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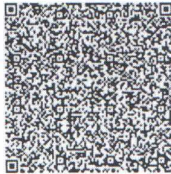
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e-Stamp

Certificate No.	: IN-DL63197444520606T
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Account Reference	: SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
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Purchased by	: KARNIKA SETH
Description of Document	: Article 12 Award
Property Description	: ARBITRATION AWARD UNDER INDRP POLICY
Consideration Price (Rs.)	: 0 (Zero)
First Party	: KARNIKA SETH
Second Party	: NOT APPLICABLE
Stamp Duty Paid By	: KARNIKA SETH
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)

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ARBITRATION AWARD

Before the Sole Arbitrator, Dr. Karnika Seth

IN INDRP Case No. 1457

[Signature]

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.IN REGISTRY
(NATIONAL INTERNET EXCHANGE OF INDIA)
.IN Domain Name Dispute Resolution Policy (INDRP)

Disputed Domain Name: www.sudocrem.co.in

Dated: 13th December, 2021

IN THE MATTER OF:

Tosara Pharma Limited
Unit 146, Baldoyle Industrial Estate,
Grange Road, Baldoyle
Dublin D13 CD79, Ireland

..... Complainant

Vs.

Beau Shop
25/5, Bannerghatta Main Road,
J.P. Nagar, 4th Phase, Dollars Colony
Bengaluru -560078
Karnataka, India

..... Respondent

1. Parties

- 1.1. The Complainant in the arbitration proceeding is Tosara Pharma Limited, having address at Unit 146, Baldoyle Industrial Estate, Grange Road, Dublin D13 CD79, Ireland. The Complainant is represented by Silka Law, Stockholm, Sweden.

1.2. The Respondent in this arbitration proceeding as per the 'Whois' record is Beau Shop, in Karnataka, India (as per **Annexure II** of the Complaint). As the complete address of the Respondent is incomplete in the WHOIS report, in order to show the complete address of the Respondent the Complainant has made available screenshot from disputed domain name website (as per **Annexure V** & page 6 of the Complaint).

2. **The Dispute-** The domain name in dispute is "www.sudocrem.co.in" registered by the Respondent on 7th June, 2021. According to the .IN 'Whois' search, the Registrar of the disputed domain name is Godaddy.com.

3. **Important Dates**

S. No	Particulars	Dates (All Communication done in electronic mode)
1.	Date on which NIXI's email was received seeking consent for appointment as Arbitrator.	Nov 12, 2021
2.	Date on which consent was given to act as an Arbitrator in the case.	Nov 12, 2021
3.	Date of Appointment as Arbitrator.	Nov 12, 2021
4.	Soft Copy of complaint and annexures were received from NIXI through email.	Nov 12, 2021

5.	Date on which notice was issued to the Respondent	Nov 13, 2021
6.	Date on which Complainant filed proof of completed service of complaint on Respondent	Dec 9, 2021
7.	Date on which Award passed	Dec 13, 2021

4. Procedural History

- 4.1 This is mandatory arbitration proceeding in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP) adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of Procedure (the Rules) were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. The updated rules are available on <https://www.registry.in/INDRP%20Rules%20of%20Procedure>. By registering the disputed domain name accredited Registrar of NIXI, the Respondent agreed to the resolution of the dispute pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.
- 4.2 In accordance with the Rules 2(a) and 4(a) of INDRP Rules, NIXI formally notified the Respondent of the complaint and appointed Dr. Karnika Seth as a sole arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996 and the rules framed thereunder. The Arbitrator submitted the statement of Acceptance and Declaration of impartiality and independence, as required by NIXI
- 4.3 The complaint was filed in accordance with the requirements of the .IN Domain Name Dispute Resolution



- 4.4 The Arbitrator issued notice to the Respondent on 13 Nov, 2021 at the email address care@sudocrem.co.in calling upon the Respondent to submit his reply to the complaint within fifteen (15) days of receipt of the Arbitrator's email. The Complainant also filed proof of completed service of the complaint upon Respondent on Dec 9, 2021. Due to pandemic, service of hard copy of the Complaint upon the Respondent is being exempted and the electronic service is complete.
- 4.5 Despite the notice, the Respondent failed to file any reply. Therefore, in accordance with the Rule 12 of INDRP Rules, the Arbitration proceedings were conducted ex-parte and the Award is passed which is binding on both parties herein.

