

## **ADMINISTRATIVE PANEL DECISION**

Walgreen Co. v. Sean Harry  
Case No. D2023-3772

### **1. The Parties**

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

Respondent is Sean Harry, United States.

### **2. The Domain Name(s) and Registrar(s)**

The disputed domain name <walgreenpharma.com> is registered with NameCheap, 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 11, 2023, 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 Respondent is listed as the registrant and providing the contact details and contact information for the disputed domain name.

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 Respondent of the Complaint, and the proceedings commenced on October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 24, 2023.

The Center appointed Jeffrey D. Steinhardt as sole panelist in this matter on November 3, 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

Complainant is a major retail pharmacy chain in the United States. Complainant owns many registrations for its WALGREENS trademarks in the United States and China, including, for example, United States Trademark Registration No. 1057249, registered January 25, 1977 in International Class 42, with a first use date of 1971. Complainant also owns a registration for its stylized “W” trademark design under United States Trademark Registration No. 4362425 (drawing), registered July 2, 2013 in International Classes 35, 40 and 44 with a first use date of September 16, 2012.

The disputed domain name was registered September 28, 2022 and does not presently resolve to an active webpage.

#### 5. Parties 'Contentions

##### A. Complainant

Complainant avers that it has over 9,000 retail pharmacies and employs more than 240,000 workers, filling 1.2 billion prescriptions in 2021. Complainant avers that it interacts with over 9 million customers daily through its stores and online platforms.

Complainant alleges that the website to which the disputed domain name resolves has displayed Complainant’s “W” trademark design and offered the sale of prescription pharmaceuticals in competition with Complainant’s business. Complainant also alleges that Respondent’s website illegally offered pharmaceuticals in the United Kingdom without requiring prescriptions, although the disputed domain name now resolves to an error page.<sup>1</sup>

Summarizing its legal contentions, Complainant alleges that (1) the disputed domain name is confusingly similar to Complainant’s marks, (2) Respondent has no rights or legitimate interests in the disputed domain name, and (3) the disputed domain name was registered and is being used in bad faith, all in violation of the Policy.

On this basis, Complainant seeks transfer of the disputed domain name.

##### B. Respondent

Respondent did not reply to Complainant’s contentions.

#### 6. Discussion and Findings

For Complainant to prevail under the Policy, it must be established that (1) the disputed domain name is identical or confusingly similar to Complainant’s WALGREENS marks, (2) Respondent has no rights or legitimate interests in the disputed domain name, and (3) the disputed domain name was registered and is being used in bad faith. Policy, paragraph 4(a).

The fact that Respondent has not provided any Response does not, by itself, mean that Complainant prevails. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.3. The Panel may, however, accept as true reasonable factual allegations in the Complaint. See, e.g., *ThyssenKrupp USA, Inc. v. Richard Giardini*, WIPO Case No. [D2001-1425](#) (citing *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#)).

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<sup>1</sup> Complainant provides an annex with screen captures to support these allegations.

## A. Identical or Confusingly Similar

The Panel agrees with Complainant's allegation that the disputed domain name is confusingly similar to Complainant's WALGREENS marks.

UDRP panels commonly disregard Top-Level Domains ("TLDs") in determining whether a disputed domain name is identical or confusingly similar to a complainant's marks. [WIPO Overview 3.0](#), section 1.11.1.

Omitting the ".com" TLD, the Panel notes that nearly the entirety of Complainant's WALGREENS mark is included in the disputed domain name, removing only the letter "s" and adding only the word "pharma" (which, in any case, is descriptive of Complainant's business under its WALGREENS marks). The Panel finds that these modifications to Complainant's mark do not prevent a finding of confusing similarity. See, e.g., [WIPO Overview 3.0](#), Section 1.7 ("[I]n 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 . . ."); *id.*, section 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.").

The Panel therefore finds that the disputed domain name is confusingly similar to Complainant's mark and concludes that the first element of paragraph 4(a) of the Policy is established.

## B. Rights or Legitimate Interests

The Panel also concludes that Respondent has no rights or legitimate interests in the disputed domain name.

The Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes: (1) using the domain name in connection with a *bona fide* offering of goods and services; (2) being commonly known by the domain name; or (3) making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers. Policy, paragraphs 4(c)(i) – (iii).

