

By Courier

Mr Kenneth Berland
2263 Derby Street
Berkeley, CA 94705
United States of America

Zurich, 27 May 2008 A/csu
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Dr. Claude P. Blum M.C.L.
Dr. Albrecht Langhart LL.M.
Dr. André Wahrenberger LL.M.
Walter H. Boss LL.M.
Adrian Hirzel LL.M.
Stefan P. Wehrenberg
Zsolt K. Zsigray LL.M.
Christian Sutter LL.M.
Philipp C. Thommen
Stefanie M. Monge LL.M.
Dr. Eliane E. Ganz LL.M.
Gian Marchet Kasper
David B. Schwaninger
Fabian N. Jeske

Counsel:
Dr. Florian H. von Meiss LL.M.

Members of the Swiss Bar Association
Registered with the Attorneys' Registry

Usterstrasse 14
CH-8021 Zürich
Tel +41 43 443 88 00
Fax +41 43 443 88 99
info@blumlegal.ch
www.blumlegal.ch

Case Number: D2008-0779
Case Manager: Auke-Jan Bossenbroek

O/Ref.: 08/39/CH/HE/RM

Amended Complaint of Hero, CH-Lenzburg, vs. The Heroic Sandwich, US-Berkeley, in matters of the Disputed Domain Name hero.com, dated May 27, 2008 (Original Complaint dated May 16, 2008)

Dear Mr Berland,

Please find enclosed the amended Complaint dated May 27, 2008 in the above-cited disputed domain name case D2008-0779 (hero.com).

Upon request of the WIPO Arbitration and Mediation Center based on formal requirement, the original Complaint (dated May 16, 2008) has been amended not to contain more than 5'000 words on the merits, i.e. within paragraphs 12 through 53 of the Complaint; the amended Complaint (dated May 27, 2008) is in compliance with such requirement. This has been accomplished by putting the three schedules originally shown in the paragraphs 14, 20 and 25 of the original Complaint into three additional Annexures A-56 through A-58 to the amended Complaint. Copies of the Annexures A-56 through A-58 are also enclosed hereto.

The Annexures A-1 through A-55 to the original Complaint previously sent to you remain the Annexures A-1 through A-55 to the amended Complaint, and are thereto incorporated by reference. Thus, the Annexures A-1 through A-55 provided with the original Complaint and the Annexures A-56 through A-58 provided with the amended Complaint constitute together the complete set of Annexures, i.e. Annexures A-1 through A-58, to the Complaint.

The amended Complaint again is sent to you together with the coversheet as described by the WIPO Supplemental Rules.

Your acknowledgement of safe receipt of the Complaint, Coversheet and Annexures will be appreciated.

Yours sincerely,



Christian Sutter

Copy: Complainant (Hero, Switzerland)

(AMENDED) COMPLAINT TRANSMITTAL COVERSHEET

Attached is a (Amended) Complaint that has been filed against you with the World Intellectual Property Organization (**WIPO**) Arbitration and Mediation Center (the **Center**) pursuant to the Uniform Domain Name Dispute Resolution Policy (the **Policy**) approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, 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**).

The Policy is incorporated by reference into your Registration Agreement with the Registrar(s) of your domain name(s), in accordance with which you are required to submit to a mandatory administrative proceeding in the event that a third party (a **Complainant**) submits a complaint to a dispute resolution service provider, such as the Center, concerning a domain name that you have registered. You will find the name and contact details of the Complainant, as well as the domain name(s) that is/are the subject of the Complaint in the document that accompanies this Coversheet.

You have no duty to act at this time. Once the Center has checked the Complaint to determine that it satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules, it will forward an official copy of the Complaint to you. You will then have 20 calendar days within which to submit a Response to the Complaint in accordance with the Rules and Supplemental Rules to the Center and the Complainant. You may represent yourself or seek the assistance of legal counsel to represent you in the administrative proceeding.

- The **Policy** can be found at <http://www.wipo.int/amc/en/domains/rules/>
- The **Rules** can be found at <http://www.wipo.int/amc/en/domains/rules/>
- The **Supplemental Rules**, as well as other information concerning the resolution of domain name disputes can be found at <http://www.wipo.int/amc/en/domains/rules/>
- A **model Response** can be found at <http://www.wipo.int/amc/en/domains/respondent/index.html>

Alternatively, you may contact the Center to obtain any of the above documents. The Center can be contacted in Geneva, Switzerland by telephone at +41 22 338 8247, by fax at +41 22 740 3700 or by e-mail at domain.disputes@wipo.int.

You are kindly requested to contact the Center to provide the contact details to which you would like (a) the official version of the Complaint and (b) other communications in the administrative proceeding to be sent.

A copy of this Complaint has also been sent to the Registrar(s) with which the domain name(s) that is/are the subject of the Complaint is/are registered.

By submitting this Complaint to the Center the Complainant hereby agrees to abide and be bound by the provisions of the Policy, Rules and Supplemental Rules.

Before the:

WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER

Hero
Niederlenzer Kirchweg
5600 Lenzburg
Switzerland

(Complainant)

-v-

The Heroic Sandwich
2263 Derby Street
Berkeley, CA 94705
United States of America

(Respondent)

Disputed Domain Name: hero.com

(AMENDED) COMPLAINT

(Rules, para. 3(b))

I. Introduction

1. This (Amended) Complaint (**Complaint**) is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

II. The Parties

A. The Complainant

(Rules, para. 3(b)(ii) and (iii))

2. The Complainant in this administrative proceeding is Hero, a corporation organized under the laws of Switzerland, having its principal place of business at CH-Lenzburg, Switzerland.

