

ADMINISTRATIVE PANEL DECISION

Tosara Pharma Ltd. v. Liu Fen
Case No. DCO2023-0011

1. The Parties

The Complainant is Tosara Pharma Ltd., Ireland, represented by SILKA AB, Sweden.

The Respondent is Liu Fen, China.

2. The Domain Name and Registrar

The disputed domain name <sudocrem.co> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 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 (Domain by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 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 amendment to the Complaint on February 10, 2023.

The Center verified that the Complaint together with the amendment to 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 February 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 6, 2023.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on March 13, 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 was founded in 1954 and is a subsidiary of the Israeli multinational pharmaceutical company Teva Pharmaceutical Industries Ltd established in 1901. The Complainant produces and commercializes various pharmaceutical products, including topical creams, antiseptic creams, pain medicine, antibiotics, psoriasis medicines, infection medication, as well as an over-the-counter medicated cream, invented in 1931, which is sold under the brand SUDOCREM and is available in more than 40 countries for the treatment of sore skin, nappy rash, eczema, and acne, with estimated annual global sales of 34.5 million units.

The Complainant holds a number of registrations for the trademark SUDOCREM in numerous jurisdictions, including the European Union Trade Mark Registration No. 00239442, SUDOCREM, word, registered on October 2, 2000, in classes 3, and 5; and the International Trademark Registration No. 886513, SUDOCREM, figurative, registered on May 19, 2006, in classes 3 and 5, designating, among other jurisdictions, China, (collectively the “SUDOCREM mark”).

Prior decisions have recognized the widespread reputation of the SUDOCREM mark.¹

The Complainant further owns numerous domain names that comprise or contain the SUDOCREM mark, including the domain name <sudocrem.com> (registered on May 2, 1999) that resolves to its corporate website. Other domain names owned by the Complainant include <sudocrem.co.uk>, <sudocrem.ca>, <sudocremtube.com>, <sudocremskincare.com>, <sudocremskincare.co.uk>, <sudocrembabyshower.com>, <sudocremcareandprotect.com>, <sudocremservice.com>, <sudocremadmin.com>, and <mylittlesudocrem.com> (all registered before the registration of the disputed domain name).

The disputed domain name was registered on November 24, 2022, and resolves to a parked page of Dan.com (the Registrar’s brand) that informs that the disputed domain name is for sale, and offers it for the price of USD 1,450.

5. Parties’ Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The Complainant operates under the SUDOCREM mark since 1950, and first registered this trademark in 1971. The SUDOCREM mark and the Complainant’s products have been conferred with numerous awards, and the SUDOCREM mark is internationally used and well known.

The disputed domain name is identical to the SUDOCREM mark. The addition of the country code Top-Level Domain (“ccTLD”) “.co” does not differentiate the disputed domain name from this trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The term “sudocrem” is not descriptive but rather a highly distinctive trademark, and the SUDOCREM mark has been in use by the Complainant in relation to pharmaceuticals since 1950, having global presence. The Respondent is neither a licensee and/or an authorized agent of the Complainant nor in any other manner authorized to use the SUDOCREM mark. The disputed domain name has been parked for sale at Dan.com for USD 1,450, which is neither a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use under the Policy. The disputed domain name is intended to exclusively “pass off” as the Complainant herein and have a free ride on its reputation and goodwill.

¹ See *Forest Tosara Limited v. 王晓文 (Wang Xiao Wen)*, WIPO Case No. [DCN2019-0008](#); and *Tosara Pharma Ltd. v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2022-5036](#).

The disputed domain name was registered and is being used in bad faith. The SUDOCREM mark extensive use and presence over the Internet makes implausible that the Respondent did not have knowledge of the Complainant and its prior rights over this mark. The Respondent (being a domain name investor or domainer) has an affirmative obligation to avoid the registration of trademark-abusive domain names. The Respondent should have screened such registrations against readily available online databases to avoid the registration of a trademark-abusive domain name. The disputed domain name is for sale in an amount in excess of the Respondent's out-of-pocket costs of registration, which indicates it was registered for the sole purpose of selling it with opportunistic bad faith. It is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") that it considers supportive of its position, and requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

The Complainant indisputably has rights in the SUDOCREM mark, both by virtue of its trademark registrations and as a result of its continuous use of this mark over more than 70 years.

The disputed domain name incorporates the SUDOCREM mark in its entirety, adding the ccTLD ".co", which is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. The disputed domain name is identical to the Complainant's trademark. See sections 1.7, and 1.11 of [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the first element of the Policy under paragraph 4(a) has been satisfied.

B. Rights or Legitimate Interests

The Complainant's above-noted assertions and evidence in this case effectively shift the burden to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case. However, the Respondent has not replied to the Complainant's contentions, not providing any explanation or evidence of rights or legitimate interests in the disputed domain name.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

A core factor in assessing fair use of a domain name is that it does not falsely suggest affiliation with the Complainant's trademark. See section 2.5, [WIPO Overview 3.0](#). The disputed domain name incorporates the SUDOCREM mark in its entirety being identical to this trademark and therefore denoting a risk of implied affiliation and confusion.

The Panel further notes that the disputed domain name is almost identical to the Complainant's domain name used for its corporate website ("www.sudocrem.com"). This circumstance without doubt aggravates the risk of confusion and implied affiliation for Internet users.

