

ADMINISTRATIVE PANEL DECISION

Connected International, Inc. v. Domain Administrator, See
PrivacyGuardian.org / Cali Green Store, Mcglenny Ros
Case No. D2022-1978

1. The Parties

Complainant is Connected International, Inc., United States of America (“US”), represented by Venable, LLP, US.

Respondent is Domain Administrator, See PrivacyGuardian.org, US / Cali Green Store, Mcglenny Ros, US.

2. The Domain Name and Registrar

The disputed domain name <alienlabsshop.com> (the “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 May 31, 2022. On June 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on June 1, 2022.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on June 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 28, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on July 4, 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 was founded in 2009 and is a cannabis cultivator and retailer. In 2017, Complainant acquired Alien Labs, a cannabis company founded in 2014 that is a top-level cannabis brand in California and Arizona.

As indicated in the chart below, Complainant owns federal trademark registrations and pending applications for the trademark ALIENLABS in International Classes 25, 34, and 35. Complainant has also been issued Notices of Allowances for its pending applications for the ALIENLABS mark in International Classes 1, 3, 5, 29, 30, 31, and 34. In addition, Complainant owns California and Arizona state registrations for the ALIENLABS mark in Classes 5, 31, and 34.

Regis. No.	Trademark	Int'l Classes	Regis. Date	Date of First Use	Type
6315464	ALIENLABS	25	Apr. 6, 2021	June 1, 2016	Federal
6315466	ALIENLABS	35	Apr. 6, 2021	June 1, 2016	Federal
6315271	ALIENLABS	34	Apr. 6, 2021	Oct. 1, 2017	Federal
90149115	ALIENLABS	1, 3, 5, 29, 30, 31	Pending	1(b) Application	Federal
90149124	ALIENLABS	34	Pending	1(b) Application	Federal
9188725	ALIENLABS	5, 31, 34	Nov. 13, 2020	Nov. 13, 2020	Arizona
2006749	ALIENLABS	5, 31, 34	Oct. 12, 2020	Mar. 1, 2014	California

Complainant principally markets the ALIENLABS mark for a wide range of consumer products, including but not limited to cannabis products, tobacco products, t-shirts, shorts, hats, sweatshirts, hoodies, sweatpants, and socks, which are sold both online and in stores.

Complainant conducts business on the Internet and states that the ALIENLABS mark has a strong Internet presence. For example, Complainant operates an online store at the following sites: "www.alienlabs.org" and "www.twentysixtynine.com". In addition, over 300,000 consumers follow Complainant's @alienlabs Instagram account.

The Domain Name was registered on June 29, 2020 and resolves to a website which offers for sale cannabis products, including but not limited to "buds, concentrates, pre-rolls, and vapes", using photographs taken from Complainant's Instagram account.

5. Parties' Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states that as a result of long, continuous and extensive use of its ALIENLABS trademark and the commercial success of its ALIENLABS products, the ALIENLABS mark has developed an enviable cachet, image, and reputation in the cannabis industry and to consumers. The goodwill associated with the ALIENLABS mark is of inestimable value to Complainant.

Complainant asserts that Respondent has been using the Domain Name because of its similarity to Complainant's domain name <alienlabs.org>, where Complainant offers and advertises its goods. Respondent's usage of the Domain Name is confusingly similar to the ALIENLABS mark, as Respondent is attempting to mislead consumers into believing that Respondent is related to or affiliated with Complainant, or that Respondent is authorized to use the ALIENLABS trademark, when it is not.

Complainant emphasizes that Respondent registered the Domain Name on June 29, 2020, over four years after Complainant began using its ALIENLABS mark nationally, and over six years after Complainant began using its ALIENLABS mark in California. The Domain Name incorporates the entire ALIENLABS trademark, with the addition of the word "shop" and the ".com" generic Top-Level-Domain ("gTLD"). Complainant contends the mere addition of a non-distinctive term like "shop" to the ALIENLABS trademark constitutes confusing similarity. Further, because consumers often seek to "shop" on Complainant's authentic website, the combination of the ALIENLABS trademark and the word "shop" is confusingly similar. Moreover, the addition of ".com" is an insignificant addition that does not remove the likelihood of confusion, as it only indicates the Domain Name is registered in the ".com" gTLD.

In view of the above, Complainant concludes it may be inferred that the Domain Name is calculated to confuse or deceive, as it falsely suggests an association with Complainant.