3. The Complainant's contact details are:

Address: Niederlenzer Kirchweg, 5600 Lenzburg, Switzerland
Telephone: +41 62 885 51 11
Fax: +41 62 885 51 01
E-mail: *not applicable*

4. The Complainant's authorized representative in this administrative proceeding, with power of attorney of May 15, 2008 provided as **Annexure A-1**, is:

Name: Blum Attorneys at Law
Contact: Mr Christian Sutter
Address: Usterstrasse 14, 8021 Zürich, Switzerland
Telephone: +41 43 443 88 00
Fax: +41 43 443 88 99
E-mail: tm@blumlegal.ch

5. The Complainant's preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material

Method: e-mail
Address: tm@blumlegal.ch
Contact: Mr Christian Sutter

Material including hardcopy

Method: post/courier
Address: Usteristrasse 14, 8021 Zurich, Switzerland
Contact: Mr Christian Sutter

B. The Respondent
(Rules, para. 3(b)(v))

6. According to the Network Solutions, LLC Whois database, the Respondent in this administrative proceeding is The Heroic Sandwich, 2263 Derby Street, US-Berkeley, CA 94705, United States of America (Registrant). Copies of the print-out of the database searches conducted on May 15, 2008 are provided as **Annexures A-2 through A-5**.

7. All information known to the Complainant regarding how to contact the Respondent is as follows (copies of the printout of the database and internet searches conducted on May 15, 2008 are provided as **Annexures A-2 through A-5**):

Registrant:

Name: The Heroic Sandwich
Address: 2263 Derby Street, Berkeley, CA 94705, USA
Telephone: *to be provided by Registrant*
Fax: *to be provided by Registrant*
E-mail: *to be provided by Registrant*

Administrative Contact of Registrant:

Name: Mr Kenneth Berland
Address: 2263 Derby Street, Berkeley, CA 94705, USA
Telephone: +1 310 393 79 81
Fax: +1 123 123 12 34
E-mail: ken@hero.com
Employer: Howard Rice Nemerovski Canady Falk & Rabkin
Telephone Off.: +1 415 434 16 00
E-Mail Office: kberland@howardrice.com

Technical Contact of Registrant:

Name: Mr Steve Linn
Address: 2618 Manhattan Avenue, Hermosa Beach,
CA 90254-3528, USA
Telephone: +1 310 448 77 59
Fax: +1 310 372 65 88
E-mail: sl@hero.com

8. According to the Network Solutions, LLC Whois database, Mr Kenneth Berland is the administrative contact of the Registrant (see **Annexures A-2 and A-3**). In the course of pre-complaint dealings between the Complainant and the Respondent, e-mails have been successfully exchanged between contact persons of the Complainant and the Respondent's administrative contact person, Mr Kenneth Berland, via Mr Kenneth Berland's e-mail address ken@hero.com identified in the concerned registrar's Whois database (see **Annexures A-2 and A-3, Annexures A-6 and A-54**). Furthermore, according to Mr Kenneth Berland's website within his employer's, Howard Rice Nemerovski Canady Falk & Rabkin, internet presence, Mr Kenneth Berland was a partner in The Heroic Sandwich (allegedly a pioneering Internet café in NYC, allegedly founded in 1994) (see **Annexure A-7**). Apparently, Mr Kenneth Berland is the acting business manager, administrator and responsible person of the Respondent.

III. The Domain Name and Registrar
(Rules, para. 3(b)(vi) and (vii))

9. This dispute concerns the domain name identified below (see **Annexure A-4**):

Domain Name: **hero.com** (likewise HERO.COM)

IP Address: 207.151.19.45 (ARIN & RIPE IP search)

IP Location: US (United States) – California – Los Angeles

10. The Registrar with which the domain name is registered is (see **Annexure A-8**):

Registrar: NETWORK SOLUTIONS, LLC.
Address/Basis: 13861 Sunrise Valley Dr. Suite 300, Herndon
Virginia 20171, USA
E-mail: www.networksolution.com

IV. Jurisdictional Basis for the Administrative Proceeding
(Rules, paras. 3(a), 3(b)(xv))

11. This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the Policy. A true and correct copy of the domain name dispute policy that applies to the domain name in question, i.e., the Uniform Domain Name Dispute Resolution Policy and the Rules thereto, is provided as **Annexures A-9 and A-10** to this Complaint.

V. Factual and Legal Grounds
(Policy, paras. 4(a), (b), (c); Rules, para. 3)

12. This Complaint is based on the following grounds:
- A. The domain name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;**
(Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1))

I. Complainant's Rights

aa. Complainant's Identity and Activity

13. The Complainant was founded under the trade name and identity "HERO" in the year 1886 in Lenzburg, Switzerland, by Messrs. Gustav Henckell and Gustav Zeiler (since 1889 "Henckell & Roth", since 1898 "Hero"), has focused ever since its foundation on the producing and delivering of high-quality branded

food products and innovations, has become already long time ago a well-known and highly valued consumer foods manufacturer, and is today a successful and competitive consumer goods player on all important national, regional and international markets of the world. The Complainant also has a long successful and noteworthy history. Soon after the turn of the century before last, the Complainant commenced its international expansion by forming and establishing its first subsidiaries in Spain, the Netherlands, and Italy, later on in Germany, all under the trade name and identity of “HERO”. In the 1980s and the early 1990s of the last century, the Complainant under the trade name and identity of “HERO”, and of the “HERO Group”, diversified its range of products to the categories of fruit foods and drinks, infant nutrition, cereals and decoration, as well as substantially expanded its geographical extension from the Western European heartland to the rest of Europe, North Africa/Middle East, Turkey/Central Asia, Far East, and the Americas. Since the mid 1990s, the Complainant has established its presence in the United Kingdom, France, Portugal, Poland, the Czech Republic, Slovakia, Turkey/Central Asia, Egypt and most Middle East countries, the USA and Canada, Mexico and Central/South America, and several Far East countries including India, Thailand, Singapore, Malaysia, Indonesia, the Philippines, Hong Kong, China, Taiwan, Japan and South Korea. Since 2000, the Complainant has made substantial progress in becoming a leading international manufacturer of healthy consumer-food products in the Group’s core categories infant nutrition, fruit, cereals, decoration and gluten-free, and has evolved in most recent years into a leading global player in infant and fruit through the launch of a number of important new product innovations, the strategic acquisitions of several strong and well-positioned suppliers in infant nutrition in the United Kingdom and in prescription-based gluten-free in the Benelux countries, the establishing of a sustainable market presence in Russia and other former CIS countries and the major investments in advanced technologies and production assets, including the purchase of a new production facility for infant-formula and gluten-free powders in Sweden and the development of a state-of-the-art infant production facility in the United States (Albany NY), with similar projects being undertaken or announced for Germany, France (both chilled fruit technology), Turkey (infant technology) and Switzerland. Excerpts of the Annual Reports of the years 2007, 2006, 2004 and 2002 of the Complainant are marked as **Annexures A-11 through A-14** (*submitted under the express request to all recipients to treat the reports as con-*

