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e-Stamp

Certificate No. : IN-DL57940002137896T
 Certificate Issued Date : 10-Mar-2021 01:00 PM
 Account Reference : SELFPRINT (PU)/ dl-self/ NEHRU/ DL-DLH
 Unique Doc. Reference : SUBIN-DL DL-SELF17772418052784T
 Purchased by : IRA LAW PREETIKA KASHYAP
 Description of Document : Article 12 Award
 Property Description : ARBITRATION AWARD
 Consideration Price (Rs.) : 0
 (Zero)
 First Party : BINNY KALRA
 Second Party : NONE
 Stamp Duty Paid By : BINNY KALRA
 Stamp Duty Amount(Rs.) : 100
 (One Hundred only)

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Online E-Stamp Certificate Online E-Stamp Certificate Online E-Stamp Certificate Online E-Stamp Certificate
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ARBITRATION AWARD

.IN REGISTRY

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <merckpharma.in>

Merck KGaA

Complainant

vs

Vishal Tanwar

Registrant

Binny Kalra

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**ARBITRATION AWARD
.IN REGISTRY**

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <merckpharma.in>

In the matter of:

Merck KGaA
Frankfurter Strasse 250,
64293 Darmstadt,
Germany

Complainant

vs

Vishal Tanwar
h house 45, jh house 32
New Delhi 110028,
India
Email: vt83174l@gmail.com

**Registrant/
Respondent**

INDRP Case No: 1322

1. The Parties:

The Complainant is Merck KGaA having its postal address at Frankfurter Strasse 250, 64293 Darmstadt, Germany, who is represented in these proceedings by its authorised representative Markus Rouvinen, Thomsen Trampedach GmbH, having his address at Kompagnistrede 18, 1204 Copenhagen, Denmark. The Registrant is Vishal Tanwar whose particulars in the WHOIS data are the following:

Registrant organization: " ighq"

Registrant street address: h house 45, jh house 32

Registrant State/Province: Delhi

Registrant city: uie2339e8

Registrant postal code: 110028

Registrant country: India

Registrant phone: +91.8828425825



Registrant fax: +91. 7857824185

Registrant email: vt83174l@gmail.com

The Registrant could not be served at the email address given in the WHOIS data and an alternative email address provided by the Complainant.

2. The domain name, Registrar, and Policy:

These proceedings pertain to a dispute regarding the domain name merckpharma.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is GoDaddy.com LLC. The present arbitration is being conducted in accordance with the Arbitration and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy ("**Policy**") and the INDRP Rules of Procedure ("**Rules**").

3. Procedural history:

- 23 February 2021: Consent of the arbitrator along with a declaration of impartiality and independence was given to the .IN Registry
- 25 February 2021: A notice from the .IN Registry to the parties informing them of the appointment of the arbitrator was sent along with the complete set of papers comprising the Complaint and its annexures.
- 25 February 2021:
- Notice of commencement of arbitration proceedings was sent to all parties by the arbitrator and a period of 30 days, until 27 March 2021, was given to the Registrant to submit a statement of defence.
 - The Registrant could not be served with the notice of commencement of arbitration proceedings at the email addresses provided in the complaint namely postmaster@merckpharma.in and vt83174l@gmail.com as these emails bounced.



- The Complainant was called upon to confirm if there was any alternative email address of the Registrant for service. The Complainant updated the complaint with an alternative address saina@merckpharma.in with a note "not included in WHOIS data but related to the Complainant by a third party".

26 February 2021: The notice of commencement of arbitration proceedings was again sent to all email addresses of the Registrant made available to the Panel. However email service on the Registrant failed and delivery failure reports were received for each of these addresses, namely postmaster@merckpharma.in, vt83174l@gmail.com and saina@merckpharma.in.

27 February 2021: The Panel informed NIXI and the Complainant that since there appeared to be no other reasonable means of serving the other party, the arbitration proceedings will continue ex parte against the Registrant and a default award will be passed.

4. The Complainant's case:

The Complainant has at the outset given the details of the trademarks on which the complaint is based, namely:

- i. "MERCK", International Trade Mark Registration No. 1349459 designating India, registered with effect from 15 December 2017 inter alia in class 5 in respect of "Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides".



- ii. "MERCK", Indian Trade Mark registration No. 146102, registered with effect from 11 November 1950 in class 5 in respect of "Medicinal and pharmaceutical preparations and chemical preparations used in medicine".

These registrations are seen at Annexure 2.

The Complainant has further made the following factual claims:

- The Complainant is one of the largest and oldest life science and technology conglomerates in the world.
- It is a direct continuation of the pharmacy founded in Darmstadt, Germany by Friedrich Jacob Merck in 1668.
- The Complainant holds rights to the name and mark "Merck" in connection with the offering of pharmaceutical and life science-related products worldwide, excluding USA and Canada, where the rights to the name "Merck" belong to an unrelated US company Merck & Co, Inc.
- Merck's current business consists of three main areas, Healthcare and pharmaceuticals, Life Science products and services targeting the research community and high-tech Performance Materials for industrial applications.
- Merck has been actively in business in India since 1904, and it was first incorporated in 1967 through the subsidiary E. Merck India Private Limited.
- Merck presently has over 2000 employees in India and operates offices, manufacturing sites and IT centres across Mumbai, Bengaluru, Delhi, Hyderabad and Kolkata.

