

## **ADMINISTRATIVE PANEL DECISION**

Walgreen Co. v. Registration Private, Domains By Proxy, LLC /  
Carolina Rodrigues, Fundacion Comercio Electronico  
Case No. D2022-2521

### **1. The Parties**

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Carolina Rodrigues, Fundación Comercio Electrónico, Panama.

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

The disputed domain name <walgreensla.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 July 11, 2022. On July 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 13, 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 18, 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 21, 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 August 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 26, 2022.

The Center appointed Felipe Claro as the sole panelist in this matter on October 5, 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, with approximately 9,000 retail stores, including in 50 states. 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.

Approximately 9 million customers interact with Walgreens online and in Walgreens stores daily, and nearly 80% of the U.S. population lives within 5 miles of a Walgreens store. Walgreens is a popular and valuable brand, being ranked the 49th most valuable U.S. brand by Brand Finance in 2022.

The Complainant's history dates back to 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.

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 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 also provides pharmacy and healthcare-related services through its <walgreens.com> domain name that includes the WALGREENS famous trademark, and is used for the primary website of the Complainant. The <walgreens.com> domain name was created in May 1995.

The disputed domain name was registered on December 7, 2021. On the date of the submission of the Complaint, the disputed domain name redirected to rotating English-language content that directed users to download a browser extension, to a third party survey site, and it also redirected users to the official Complainant's website. On the date of the Decision, the disputed domain name continues to engage in a dynamic redirect to various third party sites.

## 5. Parties' Contentions

### A. Complainant

The Complainant owns numerous trademark registrations for the WALGREENS mark and other WALGREENS-formative marks in many jurisdictions throughout the world. Such trademark registrations include the following:

- WALGREENS (U.S. Reg. No. 1057249) in Class 42, used in commerce since 1971 and registered on January 25, 1977;

The Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent is not commonly known by the disputed domain name. The disputed domain name resolves to a rotating selection of content that constitutes no *bona fide* commercial or fair or legitimate noncommercial use of the disputed domain name.

The Respondent registered and is using the disputed domain name in bad faith with actual knowledge of the Complainant's rights in its marks, having registered the disputed domain name long after the Complainant had registered many of the WALGREENS marks, using the disputed domain name to direct Internet users to download a browser extension that hijacks online searches and redirects them, as well as using the disputed domain name to redirect users to third-party survey sites and the official Walgreens website, and having registered and used the disputed domain name to disrupt the Complainant's business and attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's WALGREENS marks as to the source, sponsorship, affiliation or endorsement of the various downloads and third-party websites to which the disputed domain name resolves.

### B. Respondent

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

## 6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a), and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding based on the Complainant's undisputed representations. In that regard, the Panel makes the following specific findings.

### A. Identical or Confusingly Similar

The disputed domain name fully incorporates and is confusingly similar to the WALGREENS mark owned by the Complainant. The only difference between the Complainant's mark and the disputed domain name is the addition of the geographical term "la" (an abbreviated form of the geographical city name "Los Angeles") and the ".com" Top-Level Domain ("TLD") extension.

It is well established that the use of a trademark in its entirety is sufficient to establish confusing similarity and that the addition of terms or a TLD extension to an identical mark does not escape a finding of such similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.8 and 1.11. Accordingly, the addition of the letters or geographical term "la" and the TLD ".com" do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's WALGREENS mark.

Consequently, the disputed domain name is confusingly similar to the Complainant's registered trademarks.

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

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

The Respondent has never been authorized by the 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 the United States, which is where the disputed domain name is targeted given the inclusion of the letters "la" in the disputed domain name, which is a common geographical abbreviation for the city of "Los Angeles" wherein the Complainant operates various stores.

The disputed domain name does not reflect the Respondent's common name. Rather, the Respondent is using the disputed domain name to infringe and cybersquat upon the Complainant's rights in its WALGREENS marks. The disputed domain name resolves to rotating website content that directs users to download a browser extension that ultimately redirects Internet users, and also redirects users to third-party survey sites, and the official Walgreens website. Accordingly, the Respondent is or was 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 rotating third-party websites, thereby presumably generating click-through revenue. Such use of the disputed domain name does not constitute any legitimate *bona fide* sale of goods or services or legitimate noncommercial or fair use.

Lastly, as noted above, the disputed domain name consists of the Complainant's WALGREENS mark entirely, along with the letters "la" that could be interpreted as the geographical abbreviation for "Los Angeles", wherein the Complainant operates various store, and thus the construction of the disputed domain name is such to carry a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

The burden of production shifts to the Respondent to come forward with evidence to the contrary. Absent a response and not showing to the contrary by the Respondent, the Complainant has therefore established that the Respondent has no rights or legitimate interests in the disputed domain name.

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

The disputed domain name consists of the Complainant's distinctive WALGREENS mark entirely, along with geographical descriptive terms for a city in which the Complainant operates. Moreover, among the sites to which the disputed domain name redirects was the Complainant's own genuine website. Accordingly, the Respondent was clearly aware of and intended to target the Complainant when registering the disputed domain name. Notwithstanding the above, the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Respondent is using the disputed domain name to redirect Internet users to rotating third-party websites that generate click-through revenue, thus unfairly trading on the goodwill associated with the Complainant's WALGREENS marks. Accordingly, the Respondent is disrupting the Complainant's business by diverting business and prospective business away from the Complainant and its goods and services. Moreover, the Respondent has intentionally attracted Internet users for commercial gain by creating a likelihood of confusion with the Complainant's WALGREENS marks as to the source, sponsorship, affiliation, or endorsement of the

other websites to which the disputed domain name resolves. This activity constitutes bad faith. While the redirection of the disputed domain name also featured the Complainant's own genuine website, the Respondent's retention of control over the disputed domain name, and thus its redirection, remains an ongoing implied threat to the Complainant and one that is manifested here through the other various third-party sites to which the disputed domain name did redirect, including potentially malicious sites.

The Complainant's rights in the WALGREENS marks are well established, and its WALGREENS brand has achieved a level of recognition and fame such that the Respondent should have been aware of this trademark. The disputed domain name is only valuable because of its association with the WALGREENS marks.

Thus, in the totality of the circumstances, the Panel finds the Respondent has registered the disputed domain name and is using it in bad faith.

## **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, <walgreensla.com> be transferred to the Complainant.

*/Felipe Claro/*

**Felipe Claro**

Sole Panelist

Date: October 19, 2022