



## MEMORANDUM

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Fadi Chehadé  
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Community Priority Evaluation  
Panel

**LOCATION** ICANN  
ICANN  
ICANN  
Economist Intelligence Unit

**CC** Rashi Rai  
Merck & Co., Inc

**FROM** David Taylor  
**TELEPHONE** +33 1 53 67 47 47

**DATE** 8 April 2016  
By email

**SUBJECT** Comment on Community Priority Evaluation for Application Number 1-980-7217 as Filed by Merck KGaA for .MERCK

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Dear ICANN and the Economist Intelligence Unit

I write to you on behalf of my client, Merck & Co., Inc., Kenilworth, NJ, USA, in order to submit comments on the upcoming Community Priority Evaluation procedure for the Community-based application as filed by Merck KGaA ("Applicant") for the string .MERCK, application number 1-980-7217.

Applicant's Community-based application and claimed "community" status does not fulfil the CPE criteria and does not meet the threshold score of 14 required to be considered as a qualified Community-based application as per the New gTLD Applicant Guidebook (AGB).

In essence, this is because Applicant's "community" is nothing more than Applicant itself – a parent company and its wholly owned subsidiaries. Thus Applicant's proposed "community" is not a community at all – it is merely Applicant's own corporate organization. To classify such a corporate organisation as a "Community" would create a significant and unintended precedent for ICANN and for future new gTLD application rounds.

In the interests of transparency, Merck Registry Holdings Inc., a wholly owned subsidiary of Merck & Co., Inc., Kenilworth, NJ, USA, has also filed a Community-based application for .MERCK.

### 1. INTRODUCTION

As set out in the AGB the Community Priority Evaluation (CPE) procedure is based upon four criteria (*AGB Section 4.2.3*). There are a total of four points available for each criterion, thus a total of 16 points.

To successfully pass CPE an application must score 14 points out of 16. According to the AGB, the scoring process has been devised in order to prevent "false positives", that

is to say, applicants claiming community status to secure a string as a generic Top Level Domain (gTLD) on a priority basis when they are not genuine communities.

The below sets out an assessment of application number 1-980-7217 for .MERCK, as filed by Merck KGaA ("Applicant") under the criteria for CPE set out in the AGB and CPE Guidelines prepared by The Economist Intelligence Unit.

## 2. CRITERION 1 – COMMUNITY ESTABLISHMENT

As set out in the AGB, Section 4.2.3 at 4-10, there are a maximum of four points available under Criterion 1. Criterion 1 is split into sub-criteria, namely Delineation and Extension, each of which is worth two points.

### 2.1 Delineation

In order to score the full two points on the sub-criterion concerning delineation, the applicant must demonstrate that it is a clearly delineated, organized and pre-existing community.

The AGB gives several examples of possible "communities." See, e.g., AGB 4.2.3, at 4-12 ("a community can consist of legal entities (for example, an association of suppliers of a particular service), of individuals (for example, a language community) or of a logical alliance of communities (for example, an international federation of national communities of a similar nature)"). Nowhere does the Guidebook suggest that a single corporate organization, like Applicant, can constitute its own self-serving "community." Indeed, such an outcome would make the notion of a "community" meaningless. At its essence, a "community" contemplates the drawing together of a group of separate, independent entities (whether individuals or organizations) to serve a single common purpose or with a common interest. A parent company that forms wholly owned subsidiaries as a matter of corporate convenience to carry out its affairs has created a corporate organization, not a "community." Applicant has thus failed to demonstrate that it is a "clearly delineated community".

Applicant has defined its "community" as follows:

*"Merck KGaA operates its worldwide business through over 250 companies which (1) are fully owned subsidiaries of Merck KGaA, (2) use Merck as the sole element or as a component of their company name, and (3) use the German figurative trademark No. 30130670, "MERCK", as their umbrella brand. The nexus of these companies, together with the parent company Merck KGaA, constitutes the "Merck Community". (Response to Q18(a)).*

Thus, it is clear from the statements Applicant has made that the delineated "community" it seeks to represent is in fact nothing more than Applicant itself – a parent company and its wholly owned subsidiaries. Indeed, Applicant's proposed "community" is not a community at all – it is merely Applicant's own corporate organization using its trade mark.

It is respectfully submitted that should such corporate structures be viewed as "clearly delineated communities", then the very notion of "community" as set out in the AGB becomes nonsensical, as virtually any company with one or more subsidiaries would be able to qualify as a community under the ICANN new gTLD program.

This is a distortion of what the AGB envisaged for Community-based applications. A statement at Article 1.2.3.2 of the AGB reads as follows:

*"Community-based applications are intended to be a narrow category, for applications where there are unambiguous associations among the applicant, the community served, and the applied-for gTLD string."*

If a corporate entity could be considered a community, then this would create significant and unintended precedent for ICANN and future new gTLD rounds.

Significantly, the International Chamber of Commerce (ICC) found that Applicant was not a Community in three decisions issued by an appointed Expert relating to Community Objections which had been filed by Applicant, case reference numbers EXP/419/ICANN36, EXP/425/ICANN/42 and EXP/428/ICANN/45. See **Annex 1** for copies of these three decisions. Please note that cases EXP/419/ICANN36 and EXP/425/ICANN/42 were consolidated.

In all three decisions, the Expert rejected Applicant's Community Objections on the grounds that Applicant was most decidedly not a clearly delineated community. In decision EXP/419/ICANN/36 (c. EXP/425/ICANN/42), the Expert's wording and reasoning was unequivocal with regard to the inability of Applicant to demonstrate that it was a clearly delineated community.

Indeed, the view of the Expert was that Applicant was representing nothing more than a corporate entity and its wholly owned subsidiaries and that *"On balance, the Expert finds that the so-called Merck Community cannot be considered as a clearly defined community for the purposes of the Guidebook."* (Paragraph 88).

In reaching this carefully considered decision, the Expert examined the structure of Applicants claimed community and found that *"In the Expert's opinion, a community of corporations or of other legal entities may sometimes qualify as a delineated community. However, this is not the case in the [Applicant's] community. The key element in our analysis is that the members of the so-called Merck Community are not associated with Merck KGaA but are rather owned – directly or indirectly – by the latter. Indeed, in order to form a clearly delineated community, the link must be of association and not of ownership, control, management and/or governance."* (Paragraph 77).

Furthermore, the fact that Applicant's claimed community was based upon *"ownership, control, management and/or governance"* led the Expert to reason that *"the alleged members of the so-called Merck Community are not associated with Merck KGaA but rather owned – directly or indirectly – by the latter. Therefore, in the Expert's opinion, the so-called Merck Community is composed of one member only."* (Paragraph 87).

As a result of this, the Expert found that *"Merck KGaA's group of companies is not a clearly delineated community, but rather a group of companies. The boundaries in the so-called Merck Community are of ownership, not membership."* (Paragraph 98).

Turning to the question of activities carried out by Applicant in relation to its proposed "community", the Expert found that *"As any group of companies, the subsidiaries of Merck KGaA's group of companies serve the main purpose of generating profits for the parent company, which in turn may be translated into dividends for the parent company's shareholders. This is achieved through the regular activities or ordinary course of business of the subsidiaries, which mainly benefit the parent company (and not the community as a whole)." (Paragraph 96).*

Consequently, the Expert concluded that *"any institutional purpose of the [Applicant] with the community is outweighed by the purpose of the community of advancing the [Applicant's] economical benefit."* (Paragraph 97).

Thus the Expert concluded that there were no activities carried out for the benefit of any possible community due to the fact that Applicant's "community" was wholly owned by Applicant and exists to generate profits for Applicant and Applicant alone. Such activities cannot be considered community activities.

Notably, the Expert also stated that it was *"reluctant to approve a community composed of subsidiaries of the same parent company. As the Respondent correctly suggests, the Expert must avoid creating a dangerous precedent that may give rise to abusive community objections in the future. Allowing groups of companies to qualify as valid communities under the Guidebook will create every incentive for potential objectors to incorporate subsidiaries in order to build a synthetic community."* (Paragraph 80).

It is important to note the substantial overlap between the ICC Expert's findings on the one hand and the AGB's CPE scoring and the CPE Guidelines on the other hand with respect to the question of delineation of Applicant's "community". At each hurdle, Applicant fails to meet the CPE criteria.

**Is the community clearly delineated?** The CPE definitions in the AGB refer to clear, straightforward membership as a possible measurement of delineation along with an awareness and recognition of the community among its members. The CPE Guidelines provide additional clarity on this point by listing some non-exhaustive elements which show straight forward membership. These are as follows:

*"fees, skill and/or accreditation requirements, privileges or benefits entitled to members certifications aligned with community goals."*

None of these elements is present in Applicant's application or indeed on any of its corporate websites. Indeed, the only requisite to being a member of Applicant's claimed "community" is to be a wholly owned subsidiary of Applicant and the only benefits that are apparent in this relationship are those which flow to Applicant as the parent company of a corporate structure.

The AGB and CPE Guidelines also note that to qualify as a delineated community there should be requisite awareness and recognition of the community among its members.

The only evidence that is available to show any awareness and recognition of Applicant's "community" is a selection of almost identical letters submitted by its wholly owned subsidiaries in support of its Community-based application. It is respectfully submitted that such letters are not sufficient to constitute evidence of awareness and recognition from a clearly delineated community as such letters have been effectively drafted by Applicant itself via its wholly owned subsidiaries and not by any community members.

Indeed, apart from these letters, and prior to the launch of the ICANN New gTLD program, there were no references to the "Merck Community" nor any sense that a "Merck Community" existed in the eyes of either Applicant or its purported "community" members. Clearly, Applicant is attempting to shoehorn its corporate structure into the ICANN definitions of a community in an attempt to gain an unfair advantage in the new gTLD application and evaluation process.

**Is there at least one entity mainly dedicated to the community?** In order to assess this, the CPE Guidelines suggest that the following questions be considered:

i) Was Applicant established to administer the community? Clearly Applicant was not established to administer to the community. Applicant asserts that it *"has been in the pharmaceutical business since 1668, and is the oldest business of its kind in the world."* (Response to Q20(c)). As such, Applicant was established to do trade as a pharmaceutical company, not to be or to administer to a "community".

ii) Does Applicant have a mission statement identifying the community? Applicant's website found at [www.merckgroup.com](http://www.merckgroup.com) is a corporate website that makes no mention of the purported "community" identified by Applicant in its new gTLD application for .MERCCK. There are, however, repeated references to the corporate entity that is Applicant and its performance as a corporate entity using indicators such as profit margins, focus on its various business sectors and growth of the corporate entity. There is no reference to or sense of "community" within Applicant's corporate mission statement. Indeed, its mission statement is nothing more than that of a corporate entity seeking to further its economic goals for its own singular benefit.

**Does the entity have documented evidence of community activities?** Yet again, Applicant cannot demonstrate that it has conducted any community activities simply because there is no evidence of an actual community. All of Applicant's activities have been commercial based ventures for its own economic benefit. This is clearly evidenced from a review of Applicant's website.

**Has the community been active since at least September 2007?** While it appears that Applicant has been active in some form prior to September 2007, it is clear that there is nothing about Applicant's corporate structure that remotely qualifies it to be considered as a pre-existing community for the purposes of ICANN's new gTLD program.

Based on the above, it is clear that for the purposes of this CPE process, Applicant's so-called community fails to meet any of the standards set out regarding a clearly delineated community because it clearly is not a "Community" as conceived by the AGB.

**As such, Applicant should not be awarded any points under this sub-criterion.**

## 2.2 Extension

In order to score the full two points on the sub-criterion concerning extension, Applicant must demonstrate that it is a community of considerable size and longevity.

As set out above, Applicant's so called community only consists of itself and its wholly owned subsidiaries, essentially Applicant's own corporate structure. As such, it fails to meet the criteria for a clearly delineated community, simply because it is not a community. Thus turning to the question of "extension" of the community, it is evident that Applicant should not be able to score any points on this sub-criterion as the application does not relate to a real community.

The AGB gives several examples of possible "communities." Nowhere does the AGB suggest that a single corporate organization, like Applicant, can constitute its own self-serving "community." Indeed, such an outcome would make the notion of a "community" meaningless. A parent company that forms wholly owned subsidiaries as a matter of corporate convenience to carry out its affairs has created a corporate organization, not a "community".

Thus, while Applicant has been in existence since before September 2007 and it is possible that Applicant will continue to exist in some form in the future, it is clear that it is not a genuine community and that the tests relating to the sub-criterion of extension have not been met and that Applicant does not merit a score of one point, let alone two points. The very concept of a corporate structure consisting of a parent company and its wholly owned subsidiaries being considered a "community of considerable size and longevity", creates a significant and unintended precedent for ICANN and future new gTLD rounds.

**As such, Applicant should not be awarded any points under this sub-criterion.**

### 3. CRITERION 2 – NEXUS BETWEEN PROPOSED STRING AND COMMUNITY

As set out in the AGB, Section 4.2.3 at 4-12, there are a maximum of four points available under Criterion 2. Criterion 2 is split into sub-criteria, namely Nexus, worth three points and Uniqueness, worth one point.

#### 3.1 Nexus

In order to score all three available points under this sub-criterion, the applied-for string .MERCK must either match the name of the community or be a well-known short-form or abbreviation of the community name

As set out above, Applicant cannot demonstrate that it is seeking to represent a bona fide community. However, even when setting this fact to one side, Applicant fails to sufficiently meet this sub-criterion to score three points.

The term "match" is defined as meaning "corresponds to" or is "equal to" on page 7 of the CPE Guidelines. However, it is submitted that the string MERCK can in no way be construed as corresponding or being equal to Applicant. This is because of the existence of Merck & Co., Inc., Kenilworth, N.J., USA, one of the largest healthcare companies in the world, with more than \$39.5 billion in annual revenue and more than 68,000 employees around the world as of December 2015 (see Merck & Co., Inc.'s company information and rankings, attached hereto as **Annex 2**). For well over a century Merck & Co., Inc. has operated under the MERCK name and trademark in the United States and Canada, and under a family of MERCK-composite trademarks internationally (specifically MERCK SHARP & DOHME). During this time, Merck & Co., Inc. has established a family of MERCK and MERCK-composite trademarks registered in various countries throughout the world, a summary chart of which is attached hereto as **Annex 3**. Merck & Co., Inc. has the right to identify itself throughout the world under the Merck & Co., Inc., Kenilworth, NJ, USA firm name and under the MERCK SHARP & DOHME trademark and firm name.

Indeed, Merck & Co. Inc. has prevailed at several uniform domain name dispute resolution policy (UDRP) proceedings where panels have recognized the strength and renown of Merck & Co., Inc.'s family of MERCK and MERCK-composite trademarks. For example:

**WIPO Case No. D2011-0141** *"Complainant's brand, Merck, is well-known, and indeed world famous, for its activities in the field of pharmaceuticals."*

*"Complainant has been operating under the MERCK name for over 120 years; it is an internationally known brand"*

**WIPO Case No. D2011-0278** *"The Panel accepts the evidence adduced by the Complainant that MERCK is a well-known and famous mark that the Complainant owns"*

**WIPO Case No. D2011-1898** *"The MERCK Marks [MERCK SHARP & DOHME] have been registered worldwide including China and it has a widespread reputation in pharmaceutical industry worldwide."*

**WIPO Case No. D2011-2047** *"...the MERCK mark is widely known as identifying Complainant's business and products"*

Copies of these decisions are attached at **Annex 4**.

It is clear that Merck & Co., Inc., Kenilworth, NJ, USA have a significant global reputation in the term MERCK due to its family of MERCK (in the US and Canada) and MERCK-composite trademarks. Merck & Co., Inc has the right to identify itself throughout the world as 'Merck Sharp & Dohme', so the name 'Merck' is nowhere that of the Applicant alone.

As such, it follows that the term MERCK has a substantial meaning outside of Applicant's so-called "community".

Thus, it is clear that Applicant cannot score the full three points on this sub-criterion.

The AGB states that Applicant could score two points if the *"String identifies the community"*. The term "identify" is defined in the AGB, Section 4.2.3 at 4-13, as meaning *"that the applied for string closely describes the community or the community members, without over-reaching substantially beyond the community."* Page 7 of the CPE Guidelines defines "over-reaching substantially" to mean *"that the string indicates a wider geographical or thematic remit than the community has."*

Taking this into account, it would appear to be problematic for Applicant to score even two points as the string MERCK has a significantly wider thematic remit than Applicant's own corporate structure due to the existence and ubiquitous presence of Merck & Co., Inc., Kenilworth, NJ, USA and its established family of MERCK (in the US and Canada) and MERCK-composite trademarks registered in various countries throughout the world.

Examining this further in terms of the question of the name of the community, the AGB, Section 4.2.3 at 4-13 contains the following definition: *"Name" of the community means the established name by which the community is commonly known by others."*

The CPE Guidelines provide additional clarity on Page 7 by stating that "Others" refers to *"to individuals outside of the community itself, as well as the most knowledgeable individuals in the wider geographic and language environment of direct relevance."*

As set out above, in the global market for pharmaceutical goods and services it would be untrue to say that knowledgeable individuals associate MERCK only with Applicant, and not with Merck & Co., Inc., Kenilworth, NJ, USA. Indeed, Merck & Co., Inc. submits that consumer recognition of the string MERCK name flows from itself, and not from Applicant's corporate organization. To say otherwise would clearly be a substantial over-reach on the part of Applicant.

Furthermore, this nexus issue is a central part of litigations between Applicant and Merck & Co., Inc. in a number of countries regarding rights to the MERCK name. There is a long history of agreements between the parties allowing both to use the name MERCK.

**As such, even putting to one side the fact that Applicant has failed to demonstrate that it is a community, the Applicant should not score any points under this sub-criterion.**

### 3.2 Uniqueness

Turning to the sub-criterion for uniqueness, in order to score the one available point under this sub-criterion, Applicant must demonstrate that the string MERCK has no other significant meaning beyond identifying the community described in the application.

It is clear that the string MERCK has significant meaning across the globe, but this meaning is not solely the preserve of Applicant. As demonstrated above, the string MERCK also means Merck & Co., Inc., Kenilworth, NJ, USA.

As set out above in point 3.1, the term "identify" is defined in the AGB, Section 4.2.3 at 4-13 as meaning "*that the applied for string closely describes the community or the community members, without over-reaching substantially beyond the community.*" Page 7 of the CPE Guidelines defines "over-reaching substantially" to mean "*that the string indicates a wider geographical or thematic remit than the community has.*"

For all the foregoing reasons, Applicant cannot claim that the string MERCK has no significant meaning beyond its own corporate structure and this is a clear case of a string over-reaching substantially beyond its thematic remit.