5. Legal grounds:

Under Paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

- (a) the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and



(b) the Registrant has no rights or legitimate interests in respect of the Disputed Domain Name; and

(c) the Disputed Domain Name has been registered or is being used in bad faith.

6. Discussion and findings:

The Registrant could not be served and has therefore not been represented in the present proceedings. Therefore, the claims of fact made by the Complainant as summarized in paragraph 4 of this decision, shall be accepted by the Panel if they are found to be *prima facie* valid. The following discussion therefore proceeds on this basis.

A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights

The Disputed Domain Name is <www.merckpharma.in>. The Complainant has claimed statutory and common law rights in the mark MERCK. The evaluation of Issue A shall therefore be twofold:

a. Whether the Complainant has rights in the mark / name "Merck"

The Panel notes the following factors that are most relevant to establish that the Complainant has rights in the mark / name "Merck":

- Indian trademark registration No. 146102 and IRN 1349459 designating India for the word mark MERCK in class 5. The Panel notes that the screenshot of the online records of the Trademark Office filed as Annexure 5 shows that the use of the trademark MERCK bearing registration No. 146102 is claimed since 1 December 1904. These registrations give the Complainant a right to the exclusive use of the trademark "Merck" inter alia in respect of pharmaceutical preparations.



Section 28 of the Trademark Act 1999 confers on the registered proprietor the exclusive right to the use of the mark for the goods and services for which it is registered. The Hon'ble Supreme Court in *Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd.* [(2004) 6 SCC 145] has held that, in relation to commercial activity on the internet, domain names are used as business identifiers and that where domain names are used in connection with a business, the value of maintaining exclusivity becomes critical;

- The domain name www.merck.in was registered on 11 February 2005 by the Complainant as per the WHOIS record filed as Annexure 7. The Panel notes that the said domain name resolves to the Complainant's website at www.merckgroup.com;
- The Complainant is a very well-established company in the field of pharmaceuticals and has had a presence in India for well over 50 years. The Panel viewed the website and the history of the Complainant filed as Annexure 4 and found its claims to be substantiated;

The Panel finds each of these claims to be *prima facie* valid, based on the documents placed on record as Annexures 1 to 8 to the Complaint. It is noted that the registrant information in the WHOIS data (Annexure 1 attached with the Complainant's email of 26 February 2021) is apparently incorrect with details of the Registrant Organization ("ighq"), Registrant Street ("h house 45 jh house 32") and Registrant City ("uie2339e8") that sound fictitious.

In view of the above noted factors, the Panel finds that the Complainant has clearly established statutory and common law rights in the trademark MERCK in India, and its associated goodwill and reputation in the said trademark entitles it to claim protection for a domain name incorporating its trademark.

b. Whether the Disputed Domain Name is identical and/or confusingly similar to the trademark MERCK



The Panel finds a clear similarity between the Disputed Domain Name and the Complainant's trademark MERCK, and notes that:

- The Disputed Domain Name <www.merckpharma.in> wholly contains the Complainant's trademark MERCK, which is protected under Indian trademark registration Nos. 146102 and 3574581;
- The descriptive suffix "pharma" along with the word MERCK in the Disputed Domain Name does not diminish its confusing similarity to the Complainant's trademark MERCK. It is well settled law that the mere addition of a descriptive term is not sufficient to distinguish a subsequent user's mark/name from a prior trademark/ trade name. This reasoning has been upheld in several decisions, including *Citigroup Inc. v. Citicorp Business & Financial Pvt. Ltd.* [(2015) 216 DLT 359].
- Notwithstanding the addition of the suffix "pharma" to the Registrant's Disputed Domain Name, there is a real likelihood that consumers who access the Registrant's website at www.merckpharma.in will associate it with the Complainant, believing it to be that of or related to the Complainant. This is more so because the Complainant is a well-known pharmaceutical company and "pharma" is a commonly used abbreviated form of "pharmaceutical";
- The fact that the Registrant has chosen the exact spelling of the word MERCK with the descriptive suffix "pharma" is self-evident of its intent to cause confusion. The Disputed Domain Name is likely to mislead consumers who access the Registrant's website and it has a high likelihood of causing confusion and diversion of consumers to the Registrant's website and consequently of causing irreparable harm to the Complainant's business. The reasoning applied by the learned arbitrator in an earlier award in favour of the Complainant with respect to the domain name merckchemicals.in [Case No. INDRP/323] dated 28 February 2012 and the cases referred to therein are very pertinent to the present dispute.



