

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2023-3735

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 Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <compliancewalgreens.com> (the “Domain Name”) 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 September 8, 2023. On September 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 11, 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 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 4, 2023.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on October 9, 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 to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant operates a large retail pharmacy chain with 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 also provides pharmacy and healthcare-related services through its <walgreens.com> domain name registered in 1995.

The Complainant owns numerous trademark registrations for the WALGREENS mark and other WALGREENS-formative marks, such as U.S. trademark registration number 1057249 (registered on January 25, 1977) and International trademark registration number 1100522 (registered on August 19, 2011). The Complainant has promoted its trademarks globally.

The Domain Name is registered on October 17, 2022. At the time of drafting the Decision, the Domain Name appears to resolve to web content that has a malicious content prompting the user to download software or browser extensions.

5. Parties' Contentions

A. Complainant

The Complainant provides evidence of trademark registrations and argues that the only difference between the Complainant's trademark and the Domain Name is the addition of the term "compliance" (a reference to pharmacy compliance, which involves adhering to regulations regarding medication and pharmaceutical safety). In the Complainant's view, the term "compliance" in the Domain Name only enhances the confusing similarity.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not authorized, licensed, or permitted to register or use a domain name incorporating the Complainant's trademark. The Respondent's use of the Domain Name is not *bona fide* commercial or fair or legitimate noncommercial use. Use of a domain name for illegal activity, including distributing malware, can never confer rights or legitimate interests on a respondent.

The Complainant argues that the Respondent has registered and is using the Domain Name in bad faith. The Respondent has offered the Domain Name for sale from a parked webpage for minimum USD 899. The Respondent has engaged in a bad faith pattern of preventing trademark owners from reflecting their marks in corresponding domain names. The Respondent has been involved in over 200 prior UDRP proceedings in which the Respondent was found to have registered domain names in bad faith. The use for illegitimate activity to distribute malware is also considered evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Domain Name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has established that it has rights in the trademark WALGREENS. The Domain Name differs from the trademark in the addition of “compliance”. The addition does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8. For the purpose of assessing the confusing similarity under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain (“gTLD”); see [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. While the overall burden of proof in UDRP proceedings is on the complainant, 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 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. See [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name. Based on the record, the Respondent is not affiliated or related to the Complainant. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired trademark rights. There is no evidence of the Respondent’s use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. The Respondent’s use of the Domain Name is rather evidence of bad faith, see below. Lastly, given the risk of implied affiliation to the Complainant manifested in the construction of the Domain Name, namely the combination of the industry-related term “compliance” with the Complainant’s WALGREENS trademark, the Panel finds such composition cannot constitute fair use under the circumstances of this proceeding.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

It is clear that the Respondent is intentionally creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement. The Respondent has offered the Domain Name for sale for valuable consideration most likely in excess of its out-of-pocket costs directly related to the Domain Name. The Domain Name appears to be used to distribute malware, and the Respondent has engaged in a bad faith pattern of preventing trademark owners from reflecting their marks in corresponding domain names.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

The third element of the Policy has been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders the Domain Name <compliancewalgreens.com> transferred to the Complainant.

/Mathias Lilleengen/

Mathias Lilleengen

Sole Panelist

Date: October 12, 2023