

## **ADMINISTRATIVE PANEL DECISION**

**Johnson & Johnson v. Rogaine Minoxidil**  
**Case No. D2023-1114**

### **1. The Parties**

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

The Respondent is Rogaine Minoxidil, India.

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

The disputed domain name <rogaineminoxidil.com> is registered with Gandi SAS (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 2023, 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 March 16, 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 the Respondent of the Complaint, and the proceedings commenced on March 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2023.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on May 1, 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

The Complainant is a multinational company which is one of the world's leaders in premier consumer health products and devices. It markets in particular a product line for the treatment of alopecia, under the brand name ROGAINE. This brand has been used since 1986, in the United States and elsewhere, and it is promoted through a website hosted under the domain name <rogaïne.com>. The generic name for the active ingredient in ROGAINE products is minoxidil.

As a basis for its Complaint, the Complainant relies on a global portfolio of trademarks ROGAINE registered worldwide. It includes the Indian trademark No. 2062573 registered on December 2, 2010, and the Europe Union trademark No. 002341063 registered on October 30, 2002.

The identity of the Respondent was disclosed by the Registrar in the course of this proceeding. The Respondent is an individual domiciled in India, who claims to be named "Rogaine Minoxidil".

The disputed domain name was registered on December 17, 2022. It is used by the Respondent to host a commercial website which, under the heading "Rogaine Minoxidil", purportedly offers for sale a series of ROGAINE products. The website is in English and is specifically targeting Indian consumers, with indications such as "Rogaine India", "Rogaine Foam India", "Rogaine Price in India", etc. The products are available for purchase in Indian rupees, with significant discounts. The Complainant is itself not in a position to confirm whether they are genuine or not. The website contains, at the end, the following text in grey and in small size: "Welcome to Rogaine Minoxidil Online Shopping! We are your one-stop shop for all you Rogaine needs. We offer imported USA brand products and ship them all over India with either cash on delivery or prepaid orders. Our products are of the highest quality and are designed to help you achieve the best results. We are proud to be one of the leading suppliers of Rogaine products in India and we strive to provide our customers with the best shopping experience possible. We have a wide variety of products in stock, from the original Rogaine foam to the newer Minoxidil solution. Browse our selection and find the product that's right for you. Thank you for choosing Rogaine Minoxidil Online Shopping!."

The Complainant indicates in the Complaint that the commercial website operated by the Respondent does not offer solely a range of ROGAINE products. It contains also a reference to "Maybelline New York", a brand which is unrelated. Actually, "Maybelline New York" is solely mentioned once on the website, in a single line at the very end, within a section entitled "Popular Brands" which otherwise appears to refer to the range of ROGAINE products.

#### 5. Parties' Contentions

##### A. Complainant

The arguments of the Complainant can be summarized as follows:

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the trademark ROGAINE, as it incorporates it in its entirety. It merely adds the generic name of the medication, "minoxidil", and the Top-Level Domain ("TLD") ".com". It highlights the fact that associating the brand ROGAINE to its active ingredient reinforces the confusing similarity, rather than reducing it.

On the second element of the Policy, the Complainant develops a number of arguments to show that the Respondent has no rights or legitimate interests in the disputed domain name. It indicates in particular that it has no relationship of any sort with the Respondent, that the Respondent is operating a deceptive website, and has provided false contact details as he/she is obviously not named "Rogaine Minoxidil". Also, according to the Complainant "The Respondent merely set up the website at the Domain Name to lure traffic and buyers to the website at the Domain Name. This is not a *bona fide* offering or use, but instead is nothing more than a form of parasitic exploitation of the Complainant's name and business. 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 references non-ROGAINE products and fails to disclose the lack of any relationship with the Complainant”.

On the third element of the Policy, the Complainant claims that the Respondent has registered and is using the disputed domain name in order to create a likelihood of confusion, as it induces the public into the false belief that the website operated by the Respondent is associated with, or even operated by, the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires that the Complainant prove all of the following three elements in order to be successful in this proceeding:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

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

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights. It is well accepted that this first criterion is perceived primarily as a standing requirement for the Complainant.

The Complainant has shown that it holds rights over the trademark ROGAINE, as registered in several jurisdictions.

The disputed domain name <rogaineminoxidil.com> includes the Complainant’s trademark in its entirety, combined with the term “minoxidil”. This addition does not prevent the Complainant’s trademark from being recognizable in the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”): “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”

As the disputed domain name includes the Complainant’s trademark in its entirety combined with a term that does not prevent the Complainant’s trademark from being recognizable, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark.

Therefore, the first element of the Policy is satisfied.

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

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production to demonstrate rights or legitimate interests in the disputed domain name. If

the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see [WIPO Overview 3.0](#), section 2.1).

The Complainant has indicated that the Respondent is not affiliated to it, is not known under the disputed domain name, has no rights over the disputed domain name, and has no rights or legitimate interests in the disputed domain name.

The issue of the potential legitimate interests of the Respondent in operating a commercial website, in which authentic goods are presumably offered for sale, must be assessed carefully.

Section 2.8.1 of the [WIPO Overview 3.0](#) indicates that “Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the ‘Oki Data test’, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to ‘corner the market’ in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark”.

Also, section 2.8.2 of the [WIPO Overview 3.0](#) adds that “Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., ‘parts’, ‘repairs’, or ‘location’), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant’s trademark”.

In this case, the Oki Data test fails on account of the lack of a proper, prominent and clear disclaimer regarding the relationship between the Respondent and the Complainant. The text inserted at the end of its website by the Respondent is barely accessible, and its content is not sufficiently clear: users cannot immediately infer from this text that the Respondent is an unaffiliated reseller of genuine goods of the Complainant. Further, the website includes one reference to another brand “Maybelline New York”. This is true also with the overall layout of the website, which could be perceived as being operated by the Complainant or under its control.

Although the Respondent registered the disputed domain name with the name “Rogaine Minoxidil”, there is no evidence on record showing that this is the actual name of the Respondent or the Respondent is commonly known by the disputed domain name. See section 2.3 of the [WIPO Overview 3.0](#).

Moreover, the composition of the disputed domain name, which includes the Complainant’s trademark plus a term referring to the generic name for the active ingredient of the Complainant’s products, carries a risk of an implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the second element of the Policy is satisfied.

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

In order to prevail under the third element of paragraph 4(a) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances, which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant's trademark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent'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 respondent's] website or location or of a product or service on [the respondent's] website or location.

The circumstances identified in paragraph 4(b)(iv) of the Policy are clearly met here.

The Respondent specifically targeted the Complainant when he/she registered the disputed domain name, by combining the distinctive and reputed trademark ROGAINE and the term "minoxidil". As evidenced by the Complainant, minoxidil is the generic name for the active ingredient of Rogaine products.

And, even assuming that authentic goods are offered for sale, which is the best-case scenario for the Respondent, he/she has used the disputed domain name to host a commercial site which is highly likely to create a likelihood of confusion to the detriment of consumers and of the Complainant: users likely to believe that this website is operated by the Complainant, or under its control because there is no accurate and prominent disclaimer on the website.

Besides, additional elements confirm that the Respondent has acted in bad faith, namely the indication of (likely) false contact details, and the reference to a third-party brand on his/her website.

Accordingly, the third element of the Policy is satisfied.

### **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, <rogaineminoxidil.com>, be transferred to the Complainant.

*/Benjamin Fontaine/*

**Benjamin Fontaine**

Sole Panelist

Date: May 15, 2023