

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nr. D2003-0841

Entscheidung vom 1. Dezember 2003

1. The Parties

The Complainants are Hershey Foods Corporation and Hershey Chocolate

The Respondent is ... Services (Hersheychocolateworld-Com-Dom), Jerusalem, Israel.

2. The Domain Name and Registrar

The disputed domain name <hersheychocolateworld.com> (herein the "Domain Name in dispute") is registered with iHoldings.com Inc. d/b/a DotRegistrar.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 23, 2003. On October 23, 2003, the Center transmitted by email to iHoldings.com Inc. d/b/a DotRegistrar.com a request for registrar verification in connection with the domain name at issue. On October 29, 2003, iHoldings.com Inc. d/b/a DotRegistrar.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 30, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was November 19, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 20, 2003.

The Center appointed J. Nelson Landry as the sole panelist in this matter on November 26, 2003. 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 Complainants are Hershey Foods Corporation (herein "Complainant Hershey"), and Hershey Chocolate & Confectionery Corporation (herein "Complainant HCCC" or collectively "Complainants Hershey and HCCC" or "Complainants").

Complainant Hershey operates the largest chocolate production facility in the world. For more than a century, Complainant Hershey has manufactured and sold chocolate bars and other confectionery items under the HERSHEY and HERSHEY'S trademarks (collectively, the "HERSHEY Trademarks"). In as early as 1894, the founder, Milton Hershey, first began selling HERSHEY'S brand chocolates and the first U.S. federal trademark registration for the HERSHEY'S trademark dates back to 1906.

Together Complainants Hershey and HCCC currently own over 90 U.S. federal trademark registrations including HERSHEY'S (U.S. Reg. No. 54,041), HERSHEY (U.S. Reg. No. 1,455,684), and HERSHEY'S CHOCOLATE WORLD and Design (U.S. Reg. No. 1,401,636), and have put these registrations in evidence. Complainant Hershey also owns over 575 active trademarks incorporating HERSHEY registered worldwide, under which it sells candy and other products and services, including, HERSHEY'S KISSES (U.S. Reg. No. 1,549,371), HERSHEY'S HUGS (U.S. Reg. No. 1,387,671), HERSHEY'S NUGGETS (U.S. Reg. No. 2,591,166), and HERSHEYS.COM (U.S. Reg. No. 2,649,859), as well as a myriad of other registrations for a variety of goods and services. The majority of the HERSHEY Trademarks in such countries as the United States, Canada, Mexico, Venezuela, the CIS countries, and most countries in Central America are owned by Complainant HCCC. The balance of the HERSHEY Trademarks are owned by Complainant Hershey.

The Complainants had represented in paragraph 14 of the Complaint that one of them was the owner of CHOCOLATE WORLD (U.S. Reg. No. 1,003,660) and had included a search result in their voluminous documentation. In Exhibit 6 the said mark CHOCOLATE WORLD appears to be registered in the name of Homestead Inc. of Newark, New Jersey while the contact information refers to Complainant HCCC address. Upon verification on the USPTO website, it appears that this trademark was registered by Complainant HCCC and Homestead Inc. appears as the "last listed owner". This evidentiary inaccuracy, most likely by inadvertence, is of no significant consequence because it relates to a trademark which does not encompass the word Hershey. The trademark HERSHEY'S CHOCOLATE WORLD (U.S. Reg. No. 1,401,636) is in the name of Complainant HCCC, thereby in concordance with the ownership of the various HERSHEY Trademarks.

Complainant Hershey also maintains a website at its <hersheyschocolateworld.com> domain name, a website that many access to learn information about Complainant Hershey's HERSHEY'S CHOCOLATE WORLD Visitor Center. The HERSHEY'S CHOCOLATE WORLD Visitor Center is the official visitor center for Complainant Hershey Foods Corporation and draws an annual attendance of over 2.6 million guests. Guests at the HERSHEY'S CHOCOLATE WORLD Visitor Center may take free tours of the fascinating chocolate-making process and receive information. The "www.hersheyschocolateworld.com" website provides information such as on hours of operation, employment opportunities and attractions.

In or about March 2003, Complainant Hershey became aware that Respondent had registered the domain name <hersheychocolateworld.com>. The website associated with the <hersheychocolateworld.com> domain name displays a search engine with links to categories such as "Chocolate," "Chocolate Candy," "Entertainment," and "Shows" as well as provide further links to other websites, including gambling, sexually explicit, and competitive websites. The "Chocolate" and "Chocolate Candy" web pages include links to competitors selling Lindt and Droste, which are competitive products. The "Entertainment" web page includes a link to the AnteUp Gambling Links gambling website which provides links to "recommended casinos" and information on various gambling games. The "Shows" web page includes links to explicit pornographic websites and when Internet users attempt to close these websites, further browser windows pop up,

displaying more pornographic material.

