

ADMINISTRATIVE PANEL DECISION

W.W. Grainger, Inc. v. Paul Vaughan
Case No. D2022-1452

1. The Parties

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

Respondent is Paul Vaughan, United States.

2. The Domain Name and Registrar

The disputed domain name <graingerexpress.com> (hereinafter the “Disputed Domain Name”) 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 April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 26, 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 Complainant on April 27, 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 April 27, 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 May 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 23, 2022.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on June 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

Complainant is a leading broad line supplier of maintenance, repair, and operating (“MRO”) products, all of which Complainant markets under the GRAINGER mark. Complainant has used its GRAINGER mark since 1928 in connection with its MRO products in North America, Asia, Europe, and Latin America. Complainant owns multiple trademark registrations for GRAINGER and GRAINGER formative marks in the United States and internationally. Of relevance to this proceeding are Complainant’s United States trademark registrations for the word mark GRAINGER (Registration Numbers 2,039,641, 1,747,557, 1,559,199, 2,128,519) (registered February 25, 1997, January 19, 1993, October 3, 1989, and January 13, 1998 respectively), and **GRAINGER** (Registration Numbers 3,256,911, 3,256,912, 2,998,326, 3,053,642) (registered June 26, 2007, September 20, 2005, January 31, 2006, and April 10, 2001 respectively) (collectively the “GRAINGER Marks”).

Respondent registered the Disputed Domain Name on August 6, 2009, long after Complainant registered its GRAINGER Marks. The webpage associated with the Disputed Domain Name displays hyperlinks to third-party websites that offer similar products to the MRO products offered in connection with the GRAINGER Marks, and therefore, these third parties compete with Complainant.

5. Parties’ Contentions

A. Complainant

Complainant asserts that its GRAINGER Marks are famous by virtue of its use of the marks since 1928 and its ownership of trademark registrations for the GRAINGER Marks in at least 80 countries. As such, Complainant contends it has established rights in the GRAINGER Marks and that the Disputed Domain Name is confusingly similar thereto.

Complainant further asserts that Respondent lacks rights or legitimate interests in the Disputed Domain Name because Respondent has never used the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Specifically, Respondent is not using the Disputed Domain Name for a legitimate noncommercial or fair use and Respondent has never been commonly known by the Disputed Domain Name. Complainant states that, because the Disputed Domain Name resolves to a pay-per-click (“PPC”) website with links to various third party industrial supply websites that are in direct competition with Complainant, Respondent merely holds the Disputed Domain Name to capitalize on the goodwill of Complainant’s GRAINGER Marks.

Additionally, Complainant contends that Respondent was aware of Complainant’s rights in the GRAINGER Marks when it registered the Disputed Domain Name because the Disputed Domain Name incorporates Complainant’s GRAINGER mark and hosts a website that directs visitors to Complainant’s competitors. Complainant also states that it is not aware of any use of the GRAINGER mark or “graingerexpress” by a third party for use in connection with the provision of products to businesses. Complainant finds this lack of third party use to be further evidence of Respondent’s intent to attract Internet users for the purposes of commercial gain and disruption to Complainant’s business.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that Complainant's GRAINGER Marks establish that it has the exclusive rights to use the GRAINGER mark. The Panel further finds that, because the Disputed Domain Name incorporates Complainant's mark entirely, it is confusingly similar to Complainant's registered marks. Respondent's addition of the term "express" in the Disputed Domain Name does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

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

B. Rights or Legitimate Interests

Complainant has presented a *prima facie* case for Respondent's lack of rights or legitimate interests in the Disputed Domain Name, which Respondent has not rebutted. The Panel finds that Respondent has no rights or legitimate interests in the Disputed Domain Name as (i) Respondent is not licensed to use Complainant's GRAINGER Marks, (ii) Respondent is not affiliated or associated with Complainant, and (iii) Respondent had not made a *bona fide* use of the Disputed Domain Name. Specifically, the Disputed Domain Name resolves to a PPC advertising webpage featuring links for industrial supplies that compete with the products sold by Complainant under its GRAINGER Marks, Respondent is using the Disputed Domain Name to mislead consumers and derive a commercial benefit through the collection of click-through revenue. Therefore, Respondent is not making a *bona fide* use of the Disputed Domain Name. See [WIPO Overview 3.0](#), section 2.9; see also *Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#); and *SOCIÉTÉ DES PRODUITS NESTLÉ SA v. Mustafa Yakin/Moniker Privacy Services*, WIPO Case No. [D2008-0016](#).

Complainant has satisfied paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

The Panel finds that Respondent acquired the Disputed Domain Name fully aware of Complainant's rights. As Respondent has not denied Complainant's allegations or evidence regarding the worldwide recognition of the GRAINGER Marks, the Panel finds it more probable than not that Respondent knew of Complainant's GRAINGER mark when Respondent registered the Disputed Domain Name. As such, Respondent registered the Disputed Domain Name in bad faith. See *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) (bad faith is found where a domain name "is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith").

Additionally, Respondent has used the Disputed Domain Name in bad faith, specifically to direct Internet visitors to a PPC parking page featuring links to competitors, intentionally creating a likelihood of confusion with Complainant's trademark for Respondent's financial gain. See *Wayfair LLC v. Xiamen Privacy Protection Service Co., Ltd. / zhang qin*, WIPO Case No. [D2018-2032](#); see also *Wal-Mart Stores Inc. v. Frank Warmath*, WIPO Case No. [DTV2008-0013](#) ("When a domain name incorporating a famous mark is used to attract Internet traffic to fuel click-through revenues which trade on the reputation of that mark, a conclusion of bad faith registration and use under paragraph 4(a)(iii) of the Policy is unavoidable.").

In addition, two mail exchange ("MX") records have been activated for the Disputed Domain Name, thereby enabling emails to be sent and received using the Disputed Domain Name. A MX record is a resource record in the domain name system specifying which email server is responsible for accepting email on behalf of a domain name. It is not necessary to assign MX records to a domain name if the registrant does not intend to use the domain name to send and receive email. Activating the MX records to designate an email server and enable email is an action beyond mere registration of the Disputed Domain Name and may

support a finding of bad faith. See also *Equinor ASA v. Domains By Proxy, LLC / Name Redacted*, WIPO Case No. [D2021-2835](#); *Tetra Laval Holdings & Finance S.A. v. Himali Hewage*, WIPO Case No. [D2020-0472](#); and *Ares Management LLC v. juandaohanjing (上海锐思人力资源有限公司)*, WIPO Case No. [D2020-3254](#). See also [WIPO Overview 3.0](#), section 3.3.

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, <graingerexpress.com>, be transferred to Complainant.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: June 15, 2022