

ADMINISTRATIVE PANEL DECISION

Merck KGaA v. Khaled Mahmud, Brighter Care
Case No. D2022-4571

1. The Parties

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

The Respondent is Khaled Mahmud, Brighter Care, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <merckgroupuk.com> is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 30, 2022. On December 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed two amended Complaints respectively on December 7, and 13, 2022.

The Center verified that the Complaint together with the amended Complaints 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 the Respondent of the Complaint, and the proceedings commenced on December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2023.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on January 13, 2023. 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

The Complainant is a German multinational chemical, pharmaceutical and life sciences company with headquarters in Germany and is one of the largest and oldest pharmaceutical companies in the world.

The name MERCK was first associated with pharmaceutical goods in 1668 and used as a trademark in 1850 when the company E. Merck was founded in Germany.

The Complainant is the owner 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. The trademark is duly renewed and currently valid.

The Complainant has a strong Internet presence and owns numerous domain names including its trademark, such as its official domain name <merck.com> that was registered in the year 1992. Also, the Complainant operates its primary business website at the domain name <merckgroup.com>.

The disputed domain name <merckgroupuk.com> was registered on April 29, 2022.

The disputed domain name does not resolve to an active webpage. The evidence on the case file shows that the disputed domain name was used to send fraudulent contact messages.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

Under the first element, the Complainant argues, in addition of the statements under the Section 4, that it has 62,700 employees in 66 countries around the world. Also, the Complainant owns more than 3,000 registrations for the MERCK mark in more than 175 jurisdictions around the world, including the United Kingdom, and it has registered numerous domain names containing the elements "merckgroup" or "merck-group". The disputed domain name is confusingly similar to the Complainant's MERCK mark, as it contains the mark in its entirety, together with the non-distinctive terms "group" and "uk" (an abbreviation of United Kingdom) which does not prevent the confusing similarity.

Under the second element, the Complainant states that there is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent has not been commonly known by the disputed domain name and has no trademark registrations for it. The Respondent is not making a legitimate, noncommercial or fair use of the disputed domain name. The Complainant has not authorized or licensed the Respondent to use its MERCK trademark.

Under the third element, the Complainant argues that the Respondent registered and is using the disputed domain name in bad faith. The Complainant underlines that the disputed domain name was used to send fraudulent contact messages.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The test that the Panel must carry of the disputed domain name in order to establish if they are identical or confusingly similar a trademark involves a comparison between a trademark in which the Complainant has rights and the disputed domain name.

First, in the present case, the Panel is satisfied that the Complainant has established its trademark rights in the MERCK trademark in many jurisdictions and internationally.

Regarding whether the disputed domain name is identical or confusingly similar to the MERCK trademark, this Panel observes that the disputed domain name includes the Complainant's trademark MERCK in its entirety; following by the terms "group" and the "uk" (which is an abbreviation of the United Kingdom in English) and; followed by the generic Top-Level Domain ("gTLD") ".com".

In conclusion, the disputed domain name includes the trademark MERCK in its entirety with the only difference is the inclusion of the terms "group" and "uk" and the inclusion of the gTLD ".com".

It is well established that where a domain name incorporates a complainant's trademark in its entirety, the domain name will be normally considered identical or confusingly similar to that trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. and 1.8 that states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not prevent a finding confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

Also, the addition of the gTLD ".com" is viewed as a standard registration requirement and therefore may be disregarded when determining the confusing similarity between the trademarks and the disputed domain name. See [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark for the purposes of the first element.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

Even though the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#) that a

complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant allegations and evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent does come forward with arguments or evidence proving its rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not commonly known by the disputed domain name or the trademark MERCK. The Respondent has not been authorized by the Complainant to register or use the trademark MERCK in conjunction or separately in any way, including the disputed domain name. The website and the use of the disputed domain name does not show any *bona fide* offering of goods or services. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been refuted by the Respondent.

In the present case, the Panel has the view that the use of the disputed domain name to resolve to inactive website does not constitute a *bona fide* offering goods or services or legitimate noncommercial or fair use by the Respondent within paragraphs 4(c)(i) and (iii) of the Policy.

Regarding paragraph 4(c)(ii) of the Policy, the Panel notes that there is no evidence that the Respondent has been commonly known by the term “merck” or the disputed domain name.

In the present case the Panel finds that the Complainant has made out a *prima facie* case for the disputed domain name. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. In addition, the Complainant comes with evidence showing that the disputed domain name was used to send fraudulent contact messages. Such use of the disputed domain name for illegal activity (phishing, impersonating/passing off) can never confer rights or legitimate interests on the Respondent.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

This Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith pursuant to paragraph 4(b) of the Policy. In order to prevail under the Policy, the Complainant must demonstrate that the disputed domain name have been registered and is being used in bad faith, accordingly it is a cumulative requirement.

The Panel is satisfied that the Respondent must have been aware of the Complainant’s trademark MERCK when it registered the disputed domain name as the disputed domain name contain the Complainant’s widely known trademark in its entirety.

Furthermore, the MERCK trademark is unique to the Complainant. The word “merck” is not commonly used for chemical and pharmaceutical goods and services. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the disputed domain name, without the intention of invoking a misleading association with the Complainant. A factor indicating bad faith, see [WIPO Overview 3.0](#), section 3.2.2 and the cases referenced therein.

Also, from all the available evidence, the disputed domain name was registered long after the Complainant attained registered rights in the Complainant’s trademarks. Previous UDRP panels have consistently found

that registration of a domain name that is confusingly similar to a widely known trademark, as it is the present case in the disputed domain name, can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

The Panel accepts the Complainant's submissions that the trademark MERCK is a distinctive mark and has been in use for a long term and that it is obvious that the Respondent registered the disputed domain name having the Complainant's trademark in mind, due to the fact that the Complainant's rights in its MERCK mark predate the registration of the disputed domain name by more than a century. Also, the nature of the disputed domain name (reflecting the Complainant's MERCK mark in its entirety, together with the terms "group", and "uk" (abbreviation of United Kingdom)) implies affiliation with (or being) the Complainant.

The Panel finds that the evidence supports a finding that the Respondent was aware of the Complainant when registering the disputed domain name therefore the Panel finds that the disputed domain name was registered in bad faith.

The Panel also finds that the Respondent is using the disputed domain name in bad faith.

Here, the Panel notes that the Complainant's trademark is distinctive and well known around the world for pharmaceutical and chemical goods and services, and that the Respondent has not submitted any response or provided any evidence of possible good faith use.

Also the Panel finds that the evidence presented by the Complainant, that the Complainant was informed that a message has been sent to a third party company through contact forms (not direct email) by the Respondent using an email address associated with the disputed domain name as their contact email address, misrepresenting as the Complainant. The email address contains, in whole, the disputed domain name and the name of a person that is not part of the team or is not employed by any form by the Complainant. In this case, the communication provided by the Complainant is an evidence that the Respondent had been using the disputed domain name for fraudulent purposes. According to Section 3.4. of [WIPO Overview 3.0](#), "panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, the respondent may host a copycat version of the complainant's website). Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers".

In this case, the Panel finds that the evidence presented by the Complainant is enough to find the use of the disputed domain name for bad faith.

In summary, this Panel finds that, in the absence of convincing evidence and rebuttal to the contrary from the Respondent, the choice of the disputed domain name and the conduct of the Respondent are indicative of registration and use of the disputed domain name in bad faith.

The Panel therefore finds that disputed domain name has been registered and is being used in bad faith. Therefore, the Panel sustains that the Complainant fulfils the third condition of 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, <merckgroupuk.com>, be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: January 26, 2023