

ADMINISTRATIVE PANEL DECISION

W.W. Grainger, Inc. v. Domains By Proxy, LLC / Domain Admin
Case No. DCO2022-0049

1. The Parties

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

The Respondent is Domains By Proxy, LLC / Domain Admin, United States / Domain Admin, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <wwgrainger.co> 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 June 16, 2022. On June 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 22, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 23, 2022.

The Center verified that the Complaint together with the amended 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 June 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 21, 2022.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on August 1, 2022. 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 W.W.Grainger, Inc., North America's leading broad line supplier of maintenance, repair and operating products, with more than 1.2 million products available, 354 branches and almost 24,000 employees worldwide.

The Complainant owns several registrations in at least 80 countries incorporating its famous GRAINGER trademark, including the United States registration No. 1,559,199 for GRAINGER, registered on October 3, 1989 and the British Virgin Islands registration No. 2371 for GRAINGER & Design, registered on December 26, 2007.

The Complainant operates its primary consumer-facing website accessible at the URL "www.grainger.com".

The disputed domain name was registered on November 30, 2020 and resolves to a website that redirects Internet users to third-party websites.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name incorporates its trademark in full, just adding the letters "ww" plus the generic Top-Level Domain ("gTLD") ".co" after the mark and that the letters "ww" are identical to the "ww" in the Complainant's corporate name (W.W. Grainger, Inc.). The Complainant adds that "ww" is also similar to "www" which is part of the URL for the Complainant's website.

Also, the Complainant says that the Respondent is not commonly known by the disputed domain name, has not used or prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services, and has not been authorized, licensed or otherwise permitted by the Complainant to register and/or use the disputed domain name. Instead, the Respondent is using the disputed domain name to divert Internet traffic to various third party websites to earn a commission through an affiliate advertising program.

Furthermore, the complaint shows evidence that the Respondent has listed the disputed domain name for sale for USD 688 as an attempt to sell it well in excess of its out-of-pocket costs.

According to the Complainant, the disputed domain name was registered in opportunistic bad faith, with full knowledge of the Complainant's rights in the term GRAINGER to create a likelihood of confusion among Internet users for commercial gain. In addition, the Complainant informs that the disputed domain name also has an active mail exchange records, which may be indicative of use of the disputed domain name for phishing or fraud purposes.

The Complainant informs that on March 24, 2022 sent a letter to the Respondent advising of its rights over GRAINGER mark and that the Respondent has not responded to it.

Last but not least, the Complainant argues that the registrant of the disputed domain name used a proxy service to shield its identity and that for all those reasons, the Respondent's conduct constitutes bad-faith registration and use of the disputed domain name.

Finally, the Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (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

The evidence presented in the Complaint demonstrates that the Complainant is the owner of numerous trademark registrations for GRAINGER around the world. Also, the Complainant registered the domain name <grainger.com> on March 23, 1994 and it corresponds to its principal website. All of these registrations predate the registration date of the disputed domain name.

The disputed domain name comprises the Complainant's trademark GRAINGER in its entirety. The addition of the letters "ww" does not avoid confusing similarity between the disputed domain name and the Complainant's trademark.

In this regard, it is the general view among UDRP panels that the addition of merely dictionary, descriptive or geographical words to a trademark in a domain name does not avoid a finding of confusing similarity under the first element of the UDRP (for example, *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd*, WIPO Case No. [D2001-0110](#)).

Also, prior UDRP panels have recognized that the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that the disputed domain name is confusingly similar to the complainant's registered mark. See section 1.7, [WIPO Overview 3.0](#).

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain name is confusingly similar to the Complainant's trademarks.

B. Rights or Legitimate Interests

The Respondent has not submitted a response to the Complaint.

There is no evidence that the Respondent has any authorization to use the Complainant's trademark or to register domain names containing the trademark GRAINGER.

There is no evidence that the Respondent is commonly known by the disputed domain name.

There is also no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent has made use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, the Complainant showed evidence that the disputed domain name was used in bad faith.

Moreover, the construction of the disputed domain name itself is such to carry a risk of implied affiliation that cannot constitute fair use. See section 2.5.1, [WIPO Overview 3.0](#).

The Panel finds that the use of the disputed domain name, which incorporates the Complainant's trademark, does not correspond to a *bona fide* use of the disputed domain name under the Policy.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The trademark GRAINGER is registered by the Complainant in several jurisdictions and has been used since a long time. The Complainant's GRAINGER mark is distinctive and enjoys worldwide visibility. Thus, a domain name that reproduces such a mark is suggestive of the registrant's bad faith.

Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4, [WIPO Overview 3.0](#). The Panel also finds that the addition of the letters "ww" in the disputed domain name - identically incorporated in the Complainant's corporate name (W.W.Grainger, Inc.) - further suggests bad faith.

The Complaint shows evidence that the Respondent registered the disputed domain name to use it for the purpose of generating click through revenue, to redirect Internet traffic to an alternative website, or even to facilitate the creation of email addresses for purposes of future fraudulent messages. In any case, the Respondent aimed to mislead users into believing that the corresponding website was related to or authorized by the Complainant.

The Respondent was obviously aware of the Complainant's trademark rights at the time of the registration of the disputed domain name and used a proxy service to hide its identity, which confirms bad faith registration and use.

Moreover, the Respondent has chosen not to respond to the Complainant's allegations. According to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#): "the failure of the Respondent to respond to the Complaint further supports an inference of bad faith".

Therefore, this Panel finds that the Respondent has intentionally attempted to cause confusion with the Complainant's trademark by misleading Internet users to believe that its website belongs to or is associated with the Complainant.

This Panel finds that the Respondent's attempt of taking undue advantage of the trademark GRAINGER as described in paragraph 4(b)(iv) of the Policy has been demonstrated.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i.e.*, the disputed domain name has been registered and is being used in bad faith.

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, <wwgrainger.co> be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: August 15, 2022