

ADMINISTRATIVE PANEL DECISION

Theocorp Holding Company LLC v. Arman Sadeghpour
Case No. DEU2022-0028

1. The Parties

The Complainant is Theocorp Holding Company LLC, United States of America (“United States”), represented by Brandsmiths SL Limited, United Kingdom.

The Respondent is Arman Sadeghpour, Sweden, represented by Phelps Dunbar, LLP, United States.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <theodent.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On August 11, 2022, the Registry 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 16, 2022 providing the registrant and contact information disclosed by the Registry, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 23, 2022.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 4, 2022. In accordance with the ADR Rules, Paragraph B(3)(a), the due date for Response was November 15, 2022. The Response was filed with the Center on November 15, 2022.

The Center verified that the Response satisfied the formal requirements of the ADR Rules and the Supplemental Rules.

The Center appointed Assen Alexiev as the sole panelist in this matter on December 1, 2022. 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 ADR Rules, Paragraph B(5).

4. Factual Background

The Complainant was founded in 2007 by Mr. Joseph Fuselier, Dr. William Simmons, Dr. Arman Sadeghpour (the Respondent) and Dr. Tetsuo Nakamoto. Between 2007 to 2012, it developed patented technology, using an extract from cacao – theobromine, which was clinically shown to remineralize tooth enamel more effectively than fluoride-based toothpastes. Using this technology, the Complainant developed and manufactured Theodent Classic and Theodent 300 toothpastes in 2012. The Complainant also launched Theodent Kids in 2013 and have since then launched its products online and in well-known and luxury stores across the world such as Whole Foods, Harrods, Selfridges & Co. Since the launch of the Complainant's products, it has grown its distribution in the United States, Canada, United Kingdom, the Russian Federation, Slovenia, Hong Kong, China, United Arab Emirates, Iraq, and other territories. For the financial year ending in 2021, the Complainant has generated a revenue of USD 1 million and has sold over 80,000 tubes of toothpaste worldwide. The Respondent, Dr. Arman Sadeghpour was the Chief Executive Officer and Manager of the Complainant until his official dismissal on August 18, 2020. After his dismissal, the Respondent continues to be an investor in the Complainant.

Following his dismissal in August 2020, the Respondent registered the disputed domain name on May 11, 2021. According to the Complainant, the Respondent refuses to provide access to and transfer the disputed domain name to it. In 2021, the Complainant and its affiliate Theodent, LLC commenced legal proceeding against the Respondent in the 24th Judicial District Court for the Parish of Jefferson, State of Louisiana, case No.823-404 (the "Louisiana litigation"). The subject matter of the Louisiana litigation includes claims for damages arising as a result of the Respondent's alleged misconduct as CEO of the Complainant, and for a declaration that the Complainant and Theodent, LLC are the rightful owners of a non-exhaustive list of "theodent"-formative domain names registered in different TLDs and of the associated email accounts at these domain names. The Respondent has raised counterclaims in the Louisiana litigation.

The Complainant has submitted evidence that it is the owner of a number of trademark registrations for the sign "THEODENT" in the United States. A review of the public databases shows that the Complainant is also the owner of the International trademark THEODENT with registration No. 1358499, registered on June 5, 2017, for goods in International Class 3 (the "THEODENT trademark"). The THEODENT trademark is designated for multiple jurisdictions, including the European Union.¹

The disputed domain name was registered on May 11, 2021. It resolves to a parked webpage.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its THEODENT trademark, because of the use of the prefix mark THEO- and of its company name Theocorp. The Complainant explains that the THEODENT trademark is derived from the name of the active ingredient theobromine and the Latin word for teeth "dentes". The Complainant states that it is the only company to be using these active ingredients in dental care, and as a result of the Complainant's extensive use of the THEODENT trademark globally it has generated extensive goodwill in the THEODENT trademark, making its trademark

¹ Noting in particular the general powers of a panel articulated in Paragraph B (7)(a) of the ADR Rules, the Panel is not obliged, but is permitted at its sole discretion, to conduct its own investigations on the circumstances of the case.

extremely valuable corporate assets. According to the Complainant, the THEODENT trademark is inherently distinctive, being an invented word.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant states that the Respondent, as an individual, has never been known by the disputed domain name or any name similar to the disputed domain name, and has never acquired any trademark rights in the disputed domain name. The Complainant states that all trademarks in relation to the disputed domain name are registered by the Complainant.

