

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Privacy service provided by Withheld for Privacy ehf / john kroehle

Case No. D2022-2716

1. The Parties

Complainant is Walgreen Co., United States of America ("United States" or "U.S."), represented by Winterfeldt IP Group PLLC, U.S.

Respondent is / john kroehle, U.S.

2. The Domain Name and Registrar

The disputed domain name <n95maskwalgreens.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 July 25, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on July 25, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint.

The Center sent an email communication to Complainant on July 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 26, 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 Respondent of the Complaint, and the proceedings commenced on August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on September 1, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on July 6, 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

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

With a history dating back to 1901, Complainant operates one of the largest retail pharmacy chains in the United States, with approximately 9,000 retail stores providing pharmacy and healthcare-related services through its thousands of retail drugstores under the trademark WALGREENS, (the “WALGREENS Mark”) including prescription medicine refills, on-site pharmacy services, vaccinations and immunizations. Complainant employs more than 240,000 people, including over 85,000 healthcare service providers.

Approximately nine million customers interact with Walgreens online and in Walgreens stores daily, and nearly 80% of the U.S. population lives within five miles of a Walgreens store. Walgreens ranked the 49th most valuable U.S. brand by Brand Finance in 2022.

Since completing a 2014 merger with a leading international pharmacy-led health and beauty group, which formed a new global company, Walgreens Boots Alliance, Complainant became a subsidiary of a Fortune 500 company that generated sales of USD 132.5 billion in its 2021 fiscal year and is the largest retail pharmacy, health, and daily living destination across the U.S. and Europe, employing more than 315,000 people, with a presence in 9 countries, and approximately 13,000 stores within the U.S., Europe, and Latin America.

Complainant holds numerous trademark registrations for the WALGREENS Mark and variations thereof in the U.S. and around the world used in connection with Complainant’s retail drug store, pharmacy, healthcare and general merchandise services, as well as for a wide variety of, medical, dental, and cosmetic consumer goods, including:

1. U.S. Registration No. 1057249, WALGREENS, registered on January 25, 1977, for a range of services in Class 42, claiming use in commerce since 1971.
2. U.S. Registration No. 2077524, WALGREENS, registered on July 8, 1997, for a range of services in Class 42, and claiming use in commerce since 1995.
3. U.S. Registration No. 4684998, WALGREENS CONNECTED CARE, registered on February 10, 2015 for services in Class 35, and claiming use in commerce since 2014.
4. International Trademark Registration No. 1100522, WALGREENS registered on August 19, 2011, for services in Class 42.
5. International Trademark Registration No. 1103543, WALGREENS, registered on August 19, 2011 for goods in Classes 10 and 21.

Complainant asserts that the goodwill generated by Complainant’s WALGREENS Marks have earned it recognition from organizations and news outlets worldwide, including recognition for Complainant’s efforts during the COVID-19 pandemic to distribute N95 masks and COVID-19 vaccines as shown in media coverage submitted in the Annexes attached to the Complaint. Prior UDRP panels in decisions cited in the Complaint have also found Complainant’s WALGREENS Mark to be famous in the United States and throughout the world.

Complainant has also registered domain names that incorporate the WALGREENS Mark, including <walgreens.com>, its primary domain name, registered since May 1995 and, used to access the Official

WALGREENS Website where it promotes and provides pharmacy and healthcare-related services while making substantial use of the WALGREENS Mark (the “Official WALGREENS Website”).

The disputed domain name was registered on March 17, 2022, and as of the filing of the complaint resolved to a website offering KN95 face masks for sale under the WALGREENS Mark (“Respondent’s Website”) in competition with Complainant that also sells N95 face masks, both in its stores and through Complainant’s Official WALGREENS Website.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant’s trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

In view of Respondent’s failure to submit any Response, the Panel shall decide this administrative proceeding on the basis of Complainant’s undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable, and supported, allegations and inferences set forth in the Complaint as true, unless the evidence is clearly contradictory.

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these requirements in more detail below.

The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that Complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

Complainant claims registered trademark rights in the WALGREENS Mark for its retail drug store, pharmacy, healthcare and general merchandise services dating back to 1900. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting national and international trademark registration documents in the name of Complainant referenced in Section 4. Complainant has demonstrated, therefore, that it has rights in the WALGREENS Mark required under the Policy. See *Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy Nikolaevich et al.*, WIPO Case No. [D2016-0205](#); see also *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

Complainant's extensive and detailed evidence submitted in the Complaint and its Annexes relating to the disputed domain name shows it clearly and prominently encompasses Complainant's WALGREENS Mark in full. Complainant contends, therefore, that the WALGREENS Mark remains fully recognizable in the disputed domain name and is confusingly similar to Complainant's WALGREENS Mark. (Complainant also notes that Respondent's selection of the added specific terms "n95" and "mask" at the second level together comprise the name of a product sold on Complainant's Website. Complainant contends, therefore, that the terms selected enhance a determination of confusing similarity, but the Panel considers these facts more appropriate for consideration under the second and third elements of the Policy.)

