

## **ADMINISTRATIVE PANEL DECISION**

Andrea Mantella v. gilda copertino

Case No. D2024-0037

### **1. The Parties**

The Complainant is Andrea Mantella, Canada, represented by Rowand LLP, United States of America (“United States”).

The Respondent is gilda copertino, Canada.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2024. On January 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 8, 2024, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 9, 2024, 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 and further Amended Complaint on January 12, 2024.

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 January 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 4, 2024. The Respondent sent email communications to the Center on January 9, 2024.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on February 7, 2024. 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 a natural person residing in Canada, owning several registered trademarks (the “ASTROPINK Trademarks”) including:

- the Canadian word mark ASTROPINK, No. TMA 1208069, filed on August 6, 2019, and registered on November 10, 2023, for products and services in classes 9, 16, 18, 21, 25, 29, 30, 32, 34, 35, 41 and, 45;
- the Canadian word mark ASTROPINK, No. TMA 1209092, filed on August 6, 2019, and registered on November 10, 2023, for products and services in classes 16, 18, 21, 29, 30, 32, 35, and 41;
- the Canadian wordmark ASTROXO, No. TMA 1202239, filed on August 6, 2019, and registered on October 11, 2023, for products and services in classes 9, 16, 18, 21, 25, 29, 30, 32, 34, 35, 41 and 45.

The Complainant is also the owner of a copyright image, reproducing the ASTROPINK Trademarks with a particular design, registered with the Canadian Intellectual Property Office on July 14, 2023, with a first publication date of June 30, 2018.

The Disputed Domain Name was registered on October 25, 2021, and reverts to a website selling cannabis and cannabis-related products.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant contends that the Disputed Domain Name is confusingly similar to its ASTROPINK Trademarks. The Complainant highlights that the Disputed Domain Name is constituted by the ASTROPINK Trademarks in their entirety and that the addition of the term “official” does not prevent a finding of confusing similarity.

Then, the Complainant submits that the Respondent does not have rights or legitimate interest in respect of the Disputed Domain Name. First, the Complainant asserts that the Disputed Domain Name is used for illegal activity since it resolves to an online retail store offering to sell cannabis products to customers located in Toronto, Ontario. For the Complainant, such offer is illegal and is in violation of provincial regulations which prohibit such sale without being granted a license to do so. Furthermore, the Complainant contends that the Respondent has misappropriated a copyright image that it owns and that it has taken several steps to hide its true identity, by using a privacy or proxy service, by providing false contact details, and by refusing to reveal its true identity. Finally, the Complainant highlights that it has not authorized or licensed the Respondent to use the ASTROPINK Trademarks.

Finally, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith. For the Complainant, the Respondent has registered the Disputed Domain Name with the intent to capitalize on its nascent trademarks’ rights. The Complainant highlights that the Disputed Domain Name was registered after the Complainant’ ASTROPINK Trademarks’ applications. The Complainant also underlines that the Respondent has used lots of efforts to conceal its identity. Then, the Complainant

contends that the Disputed Domain Name is used for illegal activity for the selling of cannabis products in violation of provincial regulations. Finally, the Complainant asserts that the Respondent had prior knowledge of its prior rights when registering the Disputed Domain Name since (i) it was registered after the filing of its trademarks applications and designs and (ii) the website linked to the Disputed Domain Name reproduces the Complainant's distinctive and fanciful ASTROPINK Trademarks.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. However, on January 9, 2024, the Center received unsigned informal communications stating that it had the "wrong person".

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

(i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of another term here, "official", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a Disputed Domain Name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant

evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

The Panel further notes that the Disputed Domain Name reproduces the Complainant's mark in its entirety with the additional term "official", being the website at the Disputed Domain Name used in connection with products like the ones included within the scope of the Complainant's trademark, which carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered the Disputed Domain Name prior to the registration of the ASTROPINK Trademarks.

However, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name following the complainant's filing of a trademark application [WIPO Overview 3.0](#), section 3.8.2.

In the present case, even though the ASTROPINK Trademarks were registered after the registration of the Disputed Domain Name, the Panel finds that:

- the Disputed Domain Name was registered after the Complainant filed for trademark protection for the ASTROPINK Trademarks, and the Panel considers it unlikely that the Respondent came randomly with a name almost identical to the Complainant's ASTROPINK for use in connection with the same type of products, leading to a conclusion of registration in bad faith;
- the website linked to the Disputed Domain Name reproduces several of the Complainant's now registered trademarks including those other than the ASTROPINK Trademarks, and reproduces the Complainant's registered copyright without its authorization;
- the Respondent has hidden its identity through privacy or proxy services;
- the Respondent did not reply to the Complainant's contentions, and did not provide any reasonable explanation as to the reason why the Respondent selected such composition for the Disputed Domain Name;
- Finally, the Disputed Domain Name is being used to offer the same products offered by the Complainant, thus, affirming that the Respondent, most likely than not, had prior knowledge of the Complainant and its ASTROPINK nascent trademark rights, and targeted the Complainant.

Having reviewed the record, the Panel finds there is sufficient evidence to consider that the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Panel finds that the Complainant has established 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 Disputed Domain Name <astropinkofficial.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: February 21, 2024