

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Ken Williams
Case No. D2023-3710

1. The Parties

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

The Respondent is Ken Williams, Cameroon.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 2, 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 5, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on September 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 3, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on October 20, 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 operates one of the largest retail pharmacy chains in the US, with approximately 9,000 retail stores. The Complainant provides pharmacy and healthcare-related services through 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 since 1995.

The Complainant is the owner of several registered trademarks on the term “WALGREENS” in many jurisdictions throughout the world (the “WALGREENS Trademarks”), including:

- the US word trademark WALGREENS Number 1057249, registered on January 25, 1977, and regularly renewed, in class 42;
- the US word trademark WALGREENS Number 2077524, registered on July 8, 1997, and regularly renewed, in class 42;
- the US word trademark WALGREENS Number 2096551, registered on September 16, 1997, and regularly renewed, in classes 3, 5, 9, 10, 11, 21, 25 and 42;
- the US trademark WALGREENS SPECIALTY PHARMACY Number 3456190, registered on July 1, 2008, in class 35;
- the Chinese trademark WALGREENS Number 6997452, registered on November 14, 2015, in class 5;
- the international trademark WALGREENS Number 1100522, registered on August 19, 2011, in class 42.

The Disputed Domain Name was registered on December 16, 2022, and, resolved to an English-language website that offered prescription medicines such as pain relievers and hydrocodone under the WALGREENS Trademarks and a “Walgreens PHARMACY” logo (the “Respondent’s Website”). This website also offered illegal substances such as crystal methamphetamine. After the Complainant filed a takedown request with the webhost, Namecheap, alleging the Respondent’s Website was an illegal online pharmacy infringing WALGREENS Trademarks, the Respondent’s Website has been taken down by the webhost.

5. Parties’ Contentions

A. Complainant

First, the Complainant states that the Disputed Domain Name is confusingly similar to its WALGREENS Trademarks, which it fully incorporates. The Complainant adds that the addition of the terms “pharmacy” and “usa” in the Disputed Domain Name only enhance the confusing similarity, since they imply an authorized online source for the Complainant’s pharmacy services, including in the US where the Complainant is based.

Then the Complainant states that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant indicates that the Respondent has never been authorized by the Complainant to use the WALGREENS Trademarks in any manner and that the Disputed Domain Name was registered well after the Complainant had registered the WALGREENS Trademarks. In addition, the Complainant explains that the Disputed Domain Name does not reflect the Respondent’s common name. Moreover, the Complainant points out that the Respondent is using the Disputed Domain Name to infringe and cybersquat upon the Complainant’s rights in the WALGREENS Trademarks. The Complainant finally adds that the use of the Disputed Domain Name through the Respondent’s website does not constitute any legitimate *bona fide* sale of goods or services or legitimate noncommercial or fair use.

Finally, the Complainant states that the Disputed Domain Name was registered and is being used in bad faith. The Complainant explains that the Respondent used the Disputed Domain Name to redirect Internet users to the Respondent's Website that directly competed with the Complainant, by unfairly trading on the goodwill associated with the Complainant's WALGREENS Trademarks. Accordingly, the Respondent disrupted the Complainant's business by diverting business and prospective business away from the Complainant and its goods and services to those of a competitor. The Respondent's Website also intimated it offered crystal methamphetamine, an illegal substance in the United States. The Complainant also adds that the Respondent's Website intended to attract Internet users for commercial gain by creating a likelihood of confusion with the WALGREENS Trademarks. Finally, the Complainant underlines that there is no evidence of any conceivable good faith use of the Disputed Domain Name and that the Respondent's activity clearly constitutes bad faith under the Policy.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the WALGREENS Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. 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 normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDPR Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Disputed Domain Name is composed of:

- the WALGREENS Trademark;
- the word "pharmacy";
- the letters U, S, and A; and
- generic Top-Level Domain ("gTLD") ".com."

According to prior UDRP panel decisions, it is sufficient that the domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing.

The mere addition of a word to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#); *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. [D2002-0615](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that the combination of the WALGREENS Trademark to the word “pharmacy” which is descriptive of the Complainant’s activity, and the letters U, S and A which constitute the abbreviation of the United States of America where the Complainant is incorporated, does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s trademarks.

Furthermore, the Panel adds that the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Finally, the Panel holds that the Disputed Domain Name is confusingly similar to the WALGREENS Trademarks, and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- (i) before any notice 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 (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent 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 or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent 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 *prima facie* that a 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Complainant has not given any license or authorization of any kind to the Respondent to use the WALGREENS Trademarks.

Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, the Respondent used the Disputed Domain Name to host the Respondent's website that offered prescription medicines such as pain relievers and hydrocodone under the WALGREENS Trademarks and a "Walgreens PHARMACY" logo and also offered illegal substances such as crystal methamphetamine. According to prior UDRP panel decisions, panels have categorically held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods or illegal pharmaceuticals) can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

Finally, the Respondent did not reply to the Complainant's contentions, and consequently, did not rebut the Complainant's *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

First, according to prior UDRP panel decisions, the mere registration of a domain name that is identical or confusingly similar to a 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](#)). Indeed, the Panel considers that it is established that the WALGREENS Trademarks were registered and used well before the registration of the Disputed Domain Name and that these Trademarks are well known. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it wholly reproduces the WALGREENS Trademarks.

In the view of the Respondent's Website, which impersonates the Complainant, there is no doubt that the Respondent knew the Complainant's WALGREENS Trademarks and has chosen the Disputed Domain Name in bad faith.

Moreover, the Panel points out that this use of the Disputed Domain Name by the Respondent demonstrates that the Respondent has intentionally attempted 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.

The current non-use of the Disputed Domain Name does not change the Panel's finding of the Respondent's bad faith.

Finally, the Respondent has not provided any response to the Complainant's contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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 <walgreenspharmacyusa.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: November 3, 2023