

## **ADMINISTRATIVE PANEL DECISION**

Walgreen Co. v. Domain Holdings

Case No. D2023-3749

### **1. The Parties**

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

The Respondent is Domain Holdings, New Zealand.

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

The disputed domain name <waalgreens.com> (the “Disputed Domain Name”) is registered with Internet Domain Service BS Corp (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 8, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed 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 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 9, 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 United States, 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 for WALGREENS in many jurisdictions throughout the world (the "WALGREENS Trademarks"), including:

- the United States word trademark WALGREENS Number 1057249, registered on January 25, 1977, and regularly renewed, in class 42;
- the United States word trademark WALGREENS Number 2077524, registered on July 8, 1997, and regularly renewed, in class 42;
- the United States word trademark WALGREENS Number 2096551, registered on September 16, 1997, and regularly renewed, in classes 3, 5, 8, 9, 10, 11, 16, 21, 25, 29, 30, and 42;
- the United States trademark WALGREENS SPECIALTY PHARMACY Number 3456190, registered on July 1, 2008, in class 35;
- the United States trademark *Walgreens* Number 3303249, registered on October 2, 2007, in class 35;
- the international trademark WALGREENS Number 1100522, registered on August 19, 2011, in class 42.

The Disputed Domain Name was registered on February 19, 2005. At the time of the Complaint, it resolved to rotating content, including an English-language Rakuten webpage offering coupons and promotion codes, a webpage with fake virus warnings and pop-up malware and a webpage containing links to third parties' websites (the "Respondent's Website").

#### 5. Parties' Contentions

##### A. Complainant

First, the Complainant contends that the Disputed Domain Name is identical or confusingly similar to its WALGREENS Trademarks. The Complainant asserts that the mere addition of the letter "a" at the second level and of the generic top-level domain ("gTLD") ".com" does not prevent a finding of confusing similarity since the Disputed Domain Name remains near-identical to the WALGREENS Trademarks.

Then, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name since it has never authorized the latter to use the WALGREENS Trademarks to register the Disputed Domain Name. The Complainant explains that the Disputed Domain Name does not reflect the Respondent's common name and that the Respondent is using the Disputed Domain Name to infringe or cybersquat upon its rights. For the Complainant, the Respondent's Website is evidence of this absence of legitimate interest since it resolves to rotating website content including a Rakuten webpage featuring the Complainant's logo or a parking page containing links to third-party websites. The Complainant asserts that the Respondent is or was monetizing the Disputed Domain Name by trading on the goodwill associated with its WALGREENS Trademarks.

Finally, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith since the Disputed Domain Name redirects Internet users to rotating third-party websites that generate click-through revenue for the Respondent. The Complainant considers that the Respondent was disrupting from it and its good and services. The Complainant asserts that the Disputed Domain Name was registered with the intent to attract Internet users for commercial gain by creating a likelihood of confusion with the WALGREENS Trademarks.

## **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 UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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

- the WALGREENS Trademark with an additional "a"; and
- the 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.

Moreover, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (see section 1.9 of the [WIPO Overview 3.0](#)). Here, the Panel considers that the addition of another letter "a" in the WALGREENS Trademark does not prevent a finding of confusing similarity.

Lastly, the Panel adds that the gTLD in a domain name is viewed as a standard registration requirement and as such is generally 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 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 Disputed Domain Name resolved to rotating content, including an English-language webpage offering coupons and promotion codes under the Complainant's Trademarks, a webpage with presumably fake virus warnings and pop-up malware, and parking page with links to third parties' websites. According to prior UDRP panel decisions, panels have categorically held that the use of a domain name for illegal activity (e.g., distributing malware, impersonation/passing off) 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. By adding an additional letter "a" in the WALGREENS Trademarks, the Respondent has intentionally attempted to confuse Internet users and capitalized on the fame of the WALGREENS Trademarks. This constitutes an act of typosquatting that must be considered as a bad faith registration of the Disputed Domain Name.

Moreover, as discussed above, the Panel points out the fact that the Disputed Domain Name redirected visitors to a variety of unrelated websites, including websites that appear to be designed to distribute malware or otherwise endanger Internet users, also constitutes a use in bad faith.

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 WALGREENS Trademarks as to the source, sponsorship, affiliation, or endorsement.

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

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 <waalgreens.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: November 3, 2023