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### ARBITRATION AWARD

.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA  
.IN domain Name Dispute Resolution Policy  
INDRP Rules of Procedure

#### IN THE MATTER OF:

The Hershey Company  
100 Crystal A Drive,  
Hershey, PA 17033

..... Complainant

#### VERSUS

Rimi Sen, Corporate Domains  
New York, NY 10011 US

..... Respondent

1. **THE PARTIES:**

The Complainant in this administrative proceeding is The Hershey Company, having its address at 100 Crystal A Drive, Hershey, PA 17033 represented through K&S Partners, 109, Sector 44, Gurgaon 122 003, National Capital Region, India.

The Respondent is Rimi Sen, Corporate Domains, 76 Ninth Avenue, New York, NY 10011 US.

2. **THE DOMAIN NAME AND REGISTRAR**

The disputed domain name **WWW.HERSHEYS.CO.IN** has been registered by the Respondent. The Registrar with whom the disputed domain is registered is A to Z Domains Solutions Pvt. Ltd.

3. **PROCEDURAL HISTORY**

The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Rimi Sen, Corporate Domains, New York, NY 10011 US. The NIXI verified that the Complaint together with the annexures to the Complaint and satisfied the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules").

- 3.1 In accordance with the Rules, Paragraph-2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed me as a Sole Arbitrator for adjudicating upon the dispute in accordance with The Arbitration and Conciliation Act, 1996, Rules framed there under, .In Dispute Resolution Policy and Rules framed there under on **23<sup>rd</sup> December, 2011**. The



parties were notified about the appointment of an Arbitrator on **23<sup>rd</sup> December, 2011**.

- 3.2 The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6). The arbitration proceedings commenced on **23<sup>rd</sup> December, 2011**. In accordance with the rules, paragraph 5(c). The Respondent was notified by me about the commencement of arbitration proceedings and the due date for filing his response.
- 3.4 The Respondent failed and/or neglected and/or omitted to file formal response to the Complaint within 10 days as was granted to him by the notice dated **23<sup>rd</sup> December, 2011**. The respondent was further granted a final opportunity of 3 days vide notice dated **9<sup>th</sup> January, 2012**, however, the Respondent failed and/or neglected and/or omitted to file any response.
- 3.5 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

#### 4. FACTUAL BACKGROUND

- 4.1 The Complainant in these administrative proceedings is The Hershey Company, having its address at 100 Crystal A Drive, Hershey, PA 17033.
- 4.2 The Complainant claims that the founder and predecessor in interest of the Complainant, Milton Hershey, first began selling

A handwritten signature in black ink, appearing to be a stylized 'M' or 'H' followed by a flourish.

HERSHEY'S brand chocolates in the year 1894 and that the first U.S. federal trademark registration for the HERSHEY'S trademark dates back to 1906 (U.S. Reg. No. 54041). The Complainant further claims that since then, Complainant (through its predecessors in interest, directly, or through its licensees or wholly-owned subsidiaries) has used at common law, applied to register and registered numerous trademarks comprised of or incorporating HERSHEY'S for a variety of goods and services. The complaint submits that Complainant's HERSHEY'S family of trademarks (in the name of its wholly-owned subsidiary Hershey Chocolate & Confectionery Corporation) in the United States totals over 130 marks. The complainant has filed the trademark applications, trademark registrations for the HERSHEY'S trademark that are owned in the United States by Complainant's wholly-owned subsidiary, Hershey Chocolate & Confectionery Corporation.

- 4.3 The Complainant claims that the first Indian trademark registration for the HERSHEY'S trademark dates back to September 17, 1982 (Indian Reg. No. 395382B). The complainant has filed as **Complaint Annex C** listing the trademark applications, trademark registrations and common law trademarks for the HERSHEY'S trademarks owned by Complainant in India. Together, Complainant's HERSHEY'S family of trademarks in India totals over 20 marks.
- 4.4 The Complainant claims to have established rights in numerous countries around the world in its HERSHEY'S trademarks and has annexed a representative listing of Complainants' foreign trademark registrations for the mark HERSHEY'S and marks incorporating HERSHEY'S existing outside the U.S. and India.





4.5 The Respondent has registered the disputed domain name WWW.HERSHEYS.CO.IN on 6<sup>th</sup> March, 2011 through the Registrar A to Z Domains Solutions Pvt. Ltd.

