

ADMINISTRATIVE PANEL DECISION

Johnson & Johnson v. Widome Design
Case No. D2013-1281

1. The Parties

The Complainant is Johnson & Johnson of New Brunswick, New Jersey , United States of America (“U.S.A”), represented by Drinkler Biddle & Reath LLP, U.S.A.

The Respondent is Widome Design of Potomac Maryland, U.S.A, represented by the Law Offices of Karen J. Bernstein, U.S.A.

2. Domain Name and Registrar

The domain name at issue is <johnsons.com> (the “Domain Name”), registered with Tucows Domains, Inc. (the “Registrar”)

3. Procedural History

The Complaint was received by the WIPO Arbitration and Mediation Center (the “Center”) email on July 15, 2013. The Center has verified that the Complaint satisfies 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”) and that payment was properly made. The Administrative Panel (the “Panel”) is satisfied that this is the case.

On July 16, 2013, the Center sent an Acknowledgement of Receipt of Complaint to the Complainant. On July 16, 2013, the Center sent to the Registrar a request for verification of registration data. On July 17, 2013, the Registrar confirmed the registrant and contact details for the Domain Name and that the Domain Name is registered in the Respondent’s name.

Having verified that the Complaint satisfies the formal requirements of the Policy, the Rules, and the Supplemental Rules, the Center on July 24, 2013, sent to the Respondent, with a copy to the Complainant, the Complaint and a Notification of Complaint and Commencement of Administrative Proceeding in accordance with paragraph 2(a) of the Rules. Pursuant to paragraph 5(a) of the Rules, the Center set August 13, 2013, as the date for the submission of a Response by the Respondent. Respondent submitted a Response to the Center by email on August 13, 2013.

The Center appointed a three-member administrative panel (the “Panel”) on the election of the Respondent and after receiving the payment. The duly appointed members of the Panel include Maxim H. Waldbaum

chair, Diane Cabell and Petter Rindforth. 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. The Center sent the parties the Notification of Appointment of Administrative Panel on September 10, 2013 by email.

4. Factual Background

The Complainant is Johnson & Johnson, a New Jersey company specialized in the field of personal care products, especially for babies and children since 1894. The Complainant owns numerous national and international trademark registrations worldwide, including JOHNSON'S. The JOHNSON'S mark has been registered since as early as August 27, 1912 (as shown by copy of Certificate of Registration, Annex I of the Complaint) and the Complainant first began using the trademark since 1894 in connection with baby powder.

The Respondent is Widome Design, a graphic design, corporate communications, marketing as well as website design and management company. Currently the sole proprietor of Widome Design is Sue Widome. The Domain Name <johnsons.com> was transferred to the Respondent on or around November 12, 2006.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the Domain Name <johnsons.com> is identical and confusingly similar to the famous, distinctive and registered trademark JOHNSON'S in which the Complainant has rights. The Complainant continues to allege that the Respondent registered, used and continues to use the Domain Name <johnsons.com> in bad faith in disregard of the JOHNSON'S mark.

The Complainant submits that the Complainant owns and holds the rights to the internationally famous JOHNSON'S mark in the U.S.A. and in several other countries worldwide, including numerous trademark registrations. The Complainant further argues that the Complainant has invested hundreds of millions of dollars in advertising and promoting the famous mark and extensively promotes the famous Johnson's brand in various ways on the Internet, operating websites at, e.g. "www.johnsonsbaby.com" and numerous Facebook pages, etc.

The Complainant alleges that on or around November 12, 2006 the <johnsons.com> Domain Name was transferred to the Respondent in disregard of the JOHNSON'S marks.

The Complainant further submits that the Domain Name <johnsons.com> is identical and confusingly similar to the Complainant's JOHNSON'S mark, because the only differences between <johnsons.com> and the Complainant's famous trademark JOHNSON'S is the apostrophe after "Johnson" and the addition of the generic top level domain (gTLD) ".com".

