

ADMINISTRATIVE PANEL DECISION

Samuel Kim v. Domain Administrator, See PrivacyGuardian.org / Jonathan Littlewood

Case No. D2022-0368

1. The Parties

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

Respondent is Domain Administrator, See PrivacyGuardian.org, United States / Jonathan Littlewood, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bigchiefofficial.com> (hereinafter “Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2022. On February 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 3, 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 February 7, 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 February 7, 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 February 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 2, 2022.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on March 7, 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 owns United States trademark Registration No. 4,417,441 (registered October 15, 2013) for the mark BIG CHIEF for various tobacco and smoking products. It also operates (or licenses) dispensaries in California that sell a variety of cannabis products, including vaping cartridges. Complainant often uses a stylized version of its mark:



(hereinafter the “Stylized Mark”). Complainant also owns United States federal trademark Registration 6,143,567 (Registered September 1, 2020) for a design that includes the letters “BC”:



(hereinafter the “BC Design Mark.”).

Complainant licenses use of the BIG CHIEF trademark to authorized licensees holding valid licenses issued by the California Department of Cannabis Control authorizing those licensees to manufacture, distribute, and sell cannabis products within the state. One of Complainant’s licensees, Cali Blue Sky Investments, Inc., registered the <bigchiefextracts.com> domain name on February 17, 2019 pursuant to such a license.

Although Complainant does not sell cannabis products online, it maintains with its licensees a website under the <bigchiefextracts.com> domain name. The BIG CHIEF mark is displayed on the website in block letters and in the Stylized Mark format. The website also displays images of Complainant’s authorized cannabis product packaging, which include the BIG CHIEF mark as registered, the Stylized Mark and the BC Design Mark.

Respondent registered the Disputed Domain Name on June 1, 2021, long after Complainant registered the BIG CHIEF trademark. On the associated webpages, Respondent displays all of Complainant’s trademarks, including the Stylized Mark and BC Design Mark, which it uses as a favicon. Respondent’s website displays images of cannabis product packaging identical to Complainant’s, including identical subbrands such as “Apple Jack” and “Black Water OG”.

5. Parties’ Contentions

A. Complainant

Complainant contends that its United States trademark registration establishes its rights in the BIG CHIEF trademark and that the Disputed Domain Name is confusingly similar to its registered mark.

Complainant contends that Respondent has no rights or legitimate interest in the Disputed Domain Name. Complainant has not licensed Respondent to use the BIG CHIEF mark. Complainant alleges that the

cannabis products displayed on Respondent's website are counterfeit. Complainant also alleges that Respondent's interstate sales violate California law, which only authorizes sales within the state.

Complainant contends that Respondent registered and continues to use the Disputed Domain Name in bad faith. Given Respondent's wholesale copying of Complainant's marks and product packaging, Complainant contends that the inference is incontrovertible that when Respondent registered the Disputed Domain Name, it was aware of Complainant and its rights in the BIG CHIEF mark.

Complainant contends that Respondent is using the Disputed Domain Name in bad faith to attract and confuse Internet Users to sell them counterfeit products for commercial gain.

B. Respondent

Respondent did not answer the complaint.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that Complainant's trademark registrations establish that it has rights in the BIG CHIEF trademark. The Panel further finds that, because the Disputed Domain Name incorporates Complainant's mark entirely, it is confusingly similar to Complainant's registered mark. Respondent's addition of the term "official" in the Disputed Domain Name does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant has presented a *prima facie* case for Respondent's lack of rights or legitimate interests in the Disputed Domain Name, which Respondent has not rebutted. The Panel finds that Respondent has no rights or legitimate interests in the Disputed Domain Name. Respondent is not licensed to use Complainant's mark or by the State of California to sell cannabis products. Respondent is passing itself off as Complainant to sell counterfeit products online, offering to deliver the counterfeit products to all 50 states in violation of California law. The Panel therefore finds that Respondent has no rights or legitimate interests in the Disputed Domain Name. See [WIPO Overview 3.0](#), section 2.13.1 (sale of counterfeit goods or illegal pharmaceuticals never legitimate).

Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent registered the Disputed Domain Name in bad faith. Complainant's trademark was registered well before Respondent registered the Disputed Domain Name. Respondent was obviously well aware of Complainant and its rights—it created counterfeits of Complainant's product packaging and copied the distinctive elements of Complainant's website, including prominent display of Complainant's Stylized Mark and the adoption of Complainant's BC Design Mark as a favicon. Intentional copying is evidence bad faith registration. See *LeSportsac, Inc. v. Kathy Clapp*, WIPO Case No. [D2012-2506](#) ("In order to mislead consumers into believing that Respondent is an authorized dealer, Respondent purposely mimics the distinctive elements of Complainant's website. Such illegal and confusingly deceptive activity is strong evidence that Respondent registered and uses the Domain Name in bad faith").

The Panel also finds that Respondent is intentionally attempting to attract, for commercial gain, Internet users to Respondent's website, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Policy paragraph 4(b)(iv). It is bad faith to use the Disputed Domain Name to attract Internet users and sell them counterfeit products. [WIPO Overview 3.0](#), section 3.1.4 ("As noted in section 2.13.1, given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith."). The bad faith here is especially egregious because Complainant does not sell its cannabis products online. It only sells its cannabis products from dispensaries licensed by the state to sell cannabis products within California. This is also bad faith use.

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 <bigchiefofficial.com> be transferred to Complainant.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: March 21, 2022