

## **ADMINISTRATIVE PANEL DECISION**

Johnson & Johnson v. JOHN PAUL DAWN GONIA

Case No. D2023-3055

### **1. The Parties**

The Complainant is Johnson & Johnson, United States of America, represented by Fross Zelnick Lehrman & Zissu, PC, United States of America.

The Respondent is JOHN PAUL DAWN GONIA, Philippines.

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

The disputed domain name <rg-jnjbrands.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 17, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 19, 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 [Privacy Protect, LLC (PrivacyProtect.org)] and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 25, 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 August 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 29, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on September 5, 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 has been manufacturing and selling consumer products around the world and the Complainant, and its family of trademarks, have become extremely famous worldwide and have become associated exclusively with J&J's goods and services. The J&J family of companies includes the world's premier consumer health company, the world's largest and most diverse medical devices and diagnostics company, the world's fourth-largest biologics company and the world's eighth-largest pharmaceuticals company. J&J has more than 250 operating companies in 60 countries around the world, employing approximately 114,000 people.

The Complainant has registered the mark JNJ in many markets around the world for a variety of goods and services. Among its registrations are the following, all of which predate by many years the Respondent's registration of the disputed domain name:

- Argentina trademark registration Nos. 2609107, registered on November 11, 2013; 2605490, registered on November 5, 2013; 2601403, registered on October 15, 2013; 2601404, registered on October 15, 2013; and 2605491, registered on November 5, 2013;
- Australia trademark registration No. 897243, registered on December 5, 2001;
- Brazil trademark registration Nos. 824644921, 824638611, 824638620, 824638646, 824638654, and 824638638, all registered on April 24, 2007;
- Canada trademark registration No. TMA646035, registered on August 18, 2005;
- China trademark registration Nos. 3056677, registered on April 28, 2003; 3056673, registered on May 14, 2003; 3056674; and registered on April 28, 2003;
- Japan trademark registration No. 4703911, registered on August 23, 2003;
- Mexican trademark registration Nos. 745574, 745575, 745576, 745577, and 745573, all registered on April 30, 2002; and
- United Kingdom trademark registration No. 2286338, registered on May 3, 2002.

JNJ is also the Complainant's stock symbol at the New York Stock Exchange, and <jnj.com> is the domain name used with the Complainant's main website.

The disputed domain name was registered by the Respondent on August 24, 2021, and resolves currently to an inactive website.

However, at the time of filing the Complaint, the disputed domain name resolved to a website with content that purported to be a virtual "booth" at a medical convention for medical professionals practicing in the Philippines. The initial page indicated the corporate name "Johnson & Johnson (Philippines), Inc.". Once visitors clicked to proceed, the website displayed a virtual convention hall with drug product information on four pharmaceutical products of the Complainant.

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

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

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

Notably, the Complainant contends that:

- the disputed domain name is confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy 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 in respect of 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms like "rg" and "brands" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name 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.

While 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 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name such as those enumerated in the Policy or otherwise.

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 trademark is well-known (*Johnson & Johnson v. Privacy Protected by Withheld for Privacy ehf /Fatih Dolan*, WIPO Case No. [D2022-3076](#));
- the Respondent did not submit a Response in the present matter;
- the disputed domain name was registered by the Respondent on August 24, 2021. This is several years after the Complainant's trademarks were registered and used around the world. Furthermore, the disputed domain name is confusingly similar to the Complainant's JNJ marks; and
- at the time of filing the Complaint, the disputed domain name resolved to a website with content that purported to be a virtual "booth" at a medical convention for medical professionals practicing in the Philippines. The initial page indicated the corporate name "Johnson & Johnson (Philippines), Inc.". Once visitors clicked to proceed, the website displayed a virtual convention hall with drug product information on four pharmaceutical products of the Complainant.

Considering the above, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

### **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, <rg-jnjbrands.com> be transferred to the Complainant.

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Sole Panelist

Date: September 19, 2023