

## **ADMINISTRATIVE PANEL DECISION**

Johnson & Johnson v. Universe, Universe Domains  
Case No. D2022-3727

### **1. The Parties**

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

Respondent is Universe, Universe Domains, United States.

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

The disputed domain name <boddiebandaids.com> (the “Domain Name”) is registered with 1API GmbH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 6, 2022. On October 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 7, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on the same day, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 11, 2022.

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 Respondent of the Complaint, and the proceedings commenced on October 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 3, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on November 7, 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 manufactures adhesive bandages, available in various sizes and shapes. Complainant has manufactured this product for more than a century, and the associated trademark, BAND-AID, has been one of the world's most famous trademarks for many decades.

Complainant holds trademark registrations for BAND-AID in many jurisdictions around the world, including United States Patent and Trademark Office Reg. No. 194,123, registered January 13, 1925. Complainant operates a website via the domain name <band-aid.com>, which garners more than 40,000 unique visitors per month.

The Domain Name was registered on March 18, 2022. The Domain Name resolves to a rudimentary website at which shirts appear to be offered for sale. The shirts bear the phrase "Had to take some risks," and they feature a pair of dice emerging from a cup. According to Complainant, a visitor cannot purchase clothing directly at this website, but there are hyperlinks to social media pages where clothing may be purchased.

Annexed to the Complaint are the Instagram and Twitter pages apparently linked to Respondent. The Instagram page, still under construction, includes the phrase "Had to take some risks just to shine like this," and features a stylized logo "Bandaid's Apparel" with a small bandage (which looks like a BAND-AID) situated between the two words.

The Twitter page, for "Boddie Bandaid's," also features a stylized logo of "Bandaid's Apparel," this time including a wad of dollar bills held together with a bandage (again, resembling a BAND-AID) that has just separated. The Twitter page describes the business as a "men's clothing store."

Complainant sent Respondent a cease-and-desist letter on April 7, 2022, and received no response. Complainant sent a chaser on May 9, 2022, and again received no response.

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

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

Complainant contends that it has satisfied all three elements required under the Policy for a transfer of the Domain Name.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

#### **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has rights in the trademark BAND-AID through longstanding and widespread registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The lack of a hyphen in the Domain Name and the pluralizing “s” do little or nothing to distinguish the Domain Name from the mark. The additional word “boddie” (which may be some sort of deliberate misspelling of “body,” which would suggest that Respondent’s clothing is supposed to fit like a sort of BAND-AID for the entire body) does little to overcome the confusing similarity between the mark and the Domain Name. In sum, despite the differences, the trademark BAND-AID is clearly recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

#### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Respondent has not come forward, either in response to Complainant’s cease-and-desist letters or in this proceeding, to articulate or prove any possible legitimate interest in the Domain Name. None of the above-quoted “safe harbors” applies here, based on the record presented.

It is undisputed that Respondent has no license or other authorization to use the famous BAND-AID trademark in a domain name or otherwise. Respondent’s apparent effort to market clothing under a brand that incorporates the famous BAND-AID trademark cannot be viewed as legitimate under the Policy.

Complainant has established Policy paragraph 4(a)(ii).

#### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that Respondent 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. This is a clear case of cybersquatting. On the clear record presented, Respondent targeted Complainant's famous trademark. If there were any possible room to suspect that a coincidence might be afoot, the existence of a bandage in the stylized logos used on Respondent's social media pages would easily extinguish this possibility.

Respondent's conduct here, namely, free-riding on Complainant's famous trademark in order to enhance Respondent's clothing sales, is an obvious instance of bad faith use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

## **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 Domain Name, <boddiebandaids.com>, be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: November 11, 2022