

ADMINISTRATIVE PANEL DECISION

W.W. Grainger, Inc. v. shi lei

Case No. D2023-3036

1. The Parties

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

The Respondent is shi lei, China.

2. The Domain Name and Registrar

The disputed domain name <graingertotalreward.com> 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 July 14, 2023. On July 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 17, 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 July 18, 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 July 19, 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 July 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on August 28, 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 in business for many decades and according to the Complaint, it is a leading broad line supplier of maintenance, repair, and operating products.

The Complainant owns various trademark registrations for the mark GRAINGER around the world, *inter alia*

- US word mark registrations, Registration No 1,559,199, registered October 3, 1989 and Registration No 1,747,557, registered January 19, 1993;
- European Union word mark registration, Registration No 220103, registered April 8, 1999;
- United Kingdom trademark registrations, Registration No 2067557, registered August 29, 1997 and Registration No UK00900220103, registered April 8, 1999;
- China trademark registration, Registration No 1122583, registered October 28, 1997 (Annexes 8 and 9 to the Complaint).

The Complainant moreover operates its primary website under the domain name <grainger.com> (Annex 6 to the Complaint). It also owns the domain name <graingertotalrewards.com> which redirects to an online portal for employees of the Complainant to access their benefits (Annex 7 to the Complaint).

The disputed domain name was registered on March 3, 2018 (Annex 4 to the Complaint).

The Complainant claims that at the time of filing the Complaint, the disputed domain name resolved to a website which purported to display notifications stating that malware has been detected on the visitor's computer (Annex 10 to the Complaint). Currently, the disputed domain name resolves to a website with sponsored links *inter alia* in connection with an employee benefits program (Panelist's Internet visit, September 2, 2023). Moreover, the disputed domain name has an active MX (mail exchange) records, as shown in an MX records lookup (Annex 11 to the Complaint).

The Respondent was involved in several UDRP cases as respondent, ending with a transfer decision under the Policy and Rules (Annex 12 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant is a publicly traded company on the New York and Chicago Stock Exchanges. It has been in business for over 85 years, and with more than 30 million products available globally, 354 branches, more than 26,000 employees and 4.5 million customers worldwide, and over USD 15.2 billion in annual sales in 2022; according to the Complaint, the Complainant is North America's leading broad line supplier of maintenance, repair and operating (MRO) products. The Complainant also has operations in Asia, Europe and Latin America and addresses its primary website under the domain name <grainger.com>.

The Complainant uses a well-known employee benefits company to operate an online portal for its employees (called "Grainger Total Rewards Portal") to access their benefits. The Grainger Total Rewards Portal is located on the domain name <graingertotalrewards.com>.

The Complainant owns numerous trademark registrations for its famous GRAINGER mark in the US and around the world, also in China where the Respondent is purportedly located.

The disputed domain name incorporates the Complainant's mark in full, specifically the GRAINGER mark, changing the mark only by adding the terms "total" and "reward", which directly describe the Complainant's "total rewards" benefits given to employees, and then the generic Top-Level domain ("gTLD") ".com" after the mark. Further, the disputed domain name is also virtually identical to the Complainant's domain name <graingertotalrewards.com> – it only omits the "s".

The fact that the disputed domain name wholly incorporates the Complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy. The addition of the terms "total" and "reward" to the Complainant's GRAINGER mark does not distinguish the disputed domain name but instead actually increase the likelihood of confusion based on the direct association of those words with the Complainant's employment benefits.

Further, the Respondent has no rights or legitimate interests in respect of the disputed domain name:

Without the Complainant's authorization or consent, the Respondent registered the disputed domain name which misappropriates and is confusingly similar to the Complainant's GRAINGER mark.

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.

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 fraudulent website, which purports to display notifications from Microsoft stating that malware has been detected on the visitor's computer in an attempt to trick the visitor into clicking a button which will actually install malware on the visitor's computer.

Finally, the disputed domain name was registered and is being used in bad faith:

Long after the Complainant established its rights in its famous GRAINGER mark, and with knowledge of the Complainant's GRAINGER mark, the Respondent registered the confusingly similar disputed domain name to divert Internet traffic to deceptive offers to download malware for the Respondent's commercial gain.