fidetial) and the Product Brochures of the years 2007 and 2006 of the Complainant (Innovation Powered by Hero) are marked as **Annexures A-15 and A-16**.

14. It is pertinent to mention here that most of the Complainant's subsidiaries and/or affiliate international companies have been formed and are established under the trade name and corporate identity wherein its trademark "HERO" forms an integral and inalienable part, and that as on date the Complainant under the trade name "HERO" has existence in more than thirty countries across the world by way of its own organization, associated/licensed companies or distributors. The details of Complainant's worldwide subsidiaries and participations can be seen from the Excerpt of the Annual Report 2007, page 72 through 74, marked as **Annexure A-11**. The organizational structure in terms of percentage of shareholding and details of companies and distributors are stated in **Annexure A-56**.
15. The Complainant currently employs more than 4'300 employees stretching over more than thirty countries across the world. The Complainant's consolidated net sales amounted for 2006 to CHF 1,75 billion and for 2007 to CHF 1.875 billion, as shown in the respective Annual Report Excerpts (**Annexures A-11 and A-12**).

bb. Complainant's Trading Name

16. The Complainant has existed and traded under the name "HERO" since the year of 1898, first in Switzerland and the United States, and thereafter in Europe and around the world. An excerpt from the Commercial Register of the Canton of Aargau, Switzerland, concerning the Complainant is marked as **Annexure A-17**.
17. The Complainant's trading name "HERO" is in fact a combination of the prefixes of the names of the two original proprietors of HERO, Switzerland. The trading name "HERO" has been and is continuously and extensively used in all sorts of local, national, international and global printing and online media in the reporting, news coverage and commentatorship relating to the Complainant's company, business, products and trademarks as well as in the Complainant's advertising and publicity campaigns all over the world.

18. Copies of news paper clipping in the Neue Zürcher Zeitung dated February 29, 2008 indicating the acquisition of the British company Organix Brands engaged in the production of biological infant nutrition; dated April 1, 2007 reporting on the focusing on the core categories fruit and infant nutrition and the acquisition of the UK trademark Juvela for gluten-free products; dated March 29, 2007 giving account on the progress made in the core focus areas growth, nutrition and internationalization; dated March 28, 2007 reporting on the strong organic growth in the markets of Germany, Spain, North America, Turkey/Central Asia, Middle East, Africa and Central/Eastern Europe and the acquisitions of Semper and Beech-Nut in the infant nutrition area; dated February 20, 2006 on the entire takeover of the American company Signature Brands being the market leader in decoration in the USA and Canada; dated February 2, 2006 on the acquisition of Semper; dated November 9, 2005 on the US takeover panel's approval of the Beech-Nut acquisition; dated October 10/11, 2005 on the acquisition of Beech-Nut; dated April 23, 2004 on the acquisition of the Sunar brands in the Czech Republic and Slovakia; dated February 10, 2004 on the acquisition of the baby food brands Galactina, Adapta and Ceralino from Associated British Food; dated October 7, 2002 on the acquisition of a 65% participation in the Egyptian market leader in jam and jellies (Vitrac), are marked as **Annexures A-18 through A-29**.

19. The Complainant is an internationally well established, recognized and reputed producer and marketer of branded food products under the trademarks "HERO", "HERO & (blue) Oval" and "HERO BABY" etc. in the categories preserved, fruit, infant nutrition, baby food, cereals, clinical food and decoration. Reference is made to the Product Brochures of Hero, marked as **Annexure A-15 and A-16**. Also, copies are enclosed of online press releases on www.presseportal.ch giving an account of the Complainant's 120 years anniversary (dated July 18, 2006) and of the consumer perception regarding the Complainant's products (dated March 21, 2006), marked as **Annexures A-30 and A-31**. Further online evidence on the Complaint's reputation, such as on www.swissmade.com, an international online shop for Swiss made products, offering "HERO Roeschti"; www.scff.com (Swiss Chalet Fine Foods) indicating the "HERO" brand is one of the most widely recognized name in the professional pastry kitchen worldwide; www.dciimports.com (Euro-Pacific Imports), an online index for worldwide gourmet foods & gourmet gifts, offering "HERO preserves"; www.herousa.com, the website of Hero North

America; www.nutraingredients.com reporting on the acquisition of the Wander brands from Associated British Foods; www.dailygazette.com giving account on the impact of the Beech-Nut acquisition to the Florida town hosting the facility; www.bizjournals.com (St. Louis Business Journal) reporting on the Beech-Nut acquisition, are enclosed and marked as **Annexures A-32 through A-38**.

