

ADMINISTRATIVE PANEL DECISION

Samuel Kim v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) /
David Monroe
Case No. D2022-3086

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, Privacy Protect, LLC, United States / David Monroe, United States.

2. The Domain Name and Registrar

The disputed domain name <bigchiefextractsofficial.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 20, 2022. On August 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 23, 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 August 30, 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 August 30, 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 September 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 27, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on September 30, 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 is a company that advertises and sells cigarettes, tobacco, cigarette rolling papers, oral vaporizers for smokers containing hemp-derived CBD, pre-filled vaporizer cartridges, cannabis, edibles, and products containing cannabis extract.

The Complainant owns the following trademarks with the United States Patent and Trademark Office (“USPTO”): BIG CHIEF (standard character mark), United States Registration No. 4,417,441, registered on October 15, 2013, in international class 34; and BC (stylized mark), United States Registration No. 6,143,567, registered on September 1, 2020, in international class 25 and 34. The foregoing trademarks will hereinafter collectively be referred to as the “BIG CHIEF Marks”.

In addition, the Complainant owns the following trademarks in the State of California, United States, registered with the California Secretary of State: BIG CHIEF (standard character mark), Registration No. 02005307; and BC (stylized mark), Registration No. 02005326.

The Complainant licenses use of the BIG CHIEF Marks for cannabis-smoking products to licensees in California holding valid licenses issued by the California Department of Cannabis Control, which authorizes those licensees to manufacture, distribute and/or sell cannabis products within the State.

The Disputed Domain Name was registered on May 24, 2021, and resolves to a website that is extremely similar to the Complainant’s website. The Respondent’s resolving website displays the Complainant’s BIG CHIEF Marks and copies elements of the Complainant’s website located at “www.bigchiefextracts.com”. Although cannabis-smoking products are displayed on the Complainant’s website, no smoking products containing cannabis can be purchased directly through the website. All 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. The Respondent is not a licensee of the Complainant, nor does it have a valid license to manufacture, promote or sell cannabis in California.

5. Parties’ Contentions

A. Complainant

The following are the Complainant’s contentions:

- the Disputed Domain Name is confusingly similar to the Complainant’s BIG CHIEF Marks;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

(i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

(iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the BIG CHIEF Marks.

It is uncontroverted that the Complainant has established rights in the BIG CHIEF Marks based on its several years of use as well as its registered trademarks for the BIG CHIEF Marks in the United States. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the BIG CHIEF Marks. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the BIG CHIEF Marks.

The Disputed Domain Name consists of the BIG CHIEF Marks followed by the terms "extracts" and "official", and then followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". For example, numerous UDRP decisions have reiterated that the addition of other terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Further, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent bears the burden of production to demonstrate rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant's BIG CHIEF Marks. The Complainant does not have any business relationship with the Respondent, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name. Based on the use made of the Disputed Domain Name to resolve to a website promoting presumably counterfeit goods bearing the BIG CHIEF Marks, and copying other elements of the Complainant's website, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name.

In this case, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not submitted any substantive arguments or evidence to rebut the Complainant's *prima facie* case. As such, the Panel determines that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy as set forth below.

First, the Panel concludes that the Respondent is using the Disputed Domain Name for an illegitimate purpose that demonstrates knowledge of the Complainant's trademark rights and a bad faith intent to register and use the Disputed Domain Name. By registering a disputed domain name confusingly similar to a complainant's mark to provide similar services to the ones provided by the complainant, it is evident that a respondent had knowledge of the complainant, its business, and its mark when registering the disputed domain name. In light of the circumstances in this case, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's BIG CHIEF Marks at the time the Disputed Domain Name was registered.

Second, the use of a domain name to intentionally attempt to attract Internet users to a respondent's website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's website demonstrates registration and use in bad faith. Based on the circumstances here, the Respondent registered and is using the Disputed Domain Name in bad faith to target the Complainant's BIG CHIEF Marks to disrupt the Complainant's business, and to drive Internet traffic seeking the Complainant's goods to the website to which the Disputed Domain Name resolves.

Moreover, the registration of a domain name that reproduces a trademark in its entirety (being identical or confusingly similar to such trademark) by an individual or entity that has no relationship to that mark, without any reasonable explanation on the motives for the registration, may be suggestive of opportunistic bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#). Since the Respondent is not one of the Complainant's licensees, and does not have a valid California cannabis license, the Respondent presumably distributes counterfeit BIG CHIEF pre-filled vaporizer cartridges containing cannabis extract to online consumers by creating a likelihood of confusion with the Complainant's BIG CHIEF marks as to the source, sponsorship, affiliation or endorsement of the Respondent's website. In doing so, the Respondent by means

of the inherently misleading disputed domain name fraudulently attempts to hold itself out as the “official” BIG CHIEF website, which conduct is tantamount to bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 <bigchiefextractsofficial.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: October 14, 2022