

## **ADMINISTRATIVE PANEL DECISION**

W.W. Grainger, Inc. v. Shi Lei  
Case No. D2023-4266

### **1. The Parties**

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

The Respondent is Shi Lei, China.

### **2. The Domain Name and Registrar**

The disputed domain name <mygraingerbenefit.com> is registered with Dynadot Inc (the “Registrar”).

The disputed domain name <wwwmygraingerbenefits.com> is registered with Cloud Yuqu LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 13, 2023. On October 13, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On October 13, 2023, and October 16, 2023, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (REDACTED FOR PRIVACY, Super Privacy Service LTD c/o; REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 20, 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 amendment to the Complaint in English on October 25, 2023.

On October 20, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name <wwwmygraingerbenefits.com> is Chinese. On October 25, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the amendment to 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 in English and Chinese of the Complaint, and the proceedings commenced on October 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 16, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on December 1, 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 North American broad line supplier of maintenance, repair and operating (MRO) products. It also has operations in Asia, Europe, and Latin America. It is a publicly traded company on the New York and Chicago Stock Exchanges under the symbol GWW. It has been in business for over 85 years, and with more than 30 million products offered globally, 353 branches, and over 26,000 employees worldwide.

The Complainant is the owner of the GRAINGER mark in different jurisdictions, including United States Trade Mark Registration No. 2039641 registered on February 25, 1997, in class 9; United States Trade Mark Registration No. 1747557 registered on January 19, 1993, in class 42; and China Trade Mark Registration No. 3808738 registered on December 21, 2005 in class 35.

The Complainant operates its primary website at "www.grainger.com" and uses the domain name <grainger.com> for all of its official email addresses. It is also the owner of the domain name <mygraingerbenefits.com>, which directs its employees to call the Grainger Benefits Center for questions about benefits or enrollment.

The Respondent is Shi Lei, China.

The disputed domain names were registered on April 27, 2023. At the time of filing the Complaint, the disputed domain names resolve to an active pay-per-click webpage that lists out multiple third-party links related to different advertisements covering contents such as "Employee Benefits" and "Employee Health Insurance Benefit".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain names incorporate and are confusingly similar to the Complainant's well-known GRAINGER mark in full, changing the mark only by adding the generic terms "www," "my," and "benefit(s)" which are generic terms to be used in connection with the world-wide web, employee benefits program, and the generic Top-Level Domain ("gTLD") ".com". The addition of the generic terms and gTLD are insufficient to distinguish the disputed domain names from the Complainant's mark.

The Complainant further alleges that the disputed domain names were registered by the Respondent without the Complainant's authorization or consent long after the Complainant established rights in the Complainant's GRAINGER mark. The Respondent is not commonly known by the disputed domain names. Further, the Respondent has never operated any *bona fide* or legitimate business under the disputed domain names and is not making a protected noncommercial or fair use of the disputed domain names. The

Respondent has used the disputed domain names to divert Internet traffic by “typo-squatting” on the Complainant’s website at the domain name <mygraingerbenefits.com> and offering pay-per-click links.

The Complainant finally asserts that the Respondent registered and is using the disputed domain names in bad faith. The Respondent acquired the confusingly similar disputed domain names to divert Internet traffic intended for the Complainant, which redirects to a pay-per-click advertising website intended to generate revenue for the Respondent. Further, the Respondent has listed the disputed domain name <wwwmygraingerbenefits.com> for sale for USD 2,980 on a domain name sales and auction platform. The Complainant also claims that disputed domain names have active MX (mail exchange) records which evidences a likelihood of additional bad faith use of the disputed domain names.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Procedural Issue: Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name <wwwmygraingerbenefits.com> is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the disputed domain names contain English words in Latin script, rather than Chinese script; (ii) the disputed domain names wholly contain the term “grainger”, which is identical to the Complainant’s GRAINGER mark in Latin Script; (iii) the disputed domain names resolve to web pages containing English; (iv) the Complainant’s counsel has no familiarity with reading and writing in the Chinese language, and therefore, conducting proceedings in Chinese would add unnecessary cost to the Complainant and cause delay in commencement of proceedings.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### **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 trade mark and the disputed domain names. See [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 entirety of the GRAINGER mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “www”, “my”, and/or “benefit(s)” 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 names and the 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.

