

ADMINISTRATIVE PANEL DECISION

Samuel Kim v. Domain Admin by WhoisProtection.cc / Dave Cary
Case No. D2022-2355

1. The Parties

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

The Respondent is Domain Admin by WhoisProtection.cc, Malaysia / Dave Cary, United States.

2. The Domain Name and Registrar

The disputed domain name <bigchiefextractsonline.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 29, 2022. On June 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 30, 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 the Complainant on July 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 1, 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 the Respondent of the Complaint, and the proceedings commenced on July 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 1, 2022.

The Center appointed William F. Hamilton as the sole panelist in this matter on August 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

The Complainant sells cigarettes, tobacco, pre-filled vaporizer cartridges containing cannabis extract, and related products.

The Complainant obtained and owns the registration of the BIG CHIEF word trademark (the “Mark”) with the United States Patent and Trademark office, Registration No. 4,417,441, dated October 15, 2013, indicating a first use of June 1, 2012. The Complainant also obtained and owns a registration of a design trademark (the “Design”) with the United States Patent and Trademark Office, Registration No. 6,143,567, dated September 1, 2020. The Complainant also obtained registrations for the Mark and Design with the State of California, United States.

The Complainant owns the domain name <bigchiefextracts.com> which resolves to a website promoting the Complainant’s products.

The disputed domain name was registered on July 14, 2021. The disputed domain name resolves to a website prominently featuring the Mark and the Design and offering for sale products similar to the products offered for sale by the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name is composed of the Complainant’ Mark and the dictionary terms “extracts” and “online” used as suffixes to the Mark.

The Complainant asserts that the Complainant has never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, and that the Respondent has never engaged in any *bona fide* commercial activity in connection with the disputed domain name.

The Complainant assert that the Respondent registered and used the disputed domain name in bad faith to lure unsuspecting Internet consumers to the Respondent’s website utilizing the Complainant’s Mark and Design.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's Mark.

The disputed domain name is composed of the Mark and the dictionary words "extracts" and "online" appended to the Mark. The Mark is highly recognizable within the disputed domain name. A domain name which wholly incorporates a complainant's registered mark is sufficient to establish confusingly similarity for the purposes of the Policy when, as here, the addition to the Mark is a generic or dictionary term. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7; *Nomura International Plc / Nomura Holdings, Inc. contre Global Domain Privacy / Nicolas Decarli*, WIPO Case No. [D2016-1535](#) (transferring <nomura-bank.com>). See also [WIPO Overview 3.0](#), section 1.8 ("where the relevant trademark is recognizable with the disputed domain name, the additions of other terms (whether descriptive, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element"); *Nomura International Plc and Nomura Holdings, Inc. v. Whois Privacy Protection Service, Inc. / PUK SERVICES*, WIPO Case No. [D2015-2036](#) (transferring <nomuralabuan.com>); *Nomura International Plc. v. Name Redacted*, WIPO Case No. [D2021-0654](#).

The generic Top-Level Domain of the disputed domain name, in this case ".com", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. [D2016-1759](#) (transferring <monsterenergy.world>).

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. The Respondent is not affiliated with the Complainant in any way and does not have any business relationship with the Complainant. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. *Compagnie de Saint Gobain v. Com-Union Corp.*, WIPO Case No. [D2000-0020](#).

The Complainant has thus established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name.

Furthermore, the disputed domain name carries a risk of implied affiliation with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1. The association of the two words "extracts" and "online" with the Mark in the disputed domain name clearly suggests that the disputed domain name will resolve to a website offering the Complainant's products for sale which website, in fact, extensively copies the Mark and the Design.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following scenarios:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds the disputed domain name was registered and is being used in bad faith.

On the evidence presented, there is no doubt that the disputed domain name was registered and used in bad faith to lure unsuspecting Internet users to the Respondent's website for the purpose of selling products fraudulently bearing the Complainant's Mark and Design. The Respondent cannot plausibly claim not to have been aware of the Complainant's Mark and Design which would have been quickly disclosed in an Internet search. But more obviously, the simple fact that the Respondent is offering similar products to the Complainant's products on the Respondent's website that prominently features both the Complainant's Mark and Design dispels any claim of mere coincidence or serendipity.

Moreover, even disregarding the foregoing analysis, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#) ("where the reputation of a complainant in a given mark is significant and the mark bears strong similarities to the disputed domain name, the likelihood of confusion is such that bad faith may be inferred"); *DPDgroup International Services GmbH & Co. KG v. Wise One, Wilson TECH*, WIPO Case No. [D2021-0109](#); *Monster Energy Company v. PrivacyDotLink Customer 116709 / Ferdinand Nikolaus Kronschnabl*, WIPO Case No. [D2016-1335](#).

The Complainant has met its burden under 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 <bigchiefextractsonline.com> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: August 11, 2022