

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Privacy Protection/ Domain, Administrator
Case No. D2022-2812

1. The Parties

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

The Respondent is Domain, Administrator, Nigeria.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 1, 2022. On August 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 4, 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 August 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 August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 11, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on July 5, 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, Walgreen Co. is a large retail pharmacy chain with approximately 9,000 stores in the United States of America. The Complainant was founded in 1901 by Charles R. Walgreen Sr. and has a long history of providing pharmacy and healthcare-related services. The Complainant employs over 240,000 people and was ranked the 49th most valuable U.S. brand by Brand Finance in 2022. During the COVID-19 pandemic, the Complainant distributed N95 masks, vaccines, and provided testing services. In 2014, the Complainant merged with Alliance Boots to form Walgreens Boots Alliance, a Fortune 500 company that provides a wide range of pharmacy and healthcare-related services, including prescription medicine refills, on-site pharmacy services, vaccinations, immunizations, and COVID-19 testing services through its website and stores across the U.S. and Europe and generates sales of USD 132.5 billion.

The Complainant holds many trademark registrations that consist of or contain the word “walgreens” (the “WALGREENS trademarks”) in many jurisdictions throughout the world, including, but not limited to the United States Registrations No. 1057249 in Class 42 registered on January 25, 1977, and No. 2096551 in Classes 3, 5, 9, 10, 11, 21, 25, and 42 registered on September 16, 1997, and the International Trademark Registration No. 1103543 registered on August 19, 2011.

In addition, the Complainant is the owner of the domain name <walgreens.com> featuring the WALGREENS trademarks, registered in May 1995.

The Disputed Domain Name was registered on January 9, 2022. As of the date of this Decision, the Disputed Domain Name is resolving to an inactive website. However, the Disputed Domain Name was used to resolve to a website featuring third-party links that direct users to competitor healthcare websites offering COVID-19 testing services.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

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

First, the Complainant contends that it has rights in and to the WALGREENS trademarks in many jurisdictions. Further, the Complainant asserts that its WALGREENS trademarks have achieved worldwide recognition.

Second, the Complainant argues that the Disputed Domain Name is confusingly similar to the WALGREENS trademarks as it almost fully incorporates them. The only difference is the removal of the letter “s” in WALGREENS and the addition of the descriptive terms “covid” and “test”. The Complainant argues that using a trademark in its entirety is enough to establish confusing similarity, and previous UDRP panel decisions confirm that adding the aforesaid descriptive terms does not eliminate the confusion.

Third, the Complainant argues that the addition of the generic Top-Level Domain (“gTLD”) “.com” should be disregarded under the first element.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant argues that the Respondent was never authorized to use the WALGREENS trademarks, neither in any capacity nor as part of the Disputed Domain Name.

Second, the Complainant submits that the Respondent has no rights or legitimate interests in the Disputed Domain Name given that the Disputed Domain Name was registered after the Complainant had established extensive goodwill associated with the WALGREENS trademarks, particularly in relation to health services.

Third, the Complainant contends that the use of the Disputed Domain Name does not reflect the Respondent's common name. Instead, it infringes upon the Complainant's well-known WALGREENS trademarks.

Furthermore, the Disputed Domain Name resolves to a parked webpage with links to competitor healthcare websites offering COVID-19 testing services. This indicates an intent to profit from the reputation of the WALGREENS trademarks, which does not constitute any legitimate *bona fide* sale of goods or services or legitimate noncommercial or fair use.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant argues that the Respondent registered the Disputed Domain Name to prevent the Complainant from reflecting the WALGREENS trademarks alongside the terms "covid" and "test" in a corresponding domain name. This demonstrates bad faith under paragraph 4(b)(ii) of the Policy.

Second, the Complainant contends that the Respondent uses the Disputed Domain Name to direct users to a webpage with third-party links related to COVID-19 testing, generating click-through revenue. This unfairly trades on the goodwill associated with the Complainant's WALGREENS trademarks and disrupts the Complainant's business, violating paragraph 4(b)(iii) of the Policy.

Finally, the Complainant submits that the Respondent intentionally attracts users for commercial gain by directing them to competitor healthcare websites offering COVID-19 testing services. This creates a likelihood of confusion with the Complainant's WALGREENS trademarks regarding the source or endorsement of the Disputed Domain Name, constituting bad faith under paragraph 4(b)(iv) of the Policy.

With the said arguments, the Complainant requests 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

A. Procedural Issues

(I) The Respondent's Identity

The Panel notes that at the time the Complaint was filed on August 1, 2022, the Respondent was identified as "Privacy protection". On August 2, 2022, the Registrar revealed the underlying Registrant "Domain, Administrator". The Center sent a Notice of Registrant Information to the Complainant on August 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

On August 8, 2022, the Complainant filed an amended Complaint, adding the named Respondent in the initial Complaint with the underlying registrant. Consequently, the Panel considers the “Domain, Administrator” as the Respondent in the subject case.

(II) The Respondent’s Failure to Respond

The Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#); and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent’s default.

B. Identical or Confusingly Similar

The Complainant is required to establish the two following elements: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Complainant has established registered trademark rights in the WALGREENS trademarks, which *prima facie* establish standing for purposes of the Policy. Further, the Complainant has shown longstanding use of the WALGREENS trademarks in commerce, specifically in connection with the provision of pharmacy and healthcare-related services worldwide. This evidence sufficiently demonstrates the Complainant’s trademark rights for the purposes of this proceeding.

