

## **ADMINISTRATIVE PANEL DECISION**

Merck KGaA v. Jimmy Kawekwa, HostGiant Limited

Case No. DME2022-0001

### **1. The Parties**

Complainant is Merck KGaA, Germany, represented by ZMP (Živko Mijatović & Partners d.o.o. Beograd), Serbia.

Respondent is Jimmy Kawekwa, HostGiant Limited, Uganda.

### **2. The Domain Name and Registrar**

The disputed domain name <merckgroup.me> is registered with TLD Registrar Solutions Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 28, 2022. On January 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing additional registrant and contact information for the disputed domain name. The Center sent an email communication to Complainant on February 3, 2022, providing the additional registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 7, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. On February 17, 2022, the Center received several emails from a third party claiming that it has registered the disputed domain name for Respondent, but no formal response was received. Accordingly, the Center informed the Parties that it will proceed to Panel Appointment on March 8, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on March 24, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

Complainant is a major international chemical, pharmaceutical and life sciences company that is headquartered in Germany. It is the proprietor of numerous registrations for its MERCK mark, including the following:

- International Trademark No. 1349459 for MERCK (word mark), registered on November 2, 2016 for goods and services in classes 1, 2, 3, 5, 7, 9, 10, 11, 16, 17, 29, 30, 32, 35, 40, 41, 42, and 44. This registration designates, *inter alia*, Montenegro;
- German Trademark No. 45659 for MERCK (word mark), registered on September 24, 1900 for goods in classes 1, 2, 3, 4 and 5.

Complainant operates its primary business website at the domain name <merckgroup.com>.

The disputed domain name was registered on June 18, 2021. It does not currently resolve to an active website. The record reflects that the disputed domain name previously resolved to a website mimicking that of Complainant. Complainant sent a cease-and-desist letter and email to Respondent on November 3, 2021. The record does not reflect any response thereto.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it is the oldest still operating pharmaceutical and chemical company in the world. The name MERCK was first associated with pharmaceutical goods in 1668 and has been used as a trademark in Germany since 1850. Complainant has 58,000 employees in 66 countries around the world. Complainant owns more than 3,000 registrations for the MERCK mark in more than 175 jurisdictions, and it has registered numerous domain names containing the elements "merck". and "merckgroup" or "merck-group." The disputed domain name is confusingly similar to Complainant's MERCK mark, as it contains the mark in its entirety, together with the non-distinctive term "group."

Under the second element, Complainant states that there is no evidence of Respondent's use of, or demonstrable preparations to use, the disputed domain name. Respondent has not been commonly known by the disputed domain name and has no trademark registrations for it. Respondent is not making a legitimate, non-commercial or fair use of the disputed domain name. Complainant has not authorized Respondent to use its MERCK mark. Respondent's company website does not reveal any legitimate relationship between Respondent and the MERCK mark.

Under the third element, Complainant states that the disputed domain name previously resolved to a website that was an obvious copy of Complainant's website, demonstrating knowledge of Complainant and its MERCK mark. Complainant filed a takedown action and the disputed domain name has been passively held since that time. Several factors indicate bad faith: the MERCK mark is well known, and its registration predates the registration of the disputed domain name; Respondent failed to respond to Complainant's

cease-and-desist letter; there is no legitimate use of the disputed domain name; and Respondent concealed his identity.

Complainant requests transfer of the disputed domain name.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) Respondent has registered and is using the disputed domain name in bad faith.

### **A. Identical or Confusingly Similar**

Complainant has provided evidence establishing that it has trademark rights in the MERCK mark through registrations in numerous jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

In comparing Complainant's marks with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to Complainant's MERCK mark. The disputed domain name comprises Complainant's mark, followed by the term "group." It is the consensus view of UDRP panels that, where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that a country-code Top-Level Domain ("ccTLD"), such as ".me", is viewed as a standard registration requirement and as such may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

### **B. Rights or Legitimate Interests**

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no rights in the MERCK mark. The disputed domain name reflects Complainant's mark together with a term suggesting sponsorship or endorsement by the trademark owner. Such use cannot confer rights or legitimate interests. See, for example, [WIPO Overview 3.0](#), section 2.5.1.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not provided any rebuttal of Complainant's *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name. There is no evidence that Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish Respondent's rights therein. Rather, as the record shows, the disputed domain name resolved to a website that mimicked Complainant's website, reflecting Complainant's MERCK mark and purporting to offer identical services. The Panel finds that such use has been done with the intention of diverting Internet users seeking information about Complainant and its products and services. Such use can never confer rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.13.1, and cases cited thereunder.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant's rights in its MERCK mark predate the registration of the disputed domain name by more than a century. The disputed domain name reflects Complainant's MERCK mark in its entirety, together with the term "group," which implies affiliation with (or being) Complainant. The Panel finds that the evidence supports a finding that Respondent was aware of Complainant when registering the disputed domain name.

The Panel finds that Respondent has demonstrated bad faith use of the disputed domain name. The evidence on record supports a finding that Respondent has, by using the disputed domain name to point to a website copying that of Complainant, intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark. Respondent's website featured Complainant's mark, logo, content and website colors. On these facts, the Panel cannot find any explanation for such actions other than the perpetuation of a fraudulent scheme. Such conduct is emblematic of bad faith use of the disputed domain name. See [WIPO Overview 3.0](#), section 3.1.4.

The Panel also finds that Respondent has demonstrated bad faith by passive holding of the disputed domain name. Such a finding is consistent with previous UDRP decisions, such as *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). See also [WIPO Overview 3.0](#), section 3.3. Complainant has provided sufficient evidence that its MERCK mark is well known, and Respondent has provided no evidence of actual or contemplated good-faith use of the disputed domain name. Respondent has not presented any rational basis for registering and using the disputed domain name, nor does the Panel find that any such a basis is plausible. Such circumstances indicate bad faith in registration and use of the disputed domain name. See [WIPO Overview 3.0](#), section 3.1.1 and cases cited thereunder.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <merckgroup.me> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa/*  
**Ingrīda Kariņa-Bērziņa**  
Sole Panelist

Date: April 7, 2022