

## **ADMINISTRATIVE PANEL DECISION**

W.W. Grainger, Inc. v. Tyler Stuckart  
Case No. D2024-3233

### **1. The Parties**

The Complainant is W.W. Grainger, Inc., United States of America (“United States” or “U.S”), represented by Greenberg Traurig, LLP, United States.

The Respondent is Tyler Stuckart, United States.

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

The disputed domain name <grainger-inc.com> is registered with Global Domain Group LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 7, 2024. On August 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 8, 2024, 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 August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 30, 2024.

The Center appointed Stefan Naumann as the sole panelist in this matter on September 10, 2024. 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 is a U.S. publicly traded company that supplies maintenance, repair and operating products. It operates globally and notably owns the <grainger.com> domain name, the U.S. trademark GRAINGER (n° 1 559 199) registered on October 3, 1989, for services in classes 35 and 42 of the Nice Classification for classifying goods and services, and further U.S. trademarks comprised of the term “grainger” alone or in combination with other verbal and/or design elements. Some of these additional elements are disclaimed.

The Complainant has submitted a Whois printout of its domain name and copies of the registrations of the U.S. trademarks it owns, as well as evidence of its history, reputation and use of the trademarks and domain name in the U.S. and other countries, and a list of its numerous GRAINGER trademarks in various jurisdictions worldwide. The Complainant’s trademarks mentioned in the Complaint were registered before the registration of the disputed domain name.

The disputed domain name was registered on June 5, 2024. The Complainant indicates and provides robust evidence that a week after the registration, the disputed domain name was used for email addresses to engage in a fraudulent email scheme impersonating the Complainant.

According to the information provided by the Registrar, the Respondent is an individual located in the U.S.

The Complainant has not provided evidence of a webpage or website to which the disputed domain name resolves. In the interest of allowing a timely resolution of the matter, and in keeping with the consensus view among UDRP panels that a panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision,<sup>1</sup> the Panel carried out online searches that show that the disputed domain name is not accessible.

#### 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 name.

Notably, the Complainant contends that its GRAINGER trademarks are well known, that the Respondent has no permission from the Complainant to use the Complainant’s trademarks or apply for a domain name with the Complainant’s trademarks, that the Respondent is not commonly known by the disputed domain name, and does not have a right or legitimate interest with respect to the disputed domain name in connection with a bona fide offer of goods and services, and that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant submits evidence that the disputed domain name was used in connection with emails impersonating an employee of the Complainant that reference the Complainant’s trademarks as well as the name of the employee, and were sent to a third party to order a substantial shipment of products, and argues that the fraudulent use of the disputed domain name to perpetrate email scams constitutes bad faith use of the disputed domain name.

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<sup>1</sup> *Sermo, Inc. v. CatalystMD, LLC*, WIPO Case No. [D2008-0647](#); *e-Duction, Inc. v. John Zuccarini, d/b/a The Cupcake Party & Cupcake Movies*, WIPO Case No. [D2000-1369](#); see also *Descente, Ltd. and Arena Distribution, S.A. v. Portsnpotals Enterprises Limited*, WIPO Case No. [D2008-1768](#); *Latchways PLC v. Martin Peoples*, WIPO Case No. [D2010-1255](#); *Sensis Pty Ltd. Telstra Corporation Limited v. Yellow Page Marketing B.V.*, WIPO Case No. [D2011-0057](#).

## B. Respondent

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

## 6. Discussion and Findings

In order to succeed in its claim, the Complainant must demonstrate that all three elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name must be identical or confusingly similar to a trademark or service mark in which the Complainant has rights,
- (ii) the Respondent must have no rights or legitimate interests with respect to the disputed domain name, and
- (iii) the disputed domain name must have been registered and used in bad faith.

Paragraph 15(a) of the Rules provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Furthermore, paragraphs 10(b) and 10(d) of the Rules provide that a panel shall ensure that the parties are treated with equality and shall determine the admissibility, relevance, materiality, and weight of the evidence.

Paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, the Rules, a panel shall draw such inferences therefrom as it considers appropriate.

In the present matter, the Respondent did not reply to the Complainant's contentions.

