

## **ADMINISTRATIVE PANEL DECISION**

Surterra Holdings, Inc. v. Vam Sampleton

Case No. D2023-2287

### **1. The Parties**

The Complainant is Surterra Holdings, Inc., United States of America, represented by Nelson Mullins Riley & Scarborough, L.L.P., United States of America.

The Respondent is Vam Sampleton, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <surterrawellness.org> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2023. On May 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 26, 2023, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 31, 2023 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 May 31, 2023.

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 June 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 3, 2023.

The Center appointed Andrew J. Park as the sole panelist in this matter on July 10, 2023. 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, Surterra Holdings, Inc. is a developer and retailer of cannabis-based medical products intended to empower health and well-being. Since it was founded in 2014, the Complainant became one of the nation’s fastest growing health and wellness companies as an authorized Medical Marijuana Treatment Center (MMTC) pursuant to Florida’s Compassionate Medical Cannabis Act of 2014. The Complainant has been offering a wide variety of medical, health, and wellness products in multiple delivery options, including vaporizer pens, tinctures, oral sprays, topical creams, time released transdermal patches, and soft gels under the SURTERRA and SURTERRA WELLNESS trademarks (collectively the “Surterra Mark”) throughout the state.

The Complainant opened its first brick-and-mortar retail store in Florida in October, 2016, and now operates nearly 40 retail stores throughout the state. In addition, the Complainant promotes and offers for sale its products and services on the Internet. The Complainant registered, owns and operates, among others, the <surterra.com> and <surterrawellness.com> domain names.

To fully protect the goodwill associated with the SURTERRA Mark, the Complainant applied for and has obtained the following United States federal trademark registrations:

Country	Trademark	Registration No.	Registration Date
United States	SURTERRA	6309305	March 20, 2021
United States	SURTERRA WELLNESS & DESIGN	6486561	September 14, 2021
United States	SURTERRA WELLNESS	6504839	October 5, 2021

The Respondent registered the disputed domain name on April 5, 2023. The Respondent has used the website to which the disputed domain name resolves as its homepage and mimics the Complainant’s own official website and its contents including the SURTERRA Mark.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant contends that the disputed domain name should be transferred to the Complainant for the following reasons:

The disputed domain name is identical or confusingly similar to the Complainant’s SURTERRA Mark in which the Complainant has rights.

Prior to the Respondent’s registration of the disputed domain name on April 5, 2023, the Complainant obtained common law rights in the SURTERRA Mark, dating back as early as 2016, when the Complainant opened its first retail location in Florida. Subsequently, the Complainant obtained registrations in the United States for the SURTERRA and SURTERRA WELLNESS marks in 2021, which are also before the registration of the disputed domain name by the Respondent.

The Complainant contends that the Complainant is the exclusive owner of the distinctive and well-known SURTERRA Mark, and the disputed domain name incorporates the Complainant’s trademark SURTERRA in its entirety, or where at least a dominant feature of the Complainant’s relevant mark is recognizable in the disputed domain name. Therefore, the disputed domain name should be considered as confusingly similar to the Complainant’s mark.

The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has never been, is not, and will not be revealed to be

commonly known by the distinctive SURTERRA or SURTERRA WELLNESS marks or any variation thereof. Moreover, the Complainant has not authorized the Respondent to use the SURTERRA Mark and the Respondent is not, and has never been a licensee of the Complainant. The Respondent also has never been authorized by the Complainant to register or use the Complainant's SURTERRA Mark to apply for or use any domain name incorporating the mark. Also, the Respondent cannot claim that it is making a legitimate noncommercial use of the disputed domain name based on the fact that the Respondent is purportedly offering the Complainant's products for sale in its website to which the disputed domain name resolved. The Respondent's misappropriated, unauthorized, and infringing use of the Complainant's SURTERRA Mark is clear evidence of Respondent's intent to create confusion as to the source, sponsorship, or affiliation of the disputed domain name with the Complainant in furtherance of Respondent's financial gain which cannot be qualified as a *bona fide* offering of goods and services. Lastly, the Respondent has not made any demonstrable preparation to do so.

The disputed domain name was registered and is being used in bad faith.

The Complainant contends that the Respondent must have had actual knowledge of the Complainant, its trademarks, and its business activities when it registered the disputed domain name. The Respondent registered the disputed domain name with the aim of taking advantage of the reputation and goodwill of the Complainant's well-known SURTERRA Mark and creating confusion between the disputed domain name and the Complainant's trademark, which can be clearly evidenced by the Respondent's infringing and counterfeit use of the SURTERRA Mark throughout the website to which the disputed domain name resolved.

The Complainant also claims that the Respondent is using the disputed domain name in bad faith. Currently, the Respondent runs a website that mimics Complainant's website and features unauthorized, infringing, and counterfeit use of the SURTERRA Mark in connection with the allegedly legitimate offering for sale of Complainant's products. The Respondent's use of the disputed domain name in this manner is per se illegal and the use of disputed domain name to conduct illegal activities can never confer rights or legitimate interests on the Respondent and therefore such use is manifestly considered evidence of bad faith.

These are clear indications of bad faith and the purpose of the Respondent in registering the disputed domain name was definitely to mislead, confuse and divert consumers or to tarnish the Complainant's well-known SURTERRA Mark and thereby illegitimately capitalizing on the Complainant's name and reputation.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark. The Panel finds that the Complainant has established registered rights in the SURTERRA trademark and that the disputed domain name is identical or confusingly similar to the Complainant's trademark. Indeed, the disputed domain name incorporates the Complainant's trademark SURTERRA WELLNESS in its entirety.