4.6 The Respondent has not submitted formal reply to the contentions raised by the Complainant in the Complaint.

## 5. PARTIES CONTENTIONS

### 5A COMPLAINANT

5A(1) The Complainant submits that Hershey Chocolate & Confectionery Corporation's U.S. trademark registration for the HERSHEY'S (U.S. Reg. No. 54,041) trademark was first registered in 1906, and the trademark was first used in commerce in 1894. The Complainant further submits that the Complainant's HERSHEY'S trademark, which has been in use for more than 100 years, is famous and recognized globally and is the subject matter of registration in many countries in the world. The Complainant also claims to be the registered proprietor of trademark No. 395382 in India for the trade mark HERSHEY'S.

5A(2) The Complainant submits that the Respondent's domain name WWW.HERSHEYS.CO.IN is confusingly similar to the HERSHEY'S trademarks in which Complainant and its wholly-owned subsidiary have rights through continuous and exclusive use of the mark in commerce as evidenced by, among other things, the U.S. and foreign registrations. The Complainant further submits that the Complainant and its wholly-owned subsidiaries own numerous domain names incorporating a form of "hershey," one of them being the domain name <hersheys.com>, which is highly similar to the disputed domain name, WWW.HERSHEYS.CO.IN.



5A(3) The Complainant submits that the Respondent has registered the WWW.HERSHEYS.CO.IN domain name which is identical to the Complainant's famous HERSHEY'S trademark except that the domain name (1) adds the generic country code ".co", and (2) adds the generic country code ".in." The Complainant further submits that the addition of the country codes ".co" and ".in" are insufficient to distinguish the Domain Name from Complainant's famous HERSHEY'S mark.

5A(4) The Complainant submits that the Respondent is not using and has not, prior to the serving of the notice of the instant dispute, used the domain name WWW.HERSHEYS.CO.IN in connection with a bona fide offering of goods or services. The Complainant further submits that there is no relationship between the Complainant and the Respondent which would entitle the Respondent to use Complainant's mark. To the contrary, Respondent's sole purpose in registering and using the disputed domain name is to trade on the fame of Complainant's trademark and to deliberately increase Internet traffic to its website, WWW.HERSHEYS.CO.IN, which has no relation to Complainant.

5A(5) The Complainant submits that the information found at the disputed URL WWW.HERSHEYS.CO.IN is essentially a website for sponsored listings and related searches for candy or chocolate bars and upon accessing the site, the user encounters various sponsored links (pay-per-click advertising), one of which leads to a legitimate website of Complainant, but most of which divert to the websites of competing chocolate and candy manufacturers, all while presumably accruing pay-per-click advertising revenues for Respondent. The Complainant has cited various UDRP decisions in support this proposition.



5A(6) The Complainant submits that the actions of the Respondent cannot constitute a bona fide offering of goods or services as there is no reasonable possibility that Respondent chose the disputed domain name by chance and that the Respondent is intentionally trading on the fame of Complainant's famous "Hershey's" trademark, deliberately typo-squatting on Complainant's well-known domain names, including <hersheys.com>, using a name that is confusingly similar to Complainant's well-known HERSHEY'S mark.

5A(7) The Complainant submits that the Respondent is not licensed or otherwise authorized by Complainant to use Complainant's famous HERSHEY'S trademark or any other mark similar to Complainant's HERSHEY'S trademark; nor is Respondent commonly known by the name, "WWW.HERSHEYS.CO.IN." The Complainant further submits that Complainant's HERSHEY'S mark is famous and known worldwide as an indicator of the source of Complainant's goods and given the strength and fame of Complainant's HERSHEY'S mark, it is highly unlikely that Respondent could make a legitimate use of the WWW.HERSHEYS.CO.IN domain name without infringing Complainant's rights.

5A(8) The Complainant claims that based on the global fame of the HERSHEY'S mark, Internet users are as likely to encounter Respondent's website as they are likely to encounter a website that legitimately relates to Complainant's goods or services. The Complainant claims that it is unquestionably Respondent's goal to divert Internet users, searching for websites legitimately associated with Complainant.

5A(9) The Complainant claims that given the widespread recognition of Complainant's HERSHEY'S trademark, it can be inferred





that Respondent was aware of Complainant's mark when it registered the disputed domain name, and therefore, that Respondent had notice of Complainant's rights. Further it is claimed that as the Respondent provides sponsored links to Complainant's <HersheysStore.com> website, this presents an inference that Respondent had actual knowledge of Complainant's rights when it registered the disputed domain name. This behavior is claimed as an evidence of bad faith registration and use under the Policy.

