

## **ADMINISTRATIVE PANEL DECISION**

### **Walgreens Boots Alliance, Inc. and Walgreen Co. v. Andrea Ruth** **Case No. D2022-3470**

#### **1. The Parties**

Complainants are Walgreens Boots Alliance, Inc., United States of America (“United States”), and Walgreen Co. United States, represented by Winterfeldt IP Group, PLLC, United States.

Respondent is Andrea Ruth, United States.

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

The disputed domain name <walgreenboots.online> is registered with Hostinger, UAB (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2022. On September 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing additional contact details. The Center sent an email communication to Complainants on September 22, 2022, providing the registrant and additional contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on September 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 Respondent of the Complaint, and the proceedings commenced on September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. Respondent did not submit any response. Accordingly, the Center notified the Parties of Respondent’s default on October 20, 2022.

The Center appointed Ingrida Kariņa-Bērziņa as the sole panelist in this matter on July 13, 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 Walgreens Boots Alliance, Inc. is an international retailer of pharmacy, health, and beauty products operating in the United States, Europe, and Latin America. It was formed by the 2014 merger of the leading British retail pharmaceutical chain Boots and another Complainant Walgreen Co. Complainant Walgreens Boots Alliance, Inc. employs more than 315,000 people in approximately 13,000 stores in nine countries. Complainant Walgreens Boots Alliance, Inc. operates an e-commerce website at the domain name <boots.com> and a mobile app with the same name.

Complainants are the proprietors of the following trademark registrations, respectively:

- United States Trademark Registration No. 5433695 for WALGREENS BOOTS ALLIANCE (word mark), registered on March 27, 2018 for services in class 44;
- United States Trademark Registration No. 1057249 for WALGREENS (word mark), registered on January 25, 1977 for services in class 42, claiming a date of first use of 1971.

Complainant Walgreen Co. is a subsidiary of Complainant Walgreen Boots Alliance, Inc. and operates one of the largest retail pharmacy chains in the United States, with approximately 9,000 retail stores. Complainant Walgreen Co. operates an e-commerce website at the domain name <walgreens.com>.

The disputed domain name was registered on December 22, 2021. At the time of filing of the Complaint, the disputed domain name resolved to a Registrar's parking page while at the time of this Decision, it does not resolve to an active website. The record contains evidence that mail exchange ("MX") records have been established for the disputed domain name.

#### **5. Parties' Contentions**

##### **A. Complainants**

Complainants' contentions may be summarized as follows:

##### **1) Request to Consolidate Complainants**

Complainants request that the Panel allow Complainants to be consolidated for purposes of this domain name dispute. Complainants have a common grievance against Respondent regarding the disputed domain name which targets both Complainants. Moreover, Complainant Walgreen Co. is a subsidiary of Complainant Walgreens Boots Alliance, Inc. Accordingly, the consolidation of both Complainants would be equitable and procedurally efficient.

##### **2) Substantive Contentions**

Under the first element, Complainants state that the disputed domain name nearly fully incorporates and is confusingly similar to Complainants' marks, in particular WALGREENS and WALGREENS BOOTS ALLIANCE, in which Complainants have well-established rights. The only differences between Complainants' marks and the disputed domain name are the omission of the letter "s" in the WALGREENS mark and the omission of the word "alliance" in the WALGREENS BOOTS ALLIANCE mark, and the addition of the ".online" Top-Level Domain ("TLD") extension.

Under the second element, Complainants state that Respondent has never been authorized by Complainants to use the WALGREENS and WALGREENS BOOTS ALLIANCE marks in any manner, much

less as part of the disputed domain name. Respondent has no legitimate interests in the disputed domain name given that the disputed domain name was registered well after Complainants had registered their marks and had established extensive goodwill, including with regard to the merged entity Walgreens Boots Alliance, Inc., which is the association that the disputed domain name targeted given the inclusion of the terms Walgreens and Boots in the disputed domain name. The disputed domain name resolves to a parked webpage passively held by Respondent.

Under the third element, Complainants state that Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor. The disputed domain name resolves to a webpage parked with the Registrar and is therefore being passively held by Respondent, especially considering the distinctiveness and fame of Complainants' marks. The existence of MX records indicates that a domain name registrant is able to send emails from a domain name, and is thus able to create consumer confusion by allowing consumers to think they are receiving an email from an authentic provider of goods or services.

Complainants request transfer of the disputed domain name.

## **B. Respondent**

Respondent did not reply to Complainants' contentions.

## **6. Discussion and Findings**

### **6.1 Preliminary Issue – Consolidation of Complainants**

Pursuant to paragraph 10 of the Rules:

- (a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- (b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

[...]

- (e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

The principles to assess a request to consolidate multiple complainants are set forth in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1.

Noting the circumstances of the case, in particular the fact that Complainant Walgreens Co. is a wholly-owned subsidiary of Complainant Walgreens Boots Alliance, Inc., and the fact that they are the owners of trademark registrations for WALGREENS and WALGREENS BOOTS ALLIANCE, the Panel considers that Complainants have a specific common grievance against Respondent and Respondent has engaged in common conduct that has affected Complainants in a similar fashion. Under the circumstances, the Panel finds it would be equitable and procedurally efficient to permit the consolidation.

Respondent does not challenge Complainants' assertions nor offer any alternative explanation for these circumstances. Accordingly, the Panel accepts Complainants' consolidation request pursuant to the Rules, paragraph 10(e). Complainants are hereinafter referred to as "Complainant".

## 6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

### A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the WALGREENS and WALGREENS BOOTS ALLIANCE marks through registration in the United States and other jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See [WIPO Overview 3.0](#), section 1.2.1.

In comparing Complainant’s WALGREENS and WALGREENS BOOTS ALLIANCE marks with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to these marks as the marks or dominant parts thereof are clearly recognizable within the disputed domain name. It is the consensus view of UDRP panels that, 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 disputed domain name, the disputed domain name will normally be considered confusingly similar to that mark. See [WIPO Overview 3.0](#), section 1.7.

It is the well-established view of UDRP panels that a TLD such as “.online” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no rights in the WALGREENS or WALGREENS BOOTS ALLIANCE marks, nor is Respondent commonly known by the disputed domain name.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not provided any rebuttal of Complainant’s *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name. There is no evidence that Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish Respondent’s rights therein. There is no evidence of legitimate noncommercial or fair use or a *bona fide* offering of goods or services.

The evidence in the record establishes that the disputed domain name has not been used to resolve to an active website other than a Registrar's parking page. Therefore, there has been no use that would confer rights or legitimate interests.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

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

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant's registered rights in its WALGREENS mark predates the registration of the disputed domain name by more than 40 years. The disputed domain name reflects Complainant's well-established WALGREENS mark and the dominant part of its WALGREENS BOOTS ALLIANCE mark, implying a connection to Complainant's group of companies. Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity, as in this case, can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

The disputed domain name does not resolve to an active website other than a Registrar's parking page. The Panel finds that Respondent has, on balance, demonstrated bad faith by passive holding of this disputed domain name. Such a finding is consistent with previous UDRP decisions, such as *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). See also [WIPO Overview 3.0](#), section 3.3. In particular, the disputed domain name reflects Complainant's registered and long-established WALGREENS mark. Respondent has failed to provide any evidence of a connection to a legitimate business related to the disputed domain name. Respondent has also failed to provide any evidence of actual or contemplated good-faith use of the disputed domain name. Under the circumstances, the Panel does not find any plausibility of any good faith use to which the disputed domain name may be put.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) 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 <walgreenboots.online> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: July 27, 2023