On March 10, 2002, counsel for Complainant Hershey sent a letter to Respondent via e-mail notifying Respondent that his registration of the <hersheychocolateworld.com> domain name infringed Hershey's federal and common law trademark rights, and violated the Anticybersquatting Consumer Protection Act and demanding that Respondent assign the <hersheychocolateworld.com> domain name to Complainant Hershey.

Respondent did not respond to the March 10, 2002 letter.

Counsel for Complainant Hershey sent a substantially identical letter to Respondent on September 17, 2003, by e-mail to the address listed in the registration information. The e-mail was returned with a "Failure Delivery Report" stating that the account had been disabled or discontinued. As of this time, Respondent has not contacted Complainant regarding the Domain Name in dispute nor has Respondent voluntarily cancelled said Domain Name or transferred it to Complainant Hershey. The website located at "www.hersheychocolateworld.com" remains active and still contains links to competitors', gambling, and pornographic websites.

5. Parties' Contentions

A. Complainants

The Complainants represent that they, each in respective parts, are the owners of the HERSHEY Trademarks used over a century in many countries of the world and consequently said HERSHEY Trademarks have become highly distinctive and famous source identifiers of HERSHEY'S branded products and services, and are universally recognized symbols of Hershey's good will.

The Complainants represent that the Domain Name in dispute incorporates the HERSHEY and the HERSHEY'S CHOCOLATE WORLD trademarks and that therefore the Domain Name in dispute is confusingly similar or identical in appearance, sound, and commercial impression to the HERSHEY Trademarks. The Complainants rely on *Realmark Cape Harbour L.L.C. v. Lewis*, [WIPO Case No. D2000-1435](#) and *Infospace, Inc. v. Behain*, [WIPO Case No. D2000-1631](#) in that the deletion of the single letter "s" after "hershey" is insufficient to overcome this fact of confusion and that the exclusion of a single letter is insufficient to change the sound, appearance, or commercial impression of a domain name.

The Complainants further represent that Respondent's use of the HERSHEY'S CHOCOLATE WORLD mark in the disputed domain name is commonly known as "typosquatting," which occurs when a registrant registers "misspellings or typographically incorrect versions" of trademarks, again referring to several administrative panel decisions, such as *Federated Western Properties., Inc. v. John Zuccarini dba Cupcake Patrol, RaveClub, and RaveClub Berlin*, [WIPO Case No. D2003-0298](#), *Six Continents Hotels, Inc. v. null John Zuccarini d/b/a Country Walk*, [WIPO Case No. D2003-0161](#), and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, [WIPO Case No. D2002-1011](#).

Complainants allege that Respondent's use of the "www.hersheychocolateworld.com" website is to provide links to competitors', gambling, and sexually explicit websites and thus violates Complainants' valuable rights in their HERSHEY Trademarks because the Respondent's "www.hersheychocolateworld.com" website firstly includes links to Hershey competitors, such as Lindt and Droste, secondly also contains links to gambling and thirdly links to sexually explicit websites. Thus Internet users or any of the million of HERSHEY'S CHOCOLATE WORLD Visitor Center looking to obtain information about Hershey, might very well type the Domain Name in dispute by mistake and be diverted to such undesired websites. Complainants contend that this may tarnish Complainants' image and reputation with the public and negatively affects the value of the goodwill that Complainants have long worked to establish in the HERSHEY Trademarks.

Complainants contend that Respondent's use and registration of the Domain Name in dispute is likely to violate Section 32(a) of the Lanham Act, 15 U.S.C. §1114 relating to confusion, mistake, or to deception as well as violate the unfair competition provisions of Section 43(a) of said Lanham Act in that such confusion, mistake, or deception as to the affiliation, connection or association of Complainants with Respondent as to sponsorship, or approval of Respondent's goods, services or commercial activities may harm the reputation and goodwill of Complainants.

Complainants further represent that Respondent's misappropriation of the Domain Name in dispute also violates the Federal Trademark Dilution Act, which is codified at Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). It prohibits the use by third parties of marks or names that dilute the distinctive quality of those famous marks. Complainants rely on a U.S. court decision, namely, *Playboy Enters., Inc. v. Asiafocus Intl., Inc.*, No. Civ. A. 97-734-A, 1998 WL 724000, at *7-8 (E.D. Va. 1998) (enjoining defendants' use of domain names <asian-playmates.com> and <playmates-asian.com>, which diluted plaintiff's rights in famous "Playboy" and "Playmate" marks).

Finally, Complainants contend that Respondent's registration of the Domain Name in dispute also violates the Anticybersquatting Consumer Protection Act ("Anticybersquatting Act"), codified at Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d).