cc. Complainant's Trademarks

20. The Complainant is the prior, honest and bonafide adopter and worldwide user of the trademark and corporate brand "HERO" in respect of goods falling under various international classes covering an extensive range of goods and services, including such in classes 05, 29, 30, 31 and 32. The trademark "HERO" in fact is a combination of the prefixes of the names of the two original proprietors of the Complainant. The trademark "HERO" was first used in commerce by the Complainant in the year 1892 in New York. The trademark "HERO" was first registered in the year 1926 in the international classes 29, 30 and 32 in the name of the Complainant in the United Kingdom (no. 470267), and in the year 1928 in classes 01, 02, 05, 29, 30, 31, 32 and 33 in Switzerland (no. 59194), and is registered since 1948 by virtue of an International Registration in various countries of the world (no. 137974). Since 1928 the Complainant is the registered proprietor of the Swiss trademark "HERO & Circle" (no. 59193), which is registered since 1948 by virtue of an International Registration in various countries (no. 137973). Further, the Complainant is since decades the registered proprietor of the trademarks "HERO & Oval" and "HERO BABY", and of a range of other marks consisting of or containing "HERO", which are nationally, regionally and/or internationally registered in its name in countless countries of the world. The details are shown in **Annexure A-57** (however, the list in the Annexure is providing only a mere selection of all "HERO" marks owned and used by the Complainant worldwide until/in 1995):
21. The print outs of the registrations as retrieved from the official websites of the various trademark offices across the world for the various marks "HERO" by the Complainant are marked as **Annexure A-39/I – A-39/X** (CH/I, International/II, EC/III, USA/IV, UK/V, Ireland/VI, Canada/VII, Australia/VIII, Singapore/IX, various jurisdiction/X). The Complainant by virtue of these registrations, as well

as by virtue of its longstanding use thereof, possesses the exclusive statutory right and common law right to these trademarks “HERO”.

22. Today, the Complainant is the honest and bona fide registrant and user of dozens and dozens of national, regional and international trademarks consisting of or containing the word “HERO” in respect of a great range of goods and services sold in a great variety of market outlets in all continents across the world. Print outs from the trademark database of the respective trademarks “HERO” administered by the Complainant authorized representative are marked as **Annexure A-40** (list showing trademarks registered and used until/during 1995 is marked as **Annexure 40/I**; list showing marks currently registered and used is marked as **Annexure 40/II**).

23. The trademark “HERO” along with the other trademarks consisting of or containing the word “HERO” have been and are continuously and extensively used by the Complainant all over the world on or in connection with the wide range of goods and services for which they are registered. The Complainant is the prior user of the mark “HERO” and has acquired vast and enviable reputation in the national and international market by reason of long and extensive user, and the mark “HERO” has for a long time come to be associated exclusively with the Complainant, as well as vice versa. In more than a few legal cases and court decisions in Switzerland and across the world, competent authorities have awarded the Complainant’s mark “HERO” famousness and well-known reputation. Notably, the Swiss Federal Appellate Commission of Intellectual Property recognized the mark “HERO” to be a very well-known non-generic mark (arbitrary mark) in Switzerland; a copy of the decision’s publication in the professional journal “sic! 2006 Volume 7+8” is marked as **Annexure A-41**. In a decision of the year 2006 the Registrar of the Hashemite Kingdom of Jordan submitted a convincing evidence that the trademark “HERO” is registered and used in several countries of the world since 1946, is being used in Jordan and known to Jordan customers since long time and can be classified as famous trademark due to extensive registration and use by the owner company, marked as **Annexure A-42**.

24. The trademark “HERO” of the Complainant enjoys a significant reputation not only in its Swiss and European homeland but around the world. According to an

assessment reported in the esteemed business magazine “BILANZ” of January 2005 the mark “HERO” ranks amongst the fifty most valuable Swiss brands, marked as **Annexure A-43**. Pursuant an independent press release reporting on the Swiss appearance at the World Expo 2005 in Japan, “HERO” jams were a greatly demanded article in the Swiss pavilion shop, marked as **Annexure A-44**. Following a clip on the site <http://simplyswiss.com> of August 29, 2006 “HERO” jams and preserves are among the Swissness products of global presence comprising a representation of purity, quality and trust, marked as **Annexure A-45**. A notoriety and famousness check conducted in the year 2004 revealed that the “HERO” products of the Complainant enjoy significant reputation in India, specifically in the metropolitan cities of Delhi, Mumbai, etc. A market survey done in New Delhi revealed that about twelve top and well-known chain of five star hotels use the products of the Complainant bearing the trademark “HERO” and/or with its variations. The same survey also revealed that “HERO” products are sold in most of the high end product supermarkets in the Indian metropolises. The details are provided in the respective report, marked as **Annexure A-46**.

25. By virtue of the trade name, reputation and goodwill attached to the trademark, the Complainant has substantial business that runs into billions of dollars of worldwide revenues (see hereinbefore para. 15, **Annexures A-15 and A-16**).

dd. Complainant's Domain Names

26. The Complainant, and its group, is the prior, honest and bona fide registrant of various domain names containing the word “HERO”, as listed in **Annexure A-58**.
27. The Complainant operates its principle websites at www.hero.ch and www.hero-group.ch. The site www.hero.ch includes electronic information on the Complainant's company, marks and products, as well as news and contact services. An actual excerpt of the site www.hero.ch is marked as **Annexure A-47**. The website www.hero-group.ch contains electronic information on and links to the Complainant's subsidiaries and their respective websites, the CEO's message, an overview on the Complainant group's product categories and brands, as well as customer information on events and press, the Hero Way, careers and contacts. An actual excerpt of the site www.hero-group.ch is marked as **Annexure A-48**.

