

ADMINISTRATIVE PANEL DECISION

Johnson & Johnson (“Johnson & Johnson” or “J&J”) v. Joe Tanona
Case No. D2023-3428

1. The Parties

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

The Respondent is Joe Tanona, United States.

2. The Domain Name and Registrar

The disputed domain name <its-jmj.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 11, 2023. On August 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 17, 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 August 22, 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 August 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 13, 2023.

The Center appointed Ezgi Baklaci Gülkökar as the sole panelist in this matter on September 18, 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 one of the world's largest and most diversified healthcare products company. The Complainant and its trademarks have become associated exclusively with Johnson & Johnson's goods and services. The J&J family of companies operates in 60 countries around the world, employing approximately 155,000 people.

The Complainant also owns and uses several domain names, including <jnj.com> and it is the primary website for Johnson & Johnson for consumers around the world. JNJ is also the Complainant's stock symbol at the New York Stock Exchange.

The Complainant has registered the JNJ trademark in many markets around the globe and among its registrations are the following, all of which predate the Respondent's registration of the disputed domain name:

- Canadian trademark registration no. TMA 646035, registered on August 18, 2005,
- Mexican trademark registrations no. 745574, 745575, 745576, 745577 and 745573 all registered on April 30, 2002
- Argentinian trademark registrations no. 2609107, registered on November 11, 2013; 2605490, registered on November 5, 2013; 2601403, registered on October 15, 2013; 2601404, registered on October 15, 2013; and 2605491, registered on November 5, 2013,
- Brazilian trademark registration nos. 824644921, 824638611, 824638620, 824638646, 824638654, and 824638638, all registered on April 24, 2007.

The disputed domain name was registered by the Respondent on May 1, 2023. It currently resolves to an inactive website and has been used to send fraudulent emails.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy is satisfied in the present case, as follows:

Identical or confusingly similar

The Complainant submits that the disputed domain name is identical or confusingly similar to the Complainant's JNJ mark, by merely adding the altered version of the Complainant's corporate email subdomain <its.jnj.com> and changing the letter "N" with the letter "M". The Complainant refers to a previous UDRP decision to argue that misspelling does not prevent a confusing similarity finding for purposes of the Policy and such actions constitute "typo-squatting".

The Complainant further argues that the disputed domain name incorporates the Complainant's registered JNJ mark in its totality and this is sufficient to render the disputed domain name confusingly similar to the Complainant's marks for the purposes of the Policy.

The Complainant also argues that its JNJ trademarks have strong reputation and is known all over the globe and such reputation increases the risk of confusion and association, especially considering that the Respondent also attempts to imitate the Complainant in email messages sent from the disputed domain name.

Rights or legitimate interests

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant further submits that the Respondent has no rights on the Complainant's JNJ trademarks, corporate name, trade name, shop sign or domain names and that the Respondent is not known by the disputed domain name.

The Complainant also argues that the Respondent has no affiliation with the Complainant and the Complainant has not given the Respondent permission to register and/or use the Complainant's JNJ trademarks in any manner.

Furthermore, the Respondent has neither made use of the disputed domain name nor engaged in any demonstrable preparations to use it in connection with a *bona fide* offering of goods or services, instead the Respondent is using the disputed domain name to send fraudulent email messages in order to confuse various vendors (as demonstrated via Exhibit L) for the Respondent's financial gain as demonstrative of bad faith registration and use under the Policy. This conduct it is said is causing disruption of the Complainant's business and creating a likelihood of confusion regarding source, sponsorship affiliation or endorsement. The Complainant further argues that such uses cannot be accepted within the scope of noncommercial or fair use.

The disputed domain name was registered and used in bad faith

The Complainant initially argues that the Complainant is one of the well-known companies in the globe and, therefore, it is not acceptable that the Respondent was unaware of the JNJ trademarks when it registered the disputed domain name.

The Complainant further asserts that the Respondent using the disputed domain name to impersonate one of the Complainant's employees makes it clear that the Respondent was aware of the Complainant in the first place.

The Complainant argues that the disputed domain name being used to impersonate one of the Complainant's employees and further contacting one of the Complainant's vendors directly violates the Paragraph 4(b)(iv) of the Policy.

The Complainant states that the Respondent has knowingly registered the disputed domain name in order to engage opportunistic cybersquatting and both active and passive behavior constitutes bad faith registration and use.

