

ADMINISTRATIVE PANEL DECISION

Walgreen Co. v. Simon Rahman / Ashish Surana / Parmar Techmero Solutions Pvt Ltd, Krishna Parmar / Luke Hoobs / Khalil Shaikh / Mohammad Shaikh / Shaikh Khalil
Case No. D2023-0278

1. The Parties

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

The Respondent is Simon Rahman, Bangladesh; Ashish Surana, India; Parmar Techmero Solutions Pvt Ltd, Krishna Parmar, India; Luke Hoobs, U.S.; Khalil Shaikh, India; Mohammad Shaikh, India; Shaikh Khalil, India (“the Respondent”).

2. The Domain Names and Registrars

The disputed domain names <walgreenslistens.live>, <walgreenslistens.page> and <walgreenslistensusa.shop> are registered with NameSilo, LLC.

The disputed domain names <walgreenslistens.lol>, <walgreenslistens.one>, <walgreenslistens.shop>, <walgreenslistensu.shop> and <walgreenslistenswin3000.shop> are registered with NameCheap, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 20, 2023. On January 23, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On January 23, 2023 and January 24, 2023, the Registrars transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names 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 January 24, 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 February 8, 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 February 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2023. Upon request by the Complainant, the proceedings were suspended on March 6, 2023, for purposes of settlement discussions. The Complainant agreed to a settlement concerning two other domain names. The proceedings were reinstated on July 25, 2023, also upon the Complainant’s request, with the new Response due date being July 30, 2023. The Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on August 3, 2023.

The Center appointed Louis-Bernard Buchman as the sole panelist in this matter on August 8, 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, a company registered in the U.S., dates back to 1901 when Charles R. Walgreen Sr., a pharmacist, purchased a drugstore in Chicago and started a chain of drugstores under the Walgreen name. Today, the Complainant operates one of the largest pharmacy chains across the U.S., with around 9.000 stores, employing over 240.000 persons and serving around 9 million customers daily online and in its stores. Since 2014, the Complainant is a subsidiary of Walgreens Boots Alliance, which had a turnover in 2021 of USD 132,5 billion.

The disputed domain names were initially registered in the name of privacy services. The identity of the Respondents was disclosed by the Registrars in response to the Center’s request for registrar verification in connection with the disputed domain names.

The Complainant owns a large portfolio of trademarks containing the element WALGREENS, including *inter alia* the U.S. Trademark No. 1057249, registered on January 25, 1977, the U.S. Trademark No. 2292545, registered on November 16, 1999; the international trademark No. 1100522, registered on August 19, 2011; and the Popular Republic of China trademark No. 6997485, registered on April 28, 2014 (together hereinafter referred to as: “the Mark”).

The Complainant owns, among many domain names related to its activities, the <walgreens.com> domain name, registered in May 1995, and the <walgreenslistens.com> domain name, registered on May 6, 2016.

The <walgreenslistens.com> domain name resolves to the primary customer survey website of the Complainant, through which it provides customer survey services.

The disputed domain names <walgreenslistensu.shop> and <walgreenslistenswin3000.shop> were created on September 19, 2022; the disputed domain name <walgreenslistensusa.shop> was created on September 24, 2022; the disputed domain name <walgreenslistens.lol> was created on October 11, 2022; the disputed domain name <walgreenslistens.one> was created on October 13, 2022; the disputed domain names <walgreenslistens.live> and <walgreenslistens.page> were created on October 27, 2022 and the disputed domain name <walgreenslistens.shop> was created on December 29, 2022.

The Complainant has submitted evidence that the disputed domain names resolved to English-language websites using the Mark, advertising the Complainant’s customer satisfaction survey, and a chance to win USD 3.000.

5. Parties' Contentions

A. Complainant

- (i) The Complainant submits that the disputed domain names reproduce the Mark, in which the Complainant has rights, and are confusingly similar to the Mark, insofar as the disputed domain names all contain the Mark in its entirety followed by the word "listens" (some of them being further followed by the letters "com", "u", "usa" or "win3000" respectively), such additions not being capable of dispelling the confusing similarity.
- (ii) The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. Furthermore, the Complainant contends it never authorized the Respondent to use the Mark in any manner and that the Respondent has no license from the Complainant.
- (iii) The Complainant submits that the Respondent has registered the disputed domain names in bad faith and alleges that the Respondent had knowledge of the Mark when registering the disputed domain names.
- (iv) The Complainant submits that the Respondent is using the disputed domain names in bad faith.
- (v) The Complainant requests that the disputed domain names be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural Aspects

A. Request for Consolidation

In its Complaint, the Complainant requested a consolidation of Respondents.

