

## **ADMINISTRATIVE PANEL DECISION**

Johnson & Johnson v. Max Efremov

Case No. D2022-3745

### **1. The Parties**

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

The Respondent is Max Efremov, Russian Federation.

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

The disputed domain name <pepcid4all.top> is registered with Porkbun LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 6, 2022. On October 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 7, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 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 19, 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 the Respondent of the Complaint, and the proceedings commenced on October 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 16, 2022.

The Center appointed Peter Burgstaller as the sole panelist in this matter on November 25, 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**

The Complainant owns various trademark registrations containing the mark PEPCID, *inter alia*:

- In the United States, U.S. Registrations No. 1,373,383, registered on December 3, 1985; No 4772806, registered on July 14, 2015; and No 1984651, registered on July 2, 1996 (renewed on July 2, 2016), all in class 5 (Annexes H and I to the Complaint);
- In Canada, Registrations No. TMA570936, registered on November 20, 2002 (renewed on November 20, 2017) and No. TMA319584, registered on October 17, 1986 (renewed on October 17, 2016), all in in class 5 (Annex J to the Complaint); and
- In the Republic of Korea, Application No. 40-2015-0091291, registered on June 29, 2016 in class 5 (Annex J to the Complaint).

The Complainant has used the trademark PEPCID in commerce, also on the Internet by providing information about the PEPCID histamine-2 blocker on its website under <pepid.com> and <pepid.ca> (Annexes E and F to the Complaint) as well as on its social media platforms Facebook, Twitter, YouTube and Instagram (Annex G to the Complaint).

The disputed domain name was registered on June 10, 2021 (Annex A to the Complaint).

The disputed domain name was used actively to address a website providing offers to buy PEPCID online (“without prescription”) as well as information about the PEPCID histamine-2 blocker (Annex L to the Complaint). Moreover, users that click on the “Buy Online” button were redirected to <https://bestfamilyshop.top/products/pepid.html>, an online pharmacy at which they are offered PEPCID products in prescription and non-prescription level doses (Annex M to the Complaint).

#### **5. Parties’ Contentions**

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

The Complainant’s 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; it has more than 250 operating in 60 countries around the world, employing approximately 114,000 people.

The Complainant sells a wide variety of PEPCID products: the PEPCID product is a histamine-2 blocker (H2 blocker) that provides relief for heartburn.

Through extensive use and advertising over many years, the PEPCID marks have become famous trademarks that are uniquely identified with the Complainant’s products and represent an enormous and valuable goodwill. In addition, the Complainant owns longstanding federal registrations for its PEPCID mark, including U.S. Registration No. 1,373,383. It also owns a number of additional registrations for its PEPCID family of marks, including PEPCID AC and PEPCID COMPLETE. These registrations constitute evidence of Complainant’s exclusive right to use these marks in connection with the identified goods as a matter of law in the United States. Moreover, the Complainant has also secured registrations for PEPCID family of trademarks in jurisdictions around the world since 2011.

The Complainant has dedicated websites for its PEPCID products in the United States under the domain name <pepcid.com> and Canada under “www.pepcid.ca”. These websites provide information on the Complainant’s PEPCID products. Similar information can be found at Complainant’s social media pages for the PEPCID brand at Facebook, Twitter, YouTube, and Instagram.

Therefore, the disputed domain name is identical to the Complainant’s PEPCID marks, as it incorporates the Complainant’s distinctive PEPCID trademark in its entirety, merely adding “4all” and the generic Top-level-Domain (gTLD) “.top” to the Complainant’s mark.

Moreover, the Respondent cannot demonstrate or establish any legitimate interests in the disputed domain name. It registered the disputed domain name on June 10, 2021, long after the Complainant had established rights in its PEPCID marks through extensive use around the world over the past decades. Furthermore, no relationship exists between the Respondent and the Complainant or any of the Complainant’s licensees, agents or affiliated companies that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name, which incorporates the PEPCID marks. The Respondent is not commonly known by the disputed domain name.

Finally, the Respondent registered and is using the disputed domain name in bad faith since it improperly exploits the disputed domain name and the PEPCID marks for its own gain.

Since the PEPCID marks are so well-known, the only reason that the Respondent could have for registering and using the disputed domain name is that it knew of the PEPCID marks and wanted to trade on the Complainant’s renown to lure Internet users to its website to sell PEPCID products without authorization.

The website addressed by the disputed domain name is not authorized to use the PEPCID marks, creates the false impression that it is an official website, and was primarily designed to trade upon the fame of the PEPCID marks of the Complainant. Given the widespread reputation of the PEPCID mark, the Internet user is likely to be confused into thinking that the disputed domain name has a connection with the Complainant, contrary to the fact. There is a strong likelihood of confusion as to source, sponsorship, affiliation or endorsement of the website to which the disputed domain name is resolved. Hence, the Respondent has through the use of a confusingly similar domain name and webpage contents created a likelihood of confusion with the PEPCID mark of the Complainant.

By virtue of the use of the Complainant’s PEPCID marks at the website, the public was likely to be confused into believing, falsely, that the Domain Name and the website associated therewith had a connection with the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove 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 with respect to 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 submitted evidence, which incontestably and conclusively establishes rights in the trademark PEPCID.

The disputed domain name is identical or confusingly similar to the Complainant's registered trademark PEPCID since it entirely contains this distinctive mark and only adds the number and term "4all".

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)").

Finally, it has also long been held that gTLDs are generally disregarded when evaluating the confusing similarity of a disputed domain name.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

While the overall burden of proof in UDRP proceedings is on the complainant, prior UDRP 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 (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's distinctive mark in its entirety together with the term "4all", cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above and all of the evidence put forward by the Complainant in the Complaint, as well as the Complainant's contentions that the Respondent has no rights or legitimate interests in the disputed domain names, that the Respondent has no connection or affiliation with the Complainant, and the Respondent has not received any license or consent, express or implied, to use the Complainant's trademark PEPCID in a domain name or in any other manner as well as the fact that the Respondent has not rebutted these allegations, it is undeniable for this Panel that the conditions set out in paragraph 4(a)(ii) of the Policy have been met by the Complainant.

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

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has rights in and is the owner of the distinctive U.S. registered trademark PEPCID. The PEPCID mark is a registered trademark since 1985 and has been used in the course of trade for years by the Complainant, also on the Internet.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant's rights in the PEPCID mark, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive trademark PEPCID entirely and the PEPCID marks have been registered long before the registration of the disputed domain name.

(ii) The disputed domain name moreover was actively used in bad faith: It resolved to a website where the Respondent offered PEPCID products as well as provided information about the PEPCID medicine. Thereby the Respondent attracted Internet users to a website supposedly providing PEPCID products by the Complainant, obviously for commercial gain.

Moreover, Panels have consistently found that the mere registration of a domain name incorporating a distinctive mark in its entirety plus a descriptive term (as in the present case) by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

This Panel also concludes bad faith use, putting emphasis on the following:

- the Complainant's trademark PEPCID is distinctive and well-known in the health sector;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;
- the disputed domain name incorporates the Complainant's trademark in its entirety, and is thus suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant's site); and,
- there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

Taking all these facts and evidence into consideration this Panel finds that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) 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 <pepcid4all.top> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: November 28, 2022