



தமிழ்நாடு தி. மிலநாடு TAMILNADU

18/11
22-8-12

Sridharan

AK 496192

S. MALLINATHAN
STAMP VENDOR
L.No. 14661-B1/86
Plot. 1706, 35th Street, I-Block,
ANNA NAGAR WEST, MADRAS-600 040.

BEFORE THE INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

ARBITRATOR: S SRIDHARAN

DATED: 16th August 2012

Merck KGaA, Germany

- vs -

Zhaxia

- - Complainant

- - Respondent

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BEFORE THE INTERNET EXCHANGE OF INDIA

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Merck KGaA, Germany

... Complainant

Versus

Mr.Zhaxia

... Respondent

1. The Parties

1.1 The complainant Merck KGaA, (earlier known as E. Merck) is a company existing under the laws of Germany and having its office at Frankfurter Strasse 250, D-64293 Darmstadt, Germany represented by Ms.Anju Agarwal, advocate of L. S. DAVAR & CO at 5/1, First Floor, Kalkaji Extension, New Delhi – 110019.

1.2 Respondent is Mr. Zhaxia of Pfister Hotel at Milwaukee, W1 53214, USA- 53202, United States of America.

The Domain Name and Registrar

1.3 The disputed domain name <merck-serono.co.in> is registered with Bharat Domains (R129-AFIN).

2. Procedural History

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- 2.1 NIXI asked me about my availability and consent to take up the Complaint for arbitration and I informed my availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially.
- 2.2 On 23rd June, I received hardcopy of the Complaint.
- 2.3 On 23rd June 2012, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.4 On 25th June 2012, I received soft copy of the Complaint from the Complainant.
- 2.5 The notice sent to the Respondent bounced back to me. On 26th June 2012, I sent the notice to the Respondent at the email address mentioned in the whois data. I informed the Respondent that his time to file his response started from this date.
- 2.6 Respondent has not filed any response to the Complaint.
- 2.7 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

3. **Factual Background**

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A Complainant

- 3.1 The Complainant is an old, well known, reputed and established company since over the past 300 years engaged in the manufacture and marketing of a wide range of pharmaceutical preparations, and had been trading ever since with the name Merck appearing as a trading name.
- 3.2 The complainant first adopted in Germany its house trademark Merck in respect of its preparations some 150 years and which has been used ever since on a continuous basis.
- 3.3 The complainant is the registered proprietor of the trademark Merck in India under registration no.1045475 in class 9, 1045471 for the trademark Merck in class 1, 146735 for the trademark Merck in class 1, 146102 for the mark Merck in class 5. The said registrations are valid and in force. The Complainant has filed copies of advertisement of the said marks in the Trade Marks Journal and their current status, registration certificates, and renewals at Annexure-3.
- 3.4 The Complainant started using the house trade mark Merck in India through its subsidiary company Merck Ltd. in the year 1967 and has been using the same continuously and uninterruptedly till date.
- 3.5 The complainant has registrations of the trade mark Merck in various countries around the world. The Complainant has filed a list of the same along with copies of Registration Certificate at Annexure-4 and copies of Registration Certificates in various countries at Annexure-5 (collectively).

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- 3.6 Besides being a trademark, the word Merck also constitutes an important component of the trading name of complainant and the name Merck has been appearing in one form or another in the trading name since 150 years.
- 3.7 The complainant has related or subsidiaries in 60 countries, and all such related companies or subsidiaries use the house trademark Merck.
- 3.8 That the various related or subsidiary companies of complainant use the name Merck as part of its trading name, and a list of such related or subsidiary companies is filed herewith as Annexure-6.
- 3.9 The trademark and the trade name Merck has been derived some 150 years ago from the name of the founder members of complainant.
- 3.10 The approximate international/worldwide sales of the products of the complainant bearing the house trademark Merck for the past 3 years are as follows:

Year	Net Sales (worldwide) (Billion EURO)
2008	7,590
2009	7,747
2010	9,291

The Complainant has filed copies of few sale invoices at **Annexure-7**.

- 3.11 The Complainant through its subsidiary company Merck Ltd. is using its house trademark Merck in respect of its products in India. The approximate sale of the goods of subsidiary company of the complainant bearing the house trademark Merck for past 5 years is as follows:-

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Year	Net Sales (‘000 EURO)
2006	3294.9
2007	3148.3
2008	3894.6
2009	4731.1
2010	5090.8

The complainant has filed copies of few sale invoices at **Annexure-8**.

3.12 At all material times, the trade mark Merck when used on or in relation to the aforesaid products has indicated and still indicates to purchasers and intending purchasers as goods of the complainant and none other. Complainant has filed copies of few cartons, advertisement materials and website materials at **Annexure-9**.

