

ADMINISTRATIVE PANEL DECISION

FLRish IP, LLC v. Leonard Rotich
Case No. D2022-1706

1. The Parties

The Complainant is FLRish IP, LLC, United States of America (“United States”), represented by Evoke Law, PC, United States.

The Respondent is Leonard Rotich, Kenya.

2. The Domain Name and Registrar

The disputed domain name <shop-harborside.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2022. On May 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 11, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 June 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 22, 2022.

The Center appointed Federica Togo as the sole panelist in this matter on June 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 the registered owner of trademarks in several jurisdictions for HARBORSIDE, e.g. United States Registration No. 5509269 HARBORSIDE, registered on July 3, 2018 for several goods and services in classes 25, 35, 41 and 44.

The disputed domain name was registered on April 25, 2022. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolves to an online shop selling cannabis products, where the Complainant's trademark is prominently displayed, reproducing the logos and images, as displayed on the Complainant's official website available at "www.shopharborside.com".

5. Parties' Contentions

A. Complainant

It results from the Complainant's undisputed allegations that it is a California state-licensed enterprise operating cannabis dispensary, delivery services, manufacturing, and cultivation pursuant to California's Medicinal and Adult-Use Cannabis Regulation and Safety Act (SB 94) under the HARBORSIDE brand. Prior to the enactment of SB 94, since 2006 the Complainant provided medical cannabis pursuant to California law SB 215, as a properly organized collective. At all times, the Complainant has maintained the necessary state approvals to legally provide patients and/or adult-users cannabis products in California. It is subject of a documentary series on the Discovery channel and had been prominently and positively reported on in the media, featured by news teams from around the globe including major news outlets in the United States, as well as in Canada, Japan, Germany, and the United Kingdom.

Since August 2016, the Complainant use the domain name <shopharborside.com> which resolve to its official website providing all information related to the Complainant's business.

The Complainant contends that due to its success and prominence in the cannabis industry, it has established considerable goodwill in the HARBORSIDE trademark.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademark, since it entirely incorporates the Complainant's registered trademark HARBORSIDE and by adding a hyphen "-" the disputed domain name is clearly trying to trade off potential confusion with the Complainant's actual website at "www.shopharborside.com". Furthermore, the addition of the term "shop" is irrelevant as this is a descriptive term for the Complainant's dispensary shop and does not avoid the confusing similarity with the Complainant's trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, it has not granted any license, consent, or other right to the Respondent authorizing him to register the disputed domain name using HARBORSIDE trademark. In addition, the Respondent is not commonly known by the disputed domain name, nor is the Respondent making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. The disputed domain name leads to a webpage that prominently displays the well-recognized and registered HARBORSIDE mark and HARBORSIDE flag logo in connection with promoting the sale of cannabis and cannabis products. While the Respondent's website currently offers cannabis goods for sale, such offerings cannot be classified as being *bona fide* as they are being made with the intention to deceive consumers into mistakenly thinking they are purchasing from the Complainant. Such obvious impersonation is undoubtedly for fraudulent purposes.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. In the webpage to which the disputed domain name resolves the Complainant's registered HARBORSIDE flag logo mark appears prominently in the top left corner and the page also uses the

Complainant's photo of team members wearing badges with the HARBORSIDE flag logo. Content on the webpage contains links to where persons can purchase cannabis and cannabis products. Therefore, there is no doubt that the Respondent was aware of the Complainant's trademarks when it sought to register the disputed domain name. It is clear that the Respondent has intentionally attempted to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's mark.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for HARBORSIDE. Reference is made in particular to United States Registration No. 5509269 HARBORSIDE, registered on July 3, 2018 for several goods and services in classes 25, 35, 41 and 44.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark HARBORSIDE is fully included in the disputed domain name, preceded by the term "shop" and by a hyphen. Furthermore, it is the view of this Panel that the addition of the term "shop" and the hyphen in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark HARBORSIDE, e.g., by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation, since the disputed domain name contains the Complainant's trademark preceded by the term "shop" and terms with an "inherent Internet connotation" are seen as tending to suggest sponsorship or endorsement by the trademark owner, see [WIPO Overview 3.0](#), section 2.5.1. This is also confirmed by the content of the website to which the disputed domain name resolves, selling cannabis products, where the Complainant's trademark is prominently displayed, reproducing the logos and images, as displayed on the Complainant's website at "www.shopharborside.com".

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain name resolves to a website allegedly selling similar goods to those of the Complainant and reproducing without any authorization the Complainant's trademark, the logos and images, as displayed on the Complainant's official website available at "www.shopharborside.com". For the Panel, it is therefore evident that the Respondent positively knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the

Complainant's trademarks when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant's registered trademark HARBORSIDE preceded by the term "shop" and by a hyphen. Registration of the disputed domain name which contains a third party's mark, in awareness of said mark and in the absence of rights or legitimate interests amounts to registration in bad faith (see e.g., *Cofra AG v. Privacy Service Provided by Withheld for Privacy ehf / Name Redacted*, WIPO Case No. [D2021-3762](#); *F. Hoffmann-La Roche AG v. Domain Administrator*, See *PrivacyGuardian.org / Ponomarenko LTD, Pawlo Ponomarenko*, WIPO Case No. [D2021-2951](#); *Philip Morris Products S.A. v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Farvez Bhuiyan, Heets Dubai ae*, WIPO Case No. [D2021-1194](#)).

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at point 3.2.1):

(i) the nature of the disputed domain name (a domain name incorporating the Complainant's mark plus the addition of the term "shop");

(ii) the content of the website to which the disputed domain name directs, selling similar goods to those of the Complainant and reproducing without any authorization the Complainant's trademark, the logos and images, as displayed on the Complainant's official website.

(iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

(iv) other indicia generally suggesting that the Respondent had somehow targeted the Complainant (e.g. the disputed domain name <shop-harborside.com> is almost identical to the domain name used by the Complainant for its official website <shopharborside.com>.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <shop-harborside.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: July 14, 2022