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 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 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 disputed domain names such as those enumerated in the Policy or otherwise.

The Respondent has not provided evidence of a legitimate use of the disputed domain names or reasons to justify the choice of two domain names that are confusingly similar to the Complainant’s GRAINGER mark. Further, there is no indication to show that the Respondent is commonly known by the disputed domain names or otherwise has rights or legitimate interests in any of them. In addition, the Complainant has not granted the Respondent a license or authorization to use the Complainant’s marks or register the disputed domain names. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names in the terms of paragraph 4(c)(iii) of the Policy since at the time of filing the Complaint and, at the date of this Decision, the disputed domain names resolve to a pay-per-click website with links to third party websites. Such usage may reasonably be assumed to be commercial in its intent and effect. Prior UDRP panels have found that the use of a domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering of goods or services where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. See section 2.9 of the [WIPO Overview 3.0](#).

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.

In the present case, the Panel notes that the Complainant's GRAINGER mark has been registered in range of jurisdictions, including in China. The disputed domain names were registered long after the registration of the Complainant's GRAINGER mark. Through extensive use and advertising, the Complainant's GRAINGER mark is known throughout the world. Search results using the key word "grainger" on the Internet search engine direct Internet users to the Complainant and its business, which indicates that an exclusive connection between the GRAINGER mark and the Complainant has been established. As such, the Respondent either knew or should have known of the Complainant's GRAINGER mark when registering the disputed domain names.

Section 3.1.4 of the [WIPO Overview 3.0](#) states that "[...] mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". In this case, the disputed domain names are confusingly similar to the widely known GRAINGER mark and were registered by the Respondent who has no relationship with the Complainant, which means that a presumption of bad faith can be created.

Section 3.5 of the [WIPO Overview 3.0](#) states that "[p]articularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests)". The Panel notes that both disputed domain names resolve to a parked page comprising pay-per-click advertising links that divert Internet users to various contents, some of which are related to the Complainant's business. The Panel finds that the use of confusingly similar disputed domain names to lure Internet users to third-party websites is evidence of bad faith. See *Sodexo v. 杨智超 (Zhi Chao Yang)*, WIPO Case No. [D2020-1171](#).

In addition, the disputed domain name <www.mygraingerbenefits.com> is being offered for sale for USD 2,980 on a domain name sales and auction platform at the time of filing of the Complaint, which is in excess of the normal costs for registering and maintaining a domain name. The absence of circumstances indicating that the Respondent has rights or legitimate interests in this disputed domain name leads the Panel to conclude that the Respondent's intent in registering this disputed domain name was in fact to profit from or otherwise exploit the Complainant's mark. In this case, the Panel finds the sale of this disputed domain name as evidence of bad faith registration and use. See section 3.1.1 of the [WIPO Overview 3.0](#).

The Panel also notes that the Respondent has set up MX records for the disputed domain names, indicating the possibility that the disputed domain names may be used for fraudulent email communication. See *Tetra Laval Holdings & Finance S.A. v. Himali Hewage*, WIPO Case No. [D2020-0472](#); *Altria Group, Inc. and Altria Group Distribution Company v. Emerson Terry*, WIPO Case No. [D2021-0045](#).

The Respondent has kept silent in the face of the Complainant's allegations of bad faith. Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain names and, considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain names as discussed above, the Panel is led to conclude that the disputed domain names were registered and are being used in bad faith.

Based on the available record, 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 names <mygraingerbenefit.com> and <wwwmygraingerbenefits.com> be transferred to the Complainant.

*/Rachel Tan/*

**Rachel Tan**

Sole Panelist

Date: December 15, 2023