

## **ADMINISTRATIVE PANEL DECISION**

Walgreen Co. v. Nicholas Bach, Paid Equity partners  
Case No. D2022-4135

### **1. The Parties**

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

Respondent is Nicholas Bach, Paid Equity partners, United States.

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

The disputed domain name <walgreensx.app> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On November 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 3, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to Complainant on November 4, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 8, 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 November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 30, 2023. The Center received an informal reply from Respondent on November 30, 2023.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on July 4, 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**

Complainant is a United States company. For decades prior to the registration of the disputed domain name, Complainant has offered retail pharmacy and related goods and services under the mark WALGREENS. Complainant owns numerous registrations for the WALGREENS mark. These include, among others, United States Registration No. 1057249 (registered January 25, 1977).

The disputed domain name was registered on February 17, 2022. Respondent has used the URL associated with the disputed domain name to resolve to a website that appears to mimic an official website of Complainant. The website includes references to the WALGREENS mark and associated logos used by Complainant in connection with its retail pharmacy and related goods and services. Complainant has not authorized any activities by Respondent, nor any use of its trademarks thereby.

#### **5. Parties' Contentions**

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

Complainant contends that the (i) disputed domain name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

In particular, Complainant contends that it "operates one of the largest retail pharmacy chains in the United States of America, with approximately 9,000 retail stores across the United States" nation and territories and with "more than 240,000" employees and "[a]pproximately 9 million customers".

Complainant contends that Respondent has incorporated Complainant's famous WALGREENS mark into the disputed domain name, and merely added the letter "x" and top-level-domain ".app". Complainant asserts that Respondent has no rights or legitimate interest in the registration or use of the disputed domain name. Rather, Complainant contends that Respondent has acted in bad faith in setting up a website meant to impersonate Complainant and to confuse prospective consumers seeking the goods and services offered by Complainant under the WALGREENS mark, when Respondent clearly knew of Complainant's rights. In this regard, Complainant asserts that Respondent has used Complainant's mark for Respondent's own commercial gain.

##### **B. Respondent**

Respondent sent an informal communication from the Respondent's email confirmed by the Registrar and asking "what to do in order to take care of this" and copying his lawyer but did not follow up (neither did the lawyer) to reply to Complainant's contentions.

#### **6. Discussion and Findings**

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

This Panel must first determine whether the disputed domain name is identical or confusingly similar to a

trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that it is. The disputed domain name directly incorporates Complainant's registered WALGREENS mark, with the addition of the letter "x" and using the top-level-domain ".app",

Numerous UDRP panels have agreed that supplementing or modifying a trademark with a mere letter or dictionary term does not make a domain name any less "identical or confusingly similar" for purposes of satisfying this first prong of paragraph 4(a)(i) of the Policy. See, for example, *Inter Ikea Systems B.V. v. Polanski*, WIPO Case No. [D2000-1614](#) (transferring <ikeausa.com>); *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (transferring <ge-recruiting.com>); *Microsoft Corporation v. Step-Web*, WIPO Case No. [D2000-1500](#) (transferring <microsofthome.com>); *CBS Broadcasting, Inc. v. Y2K Concepts Corp.*, WIPO Case No. [D2000-1065](#) (transferring <cbsone.com>). Furthermore, a top-level-domain is typically not helpful in avoiding a likelihood of confusion. See *Groupon, Inc. v. Hily Jiang*, WIPO Case No. [D2019-3213](#) (transferring <groupon.app>).

The Panel therefore finds that the disputed domain name is identical or 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**

The Policy provides some guidance to respondents on how to demonstrate rights or legitimate interests in the domain name at issue in a UDRP dispute. For example, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name "in connection with a *bona fide* offering of goods or services;" (ii) demonstration that Respondent has been "commonly known by the domain name;" or (iii) "legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Despite sending an informal communication, Respondent did not reply to Complainant's contentions, and Respondent did not allege or otherwise provide any information that would support a finding that Respondent has rights or legitimate interest in the disputed domain name. Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interest in the disputed domain name, which Respondent has not rebutted.

The Panel therefore finds that the Complainant has met its burden as to paragraph 4(a)(ii) of the Policy.

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

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. For example, paragraph 4(b)(iv) of the Policy states that bad faith can be shown where "by using the domain name [respondent has] intentionally attempted to attract, for commercial gain, Internet users to [respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or of a product or service on [the] web site or location." As noted in Section 4 of this Panel's Decision, Respondent has used the URL associated with the disputed domain name to resolve to a website that appears to mimic an official website of Complainant. The website includes references to the WALGREENS mark and associated logos used by Complainant in connection with its retail pharmacy and related goods and services.

Complainant has not authorized any activities by Respondent, nor any use of its trademarks thereby. Respondent is thus trading on the goodwill of Complainant's trademarks to attract Internet users, presumably for Respondent's own commercial gain. See also *Walgreen Co. v. Registration Private, Domains By Proxy, LLC /*

*Nitish Maheshwari, The lead Generators*, WIPO Case No. [D2017-1601](#); and *Walgreen Co. v. Jon Reegy*, WIPO Case No. [D2011-1621](#).

The Panel finds that Respondent registered and used the disputed domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For all 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 <walgreensx.app> be transferred to Complainant.

*/Lorelei Ritchie/*

**Lorelei Ritchie**

Sole Panelist

Dated: July 17, 2023