

ADMINISTRATIVE PANEL DECISION

Backpack Boyz LLC v. Privacy service provided by Withheld for Privacy ehf / Legend Killer, Domain Administrator, See PrivacyGuardian.org / Max Ngassa, Cockatoo Parrots store, Domain Administrator, See PrivacyGuardian.org / rich man corps, Privacy service provided by Withheld for Privacy ehf / ANIL KUHLMAN, Kevin Peyton
Case No. D2022-2509

1. The Parties

The Complainant is Backpack Boyz LLC, United States of America (“United States”), represented by Pillsbury Winthrop Shaw Pittman LLP, United States.

The Respondents are Privacy service provided by Withheld for Privacy ehf / Legend Killer, Domain Administrator, See PrivacyGuardian.org / Max Ngassa, Cockatoo Parrots store, Domain Administrator, See PrivacyGuardian.org / rich man corps, Privacy service provided by Withheld for Privacy ehf / ANIL KUHLMAN, Kevin Peyton, Cameroon.

2. The Domain Names and Registrars

The disputed domain names <backpackboyzdelivery.com> and <backpackboyzzshop.com> are registered with NameSilo, LLC (the “Registrar 1”). The disputed domain names <backpackboyz-shop.com> and <backpackboyzz.com> are registered with NameCheap, Inc. (the “Registrar 2”). The disputed domain name <backpackboyzonlinestore.com> is registered with Web Commerce Communications limited dba WebNic.cc (the “Registrar 3”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 9, 2022. On July 11, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On July 11, 2022, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to the Complainant on July 12, 2022 providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 16, 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 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 24, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on August 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 provides lifestyle and cannabis-related goods and services. Its predecessor-in-interest commenced use of the BACKPACK BOYZ mark in connection with lifestyle apparel and cannabis products in 2017.

The Complainant is the owner of the following trademark registrations:

- United States trademark registration No. 6,548,517 for BACKPACKBOYZ, claiming first use in commerce on January 1, 2018 and registered on November 2, 2021, in class 34; and
- United States trademark registration No. 6,761,060 for BACKPACK BOYZ, claiming first use in commerce on January 6, 2017 and registered on June 14, 2022, in class 34.

The disputed domain names were registered on and are presently used in connection with:

Disputed Domain Name	Registration Date	Present Use
<backpackboyzdelivery.com>	May 31, 2022	No active webpage.
<backpackboyzzshop.com>	November 27, 2021	Online shop selling Backpackboyz cannabis packs and weed strains.
<backpackboyz-shop.com>	May 15, 2022	Online shop selling Backpackboyz cannabis packs and weed strains.
<backpackboyzz.com>	November 22, 2020	Online shop selling Backpackboyz cannabis packs and weed strains.
<backpackboyzonlinestore.com>	July 20, 2021	No active webpage.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that its predecessor-in-interest commenced use of the BACKPACK BOYZ mark for a new lifestyle apparel and cannabis brand in 2017. The Complainant further asserts that as a result of its

efforts, the BACKPACK BOYZ brand received frequent consumer praise, public recognition, and unsolicited media coverage.

The Complainant submits that the disputed domain names are subject to common control by either the same person or connected parties and for reasons of fairness, equity and efficiency, the Complainant requests consolidation of the multiple Respondents to the same Complaint, given that the disputed domain names:

i) have similar naming patterns; ii) are used in connection with websites that have similar content or layouts; iii) use the same language; iv) target the Complainant's products and depict the Complainant's trademark and logo; v) use the same registrars and privacy services; vi) sell similar or identical products; vii) use Whois information that appears to be unreliable; viii) were created for the same purpose, namely, to create a false association with the Complainant; and ix) were registered within an 18-month period.

The disputed domain names are, according to the Complainant, confusingly similar to the Complainant's trademark, creating a likelihood of confusion given the reproduction of its trademark which is clearly recognizable as the leading element of the disputed domain names, with the additions which are not capable of adding any distinctiveness thereto.