3.13 The aforesaid products sold and offered for sale by the complainant under the house trade mark Merck are of excellent quality and thus have acquired reputation and goodwill all over world including India and intending purchasers identify and recognize products of the complainant by the house trade mark Merck.

3.14 That the complainant is, therefore, the exclusive proprietor of the house trade mark Merck.

3.15 The complainant has already obtained decisions from WIPO, Czech Republic, South Korea and Japan legal decisions that the trademark Merck is a well-known trademark. Complainant has filed copies of such decision with the English translation at **Annexure-10**.

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3.16 The trademark Merck of complainant is a well-known trademark.

3.17 The Complainant has about 1087 domain names registered in its name throughout the world, all having component Merck as a significant part thereof. The Complainant has filed a list of the same at **Annexure-11**.

3.18 From the aforementioned, it is clearly evident that the Complainant is the prior adopter and user of the word Merck throughout the world, including INDIA.

B Respondent

3.19 The Respondent has not filed any reply to the Complainant's Compliant in this arbitration.

4. Parties Contentions

A Complainant

4.1 The disputed domain name <merck-serono.co.in> is identical to the well-known and registered Trade Mark Merck of the Complainant.

4.2 The Respondent has no right or legitimate interest in respect of the disputed domain name <merck-serono.co.in>. Merck is not the personal or surname name, trade/ service mark, trading name, of the Respondent. He has no reason whatsoever to adopt the disputed domain name <merck-serono.co.in>, which is a well-known registered trade mark of the Complainant. The Respondent is called upon to state why he adopted the disputed domain name <merck-serono.co.in>.

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- 4.3 The Respondent, to the best of the knowledge of the Complainant, has adopted the disputed domain name <merck-serono.co.in> with dishonesty and bad faith with the mala-fide intention to trade upon the goodwill and reputation associated with the trade mark Merck of the Complainant, thereby earning undue profits. This is evident from the fact that the registrant has linked his domain name to that of the Complainant.
- 4.4 It is apparent that the Respondent has registered the disputed domain name <merck-serono.co.in> for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who is the proprietor of the trade mark and trade name Merck, or to a competitor of the Complainant, for a valuable consideration.
- 4.5 Respondent has registered disputed domain name <merck-serono.co.in> having component Merck which is house trademark of complainant so as to trade upon the reputation and goodwill accruing to the complaint in it's well known trademark Merck and undue profit.
- 4.6 The general public and trade associate the well-known trademark Merck exclusively with the Complainant. The Respondent by registering the disputed domain name <merck-serono.co.in> which is having house trademark Merck of the complainant will invariably deceive the trade and the public into a belief that the disputed domain name <merck-serono.co.in> is associated with the Complainant.
- 4.7 The intention of the Respondent in registering the disputed domain name <merck-serono.co.in> having component/trademark Merck of the

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Complainant is not only malafide but also dishonest in that it was aware that the well-known trademark Merck was/is the trademark of the Complainant.

4.8 The Respondent has deliberately registered the disputed domain name <merck-serono.co.in> having component/well known trademark Merck so as to create confusion in trade and general public.

4.9 The Respondent has registered the disputed domain name in order to prevent the Complainant - the proprietor of the trademark Merck from reflecting the mark in a corresponding domain name.

4.10 By using the disputed domain name <merck-serono.co.in>, the Respondent has intentionally attempted to attract Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's trade name or trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

B. Respondent

4.11 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

5. Discussion and Findings

5.1 Respondent has not filed his response. I have not received any communication from him until the date of this award. Since the Respondent

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chose not to respond to this Complaint, I am proceeding to determine this Complaint on the basis of the materials made available by the Complainant.

5.2 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (II) Respondent has no rights or legitimate interests in respect of the domain name; and
- (III) Respondent's domain name has been registered or is being used in bad faith.

5.3 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.

5.4 The Complainant is the proprietor of the mark Merck. The mark was first adopted in Germany some 150 years ago by the founder members of the Complainant. The Complainant started using the mark Merck in India through its subsidiary company Merck Ltd. in the year 1967. The first registration in India under No.146102 dates back to 11.11.1950. The Complainant has about 1087 domain names registered in its name throughout the world, all having component Merck as a significant part thereof. The disputed domain

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name <merck-serono.co.in> was registered on 26.04.2011. Obviously, the Complainant is the prior adopter and registrant of the mark Merck. The above facts have established that the Complainant has both common law and statutory rights in respect of its trade mark Merck.

5.5 The predominant and distinctive part of the disputed domain name <merck-serono.co.in> is Merck. The Complainant's Merck marks are famous and well known throughout the world including India. It is clearly seen that the disputed domain name <merck-serono.co.in> wholly incorporates Merck, the prior registered trade mark of the Complainant.

5.6 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its trade mark Merck.
- (b) The disputed domain name <merck-serono.co.in> is confusingly similar to the Complainant's prior registered trade mark Merck.