B. **RESPONDENT**

5B(1) The Respondent has twice been given opportunities to file his/her response to the Complaint by the panel by its notice dated 23<sup>rd</sup> December, 2011 and notice dated 9<sup>th</sup> January, 2012.

5B(2) The Respondent has, however, failed and/or neglected and/or omitted to file any response to the Complaint filed by the Complainant.

5B(3) The Panel, therefore, has no other option but to proceed with the proceedings and to decide the complaint on the basis of the material on record and in accordance with the .In Dispute Resolution Policy and the Rules framed thereunder.

6. **DISCUSSIONS AND FINDINGS**

6.1 The Complainant, while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed thereunder in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the policy, while seeking registration of the disputed domain name.





- 6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing. Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.
- 6.3 It is therefore, appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.
- 6.4 In accordance with the principles laid down under order 8 Rule 10 of the Code of Civil Procedure, the arbitrator is empowered to pronounce judgment against the Respondent or to make such order in relation to the Complaint as it think fit in the event, the Respondent fails to file its reply to the Complaint in the prescribed period of time as fixed by the panel.
- 6.5 The award can be pronounced on account of default of Respondent without considering statements or averments made by the Complainant on merit. However, in view of the fact that preliminary onus is on the Complainant to satisfy the existence of all conditions under the policy to obtain the relief's claimed, the panel feels it appropriate to deal with the



averments made by the Complainant in its Complaint in detail and to satisfy itself if the conditions under the policy stand satisfied.

- 6.6 The Respondent has not filed its reply or any documentary evidence in response to the averments made in the complaint. The averments made in the complaint remain unrebutted and unchallenged. There is no dispute raised to the authenticity of the documents filed by the Complainant.
- 6.7 The onus of proof is on the Complainant. As the proceedings are of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the Complainant's legitimate right, interest and title in the trade mark, trade name and domain name WWW.HERSHEYS.CO.IN and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the Annexures/Exhibits filed by the Complainant along with the Complaint.
- 6.8 Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.
- 6.9 The decision of Hon'ble Supreme Court of India in the matter of **Jahuri Sah Vs. Dwarika Prasad** – AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof. (See Section 58 of the Indian Evidence Act, 1872).



6.10 The Panel therefore accepts the case set up and the evidence filed by the Complainant and concludes that the same stand deemed admitted and proved in accordance with law.

6.11 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant.

6.12 Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled:

A. **IDENTICAL OR CONFUSINGLY SIMILAR**

6A.1 The Complainant contends that the Registrant's Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

6A.2 The Respondent has registered the identical domain name WWW.HERSHEYS.CO.IN with the .IN Registry. The aforesaid domain name incorporates the Complainant's well-known and prior registered mark HERSHEY'S. The first Indian trademark registration for the HERSHEY'S trademark dates back to September 17, 1982 under No. 395382B. The first U.S. federal trademark registration for the HERSHEY'S trademark dates back to 1906 (U.S. Reg. No. 54041). Complainant has established rights in numerous countries around the world in its HERSHEY'S trademarks. Complainant has established rights in the Hershey's trademarks through long term, continuous and exclusive use of the mark in commerce in the U.S., India, and worldwide.





6A.3 The Respondent has registered the WWW.HERSHEYS.CO.IN domain name which is identical to the Complainant's famous HERSHEY'S trademark except that the domain name (1) adds the generic country code ".co", and (2) adds the generic country code ".in." The addition of the country codes ".co" and ".in" are insufficient to distinguish the Domain Name from Complainant's famous HERSHEY'S mark. The addition of the country code top level domain ".co" in the disputed domain name does not avoid a determination that the domain name is identical or confusingly similar to Complainant's mark.

6A.4 It is a settled proposition of law that where there is copying, dishonesty ought to be presumed. In the present case, copying by the respondent is evident from its adoption of an identical domain name. Furthermore, respondent's intention is clearly to take a free ride on the goodwill and the unique sales appeal that the Complainant's goods under the mark/domain HERSHEY'S has achieved over a period of time. The Complainant claims the use of the mark HERSHEY'S since 1894 when the founder and predecessor in interest to Complainant, Milton Hershey, first began selling HERSHEY'S brand chocolates. Since then, Complainant (through its predecessors in interest, directly, or through its licensees or wholly-owned subsidiaries) has used at common law, applied to register and registered numerous trademarks comprised of or incorporating HERSHEY'S for a variety of goods and services.