**Thus, even putting to one side the fact that Applicant has failed to demonstrate that it is a community, the application should not score any points under this sub-criterion as the applied-for string MERCK has a significant meaning beyond Applicant's corporate structure in that it identifies both Merck & Co., Inc. and Applicant.**

## 4. CRITERION 3 – REGISTRATION POLICIES

As set out in the AGB, Section 4.2.3 at 4-14, there are a maximum of four points available under Criterion 3. Criterion 3 is split into four sub-criteria each of which is worth one point. The sub-criteria are Eligibility, Name Selection, Content and Use, and Enforcement and each focuses on the Applicant's registration policies governing these four areas.

### 4.1 Eligibility

To score the one available point on this sub-criterion, Applicant must show that domain name registrations will be restricted to community members. While Applicant does describe a policy with regard to eligibility requirements in response to Question 20(e) in its application, this policy merely restricts domain name registrations under the .MERCK TLD solely to members of its own corporate structure, which consists of a parent company and its wholly owned subsidiaries. As has been demonstrated above at section 2.1 and 2.2, Applicant's corporate structure does not meet the standards set out in the AGB to be considered a community for the purposes of ICANN's new gTLD program.

As a result, Applicant's eligibility requirements are not centred on those of a community, but are more akin to those of a brand owner who intends to operate a gTLD Registry on a closed basis for its own internal purposes. Thus, Applicant's eligibility requirements are not restricted to any community members simply because no community exists.

**Therefore, Applicant does not meet the standard set out in this sub-criterion and should not score the one available point.**



#### 4.2 Name Selection

To qualify for the one point on this sub-criterion, Applicant must include policies which include name selection rules consistent with the articulated community based purpose of the applied for gTLD. A reading of Applicant's name selection policies shows that there appear to be no specific policies governing domain name registrations aside from the following general statement: *"Second-Level Domain names within the ".MERCK" TLD must only include hyphens in the third and fourth position if they represent valid internationalized domain names in their ASCII encoding (for example "xn--ndk061n"), and must otherwise comply with any other applicable ICANN requirements."*

This does not appear to be sufficient to meet the requirements to score the one available point under this sub-criterion. Indeed, Applicant's general statement is a technical requirement for all second level domain name registrations in all gTLDs and is not a policy covering name selection rules relating to the alleged community-based purpose of the .MERCK gTLD.

Applicant does make a reference in its response to Q28 regarding allocation of second level domain names, wherein it is stated: *"Domain names will be generally allocated on a "first come, first served" basis, subject to Merck KGaA's Corporate Trademark Department's prior approval that the domain name:*

- furthers the mission and purpose of the Merck Community;
- does not infringe any other third parties rights; and
- complies with any applicable laws, government rules or requirements"

However, this statement only goes to demonstrate yet again, that Applicant is a corporate entity, monitoring the domain name registrations of its subsidiaries under its closed, brand centred gTLD.

**Therefore, Applicant does not meet the standard set out in this sub-criterion and should not score the one available point.**

#### 4.3 Content and Use

A score of one point is available for this sub-criterion. In order to score this Applicant's policies must include rules for content and use consistent with the articulated community based purpose of the applied for gTLD.

Applicant has outlined a policy relating to the content and use of domain names registered under the .MERCK gTLD, namely its Acceptable Use Guidelines. However, this policy relates to content and use of domain name registrations under the .MERCK TLD in relation to furthering the purpose of its own corporate structure, which consists of a parent company and its wholly owned subsidiaries. As has been demonstrated above at section 2.1 and 2.2, Applicant's corporate structure does not meet the standards set out in the AGB to be considered a community for the purposes of ICANN's new gTLD program. Thus, the content and use policy is designed for the economic benefit of Applicant and not for any community-based purpose.

As such, the content and use policy is not consistent with that of a community, but is more akin to that of a brand owner which intends to operate a gTLD Registry on a closed basis for its own internal purposes. Again, Applicant's content and use policy is not

related to serving a community or community members simply because no community exists.

**Therefore, Applicant does not meet the standard set out in this sub-criterion and should not score the one available point.**

#### 4.4 Enforcement

To achieve the maximum score of one point for this sub-criterion, Applicant's policies must include specific enforcement measures (e.g. investigation practices, penalties, takedown procedures) constituting a coherent set with appropriate appeal mechanisms.

Applicant has described a policy whereby it or an assigned third party would monitor and verify the registrants of domain names under the .MERCK gTLD and take action against domain names that violate Applicant's registration policies. In addition, Applicant's policy appears to contain a mechanism should the registrant of a domain name wish to appeal Applicant's decision to revoke that registrant's domain name registration.

However, as set out in 4.1 – 4.3 above, these policies are not put in place for the benefit of a genuine community, but rather they are in place for the furtherance of Applicant's corporate structure and its own economic benefit. As such, while Applicant proposes to "police" the .MERCK TLD, this is not being done for any community-based purpose.

**As such, Applicant does not meet the standard set out in this sub-criterion and should not score the one available point.**

### 5. CRITERION 4 – COMMUNITY ENDORSEMENT

As set out in the AGB, Section 4.2.3 at 4-17, there are a maximum of four points available under Criterion 4. Criterion 4 is split into two sub-criteria, namely Support and Opposition, each of which is worth two points.

#### 5.1 Support

In order to qualify for the full two points under the Support sub-criterion, Applicant must demonstrate that *"Applicant is, or has documented support from, the recognized community institution(s)/ member organization(s) or has otherwise documented authority to represent the community."* (AGB Section 4.2.3 at 4-17).

The only "documented support" Applicant has presented with regard to its claim that it has the support of a community has been a selection of almost identical letters submitted by its wholly owned subsidiaries. It is respectfully submitted that such letters are not sufficient evidence of support from a clearly delineated community as such letters have been effectively drafted by Applicant itself via its wholly owned subsidiaries and not by any other community members. Indeed, the fact that Applicant's letters of support come entirely from within its own corporate structure clearly reinforces that there is no community that Applicant purports to represent beyond the components of Applicant's corporation.

Therefore, any evaluation of Applicant's letters of support must be conducted in the context that Applicant's so-called community merely reflects a corporate structure whereby Applicant is the parent entity and its "community" consists of nothing more than its wholly owned subsidiaries. As such, the letters of support are lacking in relevance and validity for the purposes of the CPE process.

**Thus, Applicant should not be awarded any points under this sub-criterion on the basis that there is no genuine community nor any support from a community for this application.**

## 5.2 Opposition

In order to qualify for the two available points for this sub-criterion, there must be no opposition of relevance to the application.

However, this is clearly not the case with regard to Applicant's so-called community and the string .MERCK. Merck & Co., Inc., Kenilworth, NJ, USA, has filed both Legal Rights Objections and Community Objections (as per Module 3 of the AGB)<sup>1</sup> against Applicant's application for the string .MERCK. Copies of these are attached at **Annex 5**. Thus, it is clear that Applicant has been subjected to vigorous opposition from Merck & Co., Inc., and that Applicant's claimed "community" is of serious concern to Merck & Co., Inc., and its own Merck Community which is composed of a richly diverse group of entities that includes not only Merck & Co., Inc.'s core businesses, but wide ranging philanthropic endeavours, charitable foundations and leading medical and scientific publications.

Letters of opposition to Applicant's so-called community have also been lodged with ICANN by Helen Keller International and by The Task Force for Global Health.

Helen Keller International, which was founded in 1915, operates 120 programs in 22 countries and is dedicated to saving the sight and lives of the most vulnerable and disadvantaged.

Helen Keller International voice their concerns at Applicant's proposal to operate the .MERCK gTLD for its own internal corporate use and the detrimental impact this would have on the Merck Community established by Merck & Co., Inc. and the network of communities, initiatives and educational programs that it supports.

The Task Force for Global Health is a US based non-profit 501 (c) (3) organization and has been in operation for three decades. In terms of private donation support it is the fourth largest non-profit organisation in the US. The Task Force for Global Health works to improve the health and well-being of people in all parts of the world, but especially those most in need and those who have few to advocate for them.

The Task Force for Global Health believe that the .MERCK gTLD should be operated on behalf of the Merck Community established by Merck & Co., Inc., Kenilworth, NJ, USA in order to provide trusted content related to the Merck Community in order to further its philanthropic work and the many programs and people it supports. As such they are opposed to Applicant's proposal to operate the .MERCK gTLD as outlined in its application.

Copies of these letters are at **Annex 6**.

**Thus there is relevant opposition from two or more groups of non-negligible size and as a result of this Applicant should not be awarded any points for this sub-criterion.**

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<sup>1</sup> Please note that these Objections were ultimately rejected.

6. **CONCLUSION**

As previously stated, CPE procedure is based upon four criteria (AGB Section 4.2.3). There are a total of four points available for each criterion, thus a total of 16 points.

In order to successfully pass CPE, an application must score 14 points out of 16. According to the AGB, the scoring process has been devised in order to prevent "false positives", that is to say, applicants claiming community status in order to secure a string as a generic Top Level Domain (gTLD) when they are not genuine communities.

It is clear that Applicant cannot meet the threshold of 14 points out of 16, simply because Applicant's "community" is nothing more than Applicant itself – a parent company and its wholly owned subsidiaries. Thus Applicant's proposed "community" is not a community at all – it is merely Applicant's own corporate organization.

Kind regards

David Taylor

### List of Annexes

- Annex 1** Copies of the decisions EXP/419/ICANN36, EXP/425/ICANN/42 and EXP/428/ICANN/45.
- Annex 2** Merck & Co., Inc.'s company information and rankings.
- Annex 3** Summary chart of Merck & Co, Inc.'s trademarks.
- Annex 4** Copies of WIPO decisions.
- Annex 5** Copies of Legal Rights Objections filed by Merck & Co, Inc. against Applicant's .MERCK application.
- Annex 6** Letter of Opposition against Applicant's "community" by Helen Keller International to ICANN. Letter of Opposition against Applicant's "community" by The Task Force for Global Health.

# **ANNEX 1**

**THE INTERNATIONAL CENTRE FOR EXPERTISE OF THE  
INTERNATIONAL CHAMBER OF COMMERCE**

CASE No. EXP/419/ICANN/36 (c. EXP/425/ICANN/42)

MERCK KGAA

(GERMANY)

vs/

MERCK REGISTRY HOLDINGS, INC.

(USA)

and

MERCK KGAA

(GERMANY)

vs/

MERCK REGISTRY HOLDINGS, INC.

(USA)

This document is an original of the Expert Determination rendered in conformity with the New gTLD Dispute Resolution Procedure as provided in Module 3 of the gTLD Applicant Guidebook from ICANN and the ICC Rules for Expertise.

**INTERNATIONAL CENTRE FOR EXPERTISE  
OF THE  
INTERNATIONAL CHAMBER OF COMMERCE**

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CASE No. EXP/419/ICANN/36 (c. EXP/425/ICANN/42)

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**MERCK KGAA  
(GERMANY)**

*OBJECTOR*

v.

**MERCK REGISTRY HOLDINGS, INC.  
(UNITED STATES OF AMERICA)**

*RESPONDENT*

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**EXPERT DETERMINATION BY  
BERNARDO M. CREMADES  
NOVEMBER 19, 2013**

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## LIST OF ABBREVIATIONS

Term	Meaning
<b>1970/1975 Agreements</b>	Means the Agreements entered into between MSD and the Objector in 1970 and 1975, respectively (submitted as Annex 13 to the Objections, Annex F to the Response 419 and Annex D to the Response 425)
<b>Appendix III</b>	Means Appendix III to the Rules for Expertise of the International Chamber of Commerce, Schedule of expertise costs for proceedings under the new gTLD dispute resolution procedure
<b>Applicant</b>	Means Merck Registry Holdings, Inc.
<b>ccTLD</b>	Means country code top level domain
<b>Centre</b>	Means the International Centre for Expertise of the International Chamber of Commerce
<b>Expert</b>	Means Bernardo M. Cremades
<b>Expert Determination</b>	Means this expert determination rendered on November 19, 2013
<b>gTLD</b>	Means generic top level domain
<b>Guidebook</b>	Means the gTLD Applicant Guidebook
<b>ICC</b>	Means International Chamber of Commerce
<b>ICC Practice Note</b>	Means the ICC Practice Note on the Administration of Cases under the New gTLD Dispute Resolution Procedure
<b>ICANN</b>	Means Internet Corporation for Assigned Names & Numbers
<b>MSD</b>	Means Merck, Sharp & Dohme, Corp.
<b>Objection 419</b>	Means the community objection filed by the Objector against Respondent's Application No. 1-1704-73085 for the String on March 13, 2013
<b>Objection 425</b>	Means the community objection filed by the Objector against Respondent's Application No. 1-1704-28003 for the String on March 13, 2013
<b>Objections</b>	Means Objection 419 and Objection 425 collectively
<b>Objector</b>	Means Merck KGaA
<b>Parties</b>	Means collectively Merck KGaA and Merck Registry Holdings, Inc.
<b>Party</b>	Means individually Merck KGaA or Merck Registry Holdings, Inc.
<b>Procedure</b>	Means the Attachment to Module 3 of the gTLD Applicant Guidebook, New gTLD Dispute Resolution Procedure
<b>Rejoinder</b>	Means the rejoinder to the Reply filed by the Respondent on August 12, 2013
<b>Reply</b>	Means the reply to both Responses filed by the Objector on August 2, 2013

<b>Respondent</b>	Means Merck Registry Holdings, Inc.
<b>Response 419</b>	Means the response to the Objection 419 filed by the Respondent on May 23, 2013
<b>Response 425</b>	Means the response to the Objection 425 filed by the Respondent on May 23, 2013
<b>Responses</b>	Means Response 419 and Response 425 collectively
<b>Rules</b>	Means the Rules for Expertise of the International Chamber of Commerce
<b>String</b>	Means the applied-for gTLD “.MERCK” by the Applicant (Applications No. 1-1704-73085 and No. 1-1704-28003)

1. This expert determination (the “**Expert Determination**”) is issued under the Rules for Expertise of the International Chamber of Commerce (the “**Rules**”), supplemented by the ICC Practice Note on the Administration of Cases (the “**ICC Practice Note**”), and under the Attachment to Module 3 of the gTLD Applicant Guidebook, New gTLD Dispute Resolution Procedure (the “**Procedure**”) of the gTLD Applicant Guidebook (the “**Guidebook**”).

## **I. THE PARTIES AND THE EXPERT**

### **A. Objector**

2. The Objector is:

Name	Merck KGaA
Contact person	Mr. Jonas Koelle
Address	Frankfurter Straße 250
City, Country	64293 Darmstadt, Germany
Telephone	(+49) 615 172 5303
Email	<a href="mailto:jonas.koelle@merckgroup.com">jonas.koelle@merckgroup.com</a>

3. The Objector is represented herein by:

Name	Bettinger Schneider Schramm
Contact person	Dr. Torsten Bettinger
Address	Cuvilliesstr. 14 a
City, Country	81679 Munich, Germany
Telephone	(+49) 89 599 080-0
Email	<a href="mailto:info@bettinger.de">info@bettinger.de</a>

4. The Objector has appointed its legal representative to receive all communications and notifications in the present proceeding.

**B. Respondent**

5. The Respondent (also referred to as the Applicant) is:

Name	Merck Registry Holdings, Inc.
Contact person	Ms. Rashi Rai
Address	One Merck Drive
City, Country	Whitehouse Station, NJ 08889, U.S.
Telephone	(+1) 908 423 1000
Email	<a href="mailto:Rashi_rai@merck.com">Rashi_rai@merck.com</a>

6. The Respondent is represented herein by:

Name	Hogan Lovells (Paris) LLP
Contact person	Mr. David Taylor
Address	17, Avenue Matignon
City, Country	75008 Paris, France
Telephone	(+33) 1 53 67 47 47
Email	<a href="mailto:domaindisputes@hoganlovells.com">domaindisputes@hoganlovells.com</a>

Name	FairWinds Partners, LLC
Contact person	Mr. Joshua Bourne
Address	1000 Potomac Street NW
City, Country	Washington, DC 20007, U.S.
Telephone	(+1) 202 223 9252
Email	<a href="mailto:bourne.ms@fairwindspartners.com">bourne.ms@fairwindspartners.com</a>

7. The Respondent has appointed Mr. David Taylor of Hogan Lovells (Paris) LLP to receive all communications and notifications in the present proceeding.

### C. Expert

8. The Expert is:

Name	Mr. Bernardo M. Cremades
Firm	B. Cremades & Asociados
Address	Calle Goya 18 – Planta 2
City, Country	Madrid, Spain
Telephone	(+34) 914 237 200
Email	<a href="mailto:bcremades@bcremades.com">bcremades@bcremades.com</a>

### II. APPLIED-FOR GTLD

9. The applied-for generic top level domain (“**gTLD**”) is “.MERCK” (Applications Nos. 1-1704-73085 and 1-1704-28003) (the “**String**”).

### III. PROCEDURAL MATTERS

10. On March 13, 2013, the Objector filed a community objection against the Respondent’s Application No. 1-1704-73085 for the String in accordance with Article 3.2.1 of the Guidebook and Article 2 of the Procedure (the “**Objection 419**”).<sup>1</sup> On the same day, the Objector filed a community objection against the Respondent’s Application No. 1-1704-28003 for the String in accordance with Article 3.2.1 of the Guidebook and Article 2 of the Procedure (the “**Objection 425**”).<sup>2</sup> The Objection 419 and the Objection 425 shall hereinafter be jointly referred to as the “**Objections**”.

11. According to Article 3.2.1 of the Guidebook, a community objection is filed when “[t]here is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted”.

12. On April 12, 2013, the International Centre for Expertise of the International Chamber of Commerce (the “**Centre**”) invited the Parties to comment on the possibility of consolidating proceeding EXP/419/ICANN/36 with EXP/425/ICANN/42.<sup>3</sup> The Respondent

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<sup>1</sup> Proceeding originally captioned EXP/419/ICANN/36.

<sup>2</sup> Proceeding originally captioned EXP/425/ICANN/42.

