



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

S.No. 5097 Date 29-02-2012 501

Sold to H. Saritha Devi

S/o. Dr. W/o. B. Narayana Swamy

For Whom Self R. B. Hyl

M. Saritha Devi

S 786448

M. SARITHA DEVI

LICENCED STAMP VENDOR

LIC. No: 16-04-1/2005

REN. No: 16-04-32/2011

H. No: 6-3-903/F, Opp: Image Hospitals,
NAGARJUNANAGAR ROAD, AMEERPET
HYDERABAD (SOUTH) DISTRICT.
Phone No: 040-23759009, 9290146899

BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA
ARBITRATION AWARD

In The Matter Between

M/s Merck KGaA
(formerly E. Merck)

Complainant

Versus.

Zeng Wei

Respondent()

1. The Parties

H. Saritha Devi



ఆంధ్రప్రదేశ్ ఆంధ్ర ప్రదేశ్ ANDHRA PRADESH

S.No. 8098 Date 29-02-2018 50/-
Sold to Harini Narayana Swamy
Sto. No. 10 B. Narayanaswamy
For whom G. R. K. S. S. S.

M. Saritha Devi S 786449

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The Complainant is Merck KGaA (Formerly known as E. Merck), Frankfurter Strasse 250, D-64293 Darmstadt, Germany represented in these proceedings by L.S Davar & Co. of New Delhi, India.

The Respondent is Zeng Wei Shangai Weihai Rd 1888 (HD) Shanghai 20001 China.

2. The Domain name, Registrar and Policy

This Arbitration pertains to a dispute regarding the domain name <merckchemicals.in>.

The registrar for the disputed domain name is Transecute Solutions Pvt. Ltd.

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The Arbitration Proceeding is conducted in accordance with the Arbitration and Conciliation Act of 1996 (India), the .IN Domain Name Dispute Resolution Policy (the “INDRP Policy” or “Policy”), and the INDRP Rules of Procedure (the “Rules”).

3. Procedural History

The sole arbitrator appointed in the case is Mrs. Harini Narayanswamy. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, in compliance with the Rules.

The Arbitrator received the Complaint from the .IN registry on February 4, 2012 and on February 5, 2012 transmitted by email a notification of commencement of the arbitration proceedings to the Respondent. Under the INDRP Rules, copies of the said notification were sent to other interested parties to the dispute. The Respondent was given twenty-one days time from the date of the notification to file a response. The Respondent did not reply to the notification or file any response in these proceedings. Based on the material on record the Arbitrator now proceeds to determine the case on its merits.

Factual Background

The Complainant is a pharmaceutical multinational company with its headquarters in Germany. The Complainant owns the well-recognized trademark MERCK. The Complainant has provided a list of its worldwide trademark registrations and copies of trademark registration certificates for its Indian, Community Trade Mark (CTM) registrations and registrations in several other countries. Some of the documents filed with the complaint are: Indian trademark registration No 1045475 under class 9 dated September 18, 2001, Indian trademark registration 1045471 under class 1 dated September 18, 2001, Australian trademark registration No. 854375 under class 9 dated October 20, 2000, Community trademark (CTM) registration No.00283986 and Community trademark (CTM) registration No.002377257.

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The Respondent registered the disputed domain name <merckchemicals.in> on February 28, 2011.

4. Parties contentions

A. Complainant's Submissions

The Complainant states it had adopted the mark MERCK one hundred and fifty years back and presently continues to use MERCK as its house mark and also as its trading name. The Complainant states it has subsidiaries in sixty countries that also use its house mark MERCK, including its Indian subsidiary, Merck Ltd. since 1967. The trademark MERCK was derived one hundred and fifty years ago from the name of the Complainant's founder members. The Complainant has provided international sales figures for products sold under the MERCK mark for three years: For the year 2008 the net worldwide sales was 7590 billion EURO, for year 2009 net worldwide sales was 7747 billion EURO and for 2010 net worldwide sales was 9291 billion EURO. The Complainant has also provided the sales figures for its Indian subsidiary for the five years 2006 to 2010.

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

The Complainant states it has prevailed in numerous legal proceedings and has obtained the transfer of many domain names that contains its MERCK trademark, including from WIPO, the Czech Republic, South Korea and Japan and it shows its trademark MERCK is well known. The Complainant claims it has over one thousand domain names having

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the component MERCK, and this shows its prior adoption of the mark in many countries including India.

