

ADMINISTRATIVE PANEL DECISION

Samuel Kim v. Louis Santiago

Case No. D2022-1484

1. The Parties

Complainant is Samuel Kim, United States of America (“United States”), represented by Criterion Counsel, Law Corporation, United States.

Respondent is Louis Santiago, United States.

2. The Domain Name and Registrar

The disputed domain name <bigchiefscharts.org> (the “Disputed Domain Name”) is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2022. On April 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on April 27, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 28, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 30, 2022.

The Center appointed Richard W. Page as the sole panelist in this matter on June 8, 2022. 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

Complainant's BIG CHIEF standard character trademark was registered with the United States Patent and Trademark Office ("USPTO") on October 15, 2013, in International Class 34 for "Cigarettes; Filter-tipped cigarettes; Filtered cigars and cigarettes; Flavored tobacco; Hand rolling tobacco; Pipe tobacco; Roll your own tobaccos; Rolling tobacco; Smoking tobacco; Tobacco; Tobacco, Cigars and cigarettes" (Registration No. 4,417,441), as well as Complainant's BC design trademark registered with the USPTO on September 1, 2020, in International Class 34 for "Ashtrays; Boxes for electronic cigarettes and electronic cigarette accessories; Cigarette lighters; Cigarette rolling papers; Electronic cigarette lanyards; Oral vaporizers for smokers containing hemp-derived CBD with a delta-9 concentration of no more the .3% on a dry weight basis; Tobacco grinders; Tobacco pipes" (Registration No. 6,143,567). The BIG CHIEF Mark and the BC Mark shall be collectively referred to as the BIG CHIEF Mark.

In addition, Complainant owns the BIG CHIEF standard character mark and the BC design mark registered in the State of California with the California Secretary of State specifically for "pre-filled vaporizer cartridges containing cannabis extract".

Respondent registered the Disputed Domain Name on December 30, 2021. The Disputed Domain Name resolves to a website offering products under the BIG CHIEF Mark.

5. Parties' Contentions

A. Complainant

Complainant contends that the Disputed Domain Name uses the entirety of the BIG CHIEF Mark and that the Disputed Domain Name is confusingly similar to the BIG CHIEF Mark owned by Complainant, pursuant to paragraph 4(a)(i) of the Policy.

Complainant further contends that the website to which the Disputed Domain Name resolves uses the BIG CHIEF Mark, and copies other elements of the <bigchiefextracts.com> website registered and operated by authorized licensees of Complainant. Complainant further contends that an online search for "big chief carts" generates paid advertising search results for the Disputed Domain Name.

Complainant alleges that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, pursuant to paragraph 4(a)(ii) of the Policy.

Complainant again alleges that online Google searches for "big chief carts" generated paid advertising search results for the Disputed Domain Name with a residential address identified in Los Angeles, California that is entirely unrelated to Complainant or/and or to Complainant's licensees.

Complainant further alleges that the website to which the Disputed Domain Name resolves is making unlawful commercial use of the Disputed Domain Name by advertising for sale and selling cannabis products to consumers using the BIG CHIEF Mark online and without a license, while fraudulently holding itself out as a BIG CHIEF website. Respondent has copied the same stylized font and images used by Complainant for the BIG CHIEF Mark on the website registered and operated by Complainant's authorized licensees at <bigchiefextracts.com>.

Complainant further alleges that Respondent has no relationship to Complainant, no relationship to any authorized licensees of Complainant, no relationship to the BIG CHIEF Mark, and no relationship to BIG

CHIEF products. Complainant further alleges that Respondent is making use of the Disputed Domain Name for commercial gain by illegally advertising for sale cannabis smoking products to consumers online without a valid cannabis license, which is not a *bona fide* or legitimate use.

Complainant further alleges that all cannabis related business in the State of California must be conducted in California pursuant to a valid license issued by the Department of Cannabis Control. Respondent does not hold any such license and indiscriminately offered for sale, sold, and distributed counterfeit BIG CHIEF-branded cannabis products to consumers inside and outside of the State of California online through the Disputed Domain Name. Complainant alleges that this is further evidence that Respondent's use of the Disputed Domain Name is not *bona fide* or legitimate.

Complainant licenses use of the BIG CHIEF Mark to authorized licensees for cannabis smoking products manufactured, distributed, and sold in the State of California. California Marijuana Company ("CMC") is the current licensee authorized by Complainant to use the BIG CHIEF Mark for cannabis smoking products in California. CMC's California cannabis License No. C12-0000154 is identified at the bottom of the <bigchiefextracts.com> website. Although BIG CHIEF cannabis smoking products are displayed on the <bigchiefextracts.com> website, no BIG CHIEF cannabis smoking products can be purchased directly through the <bigchiefextracts.com> website. All BIG CHIEF cannabis smoking products are sold exclusively in the State of California through licensed dispensaries or via delivery through a licensed delivery business in the State.

Complainant only licenses use of the GIG CHIEF Mark to cannabis smoking products to licensees holding valid licenses issued by the California Department of Cannabis Control authorizing those licensees to manufacture, distribute and/or sell cannabis products within the State. Cali Blue Sky Investments, Inc. originally registered the domain name <bigchiefextracts.com> pursuant to such a license from Complainant prior to the expiration of its California cannabis License No. D12-0000254-LIC on September 2, 2021. The <bigchiefextracts.com> domain name registration (currently operated in connection to the active cannabis license of Complainant's licensee CMC) was renewed by Cali Blue Sky Investments, Inc. on February 16, 2019. Although BIG CHIEF cannabis smoking products are displayed on the <bigchiefextracts.com> website, no BIG CHIEF cannabis smoking products can be purchased directly through the <bigchiefextracts.com> website. All BIG CHIEF cannabis smoking products are sold exclusively in the State of California through licensed dispensaries or via delivery through a licensed delivery business in the State.

