

1. The Parties

The **Complainant** in this arbitration proceeding is **Ferrer International S.A.**, of the address: *Avenida Diagonal 549, Pta. 5, 08029, Barcelona, Spain.*

The **Respondent** in this arbitration proceeding is **Ferrer international Laboratories**, of the address: *A-21/27, Naraina, Industrial Area, Phase-II, New Delhi 110028, India.*

2. The Domain Name, Registrar and Registrant

The present arbitration proceeding pertains to a dispute concerning the registration of domain name <**FERRERGROUP.IN**> with the .IN Registry. The Registrant in the present matter is **Ferrer international Laboratories**, and the Registrar is **Godaddy.com, LLC**.

3. Procedural History

The arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI).

NIXI vide its email dated January 06, 2022, had sought consent of Mr. Vikrant Rana to act as the Sole Arbitrator in the matter. The Arbitrator informed of his availability and gave his consent vide Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the INDRP Rules of Procedure vide email on January 7, 2022. Arbitrator confirmed due receipt of the soft copies of the domain complaint as sent by NIXI on January 06, 2022 itself, however observed that the domain complaint had not been amended to include the complete details of the Registrant as revealed by the unredacted copy of the WHOIS records of the disputed domain name as had already been provided by NIXI to the Complainant and which were also annexed to the domain complaint. Accordingly, vide email dated January 11, 2022, Arbitrator requested Complainant to re-file the amended domain complaint, inter alia including complete details of the Respondent as revealed in the unredacted WHOIS record for the domain. Counsel for the Complainant duly amended the complaint and re-submitted the same for the consideration of the Arbitrator. Arbitrator acknowledged the same and, vide email of January 12, 2022, requested Complainant's counsel to serve the domain complaint as filed, along with all requisite annexures, upon the Respondent and provide proof of delivery by January 19, 2022. On January 12, 2022, Complainant's counsel copied Arbitrator on an email addressed to the Respondent, inter alia serving a full set of the domain complaint as filed along with accompanying annexures. However Arbitrator clarified, vide email on the same day, that proof of delivery of the correspondence would be required in order to ensure due service upon the Respondent. Complainant's counsel thereafter supplied proof of delivery of the domain complaint as filed along with accompanying annexures upon the Respondent vide email, however requested to be excused from the obligation of providing proof of physical service as the same would not be possible within the stipulated time period owing to their being located in Spain. Arbitrator took the request of Complainant's counsel into consideration and waived

Vikrant Rana

requirement of service by hard copy, deeming service vide email to be sufficient for the purpose and thereafter commenced arbitration proceedings in respect of the matter on January 13, 2022. Respondent was granted time till January 27, 2022 in order to submit their response. As no response was received from Respondent within the stipulated time period, Arbitrator granted them an additional but non-extendable period of seven (7) days, i.e. till February 03, 2022, to submit a response to the domain complaint. Still having received no reply from Respondent, Arbitrator concluded proceedings on February 08, 2022, and reserved the present award.

4. Factual Background/ Complainant's Contentions and Arguments

The Complainant has submitted that **FERRER INTERNACIONAL, S.A.** (hereinafter, **FERRER**) is an international pharmaceutical company active in the pharmaceutical, health, fine chemicals and food sectors and engaged in the research, production and sale of pharmaceuticals and pharmaceutical raw materials.

That **FERRER** was established in 1959 in Barcelona, Spain, and currently has a presence in over 100 countries, including in South America, as well as in Africa and in the Middle East and Far East, and business activity in France, Italy, Belgium, Portugal and Greece, with a 2,000+ member global team.


That **FERRER** has 2 research centres, one based in Barcelona, conducting all-round drug research, while the other operates out of Alsdorf, Germany and specializes mainly in pharmaceutical technology.

That the company trades under the names **Ferrer Farma** and **Grupo Ferrer** (or **Ferrer Group** in English). It is made up of 30 companies operating in pharmaceuticals, food and fine chemicals, with the overall aim to improve people's health and quality of life.