The Complainant further asserts that the Respondent not only knows the Complainant's marks but intends to benefit from their reputation as well, also adding that passive holding of a domain name can also constitute a bad faith use under the Policy.

In summary, the Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (ii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it has well-established rights in the JNJ trademarks. Further, the Complainant holds trademarks with the dominant elements JNJ.

The disputed domain name <its-jmj.com> incorporates the Complainant's trademark with sole difference being the misspelling of the letters "N" and "M" in the "JNJ/JMJ" component of the Complainant's trademarks. This change does not prevent a finding of confusing similarity between the disputed domain name and the trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.9. Therefore, the Panel accepts that this is a case of typo-squatting, especially considering the existence of fraudulent attempt by the Respondent.

The disputed domain name includes the almost identical term "JNJ" and in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the disputed domain name, the disputed domain name will be considered confusingly similar (see [WIPO Overview 3.0](#), section 1.7).

Further, the Panel notes that the disputed domain name includes the term "its", which is identical to the Complainant's employee email address with the subdomain <its.jnj.com>. The Panel is in the view that given that the Complainant's trademark is sufficiently 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 (see [WIPO Overview 3.0](#), section 1.8).

For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel accepts that the generic Top-Level Domain ("gTLD") ".com" may indeed be ignored. See [WIPO Overview 3.0](#), section 1.11.1.

In the light of the above, the Panel is of the view that the disputed domain name is confusingly similar to the Complainant's JNJ trademarks and the first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. While the overall burden of proof in UDRP proceedings is on the complainant, previous 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 a 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 ([WIPO Overview 3.0](#), section 2.1).

As of the date of this decision, the disputed domain name does not resolve to an active website. Evidence submitted by the Complainant indicates that, the disputed domain name is used in a fraudulent attempt to obtain gain from the Complainant's vendors by impersonating one of the employees of the Complainant, as noted within the Exhibit L. Previous UDRP panels have categorically held that the use of a disputed domain

name for illegal activity, including impersonation or other types of fraud can never confer rights or legitimate interests on a respondent ([WIPO Overview 3.0](#), section 2.13.1). See also *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#) (April 3, 2019) (evidence of “Respondent’s illegal activity, namely, using the disputed domain name to impersonate Complainant in emails to third parties to perpetrate fraud can never confer rights or legitimate interests on a respondent”).

The Panel finds that the use of the disputed domain name cannot amount to a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Therefore, the Panel finds that the Respondent does not have rights or any legitimate interests in the disputed domain name within the meaning of Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that a complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith. Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s trademark ([WIPO Overview 3.0](#), section 3.1).

The Panel finds that at the time the disputed domain name was registered, the Respondent had undeniable knowledge of the Complainant’s JNJ trademarks and its derivatives, as the Complainant’s trademarks are highly distinctive and unlikely to be arrived at and registered by accident. Furthermore, the registration of the disputed domain name is almost identical to the sub-domain used for the mailing systems of the Complainant. This reflects that the Respondent was aware of the Complainant and its internal structure at the time of registration.

The disputed domain name does not resolve to an active website as of the date of this decision. However, the evidence submitted by the Complainant indicates that the disputed domain name was used in a fraudulent attempt to obtain gain from the Complainant’s vendors, by misleading the receiving parties that the Respondent is an employee of the Complainant.

The evidence provided at Exhibit L shows that the disputed domain name <its-jmj.com> was used in connection with fraudulent activities and demonstrates the Respondent’s bad faith under paragraph 4(b)(iv) of the Policy. See *Altria Group, Inc. Altria Group Distribution Company v. Emerson Terry*, WIPO Case No. [D2021-0045](#). See also *Nelson Mullins Riley & Scarborough LLP v. Jamie Feinmesser*, WIPO Case No. [D2020-9585](#).

The Panel finds that the Respondent’s impersonation of the Complainant by use of the JNJ trademark in the disputed domain name to send fraudulent emails constitutes bad faith.

In the circumstances, the Panel finds that the Respondent registered and has been using the disputed domain name in bad faith, and paragraph 4(a)(iii) of the Policy has been 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, <its-jmj.com> be transferred to the Complainant.

/Ezgi Baklacı Gülkökar/

Ezgi Baklacı Gülkökar

Sole Panelist

Date: October 2, 2023