

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Zoom Token, Edward Miller, EdMiller Constructions
Case No. D2022-3125

1. The Parties

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

The Respondents are Zoom Token, India, and Edward Miller, EdMiller Constructions, United States.

2. The Domain Names and Registrars

The disputed domain name <walgreentoken.com> is registered with GoDaddy.com, LLC, and the disputed domain name <walgreentoken.site> is registered with NameCheap, Inc. (collectively the "Registrars"). In this decision, the disputed domain names are collectively referred to as the "Domain Names".

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 24, 2022. On August 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On August 25 and August 26, 2022, the Registrars transmitted by email to the Center the verification responses disclosing registrant and contact information for the Domain Names which differed from the named Respondents (Domains By Proxy, LLC, and Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 26, 2022 with the registrant and contact information of the nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaints for the Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amendment to the Complaint on September 1, 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 the Respondents of the Complaint, and the proceedings commenced on October 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 25, 2022. The Respondents did not submit any response.

Accordingly, the Center notified the Respondents' default on October 28, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on July 12, 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 leading retail pharmacy chain in the United States, operating approximately 9,000 retail stores employing more than 240,000 people who collectively fill 1.2 billion prescriptions per month. The Complainant and its predecessors in title has provided these services under the trade mark WALGREEN(S) since 1901.

The Complainant is the owner of multiple trade mark registrations for the word mark WALGREENS (the "WALGREENS Mark"), including a United States trade mark registered on January 25, 1977 with a first use in commerce of 1971 for services in class 42 (registration number 1057249).

The Domain Names were registered on April 5, 2022 and June 11, 2022 respectively and prior to the commencement of the proceeding the Domain Names each resolved to a website ("the Respondents' Website") prominently featuring the Complainant's WALGREENS Mark and W Logo and purported to offer sales of a "Walgreens Token", an apparent cryptocurrency.

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 Domain Names.

Notably, the Complainant contends that;

- a) It is the owner of the WALGREENS Mark, having registered the WALGREENS Mark in the United States. The Domain Names are each confusingly similar to the WALGREENS Mark as they reproduce the WALGREENS Mark, delete the letter "s" to create a minor misspelling, then add the descriptive term "token" and a top-level domain ("TLD") which do not distinguish the Domain Names from the WALGREENS Mark.
- b) There are no rights or legitimate interests held by the Respondents in respect of the Domain Names. The Complainant has not granted any license or authorization for the Respondents to use the WALGREENS Mark. The Respondents are not commonly known by the WALGREENS Mark, nor do they use the Domain Names for a *bona fide* purpose or legitimate noncommercial purpose. Rather the Respondents have used the Domain Names to impersonate the Complainant for the purpose of operating a cryptocurrency scheme to target users aware of the Complainant, such use not being *bona fide*.
- c) The Domain Names were registered and are being used in bad faith. There are no plausible circumstances under which the Respondents could legitimately use the Domain Names, which combine a minor misspelling of the WALGREENS Mark and the term "token", other than in bad faith. The Domain Names are being used to impersonate the Complainant for the purposes of commercial gain, which amounts to use of the Domain Names in bad faith.

B. Respondents

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

6. Discussion and Findings

6.1. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The registrants of the Domain Names did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that the Domain Names consist of identical elements (other than the TLD), were registered within a three-month period of each other and resolve to what are identical websites. It would be implausible for two unconnected entities to register domain names consisting of such an unusual combination of words and have them resolve to an identical and unique website. As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party. Finally, the Panel notes that neither of the named registrants have denied any association with the other or objected to the consolidation of the proceedings requested by the Complainant.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.2. Substantive Issues

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 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the WALGREENS Mark is recognizable within the Domain Names. Accordingly, the Domain Names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "token" may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the Domain Names and the WALGREENS Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, 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.

While 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 domain name may result in the often impossible 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. 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names. 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 Domain Names.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Names. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Names.

The Respondent has used the Domain Names to impersonate the Complainant (by the use of the WALGREENS Mark and W logo) for the purposes of advertising its (likely fictitious) Walgreens cryptocurrency. Such conduct, involving the representation that the Respondent’s Website is in some way connected to the Complainant, does not, on its face, amount to the use of the Domain Names for a *bona fide* offering of goods or services.

Based on the available record, 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.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

The Panel finds that the Respondent must have been aware of the Complainant and its reputation in the WALGREENS Mark at the time the Respondent registered the Domain Names. The Respondent has provided no explanation, and neither it is immediately obvious, why an entity would register two domain names incorporating a minor misspelling of the WALGREENS Mark (with the addition of the term “token”) and direct them to a website that reproduces the WALGREENS Mark and related W logo unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its WALGREENS Mark.

The Respondent has used the Domain Names, being confusingly similar to the WALGREENS Mark, to attract visitors to its website where it passes off as the Complainant in order to offer what purport to be Walgreens cryptocurrency products, under the Complainant’s marks. Such an action satisfies the requirements of Paragraph 4(b)(iv) of the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 Domain Names, <walgreentoken.com> and <walgreentoken.site>, be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: July 17, 2023