5. Factual Background

- 5.1 The Complainant, trading as Tosara Pharma Limited is an Irish Pharmaceutical company founded in 1954 which specializes in developing and marketing both branded ethical products and non-prescription pharmaceutical products sold over-the-counter. The Complainant is incorporated under the laws of Ireland and is a subsidiary of the well-known Israeli company Teva Pharmaceutical Industries Ltd.
- 5.2 The Complainant coined and adopted the trademark "SUDOCREM" in 1950 and using its trademark has been producing and providing a variety of topical creams, antiseptic creams, cough drops, pain medicines, antibiotics, psoriasis medicines, infection medication and other pharmaceuticals (as per **Annexure IX** of the complaint). The Complainant also sells over-the-counter medicated cream for

smoothing sore skin, treating nappy rash, eczema and acne using the trademark SUDOCREM.

- 5.3 The Complainant is registered proprietor of its trademark, SUDOCREM for past 68 years (first registration in Ireland) and since 1971 including in Australia, Canada, New Zealand, Switzerland, Jordan, Singapore, Malaysia, Ukraine, Korea, and through international registration in India, Azerbaijan, Bosnia and Herzegovina, Bhutan, China, Egypt, Great Britain, Ghana, Indonesia, Israel, Japan, Mongolia, Russia, Thailand and various other jurisdictions (as per **Annexure IV** of the complaint). Complainant registered its first trademark in Ireland in 1953 (as per **Annexure IV (d)** of the complaint).
- 5.4 The Complainant owns exclusive rights in the 'SUDOCREM' trademark in various countries including India (as per the **Annexures IV (a), (b)** of the complaint). The Trademark 'SUDOCREM' is registered in India in Class 3 & 5 under registration no. 1994095 (word mark) which was applied on 15th July 2010 and IRDI no.4852772 in class 99 (as per **Annexure IV (b)** of the complaint).
- 5.5 The Complainant has been using the "SUDOCREM" trademark distinctively in connection with its product and also maintains the website www.sudocrem.com (registered on May 02, 1999) and is active since 2003 and other formative country level domains for its trademark as per Para 7 the complaint. The Complainant's trademark SUDOCREM is available in more than 40 countries with estimated global sales of 34.5 million pots each year (as per Para 8 (A) of the complaint).
- 5.6 The Complainant's products are known for its various pharmaceutical products including in India and the trademark has achieved continuous

popularity and received wide recognition. The Complainant's trademark SUDOCREM when searched on Google shows results exclusively refer to the Complainant (as per **Annexure VII (a)** of the Complaint).

- 5.7 The Complainant also has extensive presence and following of its trademark on social media websites with 133K followers on Facebook, 25k followers on Twitter and 14k followers on Instagram, 3.2K followers on YouTube. (as per **Annexure VIII** of the complaint).
- 5.8 The Respondent in this arbitration proceeding as per the 'Whois' record is Beau Shop, in Karnataka, India (as per **Annexure II** of the Complaint). The email Id of the Respondent is care@sudocrem.co.in available at redirected website and appearing at www.sudocrem.in (as per **Annexure V** of the Complaint).

6. Parties Contention

6.1 Complainant's Submissions

- 6.1.1. Complainant operates its business using the trademark "SUDOCREM" and is engaged in developing and marketing ethical products and non-pharmaceuticals products with a comprehensive range since 1950. The Complainant claims that it has been using its mark continuously for its products not only in India but across various countries. Due to its established reputation worldwide including in India, the word SUDOCREM has been exclusively associated with the Complainant and no one else. The Complainant claims to have gained popularity, reputation and is widely known through use of its trademark "SUDOCREM".



6.1.2. The Complainant states that the trademark SUDOCREM is registered in India in classes 3 and 5 under registration no.1994095 (word mark) which was applied on 15th July 2010 and IRDI no.4852772 in class 99 (as per **Annexure IV (b)** of the complaint). The said trademark has been registered in various jurisdictions by Complainant. A list of trademark registration certificates granted in India and other countries in favour of Complainant are annexed with the complaint (as per **Annexure IV of the complaint**).

6.1.3. The Complainant submits it is the owner and proprietor of registered domain name www.sudocrem.com (registered on May 02, 1999) which features information about the products of the Complainant using the mark SUDOCREM. The Complainant also has a very strong social media presence on Instagram, Twitter, Facebook and YouTube with 14,000, 25,000, 133k and 3.26k followers respectively (as per **Annexure VIII** of the complaint). The Complainant also has presence on popular search engine www.google.com which displays Complainant's trademark in the main search result for the keyword 'SUDOCREM' that pertains to Complainant and no other entity/person (as per **Annexure VII (a)** of the complaint).

