

## **ADMINISTRATIVE PANEL DECISION**

Johnson & Johnson v. Pushpendra Singh, Radhika Store Inc.  
Case No. D2023-1601

### **1. The Parties**

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

Respondent is Pushpendra Singh, Radhika Store Inc, U.S.

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

The disputed domain name <rogaineisrael.com> (the “Domain Name”) is registered with CloudFlare, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2023. On April 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 14, 2023, 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 (Data Redacted) and contact information in the Complaint. The Center sent an email communication to Complainant on April 18, 2023, 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 April 21, 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 Respondent of the Complaint, and the proceedings commenced on April 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 16, 2023.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on May 25, 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**

Complainant Johnson & Johnson (“J&J”) has more than 250 operating companies in 60 countries around the world employing approximately 114,000 people.

J&J’s Rogaine product line of hair regrowth treatments has been available for more than thirty years. It is the first topical brand FDA-approved product to regrow hair in both men and women.

J&J owns trademark registrations for its ROGAINE Mark (or “the Mark”) around the world, including U.S. Registration No. 1,420,785, which was registered on December 16, 1986. J&J, either on its own or through affiliated companies, owns and operates the domain name <rogaine.com> which resolves to the main website for Rogaine product information for consumers around the world. The website averages over 50,000 unique visitors per month, or almost 600,000 unique visitors per year.

The Domain Name was registered on December 27, 2019. It appears that Respondent is a business located in Florida that primarily sells religious regalia (see <radhikastore.com>). Respondent has multiple social media pages, including at Facebook (“https://www.facebook.com/RadhikaStore/”) and Twitter (“https://twitter.com/RadhikaStore”). Respondent also has storefronts at Etsy (“https://www.etsy.com/shop/RadhikaStore”) and eBay (“https://www.ebay.com/str/radhikadirect”). On its eBay store, Respondent offers J&J’s Rogaine products as well as generic versions of Minoxidil. At the time the Complaint was filed, the Domain Name was being used in connection with a website that was selling and delivering J&J’s Rogaine products to customers in Israel, which represented: “Express delivery within 3 days anywhere in Israel. We also offer 14 days return with no question asked upon delivery.” Also on Respondent’s website, there was featured the message “From the Manufacturer” listing aspects about the Rogaine Product from J&J’s website at <rogaine.com> as well as various photographs from J&J’s website. Now, the Domain Name does not resolve to any webpage.

#### **5. Parties’ Contentions**

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

Through J&J’s use and registration of the ROGAINE Mark around the world since 1986, the ROGAINE Mark has come to be exclusively associated with J&J and its hair growth products. The Domain Name is confusingly similar to the ROGAINE Mark because it incorporates the Mark in its entirety. The “.com” generic Top-Level-Domain (“gTLD”) extension need not be considered when determining confusing similarity. Adding “Israel” adds rather than diminishes the likelihood of confusion because adding a place name to a trademark is a common method for indicating the location of a business enterprise identified by a trademark. Given the reputation and renown of the ROGAINE Mark, most Internet users who see the Domain Name are likely to immediately recognize the Mark and assume that the Domain Name and any website associated with it is owned, controlled, or approved by J&J. Also, consumers and other third parties who search the Internet for legitimate retailers of J&J’s goods may be directed to the website at the Domain Name, and the products purportedly being sold at the site. This will undoubtedly create a probability of confusion, particularly because Respondent makes clear that the offer at the site appears to be genuine and sponsored by J&J.

No relationship exists between Respondent and Complainant or any of Complainant’s licensees, agents or affiliated companies that would give rise to any license, permission, or authorization by which Respondent could own or use the Domain Name. Respondent is not commonly known by the Domain Name, and instead has a well-established business selling “high-quality items for all your devotional needs.” Because the ROGAINE Mark is so well-known, the only reason that Respondent could have for registering and using

the Domain Name is that Respondent knew of the ROGAINE Mark and wanted to trade on Complainant's renown to lure consumers to its website to sell Rogaine products without authorization. The website at the Domain Name purports to sell genuine Rogaine products at a website constructed to look like a legitimate website providing information on J&J's Rogaine products, and which offers to sell various versions of Rogaine products to customers in Israel. This is not a *bona fide* offering or use. Even if the goods that were being sold at Respondent's websites are genuine, Respondent's use of the Domain Name would still not have been *bona fide*, as the site fails to disclose the lack of any relationship with Complainant. Respondent's use of the Domain Name, coupled with the website's prominent use of the ROGAINE Mark give consumers the impression that Respondent's website was authorized by J&J.