The Panel further considers that the Complainant has made out a *prima facie* case that the Respondent could not have rights or legitimate interests in respect of the disputed domain name, not being authorized to use the SUDOCREM mark and no evidence existing that suggests that the Respondent may be commonly known by the disputed domain name. In this respect, the Panel notes that the Respondent's name provided in the registration of the disputed domain name was originally concealed under a privacy service, and has no resemblance with the disputed domain name.

The Panel further notes that the term "sudocrem" is a coined term, without any direct dictionary meaning.

The Panel has corroborated that, according to the evidence provided by the Complainant, the disputed domain name resolves to a parked page that offers for sale the disputed domain name. The Panel considers that, although the business of registering and selling domain names may confer rights or legitimate interests under the Policy under certain circumstances, due to the implied affiliation and likelihood of confusion generated by the disputed domain name with the Complainant's trademark, in the present case this activity cannot be considered a *bona fide* use under the Policy.

It is further remarkable that the Respondent has chosen not to reply to the Complaint, not providing any information or evidence in connection to any rights or legitimate interests in the disputed domain name.

All the above-mentioned circumstances lead the Panel to conclude that nothing in the case file gives any reason to believe that the Respondent has any rights or legitimate interests in respect of the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant to establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof is, likewise, the "balance of probabilities" or "preponderance of the evidence". See section 4.2, [WIPO Overview 3.0](#).

The Panel notes the alleged continuous and extensive use of the SUDOCREM mark for over 70 years (since 1950), and its extensive presence over the Internet, as well as the reputation of this trademark recognized by previous decisions.²

The Panel has further corroborated the extensive use of the SUDOCREM mark over the Internet. In this respect, the Panel, under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has conducted a search over the Internet for the term "sudocrem" finding numerous results all referring to the Complainant and its products.

These circumstances makes implausible that the Respondent did not know about the Complainant and its SUDOCREM mark when he registered or acquired the disputed domain name. The Panel further considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain name:

- (i) the disputed domain name incorporates the Complainant's trademark in its entirety being identical to this mark;
- (ii) the term "sudocrem" is a coined term, with no direct dictionary meaning;

² See footnote No. 1, *supra*.

- (iii) the SUDOCREM mark is reputed and the Complainant operates internationally, including in China, where the Respondent is located according to the Registrar verification;
- (iv) the disputed domain name is almost identical to the Complainant's domain name <sudo crem.com>, which resolves to the Complainant's corporate website for the products commercialized under the SUDOCREM mark, and the Panel has corroborated that this corporate website is being in use at least for 20 years (since 2003);³
- (v) according to the evidence provided by the Complainant, the disputed domain name, identical to the Complainant's trademark, resolves to a parked page, which offers for sale the disputed domain name for a price likely exceeding the Respondent's out-of-pocket costs (USD 1,450);
- (vi) the Respondent used a privacy service to register the disputed domain name; and
- (vii) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name and has not come forward to deny the Complainant's assertions of bad faith, choosing not to reply to the Complaint.

The Panel also observes that the Respondent has been apparently the unsuccessful respondent in at least other eight UDRP proceedings that are easily located by a search of the Center's public decisions database. Additionally, the Panel notes that one of these cases refer to a domain name that incorporates other trademark of the Complainant's group, namely the AJOVY trademark owned by the Complainant's parent company Teva Pharmaceutical Industries Ltd., (see *TEVA Pharmaceuticals International GmbH v. Privacy Protection/ LIU FEN*, WIPO Case No. [D2022-0034](#)).⁴

The Panel therefore finds that that these results show a pattern of bad faith on the Respondent who deliberately targeted the Complainant, its parent company, and other third parties' brands, and is engaged in a pattern of bad faith conduct that supports a further finding of bad faith against the Respondent. See section 3.1.2, [WIPO Overview 3.0](#).

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel considers that the disputed domain name was registered and is being used to target the SUDOCREM mark, in bad faith, with the intention of obtaining a free ride on the established reputation of the Complainant and its trademark.

The Panel finds that, on a balance of probabilities, the disputed domain name was primarily registered and use for the purpose of transferring it to the Complainant or to one of its competitors, for valuable consideration in excess of the documented out-of-pocket costs directly related to its registration or acquisition. The Respondent's actions have further prevented the Complainant from reflecting the SUDOCREM mark in a corresponding domain name. These actions constitute bad faith under paragraphs 4(b)(i) and (ii) of the Policy.

Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain name has been registered and is being used in bad faith.

³ The Panel, under its general powers, has consulted the public Internet archive WayBackMachine in connection to the Complainant's corporate website at "www.sudocrem.com", finding various captures of this site since 2003 until 2023.

⁴ Other cases related to the same Respondent are: *Laboratoires Thea v. Liu Fen*, WIPO Case No. [DCO2022-0119](#); *LEGO Juris A/S v. LIU FEN*, WIPO Case No. [D2023-0069](#); *Boursorama S.A. v. Liu Fen*, WIPO Case No. [DCO2022-0108](#); *IIC-INTERSPORT International Corporation GmbH v. Liu Fen*, WIPO Case No. [DCO2022-0113](#); *Boehringer Ingelheim International GmbH v. Liu Fen*, WIPO Case No. [DCO2022-0111](#); *Boehringer Ingelheim International GmbH v. Liu Fen*, WIPO Case No. [DCO2022-0112](#); and *Landesbank Baden-Württemberg (LBBW) v. Privacy Protection/ Liu Fen*, WIPO Case No. [D2021-3992](#).

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 <sudoكرم.co> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: March 23, 2023