The Complainant refers to a prior UDRP proceeding involving the <johnsons.com> Domain Name in which the Complainant filed a UDRP complaint against Tomato Pages with the National Arbitration Forum ("NAF") on June 8, 2003 (*Johnson & Johnsons v. Tomato Pages Website Production Services*, NAF Claim No. 162058). In that case a single-member panel determined that the <johnsons.com> Domain Name was confusingly similar to the Complainant's JOHNSON'S mark and that "Tomato Pages" did not have a right or legitimate interest in and to the Domain Name.

However, the previous panel denied the Complainant's 2003 Complaint on the ground that Tomato Pages lacked the requisite bad faith registration at the time the domain name was originally registered in 1997. In that case it was found that at the time of the original registration of the domain name, Tomato Pages was acting as an agent for a third party, Johnson's Flowers. The panel concluded that the issue of whether a domain name is registered in bad faith must be considered as of the original registration date of the domain name and not at the time of renewal. So the panel in that case denied bad faith.

Since the 2003 NAF proceeding, the Domain Name <johnsons.com> has been transferred at least two times. On or around March 2004, Tomato Pages, with an address in Potomac, Maryland, transferred the Domain Name to Jan Widome Website Production Services ("JWWPS") having an address in Bethesda, Maryland.

On or around November 12, 2006, there was a second transfer from JWWPS to Widome Design which claims an address identical to the original registrant, Tomato Pages.

The Complainant holds the opinion that the prior proceeding has no preclusive effect on this Complaint, because it does not constitute a refiled complaint. The Complainant states that the Respondent is different from that of the first case in 2003: Tomato Pages was the Respondent in the first case and Widome Design is the Respondent in the second case. It argues that despite the fact that Widome Design is located at the former address of Tomato Pages both are separate legal entities.

The Complainant argues that the relevant date is the date when the Respondent acquired the Domain Name, here November 12, 2006, instead of the original registration date of 1997.

The Complainant alleges that the Respondent has profited from the goodwill of the Complainant's JOHNSON'S mark by using a confusingly similar domain name -<johnsons.com> -in bad faith, since the website connected to the Domain Name leads to a pay-per-click website with competitive personal and baby care products.

Furthermore the Complainant submits that the <johnsons.com> website also generated pop-up advertisements for dating services and "win-a-prize" promotions. Internet users must click on the advertisement to close out the website, and in some cases the website gives personal information to claim a purported "prize".

The Complainant also alleges that the registration and use evidences bad faith because the Respondent was well aware of the Complainant's rights in the JOHNSON'S mark.

The Complainant alleges that there is no evidence that the Respondent has any trademark or other rights in the JOHNSON'S mark. The business website "www.widome.com" of the Respondent contains a partial list of their clients, none of whom have the name Johnson or Johnson's.

Since the company's name is Widome, Johnson is not a logical name for the website. Furthermore there is no client of the company with name Johnson.

The Complainant further asserts that the Respondent has no connection or affiliation with the Complainant and the Complainant has not granted any license or consent, express or implied, to the Respondent to use the Complainant's famous JOHNSON'S mark in any matter.

On December 7, 2010 the Complainant sent a cease and desist letter, via Federal Express and email, to the Respondent stating that the Respondent's use and registration of the Domain Name infringes the Complainant's rights in the famous JOHNSON'S marks and demanding transfer of the Domain Name. The Complainant did not receive any response.

On December 29, 2010 the Complainant sent a follow up letter to the Respondent. To date, the Complainant has received no response to either of these letters.

In the view of the Complainant the Respondent has no interest in the Domain Name, because the Respondent held the Domain Name since 2011 only passively, as a "parked page", without making any use of it at all.

B. Respondent

In response to the Complainant's allegation, the Respondent requests the Administrative Panel to deny the

remedies requested by the Complainant.

The Respondent alleges that the Complaint is nothing more than a rehashing of the first Complaint 10 years ago between the Complainant and Tomato Pages in 2003 and that the attempt to re-file the first Complaint has absolutely no merit. It continues to allege that nothing has changed since 2003 and that Widome Design, the Respondent in this proceeding, is the same registrant of the Domain Name.

