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**BEFORE THE SOLE ARBITRATOR UNDER THE
.IN DISPUTE RESOLUTION POLICY**

IN THE MATTER OF:

Merck Sharp & Dohme Corp.

One Merck Drive, P.O. Box No. 100,
Whitehouse Station, New Jersey, 08889-100
USA

Phone: +1 908 423-5250

Fax: +1 908 423-1372

Email: [debra.greene\(g\).merck.com](mailto:debra.greene(g).merck.com)

(COMPLAINANT)

Versus

Marketing Munch Pty Ltd

(Contact Person: Michael Wong)

PO Box 2578, Strawberry Hills, New South Wales, 2012, Australia

Phone: +61.0280036928

Email: email@marketingmunch.com

(RESPONDENT)

AWARD

THE PARTIES

The complainant in the present proceeding is **Merck Sharp & Dohme Corp.**, One Merck Drive, P.O. Box No. 100, Whitehouse Station, New Jersey, 08889-100, USA.

The complainant in these proceedings is represented through its authorised representative:

A L G India Law Offices

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The respondent in this proceeding is Mr. Michael Wong, Marketing Munch Ply Ltd, PO Box 2578, Strawberry Hills, New South Wales, 2012, Australia.

THE DOMAIN NAME, REGISTRAR AND REGISTRANT

The Domain Name in dispute is <msd.co.in>. According to the Whois Search utility of .IN Registry, the Registrar of the disputed domain name <msd.co.in>, with whom the disputed domain name <msd.co.in> is registered is Wild West Domains Inc.

The Information about this Registrar as found is as under:

Wild West Domains, Inc.

14455 North Hayden Rd Suite 219 Scottsdale AZ

United States

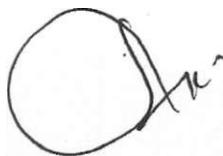
480-624-2500

support@wildwestdomains.com

The Registrant is Mr. Michael Wong, Marketing Munch Pty Ltd, PO Box 2578, Strawberry Hills, New South Wales, 2012, Australia.

PROCEDURAL HISTORY:

The Arbitrator was appointed by .IN Registry, to adjudicate upon the complaint of the Complainant, regarding the dispute over the domain name <msd.co.in>.



.In Registry has supplied the copy of the Complaint and Annexures to the Arbitrator.

In accordance to the Rules, on 11.07.2011, the Arbitrator sent an email to the parties informing them about his appointment as an Arbitrator.

Thereafter on 11.07.2011, itself the Arbitrator sent an email to Complainant requesting them to supply the copy of the complaint with annexure to the Respondent and in case if they have already served it, then to provide the details of service record.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 11.07.2011 with the instructions to file his say latest by 26.07.2011.

On 12.07.2011, the Arbitrator received an email from the Counsels/Representative of the Complainant, informing about the details of the service of the copy of Complaint to the Respondent. According to this mail copy of the complaint was duly sent to the Respondent.

Thereafter, on 12.07.2011, the Respondent through his email expressed his desire to settle the matter amicably and to proceed with the transfer process.

On 13.07.2011, the Arbitrator, sent email to both the Complainant and the Respondent stating that if both the parties are willing to amicably resolve the issue then the tribunal shall proceed with the proceedings for a consent award.

On 15.07.2011, the Arbitrator sent email to both the Complainant and the Respondent instructing them to follow the guidelines and instructions given by the tribunal and to mark the mails exchanged between the parties to the NIXI/ Arbitrator also.

Further emails from the Respondent dated 24.07.2011 and that from the Complainant dated 24.07.2011 were sent to the Arbitrator re-ascertaining their willingness to proceed with a consent award.

However, the emails sent to the Arbitrator by the Respondent dated 12.07.2011 and 25.07.2011, were not in proper compliance with the INDRP rules. The aforesaid mails addressed to the Arbitrator by the Respondent were mere conversational emails and thus there was no proper specific request made to the Tribunal by the Respondent for agreement to a consent award and to the transfer of the domain name.

Due to this shortcoming, the Arbitrator sent an email dated 26.07.2011 to the parties addressing this issue and giving the last opportunity to the Respondent to formally file a response or formal acceptance to the consent award.



Following this Respondent sent an email to the Arbitrator dated 27.07.2011, where yet he did not formally inform his willingness to transfer the domain name to the Complainant and to a consent award. However, he stated that he wanted to transfer the domain name in question to the Complainant unconditionally.

Respondent has also not filed any response to the Complaint despite opportunities given.

That I have perused the record and Annexures / document.

FACTUAL BACKGROUND:

The Complainant has raised, *inter-alia*, following important objections to registration of disputed domain name in the name of the Respondent and contended as follows in his Complaint: -

The Complainant is the second-largest pharmaceutical company in the world and is a global leader in developing, manufacturing and marketing human and animal health care products, directly and through its joint ventures. The Complainant was established in 1891 in the United States and then incorporated subsidiaries across jurisdictions.

