

## **ADMINISTRATIVE PANEL DECISION**

**Merck KGaA v. Michael Dats**

**Case No. D2023-1071**

### **1. The Parties**

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

The Respondent is Michael Dats, Nigeria.

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

The disputed domain name <seronopharmaceuticals.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2023. On March 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 11, 2023, 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 (Not known at the moment) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 17, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on March 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on April 17, 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 global pharmaceutical and chemical company. Together with its subsidiaries, it has more than 64,000 employees in more than 200 legal entities in 66 countries around the world.

The Complainant is the owner of the United States of America (“United States”) trademark for the sign SERONO (the “SERONO trademark”) with registration No. 2059423, registered on May 6, 1997, for goods in International Class 5.

The Complainant also uses the domain name <emdserono.com>, wherein the letters “EMD” stand for “Emanuel Merck Darmstadt”, the founder of the Complainant and the city where the Complainant was founded. The name “EMD Serono” is used to distinguish the Complainant’s United States and Canada division and which previously redirected to the Complainant’s official website at “www.emdgroup.com”. The disputed domain name was registered on December 6, 2022. It resolves to an online shop offering for sale pharmaceutical goods and substances. There is no other information about the possible activities of the Respondent on the site.

#### **5. Parties’ Contentions**

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

The Complainant states that the disputed domain name is confusingly similar to its SERONO trademark, because it includes the trademark in its entirety together with the dictionary word “pharmaceuticals”.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by it and has not acquired any relevant trademark rights, and because the Complainant has not authorized the Respondent to use the SERONO trademark and there is no connection between the Parties. The Complainant points out that the website at the disputed domain name represents an online shop selling various pharmaceutical products.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It submits that its SERONO trademark is well known and predates the registration date of the disputed domain name, while the Respondent’s website sells goods included in the scope of protection of the same trademark and the Respondent is using the business name of the Complainant’s United States and Canada division. According to the Complainant, this shows that the Respondent was aware of the Complainant, its domain names, and its SERONO trademark when it registered the disputed domain name, and that it intentionally attempts to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s SERONO trademark.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

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

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

(iii) the disputed domain name was registered and is being used in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ...”

The Respondent however did not submit a Response in this proceeding.

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

The Complainant has provided evidence that it is the registrant of the SERONO trademark and has thus established that it has rights in this trademark for the purposes of the Policy.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence “seronopharmaceuticals”, which incorporates the SERONO trademark and the dictionary word “pharmaceuticals”. The SERONO trademark is easily recognizable in the disputed domain name. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. See section 1.8 of [WIPO Overview 3.0](#).

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the SERONO trademark in which the Complainant has rights.

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

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Respondent is not commonly known by it and has not acquired any relevant trademark rights, and that there is no relationship between the Parties and the Respondent was not given permission to use the SERONO trademark. The Complainant points out that the Respondent uses the disputed domain name for a website offering for sale pharmaceutical goods and substances and intentionally attempts to attract, for commercial gain, Internet users to this website by creating a likelihood of confusion with the Complainant’s SERONO trademark. The Complainant has thus established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not disputed the statements and evidence submitted by the Complainant.

The disputed domain name incorporates the SERONO trademark in combination with the words “pharmaceutical”, which makes it confusingly similar to the trademark and to the pharmaceutical business of the Complainant, both of which predate the registration of the disputed domain name by many years. The Respondent’s website at the disputed domain name indeed offers pharmaceutical goods and substances and contains statements such as “Having begun its journey in 1995, Serono Pharmaceuticals operates in 34 overseas destinations leveraging 14000 happy employees and is now one of the leading Pharma Manufacturing Companies in the UK”, “We are a science-led global healthcare company with a special purpose”, and “We make a wide range of prescription medicines, vaccines and consumer healthcare products”. The Respondent has however not made any statements in the present proceeding and has not submitted any evidence backing them. The Respondent’s website does not contain any disclaimer for a lack of relationship between the Parties.

In view of the above, and in the absence of any evidence to the contrary and of any plausible alternative explanation by the Respondent, it appears to the Panel that it is more likely than not that the Respondent, being aware of the goodwill of the SERONO trademark, has registered and used the disputed domain name in an attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and its SERONO trademark as to the affiliation or endorsement of the Respondent’s website and of the products offered for sale on it. In the Panel’s view, such conduct does not give rise to rights or legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

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

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The Respondent has registered the disputed domain name many years after the registration of the SERONO trademark and after the Complainant started using it for its business. The disputed domain name incorporates the SERONO trademark in combination with the word “pharmaceutical”, and this combination directly refers to the Complainant’s pharmaceutical business carried out under the SERONO trademark, while the associated website offers pharmaceutical goods and substances that fall within the scope of protection of the same trademark and contains no disclaimer for a lack of relationship with the Complainant.

Taking the above into account, the Panel is satisfied that it is more likely than not that the Respondent, being aware of the goodwill of the SERONO trademark, has registered and used the disputed domain name in an attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with

the Complainant and its SERONO trademark as to the affiliation or endorsement of the Respondent's website and of the products offered for sale on it. This leads the Panel to the conclusion that the disputed domain name was registered and is being used in bad faith.

## **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, <seronopharmaceuticals.com>, be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: April 20, 2023