For the above reasons, the Panel finds that the Disputed Domain Name is confusingly similar to the trademark MERCK in which the Complainant has legal rights.

B. Whether the Registrant has any rights or legitimate interests in respect of the Disputed Domain Name

- Given the nature of the word MERCK which is a distinctive trademark with no dictionary meaning or connotation other than as an identifier of the Complainant's business and products, it is unlikely that the Registrant registered the Disputed Domain Name without any knowledge of the Complainant's prior use of and rights in the said mark in respect of pharmaceuticals.
- There is also no evidence on record to suggest that the Registrant is known by the name "Merck".
- From the documents on record, specifically Annexure 8, it does not appear that the Registrant is making legitimate non-commercial or fair use of the Disputed Domain Name. The Complainant also appears to have received a complaint from one Rohit Ambasta who claims to have been defrauded of a sum of money by someone posing as a recruiter offering employment in the Complainant company using email addresses associated with the Disputed Domain Name.
- Based on the submissions made in the complaint and the documents placed on record by the Complainant at Annexures 1 to 8, this appears *prima facie* to be a straightforward case of wrongful registration of a domain name by the Registrant violating the trademark rights of the Complainant.

Therefore, the Panel finds that the Registrant has no rights or legitimate interests in the Disputed Domain Name.



C. Whether the Disputed Domain Name has been registered or is being used in bad faith

As noted earlier by the Panel, the Registrant could not be served with the notice of arbitration due to the incorrect email and registered address provided in the WHOIS data filed as Annexure 2.

- Under the General Registration Policies formulated by the .IN Registry available at <https://www.registry.in/Policies>, "registrants must provide true, accurate contact information." The providing of fictitious registrant details for the registration of a domain name that contains the registered trademark of another entity is a tell-tale sign of dubious intentions on the part of a registrant.
- The Registrant in this case appears to be keen to deliberately conceal its identity which is inconsistent with a person having a genuine right and legitimate interest in a domain name. In fact, the failure of the Registrant of the Disputed Domain Name to provide accurate contact information is an obvious attempt to remain elusive and can be considered as an indication of bad faith even if this particular instance of bad faith is not specifically enumerated in the INDRP Policy, and there is little scope for any other conclusion. This reasoning has been upheld by the WIPO administrative panel in its decision of 29 October 2000 in *Nintendo of America Inc. v. Berric Lipson* [Case No. 2000-1121].
- The Panel also accepts the Complainant's submission that, given the established reputation of the Complainant's trademark MERCK in the pharmaceutical sector, the Registrant is likely to have been aware of the inevitable likelihood of confusion resulting from the Disputed Domain Name when the same was registered on 26 May 2020. The Panel does not find it difficult to conclude that by knowingly choosing a domain name incorporating the Complainant's trademark the Registrant intended to benefit from its association to the Complainant's business.
- The Panel also accepts the Complainant's submission that the Registrant has used the disputed domain name in bad faith because:



- a. the Disputed Domain Name was used fraudulently to direct phishing emails via the email address saina@merckpharma.in to persons of Indian nationality with fraudulent offers of employment at the Complainant's company. It has been previously held in other decisions [for example, Case No. INDRP/948 and Case No. INDRP/987] that the use of a disputed domain to send fraudulent emails constitutes bad faith use of the domain;
- b. the continuing use of the Disputed Domain Name for passive display pay-per-click advertising amounts to bad faith use because such use by the Registrant for pay-per-click ads unrelated to the Complainant is an attempt to capitalize on the confusion created among Internet users who would click on the ads after arriving at the disputed domain, erroneously believing it to be affiliated with the Complainant. This reasoning has been adopted by the WIPO administrative panel in the decision dated 24 June 2008 of *Societe Nationale des Chemins de Fer Francais v. ostrid co.*, [Case no. 02008-0627] wherein it was held that the "Respondent's use of the disputed domain name serves the purpose of generating revenue via advertised pay-per-click products and links and ... that such use in the circumstances does not represent a use in connection with a bona fide offering of goods and services".

The conditions of Paragraph 6 (a), (b) and (c) of the INDRP are not met by the Registrant in the present case because by using the Disputed Domain Name the Registrant has intentionally attempted to attract Internet users to its 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, which is evidence of the registration and use of the Disputed Domain Name in bad faith within the meaning of Paragraphs 4 (c) and 7(c) of the INDRP.

From all the above discussed factors, the Panel finds that the Disputed Domain



Name has been registered and is being used in bad faith.

7. Decision:

As mentioned at the outset, the award is being given ex parte as the Registrant could not be served and is consequently unrepresented in these proceedings.

For the reasons discussed above, the Panel finds that the Complainant has satisfied all three elements required under Paragraph 4 of the Policy to obtain the remedy of transfer of the Disputed Domain Name.

Therefore, the Panel orders that the Disputed Domain Name <**merckpharma.in**> be transferred to the Complainant.

Signed:



Ms. Binny Kalra

Arbitrator

Date: 11 March, 2021