Decision for dispute CAC-UDRP-107454

Case number	CAC-UDRP-107454
Time of filing	2025-04-01 12:11:03
Domain names	sudocremcare.shop

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Norton Creams Limited

Complainant representative

Organization	SILKA AB

Respondent

Name	Richard Bergeron

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant, Norton Creams Limited, with domicile in Waterfront, Ireland, is the owner, amongst others, of the following trademark registration:

US Trademark registration number 6661832 SUDOCREM (Fig.), filed on 20 November 2020 and registered on 8 March 2022 and being a designation belonging to the International Registration number 1573223 according to the Madrid Protocol.

Complainant has submitted evidence of the above mentioned registrations by showing a detailed extract from TEAS, the trademark database of the United States Patent and Trademark Office, followed by two assignment **recordals** assigning the trademark first from Tosara Pharma Limited to Norton (Waterfort) Limited and next assigning it to Norton Creams Limited.

Further, Complainant submits a list of trademark registrations registered throughout the world made available via the Global Brand Database of WIPO. All these trademarks include the word SUDOCREM.

Lastly, Complainant claims that Complainant (including its predecessor) owns common law rights in the mark since the 1950s. The Panel understands this as these common law rights are applicable in Ireland.

FACTUAL BACKGROUND

Complainant (subsidiary of the well-known Israeli company Teva Pharmaceutical Industries Ltd) is an Irish Pharmaceutical company which specializes in developing and marketing both branded ethical products and non-prescription pharmaceutical products sold over the counter. For instance, Complainant produces and markets topical creams, antiseptic creams, cough drops, pain medicine, antibiotics, psoriasis medicines, infection medication, and other pharmaceuticals. Among the great variety of pharmaceutical products sold by Complainant, it stands out as an over-the-counter medicated cream for soothing sore skin, treating nappy rash, eczema and acne, sold under the brand name SUDOCREM.

Invented by the Dublin-based pharmacist Thomas Smith in 1931, SUDOCREM was originally called "Smith's Cream", later "Soothing Cream". The name changed to SUDOCREM in 1950 due to the Dublin accent pronunciation of soothing cream. Since its adoption, according to Complainant, Complainant's trade name/mark has been identified by the purchasing public exclusively with Complainant and has acquired enormous goodwill in several countries across the globe.

SUDOCREM has become a multi-award-winning branded product and Complainant has submitted evidence in this respect. The product is available in more than 40 countries, with estimated global sales of 34.5 million pots each year. The Panel however did not find evidence on this in the Complaint. No annual reports have been submitted to verify these statements but as these were also accepted by other Panels in similar UDRP cases, which will be discussed later in this decision, the Panel considers this a fact.

Further, Complainant states that the profile and popularity of Complainant under the trade mark SUDOCREM has been continuously increasing since the date of adoption and the trademark has received wide recognition. Google Search of the term SUDOCREM throws up a huge number of results, which exclusively pertain to Complainant and its mark SUDOCREM and otherwise distinctive mark SUDOCREM also regularly features in the news. Several examples were submitted by Complainant.

Complainant mentions also that SUDOCREM has a huge social media presence being active on channels like YOUTUBE, FACEBOOK and INSTAGRAM and is also available on WIKIPEDIA.

Lastly, Complainant informs that it uses its mark in numerous .com and .cc domain names that all predate the registration of the disputed domain name <SUDOCREMCARE.SHOP>.

Respondent registered the domain name <SUDOCREMCARE.SHOP> on 7 August 2024. The domain name does not resolve to a website.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
No administratively compliant Response has been filed.

RIGHTS

According to the Policy paragraph 4(a)(i) it needs first to be established that:

(i)The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

Complainant claims that it was the first in the world to have conceived and adopted the distinctive mark SUDOCREM, almost seventy years ago. The said mark SUDOCREM has been openly, continuously and extensively used globally since 1971, when it applied for its first mark for registration under class 5 and is active as of date. Complainant owns many trademark registrations for SUDOCREM marks in various jurisdictions.

Complainant alleges that SUDOCREM is certainly not a descriptive term serving to indicate specific characteristics of any other goods or services but rather a highly distinctive mark used for the antiseptic cream produced by Complainant and also refers in this respect to Tosara Pharma Ltd. v. Liu Fen, WIPO Case No. DCO2023-0011: "The Panel further notes that the term '**sudocrem**' is a coined term, without any direct dictionary meaning."

