

## **ADMINISTRATIVE PANEL DECISION**

HEMA B.V v. NameSilo, LLC, Domain Administrator  
Case No. D2024-3007

### **1. The Parties**

The Complainant is HEMA B.V, Netherlands (Kingdom of the) (“Netherlands”), represented by HGF Limited, Netherlands.

The Respondent is NameSilo, LLC, Domain Administrator, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <hemanl.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 July 24, 2024. On July 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 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 25, 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 25, 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 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 21, 2024.

The Center appointed Torsten Bettinger as the sole panelist in this matter on August 26, 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 retailer in the Netherlands which was founded in 1926. It operates retail stores in the Netherlands, Germany, Luxembourg, Belgium, France, Austria, and Spain and also outside the European Union ("EU") namely in the United Arab Emirates, Qatar, and Mexico.

The Complainant provided evidence of ownership of numerous trademark registrations for HEMA in many jurisdictions throughout the world, including but not limited to the following:

- United States of America ("US") Registration No. 6166182 HEMA word mark, registered on October 6, 2020;
- US Registration No. 6171824 HEMA logo, registered on October 13, 2020;
- International Registration No. 963586 HEMA word mark, registered on April 16, 2008;
- International Registration No. 959369 HEMA logo, registered on September 28, 2007;
- EU Registration No. 018190584 HEMA logo, registered on June 25, 2020.

The disputed domain name was registered on June 14, 2022, and resolves to a website that displays the Complainant's HEMA's logo in the top left corner of its website and appears to be a copy of the Complainant's website at "www.hema.com."

#### **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 its HEMA trademark is widely known and that it operates more than 760 stores in 11 countries serving over six million visitors every week.

With regard to the requirement of "identity or confusing similarity between the trademark and the domain name" pursuant to paragraph 4(a)(i) of the Policy, the Complainant submits that, the disputed domain name contains the Complainant's trademark HEMA in its entirety and that the addition of the letters "nl" which is the country code of the Netherlands where the Complainant originates does not prevent a finding of confusing similarity with the Complainant's HEMA trademark.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent is not making legitimate and fair use of the disputed domain name and has the intent of commercial gain misleadingly to divert consumers and to tarnish the Complainant's trademarks;
- the disputed domain name is used for a website which is a blatant, fraudulent copy of the Complainant's own website at "www.hema.com;"
- the website to which the disputed domain name resolves displays HEMA's logo in the top left corner of its website, identical to how the Complainant is using it;
- the Respondent used the address of the Complainant's French subsidiary HEMA FRANCE SAS, as well as its corporate registration numbers and VAT numbers;
- the Respondent pretends to be the Complainant, but is not even an actual reseller of HEMA products;
- the Complainant has received multiple complaints from consumers who were under the impression to buy product at a legitimate outlet of the Complainant, but who never received any of the products that were ordered.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant's trademarks are widely known and it is obvious that the Respondent has registered this website with the sole purpose of committing fraud;
- the Complainant has received various consumer complaints;
- the disputed domain name was registered primarily for disrupting the Complainant's business and the Respondent, by using the disputed domain name, intentionally attempted to attract for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website;
- the Respondent has uploaded infringing content and is selling products pretending to be the Complainant, at discounted prices and in violation of the Complainant's trademark rights;
- the Respondent has copied the Complainant's website, products description and photographs at "www.hema.com,"
- the Respondent is using the Complainant's trademarks and copyrighted material to entice people to make an online purchase.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (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 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.

Although the addition of other terms or letters, here "nl", 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.

On the contrary, the Complainant provided evidence that the Respondent has used the disputed domain name for a website which displays the Complainant’s HEMA trademark along with its distinctive logo, as well as copyright protected material. Given the composition and use of the disputed domain name, it is reasonable to expect Internet users to be misled into believing that the disputed domain name resolves to a website associated with the Complainant or a Netherlands-based distributor, particularly given the lack of any disclaimer as to the lack of relationship. The Respondent’s behavior therefore shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademarks owned by the Complainant.

Panels have held that the use of a domain name for illegal activity, here impersonating the Complainant for fraudulent purposes, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel therefore 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 Complainant provided evidence of multiple trademark registrations for the HEMA mark that predate the registration of the disputed domain name.

In light of the extensive use of the Complainant’s HEMA trademark and the fact that the Respondent started using the Complainant’s trademark and logo as well as a copyright protected material immediately after registering the disputed domain name the Panel has no doubt that the Respondent was aware of the Complainant and the Complainant’s trademark rights when registering the disputed domain name.

The Panel therefore concludes that the Respondent registered the disputed 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, 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.

From the record, it is also evident that the Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's registered HEMA trademark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

By reproducing the Complainant's registered trademark in the disputed domain name and using the Complainant's trademark, the Respondent is clearly misleading any Internet user visiting the website provided under the disputed domain name that the Complainant is the source of the website. This suggestion is further supported by the Respondent's use of the Complainant's copyright protected material from its official website, without authorization. The very fact that the Complainant has received several complaints from the customers who actually were misled by the Respondent's website into believing that was the authentic site of the Complainant and placed orders on it only to realize later that they were defrauded corroborates this finding.

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 <hemanl.shop> be transferred to the Complainant.

*/Torsten Bettinger/*

**Torsten Bettinger**

Sole Panelist

Date: September 9, 2024