

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Domain Privacy / Ruby Gallon
Case No. D2022-2415

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 Domain Privacy, Hong Kong, China / Ruby Gallon, China.

2. The Domain Name and Registrar

The disputed domain name <walgreenusa.com> is registered with Nicenic International Group Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 2, 2022. On July 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 14, 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 July 15, 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 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 15, 2022.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on August 25, 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 operates one of the largest retail pharmacy chains in the United States and its 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.

In 2014, the Complainant completed a merger with Alliance Boots, a leading international pharmacy-led health and beauty group, to form a new global company, Walgreens Boots Alliance. Walgreens Boots Alliance was incorporated in 2014 and is a Fortune 500 company that generated sales of USD 132.5 billion in its 2021 fiscal year. The Complainant is the subsidiary of Walgreens Boots Alliance that provides pharmacy and healthcare-related services through its thousands of retail drugstores, including prescription medicine refills, on-site pharmacy services, vaccinations, and immunizations.

The Complainant owns numerous trademark registrations for the WALGREENS mark in the United States and in many other jurisdictions throughout the world, including the following:

U.S. Trademark Registration No. 1057249 WALGREENS, used in commerce since 1971 and registered on January 25, 1977, in class 42;

U.S. Trademark Registration No. 2077524 WALGREENS, used in commerce since 1995 and registered on July 8, 1997, in class 42;

U.S. Trademark Registration No. 2096551 WALGREENS, used in commerce since 1900 and registered on September 16, 1997, in classes 3, 5, 9, 10, 11, 21, 25, and 42;

International Trademark Registration No. 1100522 WALGREENS, registered on August 19, 2011, and

International Trademark Registration No. 1103543 WALGREENS, registered on August 19, 2011.

The Complainant also provides pharmacy and healthcare-related services through its <walgreens.com> domain name registered in May 1995 - which resolves to the Complainant's primary website.

The disputed domain name <walgreenusa.com> was registered on October 12, 2021, and resolves to a website that offers prescription medicines similar to those offered by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to the trademark WALGREENS in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Respondent is not a licensee of the Complainant and is not authorized to use the famous WALGREENS marks.

The Respondent is not commonly known by the disputed domain name and the Respondent's website provides pharmacy services in direct competition to those provided by the Complainant under its WALGREENS marks.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's WALGREENS trademarks.

The disputed domain name <walgreenusa.com> incorporates the Complainant's trademark WALGREENS in its entirety, without the letter "s" and the addition of the letters "usa", acronym for the United States of America, that certainly do not prevent a finding of confusing similarity.

Pursuant to section 1.7 of [WIPO Overview 3.0](#), in cases where a disputed domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the disputed domain name, the disputed domain name will normally be considered confusingly similar to the mark for the purposes of UDRP standing. Also, section 1.8 of the [WIPO Overview 3.0](#) indicates that when the relevant trademark is recognizable within the disputed domain name, as occurs in this case, the addition of other terms (whether descriptive, geographical...or otherwise) would not prevent a finding of confusing similarity under the first element.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademarks WALGREENS in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name relates is an official site of the Complainant.

As established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry." Here, the nature of the disputed domain name carries a high risk of implied affiliation.

Moreover, the disputed domain name advertises the ability for Internet users to "order the drugs without a prescription", further reinforcing the likely fraudulent and illegal nature of the services allegedly offered under the disputed domain name. Section 2.13.1 of [WIPO Overview 3.0](#) states that the use of a domain name for illegal activity can never confer rights or legitimate interests upon a respondent.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant's WALGREENS marks mentioned in section 4 above (Factual Background) when it registered the disputed domain name on October 12, 2021.

The Complainant's WALGREENS marks are famous throughout the United States and the world, as determined in prior UDRP decisions, such as "*Walgreen Co. v. Registration Private, Domains B Proxy, LLC / Nitish Masheshwari, The lead Generators*", WIPO Case No. [D2017-1601](#) (determining the WALGREENS trademark is "known throughout the world as a famous Brand"). Moreover, the website to which the disputed domain name resolves offers identical, competing services to those of the Complainant and intentionally seeks to target the Complainant's primary customer base in the United States, noting the disputed domain name's composition including the geographic acronym "usa".

In accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's name and almost identical trademark in the disputed domain name creates a presumption of bad faith. The Respondent when registering the disputed domain name has targeted the Complainant's name Walgreen and trademarks WALGREENS with the intention to confuse Internet users and capitalize on the fame of the Complainant's trademarks for its own monetary benefit. The use of the disputed domain name to feature an alleged web store offering for sale pharmaceuticals without the need for prescriptions further reinforces the Panel's finding regarding the use of the disputed domain name in bad faith.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered in bad faith (as stated in section 3.2.1 of [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has registered and is using the disputed domain name intentionally to attempt to attract for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's WALGREENS trademarks as to the source, sponsorship, affiliation, or endorsement for services similar to those offered by the Complainant. This amounts to bad faith under paragraph 4(b)(iv) 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 <walgreenusa.com> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: November 2, 2022