

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Janice Park
Case No. D2023-3937

1. The Parties

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

The Respondent is Janice Park, United States.

2. The Domain Name and Registrar

The disputed domain name <callwalgreens.com> (“Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 7, 2023. On September 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 September 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent the Center an informal communication by email on September 25, 2023. The Complainant filed an Amended Complaint on September 27, 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 October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023.

The Center appointed A. Justin Ourso III as the panelist in this matter on October 30, 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.

After appointment of the Panel, the Respondent sent the Center two additional informal communications by email, both on October 31, 2023.

4. Factual Background

The Complainant, an American company, operates the well-known “Walgreens” retail pharmacy chain throughout the United States and certain of its territories.

The Complainant owns a United States registration for its WALGREENS trademark, issued on September 16, 1997, with a first use in Class 42 since 1900 for “pharmacy and retail store services,” and for various goods in seven other classes; a United States registration for its WALGREENS trademark, issued on January 25, 1977, with a first use in Class 42 since 1971 for “storage and retrieval of pharmaceutical prescription data”; and a United States registration for its 1-800-WALGREENS trademark, issued on November 18, 1997, with a first use in Class 42 since 1995 for “providing 24-hour retail store and prescription drug information and services by telephone,” among others, including international registrations.

The Complainant is the registrant for the domain name <walgreens.com>, which it registered on May 4, 1995, and which consists of its WALGREENS trademark and the “.com” generic Top-Level Domain (“gTLD”).

The Respondent registered the Domain Name on March 15, 2023, without any authorization from the Complainant. Prior to the filing of the Complaint, the Domain Name resolved to a website parked with the Registrar and employing pay-per-click (“PPC”) advertising that included links to pharmacy services, among other services. During the preparation of this Decision, the Domain Name did not resolve to an active, functioning website. Attempts to visit the site resulted in a browser message stating that “The connection for this site is not secure” and “www.callwalgreens.com sent an invalid response.”

5. Parties’ Contentions

A. Complainant

In addition to facts set forth in the Factual Background in Part 4 above, the Complainant contends the following.

On the element of confusing similarity with a trademark in which it has rights, the Complainant contends that it owns national and international trademark registrations for its WALGREENS trademark and, therefore, has established trademark rights under the Policy; the Domain Name fully incorporates its mark, with the addition of the word “call” in front of the mark; the Domain Name is confusingly similar to its mark; the addition of the word “call” enhances confusion because the Complainant offers a telephone number corresponding to its federally registered 1-800-WALGREENS mark to service customer queries.

On the element of rights or legitimate interests in the Domain Name, the Complainant contends that it has not licensed or otherwise authorized the Respondent to use its trademark; the Respondent registered the Domain Name long after the Complainant registered its WALGREENS trademarks; the Respondent targeted the Complainant by including the word “call” in the Domain Name to suggest affiliation and access to the Complainant’s services; the Domain name does not reflect the Respondent’s common name; the Domain Name resolves to a parked webpage featuring third-party PPC links to websites offering competing services; the Respondent is monetizing the Domain Name by trading on the goodwill in the Complainant’s marks to draw Internet users to its parked webpage and generate click-through revenue, which is not a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use; no intent can exist for using the

Domain Name that would not trade on the reputation in the Complainant's mark; and, the Complainant has established that the Respondent lacks rights or legitimate interests in the Domain Names.

On the element of bad faith registration and use of the Domain Name, the Complainant contends that the Respondent is using the Domain Name to attract Internet users to its website with third-party links to pharmacy services that generate click-through revenue, unfairly trading on the goodwill in its mark and disrupting the Complainant's business by diverting customers and prospective customers away from the Complainant and in opposition to the Complainant in violation of the Policy, paragraph 4(b)(iii); the same conduct is intended to obtain commercial gain by creating a likelihood of confusion with the Complainant's marks in violation of the Policy, paragraph 4(b)(iv); the fame of the mark is such that the Respondent could be unaware of the mark, and, accordingly, the Respondent registered and is using the Domain Name in bad faith.

The Complainant requested transfer of the Domain Name.

B. Respondent

The Respondent sent three email communications to the Center - two after the response deadline. These communications did not respond to the Amended Complaint or address any of the allegations in the Amended Complaint in accordance with the Rules. One of the communications stated, in part: "I have no objection to losing the domain."

