

## **ADMINISTRATIVE PANEL DECISION**

W.W. Grainger, Inc. v. Micheal Joe

Case No. D2023-4090

### **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 Micheal Joe, United States.

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

The disputed domain name <graingerInc.com> (the “Disputed Domain Name”) is registered with HOSTINGER operations, UAB (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2023. On October 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 3, 2023, 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 Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 the same day.

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 October 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 27, 2023.

The Center appointed Lynda M. Braun as the sole panelist in this matter on November 2, 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**

The Complainant is a publicly-traded company that has been in business for over 85 years, with more than 1.2 million products available, 354 branches, almost 24,000 employees worldwide, and over USD 11 billion in annual sales. The Complainant is North America's leading broad line supplier of maintenance, repair, and operating products. The Complainant also has operations in Asia, Europe, and Latin America.

The Complainant owns multiple trademark registrations for trademarks incorporating its famous GRAINGER trademark with the United States Patent and Trademark Office ("USPTO"). The most relevant trademarks to this proceeding are the Complainant's United States trademark registrations for the word mark GRAINGER (Registration Numbers 2,039,641, 1,747,557, 1,559,199, and 2,128,519) (registered on February 25, 1997, January 19, 1993, October 3, 1989, and January 13, 1998, respectively), and GRAINGER & Design (Registration Numbers 3,256,911, 3,256,912, 2,998,326, and 3,053,642) (registered on June 26, 2007, September 20, 2005, January 31, 2006, respectively). The Complainant also has trademark registrations for its GRAINGER trademark in at least 80 other jurisdictions worldwide.

The aforementioned trademarks will hereinafter collectively be referred to as the "GRAINGER Mark".

The Complainant owns the domain name <grainger.com>, which resolves to its primary consumer-facing website "www.grainger.com", on which the Complainant prominently uses its GRAINGER Mark and features general information regarding its products and services. The Complainant also owns the domain name <graingerinc.com>, which redirects to the Complainant's aforementioned primary website and has been registered since 2001. Based on the above information and evidence, the Complainant has established longstanding rights in its well-known GRAINGER Mark, which previous panels have recognized. See, e.g., *W.W. Grainger, Inc. v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-1627](#) ("Complainant's evidence establishes that it has longstanding and widespread repute in its GRAINGER trade and service marks").

The Disputed Domain Name was registered on September 11, 2023, long after the Complainant registered its GRAINGER Mark. The Disputed Domain Name redirects to the Complainant's primary website at "www.grainger.com". The Respondent also used the Disputed Domain Name to fraudulently send emails to the Complainant's suppliers by impersonating the Complainant's Senior Vice President and Chief Financial Officer, requesting purportedly overdue payments on the Complainant's account.

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

##### **A. Complainant**

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's GRAINGER Mark.
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.
- the Disputed Domain Name was registered and is being used in bad faith.
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent in accordance with paragraph 4(i) of the Policy.

## B. Respondent

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove the following three elements in order to prevail in this proceeding:

- (i) the Disputed Domain Name is identical or confusingly similar to trademarks or service marks 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 was registered and is being used in bad faith.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the GRAINGER Mark.

It is uncontroverted that the Complainant has established rights in the GRAINGER Mark based on its decades of use as well as its registered trademarks for the GRAINGER Mark before the USPTO and worldwide. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the GRAINGER Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel concludes that the Complainant has rights in the GRAINGER Mark.

The Disputed Domain Name consists of the entirety of the GRAINGER Mark followed by a misspelling of the term "Inc" which is part of the corporate name of the Complainant, and then followed by the generic Top-Level Domain ("gTLD") ".com". The Disputed Domain Name misspells "Inc" by substituting the lower case letter "L" for the upper case letter "I" in "Inc.", creating a domain name that is confusingly similar to the Complainant's GRAINGER Mark. Notably, the lower case letter "L" is nearly identical to the upper case letter "I" in the Complainant's corporate name as well as to the Complainant's domain name <graingerinc.com> and the lower case letter "L" was undoubtedly chosen for exactly this reason.

Such a minor modification to a disputed domain name is commonly referred to as "typosquatting" and seeks to wrongfully take advantage of errors by a user in typing a domain name into a web browser. The misspelling of the term "Inc" following the GRAINGER Mark does not prevent a finding of confusing similarity to the GRAINGER Mark. See [WIPO Overview 3.0](#), section 1.9 ("A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element"); see also *Express Scripts, Inc. v. Whois Privacy Protection Service, Inc. / Domaindeals, Domain Administrator*, WIPO Case No. [D2008-1302](#); *Singapore Press Holdings Limited v. Leong Meng Yew*, WIPO Case No. [D2009-1080](#).