Under paragraph 3(c) of the UDRP Rules, the Complaint may relate to more than one domain name, so long as the person or entity that is the registrant of the domain names specified in the Complaint is the same.

Pursuant to Article 10(e) of the UDRP Rules, a "Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules".

In this case, it is notable that:

- although they are not all registered with the same Registrar, the disputed domain names were registered over a period of six months, some of them in quick succession the same day;
- with only two exceptions, the disputed domain names share the same registrant's country of residence on the Whois, which is India;
- the disputed domain names are similar to each other beyond the simple fact of containing the Mark, as they all combine the Mark with the word "listens";
- the disputed domain names resolved to very similar websites using the Mark, advertising the Complainant's customer satisfaction survey, and a chance to win USD 3.000.

- even though the disputed domain names are not registered with the same Registrar, the combination of the similarity in their structures as well as their registration by registrants mostly from the same country, one of whom, Krishna Parma, was a respondent in a prior UDRP proceeding in 2021 also involving multiple registrants, are very unlikely to be a coincidence.

The combination of the above circumstances may indicate that the disputed domain names have been, in fact, registered by the same person or entity and are subject to common control.

After giving due consideration to paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the Panel notes that the Complainant's arguments for consolidation have not been rebutted and that no objection was raised on the ground that consolidation would be detrimental to the interests of the Respondent.

Accordingly, on the balance of the probabilities and in the interest of procedural efficiency, the Panel decides that all named registrants of the disputed domain names are, in fact, the same entity and/or that all the disputed domain names are under common control, and accepts consolidation as requested by the Complainant.

B. Failure to Respond

As aforementioned, no Response was received from the Respondent.

Under the Rules, paragraphs 5(f) and 14(a), the effect of a default by the Respondent is that, in the absence of exceptional circumstances, the Panel shall proceed to a decision on the basis of the Complaint.

Under paragraph 4(a) of the Policy, it is the Complainant's burden to establish that all three of the required criteria for a transfer of the disputed domain name have been met, even in the event of a default.

Under paragraph 14(b) of the Rules, the Panel is empowered to draw such inferences from the Respondent's default as it considers appropriate under the circumstances.

In this case, the Panel finds that as a result of the default, the Respondent has failed to rebut any of the reasonable factual assertions that are made and supported by evidence submitted by the Complainant. In particular, by defaulting and failing to respond, the Respondent has failed to offer the Panel any of the types of evidence set forth in paragraph 4(c) of the Policy or otherwise, from which the Panel might conclude that the Respondent has any rights or legitimate interests in the disputed domain names, such as making legitimate noncommercial or fair use of the disputed domain names.

Moreover, as discussed below, the Respondent has failed to provide any exculpatory information or reasoning that might have led the Panel to question the Complainant's arguments that the Respondent has acted in bad faith.

6.2. Requirements of Paragraph 4(a) of the Policy

A. Identical or Confusingly Similar

In comparing the Mark with the disputed domain names, it is evident that the latter consist of the Mark, followed by the term "listens" and, as the case may be, letters such as "u", "usa" or "win3000", and followed by the generic Top-Level Domains ("gTLDs") ".live", ".lol", ".one", ".page" or ".shop".

It is well established that a gTLD does not generally affect the assessment of a domain name for the purpose of determining identity or confusingly similarity.

The Panel finds that the elements "listens", "u", "usa" or "win3000" after the Mark do not dispel the confusing similarity, and that the Mark remains recognizable in the disputed domain names.

The Panel finds that the disputed domain names are confusingly similar to the Mark.

Thus, the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Although a complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that with regard to paragraph 4(a)(ii) of the Policy, this could result in the often impossible task of proving a negative proposition, requiring information that is primarily, if not exclusively, within the knowledge of a respondent.

Thus, the consensus view of UDRP panels is that paragraph 4(c) of the Policy shifts the burden of production of evidence to the respondent to come forward with evidence of rights or legitimate interests in a domain name, once the complainant has made a *prima facie* showing, as the Panel believes the Complainant has made in this case. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

As previously noted, the Respondent offered no reason for selecting the disputed domain names. There is no evidence that the Respondent is known by any of the disputed domain names.

The disputed domain names resolved to websites using the Mark and advertising the Complainant's customer satisfaction survey and a chance to win USD 3,000.

No information is provided on what rights or legitimate interests the Respondent may have in the disputed domain names.

To counter any notion that the Respondent has such rights or legitimate interests, the Complainant has argued that the Respondent received (i) no license from the Complainant and (ii) no authorization from the Complainant to register or use the disputed domain names.