That **FERRER** was responsible for developing the drug **CERAXON** (which is also their claimed trademark), the first and only oral solution medical food containing citicoline. **CERAXON Oral Solution** provides patients who have difficulty swallowing with elevated citicoline required to help stabilize the brain, specifically during the first six weeks following injury.

A. The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

(Paragraph 4 (a) of the INDRP; and paragraph 4 (b), (v), (vi) of INDRP Rules of Procedure)

In support of the requirements under the captioned provisions of the INDRP (combined with the relevant Rules of Procedure) the Complainant has submitted that they are the registered proprietors of the trademarks **FERRER** and variations thereof (such as  **ferrer** / **FERRER INTERNACIONAL/ GRUPO FERRER INTERNACIONAL**) in various jurisdictions around the world, including Spain, European Union, UK, Perú, Philippines, India, etc., since 1967, in respect of goods and services under Classes 1, 3, 5 and 42. Furthermore, the Complainant maintains their principal global website at <**ferrer.com**>.

The Complainant has submitted that Respondent is making use of the trademark **FERRER**, as well as the denomination, **FERRER INTERNATIONAL** on the website at the impugned domain <**FERRERGROUP.IN**>.

The Complainant has submitted that the disputed domain name incorporates the Complainant's registered trademark "FERRER" in its entirety along with the descriptive a non-distinctive word

Murant Lane

“group” as a suffix, which it is insufficient for differentiation and that it in fact strengthens the idea that the website may be an official website of **FERRER** in India, because **FERRER** is also known internationally as GRUPO FERRER or FERRER GROUP. Therefore, this domain name gives an appearance of being an official website of **FERRER** in India and is purportedly being used in connection with selling counterfeit goods. Therefore, the Domain Name is identical and confusingly similar to the registered trademark **FERRER**.

That therefore, the Respondent-Registrant is taking an unfair advantage of the registered trademark **FERRER** and causing a likelihood of confusion among consumers and internet users, since the website tries to impersonate **FERRER** by creating a legitimate appearance with the same look & feel. The Complainant has also submitted that the Respondent-Registrant is in fact advertising their trademarked product, **CERAXON**, via their website hosted at the impugned domain. **<FERRERGROUP.IN>**.

The Complainant has submitted that there are sufficient significant similarities between the Respondent’s business and theirs, as reflected on the erstwhile website as hosted on the impugned domain, **<FERRERGROUP.IN>**, and that there has been deliberate and mala fide attempts by Respondent to associate their business with that of the Complainant’s. Complainant submits that it is evident from both the denomination and the content hosted therein that the disputed domain name was registered and is being used to lead users and consumers to think that they can buy original **FERRER** products from this website. All this constitutes identity theft and fraud, and it carries high risks of damages both to **FERRER** and third parties, especially to consumers, since they are buying pharmaceutical products without license, what it is really dangerous to people’s health.

Complainant has relied on the following precedents in support of its contentions under this head:

- *Indeed, Inc. v. Ankur Shrivastav (indeedgroup.in)*, INDRP Case No. 1216;
- *Sage Group Holdings Limited v. Nitin Ramchandra Parkale & Anr. (sagegroup.co.in)*, INDRP Case No. 1065;
- *Bayerische Motoren Werke AG (“BMW”) v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*, WIPO Case No. D2017-0156;
- *VF Corporation v. Vogt Debra*, WIPO Case No. D2016-2650;
- *Zippo Manufacturing Company v. Domains by Proxy, LLC and Paul Campanella*, WIPO Case No. D2014-0995.