<sup>3</sup> Letter from the Centre to the Parties, dated April 12, 2013.

filed its comments on April 15, 2013.<sup>4</sup> On April 18, 2013, the Centre informed the Parties about the consequences of the possible consolidation and requested further comments from them.<sup>5</sup> Both Parties submitted further comments in this regard.<sup>6</sup> On April 23, 2013, the Centre informed the Parties of its decision to consolidate both proceedings under the caption “EXP/419/ICANN/36 (c. EXP/425/ICANN/42)”.<sup>7</sup>

13. On May 23, 2013, the Respondent filed separate responses disputing Objector’s standing and alleging that the Objector failed to meet the community objection requirements of the Guidebook as regards the Objections filed in EXP/419/ICANN/36 (the “**Response 419**”) and EXP/425/ICANN/42 (the “**Response 425**”). The Response 419 and the Response 425 shall hereinafter be jointly referred to as the “**Responses**”.

14. On June 12, 2013, the Chair of the Standing Committee of the Centre appointed Mr. Bernardo M. Cremades as Expert in accordance with Article 7 and Article 3(3) Appendix I of the Rules.

15. On June 19, 2013, the Objector contacted the Centre to request a second round of submissions.<sup>8</sup> Two days later, the Centre suggested that the Objector address the request directly to the Expert Panel once constituted.<sup>9</sup> On June 25, 2013, the Objector directed the same request directly to the Expert.<sup>10</sup>

16. On July 16, 2013, the Centre transferred the file to the Expert and confirmed in writing that: (i) the estimated costs had been paid in full by each Party; and (ii) the full constitution of the Expert Panel had taken effect as of that same day.<sup>11</sup>

17. On July 17, 2013, the Expert issued Procedural Order No.1 directing both Parties to submit their views on certain procedural matters. The Parties replied on July 22,

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<sup>4</sup> Email from Mr. Joshua Bourne to the Centre, dated April 15, 2013.

<sup>5</sup> Letter from the Centre to the Parties, dated April 18, 2013.

<sup>6</sup> Letter from Dr. Torsten Bettinger to the Centre, dated April 19, 2013; Email from Mr. Joshua Bourne to the Centre, dated April 20, 2013.

<sup>7</sup> Email from the Centre to the Parties, dated April 23, 2013

<sup>8</sup> Email from Dr. Torsten Bettinger to the Centre, dated June 19, 2013.

<sup>9</sup> Email from the Centre to Dr. Torsten Bettinger, dated June 21, 2013.

<sup>10</sup> Email from Dr. Torsten Bettinger to the Expert, dated June 25, 2013.

<sup>11</sup> Letter from the Centre to the Parties and Expert, dated July 16, 2013.

2013. On July 23, 2013, the Expert issued Procedural Order No. 2 directing the Parties to submit additional evidence and allegations on very limited matters (Articles 17(a) and 18 *in fine* of the Procedure). The Expert also found that no hearing was necessary in this proceeding (Article 19 of the Procedure) and that the Expert Determination should be published in full (Article 21(g) of the Procedure).

18. On August 2, 2013, the Objector filed a single second memorial, together with additional evidence, for both proceedings (the “**Reply**”). On August 12, 2013, the Respondent filed a single second memorial, together with additional evidence, for both proceedings (the “**Rejoinder**”).<sup>12</sup>

19. After a careful review of the Objections, Responses, Reply and Rejoinder, and in agreement with the Centre, the Expert considers it more appropriate to render a single Expert Determination for both proceedings.<sup>13</sup>

20. In accordance with Articles 5(a) and 6(a) of the Procedure, as well as Articles 3.3.1 and 3.3.3 of the Guidebook, all of the Parties’ communications were submitted electronically in English, which is the official language of this proceeding.

21. For all purposes, the place of the proceedings is Paris (France), where the Centre is located (Article 4(d) of the Procedure).

#### **IV. BACKGROUND**

22. Both Parties generally agree on the background of this dispute. The Respondent’s parent company, Merck Sharp & Dohme, Corp. (“**MSD**”), was a subsidiary of the Objector at the beginning of the 20<sup>th</sup> century.<sup>14</sup> After World War I, MSD spun off the Objector pursuant to the U.S. Trading with the Enemy Act of 1917.<sup>15</sup> Since then, MSD has operated as a separate and independent company.

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<sup>12</sup> Due to maintenance works in the Expert’s email server, the Respondent’s email did not reach the Expert. With the permission of the Expert, the Respondent re-submitted these materials by fax on August 13, 2013. See Article 6(a) of the Procedure.

<sup>13</sup> The Centre has granted the Expert discretion to decide whether to render one or two separate Expert Determinations. Letter from the Centre to the Parties, dated April 23, 2013, p. 2 (“The Panel will examine each Objection on its own merits and shall have the discretion to decide whether, based on the specificities of each case, to issue one or separate Expert Determinations in consolidated cases”).

<sup>14</sup> Objections, p. 7; Responses, p. 5.

<sup>15</sup> Objections, p. 7; Responses, p. 5. See *a/so* Response 419, p. 9.



23. MSD and the Objector have executed a series of agreements throughout the years to regulate their co-existence and the use of the “MERCK” name, as well as the corresponding trademark.<sup>16</sup> The most recent agreements date back to 1970 and 1975 (the the “**1970/1975 Agreements**”).<sup>17</sup>

24. Pursuant to the 1970/1975 Agreements, MSD has operated in the U.S. and Canada under the name “MERCK” and under a family of Merck-composite trademarks internationally (e.g., Merck Sharp & Dohme). The Objector, on the other hand, has operated under the name Merck (without qualifying or additional text) internationally but cannot use the name “MERCK” within the U.S. and Canada.<sup>18</sup>

25. MSD and the Objector are in dispute over the use of the Merck name and trademark, including the use of <merck.com> and the use of the Merck name in social media.<sup>19</sup> For this reason, in March 2013, the Objector filed a legal action in the District Court of Hamburg, Germany, against *inter alia* MSD and Merck & Co., Inc. (which is MSD’s parent company).<sup>20</sup> The Respondent also mentions that the Objector commenced legal proceedings in the UK on March 8, 2013 claiming trademark infringement and alleging breach of the 1970/1975 Agreements.<sup>21</sup> The Objector anticipates “additional legal measures in other jurisdictions”.<sup>22</sup>

26. The Objector has also filed a number of Legal Rights Objections under Article 2(3)(ii) of the Procedure with WIPO’s Arbitration and Mediation Center against companies of MSD’s group of companies, including regarding the String.<sup>23</sup>

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<sup>16</sup> Objections, pp. 7-8; Response 419, pp. 5, 8; Response 425, pp. 5, 7.

<sup>17</sup> A copy of the 1970/1975 Agreements has been submitted as Annex 13 to the Objections, Annex F to the Response 419 and Annex D to the Response 425.

<sup>18</sup> Objections, p. 8; Response 419, pp. 5, 8; Response 425, pp. 5, 7. See also Response 419, p. 9.

<sup>19</sup> Objections, p. 8; Responses, p. 4.

<sup>20</sup> Objections, p. 8; Responses, p. 4. A copy of the Request for Relief in the District Court of Hamburg, Germany, has been provided as Annex 15 to the Objections.

<sup>21</sup> Responses, p. 4.

<sup>22</sup> Objections, p. 8.

<sup>23</sup> *Id.* See [www.wipo.int/amc/en/domains/lro/cases/](http://www.wipo.int/amc/en/domains/lro/cases/).

## V. OBJECTOR'S STANDING

27. In this section, the Expert will summarize the Parties' positions relating to the Objector's standing to file the Objections. Thereafter, the Expert will draw his conclusions in this regard.

### A. Standards

28. Article 3.2.2.4 of the Guidebook provides guidance on who may file a community objection as follows:

Established institutions associated with clearly delineated communities are eligible to file a community objection. The community named by the objector must be a community strongly associated with the applied-for gTLD string in the application that is the subject of the objection. [. . .]<sup>24</sup>

29. The Guidebook provides some explanation regarding the main requirements set forth in the quoted passage. In this regard, the Guidebook states that, “[t]o qualify for standing for a community objection, the objector must prove both of the following”, which makes abundantly clear that the two requirements that follow must be met.<sup>25</sup> These two requirements are: (i) the objector must be an “established institution”; and (ii) the objector must have “an ongoing relationship with a clearly delineated community”.<sup>26</sup> Both Parties agree with this two-pronged test.<sup>27</sup> Each portion of this test will be analyzed in the following subsections of this Expert Determination.

30. For each requirement, the Guidebook lists some “factors” to steer the Expert’s judgment. As a threshold matter, the Expert will analyze the value of the “factors” outlined in Article 3.2.2.4 of the Guidebook. The Guidebook states that the “[f]actors that may be considered [by the Expert] in making this determination include, but are not limited to. [. . .]” The use of the optional term “may” instead of any other mandatory term clearly implies that the Expert has absolute discretion to apply or not the factors expressly included in the Guidebook. In addition, the final portion of the quoted passage – “but are not limited to” –

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<sup>24</sup> Guidebook, Article 3.2.2.4 (emphasis added).

<sup>25</sup> *Id.* (emphasis added).

<sup>26</sup> *Id.*

<sup>27</sup> Objections, p. 4; Response 419, p. 6; Response 425, p. 5.

opens the door to other factors not expressly listed in the Guidebook. This conclusion is also supported by the last paragraph of Article 3.2.2.4 of the Guidebook, which states that the Expert “will perform a balancing of the factors listed above, as well as other relevant information, in making its determination”.<sup>28</sup> The reference to “other relevant information” eliminates any doubt as to the orientative nature of the factors contained in the Guidebook.

31. All the above is consistent with the last phrase of Article 3.2.2.4 of the Guidebook, which provides that “[i]t is not expected that an objector must demonstrate satisfaction of each and every factor considered in order to satisfy the standing requirements”.

## **B. Is the Objector an Established Institution?**

### **(a) Objector’s Position**

32. The Objector explains that Merck KGaA “is the parent company and head institution of the international Merck Community, which is made up of the many regional offices, subsidiaries and institutions which work together to provide state-of-the-art pharmaceuticals, research instruments, chemical solutions and life sciences equipment to clients and patients around the world”.<sup>29</sup> The Objector adds that, since its incorporation in 1668, it has become “a multinational organization with stakeholders in more than 180 countries, 2011 revenues of EUR 10.27 billion, and over 40,000 employees”.<sup>30</sup> The current version of the Objector’s Articles of Association is dated July 6, 1995, when the Objector spun-off another corporation.<sup>31</sup> The Objector also highlights that it has used the name “Merck” for centuries.<sup>32</sup>

### **(b) Respondent’s Position**

33. The Respondent does not dispute that the Objector is an established institution.<sup>33</sup>

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<sup>28</sup> Emphasis added.

<sup>29</sup> Objections, p. 4.

<sup>30</sup> *Id.* See also Reply, p. 3 (*in fine*). For a history of the Objector, see Annex 8 to the Objections.

<sup>31</sup> Annex 4 to the Objections, Commercial Register Excerpt, p. 4.

<sup>32</sup> Objections, pp. 4-5. See also Annex 3 to the Objections.

<sup>33</sup> Response 419, p. 6; Response 425, pp. 5-6.

### **(c) Expert's Conclusion**

34. The Parties do not dispute that the Objector is an established institution. However, this does not prevent the Expert from analyzing the issue.

35. From the corporate documents submitted by the Objector, the Expert is satisfied that the relevant factors included in Article 3.2.2.4 of the Guidebook are met. As a multinational company, the Objector enjoys a worldwide reputation. Thus, the “[l]evel of global recognition of the institution” factor is satisfied. Second, as to the “length of time the institution has been in existence”, the Expert is convinced that it has been in existence for more than a sufficient period and that it was not “established solely in conjunction with the gTLD application process”.<sup>34</sup> In this regard, the Objector has furnished a copy of the Objector’s registration with the Commercial Register B of the District Court of Darmstadt.<sup>35</sup> This piece of evidence also satisfies a third factor from the Guidebook, namely that the Objector has been officially registered with the national authorities of Germany.<sup>36</sup>

36. For these reasons, the Expert agrees with the Parties that the Objector is an established institution.

### **C. Is the Community Invoked by the Objector Clearly Delineated?**

#### **(a) Objector's Position**

37. The Objector relies on Article 4.2.3 of the Guidebook and sustains that “community status is defined broadly and may encompass a variety of organizations or individuals who share common interests or work together to achieve common goals”.<sup>37</sup> In this regard, the Objector applies the definition of “community” included in Criterion 1 of Article 4.2.3 of the Guidebook.<sup>38</sup> Indeed, for the Objector, such definition comprises associations “of individuals or entities who share a greater degree ‘of cohesion than a mere

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<sup>34</sup> Guidebook, Article 3.2.2.4 (“Established Institution” subsection).

<sup>35</sup> Annex 4 to the Objections.

<sup>36</sup> Guidebook, Article 3.2.2.4 (“Established Institution” subsection) (“Public historical evidence of its existence, such as the presence of a formal charter or national or international registration, or validation by a government, inter-governmental organization, or treaty.”).

<sup>37</sup> Objections, p. 5. See also Reply, p. 1.

<sup>38</sup> Objections, p. 5; Reply, p. 1.

commonality of interest”<sup>39</sup>. The Objector adds that, according to Article 4.2.3 of the Guidebook, the institution should have been in existence prior to 2007 and “it must be clear that the Community will continue to exist long into the future”.<sup>40</sup> In the Objector’s opinion, all this is satisfied.

38. The Objector also quotes with approval the definition of “community” given by ICANN’s Independent Objector,<sup>41</sup> which says:

As for the community test, (the [Independent Objector] determines if the community invoked is a clearly delineated community), the notion of “community” is wide and broad, and is not precisely defined by ICANN’s Applicant Guidebook for the new gTLDs program.<sup>42</sup>

39. Moreover, the Objector relies on a Wikipedia article regarding the word “community”.<sup>43</sup> The Objector states that – according to Wikipedia – there are three main types of eligible community arrangements, including “Community Organizations”, which in turn include *inter alia* “incorporated associations”, “economic enterprises”, and “professional associations”.<sup>44</sup>

40. The Objector points out that the guidelines for Criterion 1 of Article 4.2.3 of the Guidebook provide examples of communities, including one that says that “a community can consist of legal entities (for example, an association of suppliers of a particular service)”.<sup>45</sup> For the Objector, this definition contemplates corporate communities like the Objector’s group of companies, which is comprised of “literally hundreds of highly-specialized companies work[ing] together to provide solutions to shared healthcare and life

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<sup>39</sup> Objections, p. 5.

<sup>40</sup> *Id.*; Reply, p. 1.

<sup>41</sup> “ICANN” stands for Internet Corporation for Assigned Names & Numbers (“**ICANN**”). The Independent Objector may file objections against “highly objectionable” gTLD applications to which no objection has been filed. The Independent Objector is limited to filing two types of objections: (i) Limited Public Interest objections and (ii) Community objections. The Independent Objector acts solely in the best interests of the public who use the global Internet. See Article 3.2.5 of the Guidebook.

<sup>42</sup> Reply, p. 1 (*quoting* Annex 1 to the Reply, p. 3 – “community objections” at ¶ 3).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* (*citing* Annex 2 to the Reply, p. 7)

<sup>45</sup> Objections, p. 5; Reply, p. 1 (*quoting* Guidebook, Article 4.2.3, Criterion 1 Guidelines).

sciences goals, united by a common identity, purpose and name”.<sup>46</sup> The Objector mentions that its group of companies is present in 67 countries and serves the interests of its stakeholders in over 180 countries.<sup>47</sup>

41. The Objector argues that all the members of its Merck Community work together as an organic body and that they are identified as a “single network”.<sup>48</sup> Indeed, the Objector sustains that the so-called Merck Community is a “synergistic network of producers, developers and suppliers that work together to achieve common goals”.<sup>49</sup> To back this contention, the Objector furnishes several letters signed by officers of its subsidiaries across the world endorsing the Objector’s position.<sup>50</sup> For the Objector, the idea of a Merck Community is further reinforced by (i) the existence of a Merck University, “which offers the employees of its many Community members the opportunity to receive leadership training and take a more active role in the international organization”;<sup>51</sup> and (ii) the fact that many companies which comprise the so-called Merck Community are managed or led by members of the founding Merck family.<sup>52</sup>

42. The Objector explains that a number of applicants filed applications for gTLDs as corporate communities, including .IKANO, .STADA, .LAMBORGHINI, .BUGATTI, .大众汽车 (“Volkswagen” in Chinese), .AUDI, .OVH, .GEA and .EDEKA.<sup>53</sup> For the Objector, in each case, “these companies have applied for a controlled, single-registrant space which is designed to promote and reflect their brands online” and “[o]nly members of their corporate communities [. . .] are eligible to use domain names within the applied-for spaces”.<sup>54</sup> In the Objector’s opinion, these models correspond to the structure of its Merck Community.

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<sup>46</sup> Objections, p. 5; Reply, p. 1

<sup>47</sup> Objections, p. 6. *See also* Reply, p. 3 (*in fine*).

<sup>48</sup> Objections, p. 5.

<sup>49</sup> Reply, p. 3.

<sup>50</sup> Objections, p. 5 (*citing* Annex 5 to the Objections).

<sup>51</sup> *Id.* (*citing* Annex 6 to the Objections).

<sup>52</sup> *Id.* (*citing* Annex 7 to the Objections).

<sup>53</sup> Reply, p. 1 (*citing* Annex 3 to the Reply).

<sup>54</sup> *Id.*

43. The Objector also explains why the so-called Merck Community is “clearly delineated”. First, for the Objector, such community is composed of over 250 members who have worked together as a unified group since 1968 and share *inter alia* unified logos, branding, webpages and domain names.<sup>55</sup> As a result, clients, customers and partners worldwide recognize and associate all products and services with the Objector’s global network, rather than with one of its specific subsidiaries.<sup>56</sup>

44. Second, the Objector explains that all of the entities that comprise the so-called Merck Community share the following criteria:

1) the member is either Merck KGaA or a company which is a fully owned subsidiary of Merck KGaA, 2) the member uses “Merck” as the sole element or as a component of its company name, and 3) the member uses as its umbrella brand the German figurative trademark No. 30130670, “MERCK.”<sup>57</sup>

45. For the Objector, members of its community also hold and operate 6 gTLDs and 178 country code top level domains (“ccTLD”) consisting of “MERCK” as a sole element upon which they showcase their participation in the Merck Community to a global audience.<sup>58</sup>

46. In light of the above, the Objector sustains that it is “extremely clear which entities may, and may not, be included in this definition”.<sup>59</sup> The Objector maintains a list of all the subsidiaries which are included in the “Community”, and no other organizations or

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<sup>55</sup> Objections, pp. 5-6 (*citing* Annex 8 to the Objections). Later in this section the Objector reiterates this idea: “All members of the Community are engaged in a common purpose, which is the fulfilment of the Group’s mission to develop and deliver high-quality products for the advancement of health care, pharmaceutical research and life-sciences innovation around the world”. *Id.*, p. 6. *See also* Reply, p. 3 (“The Community has been in existence since 1967, has utilized a streamlined and unitary branding model since the 1990s, and the Objector itself is the world’s oldest pharmaceutical company. The Community is physically present in 67 countries worldwide, and is comprised of over 250 unique members”).

