

ADMINISTRATIVE PANEL DECISION

Johnson & Johnson v. Jerry Rice

Case No. D2022-0271

1. The Parties

Complainant is Johnson & Johnson, United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, PC, United States.

Respondent is Jerry Rice, United States.

2. The Domain Name and Registrar

The disputed domain name <itss-jnj.com> (the “Disputed Domain Name”) 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 January 26, 2022. On January 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 28, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the Disputed Domain Name.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 9, 2022.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on March 14, 2022. 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

Complainant states that it “has been manufacturing and selling consumer products around the world for more than 100 years”; that it is a public company traded on the New York Stock Exchange; that it “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”; that it “has more than 250 operating companies in 60 countries around the world, employing approximately 114,000 people”; and that it is the registrant, and user, of the domain name <jnj.com>.

Complainant further states, and provides documentation in support thereof, that it owns registrations for the trademark JNJ in jurisdictions around the world, including among others, Canadian Reg. No. TMA646035, registered on August 18, 2005; Mexican Reg. No. 745574, registered on April 30, 2002; Argentine Reg. No. 2605491, registered on November 5, 2013; and Brazilian Reg. No. 824644921, registered on April 24, 2007 (hereinafter referred to as the “JNJ Trademark”).

The Disputed Domain Name was created on June 1, 2021, and, according to Complainant, is being used to send at least one email to one of Complainant’s vendors in an attempt to divert payment on an invoice to a bank account not associated with Complainant. After Complainant contacted the Registrar about the Disputed Domain Name on November 30, 2021, the Registrar suspended the Disputed Domain Name on December 1, 2021, “for being involved in Spear phishing.”

5. Parties’ Contentions

A. Complainant

Complainant contends, in relevant part, as follows:

- The Disputed Domain Name is confusingly similar to the JNJ Trademark because it “incorporates Complainant’s distinctive JNJ trademark in its entirety, merely adding the typosquatted version of Complainant’s corporate email subdomain, ‘its’ and the .com [generic Top-Level Domain] to [the JNJ Trademark]”; and “Respondent’s typosquatted version of Complainant’s subdomain used for its corporate email servers, its.jnj.com, is a blatant attempt to take advantage of the fact that Complainant uses this subdomain and to mislead recipients of the fraudulent email messages sent by Respondent.”
- Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, *inter alia*, “Respondent has no connection or affiliation with Complainant and has not received any license or consent, express or implied, to use Complainant’s trademark in domain names or in any other manner”; “Respondent’s only use of the Domain Name is in connection with an email server used to divert payments from Complainant to Respondent”; and “Respondent has made no actual use of the Domain Name in connection with an active website.”
- The Disputed Domain Name was registered and is being used in bad faith because, *inter alia*, it “[i]t is... inconceivable that Respondent was unaware of JNJ mark when it registered the Domain Name” because “Complainant is one of the best known companies in the world”; “given the fact that the Respondent used the Domain Name to impersonate one of Complainant’s employees makes clear that the Respondent was aware of the Complainant and its rights in the JNJ mark”; “the ultimate effect of any use of the Domain Name will be to cause confusion with Complainant”; and “Respondent’s exploitation of Complainant’s goodwill for financial gain by perpetrating a fraud on the Complainant demonstrates Respondent’s bad faith.”

B. Respondent

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

6. Discussion and Findings

Pursuant to the Policy, Complainant is required to prove the presence of each of the following three elements to obtain the relief it has requested: (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) 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. Policy, paragraph 4(a).

A. Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the JNJ Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the JNJ Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (*i.e.*, "itss-jnj") because "[t]he applicable Top-Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test". WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1.

The Disputed Domain Name contains the JNJ Trademark in its entirety. As set forth in section 1.7 of [WIPO Overview 3.0](#), "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Further, it is notable that the Disputed Domain Name includes the letters "itss", which are almost identical to the letters Complainant uses in its subdomain ("its") for its corporate email servers and that, as stated above, the Disputed Domain Name has been used to impersonate Complainant. As set forth section 1.15 of [WIPO Overview 3.0](#), "[i]n some instances, panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears *prima facie* that the respondent seeks to target a trademark through the disputed domain name." Similarly, the Panel here considers the use to which the Disputed Domain Name has been put to confirm confusing similarity.

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

B. Rights or Legitimate Interests

Complainant has argued that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, *inter alia*, "Respondent has no connection or affiliation with Complainant and has not received any license or consent, express or implied, to use Complainant's trademark in domain names or in any other manner"; "Respondent's only use of the Domain Name is in connection with an email server used to divert payments from Complainant to Respondent"; and "Respondent has made no actual use of the Domain Name in connection with an active website."

[WIPO Overview 3.0](#), section 2.1, states: "[w]hile 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.”

The Panel finds that Complainant has established its *prima facie* case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s 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 registrant’s website or location or of a product or service on the registrant’s website or location. Policy, paragraph 4(b).

As set forth in section 3.1.4 of [WIPO Overview 3.0](#), “[...] given that the use of a domain name for per se illegitimate activity such as... phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith.” And, as set forth in section 3.4 of [WIPO Overview 3.0](#), “Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include [...] phishing[...]. Many such cases involve the respondent’s use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant’s actual or prospective customers.”

Accordingly, the Panel finds that Complainant has proven 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 name <itss-jnj.com> be transferred to the Complainant.

/Douglas M. Isenberg/

Douglas M. Isenberg

Sole Panelist

Date: March 21, 2022