The disputed domain name incorporates the mark SUDOCREM in its entirety, along with related keywords. The registration and the use of the confusingly similar disputed domain name is a direct infringement of the legitimate rights held by Complainant in the mark SUDOCREM, as Complainant states.

UDRP Panels have found that a disputed domain name is confusingly similar to a Complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety. This view was also shared by the Panel in UDRP case No. D2021-4062 <sudocremnaturcare.com> and <sudocremnaturkind.com> respectively.

Lastly, the addition of the TLD ".shop" does not differentiate the domain name from the trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.11).

Additionally, the previous WIPO panel has recognized Complainant's rights in its SUDOCREM marks, see WIPO Case No. D2024-1164 (sudocrema.com) and more.

It is likely that Complainant has trademark rights, being registered or unregistered in Ireland, as this can be concluded from the various UDRP decisions on domain names containing SUDOCREM and as submitted by Complainant. But also in this case the Panel firstly needs to assess if Complainant has submitted sufficient evidence of acquired trademark rights. The Panel concludes that the submitted and detailed extract from TEAS, the database of the US Patent and Trademark Office, will suffice as it demonstrates the registration of SUDOCREM in a red quadrilateral with two rounded sides.

This trademark registration predates the registration of the disputed domain name and thus the trademark rights prevail for as far as the disputed domain name is identical or similar.

The Panel agrees with Complainant that SUDOCREM is the distinctive element of the trademark registration. The disputed domain name consists however of the elements SUDOCREM, CARE and SHOP.

Having the disputed domain name followed by a descriptive term, being CARE, a term that provides information on the use of the trademark leads to the conclusion that CARE is no more than a descriptor, an explanation of the use of the trademark.

Further it is commonly agreed by panels that the TLD does not differentiate the domain name.

Thus, the Panel agrees with this assertion of Complainant that the disputed domain name is similar to its trademark.

Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

According to the Policy paragraph 4(a)(ii) it needs further to be established that:

(ii) Respondent has no rights or legitimate interests in respect of the domain name.

Paragraph 4 (c) of the Policy provides circumstances that could demonstrate that Respondent has no rights to and legitimate interests in the disputed domain name. These circumstances are not exclusive. Circumstance that are providing rights or legitimate interests to the domain name are:

(i) before any notice to the Respondent of the dispute, the use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if though it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Further, according to the WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd., Complainant is required to make out a prima facie case that Respondent lacks rights or legitimate interests. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

According to Complainant Respondent has no rights on the disputed domain name. In fact Complainant claims that Respondent is a cybersquatter and submits a decision of a Forum UDRP Claim Number: FA2502002140959 in which Respondent has been decided to be in bad faith under the Policy. Further, Complainant submits a list of other domain name disputes with respect to .shop extension and against Respondent that shows that all domain names were transferred.

Next, Complainant alleges that Respondent is neither a licensee nor an authorized agent of the Complainant nor in any other manner authorized to use Complainant's distinctive trademark SUDOCREM. Since there is no such authorized association, it is indeed extremely difficult to foresee any justifiable use that the Respondent may have with the disputed domain name <sudocremcare.shop>. Specifically, the disputed domain name has been held passively and currently does not resolve to an active website. This is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the domain name in terms of the Policy.

Furthermore, as Complainant states that a core factor in assessing fair use of disputed domain nameis that it does not falsely suggest affiliation with the Complainant's trademark. The disputed domain name however, incorporates the SUDOCREM mark in its entirety being identical to this trademark and therefore denoting a risk of implied affiliation and confusion,

Complainant continues with mentioning that the mark SUDOCREM is a registered trademark, and it is evident from the formation of the disputed domain name <**sudocremcare.shop**> that Respondent was aware of Complainant's mark, its business activities, and

intentionally included the keyword “care” in the disputed domain name, which is directly related to Complainant's business and product offerings. The disputed domain name registered by the Respondent is clearly intended to exclusively “pass off” as Complainant herein and have a free ride on its reputation and goodwill. Furthermore, there cannot be a plausible or legitimate good-faith use of the disputed domain name.

