

ADMINISTRATIVE PANEL DECISION

W.W. Grainger, Inc. v. Wan Jun
Case No. D2024-3159

1. The Parties

The Complainant is W.W. Grainger, Inc., United States of America, represented by Greenberg Traurig, LLP, United States of America.

The Respondent is Wan Jun, China.

2. The Domain Name and Registrar

The disputed domain name <grainger-supply.com> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 31, 2024. On August 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 5, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2024.

The Center appointed Michael D. Cover as the sole panelist in this matter on September 3, 2024. 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 on the New York and Chicago Stock Exchanges under the symbol GWW. The Complainant has been in business for over 85 years and has range of 1.2 million products, 354 branches, 24,000 employees worldwide, and over USD11 billion in annual sales.

The Complainant is a leading broad line supplier of maintenance, repair, and operating (MRO) products and has operations in the USA, Asia, Europe, and Latin America. The Complainant operates its principal website at "www.grainger.com".

The Complainant is the proprietor of certain registered trademarks in China, including the following:

No. 3808738 GRAINGER registered on December 21, 2005;

No. 1122583 GRAINGER registered on October 28, 1997;

No. 7001513 GRAINGER (and Chinese language version) registered on August 28, 2010.

The Complainant is also the proprietor of registered trademarks for its GRAINGER in at least 80 other countries.

The Complainant has used its GRAINGER trademark since at least as early as 1928.

All that is known about the Respondent is the information disclosed by the Registrar since the Respondent did not participate in this proceeding.

The Disputed Domain Name was registered on January 11, 2024. The Disputed Domain Name resolves to a website which displays the Complainant's GRAINGER trademark and which states "At Grainger, we are the leading supplier of industrial supplies ranging from power tools, fasteners, safety gear, lighting and janitorial items. Our massive product catalog features over 1 million items trusted by businesses small and large across all industries".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Identical or Confusingly Similar

Notably, the Complainant notes that the Disputed Domain Name incorporates the Complainant's GRAINGER trademark, changing the trademark only by adding a hyphen, the generic term "supply" and the generic Top-Level Domain ("gTLD") ".com". The Complainant contends that numerous UDRP panels have found that mere additions of a gTLD and generic terms to a complainant's trademark fails to produce a domain name distinct from a complainant's trademark, especially when the generic terms added describe or are associated with the Complainant's business, as the case in this instance. The Complainant submits that the addition of the term "supply" to the Complainant's GRAINGER trademark does not distinguish the Disputed Domain Name but instead actually increases the likelihood of confusion, based on the direct association of that word with the Complainant's online and retail sales of industrial supplies.

The Complainant concludes that, in the light of the foregoing, pursuant to Section 4(a)(i) of the Policy, the Disputed Domain Name is confusingly similar to the Complainant's GRAINGER trademark and its domain name <grainger.com>.

Rights or Legitimate Interests

Long after the Complainant established rights in the Complainant's GRAINGER trademark, the Respondent registered the Disputed Domain Name, without the Complainant's authorization or consent. The Complainant submits that the Respondent is not commonly known by the Disputed Domain Name, has not used or prepared to use the Disputed Domain Name in connection with a bona fide offering of goods or services and has not authorized, licensed or otherwise permitted the Respondent to register and/or use the Disputed Domain Name. As such, says the Respondent clearly lacks rights to and legitimate interests in the Disputed Domain Name, pursuant to the Policy 4(a)(ii) and Policy 4(c).

The Complainant submits that what it describes as "impostor website", to which the Disputed Domain Name resolves is used to engage in fraudulent transactions with consumers and charge consumers for products they will never receive or steal the personal or financial information of consumers.

The Complainant submits that numerous Panels have concluded that the use of a disputed domain name to impersonate a complainant in furtherance of fraud establishes that a respondent has no rights or legitimate interests in a disputed domain name,

The Complainant concludes that, based on the foregoing, it is obvious that the Respondent lacks rights or legitimate interests in the Disputed Domain Name within the meaning of the Policy 4(a)(ii).

Registered and being Used in Bad Faith

The Complainant submits that, as the facts set forth reveal, the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Complainant submits that the use of Disputed Domain Name for what is it calls an "impostor Website", passing itself off as the Complainant's website or a website sponsored by the Complainant and that such activities fall squarely into the explicit example of bad faith registration and use found in the Policy at 4(b)(iv). The Complainant submits that use of the Disputed Domain Name by the Respondent to pretend that it is associated with the Complainant brings the Respondent within the provisions of Paragraph 4(b)(iii) of the Policy, as this shows that the Respondent registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor, namely the Complainant.

The Respondent also submits that the Respondent was clearly aware of the Complainant's GRAINGER trademark, when the Respondent registered the Disputed Domain Name and that the Respondent had both actual and constructive knowledge of the Complainant's GRAINGER trademark, because of the Complainant's registration of its GRAINGER trademark.

For all the reasons set out above, the Complainant concludes that the Respondent's conduct undoubtedly constitutes bad faith registration and used of the Disputed Domain Name under the Policy 4(b)(iv).

The Remedy requested by the Complainant

The Complainant requests that the Panel order that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of its GRAINGER trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The entirety of the trademark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the Complainant's GRAINGER trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "supply", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's GRAINGER trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is well-established practice in UDRP jurisprudence to ignore the applicable gTLD when it does not form part of the relevant trademark for comparison purposes. Thus, the ".com" gTLD has no impact on the Panel's assessment of confusing similarity. [WIPO Overview 3.0](#), section 1.11.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the Complainant, Panels have recognized that proving a respondent lacks rights or legitimate interests in a disputed domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a disputed domain name for illegal activity, as applicable to this case, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. Given the composition of the disputed domain name, there is a risk of implied affiliation to the Complainant, contrary to the fact, and while the added term "supply" may

indicate a supplier or distributor, the website content to which the disputed domain name resolves clearly seeks to impersonate the Complainant given the repetitious use of the Complainant's trademark and the lack of any disclaimer as to the website's lack of association with the Complainant. As the Complainant states, it is more likely than not that the disputed domain name is being used to fraudulently obtain personal or payment information from unsuspecting Internet users expecting to be interacting with the Complainant at the disputed domain name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's GRAINGER trademark and to disrupt the business of a competitor, the Complainant.

Panels have held that the use of a domain name for illegal activity, here, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <grainger-supply.com> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: September 25, 2024