<sup>56</sup> Objections, pp. 6, 8. In particular, the Objector states that the so-called Merck Community “is globally recognized as a cohesive inter-corporational network by consumers and the public worldwide”. *Id.*, p. 6.

<sup>57</sup> *Id.*, p. 6.

<sup>58</sup> *Id.* (*citing* Annex 9 to the Objections).

<sup>59</sup> *Id.*

individuals would be eligible for inclusion in the group.<sup>60</sup> As a result, all the requirements of Article 3.5.4 of the Guidebook are met.<sup>61</sup>

47. In the Reply, the Objector finds unconvincing the Respondent's theory that a corporate community cannot meet the "community" definition of the Guidebook. The Objector sustains that this theory is contrary to the Respondent's own arguments.<sup>62</sup> In particular, the Respondent filed Application No. 1-1704-73085 on "a Community basis, claiming rights in its alleged corporate community".<sup>63</sup> The Objector points out that, in such application, the Respondent "defined its own corporate community as including its core business divisions, philanthropic and corporate responsibility programs, and medical and scientific publications and websites".<sup>64</sup> For the Objector, all these entities fall under the Respondent's main parent company and thus follow an identical model to the one proposed by the Objector.<sup>65</sup>

48. Furthermore, the Objector stresses that the Respondent itself filed "numerous" community objections against the Objector.<sup>66</sup> Although these objections were rejected by the Centre because they were untimely filed, the Objector argues that they demonstrate that the Respondent shares the view that a corporate community is eligible under the Guidebook to file a community objection.<sup>67</sup> In particular, the Objector explains that such community objections filed by the Respondent contain identical arguments as those now presented by the Objector regarding the validity of a corporate community under

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<sup>60</sup> *Id.*

<sup>61</sup> Reply, p. 3.

<sup>62</sup> See *id.*, pp. 1-2.

<sup>63</sup> *Id.*, p. 1 (*citing* Annex 4 to the Reply).

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*, p. 2. More precisely, the Objector sustains that "[a]ll of the indicated members of the Respondent's 'community', as outlined above, represent subsidiaries or organizations which are owned by or under the control, management and/or governance of Merck & Co." [*i.e.*, the Respondent's ultimate parent company].  
*Id.*

<sup>66</sup> *Id.* However, the Objector has only provided evidence of two community objections filed by the Respondent against the Objector. See Annex 5 to the Reply. In the Expert's opinion, it remains unclear whether Annex 6 to the Reply relates to one of the two proceedings referred to in Annex 5 or relates to a third proceeding.

<sup>67</sup> Reply, p. 2. See rejection letters from the Centre as Annex 5 to the Reply.



the Guidebook.<sup>68</sup> The Objector highlights the following statements made by the Respondent in such community objections:<sup>69</sup>

- “Over a period of decades, [Merck & Co. USA] has also built a family of hundreds of subsidiaries, affiliates, foundations, licensees and related parties that use its MERCK Marks in a range of economic and philanthropic activities. These parties collectively act as a community (the ‘Merck Community’)”.
- “As a community that exists only by virtue of its authorized use of the MERCK family of marks, the use of which is restricted, its members are precisely known”.
- “The Merck Community represents a highly organized network of businesses and organizations”.

49. For all the above reasons, the Objector sustains that the Merck Community is clearly delineated.

#### **(b) Respondent’s Position**

50. The Respondent sustains that the Objector does not have an ongoing relationship with a clearly delineated community because the “Objector’s ‘community’ consists of nothing more than Objector itself”.<sup>70</sup> In other words, the “Objector’s proposed ‘community’ is not a community at all – it is merely Objector’s own corporate organization”.<sup>71</sup>

51. The Respondent argues that if a corporate structure – such as the so-called Merck Community – can be considered as a community, this would create a “significant and unintended precedent for ICANN and future new gTLD rounds”.<sup>72</sup>

52. The Respondent notes that the Guidebook gives a number of examples of possible communities in Article 4.2.3, but nowhere does the Guidebook suggest that a single corporate organization can constitute its “own self-serving ‘community’”.<sup>73</sup> In the Respondent’s own words, the “Objector appears to have wilfully and mistakenly interpreted

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<sup>68</sup> Reply, p. 2.

<sup>69</sup> Annex 6 to the Reply, pp. 4-5 (partially quoted by in the Reply, p. 2).

<sup>70</sup> Responses, p. 6.

<sup>71</sup> *Id.* See also *id.*, p. 7.

<sup>72</sup> *Id.*, p. 6. See also Response 419, p. 13; Response 425, p. 11; Rejoinder, p. 3.

<sup>73</sup> Response 419, p. 7; Response 425, p. 6; Rejoinder, p. 3.

[Article 4.2.3 of the Guidebook] to mean that any corporate entity and its wholly owned subsidiaries would qualify as a clearly delineated community”.<sup>74</sup> Otherwise, for the Respondent, the notion of community would be meaningless and nonsensical because any company with one or more subsidiaries would be able to qualify as a community under the Guidebook.<sup>75</sup> For the Respondent, citing Article 1.2.3.2 of the Guidebook, that was not the intention of ICANN when designing the system.<sup>76</sup>

53. As to the Wikipedia article on the notion of community submitted by the Objector with the Reply, the Respondent asserts that, “while possibly useful as a starting point for a rudimentary discussion of the concept of ‘community’, [it] has no relevance to the ICANN new gTLD program and the ‘*narrow category*’ of gTLD applications that should be considered as Community-based applications”.<sup>77</sup>

54. In the Respondent’s opinion, “the evidence that Objector has submitted to show a purportedly substantial ‘community’ opposition to [Respondent]’s application consists of nothing more than a handful of slightly modified form letters prepared by Objector itself and several of its wholly owned subsidiaries”.<sup>78</sup> The Respondent adds that “[n]ot a single individual or entity outside of Objector’s own corporate organization has submitted any objection to Applicant’s application”.<sup>79</sup> For these reasons, the Respondent claims that such letters are not “sufficient to be considered evidence of a clearly delineated community” and instead merely reinforce “that there is no community beyond Objector’s corporate structure”.<sup>80</sup>

55. The Respondent also addresses the nine community-based applications submitted by the Objector with the Reply in which the applicants are self-identified as

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<sup>74</sup> Rejoinder, p. 1.

<sup>75</sup> Response 419, p. 7; Response 425; Rejoinder, pp. 1, 3.

<sup>76</sup> Rejoinder, p. 1. The relevant portion of Article 1.2.3.2 of the Guidebook states as follows: “Community-based applications are intended to be a narrow category, for applications where there are unambiguous associations among the applicant, the community served, and the applied-for gTLD string”.

<sup>77</sup> Rejoinder, p. 1 (*referring* to Article 1.2.3.2 of the Guidebook) (emphasis original).

<sup>78</sup> Responses, p. 8 (*referring* to Annexes 5 and 16 to the Objections).

<sup>79</sup> *Id.*

<sup>80</sup> Rejoinder, p. 3.

communities. Contrary to what the Objector states in the Reply,<sup>81</sup> the Respondent stresses that not all the applicants in these community-based applications adopted a “single-registrant” model or “made [. . .] reference to a community that consists of a corporate entity and its wholly owned subsidiaries”.<sup>82</sup> Additionally, the Respondent mentions that four out of the nine applications were submitted by entities of the Volkswagen Group (and not by four unique, unconnected applicants).<sup>83</sup> Consequently, “only five applicants out of 85 Community-based applications believed that their corporate structure of a parent company and its wholly owned subsidiaries was sufficient to be considered as a clearly delineated community”.<sup>84</sup> The Respondent concludes that this is a misinterpretation of the rule by a minority of the 1,930 applications received by ICANN and, therefore, cannot be taken into consideration by the Expert.<sup>85</sup>

56. In addition, the Respondent notes that none of these community-based applications are in connection with another application and thus will never be tested under the Community Priority Evaluation Procedure of Module 4 of the Guidebook.<sup>86</sup>

57. The Respondent addresses in the Rejoinder the Objector’s argument that the Respondent filed community-based Application No. 1-1704-73085. In the Respondent’s opinion, the “Objector falsely claims that [the Respondent] has followed the same ‘corporate community’ model as Objector”.<sup>87</sup> For the Respondent, the key difference is that the latter’s community “is composed of a richly diverse group of entities that includes not only [Respondent]’s core businesses, but wide ranging philanthropic endeavours, charitable foundations and leading medical and scientific publications”.<sup>88</sup> On the contrary,

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<sup>81</sup> Referring to Reply, p. 1 (“[T]hese companies have applied for a controlled, single-registrant space which is designed to promote and reflect their brands online. Only members of their corporate communities, including wholly-owned or majority-interest group members, are eligible to use domain names within the applied-for spaces. These models highly correspond to the structure of the Merck Community.”).

<sup>82</sup> Rejoinder, p. 1.

<sup>83</sup> *Id.*

<sup>84</sup> *Id.*, pp. 1-2.

<sup>85</sup> *Id.*, p. 2.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* See also Response 419, p. 6 (“Applicant, by contrast, represents a Community that includes not just Applicant and its corporate subsidiaries and affiliates, but also a broader family of foundations, licensees and

for the Respondent, the “Objector’s ‘community’ consists of a corporate parent and its wholly owned subsidiaries”.<sup>89</sup>

58. Among others,<sup>90</sup> the Respondent describes the following entities which purportedly form part of its community and are beyond its corporate structure and control: (i) the United Negro College Fund / Merck Science Initiative (a/k/a UMSI);<sup>91</sup> (ii) the Merck Institute for Science Education;<sup>92</sup> and (iii) the MECTIZAN Donation program.<sup>93</sup> For the Respondent, the members of its community share “interests, aims, and commitments to service”.<sup>94</sup>

59. As to the Objector’s allegation regarding the fact that the Respondent also filed community-based objections against the former in another proceeding, the Respondent insists that – as opposed to the Objector’s community – its community is diverse and beyond any corporate structure.<sup>95</sup>

60. For these reasons, the Respondent claims that the Objector has failed to identify a clearly delineated community with which it has a relationship.

### **(c) Expert’s Conclusion**

#### **(i) Preliminary Matter**

61. As a preliminary matter, the Expert feels compelled to analyze whether the Respondent’s arguments regarding the invalidity of a corporate community under the Guidebook are consistent with the position that it previously sustained. Thereafter, the Expert will analyze the consequences of any inconsistency.

62. The Objector maintains that the Respondent’s argument that a corporate community cannot be considered as a valid community under the Guidebook is inconsistent

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related parties, all of whom use its MERCK family of marks and names internationally in connection with their activities, including philanthropy, all in furtherance of their community’s collective purpose and interest”).

<sup>89</sup> Rejoinder, p. 2.

<sup>90</sup> A larger sample of members of the Respondent’s community is included in its Application No. 1-1702-73085. See Annex D to the Response 419, section 20(a) (transcribed in the Response 419 at pp. 5-6).

<sup>91</sup> Rejoinder, p. 2. (*citing* Annex 1 to the Rejoinder).

<sup>92</sup> *Id.* (*citing* Annex 2 to the Rejoinder).

<sup>93</sup> *Id.* (*citing* Annex 3 to the Rejoinder).

<sup>94</sup> Response 419, p. 6 (*citing* Annex E to the Response 419).

<sup>95</sup> Rejoinder, pp. 2-3.

with: (i) the definition of community included in Application No. 1-1702-73085 filed by the Respondent;<sup>96</sup> and (ii) the allegations contained in the related but independent community objection filed by the Respondent against the Objector regarding the string “.MERCK”.<sup>97</sup>

63. In essence, the Respondent argues that its community is different to the Objector’s community because, as opposed to the latter, the former’s community includes entities beyond a mere corporate structure. For the Respondent, its community “is composed of a richly diverse group of entities that includes not only [Respondent]’s core businesses, but wide ranging philanthropic endeavours, charitable foundations and leading medical and scientific publications”.<sup>98</sup> Among other examples, the Respondent includes within its community the United Negro College Fund / Merck Science Initiative (a/k/a UMSI); (ii) the Merck Institute for Science Education; and (iii) the MECTIZAN Donation program.<sup>99</sup>

64. In the Expert’s opinion, the above entities purportedly beyond subsidiary corporations are not very different to the Merck University included by the Objector as a member of its community.<sup>100</sup> Although they may not be owned by MSD, they are under the control, management and/or governance – whether directly or indirectly – of MSD.

65. The Expert is convinced that the Respondent has specifically endorsed the type of community now defended by the Objector, namely a community in which its members are under the ownership, control, management and/or governance – whether directly or indirectly – of a parent company. The community-based Application No. 1-1702-73085 is replete of undeniable assertions supporting this conclusion, including the following:

- “The family of subsidiaries, affiliates, foundations, licensees, and related parties that are authorized by Merck, to use the Merck marks in a range of economic and philanthropic activities, collectively act as a community”.<sup>101</sup>

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<sup>96</sup> See Annex 4 to the Reply; Annex D to the Response 419.

<sup>97</sup> See Annex 6 to the Reply.

<sup>98</sup> See n. 88, *supra*.

<sup>99</sup> See ¶ 58 and n. 90, *supra*.

<sup>100</sup> See ¶ 41, *supra*.

<sup>101</sup> Annex D to the Response 419, sections 18(a) and 20(a).

- “As a community that exists only by virtue of its authorized use of the Merck family of marks, the use of which is restricted, its members are precisely known”.<sup>102</sup>
- “Only qualified subsidiaries and affiliates of Merck, approved licensees, and Merck foundations and related parties will be eligible for inclusion in this community”.<sup>103</sup>
- “As such, registrations within the community may be made by the following for-profit and not-forprofit businesses or organizations: (a) Qualified subsidiaries and affiliates[;] (b) Merck foundations and related parties[;] (c) Approved licensees”.<sup>104</sup>

66. The allegations contained in the community objection filed by the Respondent against the Objector regarding the string “.MERCK” (submitted as Annex 6 to the Reply) are also very illustrative. Examples of such allegations were transcribed in ¶ 48 above and, in the Expert’s view, they serve as additional evidence that the Respondent has previously agreed with the Objector’s definition of community.

67. As a result, the Expert finds that the Respondent is being inconsistent with its previous understanding of the notion of a community. However, even if the Parties were to agree on an interpretation of the Guidebook, the Expert is not bound by such interpretation. On the contrary, the Expert is the gatekeeper of the Guidebook and must serve as a safety net for the correct interpretation thereof.<sup>105</sup> Consequently, if the Parties agree on an incorrect interpretation of the Guidebook, the Expert must use its discretion to accept or reject such interpretation. In the next section, the Expert will analyze the requirements of the Guidebook and the evidence presented by the Parties in order to determine whether the Objector’s community may be regarded as such for the purposes of sustaining a community objection.

## (ii) Analysis

68. The Expert observes that both Parties cite Article 4.2.3 of the Guidebook (“Community Priority Evaluation Criteria”) to support their arguments, but the provisions of Article 4.2 of the Guidebook (“Community Priority Evaluation”) and its accompanying

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<sup>102</sup> *Id.*, section 20(a).

<sup>103</sup> *Id.*, section 20(d).

<sup>104</sup> *Id.*

<sup>105</sup> Guidebook, Article 3.4.6 (“The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process”).

subsections only apply “once all applications in the contention set have completed all previous stages of the process”.<sup>106</sup> Since not all previous stages have been completed yet, it is not the appropriate time to carry out a community priority evaluation, which in any case falls outside the Expert’s mission. The criteria and examples included in such sections of the Guidebook may be used as a source of inspiration but are not binding upon the Expert.

69. Instead, the Expert must concentrate on the rules and factors contained in Module 3 of the Guidebook and, more precisely, on those relating to community objections. Article 3.2.2.4 of the Guidebook specifically deals with the standing of an institution to file a community objection, but this Article does not provide any guidance on the assessment of whether a community may be considered clearly delineated. For this reason, the Expert must turn to Article 3.5.4 of the Guidebook (“Community” subsection), which contains certain criteria to analyze whether a community is clearly delineated.<sup>107</sup>

70. As a threshold matter, the Expert notes that Article 3.5.4 of the Guidebook lists some “factors” to steer the Expert’s judgment. However, as with the factors specifically relating to the standing discussed in ¶¶ 30-31 above, the language of the factors is open. In particular, all factors set forth in Article 3.5.4 of the Guidebook (“Community” subsection) are introduced with optional language, such as “a panel could balance a number of factors to determine this”. Once again, this proves the mere orientative nature of these factors. Additionally, in all instances the Guidebook mentions that the factors included therein are not exhaustive (*i.e.*, the Guidebook uses language in the fashion of “including but limited to”). Therefore, the Expert may weigh other factors if considered appropriate.

71. The subsection of Article 3.5.4 of the Guidebook regulating the issue at bar states that “[t]he objector must prove that the community expressing opposition can be regarded as a clearly delineated community”.<sup>108</sup> The same subsection expresses that, “[i]f opposition by a number of people/entities is found, but the group represented by the

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<sup>106</sup> Emphasis added.

<sup>107</sup> The Objector appears to acknowledge that the appropriate criteria to evaluate whether there is a clearly-delineated community are those contained in Article 3.5.4 of the Guidebook. Reply, p. 3 (“Under the Guidebook, the requirements for a clearly-delineated community are provided in § 3.5.4. [. . .]”).

<sup>108</sup> Emphasis added.

objector is not determined to be a clearly delineated community, the objection will fail”.<sup>109</sup> Therefore, the threshold is not whether a great number of people or entities are opposing, but rather whether the community may in fact be clearly delineated. Yet, another conclusion may be drawn from the transcribed portion of Article 3.5.4 of the Guidebook: not every “group” or “community” (terms used in the Guidebook indistinctly) necessarily qualifies as a “clearly delineated community”.