While the Respondent's failure to respond does not automatically result in a decision in favor of the Complainant, the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), paragraph 4.3).

### A. Identical or Confusingly Similar

The test for the first element requires a reasoned but straightforward comparison between the Complainant's trademarks and the disputed domain name ([WIPO Overview 3.0](#), section 1.7).

Based on the evidence, the Complainant has established longstanding rights in its GRAINGER mark that previous panels have also recognized (see *W.W. Grainger, Inc. v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-1627](#), finding that "Complainant's evidence establishes that it has longstanding and widespread repute in its GRAINGER trade and service marks").

The Panel finds that 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 disputed domain name combines the GRAINGER trademark with a hyphen followed by the common abbreviation "Inc." and the generic Top-Level Domain ("gTLD") ".com".

The entirety of the mark is reproduced within the disputed domain name and is clearly recognizable within the disputed domain name..

For the purpose of assessing identity or confusing similarity in the present matter, the Panel considers that the addition of the common abbreviation “Inc.” does not prevent a finding of confusing similarity with the GRAINGER trademark, which remains immediately recognizable in the disputed domain name ([WIPO Overview 3.0](#), section 1.7).

The Panel is thus satisfied that the disputed domain name is confusingly similar to the Complainant’s trademark for the purposes of the Policy.

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 complainants, panels regularly consider that once a complainant has made out a prima facie case that a respondent lacks rights or legitimate interests, it is up to the respondent to come forward with evidence demonstrating his or her rights or legitimate interests in the domain name. If a respondent fails to come forward with relevant evidence, the complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

The Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests, and finds no indication in the evidence that the Respondent could claim rights or legitimate interests of his own in the term “Grainger”. Nor do the record or the circumstances of the case point to any circumstances that may support a rights or legitimate interests defense. The Respondent has chosen not to reply to the Complaint and has not come forward with any evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Since the Respondent has no permission from the Complainant and chose not to respond on the merits, his registration of the disputed domain name, based on the evidence provided by the Complainant and absent any indication of circumstances that may support a rights or legitimate interests defense, is without rights or legitimate interests.

This finding is further supported by the use of the disputed domain name for fraud, which cannot confer rights or legitimate interests on the Respondent ([WIPO Overview 3.0](#), section 2.13.1).

The Panel therefore finds that in the present case the Respondent does not have any rights or legitimate interests with respect to the disputed domain name.

The Panel finds the second element of the Policy has been established.

## **C. Registered and Used 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).

The Complainant argues that the Respondent knew or could not have ignored the Complainant’s well-known GRAINGER trademark, that the registration of the disputed domain name allows a finding of bad faith registration and that the use of the disputed domain name for fraudulent purposes constitutes bad faith use of the disputed domain name.

The disputed domain name does not resolve to an active webpage or site.

In the present matter, the Panel notes that the disputed domain name closely approximates the Complainant's domain name <grainger.com>.

The Complainant submitted clear evidence of the alleged illegal activity.

The evidence shows that the disputed domain name registered by the Respondent was used for an email address purporting to be that of one of the Complainant's employees and the fraudulent emails were sent shortly after the disputed domain name was registered by the Respondent.

Based on the foregoing, the record notably shows that:

- (i) the Respondent is located in the U.S.,
- (ii) the term "grainger" is a coined or fanciful term that could not have been chosen because of a dictionary or common meaning,
- (iii) the Respondent was aware of the Complainant's trademarks insofar as he used the trademark GRAINGER in fraudulent emails that show a fairly detailed awareness of certain of the Complainant's employees' functions, the Complainant's business dealings and invoicing,
- (iv) the Respondent registered a domain name that fully incorporates the Complainant's GRAINGER trademark with a common abbreviation for corporations and closely resembles the Complainant's <grainger.com> domain name, and;
- (v) the Respondent appears to have used the disputed domain name for fraudulent purposes.

In the present case, the Panel considers that the facts of this case as reflected in the limited record available in UDRP proceedings support a finding that the registration and use of the disputed domain name was in bad faith.

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 name <grainger-inc.com> be transferred to the Complainant.

*/Stefan Naumann/*

**Stefan Naumann**

Sole Panelist

Date: September 25, 2024