

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Kyle Hayungs, Merchant's Resource Group
Case No. D2022-2866

1. The Parties

The Complainant is Walgreen Co., United States of America (“United States” or “U.S.”), represented by Winterfeldt IP Group PLLC, United States.

The Respondent is Kyle Hayungs, Merchant's Resource Group, United States.

2. The Domain Name and Registrar

The Disputed Domain Name <walgreenscare360.com> 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 August 4, 2022. On August 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 4, 2022, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 6, 2022, 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 October 8, 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 October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 4, 2022.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on July 6, 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 operates one of the largest retail pharmacy chains in the United States of America, with approximately 9,000 retail stores across the United States, including in 50 states, the District of Columbia, Puerto Rico, and the U.S. Virgin Islands. The Complainant employs more than 240,000 people, including over 85,000 healthcare service providers such as pharmacists, pharmacy technicians, nurse practitioners and other health-related professionals.

The Complainant's history dates back at least as far as 1901, when Charles R. Walgreen Sr. purchased the Chicago drugstore where he worked as a pharmacist, and that started the Walgreen chain. By 1916, nine stores were incorporated as Walgreen Co. Over the ensuing decades, the Complainant opened thousands of stores, acquired various drugstore chains and health care providers, and delivered numerous innovations, including becoming the first drugstore chain to offer prescription labels in multiple languages chainwide.

The Complainant also provides pharmacy and healthcare-related services, including COVID19 testing services, through its domain name that includes the WALGREENS trademark, and is used for the primary website of the Complainant at "www.walgreens.com" ("the Complainant's Website") which makes substantial use of the WALGREENS trademark; this domain name was registered in May 1995.

The Complainant trademark registrations include, but are not limited to, the following:

- WALGREENS (U.S. Reg. 1057249) in Class 42, used in commerce since 1971 and registered on January 25, 1977;
- WALGREENS (U.S. Reg. 2077524), in Class 42, used in commerce since 1995 and registered on July 8, 1997;
- WALGREENS (U.S. Reg. 2096551), in Classes 3, 5, 9, 10, 11, 21, 25, and 42, used in commerce since 1900 and registered on September 16, 1997;
- 1-800-WALGREENS (U.S. Reg. 2113779), in Class 42, used in commerce since 1992 and registered on November 18, 1997;

The Complainant offers the 365 Get Healthy Here Wellness Program and Life365 Employee Assistance Program to Walgreens team members and their spouses/domestic partners enrolled in a Walgreens medical plan. The 365 Get Healthy Here Wellness Program supports the health of its participants by offering free tools, resources, and incentives to reach health-related goals.

On December 23, 2021, the Respondent registered the Disputed Domain Name, which resolves to a pay-per-click ("PPC") website containing links related to the Complainant's activity.

5. Parties' Contentions

A. Complainant

The Disputed Domain Name fully incorporates and is confusingly similar to the WALGREENS Mark owned by the Complainant, and in which Complainant has well established rights. The only difference between Complainant's WALGREENS Mark and the Disputed Domain Name is the addition of the generic or descriptive terms "care" and "360" at the second level and the ".com" generic Top-Level domain ("gTLD") extension. The term "care" in the Disputed Domain Name only enhances confusing similarity, since it implies

an authorized online source for the Complainant's healthcare services. The term "360" in the Disputed Domain Name also enhances confusing similarity as it evokes the Complainant's 365 Get Healthy Here Wellness Program and Life365 Employee Assistance Program.

It is well-established that the use of a trademark in its entirety is sufficient to establish confusing similarity and that the addition of descriptive terms or a gTLD extension to an identical mark is insufficient to escape a finding of such similarity confusion is exacerbated in this case given that the Complainant itself offers healthcare services under its WALGREENS Marks.

The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Respondent has never been authorized by Complainant to use the WALGREENS Marks in any manner, much less as part of the Disputed Domain Name.