The Complainant submits that the Respondent acted as President and CEO of the Complainant between 2007 and August 2020. During this period, the Respondent was directed to register certain domain names (different from the disputed domain name) on behalf of the Complainant. The Respondent failed to do so, instead registering these domain names in his own name in his personal capacity. The Respondent was fired from the company on August 18, 2020, and officially dismissed in October 2020. Until the Respondent's dismissal, it was the Complainant's understanding that the domain names mentioned above were owned by the Complainant, which paid the Registrar expenses in 2015-2020 to maintain their registration. With an email of October 26, 2011, to the Complainant's accounts team, the Respondent stated "NO!!! Theocorp owns all the domains...and will continue to...that is like intellectual property", thus confirming that the Complainant owned these domain names. The Complainant maintains that the Respondent registered the disputed domain name without the consent of the other co-owners of the Complainant. According to the Complainant, the Respondent has no legitimate interests in respect of the disputed domain name because he registered it after having been removed from this position as CEO and from the board of directors of the Complainant.

The Complainant contends that the disputed domain name was registered and is being used in bad faith, because it was registered after the Respondent was dismissed from his position and was registered for the purposes of disrupting the Complainant's business or for commercial gain.

B. Respondent

The Respondent maintains that he is the driving force behind "Theodent" as an oral innovation, brand, and company. In 2005, as a graduate student, the Respondent began to study the combination of theobromine with calcium and phosphate to stimulate tooth enamel re-mineralization on contact. This work became the basis for his PhD dissertation at Tulane University. The Respondent's dissertation was titled "A neural network analysis of theobromine vs. fluoride on the enamel surface of human teeth: An experimental case study with strong implications for the production of a new line of revolutionary and natural non-fluoride based dentifrices". According to the Respondent, the title for his PhD dissertation evidences his intent to commercialize the use of theobromine in oral care. The Respondent adds that he was awarded his PhD from Tulane University, graduated on May 19, 2007, and then began making arrangements to commercialize the use of theobromine through the creation of a startup toothpaste company. The Respondent joined forces with his PhD advisor, Dr. Nakamoto, and a local businessman, Mr. Joseph Fuselier, to form a company to develop and market oral care products using his own research on theobromine. As acknowledged by the Complainant, the Respondent was a "founding member" of the Complainant. The Respondent became the President, CEO, and Managing Member of Theodent LLC and Theocorp Holding, LLC. The Respondent states that he has registered several related domain names in his personal capacity: <theodent.com> in May 2007, <theo-corp.com> in January 2008, <theobev.com> in March 2008, and <rennou.com> in March 2008. The Respondent notes that he registered the disputed domain name in May 2021.

The Respondent maintains that he was unjustly removed from his position as President and CEO of Theodent LLC and Theocorp Holding, LLC effective August 18, 2020. The Respondent points out that following his removal from the Complainant entity, the Parties have been engaged in the Louisiana litigation, which was launched prior to the Complaint in the present proceeding. He adds that in the Louisiana litigation, the Complainant seeks a declaratory judgment declaring that the Complainant is the true owner of several Theodent web domain names with varying TLDs, "including, but not limited to", specifically enumerated domain names. The Respondent adds that the disputed domain name is also at issue in Louisiana litigation.

The Respondent submits that the Complainant has failed to demonstrate any interest in a right which is recognized or established by the national law of a Member State and/or European Union law. According to him, the Complainant has not submitted any evidence demonstrating that it has a trademark or other rights recognized in a European Union Member State and/or European Union Law. The Respondent notes that the Complainant has only submitted evidence showing that it has an interest in a trademark recognized by the United States Patent and Trademark Office. According to the Respondent, as the Complainant has failed to offer evidence showing that it has a trademark or other rights recognized in a European Union Member State and/or European Union Law, the Complainant has failed to show that it is entitled to the relief requested.