6A.5 The Respondent has not disputed any contentions raised by the Complainant in the Complaint. The Panel also finds and holds that the disputed Domain Name WWW.HERSHEYS.CO.IN is identical and/or deceptively similar to the earlier registered trade marks and Domain names of the Complainant. The whole of Complainant's trade mark /domain name has been incorporated in the disputed domain name and there is bound to be confusion and deception in the course of trade by the use of disputed domain name. Therefore,



the Complainant has been successful in proving that the domain name WWW.HERSHEYS.CO.IN is identical and/or confusingly similar to the trademark HERSHEY'S of the Complainant.

**B. RIGHTS OR LEGITIMATE INTERESTS**

6B.1 The Respondent has no rights or legitimate interests in respect of the domain name.

6B.2 Paragraph 7 of the Policy lists the following three non-existence methods for determining whether the Respondent has rights or legitimate interests in a disputed domain name:

6B.3 The impugned domain name was registered by the respondent on January 5, 2011. At this time, the Complainant had prior trade mark/domain name WWW.HERSHEYS.COM registration and considerable reputation in the HERSHEY'S mark and domain name in India and abroad. The Complainant is the registered proprietor of the mark HERSHEY'S in numerous classes in India since September 17, 1982. Complainant's HERSHEY'S family of trademarks in India totals over 20 marks.

6B.4 The respondent has failed to show that he/she has ever been known by the HERSHEY'S name or by any similar name. The respondent does not have any active business operations in the name of HERSHEY'S. The Respondent is thus not known by the name HERSHEY'S.

6B.5 The respondents' domain name/web-site does not contain any substantive material and, therefore, there is no legitimate business interest of the respondent in blocking/registering the said domain name. The web-site contains 'sponsored listings' only and therefore there is no legitimate business interest of the respondent in blocking/registering the said domain name. The Respondent's sole



purpose in registering and using the disputed domain name is to trade on the fame of Complainant's trademark and to deliberately increase Internet traffic to its website, WWW.HERSHEYS.CO.IN, which has no relation to Complainant.

6B.6 The Respondent is using Complainant's famous HERSHEY'S trademark in its domain name solely to increase traffic to its website and, presumably, to benefit economically from the increased traffic. The information found at the disputed URL WWW.HERSHEYS.CO.IN is essentially a website for sponsored listings and related searches for candy or chocolate bars. Upon accessing the site, the user encounters various sponsored links (pay-per-click advertising), one of which leads to a legitimate website of Complainant, but most of which divert to the websites of competing chocolate and candy manufacturers, all while presumably accruing pay-per-click advertising revenues for Respondent. Given that Complainant's famous trademark is "Hershey's" and that Complainant is a famous manufacturer of chocolate, it is clear that Respondent is attempting to capitalize on Complainant's fame.

6B.7 The Respondent is using a name that is highly confusingly similar to Complainant's well-known HERSHEY'S trademark and Complainant's registered domain names, including <hersheys.com>, in connection with a website that is not connected to Complainant. Respondent cannot have any rights or legitimate interests in the disputed domain name WWW.HERSHEYS.CO.IN and, thus, cannot be using the name in connection with a bona fide offering of goods and services. Further, it is clear that the Respondent is intentionally trading on the fame of Complainant's famous "Hershey's" trademark, deliberately typo-squatting on Complainant's well-known domain names, including <hersheys.com>, using a name that is confusingly similar to Complainant's well-known HERSHEY'S mark. Such actions cannot constitute a bona fide offering of goods or services.





6B.8 The Respondent is not licensed or otherwise authorized by Complainant to use Complainant's famous HERSHEY'S trademark or any other mark similar to Complainant's HERSHEY'S trademark; nor is Respondent commonly known by the name, "WWW.HERSHEYS.CO.IN." Complainant's HERSHEY'S mark is famous and known worldwide as an indicator of the source of Complainant's goods and has placed various documents on record to prove the same. Therefore, given the strength and fame of Complainant's HERSHEY'S mark, it is highly unlikely that Respondent could make a legitimate use of the WWW.HERSHEYS.CO.IN domain name without infringing Complainant's rights.