6.1.4. The Complainant also submits that SUDOCREM was invented by the Dublin-based pharmacist Thomas Smith in 1931. The trademark SUDOCREM is now a multi-award-winning product available in more than 40 countries, with estimated global sale of 34.5 million pots each year. Further, the Complainant submits that it has won many prestigious awards and accolades such as 2018 OTC Marketing Awards, 2017 Teva Purpose and Values Award, 2017 Nicholas Hall OTC International Award and 2017 OTC Bulletin Best OTC Public Relations Campaign

for a Non-Medicine Baby Changing Room Award (as per Para 8 (D) of the complaint.

6.1.5. The Complainant submitted that the disputed domain name www.sudocrem.co.in is identical to and is clear imitation of the 'SUDOCREM' trademark and has been used with an intention to deceive and mislead consumers at large. The Respondent has no legitimate interest or right in the domain name and has registered it to mislead consumers and capitalize on the Complainant's reputation and goodwill. The Complainant submits further that the Respondent registered the disputed domain name <sudocrem.co.in> that redirects to another domain name <sudocrem.in> considered as an active use by misleading the consumers and diverting the consumers to another website owned by Respondent.

6.1.6. Further, the Complainant submitted that the other domain name of Respondent <sudocrem.in> is being operated in blatant violation of Complainant's rights, as the logo, images, content has been copied from Complainant's official website (as per **Annexure V** of the complaint). The Complainant is relying on the registration of disputed domain name and redirected website at sudocrem.in as evidence of bad faith.

6.1.7. The Complainant has never granted any authorization, license or any right to the Respondent to use the trademark. However, to make unfair commercial gain and to tarnish the trademark of the Complainant, the Respondent registered the disputed domain name www.sudocrem.co.in using the trademark "SUDOCREM" in its entirety and then redirecting it to another domain name www.sudocrem.in. The Respondent has not shown its registration and use of disputed domain name in connection



with the bona fide offering of goods and services (as per **Annexure VI** of the complaint).

6.1.8. In addition, the Complainant submitted that the Respondent has registered the mark in bad faith and is using its trademark illegally. Such use is to attract internet traffic by creating a likelihood of confusion with the Complainant's name or mark and to make unjust monetary gain by falsely projecting an association or affiliation with the Complainant.

6.2. Respondent's Defence

6.2.1. On 26th Nov 2021, the Complainant sent a mail intimating the Arbitrator that Respondent has signed a settlement agreement agreeing to transfer the disputed domain name and annexed a signed settlement agreement. However, despite notice to Respondent sent again on 6th Dec, 2021, Respondent failed to participate in the arbitration and therefore such agreement cannot be taken on record. Therefore, pursuant to Rule 12 of INDRP the present arbitration was conducted ex-parte and award is passed which is binding on both parties.

7. Discussions and Finding

7.1 The .IN Domain Name Dispute Resolution Policy in para 4 requires Complainant to establish the following three requisite conditions: -

- a) The disputed domain name is identical or confusingly similar to the trademark in which Complainant has right
- b) The Respondent has no rights or legitimate interest in the domain name and
- c) The Respondent's domain name has been registered or is being used in bad faith

7.2 The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights (Paragraph 4(a))

The Complainant submitted that it owns various trademark registrations using the word "SUDOCREM" in many jurisdictions throughout the world including India and has filed documents of its registered trademark in India to prove its right in the trademark "SUDOCREM" (as per **Annexure IV (a), (b)** of the complaint). Therefore, it is established that the Complainant has statutory protection in trademark SUDOCREM in India w.e.f 15th July, 2010 which predates the registration of disputed domain name by Respondent i.e., 7th June 2021. The Complainant submitted that SUDOCREM is a trademark well recognized amongst the consumers worldwide, including in India as is extensively followed on social media and has huge goodwill on internet as well (as per **Annexure VIII** of the complaint). Thus, the trademark has popularity and has been continuously associated with Complainant since then in India.

The Arbitrator finds that the disputed domain name www.sudocrem.co.in is clearly identical and deceptively similar to Complainant's trademark in which the Complainant has exclusive trademark rights and the Complainant has submitted enough documentary evidence to prove its rights and ownership in SUDOCREM mark. A cursory glance at the disputed domain name <sudocrem.co.in> makes it obvious that the Respondent has exactly

incorporated the essential elements of the Complainant's SUDOCREM mark and thus the disputed domain name is identical/ deceptively similar to the Complainant's mark.

As per WIPO Synopsis 3.0, while each case is judged on its own merits, 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 domain name, the domain name will normally be considered confusingly similar to the mark for the purposes of UDRP standing. (*Dell Inc. v George Dell & Dell Netsolutions*, case no. D2004-0512 (WIPO Aug 24, 2004), *Busybody Inc. v Fitness Outlet Inc.* D 2000-0127 (WIPO April 22, 2000).