72. Some of the factors included in Article 3.5.4 of the Guidebook (“Community” subsection) shed light on the Expert’s analysis. The first factor in the Guidebook is:

The level of public recognition of the group as a community at a local and/or global level

73. The Expert is persuaded that the Objector enjoys worldwide public recognition. Such public recognition is in the form of a transnational group of companies which share a number of common elements. The Objector notes that all of the companies that form the group:<sup>110</sup> (i) are all directly or indirectly under the ownership of Merck KGaA; (ii) use a “Merck” composite name; (iii) use common trademarks, brands, websites, domains, etc.; and (iv) file joint financial statements. In the Expert’s opinion, all these elements allow the public to identify the Objector as an integrated group of companies. However, as mentioned earlier, not all groups qualify as clearly delineated communities.

74. The factor under analysis requires that the group be recognized as a “community” by the public. Although the members of the Merck group of companies may see themselves as a community, it has not been evidenced to the Expert that the general public sees the so-called Merck Community as being anything more than a global corporation with highly coordinated subsidiaries throughout the world. Therefore, this first factor favors the Respondent.

75. The second factor in the Guidebook is:

The level of formal boundaries around the community and what persons or entities are considered to form the community;

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<sup>109</sup> Emphasis added.

<sup>110</sup> Objections, pp. 5-6.



76. The Expert interprets this factor to allow him to analyze the nature of the persons or entities that form the group or community. In our case, the boundaries of the community as viewed by the Objector were outlined in ¶¶ 44-45 above. As the Objector contends, the so-called Merck Community is composed of “250 unique members” which are all part of Merck KGaA’s group of companies.<sup>111</sup> The Objector does not intend to include within this group any other individual or entity which is not part of the same corporate structure.

77. In the Expert’s opinion, a community of corporations or of other legal entities may sometimes qualify as a delineated community. However, this is not the case in the Objector’s community. The key element in our analysis is that the members of the so-called Merck Community are not associated with Merck KGaA but are rather owned – directly or indirectly – by the latter. Indeed, in order to form a clearly delineated community, the link must be of association and not of ownership, control, management and/or governance. Otherwise, as in the case at hand, we may stand before a sole consolidated entity.

78. Together with the Reply, the Objector submitted evidence of 9 different community-based applications for new gTLDs filed by groups of companies in order to evidence that: (i) its theory of a corporate community is valid under the Guidebook; and (ii) other applicants share such theory. As mentioned earlier, for the Objector “these companies have applied for a controlled, single-registrant space which is designed to promote and reflect their brands online” and “[o]nly members of their corporate communities [. . .] are eligible to use domain names within the applied-for spaces”.<sup>112</sup>

79. As explained in ¶ 68 above, in the Expert’s opinion, the present proceeding is not the appropriate forum to discuss issues pertaining to Module 4 of the Guidebook. The Expert must reiterate that the provisions of Article 4.2 of the Guidebook and its accompanying subsections only apply “once all applications in the contention set have completed all previous stages of the process”.<sup>113</sup> Since not all previous stages have been

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<sup>111</sup> *Id.*

<sup>112</sup> Reply, p. 1 (*citing* Annex 3 to the Reply).

<sup>113</sup> Emphasis added.

completed at the moment, it is not the appropriate time to carry out a community priority evaluation. When the time comes, if necessary, said 9 applicants will have to undergo a community priority evaluation process where their corresponding communities will be tested against the criteria of Article 4.2.3 of the Guidebook (which differ from those in Article 3.5.4 of the Guidebook).<sup>114</sup> The same is true for Respondent's community-based Application No. 1-1702-73085.<sup>115</sup>

80. In light of the foregoing, the Expert is reluctant to approve a community composed of subsidiaries of the same parent company. As the Respondent correctly suggests,<sup>116</sup> the Expert must avoid creating a dangerous precedent that may give rise to abusive community objections in the future. Allowing groups of companies to qualify as valid communities under the Guidebook will create every incentive for potential objectors to incorporate subsidiaries in order to build a synthetic community.

81. For these reasons, in the Expert's opinion, the second factor favors the Respondent.

82. The third factor in the Guidebook is:

The length of time the community has been in existence

83. The Expert reads the term "community" in this factor as interchangeable with "group". In the Expert's Opinion, the Objector has satisfied this test by evidencing that it was originally incorporated a few centuries ago and was formally re-incorporated in 1996.<sup>117</sup> Notably, the Respondent does not challenge this. Therefore, this factor favors the Objector.

84. The fourth factor in the Guidebook is:

The global distribution of the community (this may not apply if the community is territorial)

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<sup>114</sup> The Expert reads Article 3.5.4 of the Guidebook as only allowing the Expert to determine whether there is a clearly delineated community or not. Conversely, Criterion 1 (subsection A) of the Guidebook appears to include 3 levels of delineation and pre-existence of a community. *Compare* Article 3.5.4 of the Guidebook ("Community" subsection) *with* Article 4.2.3 of the Guidebook (Criterion 1, subsection A)

<sup>115</sup> Annex D to the Response 419.

<sup>116</sup> Response 419, pp. 6, 13; Response 425, pp. 6, 11; Rejoinder, p. 3.

<sup>117</sup> Annex 4 to the Objections, Commercial Register Excerpt, p. 4.

85. Again, the Expert reads the term “community” in this factor as interchangeable with “group”. Neither Party disputes that the Merck KGaA group of companies is a multinational company with presence in many parts of the world. The Objector contends that it has subsidiaries in 67 countries without citing any support.<sup>118</sup> The Expert has, however, been able to corroborate this with the Merck Annual Report for 2011.<sup>119</sup> Therefore, this factor favors the Objector’s position.

86. The fifth factor in the Guidebook is:

The number of people or entities that make up the community.

87. The Expert reiterates that the alleged members of the so-called Merck Community are not associated with Merck KGaA but rather owned – directly or indirectly – by the latter. Therefore, in the Expert’s opinion, the so-called Merck Community is composed of one member only. Consequently, this factor favors the Respondent.

88. On balance, the Expert finds that the so-called Merck Community cannot be considered as a clearly defined community for the purposes of the Guidebook.

**D. Is there an Ongoing Relationship Between the Objector and a Clearly Delineated Community?**

**(a) Objector’s Position**

89. The Objector claims to be “the parent company of the Merck Community, and as such serves as the head of the Community’s vast international network”.<sup>120</sup> The Objector describes the role of its subsidiaries as follows:

The individual companies which make up the Community are all, in their own ways and capacities, advancing the interests of the group through continued research, development, product testing and consumer outreach, and at each step the Objector is there to provide guidance, leadership and a unified vision for their work.<sup>121</sup>

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<sup>118</sup> Objections, p. 6; Rejoinder, p. 3.

<sup>119</sup> Annex 2 to the Objections, p. 34.

<sup>120</sup> Objections, p. 6.

<sup>121</sup> *Id.*

90. The Objector further argues that the community will continue to exist in the future and that the Objector itself will remain the center of the community's activities.<sup>122</sup>

### **(b) Respondent's Position**

91. The Respondent maintains that the Objector is "nothing more than Objector's own corporate organization – a parent company and its wholly owned subsidiaries".<sup>123</sup> In other words, for the Respondent, the "Objector has an ongoing relationship with itself".<sup>124</sup> Therefore, the Objector lacks standing to file the community Objections at bar.

92. In addition, the Respondent claims that it is impossible for the Objector to claim an unambiguous association with the String because the former "is the third largest healthcare company in the world, with more than \$47 billion in annual revenue and more than 83,000 employees around the world".<sup>125</sup> In the Respondent's opinion, its community "is globally renowned for its foundations, licensees and related parties, all of whom use its MERCK-related marks and names in connection with their activities, including philanthropy, all in furtherance of their community's collective purpose and interest".<sup>126</sup>

### **(c) Expert's Conclusion**

93. The Expert will now turn to analyze whether the Objector is "associated with clearly delineated communities" or, in other words, whether it "has an ongoing relationship with a clearly delineated community".<sup>127</sup> Because of the absence of a clear definition of what is a "community" under Article 3.2.2.4 of the Guidebook, the Parties referred to Article 4.2.3 of the Guidebook. However, this does not preclude the Expert from looking into the factors contained in Article 3.2.2.4 of the Guidebook.

94. The threshold to qualify for standing under the factors of Article 3.2.2.4 of the Guidebook is different than the threshold to win a Community Objection on the merits under the factors of Article 3.5.4. For standing to object it is sufficient to be an established

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<sup>122</sup> *Id.*

<sup>123</sup> Response 419, p. 7; Response 425, p. 6. See also Rejoinder, p. 3.

<sup>124</sup> Response 419, p. 7; Response 425, p. 6

<sup>125</sup> Rejoinder, p. 1.

<sup>126</sup> *Id.*

<sup>127</sup> Guidebook, Article 3.2.2.4.

institution associated with a clearly delineated community, whereas the community must be strongly associated with the String in order for an objection to be successful.<sup>128</sup> Consequently, the threshold is lower for the purposes of Article 3.2.2.4 than for Article 3.5.4 of the Guidebook.

95. In this case, the Expert will take into consideration three factors of the relevant subsection of Article 3.2.2.4 of the Guidebook. The first two relevant factors may be analyzed together: (i) “Institutional purpose related to the benefit of the associated community”; and (ii) “Performance of regular activities that benefit the associated community”. Both factors should be interpreted as a requirement of “giving” to the community and not “receiving” from the community. In other words, they relate to a benefit for the associated community and not to a benefit for the head of such associated community.

96. As any group of companies, the subsidiaries of Merck KGaA’s group of companies serve the main purpose of generating profits for the parent company, which in turn may be translated into dividends for the parent company’s shareholders. This is achieved through the regular activities or ordinary course of business of the subsidiaries, which mainly benefit the parent company (and not the community as a whole).

97. In the Expert’s Opinion, any institutional purpose of the Objector with the community is outweighed by the purpose of the community of advancing the Objector’s economical benefit. Indeed, the situation presented is completely the opposite of what the aforementioned factors of the Guidebook require. Therefore, both factors favor the Respondent’s position.

98. The third relevant factor of the corresponding subsection of Article 3.2.2.4 of the Guidebook is “[t]he level of formal boundaries around the community”. As was discussed in ¶¶ 75-77 above, the Expert is of the opinion that Merck KGaA’s group of companies is not a clearly delineated community, but rather a group of companies. The boundaries in the so-called Merck Community are of ownership, not membership. As a result, this factor favors the Respondent.

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<sup>128</sup> According to Article 3.5.4 of the Guidebook, there should be “a strong association between the community invoked and the applied-for gTLD string”. Emphasis added.

99. In light of the foregoing, the Expert determines that there is no ongoing relationship between the Objector and a clearly delineated community.

## **VI. SUBSTANCE OF THE OBJECTION**

100. Although the Expert has found that the Objector lacks standing to file the Objection, the Expert considers appropriate to clarify a few things on the substance of such Objection. Article 3.5.4 of the Guidebook establishes the four tests that enable the Expert to “determine whether there is substantial opposition from a significant portion of the community to which the string may be targeted”. Article 3.5.4 expresses the four tests as follows:

For an objection to be successful, the objector must prove that:

- The community invoked by the objector is a clearly delineated community; and
- Community opposition to the application is substantial; and
- There is a strong association between the community invoked and the applied-for gTLD string; and
- The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. Each of these tests is described in further detail below.<sup>129</sup>

101. The Expert notes that each of the four tests transcribed is separated by the term “and”, which implies that each one of them must be met in order to sustain an objection. This is further confirmed by the last sentence of Article 3.5.4 of the Guidebook, which states that “[t]he objector must meet all four tests in the standard for the objection to prevail”. This leaves no room for interpretation and evidences the high threshold that a community objection must satisfy.

102. In Section V above, the Expert has determined that the Objector lacks standing to file the community objections at hand because it is not associated with a clearly delineated community. As a result, the first test of Article 3.5.4 of the Guidebook is not met

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<sup>129</sup> Guidebook, Article 3.5.4 (emphasis added).

either (namely, “[t]he community invoked by the objector is a clearly delineated community”). Since all four tests listed Article 3.5.4 of the Guidebook must be met in order for a community objection to succeed, the Objections must fail also on the substance.

103. Notwithstanding the above, the Expert is of the opinion that an analysis of the tests of Article 3.5.4 of the Guidebook would be a futile exercise because the Expert has already determined that the Objector lacks standing.

104. On a separate note, the Parties are engaged in local litigation in Germany and the UK, as well as in several Legal Rights Objection proceedings in WIPO’s Arbitration and Mediation Center regarding the String and variations thereof.<sup>130</sup> The Objector has also anticipated more litigation in other jurisdictions.<sup>131</sup>

105. Article 12(4) of the Rules provides that, “[u]nless otherwise agreed by the parties, the expert’s report shall be admissible in any judicial or arbitral proceeding in which all of the parties thereto were parties to the expertise proceedings in which such report was prepared”. For this reason also, a full scale analysis of the substance of the case – specially the issue of possible detriment to one of the Parties<sup>132</sup> – would add nothing but nuisance to one of the Parties (as the Expert Determination may be later introduced as evidence in one of the ongoing proceedings).

106. Although it has included some discussion of the 1970/1975 Agreements in its submissions, the Objector ultimately appears to suggest that the appropriate forum to discuss any detriment or breach of the 1970/1975 Agreements is WIPO’s Arbitration and Mediation Center, as well as the courts of Germany and the UK:

Although this agreement discusses both the acceptable use of the Merck name and trademark, all considerations regarding trademark concerns are left to the LRO procedure and the parties’ ongoing court litigation.<sup>133</sup>

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<sup>130</sup> See ¶¶ 25-26, *supra*.

<sup>131</sup> See ¶ 25, *supra*.

<sup>132</sup> Guidebook, Article 3.5.4 (“The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. [. . .]”)

<sup>133</sup> Objections, p. 7.

107. The Expert is of the opinion that the community objection proceeding is not the appropriate forum to discuss the interpretation, scope or breach of the 1970/1975 Agreements.

## **VII. COSTS**

108. In accordance with Article 14(e) of the Procedure, the Centre shall refund to the prevailing party its advance payment of costs.

## **VIII. SUMMARY OF FINDINGS**

109. Within the 45 day time-limit set forth in Article 21(a) of the Procedure, the Expert concludes as follows:

- (i) the Objector lacks standing to file the Objections because it has failed to evidence an ongoing relationship with a clearly delineated community;
- (ii) the Centre shall refund to the prevailing party its advance payment of costs; and
- (iii) this Expert Determination shall be published in full.

110. For these reasons, the prevailing Party is the Respondent and thus the Objection shall be dismissed.

## **IX. DECISION**

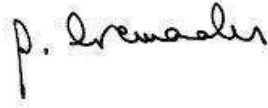
111. For the above reasons and according to Article 21(d) of the Procedure, I hereby render the following Expert Determination:

- (i) The Objections of Merck KGaA are dismissed;
- (ii) Merck Registry Holdings, Inc. prevails in both consolidated cases; and
- (iii) Merck Registry Holdings, Inc.'s advance payment of costs for both consolidated cases shall be refunded by the Centre.

\* \* \*



Date: 19/November/2013

A handwritten signature in black ink, appearing to read "B. Cremades". The signature is written in a cursive style with a large initial "B" and a long horizontal stroke extending to the right.

Signature: \_\_\_\_\_  
Bernardo M. Cremades  
Expert

**THE INTERNATIONAL CENTRE FOR EXPERTISE OF THE  
INTERNATIONAL CHAMBER OF COMMERCE**

CASE No. EXP/428/ICANN/45

MERCK KGAA

(GERMANY)

vs/

MSD REGISTRY HOLDINGS, INC.

(USA)

This document is an original of the Expert Determination rendered in conformity with the New gTLD Dispute Resolution Procedure as provided in Module 3 of the gTLD Applicant Guidebook from ICANN and the ICC Rules for Expertise.

**INTERNATIONAL CENTRE FOR EXPERTISE  
OF THE  
INTERNATIONAL CHAMBER OF COMMERCE**

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CASE NO. EXP/428/ICANN/45

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**MERCK KGAA  
(GERMANY)**

*OBJECTOR*

v.

**MSD REGISTRY HOLDINGS, INC.  
(UNITED STATES OF AMERICA)**

*RESPONDENT*

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**EXPERT DETERMINATION BY  
BERNARDO M. CREMADES  
NOVEMBER 19, 2013**

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## LIST OF ABBREVIATIONS

Term	Meaning
<b>1970/1975 Agreements</b>	Means the Agreements entered into between MSD and the Objector in 1970 and 1975, respectively (submitted as Annex 13 to the Objection and Annex C to the Response)
<b>Appendix III</b>	Means Appendix III to the Rules for Expertise of the International Chamber of Commerce, Schedule of expertise costs for proceedings under the new gTLD dispute resolution procedure
<b>Applicant</b>	Means MSD Registry Holdings, Inc.
<b>ccTLD</b>	Means country code top level domain
<b>Centre</b>	Means the International Centre for Expertise of the International Chamber of Commerce
<b>Expert</b>	Means Bernardo M. Cremades
<b>Expert Determination</b>	Means this expert determination rendered on November 19, 2013
<b>gTLD</b>	Means generic top level domain
<b>Guidebook</b>	Means the gTLD Applicant Guidebook
<b>ICC</b>	Means International Chamber of Commerce
<b>ICC Practice Note</b>	Means the ICC Practice Note on the Administration of Cases under the New gTLD Dispute Resolution Procedure
<b>ICANN</b>	Means Internet Corporation for Assigned Names & Numbers
<b>MSD</b>	Means Merck, Sharp & Dohme, Corp.
<b>Objection</b>	Means the community objection filed by the Objector against Respondent's application for the String on March 13, 2013
<b>Objector</b>	Means Merck KGaA
<b>Parties</b>	Means collectively Merck KGaA and MSD Registry Holdings, Inc.
<b>Party</b>	Means individually Merck KGaA or MSD Registry Holdings, Inc.
<b>Procedure</b>	Means the Attachment to Module 3 of the gTLD Applicant Guidebook, New gTLD Dispute Resolution Procedure
<b>Rejoinder</b>	Means the rejoinder to the Reply filed by the Respondent on August 12, 2013
<b>Reply</b>	Means the reply to the Response filed by the Objector on August 2, 2013
<b>Respondent</b>	Means MSD Registry Holdings, Inc.
<b>Response</b>	Means the response to the Objection filed by the Respondent on May 14, 2013
<b>Rules</b>	Means the Rules for Expertise of the International Chamber of Commerce

<b>String</b>	Means the applied-for gTLD “.MERCKMSD” by the Applicant (Application No. 1-1704-28482)
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1. This expert determination (the “**Expert Determination**”) is issued under the Rules for Expertise of the International Chamber of Commerce (the “**Rules**”), supplemented by the ICC Practice Note on the Administration of Cases (the “**ICC Practice Note**”), and under the Attachment to Module 3 of the gTLD Applicant Guidebook, New gTLD Dispute Resolution Procedure (the “**Procedure**”) of the gTLD Applicant Guidebook (the “**Guidebook**”).