28. Part of the Complainant's subsidiaries operate their own websites under the respective domain names, such as Hero Czech and Slovakia under www.hero.cz, Hero Spain under www.hero.es, Hero France under www.hero.fr, Hero Japan under www.hero-japan.co.jp, Hero Nederland under www.hero.nl, Hero Turkey (Hero Gida) under www.herobaby.com.tr, Hero Portugal under www.hero.pt and Hero North America under www.herousa.com. Actual excerpts of the sites of these subsidiaries are marked as **Annexure A-49**. Other of its subsidiaries operate their websites through the Complainant's group site www.hero-group.ch, like Hero Italy and Hero Polska, as shown in excerpts marked as **Annexure A-50**. All these sites, too, include electronic customer information, news and services.

ee. Summary

29. In the circumstances, it is asserted that the Complainant has been for decades, was in the year 1995 and is the true owner and lawful proprietor of its mark "HERO", and of its further marks containing the word "HERO", and has legal, vested and statutory rights to the exclusive use of the said mark consisting of or containing the word "HERO" in respect of a great variety of goods and services. The mark "HERO" is the honest and bonafide adoption on the part of the Complainant and has been used by him continuously for over more than one hundred years. The Complainant long before 1995 has acquired substantial reputation and goodwill all over the world by virtue of extensive user of its mark "HERO", and has come to be associated exclusively with its mark "HERO" in many respects across the world. The Complainant's goods are well known under the mark "HERO", and its mark "HERO" enjoys significant global reputation.

II. Identity of Domain Name with Complainant's Trademarks

30. The pure identity of the disputed domain name "hero.com", or "HERO.COM", with the Complainant's trademarks "HERO" as well as "HERO & Circle", "HERO & Oval", "HERO & Blue Oval" and "HERO & Arabic Script", and the highly confusingly similarity of the disputed domain name with the further Complainant's trademarks containing the word "HERO", such as "HERO BABY & Devise", "HERO Lunch", "HERO Mini Drink", "HERO Classica", "HERO & Device" and "HERO Lite", are apparent, obvious and evident without any doubt.

III. Conclusion

31. It is hereby contented that in relation to element (i) specified in paragraph 4(a) of the Policy the relevant part of the domain name in issue is “hero”, or “HERO”, and this is clearly identical with or confusingly similar to the various trademarks for the word “HERO” which are registered, owned and used by Complainant.

B. The Respondent has no rights or legitimate interests in respect of the domain name/s/;

(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2))

32. The Respondent has no legitimate rights or interests, and has never had, in or in respect of the disputed domain name, for the following reasons:

aa. No Bona Fide Offering of Goods or Services

33. The Respondent is not using the domain name in connection with a bona fide offering of goods or services and never intended to use the name in connection with a bona fide offering of goods or services, nor ever since the registration made demonstrable preparation to use the name in such connection.

34. The Respondent, from the date of registration of the disputed domain name until to date, never operated, nor sincerely or honestly considered to operate, under the disputed name a website of any serious, reasonable or meaningful kind and content, but always and continuously placed and replaced unsubstantial, senseless, meaningless, displeasing and/or offending contents on these sites, moreover to which sites the word “hero” or “HERO” never bore any relation whatsoever. None of the websites was ever used or operated by the Respondent in connection with a bona fide offering of goods or services, but in fact read as follows:

35. In the year 1996 the website actually operated and displayed by the Respondent under “hero.com” or “HERO.COM” read “Welcome to HERO.COM Hero dot com mail SURF.HERO.COM -and- The Windows Forum”, with links to further sites such as “Microsoft Sucks Forum”. In 1997 the website read “Welcome to hero.com we at hero are dedicated to bringing the best on the web directed to

you. enjoy your stay.”. In 1998 it simply read “H Sucks Sucks Sucks” and then “HyperNews On HERO.COM The Windows 95 Sucks Forum Sucks Framed Verision Sucks”. In 1999 it read “Martian Tools Welcome to HERO.COM Please use the Navigation to your left to pick your destination”, with links to be picked such as “Win ’95 Sucks Forum”. In 2000 it read “The Windows Sucks Forum No Frames Frames Verision 95/98 Sucks No Frames Frames Verision 2000 Sucks”. In 2003 it read “HERO CONSULTING PRESENTS V.3.O SITE REQUIREMENTS: INTERNET EXPLORER 4.0+ NETSCAPE 4.O+ MAC-ROMEDIA FLASH 5+ 800X600 RESOLUTION BEST EXPERIENCED WITH: PENTIUM II+ 1024X768 RESOLUTION BROADBAND CONNECTION 32BIT DISPLAY”. In 2004 the site read “Launch Hero Consulting Flash Presentation Get your own 35Mb @hero.com account, \$12/yr. We offer corporate email accounts for \$75/month. Five User Accounts Fully Backed-Up Secure Hosting Facility 200Mb Limit Web-Based Client Outlook Compatible Secure/ Encrypted Communication Contact ken@hero.com”, and the site basically read the same in the years 2005, 2006 and 2007. Printouts showing the contents displayed on all these websites retrieved from the site “Internet Archive Wayback Machine” (<http://web.archive.org>) are marked as **Annexure A-51**.

36. On or in connection with any site operated by the Respondent under the disputed domain name from 1996 through 2007 no consulting services, nor any goods or other services, were offered or provided by Respondent, but users were merely redirected to other sites, such as “hero dvds movie downloads new at hero.com” operated under the domain name “<http://redirect.hotkeys.com/?a=Hero.com>”, captioned “Welcome to Hero.com” and including hyperlinks such as “Hero”, “Dvds”, “Movie Downloads”, “New Movies”, “Music”, “Music Downloads”, “Cheap Dvds”, “Watch Movie Online”, “Downloads”, “Guitar Hero 3”, “Guitar Hero WII”. When clicking on any of the hyperlinks shown on the “Welcome to Hero.com” site, users were again redirected to further sites, and so on, and so forth, e.g. sites captioned “Sponsored listings for Hero: Spiderman the Hero; The Hero and the; For Hero at Amazon.co.uk; AOL TV Guide; The Hero”, “Sponsored listings for Guitar Hero WII”, “Sponsored listings for Doctor Who”, and alike, i.e., to such sites which either are completely senseless and meaningless, or to which the Respondent apparently has no relation of any kind whatsoever. Printouts retrieved from the respective websites are marked as **Annexure A-52**.

