# Panel Decision for dispute CAC-ADREU-004345

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| Case number | CAC-ADREU-004345 |
| Time of filing | 2007-04-05 13:25:57 |
| Domain names | merckgroupe.eu |

## Case administrator

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| Name | Josef Herian |

## Complainant

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| Organization / Name | Merck KGaA, Jonas Koelle |

## Respondent

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| Organization / Name | Ficsor Balazs |

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

N/a

FACTUAL BACKGROUND

The Complainant is a German pharmaceutical company Merck KGaA. On 7 April 2006 the Respondent, Ficsor Balazs, applied for and registered domain name merckgroupe.eu. The Complainant filed the Complaint to the Czech Arbitration Court on 5 April 2007 (Time of Filing).

A. COMPLAINANT

Omitting the preliminary remarks such as company details and the details of the Respondent, the Complainant submitted the following complaint:

“Confusing similarity of domain name and Complainant’s trademark

The test of confusing similarity under Art. 21 (1) of the Regulation is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the domain name is used or other marketing and use factors, usually considered in trademark infringement cases (see for example CAC Case No. 01852 – INFINITY SYSTEM SL, DEL CERRO LINAZA v. Network.de Inh. Daniel Fuehrer, DANIEL FURHRER – airis.eu).

The domain name is confusingly similar to the trademark ‘Merck’.

First of all, the domain name contains the well-known trademark ‘Merck’ and the visitor of the website is likely to put emphasis on the first part of the domain name.

Secondly, the visitor of the website is likely to be confused as to the source, because it is likely that he assumes to receive information about Merck or the Merck Group.

Thirdly, the expression ‘Merck Group’ is being used in the public and especially on the website of Merck. It is a globally operating group of companies. Companies of the Merck Group use the domain names listed in Annex X for their global appearance on the Internet.

It is well established that the top level .eu of a domain name has no affect to the domain name for the purpose of determining whether it is identical or confusingly similar (see CAC Case No. 00227 – Erwin Kunst v. Internetportal and Marketing GmbH – kunst.eu; CAC Case No. 00387 – Global Netwok Communication - Information Technoloy Forschung und Entwicklung GmbH v. HOLLAND AND BARRET

HOLDINGS LIMITED – gnc.eu; CAC Case No. 00596 – Nicolas De Borrekens v. Marcus F.M. Duncker, Joop Elzas – restaurants.eu).

Rights or legitimate interest of the domain holder

The Respondent has no rights or legitimate interest in the name in accordance to Art. 21 (1) (b) of the Regulation (EC) No. 874/2004.

The Complainant has not licensed or otherwise permitted the Respondent to use its trademark Merck and has not permitted the Respondent to apply for or use any domain names incorporating the trademark Merck. The Complainant has never authorized the Respondent to file or use the name 'Merckgroupe'.

There is no indication that the Respondent has used the domain name prior to the notice of an alternative dispute resolution procedure, in connection with the offering of goods or services (Art. 21 (2) (a) of the Regulation (EC) No. 874/2004).

The Respondent is not commonly known by the domain name 'Merckgroupe' in accordance with Art. 21 (2) (b) of the Regulation (EC) No. 874/2004.

The Respondent is not making a legitimate and non-commercial use of the domain name according to Art. 21 (2) (c) of the Regulation (EC) No. 874/2004.

Registration of the domain name in bad faith

Furthermore, the domain name was registered in bad faith according to Art. 21 (1) (b).

Merck is a well-known trademark. At the time of filing the registration, it is obvious that the Respondent knew about the Complainant's rights.

This assumption is strengthened by the fact that the Respondent tried to sell the domain name to the Complainant. In his email dated the 16 January 2007, he stated the following:

"Please click on the merckgroupe.eu. I would like to notice this contract and sell it to you. Please reply this email and I will tell you my priceimagine."

In his second email dated the 23 January 2007, he further states:

"According to the EUrid rules, strictly prohibited to offer for buying or selling the domains. And I will get money not for my "profit", but the notice of the contract with the company needs some reparation payment.

The notice needs apprx. 600 euro."

This behaviour shows that the domain name was primarily registered for the purpose of selling it and leads to the assumption that the domain name was registered in bad faith according to Art. 21 (1) (b) and (3) (a).

. When consumers visit the website, they assume that they will receive information about Merck or the Merck Group. For this reason, there is a misrepresentation as to the source.Furthermore, it is likely that the Respondent tries to take advantage of the well-known trademark Merck

At the moment, the website is filled with information which Merck cannot accept to be associated with.

As a result, the domain name was neither registered nor is it used in good faith. The requirements of acting in bad faith pursuant to Art. 21 (3) (b) (i) of the Regulation (EC) No. 874/2004 are therefore fulfilled.

Remedies requested

In accordance with Art. 21 (1) of the Regulation (EC) No. 874/2004, Art. 11 (b) of the ADR Rules and the above mentioned reasoning, the Complainant requests the Administrative panel to issue a decision that the disputed domain name be transferred to the Complainant."

B. RESPONDENT

The Respondent did not submit a response. However, the Respondent submitted a non-standard communication to the Czech Arbitration Court informing that he would not be renewing the disputed domain name.

DISCUSSION AND FINDINGS

The Complainant satisfies the eligibility criteria of Regulation (EC) No 733/2002, Article 4(2)(b) to be an owner of the .eu top level domain name.

According to Regulation (EC) No 874/2004 of 28 April 2004, Article 22(1) the Complainant must satisfy that the domain name is confusingly similar to a name in respect of which the Complainant has rights under national or EC law, and one the following:

a) the domain name has been registered by its holder without rights or legitimate interest in the name; or
b) the domain name has been registered in bad faith.