(ii) Rights or legitimate interests

Complainant asserts that Respondent has no rights or legitimate interests with respect to the Domain Name because there is no evidence or circumstances known to Complainant under paragraph 4(c) of the Policy that would give rise to any rights or legitimate interests for Respondent.

Complainant states there is no evidence that Respondent uses the Domain Name in connection with the *bona fide* offering of goods or services. Respondent registered the Domain Name in June 2020, and there is no evidence Respondent has been commonly known by the Domain Name, due to the short amount of time (less than two years) since registration of the Domain Name. Furthermore, there is no evidence of noncommercial fair use with the Domain Name. Respondent's inclusion of a blog post from 2020 as a subpage of the website linked to the Domain Name is not fair use.

Complainant claims the primary purpose for use of the Domain Name is in connection with a website for the commercial sale of counterfeit cannabis products. The main page of the site linked to the Domain Name includes products, prices, and a various "shop" links to specific product types. Complainant has provided evidence of screenshots of the website linked to the Domain Name. The blog post criticizing Complainant is only accessible after scrolling all the way to the bottom of the main page. Further, the critical blog post is from July 2020 – nearly two years ago. Prior UDRP panels have found no legitimate interest in a disputed domain name under circumstances with far less commercial activity.

Complainant submits that at the time Respondent registered the Domain Name, the ALIENLABS mark was well known within the cannabis industry and among consumers throughout the US. In July 2020, only twelve days after registering the Domain Name, Respondent posted the blog post on the website linked to the Domain Name criticizing Complainant. Through this blog post Respondent demonstrated a deep understanding of Complainant's notoriety in the cannabis industry. It may therefore be inferred that at the time Respondent registered the Domain Name, Respondent was aware of Complainant's trademark rights. This gives rise to the presumption that Respondent does not have any rights or legitimate interest in the Domain Name.

Complainant states that Respondent has not received any license or consent, express or implied, to use the ALIENLABS trademark in a domain name or in any other manner, nor has Complainant acquiesced in any way to such use or application of the ALIENLABS mark by Respondent. At no time did Respondent have authorization from Complainant to register the Domain Name. To the best knowledge of Complainant, Respondent has no rights or legitimate interest in the Domain Name. Complainant urges that the use of a domain name that incorporates a well-known trademark to direct visitors to a website unconnected with the

trademark owner cannot constitute use in connection with a *bona fide* offering of goods and services or otherwise be considered a legitimate interest in a domain name.

Complainant states the Domain Name is used by Respondent in an attempt to pass itself off as Complainant. The website linked to the Domain Name offers for sale counterfeit cannabis products, including but not limited to “buds, concentrates, pre-rolls, and vapes”, using photographs taken from Complainant’s authentic Instagram account without Complainant’s permission or authorization. The offering for sale of counterfeit goods supports a finding of bad faith.

Complainant has provided copies of pages printed on May 18, 2022 from the website linked to the Domain Name, as well as screenshot examples of the unauthorized use of the ALIENLABS mark on the website. Respondent sought to take advantage of Complainant’s goodwill and the goodwill of the ALIENLABS mark. It is impossible to conceive of a circumstance in which Respondent could legitimately use this Domain Name without creating a false impression of association with Complainant.

Complainant concludes that not only do the facts preclude Respondent from demonstrating any legitimate interest in the Domain Name, but they also further establish Respondent’s bad faith.

(iii) Registered and used in bad faith

Complainant states that Respondent has registered and used the Domain Name in bad faith. The website corresponding to the Domain Name is being maintained without Complainant’s authorization. As stated above, Respondent posted the blog post criticizing Complainant only twelve days after registering the Domain Name. This supports a finding that Respondent was not only aware of Complainant at the time of registering the Domain Name, but also registered the Domain Name in bad faith.

Complainant asserts the Domain Name is used by Respondent in an attempt to pass itself off as Complainant. The website linked to the Domain Name offers for sale cannabis products under the false guise that they are authentic ALIENLABS products when they are not. It may be inferred that Respondent has registered the Domain Name to purposefully disrupt the business of Complainant and its authorized websites at “www.alienlabs.org” and “www.twentysixtynine.com”, and to create a likelihood of confusion with the ALIENLABS mark. Through the site linked to the Domain Name, consumers can add some of the products to their cart, while other products do not have that feature. For the products that can be added to the cart the price of the products ranges from USD 50 to USD 3,000. Consumers are also charged a USD 25 flat rate shipping fee. Once a product has been added to the cart, consumers are prompted to provide their full name, billing and mailing address, phone number, and email address. Consumers are given the option to pay for their purchase using PayPal, CashApp, Apple Pay, or Bitcoin. It is a concern for Complainant that Respondent is merely trying to collect consumers’ personal identifying information, including payment information, and either provide counterfeit products or no products at all. As such, it may be inferred that Respondent has registered the Domain Name primarily to capitalize on the identity and close similarity of the Domain Name to Complainant’s ALIENLABS mark and to gain revenue therefrom.