B. The Respondent has no rights or legitimate interests in respect of the Domain Name.
(Paragraph 4 (b) and 6 of the INDRP; and paragraph 4 (b) (vi) of INDRP Rules of Procedure)

In support of the requirements under the captioned provisions of the INDRP (combined with the relevant Rules of Procedure) the Complainant has submitted that there is no evidence of any previous use of the disputed domain name or any name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services, or whether the Respondent has been commonly known by the Domain Name. That there is not any evidence of a use of any kind by the Respondent of the trademark **FERRER** save creation of the disputed domain name on 14th April 2021, i.e. more than 50 years after the first trademark register of **FERRER**. The Complainant has claimed to have been using the registered trademark **FERRER** since very long and the Respondent has registered the Domain Name consisting of the trademark owned by the Complainant without authorization when the Complainant is the only person, either legal or natural, that has rights to exploit the trademark **FERRER**, and they have never authorised, licensed or otherwise permitted Respondent or any other party to use the mark. Therefore, the Complainant has contended that the Respondent is not making a fair use of the disputed domain name as it may easily mislead consumers to associating them with



the trademark **FERRER** and, at the same time, that it impedes the Complainant from using the disputed domain name, despite being the owner of the **FERRER** trademark.

The Complainant has contended that not only is the Respondent unauthorizedly making use of their registered trademark, but they are also operating an illegal online pharmacy from the website hosted at the disputed domain name from where they are selling purportedly counterfeit pharmaceuticals, and also offering for sale the product under the impugned name CERAXON, which is also a registered trademark of the Complainant. Complainant has contended that prior Panels have categorically held that the use of a Domain Name for illegal activity, such as the sale of counterfeit goods and impersonation, as it is the case here, can never confer rights or legitimate interests on a Respondent. Particularly, in the case of counterfeits and pharmaceuticals, this is true irrespective of any disclosure on the related website that such infringing goods are "replicas" or "reproductions". Respondent's use of the disputed domain name to offer counterfeit versions of Complainant's products cannot be said to be a bona fide offering of goods or services as contemplated under the provisions of the INDRP.

The Complainant has also stated on the record that they had approached the Respondent by way of a legal notice dated October 28, 2021 to which they had received no response. Thereafter, they had attempted to contact the Respondent by way of the messaging mechanism provided on their website (at the disputed domain name), to which they had received brief acknowledgements from the Respondent, but no gestures towards resolution. The Complainant has also stated that they had concurrently approached the domain registrar and web hosting provider, **GoDaddy LLC**, vide correspondence dated October 28, 2021, towards having the impugned website removed, however had received a response dated November 29, 2021, inter alia informing that GoDaddy would only be willing to suspend the impugned website in compliance with appropriate directions from an adjudicating authority.

Complainant has annexed copies of the mentioned correspondence as Annexes 3 and 4 to the domain complaint.

Complainant has relied on the following precedents in support of its contentions under this head:

- *The Procter & Gamble Company v. Whoisguard, Inc. / Enzo Gucci, Xtremcare, Tony Mancini, USDIET, USDIET Ltd.*, WIPO Case No. D2016-1881;
- *Pfizer Inc. v. Ubrokerage Inc*, WIPO Case No. D2015-1927;
- *Philip Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilipplein*, WIPO Case No. D2015-1050;
- *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847.

C. The Domain Name was registered and is being used in bad faith.

(Paragraph 4 (c) and 7 of the INDRP; and paragraph 4 (b) (vi) of INDRP Rules of Procedure)

In support of the requirements under the captioned provisions of the INDRP (combined with the relevant Rules of Procedure) the Complainant has submitted that the facts of the present case are squarely hit by the provisions of Paragraph 7(c) and (d).

The Complainant has contended that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation and endorsement of the website and the products made available thereon. That the Respondent is trying to impersonate **FERRER** by creating an online shop selling products that pretend to be original but are likely counterfeit (given their unauthorized nature) which is evident of manifest bad faith.

That the Respondent is also attempting to cause actual confusion for their own commercial benefits. That the Respondent had the Complainant's business and trademarks in mind while registering the disputed domain name and had full knowledge of their superior rights thereto and even after being informed of their contravention, made no attempts to rectify or resolve the dispute with the Complainant. That Respondent's actions make them criminally liable for identity theft and fraud, as it carries high risks of damages in the pharmaceutical field, both to **FERRER** and third parties, especially to consumer health.

