



उत्तर प्रदेश UTTAR PRADESH

BF 502138

BODHISATVA ACHARYA
ARBITRATOR

(Appointed by IN Registry-National Internet Exchange of India)

Case No. Of 2012

ARBITRATION AWARD: DISPUTED DOMAIN NAME :< merck-chemicals.co.in >

In the matter of:

M/s. Merck KGaA,
(Formerly known as E.Merck),
Frankfurter Strasse 250,
D-64293,
Darmstadt, Germany
E-mail- jonas.koelle@merckgroup.com

Filed by its authorized representative attorney -

L.S.DAVAR & Co.
5/1, FIRST FLOOR,
KALKAJI EXTENSION,
New Delhi- 110019, India.
Email- anju2010@gmail.com

....Complainant.

Vs.

Yitao
Apex Laboratories Limited
76, C.P. Rama Road,
Hong Kong-999077
Email: sunong@live.com

..... Respondent.

A W A R D

1. The Parties:

The complainant in this arbitration proceeding is M/s. Merck KGaA, (Formerly known as E.Merck), Frankfurter Strasse 250, D-64293, Darmstadt, Germany with E-mail jonas.koelle@merckgroup.com filed by its authorized representative attorney L.S.DAVAR & Co., 5/1, FIRST FLOOR, KALKAJI EXTENSION, New Delhi- 110019, India. With Email- anju2010@gmail.com

Respondent in this arbitration proceeding is Yitao, Apex Laboratories Limited, 76, C.P. Rama Road, Hong Kong-999077 with Email: sunong@live.com

2. The Domain Name, Registrar & Registrant:

The disputed domain name is www.merck-chemicals.co.in



3. Procedural History:

The complainant, through its authorized representative, filed this complainant to NIXI regarding the disputed domain name www.merck-chemicals.co.in following the clause 4 of the policy of .IN Registry and .IN Registry appointed **Mr. Bodhisatva Acharya** (The Arbitrator) as Sole Arbitrator under clause 5 of the policy. The Arbitrator submitted his statement of acceptance and declaration of Impartiality and the Independence and the complaint was produced before the Arbitrator on September 24th, 2012 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on October 16th, 2012, to submit his reply but nothing was submitted to Arbitrator till the date of award hence the AWARD is being declared on the December 10th, 2012 as Ex-parte.

4. Factual Background:

- (a) Complainant known as E. Merck existing under the laws of Germany and having its office at Frankfurter Strasse 250, D- 64293 Darmstadt, Germany.
- (b) 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 and the complainant first adopted in Germany its house trade mark MERCK in respect of its preparations some 150 years and which has been used ever since on a continuous basis.
- (c) Complainant is the registered proprietor of the trademark MERCK under registration no. 1045475 in class 9, 1045471 for the trademark MERCK in class I, 146735 for the trademark MERCK in class 1, 146102 for the mark MERCK in class 5 are duly registered in India. The said registrations are valid and in force and the Complainant started using the house trademark MERCK in India through its subsidiary company Merck Ltd. In the year 1967 and



has been using the same continuously and uninterruptedly till date. That Complainant has registrations of the trade mark MERCK in various countries around the world and the word MERCK 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.

- (d) The trademark and the trade name MERCK has been derived some 150 years ago from the name of the founder members of the complainant and 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

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

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

The aforesaid products sold and offered for sale by the complainant under the house trade mark MERCK are of excellent quality and thus 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.

The trademark MERCK of complainant is a well known trademark and the complainant has about 1087 domain names registered in its name throughout the world, all having component MERCK as a significant part thereof.

- (e) Lastly the complainant filed this complaint for Arbitration proceeding and the complaint was produced before the Arbitrator on September 24th, 2012 and the Arbitrator sent a notice, to the Respondent through his email for the Arbitration Proceeding on October 16th, 2012, to submit his reply but nothing was submitted to Arbitrator till the date of award hence the AWARD is being declared on the December 10th, 2012 as Ex-parte.

5. Parties Contentions:

- (a) Complainant contends that
 - (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, and the domain name be transferred to the Complainant.
- (b) Respondent contends that

The respondent gave no response and produced no reply.

6. Discussion & Findings:

- (i) The Respondent has no right or legitimate interest in respect of the impugned domain name. MERCK is not the personal or surname name, trade/service mark, trading name, of the Respondent. He has no reason whatsoever to adopt the domain name "merck-



chemicals.co.in", which is a well known registered trade mark of the Complainant.

- (ii) The Respondent has registered domain name having component Merck which is house trademark of complainant so as to trade upon the reputation and goodwill accruing to the complainant's in it's well known trademark MERCK and undue profit and the intention of the respondent in registering the subject domain name having component/trademark MERCK of the complainant is not only malafide but dishonest in that it was aware that the well known trademark MERCK was/is the trademark of the complainant and hence the respondent deliberately registered the subject domain name having component/well known trademark MERCK so as to create confusion in trade and general public.
- (iii) The Complainant thus has satisfied the Arbitrator on all the parameters as mentioned in the Paragraph 4 of the Policy (INDRP).

7. Decision:

Hence the Arbitrator decides, 'the Disputed Domain Name www.merck-chemicals.co.in is identical or confusingly similar to registered trademark of the Complainant and Respondent has no right to use the disputed domain name and the Respondent domain name has been registered in bad faith.

The Arbitrator further decides and orders that the domain name www.merck-chemicals.co.in shall be transferred to the Complainant with immediate effect.


Dr. BODHISATVA ACHARYA
SOLE ARBITRATOR
NIXI

DATED: December 10TH, 2012,
PLACE: NEW DELHI,
INDIA.