The Respondent argues and provides evidence to support that the Domain Name has always been co-owned by Ms. Windom and her brother for their business ventures up until the death of her brother 2005. Only the Whols information has changed since the NAF case of 2003, but the Domain Name has been used over a decade from the same Respondent.

The Respondent also argues that since the business and domicile of Ms. Widome and her brother is located in the Maryland area, Maryland law also applies.

The Respondent alleges that any acts stated in the re-filed Complaint are the same acts complained of in the previous case and that there have been no new acts. There were also pay-per-click advertisements on the website located at the Domain Name at the time the previous decision was rendered.

The Respondent argues that if a domain name was registered in good faith, it cannot, by changed circumstances, the passage of years, or intervening events later be deemed to have been registered in bad faith. The previous UDRP panel deemed that it was originally made in good faith so there can be no bad-faith registration of the Domain Name.

The Respondent submits that for only 3 months in 2007 parked pages appeared referring to the Complainant and that Ms. Widome had no control over the content of the parked pages that were displayed at that time. Once she discovered that there were advertisements concerning the Complainant, she immediately had them removed.

The Respondent has the view that one link attributing the Complainant for a very short period of time and the subsequent removal of such link is *de minimus* at best and cannot be construed as bad-faith use of the Domain Name.

The Respondent continues to argue that presently there is no bad faith use and in the past there was no bad faith use because the website is presently inactive and was inactive from 2004-2006. As recently as 2012 there were only advertisements not concerning the Complainant and for the past approximately 10 months there had been no website.

The Respondent asserts that the Complainant does not hold the exclusive rights for the name "Johnson's" for every category of use in the world. Johnson is the second common surname in the U.S.A. Thus the Respondent has a legitimate interest to use the Domain Name for prospective clients with the last name "Johnson" and is entitled to the Domain Name for the benefit of the Respondent's future clients.

The Respondent finds that the Complainant should be barred by the Complainant's delay in bringing the re-filed Complaint.

Moreover, the Respondent states the Panel should declare that the Complainant has committed reverse domain hijacking by bringing its baseless re-filed Complaint.

6. Discussion and Findings

A. *Res Judicata* / Re-filed Complaint

The Domain Name has already been the issue of a UDRP proceeding, namely *Johnson & Johnsons v. Tomato Pages Website Production Services*, NAF Claim No. 162058. Both the Complainant and the

Respondent have referred to the said case in their argumentation and asked the Panel to consider the previous case as part of the evidence and background for the Decision in the present dispute. Further, the Respondent states that this proceeding is *res judicata*.

A “Re-filed Complaint” within the scope of the Policy, is where the same complainant files a complaint against the same respondent and regarding the same domain name as in a previously decided complaint. As discussed in several previous UDRP cases, (*i.e. Grove Broadcasting Co. Ltd.v. Telesystems Communications Limited*, WIPO Case No. D2000-0703; *Creo Products Inc.v. Website In Development*, WIPO Case No. D2000-1490; *AB Svenska Spel v. Andrey Zacharov*, WIPO Case No. D2003-0527) re-filing may only be allowed in exceptional circumstances.

As stated by the panel in *Creo Products Inc. v. Website In Development*, WIPO Case No. D2000-1490 “in determining the circumstances in which Refiled Complaints should be entertained under the Uniform Policy, a distinction should be drawn between (i) Refiled Complaints that concern the act which formed the basis of the original complaint, and (ii) Refiled Complaints that concern acts which have occurred subsequent to the decision on the original complaint.” For the first type, acceptance of Re-filed Complaints should be exceptional. “In relation to the second type... a different approach is warranted. With a Refiled Complaint of this type, the concept of *res judicata* does not arise. Because the subsequent complaint concerns acts which occurred after the original decision, it is not an action upon which an adjudication has already taken place; the subsequent complaint is truly a new action under the Uniform Policy. It follows that, subject to one exception, the merits of a Refiled Complaint of this type should be determined in the same manner as any new complaint under the Uniform Policy. The exception is that the acts on which the Refiled Complaint is based should not be, in substance, the same as the acts on which the previous complaint was based (even if those previous acts would likely be included as part of the facts and arguments asserted in the new complaint).”