Complainants represent that these abovementioned factors all indicate bad faith. There is no indication that Respondent has any rights in the HERSHEY Trademarks.

The Complainants contend that Respondent has no rights or legitimate interests in the Domain Name in dispute and that it has never sought or obtained any trademark registration for "HERSHEY". Furthermore Respondent is not a licensee of Hershey, nor has it obtained permission, either express or implied, from Hershey to use the HERSHEY Trademarks, or any domain names incorporating such marks at the time Respondent registered the Domain Name in dispute, or at any time since.

The Complainants represent that Respondent's only use of the Domain Name in dispute is in connection with a website that merely acts as a simplistic search engine that includes links to gambling, sexually suggestive, and competitive websites and that such a use is not a *bona fide* offering of goods or services according to earlier panel decision; *Google, Inc. v. John G.*, NAF Claim No. FA106084, *Trump v. Zeaman*, NAF Claim No. FA101572 and *V & S Vin & Spirit Aktiebolag v. Almgreen.com*, NAF Claim No. FA97853 .

According to Complainants, Respondent's misappropriation of the Domain Name in dispute was no accident, relying on an earlier decision which held that where the mark is distinctive, it is "not one traders would legitimately choose unless seeking to create an impression of an association" with the complainant; *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

The Complainants represent that Respondent's registration and use of the Domain Name in dispute constitute bad faith under Section 4(b) of the UDRP considering the four non-exclusive factors that evidence bad faith enunciated therein.

The Complainants represent that since the Domain Name in dispute is confusingly similar to the HERSHEY'S CHOCOLATE WORLD Trademark, this is a classic case of "typosquatting" whereby the public may be misled into thinking that Respondent's website emanates from Complainants or is somehow endorsed, sponsored or licensed by, or otherwise affiliated with Complainants. They again rely on a previous administrative panel which has determined that typosquatting is evidence of bad faith registration and use; *LTD Commodities LLC. v. Party Night, Incand*, NAF Claim No. FA165155 (August 14, 2003).

The Complainants state that Respondent has registered the Domain Name in dispute in bad faith by doing so knowing of Complainants' rights in the HERSHEY Trademarks which are well known and therefore being inconceivable that Respondent would not know of Hershey or the HERSHEY'S brand. This is substantiated by the more than 2.6 million visitors per year at the HERSHEY'S CHOCOLATE WORLD

Visitor Center or by even a simple Internet search which would have revealed Hershey's extensive use of the HERSHEY Trademarks as a source identifier of Hershey and its wide array of products and services.

Complainants contend that Respondent is deemed to have constructive notice of Complainants' trademark rights by virtue of its federal registrations in the HERSHEY Trademarks and rely on *Marconi Data Systems, Inc. v. IRG Coins and Ink Source, Inc.*, WIPO Case No. D2000-0090 and *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 decisions wherein the panel found that the complainant's numerous trademark registrations, together with its wide reputation in the name "Telstra," left no other possible interpretation of the respondent's registration of the domain name <telstra.org> other than that of bad faith.

Finally, according to the Complainants, Respondent's failure to provide an accurate e-mail contact address for the Domain Name in dispute also evidences bad faith.

The Complainants represent that Respondent has used the Domain Name in dispute in bad faith by simply holding the domain name as a cybersquatter and rely on the Telstra decision cited earlier, on *AT&T Corp. v. Fred Rice*, WIPO Case No. D2000-1276 wherein the panel held that "it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith" and on *eBay Inc. v. Sunho Hong*, WIPO Case No. D2000-1633 wherein the panel considered and stated that "[T]he Respondent either registered them in order to sell them to the Complainant hoping that the Complainant would offer a large sum of money for them or he registered them in order to use them to connect to an Internet facility."

The Complainants contend that Respondent has also used the Domain Name in dispute in bad faith by using it in connection with gambling, competitive and pornographic websites according to several decisions: *Ameriquest Mortgage Co. v. Ling Shun Shing*, WIPO Case No. D2003-0294, *Mattel Inc. v. Phayze Inc.*, NAF Claim No. FA147303, *Technology Props., Inc., v. Personal*, NAF Claim No. FA96569 and *Fairchild Publications, Inc., v. Saeid Yomtobian*, WIPO Case No. D2000-1003 where it was held that a domain name used to divert Internet users to a website with gambling, in connection with pornography, linking the domain name to a website offering similar merchandise for sale to Internet users or linking to an adult sex website are all relevant consideration when determining bad faith registration and use.

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainants prove each of the following three elements in order for a domain name to be cancelled or transferred:

- i. The domain name registered by the respondent 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 interest with respect to the domain name; and
- iii. The domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

There is no doubt that the domain name <hersheychocolateworld.com> is confusingly similar with the HERSHEY Trademarks of the Complainants for purposes of the Policy. The Domain Name in dispute incorporates in its entirety many of the HERSHEY Trademarks identified in paragraph 14 of the complaint and is confusingly similar with other HERSHEY'S Trademarks also listed in said paragraph 14.