Furthermore, the nature of the disputed domain names, insofar as they are similar to the Mark, carries a high risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, which has not been rebutted by the Respondent.

C. Registered and Used in Bad Faith

As noted above, the Respondent has failed to provide any exculpatory information or persuasive reasoning that might have led the Panel to question the Complainant's arguments that the Respondent acted in bad faith by creating confusion to the detriment of the Complainant by registering the disputed domain names confusingly similar to the Mark, which can be considered as "cybersquatting".

It has been established in prior UDRP decisions that where the respondent knew or should have known of a trademark prior to registering the disputed domain name, such conduct may be, in certain circumstances, sufficient evidence of bad faith registration and use. See *Weetabix Limited v. Mr. J. Clarke*, WIPO Case No. [D2001-0775](#).

In this case, given that the Mark is distinctive and well known, as was recognized in a number of UDRP decisions (see for instance *Walgreen Company v. Jon Reegy*, WIPO Case No. [D2011-1621](#); *Walgreen Co. v. Lin yanxiao / Linyanxiao*, WIPO Case No. [D2016-1605](#); *Walgreen Co. v. Registration Private, Domains By Proxy, LLC / Nitish Masheshwari, The lead Generators*, WIPO Case No. [D2017-1601](#) and *Walgreen Co. v. Domain Privacy / Ruby Gallon*, WIPO Case No. [D2022-2415](#)), and considering the use by the Respondent of the disputed domain names for commercial gain, the Panel finds that it is impossible to believe that the

Respondent chose to register the disputed domain names randomly with no knowledge of the Mark. See *Barney's Inc. v. BNY Bulletin Board*, WIPO Case No. [D2000-0059](#); *Kate Spade, LLC v. Darmstadter Designs*, WIPO Case No. [D2001-1384](#), citing *Cellular One Group v. Paul Brien*, WIPO Case No. [D2000-0028](#); and *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#).

Prior UDRP panels have also held that bad faith use of a domain name by a respondent may also result from the fact its good faith use is in no way plausible (see *Audi AG v. Hans Wolf*, WIPO Case No. [D2001-0148](#)). The Panel finds it is indeed not possible to imagine any plausible future active use of the disputed domain names that would not be illegitimate, considering the specificity of the Complainant's activity and the composition of the disputed domain names.

Moreover, in this case, the Respondent used privacy services to hide its identity. Although using a proxy or privacy service to hide the identity of the registrant is not *per se* conclusive of bad faith registration and use (see *Trinity Mirror Plc and MGN Ltd. v. Piranha Holdings*, WIPO Case No. [D2008-0004](#)), the Panel notes that the fact that the Respondent used privacy services to hide its identity and contact details prevented the Complainant from contacting it. Prior UDRP panels have held that concealment of identity and contact information may in certain circumstances be indicative of registration in bad faith (see *TTT Moneycorp Limited v. Diverse Communications*, WIPO Case No. [D2001-0725](#), and *Schering Corporation v. Name Redacted*, WIPO Case No. [D2012-0729](#)). See section 3.2.1 of the [WIPO Overview 3.0](#).

Finally, some UDRP panels have held that in certain circumstances, registrants of domain names have a duty to abstain from registering and using a domain name, which is either identical or confusingly similar to a prior trademark held by others and which would infringe upon or otherwise violate the rights of a third party.

See Policy, paragraph 2(b); *Nike, Inc. v. B. B. de Boer*, WIPO Case No. [D2000-1397](#); *Nuplex Industries Limited v. Nuplex*, WIPO Case No. [D2007-0078](#); *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. [D2005-1304](#); *BOUYGUES v. Chengzhang, Lu Ciagao*, WIPO Case No. [D2007-1325](#); *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. [D2006-0964](#); and *mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*, WIPO Case No. [D2007-1141](#).

The Panel concludes in the light of all these circumstances showing the Respondent's attempt to trade on the goodwill of the Mark to attract Internet users, that the Respondent's registration and use of the disputed domain names constitute bad faith, and that the requirement of paragraph 4(a)(iii) of the Policy is also satisfied in this case.

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, <walgreenslistens.live>, <walgreenslistens.lol>, <walgreenslistens.one>, <walgreenslistens.page>, <walgreenslistens.shop>, <walgreenslistensusa.shop>, <walgreenslistensu.shop>, and <walgreenslistenswin3000.shop> be transferred to the Complainant.

/Louis-Bernard Buchman/
Louis-Bernard Buchman
Sole Panelist
Date: August 22, 2023