In this case, the Complainant and the Domain Name are the same as in the previous NAF Case. The Panel finds that the Domain Name has, since then, been transferred to a new holder within the same group of companies/owners as in the previous case. Further, the state of use of the Domain Name has changed. The Panel therefore concludes that the present dispute concerns a number of acts that have occurred subsequent to the decision of the original complaint and the present dispute shall be seen as a new action under the Policy.

In addition to that, the Panel notes that the preceding complaint was filed against a different Respondent. Therefore, under the circumstances, the Complaint cannot be regarded as a re-filing and the Complaint is admissible on this basis.

However, as both Parties have referred to the previous NAF case concerning <johnsons.com>, the Panel will consider the facts and circumstances described in that case in deciding the present dispute in the extent the Panel finds appropriate.

B. Identical or Confusingly Similar

The Complainant has obtained multiple trademark registrations for JOHNSON'S (*e.g.*, Reg. No. 620,110 of January 24, 1956 and Reg. No. 976,090 of January 1, 1974) with the United States Patent and Trademark Office (“USPTO”).

The Panel finds that the Complainant has established rights in the JOHNSON'S mark for purposes of the Policy through its trademark registrations with the USPTO; see *Janus Interantional Holding Co. v. Scott Rademacher*, WIPO Case No. D2002-0201 (finding that panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttal presumption that the mark is inherently distinctive. The respondent has the burden of refuting this assumption.)

The relevant part of the Domain Name is “johnsons”. The addition of the generic top-level “.com” is insufficient to distinguish the Domain Name from the Complainant’s mark.

The only difference between the Complainant's trademark JOHNSON'S and the Domain Name is that the Domain Name does not have an apostrophe between the two ending letters "n" and "s". Apostrophes are not permitted to be used in domain names, for pure technical reasons. The lack of the apostrophe in the Domain Name, compared to the Complainant's trademark is therefore not enough to create an independent distinctive domain name. See *L'Oreal v. Cheng*, WIPO Case No. D2008-0437.

Furthermore in the previous NAF case between the Complainant and Tomato Pages the Panel also found that <johnsons.com> is confusingly similar to Complainant's trademark JOHNSON'S. The Panel finds that this also true.

The Panel therefore concludes that <johnsons.com> is confusingly similar to the Complainant's trademark JOHNSON'S, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

In light of the Panel's finding below it is not necessary for the Panel to come to a decision in this regard.

D. Registered and Used in Bad Faith

As what can be seen at Annex M of the Complaint, the Domain Name was registered in the name of the Respondent on November 12, 2006. Although the Respondent refers to prior dates, the Respondent does not object to November 12, 2006 as the registration date for the current holder (the Respondent).

Both parties refer to the prior case *Johnson & Johnson v. Tomato Pages Website Production Services*, NAF Claim No. 162058, regarding the same domain name.

The owner of the current named registrant– the Respondent - of the Domain Name, was closely related to the previous holder. The majority of the Panel therefore agrees that the corporate entity which holds the current registration is in fact owned by the same personnel who made the original purchase in 1997. While a transfer of ownership in most cases would warrant a new review, the fact that the owners remain the same simply does not support an inference in this case that the absence of bad faith at the time of the original registration, which the Panel accepts on the basis of the evidence has changed.

However, in order to fulfill this third requirement, the Panel finds that the Domain Name must both be considered as registered *and* used in bad faith. The Panel however sees no substantial bad faith in this case.

Even if the Panel finds that there was some bad faith use between 2004 and 2006 this would be not enough for a transfer of the Domain Name <johnsons.com> to the Complainant, because the majority also finds that the registration was not in bad faith and all Panel members agree that there is no present bad faith use.

It is proved by the Complainant, and undisputed by the Respondent, that <johnsons.com> has been linked to a pay-per-click and pop-up advertising site with links to the Respondent's goods by at least May 2011.

