

ADMINISTRATIVE PANEL DECISION

W.W. Grainger, Inc. v. Privacy Protection / JH Kang
Case No. DCO2022-0060

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 Privacy Protection, United States / JH Kang, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <wwwgrainger.co> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 3, 2022. On August 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 4, 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 August 5, 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 August 5, 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 August 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2022.

The Center appointed Halvor Manshaus as the sole panelist in this matter on September 6, 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 a publicly traded company in New York and Chicago Stock Exchanges that has been in business for over 85 years. It is a leading supplier of maintenance, repair, and operating products in North America, having operations in Asia, Europe, and Latin America, with several branches and thousands of employees worldwide.

The Complainant owns several long-standing trademark registrations for GRAINGER in the United States such as reg. No. 2,039,641, which was registered February 25, 1997 for international class 9; reg. No. 1,747,557, registered January 19, 1993 for international class 42; reg. No. 1,559,199, registered October 3, 1989 for international classes 35 and 42; and reg. No. 2,128,519 registered January 13, 1998 for international classes 35 and 37. The Complainant also owns trademark registrations of the GRAINGER mark in several other jurisdictions and the domain name <grainger.com>, where it operates its primary website.

The disputed domain name has been used to redirect Internet traffic to a website containing pay-per-click or affiliated links diverting Internet traffic to websites that are competitive with the Complainant. Further, the disputed domain name has an active mail exchange record and has been listed for sale for USD 799 on Afternic, a platform for domain name sales and auctions. The Complainant has contacted the Respondent regarding the disputed domain name; however, the Respondent has not responded to the Complainant's correspondence.

5. Parties' Contentions

A. Complainant

The Complainant requests that the disputed domain name be transferred to it. The Complainant's arguments can be summarized as follows:

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks as it incorporates the Complainant's GRAINGER mark, with the additions of the letters "www" and the Top Level Domain ("TLD") extension ".co". According to the Complainant, the addition of "www" underlines that the disputed domain name is confusingly similar to the Complainant's mark as the Complainant's corporate name comprises the letters "W.W." and the word Grainger and it is identical to the URL of the Complainant's website.

The Complainant argues that the Respondent lacks rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent has never been authorized, licensed, or otherwise permitted to use the Complainant's trademarks and is not commonly known under the GRAINGER mark or by the disputed domain name. The Complainant submits that the Respondent has not used the disputed domain name in connection with a *bona fide* or legitimate business as the disputed domain name had been used to divert Internet traffic to the website that contains pay-per-click or affiliated links that direct to websites that are competitive with the Complainant. The Complainant also submits that the Respondent's listing of the disputed domain name on a domain name sales and auction platform is insufficient to evidence the Respondent's rights or legitimate interests in the disputed domain name.

The Complainant claims that the Respondent registered and uses the disputed domain name in bad faith. The Complainant submits that the Respondent had knowledge of the Complainant's GRAINGER mark at the time of registration of the disputed domain name and that the Respondent registered the disputed domain name to redirect Internet traffic to the website offering pay-per-click and affiliated advertisements for the Respondent's commercial gain. As such, the Complainant holds that the Respondent registered and uses the disputed domain name to intentionally attract Internet users to the Respondent's website or affiliate advertisements for commercial gain, causing disruption of the Complainant's business and creating a likelihood of confusion regarding the source, sponsorship, affiliation, or endorsement.

Further, the Complainant submits that the disputed domain name has active mail exchange records, indicating the Respondent's engagement in recognizing fraudulent emails or phishing communications. According to the Complainant, the Respondent's listing of the disputed domain name on a domain name sales and auction platform indicates bad faith, as well as the Respondent's use of a proxy service to register the disputed domain name and the lack of response to the Complainant's contentions.

B. Respondent

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

6. Discussion and Findings

The Complainant has, in accordance with paragraph 4 (i) of the Policy, requested that the disputed domain name be transferred to the Complainant.

In accordance with paragraph 4(a) of the Policy, in order to succeed in this proceeding and obtain the transfer of the disputed domain name, the Complainant must establish that each of the three following elements is satisfied for the disputed domain name:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Pursuant to paragraph 15 (a) of the Rules, the Panel shall decide the 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. Moreover, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules of any request from the Panel, the Panel shall draw such inferences therefrom, as it deems appropriate.