1. Preliminary issues

The Complainant has relied on the German company name registration Merck KGaA, German trademark registration no. 694178 MERCK, international trademark registration no. 547719 MERCK and Community trademark registration no. 283986 MERCK. The panel notes that the company name registration extract, German trademark registration certificate, and the international trademark registration certificate are submitted in German and in French. While these would, to the panelist, establish valid rights, they do not comply with Section A(3)(c) of the ADR Rules, which provides that "all documents including communications made as part of the ADR Proceedings shall be made in the language of the ADR Proceeding". The language of the proceedings is English and furthermore the Respondent is not from the same country as the Complainant. In some cases the panelists have accepted material submitted in language other than the language of the proceedings (see for example, Case No. 4371 SIMTEK). Indeed, they have discretion to do so under the terms Section A(3)(c) of the ADR Rules and in some cases it is clearly justified. However, the purpose of the language requirement is to keep both parties in equal footing. It might in many cases be very prejudicial to accept evidence which is not in the language of the proceedings, especially when the language of the material is other than the language of one of the parties to the dispute. If the respondent was a for example German company and the complainant submitted its evidentiary material in Finnish or Lithuanian, it would clearly put the respondent in a difficult position in evaluating whether the claims made by the complainant are valid. Likewise, in the present case the Complainant should not expect that the Respondent is able to understand the evidentiary material, especially when the respondent is not German himself. The Respondent might understand the validity of the claim, but on the other hand, he might not. The position of the Respondent should not be compromised merely because the complainant has not complied with the procedural rules.

In the present case it is not necessary to make a determination regarding the admissibility of the material submitted in another language, because the Community trademark certificate is in English and it therefore establishes that the Complainant has rights for the name MERCK.

2. Confusing similarity

The Complainant has rights for the name MERCK under Community law. The disputed domain name is merckgroupe.eu. The Complainant has correctly pointed out that the top level domain .eu is not taken into account when assessing the similarity of the names. The issue is therefore one of similarity of signs MERCK and MERCKGROUPE.

It is first observed that the trademark of the Complainant has been adopted in its entirety in the disputed domain name. The only difference between the compared signs is the additional element GROUPE in the disputed domain name.

Secondly, the panel has to consider whether adding the word "groupe" renders the signs sufficiently dissimilar so that there is no likelihood of confusion. Particular attention should be given to the fact that the word "groupe" is French for "group". The English meaning of the word, as well as its meaning in several other languages, is apparent. The word "groupe" is one which is often used by many companies for informative purposes. The Complainant has argued that it uses the expression "Merck Group" on its website. This claim was not backed by any evidence, and the investigations carried out by the panel did not find much support for this claim. Nevertheless, it

does not negate the commonly known fact that companies often use the descriptive term “group”. It is therefore conceivable that the Complainant could use the expression “Merck Group” and that the public would use this expression. In this respect the panel also refers to previous case law of the Czech Arbitration Court which has established that adding a non-distinctive suffix to a protected trademark does not remove the similarity of the names. See for example Case No. 4319 AIRFRANCEAIRLINES where the disputed domain name airfranceairlines.eu was held to be confusingly similar to protected trademark AIR FRANCE.

Word “groupe” has no or very little distinctive character which would separate it from mere “Merck”. Therefore, the panel finds that the disputed domain name is confusingly similar to the Community trademark MERCK of the Complainant.

3. Lack of rights or legitimate interest

Pursuant to ADR Rules and Regulation 874/2004, the Complainant has to show that the domain name was registered without rights or legitimate interest, or alternatively, that it was registered in bad faith.

The Complainant has made reasonable allegations in claiming on several grounds that the Respondent does not have rights or legitimate interest in the domain name thereby making a prima facie case to that effect. This is sufficient to shift the burden of proof on the Respondent. The Respondent did not submit a response, and in its non-standard communication to the Czech Arbitration Court the Respondent did not claim to have any rights or legitimate interest in the disputed domain name. The Respondent could have demonstrated its rights or legitimate interest in a number of ways but chose not to do so. Article 21(1) of the Regulation 874/2004 contains a non-exclusive list of considerations that could demonstrate rights or legitimate interest in the name. None of these were invoked by the Respondent and no other arguments were put forward explaining why the Respondent would have rights or a legitimate interest in the disputed domain name.

Therefore, the panel considers that the disputed domain name was registered without rights or legitimate interest.

4. Bad faith

Because the disputed domain name is confusingly similar to the Complainant’s trademark and the Complainant has satisfied the panel that the Respondent did not have rights or legitimate interest in the name, there is no need to consider the issue of bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name MERCKGROUPE be transferred to the Complainant.

## PANELISTS

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| Name | **Erkki Holmila** |

DATE OF PANEL DECISION 2007-07-03

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is a German pharmaceutical company Merck KGaA, the owner of Community trademark no. 283986 MERCK. On 7 April 2006 the Respondent registered domain name merckgroupe.eu. The Complainant commenced proceedings before the Czech Arbitration Court, claiming that the disputed domain name was confusingly similar with its trademark MERCK, that the domain name was registered without rights or legitimate interest and that it had been registered in bad faith. The panelist decided that the disputed domain name merckgroupe.eu was confusingly similar to the Complainant’s trademark. This was especially because the Complainant’s trademark was included in its entirety in the disputed domain name and the only difference was the additional non-distinctive word “groupe” in the disputed domain name. The Respondent failed to submit a Response, and because the Complainant had established a prima facie case that that the Respondent did not have rights or legitimate interest in the disputed domain name, the panel ordered the domain name to be transferred to the Complainant.