A complainant must show a *prima facie* case that a respondent lacks rights or legitimate interests in a disputed domain name, after which the burden of production passes to the respondent. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). The absence of rights or legitimate interests is established if a complainant makes out a *prima facie* case and the respondent enters no response. *Id.*, (citing *De Agostini S.p.A. v. Marco Cialone*, WIPO Case No. [DTV2002-0005](#)).

The Panel accepts Complainant's undisputed allegations that Respondent has no affiliation, no relevant trademark rights, and no authorization or license to use Complainant's marks in the disputed domain name. The Panel also accepts Complainant's averment that Respondent is not commonly known by the disputed domain name.

Since Respondent's website does not route Internet users to authorized products or services associated with Complainant's marks, the Panel concludes that there is no *bona fide* use.<sup>2</sup>

Complainant's submissions demonstrate that the disputed domain name has resolved to a website that offered prescriptions medicines in the United Kingdom without requiring prescriptions and displayed Complainant's registered "W" trademark design.

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<sup>2</sup> Even if the offerings via the website to which the disputed domain names route were related to genuine services of Complainant, the website would not qualify for fair use since the website misleads Internet users by failing to disclose its lack of a relationship with Complainant, the trademark owner. E.g., *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), sections 2.5 & 2.8.

Respondent has refrained from opposing the evidence of illegal selling of prescription medicines and infringement of Complainant's trademark, and the Panel finds that the disputed domain name has been used for such activities. UDRP Panels have categorically held that the use of a domain name for illegal activity can never confer rights or legitimate interests in a respondent. *E.g.*, [WIPO Overview 3.0](#), section 2.13.

Moreover, because the composition of the disputed domain name falsely suggests affiliation with Complainant, the Panel finds that Respondent is not making a fair use without intention to confuse Internet users. See, *e.g.*, [WIPO Overview 3.0](#), Section 2.5 (“[A] respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner”); *id.*, Section 2.5.1 (“[W]here a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner....”).

In light of the evidence and allegations submitted by Complainant, the Panel holds that Respondent is not making a legitimate or fair use of the disputed domain name and that Complainant establishes a *prima facie* case. Respondent has not opposed or rebutted that *prima facie* case. The Panel rules, therefore, that Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel accordingly concludes that the second element of Policy paragraph 4(a) is established.

### **C. Registered and Used in Bad Faith**

The Panel also finds that Respondent registered and used the disputed domain name in bad faith, as provided under paragraph 4(a)(iii) of the Policy.

The WALGREENS trademark has been widely used in Respondent's home country of the United States for over 50 years. Complainant deals with millions of customers daily. Under the circumstances, the Panel finds that a presumption of bad faith is created by Respondent's mere registration of a domain name which is confusingly similar to Complainant's well-known marks. [WIPO Overview 3.0](#), section 3.1.4. Respondent has submitted no evidence to contradict this presumption of bad faith.

In the Panel's view, the content of Respondent's website and Respondent's use of the confusingly similar disputed domain name to promote pharmaceutical sales to the public clearly demonstrate Respondent's intention to target Complainant's business in bad faith, as provided under the Policy. Policy paragraph 4(b)(iv) (“by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site . . . by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site . . . or of a product or service on your web site . . .”).

The Panel also finds that Respondent's failure to submit a response to the Complaint and the failure to provide complete and accurate contact details as required by Respondent's agreement with the Registrar are cumulative evidence of use in bad faith. *E.g.*, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).<sup>3</sup>

The Panel holds therefore that Respondent registered and used the disputed domain name in bad faith, thus fulfilling the requirements of the third element of paragraph 4(a) of the Policy.<sup>4</sup>

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<sup>3</sup> Written notification of the Complaint to Respondent by courier was not possible using the registrant address details provided by Respondent to the Registrar.

<sup>4</sup> Since the evidence clearly demonstrates Respondent's bad faith under Policy paragraph 4(b)(iv), the Panel need not rule on Complainant's allegations that Respondent uses the disputed domain name to compete with Complainant's business in the sense of Policy paragraph 4(b)(iii).

## 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 <walgreenpharma.com> be transferred to Complainant.

*/Jeffrey D. Steinhardt/*

**Jeffrey D. Steinhardt**

Sole Panelist

Date: November 17, 2023