Complainant has relied on the following precedents in support of its contentions under this head:

- *Indeed, Inc. v. Ankur Shrivastav (indeedgroup.in)*, INDRP Case No. 1216;
- *Booking.com BV v. Chen Guo Long*, WIPO Case No. D2017-0311;
- *Sage Group Holdings Limited v. Nitin Ramchandra Parkale & Anr. (sagegroup.co.in)*, INDRP Case No. 1065;
- *Ebel International Limited v. Alan Brashear*, WIPO Case No. D2017-0001;
- *The Dow Chemical Company v. dowaychemical eva_hwang@21cn.com +86.7508126859*, WIPO Case No. D2008-1078;
- *Ctrader Limited v. Niko Wibisono*, WIPO Case No. D2013-1906;
- *Emirates of Emirates Group v. Zhan Yun (emiratesgroup.in)*, INDRP Case No. 606;
- *Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO Case No. D2000-0253;
- *Legacy Health System v. Nijat Hassanov*, WIPO Case No. D2008-1708;
- *LeSportsac, Inc. v. Yang Zhi*, WIPO Case No. D2013-0482;
- *Trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. D2014 0365;
- *Walgreen Co. v. Muhammad Azeem / Wang Zheng, Nicenic International Group Co., Limited*, WIPO Case No. D2016-1607;
- *Lilly ICOS LLC v. Dan Eccles*, WIPO Case No. D2004-0750

5. Other Legal Proceedings

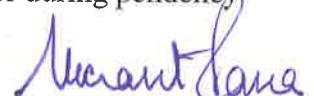
The Complainant has submitted that they are unaware of any other legal proceedings that have been commenced or terminated in connection with the domain name <**FERRERGROUP.IN**>.

6. Reliefs claimed by the Complainant (Paragraph 10 of the INDRP read with Paragraph 4(b)(vii) of the INDRP Rules of Procedure)

The Complainant has requested that the domain name <**FERRERGROUP.IN**> be transferred to them.

7. Respondent's Contentions

As already mentioned in the Procedural History of the matter, despite having been duly served with a copy of the Domain Complaint as filed, and thereafter granted adequate time to respond to the same, the Respondent had not submitted any response thereto, or in fact any communication of any kind to either the Complainant, NIXI or the Arbitrator during pendency of arbitral proceedings in the matter.




8. Discussion and Findings

In a domain complaint, the Complainant is required to satisfy three conditions as outlined in Paragraph 4 of the .IN Domain Name Dispute Resolution Policy, i.e.:-

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

i. **The Registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights**
(Paragraph 4(a) of the .IN Domain Name Dispute Resolution Policy)

The Arbitrator finds that the Complainant has been able to sufficiently prove their trademark rights to the trademark **FERRER** and variations thereof, including  **ferrer**, **FERRER INTERNACIONAL**, **GRUPO FERRER INTERNACIONAL**, inter alia by way of pre-existing international registrations designating India, as well as local trademark registrations in Spain, the EU and in the UK. The Complainant also holds the domain registration for <**ferrer.com**> (since December 2013) wherein Complainant hosts their primary global website.

Complainant has also been able to satisfactorily prove that the domain name in question, namely <**FERRERGROUP.IN**> conflicts with their trade identity, namely as **GRUPO FERRER/GRUPO FERRER INTERNACIONAL** (i.e. **FERRER INTERNATIONAL GROUP**).

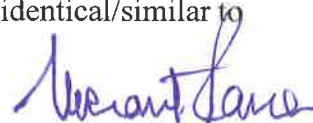
The addition of the descriptive term "GROUP" after "FERRER" in the disputed domain name does nothing to detract from its identity/deceptive similarity with Complainant's registered trademarks, especially since it encompasses "FERRER" in toto.

