

ADMINISTRATIVE PANEL DECISION

W.W. Grainger, Inc. v. FCE Domains Team

Case No. DCO2023-0047

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 FCE Domains Team, United States of America.

2. The Domain Name and Registrar

The disputed domain name <graingertotalrewards.co> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2023. On May 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 10, 2023, 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 May 12, 2023.

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 May 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 7, 2023.

The Center appointed Angela Fox as the sole panelist in this matter on June 16, 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 on the New York and Chicago Stock Exchanges, based in Illinois but trading worldwide. It is a supplier of maintenance, repair, and operating products for companies, including safety and security equipment, lighting and electrical equipment, tools and test instruments, and cleaning and janitorial equipment. It has been in business for over 85 years and has 353 branches and over 26,000 employees worldwide, and over USD 15.2 billion in annual sales. The Complainant carries out its business under the name and trademark GRAINGER.

The Complainant operates an online employee benefits program for its employees under the name “Grainger Total Rewards”, which is accessed at the “Grainger Total Rewards Portal” located at the Complainant’s website “www.graingertotalrewards.com”.

The Complainant is the owner of numerous trademark registrations in the United States and in other countries for GRAINGER and marks including GRAINGER, including the following, details of which were annexed to the Complaint:

- United States Trademark Registration No. 2,039,641 for GRAINGER in Class 9 registered on February 25, 1997
- United States Trademark Registration No. 1,747,557 for GRAINGER in Class 42 registered on January 19, 1993
- United States Trademark Registration No. 1,559,199 for GRAINGER in Class 35 registered on October 3, 1989

The disputed domain name was registered on December 22, 2022. It is in use to host what appear to be pay-per-click links entitled “Employee Rewards Catalog”, “Employee Benefits”, and “Employee Rewards”. The Complainant annexed evidence to the Complaint showing that clicking on one of these links leads to malware being installed on the user’s computer.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to its registered GRAINGER trademarks, and to its domain names “grainger.com” and “graingertotalrewards.com”. The disputed domain name differs from the Complainant’s GRAINGER Mark only by the generic terms “total” and “rewards,” and by the Top-Level Domain (“TLD”) “.co”, which the Complainant submits can be disregarded for the purpose of the comparison with the Complainant’s marks. The disputed domain name is also virtually identical to the domain name used to host the Complainant’s Grainger Total Rewards Portal, namely “graingertotalrewards.com”.

The Complainant also submits that the Respondent has no rights or legitimate interests in the disputed domain name. 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 been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name. To the Complainant’s knowledge, there are no prior trademark applications or registrations in the name of Respondent for any mark incorporating GRAINGER anywhere in the world. The Respondent has never operated any *bona fide* or legitimate business under the disputed domain name, and is not making a protected noncommercial or fair use of it. Instead, the Respondent is using the disputed

domain name to divert Internet traffic to a variety of websites to generate revenue including at least one website which attempts to download malware onto the user's computer.

Finally, the Complainant argues that the disputed domain name was registered and has been used in bad faith. The Respondent registered the disputed domain name long after the Complainant began to use its GRAINGER trademark, and did so in the knowledge of the Complainant and with the intention of diverting Internet traffic intended for the Complainant, including to a variety of websites to generate revenue including at least one website which attempts to download malware onto the user's computer. The Complainant submits that the Respondent has used the disputed domain name to intentionally attempt to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website.

B. Respondent

The Respondent did not reply to the Complainant's contentions and is in default. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14 (a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences as it considers appropriate from the Respondent's default.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

A. Identical or Confusingly Similar

The Complainant has proved that it has registered trademark rights in GRAINGER. The disputed domain name includes GRAINGER in its entirety, followed only by "totalrewards" and the country code Top-Level Domain ("ccTLD") ".co". The "totalrewards" portion of the domain name is likely to be understood descriptively, and as noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)"), at section 1.11.1, the Top-Level Domain suffix is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has provided evidence that the disputed domain name has been used for a website hosting links to employee rewards-related topics, at least one of which leads to the installation of malware on a user's computer.

[WIPO Overview 3.0](#), section 2.13.1 states, “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”.

The Panel finds that the Complainant has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant has been trading under the GRAINGER name since before the disputed domain name was registered, and its registered trademark rights long pre-date the registration of the disputed domain name.

The Complainant has, moreover, shown evidence that it has been using the nearly identical domain name <graingertotalrewards.com> to host content for its own employee rewards program since prior to registration of the disputed domain name.

Against this backdrop, and taking into account the employee reward-related links at the disputed domain name, the inescapable conclusion is that the Respondent registered the disputed domain name with the knowledge of the Complainant’s GRAINGER trademark and with the intention of masquerading as the Complainant to attract Internet users to its website under the false impression that they were in fact visiting the website of the Complainant’s GRAINGER employee rewards program. Such activities entitle the Panel to find bad faith registration and use under para 4(b)(iv) of the Policy.

In addition, [WIPO Overview 3.0](#), section 3.4, states that “Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution”. While the disputed domain name ultimately hosts the above-mentioned pay-per-click content, the evidence presented has shown that at least one of those links also seeks to install malware on Internet users’ computers.

Taking all of the above into account, the Panel finds that the disputed domain name was registered and has been used in bad faith.

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, <graingertotalrewards.co>, be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: July 13, 2023