The Respondent maintains rights and legitimate interests in the disputed domain, as he is a “founding member” of the Complainant and has a financial interest in its success because of his status as a significant shareholder.

According to the Respondent, there is no evidence that he has registered or is using the disputed domain name in bad faith. The Respondent states that he waited nearly a full year after his dismissal as the CEO of the Complainant entity to register the disputed domain name. The Respondent points out that in that period of time, the Complainant could have registered the disputed domain name in its own name. The Respondent states that there is no evidence that, at the time he registered the disputed domain name, he registered it for the primary purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant for commercial gain. According to the Respondent, there is no evidence that, at the time of registration, the Respondent registered the disputed domain name in order to prevent the Complainant from registering it, to disrupt the Complainant’s business or to attract Internet users to the website for commercial gain by creating a likelihood of confusion.

6. Discussion and Findings

6.1. Procedural issue – Request for termination of the proceeding

The Respondent maintains that the Panel should terminate the present proceeding in deference to the pending Louisiana litigation involving the same Parties and the same disputed domain name. According to the Respondent, the “Policy” was not designed to address disputes between business partners over the ownership of the business and its assets, and cases involving factual disputes like those involved in the present proceeding are better resolved through court proceedings, where the Parties can present detailed evidence. The Respondent notes that the Louisiana litigation was launched before the filing of the Complaint in the present proceeding, that it alleges similar facts to those contained in the Complaint, and that the disputed domain name is also at issue in the Louisiana litigation.

The Respondent adds that the Complainant also initiated a separate proceeding against the Respondent - WIPO Case No. [D2022-2564](#), which was related to the domain names <theodent.com>, <theo-corp.com>, <theobev.com>, and <rennou.com>. The three-member Panel in that proceeding rendered a Panel Order on September 26, 2022, whereby it terminated the proceeding without prejudice and decided to defer to the Louisiana litigation. The Panel in that proceeding reasoned that “ownership of the Domain Names is squarely at issue in the civil action”, and noted that “the Parties are before a court capable of granting injunctions and other forms of interim relief”. Therefore, the Panel in WIPO Case No. [D2022-2564](#) concluded that the proceeding “should be terminated in deference to the pending judicial proceeding involving the same Parties and Domain Names, expressly without prejudice to refiling a UDRP complaint if the question of ownership the Domain Names is not resolved in the judicial proceeding or by settlement”.

Under Paragraph A5 of the ADR Rules, the conduct of the ADR Proceeding shall not be prejudiced by any court proceeding, subject to Paragraph A4(c) of the ADR Rules. Under Paragraph A4(c) of the ADR Rules, the Panel shall terminate the ADR Proceeding if it becomes aware that the dispute that is the subject of the Complaint has been finally decided upon by a court of competent jurisdiction or an alternative dispute resolution body. The ADR Rules do not contain a provision similar to Paragraph 18(a) of the UDRP Rules, granting the Panel with a discretion to decide whether to suspend or terminate a proceeding under the ADR Rules in view of a pending court litigation between the Parties. It is notable that both Parties refer to the

UDRP in their pleadings, perhaps being under a wrong impression that it is applicable to the present case.

There is no dispute between the Parties that the Louisiana litigation which was commenced prior to the commencement of the present proceeding, is currently still pending and has not been finally decided. Therefore, even if it is accepted *arguendo* that a Louisiana court would be competent to resolve disputes in relation to “.eu” domain names, the existence of this pending litigation is not *per se* a ground for the termination of the present proceeding. Its existence may be however relevant for the decision of the Panel on the substance of the dispute. The Panel moreover notes that unlike in the prior (terminated) case before the Center, in which the relevant domain names were registered many years prior to the present dispute, the disputed domain name was registered following a breakdown in relations between the Parties.