Complainant's reliance on earlier precedent stating inter alia that generic terms such as "GROUP" does not affect a finding of confusing similarity holds here as well and Arbitrator is convinced by earlier precedents by similar Panels in this regard.

Respondent has not tendered any evidence that they hold any rights to the name/mark **FERRER/FERRER GROUP**.

Arbitrator notes that there is no longer any website available for viewing on the disputed domain name. However, taking into consideration the screenshots annexed by the Complainant (which have not been refuted by the Respondent), it is evident that the domain had resolved to a website visually similar to that of the Complainant's (at their global official website, **ferrer.com**), and was bearing the Complainant's trademarks (namely, **FERRER**).

In view of the aforesaid, the Arbitrator finds that the Complainant has successfully established the requirements as under Paragraph 4(a) of the .IN Domain Name Dispute Resolution Policy, and that the Respondent's domain <**FERRERGROUP.IN**> is confusingly identical/similar to the Complainant's trade mark(s) **FERRER**.



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

(Paragraph 4(b) and Paragraph 6 of the .IN Domain Name Dispute Resolution Policy)

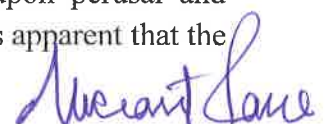
The Complainant has contended that the Respondent has no right or legitimate interest in respect of the domain <FERRERGROUP.IN>.

In the present dispute, Complainant has established that it has rights over the trademark **FERRER** and variations thereof, and is also known by the trade name **GRUPO FERRER/GRUPO FERRER INTERNACIONAL** (i.e. **FERRER INTERNATIONAL GROUP**) and that the domain <FERRERGROUP.IN> is confusingly identical/similar to the Complainant's trade mark.

The element under Paragraph 4(b) and Paragraph 6 of the .IN Domain Name Dispute Resolution Policy necessitates that Complainant has to establish a prima facie case that Respondent has no rights or legitimate interests in the disputed domain in question. The burden thereafter lies on the Respondent to rebut the showing by providing evidence of its rights or legitimate interests in the domain name. It has been held in numerous cases, including in *Huolala Global Investment Limited v Li Chenggong (INDRP /1027)* that the onus of proving rights or legitimate interest in the disputed domain name lies on the Respondent. If the Respondent fails to come forward with relevant evidence to prove rights and legitimate interest in the disputed domain name, and if the Complainant is found to have put forward a prima facie case, then the Complainant prevails.

In this case, the Respondent has not submitted any response and/or any evidence of its rights and interests even though extended time period and ample opportunities were granted to the Respondent in this regard. The Respondent has not been able to establish any of the conditions pre-requisite for considering a registrant's rights and legitimate interests in a domain name as set out under Paragraph 6 of the INDRP.

Further, it has been contended by the Complainant that they have not licensed or authorized the Respondent to use the said domain name and neither is the Respondent commonly known by the said domain name. Further, as submitted by the Complainant, the impugned domain was being used in connection with supplying of unauthorized and purportedly counterfeit pharmaceuticals, which constitutes a criminal offence and endangers the lives of the general public. The Complainant has also contended that the Respondent did not supply a suitable response or commitment towards resolution of the dispute when they were contacted by means of a legal notice in October 2021. Complainant also had to approach the domain registrar to remove the website (which, Arbitrator notes, is currently not available for viewing, showing instead an error message: "Account Suspended"). Nevertheless, based upon perusal and analysis of the screenshots of the Respondent's erstwhile active website, it is apparent that the



Respondent was indeed trying to trade off on the trademarks and look and feel of the Complainant's official website, towards selling their own products for financial gain, and lure unwary consumers into believing that they were in fact supplying Complainant's authentic products, which was clearly not the case.

Complainant has additionally contended that the Respondent had also been making use of other of their registered trademarks (namely CERAXON) without their due authorization, which further proves lack of legitimate right or interest in the domain name and that its use by the respondent was not such as to constitute 'fair use' as contemplated under the INDRP.

