

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. See PrivacyGuardian.org, Domain Administrator
Case No. D2023-3694

1. The Parties

The Complainant is Walgreen Co., United States of America, represented by Winterfeldt IP Group PLLC, United States of America.

The Respondent is See PrivacyGuardian.org, Domain Administrator, United States of America (“USA” or “U.S.”).

2. The Domain Name and Registrar

The disputed domain name <walgreensweeklyad.shop> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 1, 2023. On September 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 4, 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 (AZ) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 4, 2023 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 September 8, 2023.

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 September 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 10, 2023.

The Center appointed Ezgi Baklacı Gülkökar as the sole panelist in this matter on October 13, 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 formerly known as Walgreens is one of the largest retail pharmacy chains corporation incorporated in Delaware, USA with its principal place of business in Illinois, USA and founded in 1901. The Complainant provides pharmacy and healthcare-related services through its retail drugstores, including prescription medicine refills, on-site pharmacy services, vaccinations, and immunizations. The Complainant has 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 filled 1.2 billion prescriptions, including immunizations, on a 30-day adjusted basis, in its 2021 fiscal year. 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 brand was ranked the 49th most valuable U.S. brand by Brand Finance in 2022 evidenced in Annex 4.

The Complainant became the first drugstore chain to offer prescription labels in multiple languages chainwide. In 2014, 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 USD132.5 billion in its 2021 fiscal year. Walgreens Boots Alliance is the largest retail pharmacy, health, and daily living destination across the U.S. and Europe, employing more than 315,000 people, with a presence in 9 countries, and approximately 13,000 stores within the U.S., Europe, and Latin America. The Complainant is the subsidiary of Walgreens Boots Alliance as evidenced in Annex 4.

The Complainant is the owner of the WALGREENS and formative trademark registrations before World Intellectual Property Organization and United States Patent and Trademark Office ("USPTO"). The relevant WALGREENS trademarks are International Registration no. 1100522 registered on August 19, 2011, International Registration no. 1103543 registered on August 19, 2011, USPTO Registration no. 1057249 registered on January 25, 1977, USPTO Registration no. 2077524 registered on July 08, 1997, USPTO Registration no. 2096551 registered on September 16, 1997, USPTO Registration no. 2113779 registered on November 18, 1997, USPTO Registration no. 1057249 registered on January 25, 1977 as evidenced in Annex 6.

The Complainant holds and uses the domain name <walgreens.com> that includes WALGREENS trademark and is used to provide pharmacy and healthcare-related services for the primary website of the Complainant at "www.walgreens.com". The Complainant's domain name <walgreens.com> was registered on May 03, 1995, and evidenced with the Annex 5 of the Complainant.

The disputed domain name was registered on September 30, 2022. The disputed domain name is currently being passively held since the webpage reverts to is inactive and as evidenced with Annex 7. The Respondent is reportedly based in the United States.

5. Parties' Contentions

A. Complainant

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

Identical or confusingly similar

The Complainant argues that the disputed domain name fully incorporates and is confusingly similar to WALGREENS trademarks, the sole difference being the addition of the generic and descriptive terms “weekly” and “ad” at the second level and fails to distinguish the disputed domain name from the Complainant’s trademark.

The Complainant also contends that the Top-Level Domain (“gTLD”) “.shop” in the disputed domain name is a standard registration requirement and that the extension is not to be taken into account when comparing a disputed domain name to the Complainant’s trademarks.

The Complainant also refers to a number of previous UDRP decisions to argue that addition of descriptive terms to a complainant’s mark in a domain name would not differentiate the domain name from the trademark itself.

Rights or legitimate interests

The Complainant argues that the Respondent has no rights and legitimate interests in the disputed domain name, has no affiliation with the Complainant and the Complainant has not given the Respondent permission to register and/or use the Complainant’s trademarks in any manner.

In addition, the Complainant argues that the Respondent is not known by the disputed domain name and the Complainant submits that the Respondent is not authorized to use the Complainant’s trademark, nor the Respondent is the licensee of the mark.

The Complainant iterates that the Respondent’s activities create a likelihood of confusion regarding source, and the Complainant further argues that such uses cannot be accepted within the scope of noncommercial or fair use.

The disputed domain name was registered and used in bad faith

The Complainant initially argues that the WALGREENS is a well-known trademark throughout the world. The Complainant also notes that previous UDRP decisions already recognize that the WALGREENS mark is “well-known” and that the Respondent should be presumed to have known or should have known that the WALGREENS mark which may be considered an inference of bad faith and cites in support various previous panel decisions.