Further, it is well established that a domain name that wholly incorporates a trademark – even a misspelling of the term following the trademark – may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of such a term. As stated in section 1.8 of [WIPO Overview 3.0](#),

“where the relevant trademark is recognizable within the disputed domain name, the addition of other terms [...] would not prevent a finding of confusing similarity under the first element”. For example, numerous UDRP decisions have reiterated that the addition of a dictionary or descriptive term to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

## **B. Rights or Legitimate Interests**

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant's *prima facie* case. Furthermore, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its GRAINGER Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c).

The Respondent used emails created from the Disputed Domain Name to impersonate the Complainant's Senior Vice President and Chief Financial Officer. Such fraudulent emails were sent to the Complainant's suppliers, requesting purportedly overdue payments owed to the Complainant.

Such use of the Disputed Domain Name to impersonate the Complainant and perpetuate a fraud scheme does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”). See also *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) (finding that the respondent had no rights or legitimate interests in the disputed domain name, holding that “such phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name”).

In sum, the Panel concludes that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Panel finds that the Respondent is using the Disputed Domain Name for commercial gain with the intent to mislead by potentially defrauding the Complainant's suppliers by incorporating the Disputed Domain Name into emails sent by the Respondent to those suppliers in the name of the Complainant's Senior Vice President and Chief Financial Officer. Such use cannot conceivably constitute a *bona fide* offering of a product or service within the meaning of paragraph 4(c)(i) of the Policy.

Moreover, the Respondent also redirected the Disputed Domain name to the Complainant's own website to create the appearance of legitimacy for its fraudulent impersonation of the Complainant's officer. Since the Disputed Domain Name redirected to the Complainant's website, the Respondent's use of the Disputed Domain Name to redirect Internet traffic to the Complainant's own website does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain name. See, e.g., *MySpace, Inc. v. Mari Gomez*, WIPO Case No. [D2007-1231](#) (holding that the respondent's use of the disputed domain name to redirect Internet users to the Complainant's own website where the Respondent was not authorized to use the Complainant's mark in this way is inherently misleading and cannot give rise to a right or legitimate interest in the disputed domain name).

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

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

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

First, the Respondent's scheme to impersonate the email of the Complainant's Senior Vice President and Chief Financial Officer so as to appear to come from the Complainant, evidences a clear intent to disrupt the Complainant's business, deceive individuals, and trade off the Complainant's goodwill by creating an unauthorized association between the Respondent and the Complainant's GRAINGER Mark. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). Such conduct is emblematic of the Respondent's bad faith registration and use of the Disputed Domain Name. Numerous UDRP panels have found that email-based fraud schemes that use a complainant's trademark in the disputed domain name are evidence of bad faith. See, e.g., *BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#) (“[T]he use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.”).

Second, the registration of a domain name that is confusingly similar to a registered trademark by an entity that has no relationship to that mark may be sufficient evidence of opportunistic bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) (use of a name connected with such a well-known service and product by someone with no connection to the service and product suggests opportunistic bad faith). Based on the circumstances here, the Respondent registered and used the Disputed Domain Name in bad faith in an attempt to create a likelihood of confusion with the Complainant's GRAINGER Mark.

Third, the Panel finds that the Respondent had actual knowledge of the Complainant's GRAINGER Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the Respondent's almost identical Disputed Domain Name to the Complainant's Mark and domain name, it strains credulity to believe that the Respondent had not known of the Complainant or its GRAINGER Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its GRAINGER Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name was intended to cause confusion with the Complainant's GRAINGER Mark and to disrupt the Complainant's business. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith.

Fourth, the use of a domain name incorporating a trademark by an unauthorized third party to redirect Internet users to a complainant's website is evidence of bad faith under paragraph 4(b)(iv) of the Policy. See [WIPO Overview 3.0](#), section 3.1.4 (“Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: ... redirecting the domain name to the complainant's website....”).

Finally, the Disputed Domain Name contains a misspelling of the term “Inc” that follows the GRAINGER Mark in the Disputed Domain Name in an attempt to deceive Internet users. Such misspelling is evidence of bad faith registration and use. See *Nutricia International BV v. Eric Starling*, WIPO Case No. [D2015-0773](#). The Panel concludes that the Respondent knew about the Complainant’s rights in the GRAINGER Mark when it registered the Disputed Domain Name, since it misspelled the term “Inc” in the Disputed Domain Name by substituting the lower case letter “L” for the letter upper case letter “i” to misdirect users to the Complainant’s primary website by capitalizing on typing mistakes made by users. See *ESPN, Inc. v. XC2*, WIPO Case No. [D2005-0444](#) (“It is well-settled that the practice of typosquatting, of itself, is evidence of the bad faith registration of a domain name.”).

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## 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, <graingerInc.com>, be transferred to the Complainant.

*/Lynda M. Braun/*

**Lynda M. Braun**

Sole Panelist

Date: November 14, 2023