The Respondent has no legitimate interests in the Disputed Domain Name given that the Disputed Domain Name was registered well after the Complainant had registered the WALGREENS Marks and had established extensive goodwill, including in relation to health services, which is the association that the Disputed Domain Name targeted given the inclusion of the terms "care" and "360" in the Disputed Domain Name.

The Disputed Domain Name resolves to a parked webpage featuring third-party links that direct users to competitor healthcare websites offering competing healthcare services. The Respondent is monetizing the Disputed Domain Name by trading on the goodwill associated with the WALGREENS Marks used in the Disputed Domain Name to draw Internet users to its parked webpage and generate click-through revenue.

Respondent's registration and use of the Disputed Domain Name constitutes bad faith under paragraph 4(b)(iii) of the Policy. Respondent is using the Disputed Domain Name to direct Internet users to a parked webpage with third-party links relating to healthcare services that generate click-through revenue, thus unfairly trading on the goodwill associated with Complainant's WALGREENS Marks.

The Respondent is disrupting the Complainant's business by diverting business and prospective business away from the Complainant and its goods and services this activity is done in opposition to the Complainant and is disruptive to the Complainant's business.

The Respondent has intentionally attracted Internet users for commercial gain, generating click-through revenue by directing users to a parked webpage featuring third-party links that redirect users to competitor healthcare websites offering competing healthcare services, creating a likelihood of confusion with the Complainant's WALGREENS Marks as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name.

The Complainant's rights in the WALGREENS Marks are so well established, and its WALGREENS brand has achieved a level of recognition and fame such that the Respondent has no colorable argument that he is unaware of this brand.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the famous WALGREENS mark. The WALGREENS trademark is clearly recognizable in the disputed domain name, and the gTLD ".com" is typically disregarded under the first element confusing similarity test. See section 1.11 of the WIPO

Overview of WIPO Panel Views on Selected UDRP Questions Third Edition ("[WIPO Overview 3.0](#)"); see also, *Helpful Things, LLC v. Withheld for Privacy Purposes / Sirikwan Burnett*, WIPO Case No. [D2021-1495](#). The addition of the terms "score" and "360" do not prevent the finding of confusingly similarity under the first element.

Accordingly, for the purposes of the Policy, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent registered the Disputed Domain Name decades after the Complainant had begun using its globally famous WALGREENS mark indicates the Respondent sought to piggyback on the mark for illegitimate reasons, namely to receive PPC revenue from Internet users clicking through to third party sites. Such use indicates to the Panel that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name was registered many years after the Complainant first registered and used its famous WALGREENS trademark. The evidence on the record provided by the Complainant with respect to the extent of use and fame of its WALGREENS trademark, combined with the absence of any evidence provided by the Respondent to the contrary, is sufficient to satisfy the Panel that, at the time the Disputed Domain Name was registered, the Respondent undoubtedly knew of the Complainant's WALGREENS trademark.

There is *prima facie* no reason for the Respondent to have registered the Disputed Domain Name incorporating the WALGREENS trademark with the terms "care" and "360" which can be associated with the Complainant's services.

Further, the use of the Disputed Domain Name by the Respondent is clearly in bad faith. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's 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 has submitted evidence that the Respondent has used the Disputed Domain Name in order to direct Internet users to a parked website which includes links to websites of its competitors.

Given the fame of the Complainant's WALGREENS mark, the obvious inference is that the Respondent hoped to mislead Internet users to visit the website at the Disputed Domain Name trading on the Complainant's trademark and reputation in order to obtain PPC revenue.

In the absence of any evidence or explanation from the Respondent, the Panel finds that the only plausible basis for registering and using the Disputed Domain Name has been for bad faith purposes.

Accordingly, the Panel finds that the Complainant has satisfied 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 <walgreenscare360.com> be transferred to the Complainant.

/Colin O'Brien/

Colin O'Brien

Sole Panelist

Date: July 21, 2023