Moreover, the Complainant asserts that the Respondents have no rights or legitimate interests in respect of the disputed domain names given that:

(a) the Respondents have been using the disputed domain names in connection with online shops that unauthorizedly use the Complainant's trademark and logos, impersonating the Complainant so as to mislead consumers into believing that they are they are purchasing authentic products from the Complainant, when in fact, the Respondents are selling counterfeits which does not characterize as *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names;

(b) the disputed domain names also purport to offer interstate and international shipping of cannabis goods, which is illegal in the United States under the federal Controlled Substances Act and the Food Drug and Cosmetic Act, being a well-settled UDRP precedent that one cannot establish legitimate rights or interests in a mark that is used to offer or sell products illegally (*Nycomed Denmark ApS v Diaz*, WIPO Case No. [D2006-0779](#));

(c) the Complainant has no connection to or affiliation with the Respondents; and

(d) the Respondents are not commonly known by the disputed domain names, or a name corresponding to the disputed domain names.

As to the registration of the disputed domain names in bad faith, the Complainant asserts that the Respondents knew or should have known of the Complainant's trademark rights at the time of the registration of the disputed domain names considering that in all of the webpages that resolved from the disputed domain names the Complainant's trademark and logos were depicted, as well as unauthorized copies of the Complainant's copyrighted product packaging designs. Further, the Respondents are not authorized retailers or wholesalers of the Complainant's goods, being that the offer to ship cannabis goods to customer internationally or by interstate carrier is illegal under United States law. Lastly, given that the Respondents registered several domain names that refer to the Complainant's trademark such pattern suggests that a purpose of the registrations was to prevent the Complainant from owning the disputed domain names.

B. Respondents

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain names.

Before turning to these questions, however, the Panel needs to address the issue of the consolidation of the multiple Respondents.

A. Consolidation of Multiple Respondents

The Complainant requests that this Panel accept multiple Respondents in a single proceeding in view of the facts enumerated at the section 5.A. above.

Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) establishes that "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

All of the aforementioned criteria is present in this case and therefore this Panel accepts such request considering that it would be more procedurally efficient to have the disputed domain names dealt with at the same procedure, given that the disputed domain names: (a) were used in connection with similar online shops offering purportedly counterfeit products; (b) share a similar naming pattern; (c) were registered by the Respondents indicating similar email addresses; and (d) were registered using privacy protection services.

This Panel is satisfied, in view of the evidence submitted and on the balance of probabilities that the disputed domain names are indeed subject to a common control and that consolidation would be fair and equitable to all Parties.

B. Identical or Confusingly Similar

The Complainant has established its rights in the BACKPACK BOYZ trademark.

The Panel finds that the disputed domain names reproduce the Complainant's trademark in its entirety. The addition of the "delivery", "onlinestore", "-," and "shop", "z" and "z" and "shop" does not avoid a finding of confusing similarity under the Policy which, as recognized by past UDRP panels, involves a "comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name". ([WIPO Overview 3.0](#), section 1.7.)

The first element of the Policy has therefore been established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondents' rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondents' use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondents (as individuals, businesses, or other organizations) have been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondents are making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that the Complainant has made out a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names. The burden of production has therefore shifted to the Respondents to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests.

The Respondents, in not responding to the Complaint, have failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names. This entitles the Panel to draw any such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules.

As seen above, the disputed domain names have been and part of them continue to be used in connection with online stores purporting to offer counterfeit cannabis products internationally and interstate. Indeed such use cannot be considered here a *bona fide* offering of goods or services nor legitimate noncommercial or fair use under the Policy. Further, there is no evidence on record showing that the Respondents have been commonly known by the disputed domain names.

Therefore, the Panel finds that the Respondents lack rights or legitimate interests in the disputed domain names. The second element of the Policy has also been met.

D. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of the disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, the use of the disputed domain names in connection with the online stores purportedly offering counterfeit cannabis products with the unauthorized reproduction of the Complainant's trademark logo and promotional materials, characterizes the Respondent's likely intent of commercial gain by profiting from the Complainant's BACKPACK BOYZ trademark.

For the reasons above, the Panel finds that the Respondents have registered and used the disputed domain names in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

Further, the Panel finds that the current non-use of two of the disputed domain names pointing to error pages does not prevent a finding of bad faith.

The Panel finds that the disputed domain names were registered and are being used in bad faith. The third element of the Policy has therefore been met.

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 names <backpackboyzdelivery.com>, <backpackboyzonlinestore.com>, <backpackboyz-shop.com>, <backpackboyzz.com> and <backpackboyzzshop.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: September 13, 2022