

## **ADMINISTRATIVE PANEL DECISION**

Johnson & Johnson v. Sergey Morozov  
Case No. D2022-3676

### **1. The Parties**

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

The Respondent is Sergey Morozov, Ukraine.

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

The disputed domain name <invokana.beauty> is registered with Porkbun LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2022. On October 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 5, 2022, 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 (Private by Design, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 8, 2022, 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 October 11, 2022. In response to an invitation by the Center to rectify certain information in the Complaint, the Complainant filed an amendment to the Complaint on October 27, 2022.

The Center verified that the Complaint together with the amendment to the Complaint and 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 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2022.

On October 31, 2022, the Respondent sent an email communication to the Center. The Respondent did not submit any formal Response. On December 1, 2022, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Steven A. Maier as the sole panelist in this matter on December 9, 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. Further Procedural Considerations**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent's mailing address is stated to be in Ukraine (whether this is indeed accurate is not clear), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel notes in particular that the Respondent's mailing address appears incomplete as it lacks a street name. The Panel notes that the Center did, however, successfully send the written notice of the Complaint to the named privacy service. The Center also sent the Notification of Complaint by email to the Respondent at its email address as registered with the Registrar (and to a postmaster email address as specified by the Rules) and received an email communication from the Respondent in response to its Notification of Complaint.

The Panel also notes that the Complainant has specified in the amendment to the Complaint that any challenge made by the Respondent to any decision to transfer or cancel the disputed domain name shall be referred to the jurisdiction of the Courts of the location of the principal office of the concerned registrar. In this case, the principal office of the Registrar, Porkbun LLC, is in Oregon, United States.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark.

The Panel concludes that the Parties have been given a fair opportunity to present their case (indeed, as noted above, the Respondent has replied to the Center's email), and the Panel will proceed to a Decision accordingly.

#### **5. Factual Background**

The Complainant is a multinational corporation headquartered in the United States and active in the fields of pharmaceuticals, medical devices, and related products and services.

The Complainant is the owner of numerous registrations in various territories worldwide for the trademark INVOKANA. Such registrations include, for example, United States trademark registration number 4369669 for the word mark INVOKANA, registered on July 16, 2013 in International Class 5.

The Complainant provides evidence that its INVOKANA product is a medicine used in the treatment of diabetes and is also known by its generic name canagliflozin.

The disputed domain name was registered on June 21, 2022.

The Complainant exhibits evidence that the disputed domain name resolves to a website which redirects visitors to a second website at “www.rxlara.com”. The website is headed “Your reliable supplier of generic medications” and appears to offer the Complainant’s INVOKANA product for sale, both under that trademark and by reference to the generic name canagliflozin. The relevant webpage contains links to over 30 other categories of medical conditions, for which the website also offers a range of medicines for sale online.

## **6. Parties’ Contentions**

### **A. Complainant**

The Complainant states that its INVOKANA product has been marketed and sold since 2013 and that over three million prescriptions for the product were written in 2021. The Complainant also refers to its own informational website about the product at “www.invokanahcp.com”.

The Complainant submits that the disputed domain name is identical to its trademark INVOKANA and that the generic Top-Level Domain (“gTLD”) “.beauty” should be ignored for the purpose of comparison under the first element.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has never licensed or authorized the Respondent to use its INVOKANA trademark and that the Respondent has not commonly been known by the disputed domain name. The Complainant contends that the Respondent’s sole reason for registering the disputed domain name was to mislead Internet users into believing its website is in some way endorsed by or connected with the Complainant. The Complainant further contends that, while purporting to sell generic medicines, the Respondent’s website uses the Complainant’s INVOKANA mark without authorization and that it is impossible to tell whether the Respondent’s goods are the Complainant’s genuine branded goods, generic goods, or counterfeit versions. The Complainant states that it has never sold its INVOKANA branded goods to the Respondent directly and that the Respondent is not an authorized reseller of its products.

The Complainant also points out that the Respondent is offering numerous products other than INVOKANA on its website and contends that it cannot therefore be making *bona fide* commercial use of the disputed domain name. It adds that neither of the websites to which the disputed domain name directs contains any disclaimer making clear the Respondent’s (nonexistent) relationship with the trademark owner.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It contends in particular that the Respondent’s registration and use of the disputed domain name creates a strong likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Respondent’s website and that the public is likely to be deceived into believing that the disputed domain name and associated website have a legitimate connection with the Complainant.

The Complainant requests the transfer of the disputed domain name.

### **B. Respondent**

The Respondent did not file a formal Response in this proceeding. In its email to the Center dated October 31, 2022 the Respondent stated:

“I’m willing to sell the domain to the plaintiff for 500usd.”

## 7. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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

The Complainant has established that it is the owner of registered trademark rights in the mark INVOKANA. The disputed domain name comprises that trademark together with the gTLD “.beauty”, which is typically to be disregarded in making the relevant comparison for the purpose of paragraph 4(a)(i) of the Policy and does not in any event prevent the Complainant’s trademark from being recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

### B. Rights or Legitimate Interests

The Panel accepts the Complainant’s submissions that the Respondent is not an authorized reseller of its products, that it is using the INVOKANA trademark without authorization and supposedly to sell generic goods, and that it is impossible to discern from the Respondent’s website (and indeed its lack of any substantive response in this proceeding) precisely what goods it is offering to sell under the INVOKANA trademark.

As is well-established in previous decisions under the UDRP, a reseller of trademarked goods, even if unauthorized, may in certain limited circumstances legitimately make use of the relevant trademark in a domain name. However, those circumstances require, among other matters, that the domain name itself is not inherently misleading, that the respondent is not using the domain name to sell goods other than the trademarked goods and that the respondent prominently discloses its relationship (including the lack of any such relationship) with the trademark owner (see *e.g.* section 2.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel finds none of those circumstances to be present in this case. The disputed domain name comprises the unadorned appropriation of the Complainant’s INVOKANA trademark together with a gTLD, and is therefore inherently deceptive as implying a legitimate association with the Complainant. It is clear that the Respondent is offering numerous products on its website other than the trademarked goods and the Panel also accepts that there is no sufficient disclaimer upon the relevant website making clear that the Respondent is unconnected with the Complainant. The Respondent’s activities under the disputed domain name do not therefore amount to a *bona fide* offering of goods or services for the purposes of the Policy and the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

### C. Registered and Used in Bad Faith

Given the Respondent’s use of the disputed domain name as described above, there can be no doubt that the Respondent registered the disputed domain name with the Complainant’s INVOKANA trademark in mind and with the intention of benefitting from the Complainant’s goodwill attaching to that trademark.

For the reasons set out above, the Respondent’s use of the disputed domain name does not represent a *bona fide* offering of goods or services for the purposes of the Policy, and the Panel finds to the contrary that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s

mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel finds further that the Respondent's failure to file any Response in this proceeding, together with its email offering to sell the disputed domain name for USD 500, does nothing to dispel the impression of registration and use of the disputed domain name in bad faith.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

## **8. 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, <invokana.beauty>, be transferred to the Complainant.

*/Steven A. Maier/*

**Steven A. Maier**

Sole Panelist

Date: December 23, 2022