The Complainant is the worldwide proprietor of the well-known trademark 'MSD', which is an acronym for the Complainant's trade name (Merck Sharp & Dohme Corp) and is being used and registered in India and various countries throughout the world at least since 1970.

Complainant owns trademark registrations for the mark MSD across jurisdictions, including major jurisdictions such as India, US, EU, UK, Australia etc. The Complainant has continuously been using the mark MSD as their trademark at-least since June 2, 1958 (date of first use in commerce as claimed in US Trademark Registration No. 0922205 for the mark MSD).

In India, the Complainant has acquired tremendous goodwill and reputation through its long and extensive use of the trademark MSD, which is also the house-mark for Complainant's goods and services. The mark MSD has acquired the status of a well-known trade mark under Section 2(1) (zg) of the Trade Marks Act, 1999 and also qualifies all tests for the "well known status" under section 11 (6) of the Act which includes aspects like knowledge and recognition among relevant sections of the public, duration, extent and geographical area of use, promotion and publicity of the mark.

A handwritten signature or set of initials, possibly 'MSD', enclosed in a hand-drawn oval shape.

RESPONDENT:

The Respondent did not file a formal response in the proceedings, but in reply to the notification sent by the Arbitrator, sent an email dated 12.07.2011, which states:

"I had no idea Merck owned the MSD trademark. I am sorry I registered it by mistake.

All you had to do was ask for the domain and I would have given it to you, and you would have saved yourself a lot of trouble, time and money. :-)

Please initiate a transfer of the domain and I will authorize it, or let me know what you want me to do.

If I have registered any other Merck trademarks, please don't hesitate to let me know.

I look forward to hearing from you soon.

Best regards,

Michael Wong"

Thereafter, the Arbitrator on 26.07.2011 directed the Respondent to file a formal reply or acceptance of the consent award, in reply of which on 27.07.2011, the respondent sent an email, which states as follows:

"I hereby state that I, Michael Wong (the Respondent), am willing to transfer the domain name, MSD.CO.IN, to the Claimant (Merck Sharp & Dohme Corp.) unconditionally.

Is that sufficient?

Best regards,

Michael Wong"

PARTIES CONTENTIONS.

Complainant

The Complainant contends as follows:

The Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has the rights.

The Respondent has no rights and legitimate interest in respect of the domain name.

The Respondent has registered and is using his domain name in bad faith.



DISCUSSIONS AND FINDINGS:

Rule 8 (b) of the INDRP Rules of Procedure provides that *"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case "*.

As mentioned above fair opportunity has been given to the Complainant as well as the Respondent to present their case. From the emails exchanged it is clear that both the parties have decided to amicably settle the matter and the Respondent have agreed to transfer domain name in question unconditionally in favor of the Complainant.

Rule 12 (a) of the INDRP Rules of Procedure provided that *"An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed there under, and any law that the Arbitrator deems to be applicable "*

In the present circumstances, the decision of the Arbitrator is based upon the Complainant contentions and evidence and conclusion drawn from the Respondent's acceptance to transfer the disputed domain name to the Complainant.

Having perused and the submissions and documentary evidence placed on record, the Complainant has proved that he has statutory and common law rights in the mark "MSD".

The Complainant has to satisfy all the three conditions outlined in the paragraph 4 of .IN Domain Name Dispute Resolution Policy, viz.

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

Since the Respondent has not filed any response to the complaint and has consented to transfer the disputed domain name to the Complainant unconditionally. The Panel finds no evidence to suggest that his consent is not genuine. As a result, the Panel directs without consideration of parties Contentions pursuant to Paragraph 4 (a) of the policy, an immediate transfer of the disputed domain name to the Complainant. (The Panel relies upon the following awards:



- a. The Cartoon Network LP LLLP vs. Mike Morgan, WIPO Case No D2005-1132;
- b. Disney Enterprises Inc. vs. Elmer Morales, NAF Case No. FA475191

"it was held in these cases that under circumstances where the Respondent has agreed to comply with the request of the Complainant, the Panel felt it to be expedient and judicial to forego the traditional UDRP analysis and order the transfer")

Finally when the Respondent has consented to transfer the domain name the requirements under the Policy are fulfilled. The Panel relies on the awards of *Lonely Planet Publication Ltd. Vs. Hoang Anti Minh*, WIPO Case No. 2003-0355; and *Sanofi Aventis Vs. Day Corporation*, WIPO 2004-1075.

DECISION

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in his complaint.

.IN Registry of the NIXI is hereby directed to transfer the domain name of the Respondent i.e. <msd.co.in> to the Complainant. In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 3rd day of August, 2011.



A. K. Singh

Sole Arbitrator

Date: 3rd August, 2011