Further, the addition of the generic Top-Level Domain ("gTLD") ".org" may 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](#)).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

## B. Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights including trademark rights in respect of the name, Surterra, and is neither affiliated with, nor has it been licensed or permitted to use the Complainant's SURTERRA and SURTERRA WELLNESS marks or any domain names incorporating these trademarks.

The Complainant also contends the following:

- i. that the disputed domain name is identical/similar to its SURTERRA Mark, and thus, the disputed domain name carries with it a high risk of implied affiliation with the Complainant.
- ii. the Respondent cannot claim a legitimate noncommercial use of the disputed domain name without intent for commercial gain to misleadingly divert consumers because (a) the sole purpose of Respondent's use of the disputed domain name is commercial since respondent is purportedly offering products for sale; and (b) Respondent's misappropriated, unauthorized and infringing use of Complainant's SURTERRA Mark is evidence of Respondent's intent to create confusion as to the source/affiliation of the disputed domain name with Complainant in furtherance of Respondent's financial gain.
- iii. the Respondent cannot claim that it is making a fair use of the disputed domain name as a reseller of Complainant's products on the grounds that (a) the Respondent is not known to be a licensed entity that has been approved to operate in the cannabis industry, and even if it was, the Respondent is not authorized to do so by impersonating Complainant; and (b) there is no disclaimer of the relationship (or lack thereof) between Respondent and Complainant on the Respondent's disputed domain name's website.
- iv. Finally, the Respondent cannot establish that it has used the disputed domain name prior to any notice of the present dispute, in connection with a *bona fide* offering of goods or services or that Respondent has made demonstrable preparations to do so because the Respondent is using the disputed domain name to resolve to its website which intentionally mimics the Complainant's own website.

Therefore, the Respondent has no rights or legitimate interests in the disputed domain name.

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required 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 burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1.

Here, the Panel finds that the Complainant has made out a *prima facie* case.

The Panel finds that the Respondent has no relationship with or authorization from the Complainant to use its SURTERRA or SURTERRA WELLNESS Marks. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name. Also, there is no evidence that the Respondent has the intention to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent registered the disputed domain name and created a website using the disputed domain name, which is purportedly offering products identical or related to those of the Complainant all in an effort to confuse Internet users or consumers about the relationship between the Respondent and the Complainant and all without the Complainant's permission or authorization. All of these facts demonstrate that the Respondent never had an intention to use the disputed domain name in connection with a *bona fide* offering

of goods and or services. The Panel's view is that these facts may be taken as true in the circumstances of this case.

Further, the Panel is unable to find any reasonable basis upon which the Respondent could be said to have any rights or legitimate interests in respect of the disputed domain name, and the Respondent has not filed a formal Response.

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark, or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant argues that the Respondent violated the Policy, paragraph 4(b)(iv) by registering the disputed domain name in order to attempt to attract, for commercial gain, Internet users to the Respondent's website which the disputed domain name resolves to by creating a likelihood of confusion with the Complainant's trademark.

As stated previously, the Respondent did not file any response to the Complaint, failing thereby to rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain name.

Nevertheless, the Panel still has the responsibility of determining which of the Complainant's assertions are established as facts, and whether the conclusions asserted by the Complainant can be drawn from the established facts (see *Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

First, the Panel finds the Respondent intentionally registered the disputed domain name in bad faith. The Respondent registered the disputed domain name, which is identical or confusingly similar to the Complainant's SURTERRA and SURTERRA WELLNESS marks, while aware of the Complainant's business and its trademarks. The Complainant started its business in 2014 and created its own trademark SURTERRA, which is sufficiently qualified as the identification for the Complainant and its business activities. Also, the Complainant first registered its trademark in 2021 which predates the Respondent's registration date of the disputed domain name. Moreover, the disputed domain name was created by combining the Complainant's trademark SURTERRA and WELLNESS which clearly shows that the

Respondent had knowledge of the Complainant's trademark and its reputation when it registered the disputed domain name and that it tried to show that there was a business relationship between the disputed domain name and the Complainant and to benefit from the likelihood of confusion with the Complainant's trademark.

This registration of the disputed domain name that reproduces the Complainant's trademark in its entirety and is identical or confusingly similar to such trademark by the Respondent 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](#); and *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#).

Second, the website to which the disputed domain name resolves is almost identical to the Complainant's official website containing the Complainant's trademarks. The website is purportedly offering products which are identical to those of the Complainant. The Panel finds that the Respondent attempted to attract, for commercial gain, Internet users including the Complainant's customers to its infringing website by creating a likelihood of confusion with the Complainant's trademark.

Accordingly, the evidence shows that the Respondent likely knew of and had sought to take unfair advantage of the confusing similarity between the disputed domain name and the Complainant's trademarks all for commercial gain. The Respondent registered and is using the disputed domain name in bad faith.

As the conduct described above falls squarely within paragraph 4(b)(iv) of the Policy, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy, paragraph 4(a)(iii).

## 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 <surterrawellness.org> be transferred to the Complainant.

*/Andrew J. Park/*

**Andrew J. Park**

Sole Panelist

Date: July 24, 2023