Second, the Disputed Domain Name incorporates the Complainant’s WALGREENS trademarks, to which the Complainant holds exclusive rights. The only differences between the Disputed Domain Name and the Complainant’s trademarks are the deletion of the letter “s” in WALGREENS, and the addition of the terms “covid” and “test”. These additions do not change the fact that the trademark WALGREENS remains recognizable within the Disputed Domain Name. In this regard, the Panel finds that the said additions do not prevent a finding of confusing similarity between the Complainant’s trademarks and the Disputed Domain Name (see, e.g., *Eli Lilly and Company v. Super Privacy Service LTD c/o Dynadot / Shilei*, WIPO Case No. [D2020-0886](#)).

Third, the Panel finds, similarly to other UDRP panels, that the gTLD, in this case, “.com”, does not affect the determination that the Disputed Domain Name is confusingly similar with the WALGREENS trademarks (see section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

Based on the foregoing findings, the Panel finds that the Disputed Domain Name is confusingly similar to the WALGREENS trademarks, and paragraph 4(a)(i) of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular, but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a 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.”

The Panel finds that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute them.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (see section 2.1 of the [WIPO Overview 3.0](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted with evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that the Respondent was not given any license, permission, or authorization to register or use the Complainant's WALGREENS trademarks or the Disputed Domain Name. Further, there is no indication that the Respondent possesses any registered or unregistered trademark rights in any jurisdiction pertaining to the WALGREENS trademarks or the Disputed Domain Name. Therefore, the Panel determines that the Respondent has no trademark rights or other legitimate interests in the WALGREENS trademarks.

Furthermore, although the Disputed Domain Name currently resolves to an inactive website, the Complainant has submitted evidence showing that the Disputed Domain Name was used to resolve to a parked page with Pay-Per-Click ("PPC") links that redirect Internet users to other online locations. In this regard, section 2.9 of the [WIPO Overview 3.0](#) establishes that "the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users". In this present case, the Panel finds that the PPC links in question are referring to services of the Complainant's competitors in the health industry. Consequently, in light of the foregoing viewpoint and similarly to many well-established prior UDRP decisions, the Panel determines that the operation of a PPC parking page utilizing a distinctive trademark to provide connections to goods and/or services that compete with those offered by the trademark owner does not amount to a *bona fide* offering of goods or services (see, e.g., *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#); *Merck Sharp & Dohme Corp. v. Domain Administrator, PrivacyGuardian.org / George Ring, DN Capital Inc.*, WIPO Case No. [D2017-0302](#); *Archer-Daniels-Midland Company v. Wang De Bing*, WIPO Case No. [D2017-0363](#)).

Regarding paragraph 4(c)(ii) of the Policy, the Panel finds no evidence demonstrating that the Respondent has been commonly known by the Disputed Domain Name. This finding is substantiated by the fact that there is no evidence showing that the Respondent operates any *bona fide* business or organization under the Disputed Domain Name other than resolving the Disputed Domain Name to the parking page containing sponsored PPC links to various third-party contents. Therefore, it is not evidenced that the Respondent is identified by "walgreencovidtest" or that it has any rights in it.

Regarding paragraph 4(c)(iii) of the Policy, the Panel finds no evidence that the Respondent is making any noncommercial or fair use of the Disputed Domain Name. To the contrary, by incorporating the Complainant's distinctive trademarks into the Disputed Domain Name, the composition of the Disputed Domain Name is such to carry a risk of implied affiliation to the Complainant, when no such relationship exists, which cannot constitute fair use.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests regarding the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy, is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular, but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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 your web site or location or of a product or service on your web site or location.”

The above four circumstances are not exhaustive, and the Panel may find bad faith alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence concerning the Respondent's bad faith registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's WALGREENS trademarks have been registered in a variety of jurisdictions worldwide. In addition, the WALGREENS trademarks have been put in use for a long period and have gained a certain reputation in the sector of providing pharmacy and healthcare-related services in numerous countries. The Disputed Domain Name was registered after the Complainant's trademarks were first registered and used.

Further, the Disputed Domain Name incorporates almost fully the WALGREENS trademarks, the only difference is the deletion of the letter “s” and the addition of the descriptive terms “covid” and “test” at the end. Given the fact that the dominant term “walgreens” has no dictionary meaning in English and the extensive use of the WALGREENS trademarks by the Complainant in numerous countries, the Panel finds no plausible explanation that the Respondent registered the Disputed Domain Name without prior knowledge of the existence of the Complainant and the WALGREENS trademarks. Instead, in consideration of the use of the Disputed Domain Name resolving to the parked page with some PPC links referring to the services of the Complainant's competitors, the Respondent likely knew of the Complainant and its WALGREENS trademarks before registering the Disputed Domain Name. The Panel considers such registration as an attempt by the Respondent to attract Internet users to its website and profit from the PPC links by creating a likelihood of confusion with the Complainant's WALGREENS trademarks. This is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it is resolving to an inactive website. From the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of [WIPO Overview 3.0](#)).

With the said facts, the Panel finds the Respondent intentionally registered and used the Disputed Domain Name for commercial gain and that the Respondent's use of the Disputed Domain Name is likely to mislead consumers and confuse them by making them believe that the website is associated, fostered or recommended by the Complainant. Such misleading behavior is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith, and the third element under paragraph 4(a)(iii) of the Policy is established.

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 <walgreencovidtest.com> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: July 19, 2023