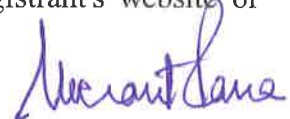
Accordingly, the Complainant's claim that such use by the Respondent is neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the domain name hold merit. In view of the above, it can be stated that *prima facie* the Respondent cannot be said to be making legitimate or fair use of the domain name.

The Complainant has established a *prima facie* case of its rights in the trademark **FERRER**, and in view of the Respondent's non-response, despite ample opportunities having been provided to them, the Arbitrator finds that Respondent has not established any rights or legitimate interests in the disputed domain name and that the Respondent is not using the disputed domain name for a bona fide offering of services and is not making legitimate non-commercial or fair use of the Complainant's trade mark.

In view of the aforesaid, the Arbitrator finds that the Complainant has successfully established the requirements as under Paragraph 4(b) of the .IN Domain Name Dispute Resolution Policy.

iii. The Registrant's domain name has been registered or is being used in bad faith (Paragraph 4(c) and Paragraph 7 of the INDRP)

Paragraph 7 of the INDRP stipulates the below circumstances which show registration and use of a domain name in bad faith - (a) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or (b) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or (c) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.



The Complainant has established its rights in the trademark **FERRER** (dating back to 1967 globally) and variations thereof, along with submitting evidence of its trademark/ domain registrations pre-dating the Respondent's registration of the impugned domain. Further, Complainant has submitted that the Respondent had knowledge of the Complainant's mark, which is further borne out by their interim acknowledgements of the Complainant's communications. However, their lack of overture towards resolution of the Complainant's objections as communicated to them, smacks of mala fide intention as alleged by Complainant in this regard.

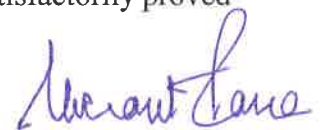
Further, as submitted by the Complainant, the impugned domain was being used in connection with supplying of unauthorized and purportedly counterfeit pharmaceuticals, which constitutes a criminal offence and endangers the lives of the general public. It is additionally apparent that the Respondent had been trying to trade off on the trademarks (including the Complainant's other registered trademarks, such as CERAXON) and look and feel of the Complainant's official website, towards selling their own products for financial gain, and lure unwary consumers into believing that they were in fact supplying Complainant's authentic products, which was clearly not the case. Thus, the Respondent's cumulative conduct in the matter has been mala fide from the start, with the culpable intention of riding on the reputation of the Complainant's trademarks for undeserved financial rewards.

Based on the above, it appears that by registering and using the domain <**FERRERGROUP.IN**>, the Respondent has engaged in conduct as enumerated in paragraph 7 (c) of the INDRP, namely that *it has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.*

Further, the Respondent's use of the disputed domain name has not been defended as having been bona fide and the Respondent has not submitted any reply nor rebuttal to the Complainant's contentions, or evidence in support of its bona fide use and/ or adoption of the disputed domain name.

In light of the above and in the absence of any defense by the Respondent, the Arbitrator finds that the disputed domain name was registered and is being used in bad faith.

In view of the aforesaid, the Arbitrator concludes that the Complainant has satisfactorily proved the requirements of Paragraph 4(c) and Paragraph 7 of the INDRP.



9. Decision

Based upon the facts and circumstances and further relying on the materials as available on the record, the Arbitrator is of the view that the Complainant has established rights over the trademark/trade name **FERRER/ FERRER GROUP**. In light of the non-response by the Respondent, the Complainant has been able to prove conclusively that:

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

The Arbitrator therefore allows the prayer of the Complainant and directs the .IN Registry to transfer the domain **<FERRERGROUP.IN>** to the Complainant.

The Award is accordingly passed and the parties are directed to bear their own costs.



Vikrant Rana, Sole Arbitrator

Date: February 28, 2022.

Place: New Delhi, India.