Normally, a respondent will be deemed responsible for content appearing on a website at its domain name, even if such registrant may not be exercising direct control over such content, for example, in the case of advertising links appearing on an "automatically" generated basis. To the extent that the presence of certain advertising or links under such arrangement may constitute evidence of bad faith use of the relevant domain name, such presence would usually be attributed to the registrant unless it can show some good faith attempt toward preventing inclusion of advertising or links which profit from trading on third-party trademarks.

In this case, the Respondent states that the Respondent had no initial knowledge of the automatic pay-per-click advertising links that was automatically added to the parking site using the Domain Name, but when being aware of this, the Respondent took actions to change the links in order not to refer to the Complainant's trademark. Further, when discovering that the parking site had changed again, the Respondent states that in order to avoid the same thing happening again, decided to take down the website

entirely.

The Panel finds no reason or the evidence to challenge the Respondent's statement.

Although the specific time and date for the take-down is not clearly specified, the fact that the Domain Name is currently no longer in use is confirmed by the Complainant.

Considering the history of the Domain Name, the relations between the Respondent and the previous holder, and the fact that the Respondent has shown some good faith attempt toward preventing and inclusion of advertising or links which profit from trading on the Complainant's trademark, the Panel cannot come to any other conclusion than that substantial bad faith use is not proved by the Complainant.

The Panel agrees that the requirements for registration and use in bad faith are not given in this case.

Reverse Domain Name Hijacking

The Respondent suggests that the Complainant is guilty of Reverse Domain Name Hijacking.

Paragraph 15(e) of the UDRP Rules provides that, if "after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding". Reverse Domain Name Hijacking is defined under the UDRP Rules as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name".

There is no evidence of harassment from the Complainant, and the accusations and presumptions filed against the Respondent are well within the scope of what the Panel finds acceptable from a trademark owner who discovers a domain name that may infringe its trademark rights.

The Panel therefore states that this is *not* a case of Reverse Domain Name Hijacking.

7. Decision

For all the forgoing reasons, the Panel agrees that the request for transfer <johnsons.com> to the Complainant is denied.

Maxim H. Waldbaum
Panelist (Chair)

Diane Cabell
Panelist

Petter Rindforth
Panelist (Dissenting)

Date: October 15, 2013

Dissenting Opinion

I fully agree with the majority Panelists regarding the conclusion on *Res Judicata* / Re-filed Complaint, namely that the Complaint cannot be regarded as a re-filing and that the Complaint is admissible.

I further fully agree that <johnsons.com> is confusingly similar to the Complainant's trademark JOHNSON'S, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

I also agree that, in the light of what the Panel has found regarding Registration and Use in Bad Faith, there is not necessary for this panel to come to a decision on Rights or Legitimate interests.

However, I respectfully partly disagree with the Panel majority's ground on Registration and Use in Bad Faith.

As stated above regarding *Res Judicata* / Re-filed Complaint, referring to the previous NAF case *Johnson & Johnsons v. Tomato Pages Website Production Services*, NAF Claim No. 162058, the Panel finds that the Domain Name has, since then, been transferred to a *new holder* within the same group of companies/owners as in the previous case. Thus, the owner of the current named registrant – the Respondent - of the Domain Name was closely related to the previous holder.

At the time <johnsons.com> was transferred to, and registered in the name of the Respondent it is therefore obvious for me that the Respondent was well aware of the fact that the Domain Name was “confusingly similar” to the Complainant's “registered and famous” trademark JOHNSON'S (see *Johnson & Johnson v. Tomato Pages Website Production Services*, NAF Claim No. 162058).

I therefore conclude that <johnsons.com> was registered by the Respondent in bad faith, based on the fact that the Respondent, at the time of registration of the Domain Name was at least on constructive notice of the Complainant's registered trademark.

However, in order to fulfill this third requirement, the Domain Name must both be considered as registered *and* used in bad faith. Here, I fully agree with the Panel majority that bad faith use is not proved by the Complainant.

Finally, I agree with the Panel majority that this is *not* a case of Reverse Domain Name Hijacking.

Petter Rindforth

Panelist (Dissenting)

Date: October 15, 2013