6. Discussion and Findings

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a). While the Respondent's email above could be seen as a consent to transfer, the Panel will address the substantive elements of the Policy for completeness.

A. Identical or Confusingly Similar

On the first element, the Panel finds that the Domain Name is confusingly similar to the Complainant's WALGREENS trademark. The Domain Name incorporates the trademark in its entirety, and the trademark is readily recognizable within the Domain Name, notwithstanding the addition of the word "call" in front of the mark. The word "call" affirms confusing similarity, because the Complainant offers a telephone number corresponding to its federally registered 1-800-WALGREENS mark to service customer queries. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.8. Accordingly, the Panel concludes that the Complainant has proven the first element: the Domain Name is confusingly similar to a trademark in which it has rights.

B. Rights or Legitimate Interests

The Respondent has not claimed the existence of any circumstance under the Policy, paragraph 4(c), that demonstrates that a respondent has rights to, or legitimate interests in, a domain name. It has instead stated "I have no objection to losing the domain." The Complainant, on the other hand, has shown that it established its trademark rights before the Respondent registered the Domain Name; it has not authorized the Respondent to use its trademark; and no evidence exists that the Respondent is known by the Domain Name. These constitute *prima facie* a showing that the Respondent lacks any rights or legitimate interests in the Domain Name under the Policy, paragraph 4(a)(ii), shifting the burden of production on this second element to the Respondent to come forward with relevant evidence proving rights or legitimate interests in the Domain Name. [WIPO Overview 3.0](#), section 2.1. The Respondent has not submitted any evidence to rebut the *prima facie* showing.

Additionally, the Panel finds that the Respondent masked its identity by using a privacy service; the Registrant's name and email address do not resemble the Domain Name, which corroborates that the Respondent is not known by the Domain Name; prior to the filing of the Complaint, the Domain Name resolved to a website parked with the Registrar employing PPC advertising that included links to competing pharmacy services, among other services, which is not a *bona fide* use; at present the, the Domain Name does not resolve to an active, functioning website, which is obviously not a *bona fide* offering of goods or services nor a legitimate noncommercial use or a fair use of the Domain Name; and the Respondent failed to provide any evidence of a planned *bona fide* commercial use, a noncommercial use, or a fair use of the Domain Name. [WIPO Overview 3.0](#), sections 2.2, 2.3, 2.4, 2.5, and 2.9. Accordingly, the Panel concludes that the Complainant has proven the second element: the Respondent lacks rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar to a well-known trademark, particularly where a respondent adds a term related to the trademark, can create a presumption of bad faith registration. [WIPO Overview 3.0](#), section 3.1.4. The Respondent has not rebutted this presumption. The Complainant used and registered its well-known mark long before the Domain Name registration. The Panel finds that the Respondent must have been aware of the Complainant's trademark and of the Complainant's rights in its mark at the time that the Respondent registered the Domain Name. Rules, paragraph 14(b); [WIPO Overview 3.0](#), section 3.2.2.

In addition to the facts recited above, the Panel finds that the term "call" before the WALGREENS trademark in the Domain Name betrays an intent to associate the Domain Name with the Complainant's trademark in a misleading manner; no *bona fide* use of the Domain Name is plausible; and the Respondent's failure to show a planned legitimate use of the Domain Name, coupled with an absence of rights or legitimate interests, tends to show bad faith. All these findings compel the Panel to conclude that the Respondent intentionally registered the Domain Name in bad faith to take unfair advantage of the Complainant's trademark and that the Respondent is using the Domain Name in bad faith, in violation of the Policy, paragraphs 4(b)(iii) and 4(b)(iv). [WIPO Overview 3.0](#), sections 3.1.1, 3.1.3, 3.1.4, 3.2.1, 3.2.2, and 3.6.

The Domain Name does not currently resolve to an active, functioning website. However, UDRP panels have consistently found that non-use of a domain name does not prevent a finding of bad faith, under the doctrine of passive holding, when other elements are present that demonstrate bad faith. [WIPO Overview 3.0](#), section 3.3. Accordingly, the Panel concludes that the Complainant has proven the third element: the Respondent registered and is using the Domain Name 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 Domain Name, <callwalgreens.com>, be transferred to the Complainant.

/A. Justin Ourso III/

A. Justin Ourso III

Panelist

Date: November 13, 2023