37. Likewise, users today entering the disputed domain name “www.hero.com” are immediately redirected to the site “http://redirect.hotkeys.com/?a=Hero.com”, i.e., the actual 2008 version of the website operated by the Respondent under the subject name is identical to the sites discussed hereinbefore. Reference is made to **Annexure A-53**. It is obvious that the whole linking and redirecting system created and used by the Respondent in connection with the domain name in issue is in fact an endless rat-tail of phony websites and links to sites of non-serious and non-reasonable kind and content, and it is furthermore obvious that the Respondent is not making any kind of bona fide offering in connection with any of these sites, and has never had any intention to do so.

38. Accordingly, the Respondent has no rights or legitimate interests in respect of the domain name in issue, and is not making a legitimate non-commercial or fair use of the disputed domain name. Panel decisions are legion to the effect that use of a domain name that is either identical or confusingly similar to the Complainant’s trademark renders such use illegitimate (See, e.g., *Chase Manhattan Corp. v. John Whitley*, WIPO Case No. D2000-0346 (June 12, 2000); *Chanel, Inc. v. Estco Technology Group*, WIPO Case No. D2000-0413 (September 18, 2000); *Owens Corning Fiberglas Technology, Inc. v. Hammerstone*, WIPO Case No. D2003-0903 (December 29, 2003).

bb. No License to Use or Other Permission

39. The Complainant, or any of its subsidiaries or affiliate companies, have never licensed or granted any right or otherwise permitted to the Respondent to use the Complainant’s trading name or any of the Complainant’s trademarks, or to apply for or use any domain name incorporating its trading name or any of its trademarks. Also, the Complainant, or any of its subsidiaries or affiliate companies, have never assigned, sold, or transferred any rights in its “HERO” trade name or trademarks to the Respondent.

cc. Respondent Not Commonly Known by Domain Name

40. The Respondent was not, is not, and has never been commonly known, neither as individual, business nor other organization, by the domain name in issue, but

he was, is, and has ever been completely unnoticed by such name in the market, including the e-commerce. Rather, it is the Complainant who was, is, and has for a very long time been commonly well-known and famous all over the world by the name “HERO”, or “hero”, due to the vast, enviable and substantial reputation and goodwill acquired by the Complainant in its trading name and trademarks in the national, international and global market by way of long and extensive user.

41. The Respondent neither was known by nor operated any business using the domain name in issue prior to the Complainant’s honest and bonafide establishment of rights and interest in its trade name “HERO” and trademarks “HERO”.

dd. Internet User Expecting Complainant as Owner of Domain Name

42. Due to the worldwide famousness of the Complainant’s products as well as the reputation and goodwill attached to its trade name and trademarks, internet user would expect and assume to reach the website of the Complainant, or the site of any of its subsidiaries or affiliate companies, when entering in the internet the domain name in issue. This is even more true and obvious in the light of the numerous domain names owned and used by the Compliant and its subsidiaries and affiliate companies containing or consisting of the Second-Level-Domain (SDL) “hero” or “HERO”, e.g., hero.ch, hero-group.ch, hero.cz, hero.es, hero.fr, hero-japan.co.jp, hero.nl, herobaby.com.tr, hero.pl, hero.pt, and herousa.com.
43. To the contrary, internet users would not at all expect or assume to reach the website of the Respondent under the disputed domain name. As a consequence, internet users are very likely to be confused and misled when not being connected to the Complainant’s website, resulting in market confusion and disarray most detrimental to the business and reputation of the Complainant. As further consequences, consumers of the Complainant are diverted and the Complainant’s trade name and trademarks are tarnished.

ee. Registration for Sole Purpose of Selling of Domain Name

44. The Respondent registered the disputed domain name solely, or primarily, for the purpose of selling, renting or otherwise transferring the domain name regis-

tration either to the Complainant who is the prior, honest, bonafide and long-standing owner of the trade name and trademark “HERO”, or to a competitor of the Complainant, for valuable consideration in excess of any reasonable out-of-pocket costs directly related to the domain name.

45. In the year 2006, the Respondent offered the disputed domain name registration to an employee of the Complainant who made a request under an alias at the price of USD 250’000.00 (see **Annexure A-6**). In 2007, the Complainant’s offer to purchase the domain name for consideration of USD 20’000.00 was refused by the Respondent with the remark “Sorry, that’s really low. No deal.”. The respective emails between the Complainant and Respondent are marked as **Annexure A-54**. Obviously, the consideration claimed by the Respondent for selling the domain name is far beyond any reasonable out-of-pocket costs directly related to the domain name.

ff. Engagement of Registrant in Pattern of Conduct

46. It must be strongly assumed that the Respondent has, and is, engaged in a pattern of conduct of registering domain names, including the disputed domain name, merely in order to prevent the Complainant, and the owners of other trademarks, from reflecting their trademarks in corresponding domain names, unless after purchasing the domain names from the Respondent for excessive consideration.

C. The domain name was registered and is being used in bad faith.

(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3))

47. The Respondent has registered and used, and still uses, the domain name in issue in bad faith, which is established by the following facts:
48. The Complainant’s trade name “HERO” and its trademarks “HERO” have been extensively and continuously used in commerce in national and international markets of the world including those of the United States for over more than one hundred years, and have acquired a strong reputation and worldwide famousness in relation to a great variety of goods and services for a long time, and thus it is inconceivable that the person or persons behind the Respondent would not have

been aware of this fact at the time of registration of the domain name in issue; the Respondent could not have formed the requisite good faith belief by closing his eyes to whether the chosen domain name was identical or confusingly similar to the trading name and trademark of another, i.e., of the Complainant (See, e.g., *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062 (June 4, 2007); and cited therein: *Mobile Communication Service Inc. v. WebReg*, RN, WIPO Case No. D2005-1304).