The disputed domain name consists of "SUDOCREM", the Complainant's trademark in entirety and the ccTLD ". co.in" which is likely to deceive and confuse consumers. It is well recognized that incorporating a trademark in its entirety, particularly if the mark is internationally well recognized mark, is sufficient to establish that the domain name is identical or confusingly similar to the Complainant's registered mark. (*LEGO Juris A/S v. Robert Martin*, INDRP/125(2010); *Viacom International Inc. v. MTV ALBUMS-Mega Top Video Albums Peter Miadshi*, WIPO case No. D2002-0196 (April 16, 2002); *Wal Mart Stores Inc. v. Kuchora Kal*, WIPO case no. D2006-0033 (March 10, 2006). The Complainant has cited numerous decisions of INDRP and WIPO panel regarding registration of domain names similar to the domain registered by the Respondent. The Complainant has relied on *Forest Tosara Limited v. (Wang Xiao Wen)*, WIPO DCN2019-0008,

Tosara Pharma Limited v. WhoisGuard Protected, WhoisGuard Inc/ Stephen Jadon, WIPO D2020-2273, CEC Entertainment Concepts, L.P. v. Samir Vasaya, INDRP/1154.

As the Respondent's disputed domain name incorporates entire mark of Complainant's trademark SUDOCREM, the Arbitrator finds that the Respondent's domain name is identical or confusingly similar to Complainant's registered trademark and is likely to deceive the customers.

7.3 The Registrant has no rights or legitimate interest in respect of the domain name (Para 4(b))

Under para 6 of the INDRP policy, a Respondent can prove rights or legitimate interest in the domain name. The Complainant has filed sufficient evidence to prove disputed domain name is identical to 'SUDOCREM' trademark, in which the Complainant enjoys substantial reputation and goodwill including registration of trademark in India and other jurisdictions (annexed as Annexure **IV (a), (b)** of the complaint). Complainant alleges Respondent has no legitimate interest in the disputed domain name and has brought on record web shots of its website and of disputed domain name wherein complainant's logo and other content from its website is copied allegedly without authorization (as per the **Annexures VI** of the complaint).

Despite notice, the Respondent has failed to prove any rights or legitimate interests in the disputed domain name/trademark 'SUDOCREM.' Thus, Respondent has failed to establish legitimate

interest and/or rights in the disputed domain name. Complainant has also submitted that it has not authorized nor licensed Respondent to use its SUDOCREM mark and Respondent has failed to rebut the same. The Complainant submits that the disputed domain name <sudocrem.co.in> is being redirected to impugned domain name <sudocrem.in> which is being used to take advantage of the Complainant's reputation in violation of the Complainant's protected rights and that the Respondent has registered the disputed domain name with a view to engage in unfair commercial use of the mark SUDOCREM with the sole aim to make illegal monetary benefits from unauthorised use of the goodwill and reputation of the Complainant's mark SUDOCREM. The Complainant has relied on *Medtronic Inc. v. Aytekin Yilmaz of Medo Tekstil Elecktronik Al. Sat. Tic. Ltd*, WIPO D2021-1758, *Grand Slam Tennis Properties Ltd. v. Withheld for Privacy ehf/ John Veresa*, WIPO D2021-1938.

Complainant contends that Respondent has registered the domain name only to take unfair advantage of Complainant's global reputation and goodwill. Further, the Complainant submitted that the Respondent does not have any rights or legitimate interest in the disputed domain name and it intends to make unjust and illicit commercial profits. Arbitrator is of the view that unlicensed and unauthorized use of domain name incorporating complainant's trademark proves respondent has no legitimate rights nor interest pursuant to ICANN Policy 4(b).

The Complainant submits that the bottom of web pages at the redirected website <sudocrem.in> displays the email ID in use by the Respondent-

care@sudocrem.in. There is likelihood that an actual or potential visitor to the web page of the impugned domain name or receiving any communications from an ID ending with @sudocrem.in or even @sudocrem.co.in will be misled to believe that the Complainant has licensed trademarks to the Respondent or that the Respondent has some affiliation with the Complainant. The Complainant has relied on *Accuray Incorporated v. Dr Sanjay Mongia*, INDRP/713.

It is the Respondent's responsibility to determine whether the Respondent's domain name registration is likely to infringe or violate someone else's rights. The Respondent has failed to discharge this burden as well.

Thus, for the aforesaid reasons, the Arbitrator finds that the Respondent has no rights and/or legitimate interests in the disputed domain name.