## **I. THE PARTIES AND THE EXPERT**

### **A. Objector**

2. The Objector is:

Name	Merck KGaA
Contact person	Mr. Jonas Koelle
Address	Frankfurter Straße 250
City, Country	64293 Darmstadt, Germany
Telephone	(+49) 615 172 5303
Email	<a href="mailto:jonas.koelle@merckgroup.com">jonas.koelle@merckgroup.com</a>

3. The Objector is represented herein by:

Name	Bettinger Schneider Schramm
Contact person	Dr. Torsten Bettinger
Address	Cuvilliesstr. 14 a
City, Country	81679 Munich, Germany
Telephone	(+49) 89 599 080-0
Email	<a href="mailto:info@bettinger.de">info@bettinger.de</a>

4. The Objector has appointed its legal representative to receive all communications and notifications in the present proceeding.

**B. Respondent**

5. The Respondent (also referred to as the Applicant) is:

Name	MSD Registry Holdings, Inc.
Contact person	Ms. Rashi Rai
Address	One Merck Drive
City, Country	Whitehouse Station, NJ 08889, U.S.
Telephone	(+1) 908 423 1000
Email	<a href="mailto:Rashi_rai@merck.com">Rashi_rai@merck.com</a>

6. The Respondent is represented herein by:

Name	Hogan Lovells (Paris) LLP
Contact person	Mr. David Taylor
Address	17, Avenue Matignon
City, Country	75008 Paris, France
Telephone	(+33) 1 53 67 47 47
Email	<a href="mailto:domaindisputes@hoganlovells.com">domaindisputes@hoganlovells.com</a>

Name	FairWinds Partners, LLC
Contact person	Mr. Joshua Bourne
Address	1000 Potomac Street NW
City, Country	Washington, DC 20007, U.S.
Telephone	(+1) 202 223 9252
Email	<a href="mailto:bourne.ms@fairwindspartners.com">bourne.ms@fairwindspartners.com</a>

7. The Respondent has appointed Mr. David Taylor of Hogan Lovells (Paris) LLP to receive all communications and notifications in the present proceeding.



### C. Expert

8. The Expert is:

Name	Mr. Bernardo M. Cremades
Firm	B. Cremades & Asociados
Address	Calle Goya 18 – Planta 2
City, Country	Madrid, Spain
Telephone	(+34) 914 237 200
Email	<a href="mailto:bcremades@bcremades.com">bcremades@bcremades.com</a>

### II. APPLIED-FOR GTLD

9. The applied-for generic top level domain (“gTLD”) is “.MERCKMSD” (Application No. 1-1704-28482) (the “String”).

### III. PROCEDURAL MATTERS

10. On March 13, 2013, the Objector filed a community objection against the Respondent’s application for the String in accordance with Article 3.2.1 of the Guidebook and Article 2 of the Procedure (the “**Objection**”).

11. According to Article 3.2.1 of the Guidebook, a community objection is filed when “[t]here is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted”.

12. On May 14, 2013, the Respondent filed a response disputing Objector’s standing and alleging that the Objector failed to meet the community objection requirements of the Guidebook (the “**Response**”).

13. On June 12, 2013, the Chair of the Standing Committee of the Centre appointed Mr. Bernardo M. Cremades as Expert in accordance with Article 7 and Article 3(3) Appendix I of the Rules.

14. On June 19, 2013, the Objector contacted the International Centre for Expertise of the International Chamber of Commerce (the “**Centre**”) to request a second

round of submissions.<sup>1</sup> Two days later, the Centre suggested that the Objector address the request directly to the Expert Panel once constituted.<sup>2</sup> On June 25, 2013, the Objector directed the same request directly to the Expert.<sup>3</sup>

15. On July 15, 2013, the Centre transferred the file to the Expert and confirmed in writing that: (i) the estimated costs had been paid in full by each Party; and (ii) the full constitution of the Expert Panel had taken effect as of that same day.<sup>4</sup>

16. On July 16, 2013, the Expert issued Procedural Order No.1 directing both Parties to submit their views on certain procedural matters. The Parties replied on July 19, 2013. On July 23, 2013, the Expert issued Procedural Order No. 2 directing the Parties to submit additional evidence and allegations on very limited matters (Articles 17(a) and 18 *in fine* of the Procedure). The Expert also found that no hearing was necessary in this proceeding (Article 19 of the Procedure) and that the Expert Determination should be published in full (Article 21(g) of the Procedure).

17. On August 2, 2013, the Objector filed its second memorial together with additional evidence (the “**Reply**”). On August 12, 2013, the Respondent filed its second memorial, together with the supporting evidence, in response to the Reply (the “**Rejoinder**”).<sup>5</sup>

18. In accordance with Articles 5(a) and 6(a) of the Procedure, as well as Articles 3.3.1 and 3.3.3 of the Guidebook, all of the Parties’ communications were submitted electronically in English, which is the official language of this proceeding.

19. For all purposes, the place of the proceedings is Paris (France), where the Centre is located (Article 4(d) of the Procedure).

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<sup>1</sup> Email from Dr. Torsten Bettinger to the Centre, dated June 19, 2013.

<sup>2</sup> Email from the Centre to Dr. Torsten Bettinger, dated June 21, 2013.

<sup>3</sup> Email from Dr. Torsten Bettinger to the Expert, dated June 25, 2013.

<sup>4</sup> Letter from the Centre to the Parties and Expert, dated July 15, 2013.

<sup>5</sup> Due to maintenance works in the Expert’s email server, the Respondent’s email did not reach the Expert. With the permission of the Expert, the Respondent re-submitted these materials by fax on August 13, 2013. See Article 6(a) of the Procedure.

#### IV. BACKGROUND

20. Both Parties generally agree on the background of this dispute. The Respondent's parent company, Merck Sharp & Dohme, Corp. ("**MSD**"), was a subsidiary of the Objector at the beginning of the 20<sup>th</sup> century.<sup>6</sup> After World War I, MSD spun off the Objector pursuant to the U.S. Trading with the Enemy Act of 1917.<sup>7</sup> Since then, MSD has operated as a separate and independent company.

21. MSD and the Objector have executed a series of agreements throughout the years to regulate their co-existence and the use of the "MERCK" name, as well as the corresponding trademark.<sup>8</sup> The most recent agreements date back to 1970 and 1975 (the the "**1970/1975 Agreements**").<sup>9</sup>

22. Pursuant to the 1970/1975 Agreements, MSD has operated in the U.S. and Canada under the name "MERCK" and under a family of Merck-composite trademarks internationally (e.g., Merck Sharp & Dohme). The Objector, on the other hand, has operated under the name Merck (without qualifying or additional text) internationally but cannot use the name "MERCK" within the U.S. and Canada.<sup>10</sup>

23. MSD and the Objector are in dispute over the use of the Merck name and trademark, including the use of <merck.com> and the use of the Merck name in social media.<sup>11</sup> For this reason, in March 2013, the Objector filed a legal action in the District Court of Hamburg, Germany, against *inter alia* MSD and Merck & Co., Inc. (which is MSD's parent company).<sup>12</sup> The Respondent also mentions that the Objector commenced legal proceedings in the UK on March 8, 2013 claiming trademark infringement and alleging

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<sup>6</sup> Objection, p. 7; Response, p. 5.

<sup>7</sup> Objection, p. 7; Response, p. 5.

<sup>8</sup> Objection, pp. 7-8; Response, pp. 5, 7.

<sup>9</sup> A copy of the 1970/1975 Agreements has been submitted as Annex 13 to the Objection and Annex C to the Response.

<sup>10</sup> Objection, p. 8; Response, pp. 5, 7.

<sup>11</sup> Objection, p. 8; Response, p. 4.

<sup>12</sup> Objection, p. 8; Response, p. 4. A copy of the Request for Relief in the District Court of Hamburg, Germany, has been provided as Annex 15 to the Objection.

breach of the 1970/1975 Agreements.<sup>13</sup> The Objector anticipates “additional legal measures in other jurisdictions”.<sup>14</sup>

24. The Objector has also filed a number of Legal Rights Objections under Article 2(3)(ii) of the Procedure with WIPO’s Arbitration and Mediation Center against companies of MSD’s group of companies, including regarding the String.<sup>15</sup>

## V. OBJECTOR’S STANDING

25. In this section, the Expert will summarize the Parties’ positions relating to the Objector’s standing to file the Objection. Thereafter, the Expert will draw his conclusions in this regard.

### A. Standards

26. Article 3.2.2.4 of the Guidebook provides guidance on who may file a community objection as follows:

Established institutions associated with clearly delineated communities are eligible to file a community objection. The community named by the objector must be a community strongly associated with the applied-for gTLD string in the application that is the subject of the objection. [. . .]<sup>16</sup>

27. The Guidebook provides some explanation regarding the main requirements set forth in the quoted passage. In this regard, the Guidebook states that, “[t]o qualify for standing for a community objection, the objector must prove both of the following”, which makes abundantly clear that the two requirements that follow must be met.<sup>17</sup> These two requirements are: (i) the objector must be an “established institution”; and (ii) the objector must have “an ongoing relationship with a clearly delineated community”.<sup>18</sup> Both Parties

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<sup>13</sup> Response, p. 4.

<sup>14</sup> Objection, p. 8.

<sup>15</sup> *Id.* See [www.wipo.int/amc/en/domains/lro/cases/](http://www.wipo.int/amc/en/domains/lro/cases/).

<sup>16</sup> Guidebook, Article 3.2.2.4 (emphasis added).

<sup>17</sup> *Id.* (emphasis added).

<sup>18</sup> *Id.*

agree with this two-pronged test.<sup>19</sup> Each portion of this test will be analyzed in the following subsections of this Expert Determination.

28. For each requirement, the Guidebook lists some “factors” to steer the Expert’s judgment. As a threshold matter, the Expert will analyze the value of the “factors” outlined in Article 3.2.2.4 of the Guidebook. The Guidebook states that the “[f]actors that may be considered [by the Expert] in making this determination include, but are not limited to. [. . .]” The use of the optional term “may” instead of any other mandatory term clearly implies that the Expert has absolute discretion to apply or not the factors expressly included in the Guidebook. In addition, the final portion of the quoted passage – “but are not limited to” – opens the door to other factors not expressly listed in the Guidebook. This conclusion is also supported by the last paragraph of Article 3.2.2.4 of the Guidebook, which states that the Expert “will perform a balancing of the factors listed above, as well as other relevant information, in making its determination”.<sup>20</sup> The reference to “other relevant information” eliminates any doubt as to the orientative nature of the factors contained in the Guidebook.

29. All the above is consistent with the last phrase of Article 3.2.2.4 of the Guidebook, which provides that “[i]t is not expected that an objector must demonstrate satisfaction of each and every factor considered in order to satisfy the standing requirements”.

## **B. Is the Objector an Established Institution?**

### **(a) Objector’s Position**

30. The Objector explains that Merck KGaA “is the parent company and head institution of the international Merck Community, which is made up of the many regional offices, subsidiaries and institutions which work together to provide state-of-the-art pharmaceuticals, research instruments, chemical solutions and life sciences equipment to clients and patients around the world”.<sup>21</sup> The Objector adds that, since its incorporation in 1668, it has become “a multinational organization with stakeholders in more than 180

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<sup>19</sup> Objection, p. 4; Response, p. 5.

<sup>20</sup> Emphasis added.

<sup>21</sup> Objection, p. 4.

countries, 2011 revenues of EUR 10.27 billion, and over 40,000 employees”.<sup>22</sup> The current version of the Objector’s Articles of Association is dated July 6, 1995, when the Objector spun-off another corporation.<sup>23</sup> The Objector also highlights that it has used the name “Merck” for centuries.<sup>24</sup>

### **(b) Respondent’s Position**

31. The Respondent does not dispute that the Objector is an established institution.<sup>25</sup>

### **(c) Expert’s Conclusion**

32. The Parties do not dispute that the Objector is an established institution. However, this does not prevent the Expert from analyzing the issue.

33. From the corporate documents submitted by the Objector, the Expert is satisfied that the relevant factors included in Article 3.2.2.4 of the Guidebook are met. As a multinational company, the Objector enjoys a worldwide reputation. Thus, the “[l]evel of global recognition of the institution” factor is satisfied. Second, as to the “length of time the institution has been in existence”, the Expert is convinced that it has been in existence for more than a sufficient period and that it was not “established solely in conjunction with the gTLD application process”.<sup>26</sup> In this regard, the Objector has furnished a copy of the Objector’s registration with the Commercial Register B of the District Court of Darmstadt.<sup>27</sup> This piece of evidence also satisfies a third factor from the Guidebook, namely that the Objector has been officially registered with the national authorities of Germany.<sup>28</sup>

34. For these reasons, the Expert agrees with the Parties that the Objector is an established institution.

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<sup>22</sup> *Id.* See also Reply, p. 3 (*in fine*). For a history of the Objector, see Annex 8 to the Objection.

<sup>23</sup> Annex 4 to the Objection, Commercial Register Excerpt, p. 4.

<sup>24</sup> Objection, pp. 4-5. See also Annex 3 to the Objection.

<sup>25</sup> Response, pp. 5-6.

<sup>26</sup> Guidebook, Article 3.2.2.4 (“Established Institution” subsection).

<sup>27</sup> Annex 4 to the Objection.

<sup>28</sup> Guidebook, Article 3.2.2.4 (“Established Institution” subsection) (“Public historical evidence of its existence, such as the presence of a formal charter or national or international registration, or validation by a government, inter-governmental organization, or treaty.”).

## C. Is the Community Invoked by the Objector Clearly Delineated?

### (a) Objector's Position

35. The Objector relies on Article 4.2.3 of the Guidebook and sustains that “community status is defined broadly and may encompass a variety of organizations or individuals who share common interests or work together to achieve common goals”.<sup>29</sup> In this regard, the Objector applies the definition of “community” included in Criterion 1 of Article 4.2.3 of the Guidebook.<sup>30</sup> Indeed, for the Objector, such definition comprises associations “of individuals or entities who share a greater degree ‘of cohesion than a mere commonality of interest’”.<sup>31</sup> The Objector adds that, according to Article 4.2.3 of the Guidebook, the institution should have been in existence prior to 2007 and “it must be clear that the Community will continue to exist long into the future”.<sup>32</sup> In the Objector’s opinion, all this is satisfied.

36. The Objector also quotes with approval the definition of “community” given by ICANN’s Independent Objector,<sup>33</sup> which says:

As for the community test, (the [Independent Objector] determines if the community invoked is a clearly delineated community), the notion of “community” is wide and broad, and is not precisely defined by ICANN’s Applicant Guidebook for the new gTLDs program.<sup>34</sup>

37. Moreover, the Objector relies on a Wikipedia article regarding the word “community”.<sup>35</sup> The Objector states that – according to Wikipedia – there are three main types of eligible community arrangements, including “Community Organizations”, which in

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<sup>29</sup> Objection, p. 5. See also Reply, p. 1.

<sup>30</sup> Objection, p. 5; Reply, p. 1.

<sup>31</sup> Objection, p. 5.

<sup>32</sup> *Id.*; Reply, p. 1.

<sup>33</sup> “ICANN” stands for Internet Corporation for Assigned Names & Numbers (“ICANN”). The Independent Objector may file objections against “highly objectionable” gTLD applications to which no objection has been filed. The Independent Objector is limited to filing two types of objections: (i) Limited Public Interest objections and (ii) Community objections. The Independent Objector acts solely in the best interests of the public who use the global Internet. See Article 3.2.5 of the Guidebook.

<sup>34</sup> Reply, p. 1 (*quoting* Annex 1 to the Reply, p. 3 – “community objections” at ¶ 3).

<sup>35</sup> *Id.*

turn include *inter alia* “incorporated associations”, “economic enterprises”, and “professional associations”.<sup>36</sup>

38. The Objector points out that the guidelines for Criterion 1 of Article 4.2.3 of the Guidebook provide examples of communities, including one that says that “a community can consist of legal entities (for example, an association of suppliers of a particular service)”.<sup>37</sup> For the Objector, this definition contemplates corporate communities like the Objector’s group of companies, which is comprised of “literally hundreds of highly-specialized companies work[ing] together to provide solutions to shared healthcare and life sciences goals, united by a common identity, purpose and name”.<sup>38</sup> The Objector mentions that its group of companies is present in 67 countries and serves the interests of its stakeholders in over 180 countries.<sup>39</sup>

39. The Objector argues that all the members of its Merck Community work together as an organic body and that they are identified as a “single network”.<sup>40</sup> Indeed, the Objector sustains that the so-called Merck Community is a “synergistic network of producers, developers and suppliers that work together to achieve common goals”.<sup>41</sup> To back this contention, the Objector furnishes several letters signed by officers of its subsidiaries across the world endorsing the Objector’s position.<sup>42</sup> For the Objector, the idea of a Merck Community is further reinforced by (i) the existence of a Merck University, “which offers the employees of its many Community members the opportunity to receive leadership training and take a more active role in the international organization”;<sup>43</sup> and (ii) the fact that many companies which comprise the so-called Merck Community are managed or led by members of the founding Merck family.<sup>44</sup>

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<sup>36</sup> *Id.* (citing Annex 2 to the Reply, p. 7)

<sup>37</sup> Objection, p. 5; Reply, p. 1 (quoting Guidebook, Article 4.2.3, Criterion 1 Guidelines).

<sup>38</sup> Objection, p. 5; Reply, p. 1

<sup>39</sup> Objection, p. 6. See also Reply, p. 3 (*in fine*).

<sup>40</sup> Objection, p. 5.

<sup>41</sup> Reply, p. 3.

<sup>42</sup> Objection, p. 5 (citing Annex 5 to the Objection).

<sup>43</sup> *Id.* (citing Annex 6 to the Objection).

<sup>44</sup> *Id.* (citing Annex 7 to the Objection).



40. The Objector explains that a number of applicants filed applications for gTLDs as corporate communities, including .IKANO, .STADA, .LAMBORGHINI, .BUGATTI, .大众汽车 (“Volkswagen” in Chinese), .AUDI, .OVH, .GEA and .EDEKA.<sup>45</sup> For the Objector, in each case, “these companies have applied for a controlled, single-registrant space which is designed to promote and reflect their brands online” and “[o]nly members of their corporate communities [. . .] are eligible to use domain names within the applied-for spaces”.<sup>46</sup> In the Objector’s opinion, these models correspond to the structure of its Merck Community.

