

ADMINISTRATIVE PANEL DECISION

The Johns Hopkins University, The Johns Hopkins Health System Corporation, Johns Hopkins Medicine International, L.L.C. v. Ha Tien Son
Case No. D2024-0139

1. The Parties

The Complainants are The Johns Hopkins University, United States of America (“United States” or “US”), The Johns Hopkins Health System Corporation, United States, and Johns Hopkins Medicine International, L.L.C., United States, represented by Vorys, Sater, Seymour and Pease, LLP, United States.

The Respondent is Ha Tien Son, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <johnshopkinsofficial.com> is registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2024. On January 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 16, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 January 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 6, 2024.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on February 9, 2024. 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 Complainants are the Johns Hopkins University (JHU), the Johns Hopkins Health System Corporation (JHHS), and Johns Hopkins Medicine International, LLC (JHI) jointly. The Complainants are based in Baltimore, Maryland, US. These Complainants own the trademarks HOPKINS, JOHNS HOPKINS, and JOHNS HOPKINS MEDICINE registered for use in connection with goods and services in the fields of medicine, hospitals, healthcare, medical research, and education. JHU and JHHS are the owners of the Johns Hopkins marks in the US, and JHI, a limited liability company comprised of two members, JHU and JHHS, own the registered trademarks outside the US.

The trademark JOHNS HOPKINS, US Serial Number 77797714 was registered in the United States on April 26, 2011 and has been duly renewed, in relation to goods and services in multiple classes inter alia related to health service delivery and education. The trademark HOPKINS, US Serial Number 77797733, was also registered on April 26, 2011 and duly renewed, in relation to the same or similar goods and services; and the trademark JOHNS HOPKINS MEDICINE, US Serial Number 77797740, was registered on November 16, 2010, in relation to medical services and information. The Complainants also claim extensive common law rights in the subject trademarks. The Complainants, in particular JHI, also own analogous trademark registrations in other countries, of which they provide evidence in the Complaint.

The Complainants are active in the fields of health care service provision in the United States and in other countries, health care and medicine related education and information provision, and the administration of hospitals and the like.

The disputed domain name was registered on June 26, 2023, and resolves to a website prominently displaying a stylized logo “Maximum Edge Nutrition” that provides links to purchase nutritional supplements. Two links are available that redirect users to the website “www.getglucotrust.com” for the purchase of supplements.

5. Parties’ Contentions

A. Complainants

The Complainants point out that the registration agreement for the disputed domain name is provided both in English and in Vietnamese and that given that fact and because the website to which it resolves is also in English, it would be fair and proper for this proceeding to be conducted in English.

The Complainants contend that the disputed domain name is confusingly similar to its HOPKINS and JOHNS HOPKINS marks to which it has both common law rights and rights by registration. The Complainants point out that the disputed domain name wholly incorporates the Complainants’ JOHNS HOPKINS mark and combines it with the descriptive term “official” and says that when a domain name incorporates a distinctive mark in its entirety, it is confusingly similar to that mark despite the addition of other words (as recognized in prior panel decisions). The Complainants contend that the addition of the descriptive term “official” to the HOPKINS mark does not serve to distinguish the disputed domain name and accentuates rather than diminishes the confusing similarity.

The Complainants say that the Respondent is not its licensee nor its affiliate and is not authorized to use the JOHNS HOPKINS marks referred to above. It says the Respondent is not commonly known by the disputed domain name and is not making a legitimate noncommercial or fair use of the disputed domain name or the name “johnshopkinsofficial”. The Complainants assert that they have continuously and exclusively used the JOHNS HOPKINS trademarks for more than 120 years. They say that it is implausible that the Respondent has been commonly known by the name “johnshopkinsofficial” or a similar designation or has any prior rights in the JOHNS HOPKINS marks, and that they are in any case unaware of any evidence that prior to notice of this dispute, the Respondent used or made preparations to use the disputed domain name, or a name or mark similar to it, in connection with a bona fide offering of goods or services. They point out that the disputed domain name is not of a purely generic or descriptive nature.

The Complainants point out that the click-through advertisements on the website associated with the disputed domain name resolve to an unrelated third-party website and, as such, misrepresent the source and origin of the advertised goods and services and falsely and misleadingly imply the Complainants' sponsorship, approval, affiliation, or endorsement. They say this type of use does not constitute a bona fide commercial offering of goods or services under the disputed domain name nor a legitimate noncommercial or fair use without any intent for commercial gain, or to mislead or divert consumers or tarnish the trademark at issue. The Respondent also failed to reply to cease and desist notification, and the Complainants point out that panels in a number of prior decisions have found that such failure is an indication of the Respondent's lack of legitimate interests in a domain name. Thus, the Complainants say it has made out the necessary prima facie case concerning rights and legitimate interests.

The Complainants point out that the disputed domain name resolves to a website that contains links for goods highly related to the Complainants and their JOHNS HOPKINS trademarks, all for the commercial benefit of the Respondent, and that such use is neither legitimate nor in good faith. Rather, it constitutes an attempt to create confusion so as to attract Internet users to the Respondent's website for commercial gain from click-through revenue generated by the sponsored links. The Complainants assert that diverting traffic to the Respondent's website trades on the goodwill of the Complainants and creates a mistaken belief that the Complainants condone such conduct or are somehow affiliated with the other sites advertised on the Respondent's website. The Respondent did not react to the cease and desist notification by the Complainants, and in conclusion the latter state that there is no conceivable legitimate use by the Respondent possible since the disputed domain name integrates the Complainants' highly distinctive and widely reputed trademarks.

The Complainants therefore contend that they have satisfied each of the elements required under 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

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is English and Vietnamese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement. The Complainants request that English be the language of the proceeding. Since one version of the Registration Agreement for the disputed domain name is in English, the disputed domain name incorporates the English language term "official", and the webpage to which the disputed domain name resolves is in English, it is fair, justice, and efficient to conduct this proceeding in English. The Respondent has not made any argument to the contrary.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7).

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.2.1).

The entirety of the registered trademark JOHNS HOPKINS is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.7). The addition of the term “official” does not prevent a finding of confusing similarity.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). 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).

Having reviewed the available record, the Panel finds the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ prima facie showing and has not advanced any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. The incorporation of a highly distinctive and widely known trademark in a domain name by a party unconnected to the trademark owner, for the purpose of establishing a click-through type website, is not of a kind to justify recognition of rights or legitimate interests in the registrant of that domain name. This is because it relies on the deception of consumers and Internet users.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has acquired the disputed domain name that wholly incorporates the distinctive registered trademark JOHNS HOPKINS of the Complainants. It is almost inconceivable that this came about without the Respondent knowing about the JOHNS HOPKINS trademark, or the goods and services in the healthcare sector to which the mark relates. The disputed domain name was registered by the Respondent in the full knowledge of the Complainants’ trademark rights is further reinforced by the inclusion of the term “official” which suggests a deliberate attempt to reassure Internet users that the Respondent’s relevant website is connected to the Complainants in a legitimate manner. This is obviously not the case. The disputed domain name is also used to direct to a website where click through links are provided to goods that are related to human health, which itself is a bad faith use of the disputed domain name, and further reinforces the conclusion that the initial registration itself was in bad faith. Relying on consumer deception by appropriating another party’s trademark by inclusion in a domain name is a bad faith activity that is detrimental to the trademark owner, and results in ill-gotten gains for the domain name registrant by way of click-through license fees.

The Panel therefore finds that the Complainants have established the third element 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 <johnshopkinsofficial.com> be transferred to the Complainants.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: February 23, 2024