The Panel wishes to note that the distinguished three-member Panel in WIPO Case No. [D2022-2564](#) has made a very detailed and finely-reasoned analysis of the situation and has terminated the respective proceeding without prejudice and deferred the Parties to the Louisiana litigation. The dispute in that case was however under the UDRP, which contains different provisions about the termination of proceedings in comparison to the ADR Rules, so the reasoning of the Panel in WIPO Case No. [D2022-2564](#) is not applicable to the present dispute involving a “.eu” domain name. For the same reason, the Respondent’s arguments based on the UDRP are also not relevant.

All the above leads the Panel to the conclusion that in the present circumstances there are no grounds to terminate the present proceeding. Therefore, the Panel will proceed to issue a decision on the merits of the dispute.

6.2. Substantive issues

Under Paragraph B(11)(d)(1) of the ADR Rules the Complainant is required to demonstrate the following:

- (i) that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or European Union law; and either
- (ii) that the disputed domain name has been registered by the Respondent without rights or legitimate interests in the name; or
- (iii) that the disputed domain name has been registered or is being used in bad faith.

In the present ADR proceeding, the Complainant has pleaded the cumulative existence of the circumstances provided by the ADR Rules. The Panel notes that the ADR Rules list the issues under points (ii) and (iii) in the alternative, but nevertheless the Panel will examine both of these issues in order to reach its decision in the present ADR proceeding.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

Paragraph B(11)(d)(1)(i) of the ADR Rules requires that the disputed domain name be “identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a member State and/or European Union law”.

The Respondent points out that the Complainant has not submitted evidence that it has a trademark in force in the European Union. In this regard, the Panel has performed a limited factual research in the public databases and has ascertained that that the Complainant has rights in the International trademark THEODENT with registration No. 1358499, which has force on the territory of the European Union. This is sufficient for a finding that the Complainant has rights in a name in respect of which a right is recognized or established by European Union law.

As stated in prior cases, the “.eu” country code Top-Level Domain, being a mere technical requirement for registration, is typically disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name.

The disputed domain name incorporates the Complainant's THEODENT trademark without the addition of any other elements.

Therefore, the Panel finds that the disputed domain name is identical to a name in respect of which a right of the Complainant is established by European Union law.

B. Rights or Legitimate Interests

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because the Respondent has never been known by the disputed domain name and has never acquired any trademark rights in the disputed domain name. Rather, all trademarks in relation to the disputed domain name are registered by the Complainant. According to it, the Respondent has no legitimate interests in respect of the disputed domain name because he registered it after having been removed from his position as CEO and from the board of directors of the Complainant and registered it for the purposes of disrupting the Complainant's business or for commercial gain.

The disputed domain name was registered by the Respondent in 2021 following his dismissal as CEO of the Complainant in 2020. The Respondent does not explain why he has registered the disputed domain name and how he intends to use it. If the Respondent's intention was the disputed domain name to be used by the Complainant, the Panel does not understand why the Respondent registered it on his own behalf and how this could have been in the interest of the Complainant as long as the Respondent no longer manages the Complainant and is in a dispute with it. If, conversely, the disputed domain name was registered in the interest of the Respondent, the Panel does not understand how this could be regarded as legitimate and not in breach of any fiduciary duty the Respondent may still have towards the Complainant.

Taking the above into account, and in the lack of a plausible explanation by the Respondent of his actions, the Panel finds as more likely than not that the Respondent has registered the disputed domain name contrary to the interests of the Complainant. The Panel does not regard such conduct as legitimate and giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

C. Registered or Used in Bad Faith

Under Paragraph B(11)(d)(1) of the ADR Rules, lack of rights or legitimate interests and registration or use in bad faith are considered alternative requirements for a successful complaint. As the Panel has found that the Respondent lacks rights or legitimate interests in the disputed domain name, no further discussion on bad faith registration or use is necessary.

Nevertheless, as discussed in respect of the issue of rights or legitimate interests, in view of the circumstances of this case and the lack of any plausible explanation by the Respondent why he has registered the disputed domain name following his dismissal as CEO and board member of the Complainant, it appears as more likely than not that the Respondent has registered the disputed domain contrary to the interests of the Complainant. This supports a finding that the Respondent has registered the disputed domain name in bad faith.

7. Panel Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <theodent.eu> be revoked.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: December 15, 2022