The Complainant states that it has worldwide registrations under various classes for the MERCK trademark and has extensively marketed under the mark and acquired worldwide reputation and goodwill as products sold under the mark are of excellent quality. The Complainant states the disputed domain name contains the mark in its entirety making the disputed domain name identical or confusingly similar to its mark.

The Complainant argues that the Respondent has no rights and legitimate interests in the disputed domain name, as the Respondent is not known by the disputed domain name. MERCK is not the Respondents personal name or trade name and as such the Respondent has no reason to adopt the domain name that is the well-known mark of the Complainant. That the Respondent as per the records is an individual in Shanghai, China. The Respondent does not used the disputed domain name in connection with a *bona fide* offering of goods or services, but uses it to mislead users for commercial gain. As the Respondent is not making any legitimate use of the disputed domain name it indicates Respondent's lack of rights and legitimate interests in the domain name.

The Complainant states the disputed domain name was registered and used in bad faith as the Respondent seeks to exploit its famous mark to attract Internet users to the Respondent's website or other online location by creating a likelihood of confusion with the Complainant's mark. The Complainant states that the Respondent has registered and uses the disputed domain name with dishonesty and bad faith to trade upon the goodwill and reputation associated with the MERCK trademark to earn undue profit and this is evident, as the Respondent has linked the disputed domain name to the Complainant.

The Website shows the disputed domain name is advertised for sale for EURO 6200 states the Complainant. As MERCK is its house mark and trademark, the general public is likely to associate the disputed domain name with the Complainant and it will deceive the public. The intention of the Respondent is dishonest, states the Complainant, as the

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Respondent has deliberately registered the domain name for the well-known trademark MERCK so as to create confusion in the minds of the trade and general public.

The Respondent has registered the disputed domain name to prevent the Complainant the proprietor of the mark from reflecting its mark in a corresponding domain name. By using the impugned domain name the Registrant has intentionally attempted to attract Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with Complainant's trade name or trademark as to source, sponsorship, affiliation or endorsement of Respondent's website or location.

The Complainant requests for the following relief: Cancellation of the Respondent's domain name <merckchemicals.in> and for transfer of the disputed domain name to the Complainant with the costs of the proceedings.

Respondent's Submissions

The Respondent did not respond in these proceedings

Discussion and Findings

Under the .IN Policy, the registrant of the domain name is required to submit to a mandatory arbitration proceeding in the event that a complaint is filed in the .IN Registry, in compliance with the .IN Policy and the INDRP Rules.

The .IN Policy, Paragraph 4 requires the Complainant, to establish the following three elements:

- (i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, and
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name; and

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- (iii) The Respondent's domain name has been registered or is being used in bad faith.

Identical or Confusingly Similar

The first element requires the Complainant to prove that the domain name registered by the Respondent is identical or confusingly similar to a mark in which the Complainant has rights.

It is well established, that trademark registration is recognized as *prima facie* evidence of rights in a mark. The Complainant by filing documents of its registered trademarks has established that it has rights in the trademark MERCK in numerous jurisdictions including India. The documents filed by the Complainant also show that it has used the mark extensively for a considerable period. Evidence of use of the mark for several years by the Complainant undoubtedly shows its rights in the mark. See *Starbucks Corporation v. Mohan Raj* INDRP Case 118 <starbucks.co.in>, November 26, 2009. (Use of a mark for several years by a complainant establishes its rights in the mark.).

The disputed domain name incorporates the MERCK mark in its entirety with the word "chemicals", a word that is associated with the Complainant's business; this is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. See *Indian Hotels Company Limited v. Mr. Sanjay Jha*, INDRP case 148 September 27, 2010 <gingerhotels.co.in>. (A domain name that entirely incorporates a complainant's mark is sufficient to establish the confusing similarity of the disputed domain name with the mark.) The addition of a generic word and the country code top-level domain (cc TLD) suffix does not lessen the confusing similarity of the domain name with the trademark. See *Morgan Stanley v. Bharat Jain*, INDRP Case No. 156 dated October 27, 2010.

The Arbitrator finds that the Complainant has satisfied the first element under paragraph 4 of the Policy.

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Rights and Legitimate Interests

The second element requires the Complainant to show that the Respondent has no rights and legitimate interests in the disputed domain name.

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name. Under Paragraph 7 of the Policy, a Respondent or a registrant can establish rights in the domain name, if (i) before notice of the dispute, the registrant had used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services or (ii) the registrant (as an individual, business organization) has been commonly known by the domain name, or (iii) The registrant is making legitimate, non commercial or fair use of the domain name without intent for commercial gain.