Respondent has no rights or legitimate interests in respect of the disputed domain name

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of the mark Merck. The Complainant's mark Merck is well known in many countries across the globe including India.
- (b) The Complainant's trade mark Merck was adopted some 150 years ago. In India, the Complainant began using the mark Merck through

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its subsidiary in 1967. It was registered in the name of the Complainant in India in 1951. The disputed domain name <merck-serono.co.in> was registered by the Respondent only on 26.04.2011.

5.8 Respondent did not register the disputed domain name <merck-serono.co.in> until 2011. As such, chances are slim to none that Respondent was unaware of the famous Merck marks and Complainant's rights thereto prior to registering the disputed domain name <merck-serono.co.in> in 2011.

5.9 I visited the web site of the Respondent under the disputed domain name <merck-serono.co.in>. The disputed domain name <merck-serono.co.in> led to the web page containing a tab "***Inquire about this domain name***" prominently at its top. A click on the tab leads to another page where a visitor is asked to submit his offer price to purchase the disputed domain name <merck-serono.co.in>. The disputed domain name <merck-serono.co.in> also provided links to web sites of the Complainant's competitors. It is obvious that the Respondent never intended to use the disputed domain name <merck-serono.co.in> in connection with a bona fide offering of goods or services.

5.10 In the absence of response from the Respondent, I accept the argument of the Complainant that:

- (a) The Respondent has no right or legitimate interest in respect of the disputed domain name <merck-serono.co.in>. Merck is not the

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personal or surname name, trade/ service mark, trading name, of the Respondent. He has no reason whatsoever to adopt the disputed domain name <merck-serono.co.in>, which is a well-known registered trade mark of the Complainant.

- (b) The Respondent, to the best of the knowledge of the Complainant, has adopted the disputed domain name <merck-serono.co.in> with dishonesty and bad faith with the mala-fide intention to trade upon the goodwill and reputation associated with the trade mark Merck of the Complainant, thereby earning undue profits.
- (c) It is apparent that the Respondent has registered the disputed domain name <merck-serono.co.in> for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who is the proprietor of the trade mark and trade name Merck, or to a competitor of the Complainant, for a valuable consideration.
- (d) Respondent has registered disputed domain name <merck-serono.co.in> having component Merck which is house trademark of complainant so as to trade upon the reputation and goodwill accruing to the complaint in it's well known trademark Merck and undue profit.

5.11 Respondent himself is not engaged in any activity of its own to show that he has any legitimate rights or interest in the disputed domain name <merck-serono.co.in>.

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5.12 Respondent has no *bonafide* intention to use the disputed domain name <merck-serono.co.in> and has registered the same for the sake of trafficking and subsequent sale of the aforesaid domain names to the highest bidder.

5.13 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name <merck-serono.co.in>.

Respondent's domain name has been registered or is being used in bad faith.

5.14 The Complainant is the proprietor of the mark Merck. Complainant has been using the Merck mark continuously for the past 150 years. Complainant started using its mark Merck through its subsidiary in India in 1967. The first registration in India under No.146102 dates back to 11.11.1950. The Complainant has about 1087 domain names registered in its name throughout the world, all having component Merck as a significant part thereof. The disputed domain name <merck-serono.co.in> was registered on 26.04.2011. Obviously, Complainant's rights in the Merck trademarks pre-date Respondent's registration of the disputed domain name <merck-serono.co.in>. The Respondent could not have ignored, rather actually influenced by, the well-known trade mark Merck of the Complainant at the time he acquired the disputed domain name <merck-serono.co.in>.

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- 5.15 As seen above, Respondent is currently holding the disputed domain name <merck-serono.co.in> primarily for sale and gives links to other web sites offered by third parties and not for any other purpose. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name <merck-serono.co.in> is nothing but an unjust exploitation of the well-known reputation of the Complainant's prior registered trade mark Merck.
- 5.16 Respondent's lack of response to the Complaint indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's trademark Merck.
- 5.17 The Respondent has registered the disputed domain name in order to prevent the Complainant - the proprietor of the trademark Merck from reflecting the mark in a corresponding domain name.
- 5.18 By using the disputed domain name <merck-serono.co.in>, the Respondent has intentionally attempted to attract Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainants' trade name or trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.
- 5.19 Thus it is clearly established that Respondent registered the disputed the disputed domain name <merck-serono.co.in> in bad faith.

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5.20 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name <merck-serono.co.in> into any fair/useful purpose. Respondent not even considered it worth responding the complaint of the Complainant. Respondent did not file any response. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

6. Decision

6.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

6.2 It is hereby ordered that the disputed domain name <merck-serono.co.in> be transferred to the Complainant.

6.3 Respondent is ordered to pay the Complainant a sum of Rs.10,00,000/- (Rupees ten lakhs only) towards costs of the proceedings.



S.Sridharan
Arbitrator