

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Shilei
Case No. D2023-3750

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 Shilei, China.

2. The Domain Names and Registrar

The disputed domain names <walgreenearme.com>, and <walgreensnearm.com> are registered with Dynadot Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 8, 2023. On September 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 9, 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 October 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2023.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on December 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, an American company, was incorporated in 1916. It operates one of the largest retail pharmacy chains in the United States, with approximately 9,000 retail stores across the United States, including in the 50 states, the District of Columbia, and the United States territories of Puerto Rico and the United States, Virgin Islands. The Complainant employs more than 240,000 people.

The WALGREENS trademark has been recognized as a valuable brand, being ranked the 49th most valuable United States brand by Brand Finance in 2022, and has already been recognized as a renowned trademark in previous UDRP decisions (for example, *Walgreen Co. v. Registration Private, Domains By Proxy, LLC / Nitish Masheshwari, The lead Generators*, WIPO Case No. [D2017-1601](#)).

The Complainant has numerous registrations for the WALGREENS trademark around the world. The Complainant is, *inter alia*, the owner of the following:

- United States trademark registration number 1057249 for the WALGREENS (word) trademark registered on January 25, 1977;
- United States trademark registration number 2292545 for the WALGREENS (device) trademark registered on November 16, 1999;
- Chinese trademark registration number 6997452, for the WALGREENS (word) trademark registered on November 14, 2015;
- International trademark registration number 1100522 for the WALGREENS (word) trademark registered on August 19, 2011.

The Complainant also owns and operates the domain name <walgreens.com>, registered since May 3, 1995.

The disputed domain names, <walgreenearme.com> and <walgreensnearm.com> were both registered on September 30, 2022.

The disputed domain names are currently resolving to websites hosting third-party links. From the submissions provided by the Complainant, it appears that previously (at least on February 15, 2023) the disputed domain name <walgreenearme.com> was used to redirect to the website “www.rakuten.com” where an English webpage featuring Walgreens discount codes was displayed, whereas the disputed domain name <walgreensnearm.com> was being used for a parked webpage hosting third-party links to various websites, including for pharmacy prescriptions.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the WALGREENS trademark, that the Respondents have no rights or legitimate interests in respect of the disputed domain names, and particularly that the Respondent registered and used the disputed domain names, which are now directing to websites hosting third-party links, for unauthorized commercial websites offering services competing with those offered by the Complainant, and that this is clear inference of bad faith use and registration of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain names, paragraph 4(a) of the Policy requires that the Complainant must demonstrate to the Panel that:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "near" and "me" (or "m") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 disputed domain names such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, here claimed to be misleadingly directing Internet users to competing websites offering Walgreens coupons codes, and featuring third-party links that directed users to competing third-party pharmaceutical websites, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent was aware of the Complainant's trademark registrations and rights to the WALGREENS trademark when it registered the disputed domain names.

Walgreens is not a common or descriptive term, but a renowned trademark. The disputed domain names contain in its entirety, without any authorization or approval, the Complainant's registered WALGREENS trademarks and trade name Walgreen, and this is the only distinctive component of the disputed domain names.

The disputed domain names were registered many decades after the Complainant's renowned trademark was registered and were being used to offer services in direct competition with those of the Complainant. In addition, owing to the substantial presence established worldwide and on the Internet by the Complainant, it is at the least very unlikely that the Respondent was not aware of the existence of the Complainant's trademarks when registering the disputed domain names.

Therefore, it is more likely than not that the Respondent, when registering the disputed domain names, had knowledge of the Complainant's earlier rights to the WALGREENS trademark and trade name.

Indeed, the Respondent's previous use of the disputed domain names for unauthorized commercial websites offering services competing with those of the Complainant is a clear inference that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark, and this amounts to bad faith use and registration of the disputed domain names.

The bad faith registration and use of the disputed domain names are also affirmed by the fact that the Respondent did not respond to nor has it denied the assertions of bad faith made by the Complainant in this proceeding. This is further evidence of bad faith in accordance with paragraph 4(b)(i) of the Policy.

Finally, it appears that the Respondent has also been involved in multiple prior UDRP proceedings in which the Respondent was found to have registered numerous domains in bad faith (for example, *bioMérieux v. shilei*, WIPO Case No. [D2023-3131](#)). This pattern of conduct is further evidence of bad faith registration and use within the meaning of paragraph 4(b)(ii).

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

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 names <walgreenearme.com>, and <walgreensnearm.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: December 19, 2023