In view of the prior rights of the Complainant in the trademark SUDOCREM and the enormous goodwill and reputation vested in the Trademark, it is evident from the above assertions that the sole purpose behind Respondent registering the disputed domain name is to take undue advantage of the Complainant’s mark SUDOCREM.

Respondent did not file a Defense.

Complainant has, to the satisfaction of the Panel, shown Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

According to the Policy paragraph 4(a)(iii) it finally needs to be established that:

(iii) the domain name has been registered and is being used in bad faith.

Paragraph 4 (b) of the Policy provides circumstances to demonstrate that Respondent has registered and used the domain name in bad faith. These circumstances are not exclusive. Those circumstances are for example:

(i) circumstances indicating that Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to it’s web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Complainant alleges that Complainant’s popularity is evident by the numerous domain names it already owns, some of which act as a window to the public all over the world to know more about its products and services. Such wide usage of the trademark has resulted in the mark transcending regional boundaries and acquiring an enviable trans-border reputation.

Additionally, the top search results for ‘**Sudocrem Care Shop**’ clearly pertain to Complainant’s offerings as shown in a submitted Google search. It follows, as Complainant concludes, that it is therefore evident that, notwithstanding any other considerations, the simplest degree of due diligence would have otherwise made a registrant of the disputed domain name aware of Complainant’s rights in the globally renowned SUDOCREM mark. The same was also concluded in another UDRP decision: Tosara Pharma Ltd. v. Liu Fen, WIPO Case No. DCO2023-0011 <sudocrem.co>, where the following is stated:

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. 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 Complainant and its products.

The reputation of SUDOCREM is with the above as well as the various documents on its social media presences, the awards won as well as its 90 years of existence and website prints sufficiently substantiated, according to the Panel.

Bad faith registration

Complainant cites UDRP case: Tosara Pharma Ltd. v. Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2022-5036 <sudocreme.com>:

On the issue of registration, this Panel infers that Respondent has deliberately targeted Complainant’s brand when it registered the disputed domain name and knew, or should have known, that its registration of the disputed domain name would be confusingly similar to Complainant’s trademark (see WIPO Overview 3.0, section 3.2.2).

In addition, the gap of several years between registration of the Complainant's trademark and the Respondent's registration of the disputed domain name, along with the composition of the disputed domain namein the circumstances of this case is a further indicator of bad faith. (See Asian World of Martial Arts Inc. v. Texas International Property Associates, WIPO Case No. D2007-1415).

The Panel follows the reasoning with respect to bad faith registration and agrees with it.

Bad faith use

With respect to determining if the domain name is also used in bad faith, the Panel has to weigh whether the passive holding of the disputed domain name can be identified as use in bad faith. In previous UDRP decisions circumstances are described that would establish that also the use of the disputed domain name, namely the passive holding of it, is use in bad faith. Those circumstances are

(i) Complainant's trademark has a strong reputation and is widely known;

(ii) Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,

(iii) Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,

(iv) Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

(v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

On the bad faith as Respondent's end Complainant cites i.a. Tosara Pharma Ltd. v. Liu Fen, WIPO Case No. DCO2023-0011 **<sudocrem.co>**:

The Panel also observes that the Respondent has been apparently the unsuccessful Respondent in at least eight other UDRP proceedings that are easily located by a search of the Center's public decisions database... The Panel therefore finds that these results show a pattern of bad faith on Respondent who deliberately targeted 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.

Complainant concludes that registration of an identical or confusingly similar domain name that is patently connected with a particular trademark owned by an entity with no connection with the trademark owner is indicative of opportunistic bad faith as understood in the Policy. Given the foregoing, the use and registration of the disputed domain name is clearly intended to capitalize on consumer confusion for Respondent's profit, a bad faith registration and use under the Policy.

Based on the above the Panel has the following findings.

Complainant has sufficiently shown its reputation.

Further, the bad faith use and registration of the disputed domain name are demonstrated and enhanced by the various other UDRP decisions in which the same was established.

Respondent did not file any Defense and also therefore the allegations of Complainant can be considered as true.

Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **sudocremcare.shop**: Transferred

PANELLISTS

Name	Marieke Westgeest

DATE OF PANEL DECISION 2025-05-05

Publish the Decision