On the basis of the evidence introduced by the Complainant and in particular with regard to the content of the relevant provisions of the Policy, (paragraphs 4(a), (b), (c)), the Panel concludes as follows:

A. Identical or Confusingly Similar

The Complainant indisputably holds numerous trademark registrations of GRAINGER, also combined with other characters. Based on the evidence submitted by the Complainant, describing the Complainant's trademark registrations and associated business, the Panel finds that the Complainant owns rights to the trademark GRAINGER in several jurisdictions and established a long-standing right to the GRAINGER mark.

The disputed domain name, <wwwgrainger.co>, comprises the Complainant's trademark GRAINGER in its entirety, except for the presence of the letters "www" and the TLD extension ".co". The Panel is of the opinion that the addition of the letters "www" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark. Further, the Panel finds that the TLD extension ".co" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In the Panel's view, the presented evidence referred to by the Complainant is sufficient to establish *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. As held by the Panel in *Ticketmaster Corporation v. Global Access*, WIPO Case No. [D2007-1921](#), the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name when such *prima facie* case is made out.

The Respondent has not replied to the Complainant's contentions, and the Panel has not been presented with, or otherwise discovered, any evidence showing: (i) that the Respondent has received a license or other permission to use the Complainant's trademark or any domain name incorporating or simulating this mark; (ii) that the Respondent is commonly known by the disputed domain name; (iii) that the Respondent has acquired trademark or service mark rights to use the disputed domain name; or (iv) that the Respondent is making legitimate noncommercial or fair use of the disputed domain name.

The disputed domain name diverts Internet traffic to the website with pay-per-click or affiliated links that direct to websites that are competitive with the Complainant. As held in *Ticketmaster Corporation v. DiscoverNet, Inc.*, WIPO Case No. [D2001-0252](#), the Panel finds that such use cannot qualify as demonstrating rights or legitimate interests in the disputed domain name. Additionally, the Panel's opinion is that listing the disputed domain name for sale on a domain name sales and auction platform does not provide evidence of rights or legitimate interests in the disputed domain name.

Further, as the Respondent did not reply to the Complaint and thereby opted not to seize the opportunity to demonstrate any rights or legitimate interests in the disputed domain name, the Panel considers the Complainant to have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the Complainant has satisfied the requirements under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4 (b) sets forth a non-exclusive list of circumstances indicating bad faith, such as the Respondent intentionally attempting to attract Internet users to its website or other online location by using the disputed domain name for commercial gain by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or a product or service on the website or location.

The Complainant has credibly shown that the GRAINGER mark is widely known within its sector, and the Panel finds it unlikely that the Respondent was unaware of the Complainant's trademarks when registering the disputed domain name. Moreover, the disputed domain name is confusing similar to the Complainant's widely known trademark. As UDRP panels have consistently found, *e.g.*, in *Elizabeth Taylor Cosmetics Company v. NOLDC, Inc.*, WIPO Case No. [D2006-0800](#) and *Singapore Airlines Limited v. P&P Servicios de Comunicacion S.L.*, WIPO Case No. [D2000-0643](#), the mere registration of a domain name confusing similar to a famous or widely known trademark by an unaffiliated entity can create a presumption of bad faith.

Further, as described above concerning rights or legitimate interests, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Therefore, the Panel concludes that the Respondent sought to register the disputed domain name because of its association with the Complainant, the Complainant's reputation, and the Complainant's business, with the intention of diverting Internet users, particularly customers and potential customers of the Complainant, from the Complainant's

website to the disputed domain name for the Respondent's commercial benefit.

Further, as held in *CONOCO INC. v. RDH Computer Solutions / Ronald D. Harris*, WIPO Case No. [D2000-0960](#), the conduct to offer a domain name for sale on an auction site is evidence of bad faith. Taken together with the fact that the Respondent has not filed any Response to these proceedings, not responded to the Complainant's correspondence, the Panel finds that the Complainant has established that the Respondent registered and used the disputed domain name in bad faith. If the Respondent intended to make legitimate noncommercial or fair use of the disputed domain name, the Respondent would have defended this Complaint accordingly.

The Panel, therefore, finds that the Complainant has satisfied the requirement under paragraph 4(a)(iii) 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, <wwwgrainger.co>, be transferred to the Complainant.

/Halvor Manshaus/

Halvor Manshaus

Sole Panelist

Date: September 20, 2022