that the Respondent has intentionally tried to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and its HILL'S trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

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 <hillspetstore.shop> be transferred to the Complainant.

/Christian Gassauer-Fleissner/
Christian Gassauer-Fleissner
Sole Panelist
Date: September 2, 2024