41. The Objector also explains why the so-called Merck Community is “clearly delineated”. First, for the Objector, such community is composed of over 250 members who have worked together as a unified group since 1968 and share *inter alia* unified logos, branding, webpages and domain names.<sup>47</sup> As a result, clients, customers and partners worldwide recognize and associate all products and services with the Objector’s global network, rather than with one of its specific subsidiaries.<sup>48</sup>

42. Second, the Objector explains that all of the entities that comprise the so-called Merck Community share the following criteria:

- 1) the member is either Merck KGaA or a company which is a fully owned subsidiary of Merck KGaA, 2) the member uses “Merck” as the sole element or as a component of its company name, and 3) the member uses as its umbrella brand the German figurative trademark No. 30130670, “MERCK.”<sup>49</sup>

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<sup>45</sup> Reply, p. 1 (*citing* Annex 3 to the Reply).

<sup>46</sup> *Id.*

<sup>47</sup> Objection, pp. 5-6 (*citing* Annex 8 to the Objection). Later in this section the Objector reiterates this idea: “All members of the Community are engaged in a common purpose, which is the fulfilment of the Group’s mission to develop and deliver high-quality products for the advancement of health care, pharmaceutical research and life-sciences innovation around the world”. *Id.*, p. 6. *See also* Reply, p. 3 (“The Community has been in existence since 1967, has utilized a streamlined and unitary branding model since the 1990s, and the Objector itself is the world’s oldest pharmaceutical company. The Community is physically present in 67 countries worldwide, and is comprised of over 250 unique members”).

<sup>48</sup> Objection, pp. 6, 8. In particular, the Objector states that the so-called Merck Community “is globally recognized as a cohesive inter-corporational network by consumers and the public worldwide”. *Id.*, p. 6.

<sup>49</sup> *Id.*, p. 6.

43. For the Objector, members of its community also hold and operate 6 gTLDs and 178 country code top level domains (“ccTLD”) consisting of “MERCK” as a sole element upon which they showcase their participation in the Merck Community to a global audience.<sup>50</sup>

44. In light of the above, the Objector sustains that it is “extremely clear which entities may, and may not, be included in this definition”.<sup>51</sup> The Objector maintains a list of all the subsidiaries which are included in the “Community”, and no other organizations or individuals would be eligible for inclusion in the group.<sup>52</sup> As a result, all the requirements of Article 3.5.4 of the Guidebook are met.<sup>53</sup>

45. In the Reply, the Objector finds unconvincing the Respondent’s theory that a corporate community cannot meet the “community” definition of the Guidebook. The Objector sustains that this theory is contrary to the Respondent’s own arguments in other related proceedings.<sup>54</sup> In particular, the Respondent filed an application for the gTLD “.MERCK” on “a Community basis, claiming rights in its alleged corporate community”.<sup>55</sup> The Objector points out that, in such application, the Respondent “defined its own corporate community as including its core business divisions, philanthropic and corporate responsibility programs, and medical and scientific publications and websites”.<sup>56</sup> For the Objector, all these entities fall under the Respondent’s main parent company and thus follow an identical model to the one proposed by the Objector.<sup>57</sup>

46. Furthermore, the Objector stresses that the Respondent itself filed “numerous” community objections against the Objector.<sup>58</sup> Although these objections were

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<sup>50</sup> *Id.* (citing Annex 9 to the Objection).

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

<sup>53</sup> Reply, p. 3.

<sup>54</sup> See *id.*, pp. 1-2.

<sup>55</sup> *Id.*, p. 1 (citing Annex 4 to the Reply).

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*, p. 2. More precisely, the Objector sustains that “[a]ll of the indicated members of the Respondent’s ‘community’, as outlined above, represent subsidiaries or organizations which are owned by or under the control, management and/or governance of Merck & Co.” [*i.e.*, the Respondent’s ultimate parent company].  
*Id.*

<sup>58</sup> *Id.* However, the Objector has only provided evidence of two community objections filed by the Respondent against the Objector. See Annex 5 to the Reply. In the Expert’s opinion, it remains unclear

rejected by the Centre because they were untimely filed, the Objector argues that they demonstrate that the Respondent shares the view that a corporate community is eligible under the Guidebook to file a community objection.<sup>59</sup> In particular, the Objector explains that such community objections filed by the Respondent contain identical arguments as those now presented by the Objector regarding the validity of a corporate community under the Guidebook.<sup>60</sup> The Objector highlights the following statements made by the Respondent in such community objections:<sup>61</sup>

- “Over a period of decades, [Merck & Co. USA] has also built a family of hundreds of subsidiaries, affiliates, foundations, licensees and related parties that use its MERCK Marks in a range of economic and philanthropic activities. These parties collectively act as a community (the ‘Merck Community’)”.
- “As a community that exists only by virtue of its authorized use of the MERCK family of marks, the use of which is restricted, its members are precisely known”.
- “The Merck Community represents a highly organized network of businesses and organizations”.

47. For all the above reasons, the Objector sustains that the Merck Community is clearly delineated.

#### **(b) Respondent’s Position**

48. The Respondent sustains that the Objector does not have an ongoing relationship with a clearly delineated community because the “Objector’s ‘community’ consists of nothing more than Objector itself”.<sup>62</sup> In other words, the “Objector’s proposed ‘community’ is not a community at all – it is merely Objector’s own corporate organization”.<sup>63</sup>

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whether Annex 6 to the Reply relates to one of the two proceedings referred to in Annex 5 or relates to a third proceeding.

<sup>59</sup> Reply, p. 2. See rejection letters from the Centre as Annex 5 to the Reply.

<sup>60</sup> Reply, p. 2.

<sup>61</sup> Annex 6 to the Reply, pp. 4-5 (partially quoted by in the Reply, p. 2).

<sup>62</sup> Response, p. 6.

<sup>63</sup> *Id.* See also *id.*, p. 7.

49. The Respondent argues that if a corporate structure – such as the so-called Merck Community – can be considered as a community, this would create a “significant and unintended precedent for future new gTLD rounds”.<sup>64</sup>

50. The Respondent notes that the Guidebook gives a number of examples of possible communities in Article 4.2.3, but nowhere does the Guidebook suggest that a single corporate organization can constitute its “own self-serving ‘community’”.<sup>65</sup> In the Respondent’s own words, the “Objector appears to have wilfully and mistakenly interpreted [Article 4.2.3 of the Guidebook] to mean that any corporate entity and its wholly owned subsidiaries would qualify as a clearly delineated community”.<sup>66</sup> Otherwise, for the Respondent, the notion of community would be meaningless and nonsensical because any company with one or more subsidiaries would be able to qualify as a community under the Guidebook.<sup>67</sup> For the Respondent, citing Article 1.2.3.2 of the Guidebook, that was not the intention of ICANN when designing the system.<sup>68</sup>

51. As to the Wikipedia article on the notion of community submitted by the Objector with the Reply, the Respondent asserts that, “while possibly useful as a starting point for a rudimentary discussion of the concept of ‘community’, [it] has no relevance to the ICANN new gTLD program and the ‘narrow category’ of gTLD applications that should be considered as Community-based applications”.<sup>69</sup>

52. In the Respondent’s opinion, “the evidence that Objector has submitted to show a purportedly substantial ‘community’ opposition to [Respondent]’s application consists of nothing more than a handful of slightly modified form letters prepared by Objector itself and several of its wholly owned subsidiaries”.<sup>70</sup> The Respondent adds that “[n]ot a single individual or entity outside of Objector’s own corporate organization has

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<sup>64</sup> *Id.*, p. 6. See also Rejoinder, p. 3.

<sup>65</sup> Response, p. 6; Rejoinder, p. 3.

<sup>66</sup> Rejoinder, p. 1.

<sup>67</sup> Response, p. 6; Rejoinder, pp. 1, 3.

<sup>68</sup> Rejoinder, p. 1. The relevant portion of Article 1.2.3.2 of the Guidebook states as follows: “Community-based applications are intended to be a narrow category, for applications where there are unambiguous associations among the applicant, the community served, and the applied-for gTLD string”.

<sup>69</sup> Rejoinder, p. 1 (*referring* to Article 1.2.3.2 of the Guidebook) (emphasis original).

<sup>70</sup> Response, p. 8 (*referring* to Annexes 5 and 16 to the Objection).

submitted any objection to Applicant's application".<sup>71</sup> For these reasons, the Respondent claims that such letters are not "sufficient to be considered evidence of a clearly delineated community" and instead merely reinforce "that there is no community beyond Objector's corporate structure".<sup>72</sup>

53. The Respondent also addresses the nine community-based applications submitted by the Objector with the Reply in which the applicants are self-identified as communities. Contrary to what the Objector states in the Reply,<sup>73</sup> the Respondent stresses that not all the applicants in these community-based applications adopted a "single-registrant" model or "made [. . .] reference to a community that consists of a corporate entity and its wholly owned subsidiaries".<sup>74</sup> Additionally, the Respondent mentions that four out of the nine applications were submitted by entities of the Volkswagen Group (and not by four unique, unconnected applicants).<sup>75</sup> Consequently, "only five applicants out of 85 Community-based applications believed that their corporate structure of a parent company and its wholly owned subsidiaries was sufficient to be considered as a clearly delineated community".<sup>76</sup> The Respondent concludes that this is a misinterpretation of the rule by a minority of the 1,930 applications received by ICANN and, therefore, cannot be taken into consideration by the Expert.<sup>77</sup>

54. In addition, the Respondent notes that none of these community-based applications are in connection with another application and thus will never be tested under the Community Priority Evaluation Procedure of Module 4 of the Guidebook.<sup>78</sup>

55. The Respondent addresses in the Rejoinder the Objector's argument that the Respondent filed a community-based application for ".MERCK". In the Respondent's

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<sup>71</sup> *Id.*

<sup>72</sup> Rejoinder, p. 3.

<sup>73</sup> Referring to Reply, p. 1 ("[T]hese companies have applied for a controlled, single-registrant space which is designed to promote and reflect their brands online. Only members of their corporate communities, including wholly-owned or majority-interest group members, are eligible to use domain names within the applied-for spaces. These models highly correspond to the structure of the Merck Community.").

<sup>74</sup> Rejoinder, p. 1.

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*, pp. 1-2.

<sup>77</sup> *Id.*, p. 2.

<sup>78</sup> *Id.*

opinion, the “Objector falsely claims that [the Respondent] has followed the same ‘corporate community’ model as Objector”.<sup>79</sup> For the Respondent, the key difference is that the latter’s community “is composed of a richly diverse group of entities that includes not only [Respondent]’s core businesses, but wide ranging philanthropic endeavours, charitable foundations and leading medical and scientific publications”.<sup>80</sup> On the contrary, for the Respondent, the “Objector’s ‘community’ consists of a corporate parent and its wholly owned subsidiaries”.<sup>81</sup>

56. Among others,<sup>82</sup> the Respondent describes the following entities which purportedly form part of its community and are beyond its corporate structure and control: (i) the United Negro College Fund / Merck Science Initiative (a/k/a UMSI);<sup>83</sup> (ii) the Merck Institute for Science Education;<sup>84</sup> and (iii) the MECTIZAN Donation program.<sup>85</sup>

57. As to the Objector’s allegation regarding the fact that the Respondent also filed community-based objections against the former in another proceeding, the Respondent insists that – as opposed to the Objector’s community – its community is diverse and beyond any corporate structure.<sup>86</sup>

58. For these reasons, the Respondent claims that the Objector has failed to identify a clearly delineated community with which it has a relationship.

### **(c) Expert’s Conclusion**

#### **(i) Preliminary Matter**

59. As a preliminary matter, the Expert feels compelled to analyze whether the Respondent’s arguments regarding the invalidity of a corporate community under the

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<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> A larger sample of members of the Respondent’s community is included in its Application No. 1-1702-73085 (for the string “.MERCK”). See Annex 4 to the Reply, section 20(a) (transcribed in the Reply at pp. 1-2).

<sup>83</sup> Rejoinder, p. 2 (*citing* Annex 1 to the Rejoinder).

<sup>84</sup> *Id.* (*citing* Annex 2 to the Rejoinder).

<sup>85</sup> *Id.* (*citing* Annex 3 to the Rejoinder).

<sup>86</sup> *Id.*, pp. 2-3.

Guidebook are consistent with the position that it previously sustained prior to this proceeding. Thereafter, the Expert will analyze the consequences of any inconsistency.

60. The Objector maintains that the Respondent's argument that a corporate community cannot be considered as a valid community under the Guidebook is inconsistent with: (i) the definition of community included in Application No. 1-1702-73085 (for the string ".MERCK") filed by the Respondent, which is also subject to a community objection in the proceeding originally encaptioned EXP/419/ICANN/36;<sup>87</sup> and (ii) the allegations contained in the related but independent community objection filed by the Respondent against the Objector regarding the string ".MERCK".<sup>88</sup>

61. In essence, the Respondent argues that its community is different to the Objector's community because, as opposed to the latter, the former's community includes entities beyond a mere corporate structure. For the Respondent, its community "is composed of a richly diverse group of entities that includes not only [Respondent]'s core businesses, but wide ranging philanthropic endeavours, charitable foundations and leading medical and scientific publications".<sup>89</sup> Among other examples, the Respondent includes within its community the United Negro College Fund / Merck Science Initiative (a/k/a UMSI); (ii) the Merck Institute for Science Education; and (iii) the MECTIZAN Donation program.<sup>90</sup>

62. In the Expert's opinion, the above entities purportedly beyond subsidiary corporations are not very different to the Merck University included by the Objector as a member of its community.<sup>91</sup> Although they may not be owned by MSD, they are under the control, management and/or governance – whether directly or indirectly – of MSD.

63. The Expert is convinced that the Respondent has specifically endorsed the type of community now defended by the Objector, namely a community in which its members are under the ownership, control, management and/or governance – whether directly or indirectly – of a parent company. The community-based application for the string

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<sup>87</sup> See Annex 4 to the Reply.

<sup>88</sup> See Annex 6 to the Reply.

<sup>89</sup> Rejoinder, p. 2.

<sup>90</sup> See ¶ 56 and n. 82, *supra*.

<sup>91</sup> See ¶ 39, *supra*.

“.MERCK” is replete of undeniable assertions supporting this conclusion, including the following:

- “The family of subsidiaries, affiliates, foundations, licensees, and related parties that are authorized by Merck, to use the Merck marks in a range of economic and philanthropic activities, collectively act as a community”.<sup>92</sup>
- “As a community that exists only by virtue of its authorized use of the Merck family of marks, the use of which is restricted, its members are precisely known”.<sup>93</sup>
- “Only qualified subsidiaries and affiliates of Merck, approved licensees, and Merck foundations and related parties will be eligible for inclusion in this community”.<sup>94</sup>
- “As such, registrations within the community may be made by the following for-profit and not-forprofit businesses or organizations: (a) Qualified subsidiaries and affiliates[;] (b) Merck foundations and related parties[;] (c) Approved licensees”.<sup>95</sup>

64. The allegations contained in the community objection filed by the Respondent against the Objector regarding the string “.MERCK” (submitted as Annex 6 to the Reply) are also very illustrative. Examples of such allegations were transcribed in ¶ 46 above and, in the Expert’s view, they serve as additional evidence that the Respondent has previously agreed with the Objector’s definition of community.

65. As a result, the Expert finds that the Respondent is being inconsistent with its previous understanding of the notion of a community. However, even if the Parties were to agree on an interpretation of the Guidebook, the Expert is not bound by such interpretation. On the contrary, the Expert is the gatekeeper of the Guidebook and must serve as a safety net for the correct interpretation thereof.<sup>96</sup> Consequently, if the Parties agree on an incorrect interpretation of the Guidebook, the Expert must use its discretion to accept or reject such interpretation. In the next section, the Expert will analyze the requirements of the Guidebook and the evidence presented by the Parties in order to determine whether

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<sup>92</sup> Annex 4 to the Reply, sections 18(a) and 20(a).

<sup>93</sup> *Id.*, section 20(a).

<sup>94</sup> *Id.*, section 20(d).

<sup>95</sup> *Id.*

<sup>96</sup> Guidebook, Article 3.4.6 (“The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process”).



the Objector's community may be regarded as such for the purposes of sustaining a community objection.

**(ii) Analysis**

66. The Expert observes that both Parties cite Article 4.2.3 of the Guidebook ("Community Priority Evaluation Criteria") to support their arguments, but the provisions of Article 4.2 of the Guidebook ("Community Priority Evaluation") and its accompanying subsections only apply "once all applications in the contention set have completed all previous stages of the process".<sup>97</sup> Since not all previous stages have been completed yet, it is not the appropriate time to carry out a community priority evaluation, which in any case falls outside the Expert's mission. The criteria and examples included in such sections of the Guidebook may be used as a source of inspiration but are not binding upon the Expert.

67. Instead, the Expert must concentrate on the rules and factors contained in Module 3 of the Guidebook and, more precisely, on those relating to community objections. Article 3.2.2.4 of the Guidebook specifically deals with the standing of an institution to file a community objection, but this Article does not provide any guidance on the assessment of whether a community may be considered clearly delineated. For this reason, the Expert must turn to Article 3.5.4 of the Guidebook ("Community" subsection), which contains certain criteria to analyze whether a community is clearly delineated.<sup>98</sup>

68. As a threshold matter, the Expert notes that Article 3.5.4 of the Guidebook lists some "factors" to steer the Expert's judgment. However, as with the factors specifically relating to the standing discussed in ¶¶ 28-29 above, the language of the factors is open. In particular, all factors set forth in Article 3.5.4 of the Guidebook ("Community" subsection) are introduced with optional language, such as "a panel could balance a number of factors to determine this". Once again, this proves the mere orientative nature of these factors. Additionally, in all instances the Guidebook mentions that the factors included therein are not exhaustive (*i.e.*, the Guidebook uses language in the fashion of "including but limited to"). Therefore, the Expert may weigh other factors if considered appropriate.

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<sup>97</sup> Emphasis added.

<sup>98</sup> The Objector appears to acknowledge that the appropriate criteria to evaluate whether there is a clearly-delineated community are those contained in Article 3.5.4 of the Guidebook. Reply, p. 3 ("Under the Guidebook, the requirements for a clearly-delineated community are provided in § 3.5.4. [. . .]").