The Domain Name in dispute is also confusingly similar with the website address "www.hersheyschocolateworld.com" of the Complainants.

In the opinion of the Panel, the deletion of the letters "â??s" present in a group of HERSHEY Trademarks does not deter the reader from the fact that the HERSHEY Trademarks have been taken and associated with the descriptive word "chocolateworld" and the suffix ".com" which result in the Domain Name in dispute.

This view and assessment of the situation by the Panel is further reinforced by the considerable number of registrations, of countries in which the Complainants carry its business under the HERSHEY Trademarks, the number of visitors at the Hersheysâ?? Chocolate World Visitor Center, the whole contributing to the HERSHEY Trademarks of the Complainants being represented by the later as famous, a conclusion that the Panel adopts.

The Panel finds that the Domain Name in dispute is confusingly similar with the registered HERSHEY Trademarks of the Complainants.

The criteria of paragraph 4(a)(i) of the Policy has therefore been met.

B. Rights or Legitimate Interests

The Complainants have made a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name in dispute by alleging the Respondent has never been known by the name Hershey or the Domain Name in dispute, is not making legitimate non commercial or fair use of the domain name and does not use the Domain Name in dispute in connection with *bona fide* offering of goods and services but on the contrary, in association with activities which constitute evidence of bad faith as further discussed hereinafter.

As shown by the Complainants, the use of the Domain Name in dispute by the Respondent is simply to divert Internet users to links to website offering products of competitors such as Lindt, Cadburys, Gullivers, Madelaine, Thompson and Merckens, Godiva to name only a few, links to gambling casino and links to explicit pornographic sites.

The Complainantsâ?? representations are based on several UDRP decisions, with copies thereof in its well documented evidence and authorities, supporting their representations which the Panel considers well founded. Respondent has been made aware of the Complainantsâ?? position in the Complaint that was served upon the Respondent and the later has neglected to file any evidence which may rebut the *prima facie* case that Complainants have made. The Panel concludes that the Respondent has not made any use of the Domain Name in dispute in connection with the *bona fide* offering of goods and services.

Accordingly, there is no evidence the Respondent has any rights or legitimate interests in the Domain Name in dispute and the conditions for the second criteria have been fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states circumstances which, if found, shall be evidence of the registration and use of the domain name in bad faith:

(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 the 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 on-line location, by creating a likelihood or 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."

It should be noted that the circumstances of bad faith are not limited to the above.

The Complainants contend that the Domain Name in dispute was registered and is used in bad faith.

The Panel has determined from Exhibit 2 of the well documented evidence that the Domain Name in dispute was most likely registered on October 15, 2002, when the record was created at the Registrar.

This registration was made more than a century after the commencement of the activities by the founder, Milton Hershey, and almost a century since the first registration of many HERSHEY Trademarks and the continuous extensive use in association with chocolate products and entertainment services related thereto in several countries of a mark that has become famous.

The Respondent was thus imitating Complainants' HERSHEY Trademarks which had become famous at the time of registration of the Domain Name in dispute. Complainants contend rightfully that the Respondent could not have no knowledge of Complainants' rights in the HERSHEY Trademarks when it registered the Domain Name in dispute. Even a simple Internet search would have revealed the Complainants' extensive registrations of the HERSHEY Trademarks as a source identifier of HERSHEY and its wide area of products and services. The Panel finds that, under constructive notice, Respondent was aware of the HERSHEY Trademarks.

The Panel, therefore, concludes that Domain Name in dispute was registered in bad faith.

The Panel finds that the Complainants are entitled to rely on earlier UDRP Panel decisions such as *Ameriquest Mortgage Co. v. Ling Shun Shing*, *Mattel Inc. v. Phayze Inc.*, *Technology Props., Inc. v. Personal*, and *Fairchild Publ'n, Inc., v. Saeid Yomtobian*, which held that the use of a domain name in connection with gambling, promotion of competitors' products and pornographic websites can be relevant when determining bad faith registration and use.

Therefore, the Panel finds that the Domain Name in dispute was registered and is being used in bad faith.

7. Decision

The Panel concludes that:

- (a) the domain name <hersheychocolateworld.com> is confusingly similar to the Complainants' Trademarks "HERSHEY";
- (b) the Respondent has no rights or legitimate interest in the Domain Name in dispute;
- (c) the Domain Name in dispute has been registered and is being used in bad faith.

Therefore, in accordance with Paragraphs 4(a) and 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <hersheychocolateworld.com> be transferred to the Complainant Hershey Chocolate and Confectionery Corporation.

(The Panelist)