

## ADMINISTRATIVE PANEL DECISION

HEMA B.V v. Douglas T Bates

Case No. D2024-3071

### 1. The Parties

The Complainant is HEMA B.V, Netherlands (Kingdom of the), represented by HGF Europe LLP, Netherlands (Kingdom of the).

The Respondent is Douglas T Bates, United States of America (“United States” or “US”).

### 2. The Domain Name and Registrar

The disputed domain name <hemasale.shop> is registered with Sav.com, LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 (Unavailable) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 29, 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 August 6, 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 August 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 28, 2024.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on September 3, 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, HEMA BV, is a large retailer based in the Netherlands (Kingdom of the), where it opened its first store in November 1926. It has since developed an international network of stores with, at the end of 2019, 760 stores in eleven countries, with over 11,000 employees serving over six million visitors every week.

The Complainant's website is to be found at "www.hema.com", where 24/7 online shopping is offered.

The Complainant is the owner of numerous registered trademarks in multiple jurisdictions for the term HEMA and HEMA plus device elements. Its registered trademarks include Benelux Reg. No. 0053555 for the HEMA word mark, registered on April 1, 1973; Benelux Reg. No. 1033987 for the HEMA word mark, registered on August 13, 2018; US Reg. No. 6166182 for the HEMA word mark, registered on October 6, 2020; US Reg. No. 6171824 for the HEMA logo, registered on October 13, 2020; and International Registration No. 963586 for the HEMA word mark, registered on April 16, 2008. The trademarks are used for the sale of a wide range of goods, principally in classes 3, 5, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 26, 28, 32, 33, and 35.

The disputed domain name was registered on June 13, 2024 and resolves to a website that is alleged to be a copycat version of the Complainant's website found at "www.hema.com" / "www.hema.nl".

#### **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 the disputed domain name contains the mark HEMA in its entirety, at the beginning of the disputed domain name where it readily attracts consumer attention. The Complainant points out that the addition of the word "sale" is wholly descriptive and non-distinctive. The Complainant says that the figurative elements in its earlier HEMA trademark registrations are to be discounted as consumers focus on the word element. The Complainant also maintains that HEMA is a reputed trademark and has an enhanced distinctive character.

The Complainant says that the disputed domain name resolves to a website which is a blatant, fraudulent copy of the Complainant's own website which is to be found at "www.hema.com" / "www.hema.nl". The Respondent's website uses the Complainant's HEMA logo in the top left corner, identical to how the Complainant uses it. The Respondent's website also uses identical pictures and identical product names, and also the same models showing the products, and the Complainant contends that these images are clearly copied. The Complainant says that the Respondent is impersonating it as the contact details and corporate information given on the website to which the disputed domain resolves are those of the Complainant. The Complainant contends that the Respondent is not an actual reseller of HEMA products and has ill intentions and is committing fraud. The Complainant says that even if the Respondent's website were selling genuine HEMA products, its trademarks would still be infringed as the website does not clearly provide information that there is no relationship between the Respondent and the Complainant. Further, the Complainant says, the website to which the disputed domain name resolves uses the Complainant's (figurative) trademarks and company name ostentatiously, which the Complainant contends is in breach of "fair use" and contrary to fair trade practices, as it misleads consumers about the origin of the products they are purchasing.

The Complainant contends that the disputed domain name was registered on July 13, 2024, which is long after the date of registration of the HEMA marks, which the Complainant says are reputed marks. The Complainant contends that the disputed domain name was registered with the sole purpose of committing fraud. The website to which the disputed domain name resolves contains infringing content and is selling products while claiming to be (commercially connected to) HEMA, without authorization, at dramatically decreased prices and in violation of trademarks and copyrights law, the Complainant says. The Complainant asserts that all the content on the website to which the disputed domain name resolves consists of materials copied from “www.hema.com” or its country specific equivalents, which is intended to trick people into making a purchase online.

The Complainant contends that because of blatant copying, consumers will naturally think they are purchasing genuine products from the Complainant, whilst the latter says it has information that the purchased products are never delivered to their buyers, which affects the Complainant’s business and reputation.

## **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 for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark HEMA is reproduced within the disputed domain name. Although the addition of other terms such as “sale” in this case, 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 Respondent has not been authorized by the Complainant to use the HEMA marks in any way and is not known by the disputed domain name.

Panels have held that the use of a domain name for illegal activity, here claimed fraudulent impersonation and passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In this matter the Respondent reproduced copyrighted works and trademarks of the Complainant together with the Complainant's contact details without authorization and enticed Internet users to a website that closely imitates that of the Complainant. This amounts to dishonest impersonation which appears to be aimed at defrauding Internet users who place orders for goods via the impugned website that are then not delivered.

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 registered the disputed domain name recently whereas the HEMA trademarks of the Complainant have been registered and used for many years, and in many jurisdictions. It is highly improbable that the Respondent was not aware of the rights of the Complainant in the mark HEMA, since he incorporated also the term "sale", referring to the activities of the Complainant. In any case a cursory Internet or register search would have revealed the exclusive rights of the Complainant in the mark HEMA in relation to retail sales.

Panels have held that the use of a domain name for illegal activity, here impersonation and passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Respondent replicated the Complainant's copyrighted works and trademarks together with the Complainant's contact details on the website to which the disputed domain name resolves, without any authorization to do so and without indicating its true relationship to the Complainant, in an attempt to deceive consumers and derive an unwarranted financial advantage from them.

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 <hemasale.shop> be transferred to the Complainant.

*/William A. Van Caenegem/*

**William A. Van Caenegem**

Sole Panelist

Date: September 16, 2024