Prior UDRP panels have held that a domain name which wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other terms to such marks. [WIPO Overview 3.0](#), 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") see also *Meta Platforms, Inc. et al. v. Abuz Hamal et al.*, WIPO Case No. [D2022-0212](#). Further, the addition of a generic Top-Level Domain such as .com used by Respondent in this case, "is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test". [WIPO Overview 3.0](#), Section 1.11.1.

Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, Complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, and if successful the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the disputed domain name. If the respondent fails to come forward with such evidence, a complainant may be deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or legitimate interests.

The first example, under paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services".

Here, the annexes to the Complaint show that the disputed domain name resolves to a website configured by Respondent to pass its business off as Complainant's online pharmacy website or sponsored or endorsed by Complainant through incorporating Complainant's WALGREENS Mark into its disputed domain name, and Complainant contends Respondent created such configuration and to lead consumers to reasonably believe Respondent's website originates with or is affiliated with Complainant and is used to generate revenues from the sale of Respondent's N95 masks to prospective customers for Respondent's commercial benefit.

Prior UDRP panels have held that the use of a domain names to confuse and attract Internet users through misuse of a well-known trademark, and the provision of content which promotes goods and services impersonating and competitive to Complainant cannot be considered use in connection with a *bona fide* offering of goods or services under Paragraph 4(c)(i). See *The Clorox Company v. WhoisGuard Protected, WhoisGuard, Inc. / Enos Villanueva, Melissa Rosenberg, Yang Ming*, WIPO Case No. [D2021-0603](#).

Prior UDRP panels have also held that the use of a domain name for illegal activity involving impersonation and fraud (e.g., phishing, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#), section

2.13. See also, *Springer Nature Limited v. Registration Private, Domains By Proxy, LLC / Collections Springer Nature*, WIPO Case No. [D2020-0955](#).

Applying the foregoing decision to these facts this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that Respondent is not related in any way to Complainant, does not carry out any activity for, nor has any business affiliation with Respondent. Neither has Complainant granted Respondent any license or authorization to use the WALGREENS Mark for any purpose, including as a domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

Complainant also shows that Respondent is not commonly known by the disputed domain name because the original Respondent listed in the Whois record submitted with the initial Complaint displayed “Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf” of Iceland. The Registrar identified the underlying registrant in its verification process, “/ john kroehle” of the United States, who has been substituted in the amended Complaint as Respondent. Neither the original nor the substitute bears any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant’s trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a lack of rights or legitimate interests in the disputed domain name. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

In light of the above, and with no Response or other submission in this case to rebut Complainant’s assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, Complainant contends that given its WALGREENS Mark is famous, especially in the United States where Respondent is located, and the disputed domain name incorporates the WALGREENS Mark in its entirety, shows Respondent’s actual knowledge of the WALGREENS Mark. The WALGREENS Mark has been in use for its retail drug store, pharmacy, healthcare, and general merchandise services for decades dating back to 1900 and registered in the U.S. for almost fifty years before Respondent registered the disputed domain name. Complainant registered the domain name used to access its Official WALGREENS Website in 1995. Prior UDRP panels have found that where, as here, it would be implausible to believe that Respondent selected and was using the disputed domain name for any other purpose than to target Complainant’s mark and trade on Complainant’s trademark rights and reputation, Respondent was disrupting Complainant’s business by diverting business and prospective business away from Complainant

and its goods and services. This activity was done in opposition to Complainant and was disruptive to Complainant's business and therefore establishes a fact pattern that repeatedly has been held to constitute bad faith registration and use under paragraph 4(b)(iii) of the Policy. See *Galderma Holding S.A. v. Withheld for Privacy Purposes Privacy service provided by Withheld for Privacy ehf / Yves Aya*, WIPO Case No. [D2021-0981](#); see also *Philip Morris Products S.A. v. Rich Ardtea*, WIPO Case No. [D2020-0528](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises a complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain name. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#). Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Finally, as noted in 6B. above, Respondent has intentionally configured the disputed domain name to enhance confusing similarity to Complainant's WALGREENS Mark by adding descriptive terms common to Complainant's offering of healthcare products through its retail drugstores and online, "N95" and "mask"; N95 representing a model of a protective face mask associated with protective devices used during the COVID19 pandemic, and using the disputed domain name to direct or redirect consumers to Respondent's website offering N95 facemasks in competition with Complainant's products and services. Prior UDRP Panels have found these facts demonstrate a clear indication that Respondent abused Complainant's WALGREENS Mark by incorporating it into the disputed domain name to create a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of Respondent's website to intentionally attract Internet users to its website for Respondent's own commercial gain and, therefore, registered and used the disputed domain name in bad faith in violation of paragraph 4(b)(iv) of the Policy. See, e.g., *Microsoft Corporation v. Zerbo*, WIPO Case No. [D2005-0644](#); *Royal Bank of Canada v. China Capital Investment Limited*, WIPO Case No. [D2017-1025](#); *Travelscape, LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Irwin Periola*, WIPO Case No. [D2020-2741](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied 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, <n95maskwalgreens.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: July 26, 2023