7.4 The Registrant's domain name has been registered or is being used in bad faith (Para 4(c))

For the purpose of Para 4 (c) of .IN Policy, under paragraph 7 of the policy, the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant submitted that 'SUDOCREM' trademark has acquired considerable amount of goodwill worldwide including India in respect of ethical and non-prescription pharmaceutical products with a wide variety of product range. The Complainant has secured registration of the mark "SUDOCREM" in India in classes 3 and 5 (annexed as

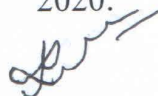
Annexure IV (a), (b) with the Complaint). The Respondent has produced no evidence of authorization from Complainant or justification for registering the disputed domain name. In fact, the Complainant has submitted that the Respondent's disputed domain name is <sudo crem.co.in> is being redirected for commercial purpose in an unauthorized manner to another domain name <sudo crem.in>. The Complainant also submits that it adopted its mark much prior to that of Respondent and that the Respondent has intentionally adopted disputed domain name www.sudo crem.co.in despite prior knowledge to make unfair gains which amounts to bad faith registration. The Complainant has relied on *HuntNews.in*, INDRP/782 to support its contention of bad faith registration.

The Complainant submitted that the disputed Domain Name has otherwise been redirected to domain name sudo crem.in. Such registration and redirection of the Domain Name cannot constitute a bona fide offering of goods and services. As per WIPO Overview 3.0, section 3.1.4, previous UDRP panels have consistently found that redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer amounts to bad faith use. Where a disputed domain clearly duplicates a Complainant's valid existing service mark, using that name to redirect internet users to a Respondent's own competing website does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use (*General Motors LLC v. MIKE LEE*, FA 1659965 (Forum Mar. 10, 2016)). The panels have further held that use of a disputed domain name to create confusion as to the affiliation of a Complainant with the

Respondent's competing website in question can support a finding of bad faith (*OneWest Bank N.A. v. Matthew Foglia*, FA 1611449 (Forum Apr. 26, 2015)).

Complainant submitted that Respondent's use at the redirected website is in complete violation of the Complainant's rights. The Complainant has relied on *Sanofi v. Privacy Protect, LLC (PrivacyProtect.org)/ Alper Tunka, SteroidTr*, WIPO D2019-1869. The Complainant has also submitted that Respondent deliberately registered the disputed domain name <sudocrem.co.in> and previously another domain name <sudocrem.in> (both domain name has same Whois details) with the intention of preventing the Complainant from reflecting the said trademark in its domain names in India.

Complainant has submitted sufficient evidence showing widespread use, goodwill and trademark rights in 'SUDOCREM' mark in various countries, including India which long predates Respondent's registration of the disputed domain name which incorporates completely the registered trademark SUDOCREM of the Complainant. WIPO Overview 3.0 notes in Section 3.14 "*panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith*". The same principle is relied on in *Adobe Inc. v. Amin Mohammad Salehi, Uranos*, case no. DIR2020-0006, June 30, 2020.



Thus, Arbitrator finds that Respondent's disputed domain name is likely to mislead the consumers by creating a likelihood of confusion with the complainant's name or mark. (*Yusuf A. Alghanism & sons WLL v Anees Salah Salahmeh* (WIPO case no. D2018-1231). The Arbitrator finds that the Respondent has registered the disputed domain name to prevent Complainant from registering or using the mark in India. Despite notice, Respondent failed to submit its response and evidence to support bonafide registration of disputed domain name in respect of its offering of goods. Such registration and use is likely to mislead the consumers of an affiliation with Complainant which amounts to bad faith registration under .IN policy. For the aforesaid reasons, the Arbitrator in the present case finds bad faith in the registration and use of the disputed domain name (Ref. *Virgin Enterprises Limited v. Syed Hussain*, WIPO Case no. D2012-2395).

Moreover, it is settled law that the incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith. (*Microsoft Corporation vs. Montrose Corporation*, (WIPO Case No. D2000-1568, January 25, 2001). It is also settled principle that registration of a domain name with the intention to create confusion in the mind of internet users and attract internet traffic based on the goodwill associated with the trademark is considered bad faith registration (*PepsiCo Ins. Vs. Wang Shaung*, INDRP case no.400, December 13, 2012).



For the aforesaid reasons, the Arbitrator finds the third ground is also established by the Complainant under the .IN Policy.

8. DECISION

On the basis of the abovesaid findings the Sole Arbitrator finds that:

- a) The Complainant has successfully established three grounds required under the policy to succeed in these proceedings.
- b) Respondent has failed to rebut averments, contentions and submissions of the Complainant

The Arbitrator directs the .IN Registry of NIXI to transfer the domain name www.sudocrem.co.in to the Complainant.

The Award is passed on this 13th December, 2021

Place: Noida



Dr. Karnika Seth
Sole Arbitrator