6B.9 The Complainant contention that there are many website addresses available that would not impinge on Complainant's famous HERSHEY'S trademark and instead of choosing one of these non-confusing web addresses, Respondent deliberately chose an address using the HERSHEY'S mark to lead Internet users to its WWW.HERSHEYS.CO.IN site has also force in the facts and circumstances of the case. Based on the global fame of the HERSHEY'S mark, Internet users are as likely to encounter Respondent's website as they are likely to encounter a website that legitimately relates to Complainant's goods or services. This is unquestionably Respondent's goal; to divert Internet users, searching for websites legitimately associated with Complainant.

6B.10 The Respondent did not dispute any of the contentions raised by the Complainant in its Complaint. The case set up by the Complainant is deemed to be admitted as not disputed by the Respondent. The Panel also finds, on the basis of the material available on record, that the respondent has no legitimate right or interest in the disputed domain name. The respondent has failed to



show any justification for the adoption, use or registration of disputed domain name.

6B.11 The Panel, therefore holds that the circumstances listed above demonstrate rights or legitimate interests of the Complainant in the domain name WWW.HERSHEYS.CO.IN and holds that Respondent has infringed the rights of the Complainant by registering the Domain Name and has no legitimate right or interest therein.

### **C Registered and used in Bad Faith**

6C.1 For a Complainant to succeed, the Panel must be satisfied that a domain name has been registered and is being used in bad faith.

6C.2 Paragraph 6 of the Policy states circumstances which, if found shall be evidence of the registration and use of a domain name in bad faith:

1. That circumstances indicating that the Registrant has registered or the Registrant has 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 that Complainant, for valuable consideration in excess of our documented out-of-pocket costs directly related to the domain name; or
2. The Registrant has 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
3. That by using the domain name, the Registrant has intentionally attempted to attract, Internet users to the



Registrant website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Registrant website or location or of a product or service on the Registrant website or location".

6C.3 Bad faith registration is established when the Complainant's trademark is well-known and, as such, is not one that third parties would legitimately choose when registering a domain name. On the evidence of the widespread recognition of Complainant's HERSHEY'S trademark shown on record, it can be inferred that Respondent was aware of Complainant's mark when it registered the disputed domain name, and therefore, that Respondent had notice of Complainant's rights and as the Respondent provides sponsored links to Complainant's <HersheysStore.com> website, it further presents an inference that Respondent had actual knowledge of Complainant's rights when it registered the disputed domain name.

6C.4 The respondent is not shown to have been carrying out any business activities through the domain name WWW.HERSHEYS.CO.IN and as mentioned in the previous paragraph has merely blocked/registered the said domain name for the purpose of attracting Internet users to its WWW.HERSHEYS.CO.IN URL, which offers sponsored links (pay-per-click advertising) to Complainant's website and websites of Complainant's competitors by deliberately creating a likelihood of confusion between Respondent's domain name and Complainant's mark, thereby disrupting Complainant's business. Such use of a domain name is likely to disrupt and diminish the Complainant's business. The Complainant's contention that Respondent is gaining some commercial advantage by using Complainant's famous mark in its domain name and Complainant suffers through dilution and tarnishment of its famous trademark has force and is accepted by the Panel. It can be presumed that





Respondent is engaging in the intentional confusion and diversion of Internet traffic for commercial gain therefore being an evidence of bad faith registration and use under the Policy.

6C.5 The Respondent does not dispute any of the contentions raised by the Complainant. The facts and circumstances explained in the complaint coupled with the material on record clearly demonstrate that the domain name WWW.HERSHEYS.CO.IN was registered by the respondent in bad faith and to attract the internet users, through disputed domain, to the website of the competitor.

6C.6 The panel accepts the contentions of the Complainant as have been raised by them and holds that the registration of the domain name on part of the Respondent is in bad faith.

7. **DECISION**

In view of the fact that all the elements of Paragraphs 6 and 7 of the policy have been satisfied and in the facts and circumstances of the case, the panel directs the

- A. Transfer of the domain name WWW.HERSHEYS.CO.IN to the Complainant.
- B. Respondent pay the Complainant cost of Rs.25,000/- in the above proceedings.



**AMARJIT SINGH**  
Sole Arbitrator

Dated: 11 February, 2012