The Respondent has not responded in these proceedings and has not provided any material to show rights in the disputed domain name. The Arbitrator finds the material on record does not show the Respondent is commonly known by the disputed domain name. If the Respondent does not put forward any evidence that it is known by the disputed domain name, it is a strong basis to infer that the Respondent lacks rights. See *Starbucks Corporation v. Mohan Raj* INDRP case 118, (<starbucks.co.in> November 26, 2009). Further, there is no indication from the material on record that the Respondent is using the disputed domain name for any legitimate purposes such as noncommercial fair use purposes.

The use of the Complainant's mark in the disputed domain name in the Arbitrator's view is likely to mislead the public and Internet users that the disputed domain name may refer to the Complainant. Misleading users by incorporating others trademarks in a domain name gives a false impression to users and does not constitute a *bona fide* use under the Policy.



The Arbitrator finds the Complainant has made a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and has satisfied the second element under paragraph 4 of the Policy.

Bad Faith

Under the INDRP Policy the Complainant is required to establish that the domain name was registered or is being used in bad faith.

The Complainant has asserted that the Respondent has registered and uses the disputed domain name in bad faith for the reasons: that the Complainant has well-established rights in the trademark MERCK, that the Respondent has intentionally attempted to attract Internet users by creating a likelihood of confusion with the Complainant's mark as to source of endorsement and affiliation; The Complainant's prior adoption of the mark predates the Respondent's domain name registration by several decades and the registration of a name that is so obviously connected with the Complainant indicates the Respondent's opportunistic bad faith. Finally, the Respondent's intention to sell the disputed domain name is apparent from the advertisement for sale of the disputed domain name at a price of EURO 6200.

The Arbitrator finds the Complainant has established its prior adoption and rights in the MERCK mark. Further, the Complainant's trademark applications were clearly made much before the disputed domain name was registered. The evidence on record show the Complainant's trademark is undoubtedly well known and it is likely that the Respondent was aware of the Complainant's prior rights in the mark when he registered the disputed domain name. The choice of the domain name does not appear to be a mere coincidence, but is a deliberate use of a well-recognized mark to attract unsuspecting users to the Respondent's site, such registration of a domain name, based on awareness of a trademark is indicative of bad faith registration under the Policy. See *Lego Juris v. Robert Martin*, INDRP / 125, February 14, 2010.



The Registration of a domain name that is confusingly similar or identical to a famous mark by an entity that has no relationship to the mark is sufficient evidence of bad faith registration and use. See *The Ritz-Carlton Hotel Company LLC v. Netlon*, INDRP Case 250, Dec 30 2011, <ritzcarlton.in>. (Where the domain name is so obviously connected to the complainant, the registration and use by the respondent suggests opportunistic bad faith, citing *Pavillion Agency v. Greenhouse Agency Ltd.* WIPO Case 2000-1221).

Internet users may falsely believe that the Respondent's domain name and website are being operated or endorsed by the Complainant. See *Bharati Airtel Limited v. Rajeev Garg* INDRP 285 <airtelworld.net.in> January 12, 2012, (where respondent's bad faith was found from intentionally attempting to attract for gain Internet users to the respondent's website or other online location by creating a likelihood of confusion with the complainant's mark).

Under Paragraph 6 (iii) of the Policy, if the registrant of the domain name in dispute, has used the domain name to intentionally attract Internet users to the Registrant's website or other online location by creating a likelihood of confusion with the trademark of another, it is considered evidence of bad faith. The Arbitrator finds the circumstances here suggest that there is no reasonable explanation for the registration and use of the disputed domain name except that the Respondent seeks to exploit the reputation and goodwill associated with the Complainant's mark in the manner mentioned under Paragraph 6 (iii) of the Policy, namely to attract Internet traffic to the Respondent's website and to mislead customers, which is considered bad faith registration and use of the disputed domain name. The Respondent in the present case is found to have registered the disputed domain name to get undue advantage from the goodwill associated with the Complainant's trademark, and as such is found to have registered and used of the disputed domain name in bad faith, as understood under the INDRP Policy.

For the reasons discussed, the Arbitrator finds the disputed domain name has been registered and used in bad faith under the Policy.

Decision



The Complainant has established the three elements under the INDRP Policy: the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights, the Respondent has no rights or legitimate interests in the disputed domain name and the disputed domain name has been registered or is being used in bad faith by the Respondent.

As the Complainant has successfully established its case in these proceedings, it is ordered that the disputed domain name: <merckchemicals.in> be transferred to the Complainant.



Harini Narayanswamy (Arbitrator)

Date: February 28, 2012