In view of the foregoing, Complainant concludes Respondent has registered and used the Domain Name in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

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

A. Identical or Confusingly Similar

Complainant has demonstrated that it has rights in its ALIENLABS trademark through registration and widespread use. The fact that the Domain Name was registered before the registration date of Complainant's federal trademarks were granted does not, by itself, preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element. See Section 1.1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") especially as Complainant's rights per its claimed first use pre-date registration of the Domain Name by more than six years ([WIPO Overview 3.0](#), section 1.3), and also noting the content clearly shows an intent to target a source-identifying capacity in the Complainant's marks ([WIPO Overview 3.0](#), section 1.15).

The Panel finds that the Domain Name incorporates the ALIENLABS mark in its entirety, while adding the word "shop". This supports a finding of confusing similarity with Complainant's ALIENLABS mark. Numerous UDRP decisions have found that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#); *General Motors LLC v. Link Commercial Corp*, WIPO Case No. [D2010-1463](#) (finding disputed domain <chevroletdealers.com> confusingly similar to complainant's CHEVROLET mark); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#) (holding the addition of the "nondistinctive generic terms 'unlimited' and 'downloads'" to complainant's WII trademark constituted confusing similarity.); see also section 1.7 of the [WIPO Overview 3.0](#), which states, "where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#) states, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element".

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to respond to the Complaint. The Panel finds that Complainant has not authorized Respondent to use Complainant's ALIENLABS trademark; that Respondent is not commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name has been used to connect to a website that impersonates Complainant and Complainant's own websites (using photographs taken from Complainant's Instagram account without Complainant's permission), and purporting to offer counterfeit products directly competitive with Complainant's products. Moreover, in the face of these

allegations in the Complaint, Respondent has made no attempt to rebut any of them. See WIPO Overview, section 2.13.1 (Panels have categorically held that the use of a domain name for illegal activity ... can never confer rights or legitimate interests on a respondent.”).

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent’s lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”.

Here, the Panel determines that the Domain Name was registered and has been used in bad faith. With respect to registration, the evidence submitted by Complainant demonstrates that Respondent was aware of Complainant and improperly targeted Complainant and its distinctive ALIENLABS trademark when registering the Domain Name. The blogpost on the website linked to the Domain Name provides a detailed discussion and critique of Complainant and its products, while identifying the drafter of the blogpost as an entity called “Flowsent”. In addition, Respondent used Complainant’s distinctive trademark in full, while merely adding the descriptive word “shop” and creating a website impersonating Complainant and Complainant’s websites. Respondent’s site purports to sell counterfeit products directly competitive with those sold by Complainant. In the face of all of these allegations made by Complainant, Respondent has provided no response at all to attempt to justify why it chose to register the Domain Name corresponding to Complainant’s ALIENLABS mark.

This point is further confirmed by Respondent’s use of the Domain Name. Complainant has submitted evidence to indicate that the Domain Name was being used by Respondent primarily for the illegal purpose of perpetrating a fraud, seeking to impersonate Complainant and its online commercial websites. Moreover, it appears more likely than not that Respondent’s intention, when registering the Domain Name, was to purposefully disrupt the business of Complainant and its official websites at “www.alienlabs.org” and “www.twentysixtynine.com”. As provided by [WIPO Overview 3.0](#), section 3.1.4, “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”; see also *Mattel, Inc. v. Magic 8 ball factory*, WIPO Case No. [D2013-0058](#) (finding bad faith where the respondent sold counterfeit Magic 8 Ball toys through the disputed domain name <magic8balls.biz>); *Balenciaga v. liu zhixian, zhixian liu*, WIPO Case No. [D2010-1831](#) (finding bad faith where respondent sold counterfeit handbags through the domain name <balenciaga-bags.com>).

In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied the third element 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 Domain Name, <alienlabsshop.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: July 26, 2022