Complainant asserts that Respondent registered and used the Disputed Domain Name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

First, Complainant asserts that Respondent registered the Disputed Domain Name on December 30, 2021. This registration occurred after the BIG CHIEF Mark was registered with the USPTO on October 15, 2013, after Cali Blue Sky Investments, Inc. registered the <bigchiefextracts.com> domain name on February 16, 2019, and after Complainant's BIG CHIEF Mark was registered with the California Secretary of State on May 28, 2020.

Second, Complainant asserts that Respondent is clearly attempting to intentionally attract for commercial gain, Internet users to the Disputed Domain Name by creating a likelihood of confusion with the BIG CHIEF Mark as to the source of Respondent's website. Complainant further asserts that Respondent is illegally selling counterfeit BIG CHIEF pre-filled vaporizer cartridges containing cannabis extract to consumers online in violation of Complainant's trademark rights, and in violation of California cannabis licensing law. Complainant further asserts that Respondent fraudulently attempts to hold itself out as the BIG CHIEF website while using identical copies of the BIG CHIEF Mark.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainant’s assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and,
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant contends that the Disputed Domain Name is confusingly similar to the BIG CHIEF Mark, pursuant to paragraph 4(a)(i) of the Policy. Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the BIG CHIEF Mark.

Complainant registered the BIG CHIEF Mark with the USPTO on October 15, 2013. Respondent has not challenged this registration. Therefore, for purposes of this proceeding, the Panel finds that Complainant has enforceable rights in the BIG CHIEF Mark.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Also, section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Also, section 1.11.1 of the [WIPO Overview 3.0](#) instructs that generic Top-Level Domains (“gTLDs”) such as “.org” may be disregarded for purposes of assessing confusing similarity.

The Panel finds that the entirety of the BIG CHIEF Mark is included in the Disputed Domain Name. The Panel further finds that the additional letter “s” and the phrase “carts” does not prevent a finding of confusing similarity. In addition, the inclusion of “.org” may be disregarded.

Therefore, the Disputed Domain Name is confusingly similar with the BIG CHIEF Mark. Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires Complainant to prove that Respondent has no rights or legitimate interests in the Disputed Domain Name. Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating it has rights or legitimate interests in the Disputed Domain Name. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the BIG CHIEF Mark.

Complainant alleges that the website to which the Disputed Domain Name resolves is making unlawful commercial use of the Disputed Domain Name by advertising for sale and selling cannabis products to consumers using the BIG CHIEF Mark online and without a license, while fraudulently holding itself out as a BIG CHIEF website. Respondent has copied the same stylized font and images used by Complainant for the BIG CHIEF Mark on the website registered and operated by Complainant's authorized licensees at <bigchiefextracts.com>. Moreover, Respondent's website does not disclose Respondent's relationship (or lack thereof) with Complainant.

Complainant further alleges that Respondent has no relationship to Complainant, no relationship to any authorized licensees of Complainant, no relationship to the BIG CHIEF Mark, and no relationship to BIG CHIEF products. Complainant further alleges that Respondent is making use of the Disputed Domain Name for commercial gain by illegally advertising for sale cannabis smoking products to consumers online without a valid cannabis license, which is not a *bona fide* or legitimate use.

Complainant further alleges that Respondent is not commonly known by the name "big chief".

The Panel finds that these allegations constitute a *prima facie* case that Respondent lacks rights or legitimate interests in the Disputed Domain Name, which Respondent has not contested.

The Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant asserts that Respondent has registered and is using the Disputed Domain Name in bad faith, pursuant to paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

(i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the BIG CHIEF Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or

(ii) you [Respondent] have registered the Disputed Domain Name in order to prevent Complainant from reflecting BIG CHIEF Mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the BIG CHIEF Mark as to the source, sponsorship, affiliation, or endorsement of your website or

location or of a product.

The four criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In addition to these criteria, other factors alone or in combination can support a finding of bad faith. Section 3.2.2 of the [WIPO Overview 3.0](#) lists additional circumstances that may support a finding of bad faith.

First, Complainant asserts that Respondent registered the Disputed Domain Name on December 30, 2021. This registration occurred after Complainant's BIG CHIEF Mark was registered with the USPTO on October 15, 2013, after Cali Blue Sky Investments, Inc. registered the <bigchiefextracts.com> domain name on February 16, 2019, and after Complainant's BIG CHIEF Mark was registered with the California Secretary of State on May 28, 2020.

Second, Complainant asserts that Respondent is clearly attempting to intentionally attract for commercial gain, Internet users to the <bigchiefscarts.org> website by creating a likelihood of confusion with the BIG CHIEF Mark as to the source of Respondent's website. Complainant further asserts that Respondent is illegally selling counterfeit BIG CHIEF pre-filled vaporizer cartridges containing cannabis extract to consumers online in violation of Complainant's trademark rights, and in violation of California cannabis licensing law. Complainant further asserts that Respondent fraudulently attempts to hold itself out as the BIG CHIEF website while using identical copies of the BIG CHIEF Mark.

Respondent has not contested these assertions.

The Panel finds that the evidence in this proceeding supports the conclusion that Respondent has violated paragraph 4(b)(iv) of the Policy. Furthermore, Respondent most likely knew, or should have known, of Complainant's rights in the BIG CHIEF Mark prior to registering the Disputed Domain Name. In addition, while unclear if any products were actually delivered from Respondent's website, and if such were counterfeit or not, the Respondent's attempt to fraudulently hold itself out as Complainant or connected to Complainant, for profit, to obtain sensitive payment details from Complainant's customers, or to otherwise take advantage of the BIG CHIEF Mark, further supports a finding of bad faith.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <bigchiefscarts.org> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: June 21, 2022