The Respondent is using the confusingly similar disputed domain name to intentionally attract Internet users to the Respondent's fraudulent website to install malware on their computers for the purposes of commercial gain, causing disruption of the Complainant's business and creating a likelihood of confusion regarding source, sponsorship, affiliation, or endorsement.

Moreover, there are numerous prior UDRP panel decisions under the Policy against the Respondent where the Respondent registered and used in bad faith domain names incorporating famous and well-known marks – also this fact supports a finding of bad faith under the Policy.

Additionally, the disputed domain name has active MX records, as shown in an MX records lookup. Those active MX records indicate a use for email, which evidences a likelihood of additional bad-faith use of the disputed domain name to engage in fraudulent email or phishing communications.

Finally, the Respondent used a proxy service for registering the disputed domain name to shield its identity and elude enforcement efforts by the legitimate trademark owner demonstrates the Respondent's bad faith use and registration of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) 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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

In the case at issue, the Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark GRAINGER.

The disputed domain name is confusingly similar to the GRAINGER mark in which the Complainant has rights since the Complainant's GRAINGER mark is clearly recognizable in the disputed domain name. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

This is the case at hand, the addition of the terms "total" and "reward" in the disputed domain name does not prevent a finding of confusing similarity.

Finally, it has also long been held that gTLDs are generally disregarded when evaluating the confusing similarity under the first element (see section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's distinctive mark in its entirety together with the terms "total" and "reward" cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)). This is especially the case at hand, because the Complainant provides an online portal for its employees under the domain name <graingertotalrewards.com> where they can access their benefits.

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g., *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated.

(i) In the present case, the Complainant has rights and is the owner of the well-known and distinctive registered trademark GRAINGER, which is registered and used in many jurisdictions around the world for decades. Moreover, the Complainant registered and is using the domain name <grainger.com> for its primary website and the domain name <graingertotalrewards.com> for addressing an online portal for the Complainant's employees to access their employee benefits.

Further, the Complainant has a strong Internet and social media presence with its GRAINGER mark.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive trademark GRAINGER entirely together with terms which refer to the Complainant's employee benefits program/service.

Furthermore, the Respondent has engaged in a pattern of multiple trademark-abusive domain name registrations corresponding to distinct marks of individual brand owners which supports the finding that the disputed domain name was registered in bad faith by the Respondent. Indeed, the Complainant provided evidence on record that the Respondent was involved in several UDRP cases as respondent, ending with a transfer decision under the Policy and Rules (Annex 15 to the Complaint).

(ii) The disputed domain name is also being used in bad faith. According to the evidence on record and the Panelist's Internet visit, the disputed domain name resolves to a website with sponsored links *inter alia* in connection with an employee benefits program (or has in the past flagged malware). Further, the disputed domain name has an active MX (mail exchange) records, as shown in an MX records lookup (Annex 11 to the Complaint), which indicates a use for email-services.

Moreover, this Panel concludes that the disputed domain name is being used in bad faith, putting emphasis on the following:

- the Complainant's trademark GRAINGER is well-known globally, distinctive and has a strong Internet presence;
- the Complainant provides for its employees an employee benefit portal under the domain name <graingertotalrewards.com>; the disputed domain name resolves to a website, where there are sponsored links in connection with employee benefits programs and refers to an identical service;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;

- the disputed domain name incorporates the Complainant's trademark in its entirety, and is thus suited to divert or mislead potential web users (especially employees) from the website they are actually trying to visit (the Complainant's "total reward" site);
- the disputed domain names moreover contain suffixes which refer to the "total reward" service of the Complainant for its employees;
- the Respondent was engaged in a pattern of multiple trademark-abusive domain name registrations corresponding to distinct marks of individual brand owners ending with a transfer decision under the Policy and Rules; and
- there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

Taking all these aspects and evidence on record into consideration and the fact that the Respondent failed to respond to the Complaint further supports the finding that the disputed domain name has been registered and is being used in bad faith under 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 <graingertotalreward.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: September 11, 2023