Given the widespread reputation of the Mark, the public is likely to be confused into thinking that the Domain Name has a connection with J&J contrary to the fact. In other words, Respondent has through the use of a confusingly similar domain name and webpage contents created a likelihood of confusion with the ROGAINE Mark.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

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

It is uncontroverted that Complainant has established rights in the ROGAINE Mark based on the aforementioned trademark registrations for it.

Furthermore, the Domain Name is confusingly similar to the ROGAINE Mark because it incorporates that Mark in its entirety and adds the designation "Israel", which does not prevent a finding of confusingly similarity. "It is established case law that where a domain name incorporates complainant's registered mark, this is sufficient to establish that the domain name is identical or confusingly similar for the purposes of the Policy." *Kabushiki Kaisha Hitachi Seisakusho (d/b/a Hitachi Ltd.) v. Wrangle*, WIPO Case No. [D2005-1105](#) (*Hitchachisemiconduct.com* confusingly similar to HITACHI. Here, combining Complainant's ROGAINE Mark with "Israel", which can be understood as a geographical designation, supports the Panel's findings under the third element. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is well settled that the addition of the gTLD, here ".com", is not significant in determining whether a domain name is identical or confusingly similar to a trademark. *CBS Broadcasting Inc. v. Worldwide Webs, Inc.*, WIPO Case No. [D2000-0834](#).

For the foregoing reasons, the Panel finds that Complainant has satisfied the first element of the Policy.

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

No relationship exists between Respondent and Complainant or any of Complainant's licensees, agents or affiliated companies that would give rise to any license, permission, or authorization by which Respondent could own or use the Domain Name. Also, Respondent is not commonly known by the Domain Name, and instead has a well-established business selling religious items. Respondent's website (at the Domain Name) purports to sell genuine Rogaine products and it is designed to look like a legitimate website providing information on J&J's Rogaine products including to customers in Israel. This is not a *bona fide* offering or use. *Philip Morris Inc. v. Alex Tsytkin*, WIPO Case No. [D2002-0946](#) ("use which intentionally trades on the fame of another cannot constitute a *bona fide* offering of goods or services."); *Bumble & Bumble LLC v. Gladyshev*, WIPO Case No. [D2008-1956](#) ("The Respondent's use of a domain name incorporating the Complainant's distinctive BUMBLE AND BUMBLE mark in its entirety, and the further use of the

Complainant's mark on the website, improperly suggest that the site is affiliated with the Complainant and that the Respondent is authorized to sell the Complainant's line of hair care and beauty products"). Even if the goods that were being sold at Respondent's websites are genuine, Respondent's use of the Domain Name would still not have been *bona fide*, as the site fails to disclose the lack of any relationship with Complainant. Respondent's use of the Domain Name, coupled with the website's prominent use of the ROGAINE Mark give consumers the impression that Respondent's website was authorized by J&J.

Where, as here, Complainant has raised a *prima facie* presumption of Respondent's lack of any rights or legitimate interests in the Domain Name, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondent has no rights or legitimate interests in the Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

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

At the time Respondent registered the Domain Name on December 27, 2019, Complainant had been using the ROGAINE Mark since at least the late 1980's (well over 30 years) to promote its hair regrowth treatment products. Respondent registered a Domain Name that is exactly the same as Complainant's registered ROGAINE Mark (adding a designation that the public could assume is a geographical location where J&J does business) to sell the same hair regrowth treatment products J&J sells under the ROGAINE Mark. In fact, it appears that Respondent misappropriated images from Complainant's website to sell competitive products (including before and after photos). Given these facts it is highly likely Respondent was aware of Complainant and its ROGAINE Mark when registering the Domain Name.

Respondent has also been using the Domain Name in bad faith. As indicated above, Respondent was using the Mark to sell goods that compete with those sold by Complainant under the Mark. Now, although the Domain Name is no longer resolving to the website selling the competing products, the fact remains Respondent could reverse course and use the Domain Name again for the same purpose -- to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the ROGAINE Mark.

The Panel therefore holds that Complainant has established the third element under the Policy above.

### **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 <rogaineisrael.com> be transferred to Complainant.

*/Harrie R. Samaras/*

**Harrie R. Samaras**

Sole Panelist

Date: June 7, 2023