49. By virtue of the longstanding and wide spread use of the trading name “HERO” and the trademarks “HERO” by the Complainant, and the reputation and goodwill attached to them, members of the public across the world, including those in the United States, would believe that the entity owning the disputed domain name “hero” or “HERO” was the Complainant, or any of its subsidiaries or affiliate companies, or entity in some other way associated with the Complainant, which the Respondent is not, and any kind of use of the disputed domain name by the Respondent misrepresents an association with the Complainant and its reputation and goodwill and makes consumers wrongly believe there was some relationship with the Complainant, resulting in passing off, confusion, dilution, trading name and trademarks infringements to the detriment of the Complainant, as well as in breaches of consumer protection legislation in various jurisdictions;
50. The Respondent has registered the domain name in issue solely or primarily for the purpose of selling the domain name registration to the Complainant who is the owner of the respective trade name and trademark, or to a Competitor of the Complainant, and the Respondent, being aware of the commercial value of the domain name to the Complainant, has asked for valuable consideration in vast excess of reasonable out-of-the pocket costs directly related to the domain name and to the assignment and transfer of the domain name unto the Complainant;
51. The Respondent not only has attempted, for the last time only recently, to extract from the Complainant an unreasonably high amount of money for the assignment and transfer of the domain name in issue, but at the same time has kept the Complainant in the dark if there were competitors of the Complainant which were interested in the domain name, too, and to which Respondent was willing to sale;

52. The Respondent does not conduct any legitimate commercial or non-commercial business activity or fair use of the disputed domain name in issue, neither in the United States nor elsewhere in the world, and the contents displayed on the Respondent's website to which the domain name "hero.com" resolves have always been, and still are, entirely unsubstantial, senseless and meaningless. Given the Complainant's numerous trademark registrations for, and its world wide reputation in, the word "HERO", as evidence by the facts established hereinbefore, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name "hero" or "HERO".

VI. Remedies Requested
(Rules, para. 3(b)(x))

53. In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section V above, the Complainant requests the Administrative Panel appointed in this administrative proceeding to issue a decision that the contested domain name be **transferred** to the Complainant.

VII. Administrative Panel
(Rules, para. 3(b)(iv))

54. The Complainant elects to have the dispute decided by a three-member Administrative Panel, and provides, in the order of Complainant's preference, the following three candidates for consideration for appointment by the Center as a Panelist in this administrative proceeding, the names and contact details of whom are as follows:

<u>Candidate 1:</u>	Mr Michele A. R. Bernasconi
Address:	M/s Baer & Karrer Brandschenkestrasse 90, 8027 Zuerich, Switzerland
Telephone:	+41 58 261 50 00
Fax:	+41 58 261 50 01
E-mail:	m.bernasconi@baerkarrer.ch

Candidate 2: Dr Bernhard F. Meyer-Hauser
Address: M/s Meyer Mueller Eckert
Kreuzstrasse 42, 8008 Zuerich, Switzerland
Telephone: +41 44 254 99 66
Fax: +41 44 254 99 60
E-mail: bernhard.meyer@mme-law.ch

Candidate 3: Mr Tobias Zuberbuehler
Address: M/s Lustenberger Glaus & Partners
Sempacherstrasse 15, 8032 Zuerich, Switzerland
Telephone: +41 44 387 19 00
Fax: +41 44 381 45 23
E-mail: tobias.zuberbuehler@lgpartner.ch

VIII. Mutual Jurisdiction
(Rules, para. 3(b)(xiii))

55. In accordance with Paragraph 3(b)(xiii) of the Rules, the Complainant will submit, with respect to any challenges that may be made by the Respondent to a decision by the Administrative Panel to transfer the domain name that is the subject of this Complaint, to the jurisdiction of the courts at the location of the principal office of the concerned registrar.

IX. Other Legal Proceedings
(Rules, para. 3(b)(xi))

56. To the Complainant's current best knowledge, no other legal proceedings have been commenced or terminated in connection with or relating to the domain name that is subject of the Complaint.

X. Communications
(Rules, paras. 2(b), 3(b)(xii); Supplemental Rules, paras. 3, 4)

57. A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, and further together with a complete set of the Annexures to the Complaint, has been sent to both the Respondent (Registrant) and the

Administrative Contact of the Respondent (Registrant), to the postal addresses indicated under paragraph 7 hereinbefore, on May 27, 2008 by courier service (with postage pre-paid and return receipt requested). A copy of the original Complaint was sent to the Respondent and the Administrative Contact of the Respondent on May 16, 2008.

58. A copy of this Complaint, together with a complete set of the Annexures, has been transmitted to the concerned Registrar on May 27, 2008 by courier service (with postage pre-paid and return receipt requested). A copy of the original Complaint was sent to the Registrar on May 16, 2008.
59. This Complaint is submitted to the Center by advance e-mail using the address specified by the Center, i.e., domain.disputes@wipo.int, and on May 27, 2008 in four sets together with the original copy of the Complaint, and further together with the respective number of complete sets of the Annexures, by courier service (with postage pre-paid and return receipt requested) to the Center's postal address, at WIPO Arbitration and Mediation Center, 34 chemin des Colombettes, 1211 Geneva 20, Switzerland. The original Complaint, also in four sets together with the original copy of the Complaint, was sent to the Center by same means of transmission on May 16, 2008.

XI. Payment

(Rules, para. 19; Supplemental Rules, Annex D)

60. As required by the Rules and Supplemental Rules, payment in the amount of USD 4'000.00 (four thousand US dollars) has been made on May 15, 2008 by the way of direct debiting of the credit card of the Complainant's authorized representative (see **Annexure 55**).