It has been further argued by the Complainant that the fact that the disputed domain name resolves to an inactive website does not prevent the finding of bad faith due to passive holding doctrine.

The Complainant also argues that the Respondent has knowingly registered the disputed domain name in order to create an impression of an association with the Complainant.

The Complainant further asserts that the disputed domain name can only be taken as intending to cause confusion among internet users as to the source of the same, especially considering the above facts and it is indicative of an intention to hold the disputed domain name for some future active use in a way which would be competitive with or otherwise detrimental to the Complainant, constituting “cybersquatting”.

The Complainant additionally argues that at the time of initial filing, the Complainant has employed a privacy protection service to hide its identity, and there is no plausible good faith use to which the disputed domain name may be put, given that that it is confusingly similar to the Complainant’s well-known WALGREENS trademarks.

In summary, the Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (ii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it has well-established rights in WALGREENS trademarks.

The disputed domain name <walgreensweeklyad.shop> consists of the registered trademark WALGREENS with additional elements "weekly" and "ad" at the ending, and the generic Top-Level Domain ("gTLD") ".shop". In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will be considered confusingly similar (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

Panel agrees that both "weekly" and "ad" does not prevent the finding of confusing similarity. Although the disputed domain name is not identical to the trademarks of the Complainant, the aforementioned addition does not prevent the finding of similarity as the Complainant's trademark WALGREENS remains recognizable within the disputed domain name ([WIPO Overview 3.0](#), section 1.8). See *DHL Operations B.V. v. DHL Packers*, WIPO Case No. [D2008-1694](#).

Moreover generic Top-Level Domain ("gTLD") ".shop." is disregarded in the confusing similarity test, as it does not form part of the comparison as it is a standard registration requirement for technical reasons ([WIPO Overview 3.0](#), section 1.11.1).

In the light of the above, the Panel is of the view that the disputed domain name is confusingly similar to the Complainant's trademarks and the first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. While the overall burden of proof in UDRP proceedings is on the Complainant, previous UDRP panels have recognized that proving a Respondent that it lacks rights or legitimate interests in a domain name may result in the often-impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the Respondent. As such, where a Complainant makes out a *prima facie* case that the Respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1), *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

The Panel notes that there is no evidence showing that the Respondent holds any rights for the term "WALGREENS". The Panel also notes that there is no evidence showing that the Respondent is authorized or licensed to use the Complainant's trademark WALGREENS.

The case file also does not contain any evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization. Further, the Panel notes that there is no evidence of the Respondent's use of, or preparation to use the disputed domain; and there is also no evidence that the Respondent is making a legitimate noncommercial or fair use under the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or any legitimate interests in the disputed domain name within the meaning of Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that a complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith. Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's trademark ([WIPO Overview 3.0](#), section 3.1).

The Panel finds that at the time the disputed domain name was registered the Respondent more likely than not was aware of the trademark WALGREENS as Complainant's trademark registrations significantly predate the registration date of the disputed domain name. According to the evidence submitted by the Complainant, the Panel finds that the Respondent knew or should have known about the Complainant's rights (and such information could readily have been reached by a quick online search; see *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

In addition, previous UDRP panels have held that the mere registration of a domain name that is confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4). The WALGREENS trademarks are recognizable pharmacy and drugstore chain brands in the United States and indeed, is well-known throughout the world and it may suggest the disputed domain name has been selected with a deliberate intent to create an impression of an association with the Complainant (see *General Motors LLC v. desgate.*, WIPO Case No. [D2012-0451](#)).

The Panel agrees that the Respondent not only knows the Complainant's marks but intends to benefit their reputation as well, also the disputed domain name does not resolve to an active website and adding that passive holding of a domain name can also constitute a bad faith use under the Policy.

In addition, the Panel notes that Respondent used privacy services to hide their identity or avoid being notified of a UDRP proceeding, which supports an inference of bad faith. Inference of bad faith registration and use of the disputed domain name is also given by the fact that the Respondent deliberately chose to conceal its identity by means of a privacy protection service. While the use of a privacy service does not in and of itself constitute bad faith under the Policy, the manner in which such service is used in the present case is deemed to contribute to a finding of bad faith ([WIPO Overview](#), Section 3.6).

In light of these particular circumstances, the Panel concludes that the Complainant has succeeded in proving the requirement of paragraph 4(a)(iii) that the disputed domain name has been registered and used in bad faith by the Respondent.

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 <walgreensweeklyad.shop> be transferred to the Complainant.

/Ezgi Baklacı Gülkökar/

Ezgi Baklacı Gülkökar

Sole Panelist

Date: October 27, 2023