XII. Certification

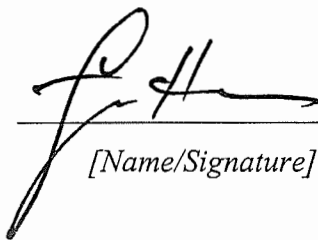
(Rules, para. 3(b)(xiv))

61. The Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the WIPO Arbitration and Mediation Center and Panelists, except in the case

of deliberate wrongdoing, (b) the concerned registrar, (c) the registry administrator, (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

62. The Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,
in the name/on behalf of
the Complainant



[Name/Signature]

Place / Date: Zurich, 27 May 2008

BLUM Attorneys at Law

Usterstrasse 14
CH-8021 Zurich
Tel +41 43 443 88 00
Fax +41 43 443 88 99
info@blumlegal.ch
www.blumlegal.ch

fivefold

(original and four copies)

Copy:

Complainant

Annexure A-56 to the Complaint (para. 14)

Organizational structure of Complainant in terms of percentage of shareholding and details of companies and distributors (subsidiaries and participants)

Company	Country	Percentage
Adolf Darbo AG	Austria	42.3 %
Beech-Nut Nutrition Corporation	USA	100 %
Cap'Fruit SA	France	100 %
Citron Export Inc. / Exportadores Agricolas Eureka C. por A.	Dominican Republic	97.4 %
Friso Nederland BV	The Netherlands	100 %
Götene Ingredients AB	Sweden	100 %
Hero Beteiligungen AG	Switzerland	100 %
Hero Czech s.r.o.	Czech Republic	100 %
Hero Drinks BV	The Netherlands	100 %
Hero España SA	Spain	100 %
Hero France SAS	France	100 %
Hero Gida San.ve Tic. AS	Turkey	50 %
Hero GmbH & Co. KG	Germany	100 %
Hero Hungary Ltd.	Hungary	100 %
Hero Italia SpA	Italy	100 %
Hero Japan Co., Ltd	Japan	51 %
Hero North America LLC	USA	100 %
Hero Nutritional Food Industries SAE	Egypt	100 %
Hero Inc.	USA	100 %
Hero Polska Sp. z o.o	Poland	100 %
Hero Portugal Lda	Portugal	100 %
Hero Slovakia s.r.o.	Slovakia	100 %
Hero UK Ltd.	UK	100 %
Milnot Holding Corporation	USA	100 %
Organix Brands	UK	100 %
OV Semper ab	Finland	100 %
Schönauer IAV	Germany	100 %
Schwartauer Werke GmbH & Co. KG	Germany	51 %
Semper Holding AB	Sweden	100 %
Semper AB	Sweden	100 %
Signature Brands LLC	USA	100 %
Small People AS	Norway	100 %
SP Hold AB	Sweden	100 %

Annexure A-57 to the Complaint (para. 20)

Selection of "HERO" marks owned and used by the Complainant worldwide until/in the year 1995, also indicating the respective classes of goods

Trademark	Classes	Country	Reg. Date	Reg. No
HERO	29, 30, 32	UK	1926	470267
HERO	1, 2, 5, 29 - 33	Switzerland	1928	59194 / 362755 (new)
HERO	32	Singapore	1939	T3903735Z
HERO	29	Singapore	1939	T3903736H
HERO	1, 2, 5, 29 - 33	International	1948	137974
HERO	31	Australia	1982	373753
HERO	29	UK	1985	1235841
HERO	29	Cuba	1993	94719
HERO	30	Cuba	1993	94719 A
Hero & Circle	1, 2, 5, 29 - 33	Switzerland	1928	59193 / 362754 (new)
Hero & Circle	1, 2, 5, 29 - 33	International	1948	137973
Hero & Oval	1, 2, 5, 29 - 33	Switzerland	1947	129470 / 350631 (new)
Hero & Oval	29	UK	1948	673683
Hero & Oval	29	USA	1953	71634241 / 0574752
Hero & Oval	1, 2, 5, 29 - 33	International	1966	327858
Hero & Oval	29	UK	1969	951642
Hero & Oval	30	UK	1969	951643
Hero & Oval	5	Australia	1970	237837
Hero & Oval	29	Australia	1970	251575
Hero & Oval	30	Australia	1970	251576
Hero & Oval	32	Australia	1970	251578
Hero & Oval	30, 32	Canada	1974	TMA201109
Hero & Oval	29 - 32	Japan	1975	1121528
Hero & Oval	29, 30, 32	Ireland	1981	103419
Hero & Oval	29	USA	1983	73312557 / 1230132
Hero & Oval	30	USA	1988	73312556 / 1495269
Hero & Oval	29, 30, 32	International	1989	540839

Hero & Oval	32	UK	1991	1469212
Hero & Blue Oval	29	Hong Kong	1983	19830068
Hero & Blue Oval	30	Hong Kong	1983	19830069
Hero & Blue Oval	32	Hong Kong	1983	19830070
Hero & Blue Oval	42 (nat.)	Thailand	1993	7.566
Hero & Arabic Script	5, 29, 30, 32	Switzerland	1979	301394
Hero & Arabic Script	5, 29, 30, 32	International	1980	450396
Hero Baby & Device	5, 10, 21, 25, 29, 30, 32	Switzerland	1990	381020
Hero Baby & Device	5, 10, 21, 25, 39, 30, 32	International	1991	566034
Hero Baby & Device	5	UK	1991	1466848
Hero Baby & Device	5	Turkey	1993	135.031
Hero Lunch	29	Switzerland	1979	297087
Hero Mini Drink	32	Switzerland	1988	361990
Hero Classica	29	UK	1990	1431755
Hero & Device	32	UK	1992	1497091
Hero Lite	32	UK	1995	2011175

Annexure 58 to the Complaint (to para. 26)

Domain Names containing the word "HERO" of which the Complainant is the prior, honest and bona fide registrant:

Domain Name	Owner
hero.ch	Hero, Switzerland
hero-group.ch	Hero, Switzerland
herousa.com	Hero North America
hero.cz	Hero Czech & Slovaika
hero.es	Hero Espana
hero.fr	Hero France
hero-japan.co.jp	Hero Japan
hero.nl	Hero Nederland
herobaby.com.tr	Hero Gida (Turkey)
hero.pl	Hero Polska
hero.pt	Hero Portugal