69. The subsection of Article 3.5.4 of the Guidebook regulating the issue at bar states that “[t]he objector must prove that the community expressing opposition can be regarded as a clearly delineated community”.<sup>99</sup> The same subsection expresses that, “[i]f opposition by a number of people/entities is found, but the group represented by the objector is not determined to be a clearly delineated community, the objection will fail”.<sup>100</sup> Therefore, the threshold is not whether a great number of people or entities are opposing, but rather whether the community may in fact be clearly delineated. Yet, another conclusion may be drawn from the transcribed portion of Article 3.5.4 of the Guidebook: not every “group” or “community” (terms used in the Guidebook indistinctly) necessarily qualifies as a “clearly delineated community”.

70. Some of the factors included in Article 3.5.4 of the Guidebook (“Community” subsection) shed light on the Expert’s analysis. The first factor in the Guidebook is:

The level of public recognition of the group as a community at a local and/or global level

71. The Expert is persuaded that the Objector enjoys worldwide public recognition. Such public recognition is in the form of a transnational group of companies which share a number of common elements. The Objector notes that all of the companies that form the group:<sup>101</sup> (i) are all directly or indirectly under the ownership of Merck KGaA; (ii) use a “Merck” composite name; (iii) use common trademarks, brands, websites, domains, etc.; and (iv) file joint financial statements. In the Expert’s opinion, all these elements allow the public to identify the Objector as an integrated group of companies. However, as mentioned earlier, not all groups qualify as clearly delineated communities.

72. The factor under analysis requires that the group be recognized as a “community” by the public. Although the members of the Merck group of companies may see themselves as a community, it has not been evidenced to the Expert that the general public sees the so-called Merck Community as being anything more than a global

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<sup>99</sup> Emphasis added.

<sup>100</sup> Emphasis added.

<sup>101</sup> Objection, pp. 5-6.

corporation with highly coordinated subsidiaries throughout the world. Therefore, this first factor favors the Respondent.

73. The second factor in the Guidebook is:

The level of formal boundaries around the community and what persons or entities are considered to form the community;

74. The Expert interprets this factor to allow him to analyze the nature of the persons or entities that form the group or community. In our case, the boundaries of the community as viewed by the Objector were outlined in ¶¶ 42-43 above. As the Objector contends, the so-called Merck Community is composed of “250 unique members” which are all part of Merck KGaA’s group of companies.<sup>102</sup> The Objector does not intend to include within this group any other individual or entity which is not part of the same corporate structure.

75. In the Expert’s opinion, a community of corporations or of other legal entities may sometimes qualify as a delineated community. However, this is not the case in the Objector’s community. The key element in our analysis is that the members of the so-called Merck Community are not associated with Merck KGaA but are rather owned – directly or indirectly – by the latter. Indeed, in order to form a clearly delineated community, the link must be of association and not of ownership, control, management and/or governance. Otherwise, as in the case at hand, we may stand before a sole consolidated entity.

76. Together with the Reply, the Objector submitted evidence of 9 different community-based applications for new gTLDs filed by groups of companies in order to evidence that: (i) its theory of a corporate community is valid under the Guidebook; and (ii) other applicants share such theory. As mentioned earlier, for the Objector “these companies have applied for a controlled, single-registrant space which is designed to promote and reflect their brands online” and “[o]nly members of their corporate communities [. . .] are eligible to use domain names within the applied-for spaces”.<sup>103</sup>

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<sup>102</sup> *Id.*

<sup>103</sup> Reply, p. 1 (*citing* Annex 3 to the Reply).

77. As explained in ¶ 66 above, in the Expert’s opinion, the present proceeding is not the appropriate forum to discuss issues pertaining to Module 4 of the Guidebook. The Expert must reiterate that the provisions of Article 4.2 of the Guidebook and its accompanying subsections only apply “once all applications in the contention set have completed all previous stages of the process”.<sup>104</sup> Since not all previous stages have been completed at the moment, it is not the appropriate time to carry out a community priority evaluation. When the time comes, if necessary, said 9 applicants will have to undergo a community priority evaluation process where their corresponding communities will be tested against the criteria of Article 4.2.3 of the Guidebook (which differ from those in Article 3.5.4 of the Guidebook).<sup>105</sup> The same is true for Respondent’s community-based application for the string “.MERCK” (Application No. 1-1702-73085).<sup>106</sup>

78. In light of the foregoing, the Expert is reluctant to approve a community composed of subsidiaries of the same parent company. As the Respondent correctly suggests,<sup>107</sup> the Expert must avoid creating a dangerous precedent that may give rise to abusive community objections in the future. Allowing groups of companies to qualify as valid communities under the Guidebook will create every incentive for potential objectors to incorporate subsidiaries in order to build a synthetic community.

79. For these reasons, in the Expert’s opinion, the second factor favors the Respondent.

80. The third factor in the Guidebook is:

The length of time the community has been in existence

81. The Expert reads the term “community” in this factor as interchangeable with “group”. In the Expert’s Opinion, the Objector has satisfied this test by evidencing that it was originally incorporated a few centuries ago and was formally re-incorporated in 1996.<sup>108</sup>

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<sup>104</sup> Emphasis added.

<sup>105</sup> The Expert reads Article 3.5.4 of the Guidebook as only allowing the Expert to determine whether there is a clearly delineated community or not. Conversely, Criterion 1 (subsection A) of the Guidebook appears to include 3 levels of delineation and pre-existence of a community. *Compare* Article 3.5.4 of the Guidebook (“Community” subsection) *with* Article 4.2.3 of the Guidebook (Criterion 1, subsection A)

<sup>106</sup> Annex 4 to the Reply.

<sup>107</sup> Response, p. 6; Rejoinder, p. 3.

<sup>108</sup> Annex 4 to the Objection, Commercial Register Excerpt, p. 4.

Notably, the Respondent does not challenge this. Therefore, this factor favors the Objector.

82. The fourth factor in the Guidebook is:

The global distribution of the community (this may not apply if the community is territorial)

83. Again, the Expert reads the term “community” in this factor as interchangeable with “group”. Neither Party disputes that the Merck KGaA group of companies is a multinational company with presence in many parts of the world. The Objector contends that it has subsidiaries in 67 countries without citing any support.<sup>109</sup> The Expert has, however, been able to corroborate this with the Merck Annual Report for 2011.<sup>110</sup> Therefore, this factor favors the Objector’s position.

84. The fifth factor in the Guidebook is:

The number of people or entities that make up the community.

85. The Expert reiterates that the alleged members of the so-called Merck Community are not associated with Merck KGaA but rather owned – directly or indirectly – by the latter. Therefore, in the Expert’s opinion, the so-called Merck Community is composed of one member only. Consequently, this factor favors the Respondent.

86. On balance, the Expert finds that the so-called Merck Community cannot be considered as a clearly defined community for the purposes of the Guidebook.

**D. Is there an Ongoing Relationship Between the Objector and a Clearly Delineated Community?**

**(a) Objector’s Position**

87. The Objector claims to be “the parent company of the Merck Community, and as such serves as the head of the Community’s vast international network”.<sup>111</sup> The Objector describes the role of its subsidiaries as follows:

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<sup>109</sup> Objection, p. 6; Rejoinder, p. 3.

<sup>110</sup> Annex 2 to the Objection, p. 34.

<sup>111</sup> Objection, p. 6.

The individual companies which make up the Community are all, in their own ways and capacities, advancing the interests of the group through continued research, development, product testing and consumer outreach, and at each step the Objector is there to provide guidance, leadership and a unified vision for their work.<sup>112</sup>

88. The Objector further argues that the community will continue to exist in the future and that the Objector itself will remain the center of the community's activities.<sup>113</sup>

### **(b) Respondent's Position**

89. The Respondent maintains that the Objector is "nothing more than Objector's own corporate organization – a parent company and its wholly owned subsidiaries".<sup>114</sup> In other words, for the Respondent, the "Objector has an ongoing relationship with itself".<sup>115</sup> Therefore, the Objector lacks standing to file the community Objection at bar.

90. In addition, the Respondent claims that it is impossible for the Objector to claim an unambiguous association with the String because the former "is the third largest healthcare company in the world, with more than \$47 billion in annual revenue and more than 83,000 employees around the world".<sup>116</sup> In the Respondent's opinion, its community "is globally renowned for its foundations, licensees and related parties, all of whom use its MERCK-related marks and names in connection with their activities, including philanthropy, all in furtherance of their community's collective purpose and interest".<sup>117</sup>

### **(c) Expert's Conclusion**

91. The Expert will now turn to analyze whether the Objector is "associated with clearly delineated communities" or, in other words, whether it "has an ongoing relationship with a clearly delineated community".<sup>118</sup> Because of the absence of a clear definition of what is a "community" under Article 3.2.2.4 of the Guidebook, the Parties referred to Article

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<sup>112</sup> *Id.*

<sup>113</sup> *Id.*

<sup>114</sup> Response, p. 6. See also Rejoinder, p. 3.

<sup>115</sup> Response, p. 6.

<sup>116</sup> Rejoinder, p. 1.

<sup>117</sup> *Id.*

<sup>118</sup> Guidebook, Article 3.2.2.4.

4.2.3 of the Guidebook. However, this does not preclude the Expert from looking into the factors contained in Article 3.2.2.4 of the Guidebook.

92. The threshold to qualify for standing under the factors of Article 3.2.2.4 of the Guidebook is different than the threshold to win a Community Objection on the merits under the factors of Article 3.5.4. For standing to object it is sufficient to be an established institution associated with a clearly delineated community, whereas the community must be strongly associated with the String in order for an objection to be successful.<sup>119</sup> Consequently, the threshold is lower for the purposes of Article 3.2.2.4 than for Article 3.5.4 of the Guidebook.

93. In this case, the Expert will take into consideration three factors of the relevant subsection of Article 3.2.2.4 of the Guidebook. The first two relevant factors may be analyzed together: (i) “Institutional purpose related to the benefit of the associated community”; and (ii) “Performance of regular activities that benefit the associated community”. Both factors should be interpreted as a requirement of “giving” to the community and not “receiving” from the community. In other words, they relate to a benefit for the associated community and not to a benefit for the head of such associated community.

94. As any group of companies, the subsidiaries of Merck KGaA's group of companies serve the main purpose of generating profits for the parent company, which in turn may be translated into dividends for the parent company's shareholders. This is achieved through the regular activities or ordinary course of business of the subsidiaries, which mainly benefit the parent company (and not the community as a whole).

95. In the Expert's Opinion, any institutional purpose of the Objector with the community is outweighed by the purpose of the community of advancing the Objector's economical benefit. Indeed, the situation presented is completely the opposite of what the aforementioned factors of the Guidebook require. Therefore, both factors favor the Respondent's position.

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<sup>119</sup> According to Article 3.5.4 of the Guidebook, there should be “a strong association between the community invoked and the applied-for gTLD string”. Emphasis added.

96. The third relevant factor of the corresponding subsection of Article 3.2.2.4 of the Guidebook is “[t]he level of formal boundaries around the community”. As was discussed in ¶¶ 73-75 above, the Expert is of the opinion that Merck KGaA’s group of companies is not a clearly delineated community, but rather a group of companies. The boundaries in the so-called Merck Community are of ownership, not membership. As a result, this factor favors the Respondent.

97. In light of the foregoing, the Expert determines that there is no ongoing relationship between the Objector and a clearly delineated community.

## **VI. SUBSTANCE OF THE OBJECTION**

98. Although the Expert has found that the Objector lacks standing to file the Objection, the Expert considers appropriate to clarify a few things on the substance of such Objection. Article 3.5.4 of the Guidebook establishes the four tests that enable the Expert to “determine whether there is substantial opposition from a significant portion of the community to which the string may be targeted”. Article 3.5.4 expresses the four tests as follows:

For an objection to be successful, the objector must prove that:

- The community invoked by the objector is a clearly delineated community; and
- Community opposition to the application is substantial; and
- There is a strong association between the community invoked and the applied-for gTLD string; and
- The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. Each of these tests is described in further detail below.<sup>120</sup>

99. The Expert notes that each of the four tests transcribed is separated by the term “and”, which implies that each one of them must be met in order to sustain an objection. This is further confirmed by the last sentence of Article 3.5.4 of the Guidebook,

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<sup>120</sup> Guidebook, Article 3.5.4 (emphasis added).



which states that “[t]he objector must meet all four tests in the standard for the objection to prevail”. This leaves no room for interpretation and evidences the high threshold that a community objection must satisfy.

100. In Section V above, the Expert has determined that the Objector lacks standing to file the community objection at hand because it is not associated with a clearly delineated community. As a result, the first test of Article 3.5.4 of the Guidebook is not met either (namely, “[t]he community invoked by the objector is a clearly delineated community”). Since all four tests listed Article 3.5.4 of the Guidebook must be met in order for a community objection to succeed, the Objection must fail also on the substance.

101. Notwithstanding the above, the Expert is of the opinion that an analysis of the tests of Article 3.5.4 of the Guidebook would be a futile exercise because the Expert has already determined that the Objector lacks standing.

102. On a separate note, the Parties are engaged in local litigation in Germany and the UK, as well as in several Legal Rights Objection proceedings in WIPO’s Arbitration and Mediation Center regarding the String and variations thereof.<sup>121</sup> The Objector has also anticipated more litigation in other jurisdictions.<sup>122</sup>

103. Article 12(4) of the Rules provides that, “[u]nless otherwise agreed by the parties, the expert’s report shall be admissible in any judicial or arbitral proceeding in which all of the parties thereto were parties to the expertise proceedings in which such report was prepared”. For this reason also, a full scale analysis of the substance of the case – specially the issue of possible detriment to one of the Parties<sup>123</sup> – would add nothing but nuisance to one of the Parties (as the Expert Determination may be later introduced as evidence in one of the ongoing proceedings).

104. Although it has included some discussion of the 1970/1975 Agreements in its submissions, the Objector ultimately appears to suggest that the appropriate forum to

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<sup>121</sup> See ¶¶ 23-24, *supra*.

<sup>122</sup> See ¶ 23, *supra*.

<sup>123</sup> Guidebook, Article 3.5.4 (“The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. [. . .]”)

discuss any detriment or breach of the 1970/1975 Agreements is WIPO's Arbitration and Mediation Center, as well as the courts of Germany and the UK:

Although this agreement discusses both the acceptable use of the Merck name and trademark, all considerations regarding trademark concerns are left to the LRO procedure and the parties' ongoing court litigation.<sup>124</sup>

105. The Expert is of the opinion that the community objection proceeding is not the appropriate forum to discuss the interpretation, scope or breach of the 1970/1975 Agreements.

## **VII. COSTS**

106. In accordance with Article 14(e) of the Procedure, the Centre shall refund to the prevailing party its advance payment of costs.

## **VIII. SUMMARY OF FINDINGS**

107. Within the 45 day time-limit set forth in Article 21(a) of the Procedure, the Expert concludes as follows:

- (i) the Objector lacks standing to file the Objection because it has failed to evidence an ongoing relationship with a clearly delineated community;
- (ii) the Centre shall refund to the prevailing party its advance payment of costs; and
- (iii) this Expert Determination shall be published in full.

108. For these reasons, the prevailing Party is the Respondent and thus the Objection shall be dismissed.

## **IX. DECISION**

109. For the above reasons and according to Article 21(d) of the Procedure, I hereby render the following Expert Determination:

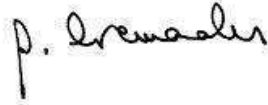
- (i) The Objection of Merck KGaA is dismissed;
- (ii) MSD Registry Holdings, Inc. prevails; and
- (iii) MSD Registry Holdings, Inc.'s advance payment of costs shall be refunded by the Centre to MSD Registry Holdings, Inc.

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<sup>124</sup> Objection, p. 7.

\* \* \*

Date: 19/November/2013

A handwritten signature in black ink, appearing to read "p. Cremades". The signature is written in a cursive style with a prominent initial "p".

Signature: \_\_\_\_\_  
Bernardo M. Cremades  
Expert

# **ANNEX 2**


**125**  
 YEARS

(/index.html)



<b>Ticker</b>	MRK												
<b>Name</b>	The company is known as Merck in the United States and Canada. Everywhere else, we are known as MSD. Merck & Co., Inc. is the legal name and is listed on the New York Stock Exchange under the symbol "MRK."												
<b>Description</b>	<p>Merck is an innovative, global healthcare leader that is committed to improving health and well-being around the world.</p> <p>Our core product categories include diabetes, cancer, vaccines and hospital acute care. We continue to focus our research on conditions that represent some of today's most significant health challenges – like cancer, hepatitis C, cardio-metabolic disease, antibiotic-resistant infection and Alzheimer's disease, and we are on the front lines in the fight against emerging global pandemics, such as ebola.</p> <p>We also devote extensive time and energy to increasing access to medicines and vaccines through far-reaching programs that donate and deliver our products to the people who need them.</p> <p>At Merck, we're applying our global reach, financial strength and scientific excellence to do more of what we're passionate about: improving health and improving lives.</p>												
<b>Employees</b>	Approximately 68,000 (as of Dec.31, 2015)												
<b>Headquarters</b>	Kenilworth, New Jersey												
<b>Businesses</b>	Pharmaceuticals Vaccines Animal Health												
<b>2015 Revenue</b>	\$39.5 billion												
<b>2014 Revenues (By Geographic Region)</b>	<table> <tr> <td>United States</td> <td>\$17.1 billion</td> </tr> <tr> <td>Europe, Middle East and Africa</td> <td>\$13.2 billion</td> </tr> <tr> <td>Asia Pacific</td> <td>\$4.0 billion</td> </tr> <tr> <td>Japan</td> <td>\$3.5 billion</td> </tr> <tr> <td>Latin America</td> <td>\$3.2 billion</td> </tr> <tr> <td>Other</td> <td>\$1.4 billion</td> </tr> </table>	United States	\$17.1 billion	Europe, Middle East and Africa	\$13.2 billion	Asia Pacific	\$4.0 billion	Japan	\$3.5 billion	Latin America	\$3.2 billion	Other	\$1.4 billion
United States	\$17.1 billion												
Europe, Middle East and Africa	\$13.2 billion												
Asia Pacific	\$4.0 billion												
Japan	\$3.5 billion												
Latin America	\$3.2 billion												
Other	\$1.4 billion												
<b>2015 R&amp;D Expense</b>	\$6.6 billion (excludes restructuring and merger related expenses)												

**Products**

Merck is a global healthcare company that delivers innovative health solutions through its prescription medicines, vaccines, biologic therapies, and animal health products. View the list of products (<http://www.merck.com/product/home.html>) marketed in the United States.

**Pipeline**

Merck has a robust pipeline, with a wide range of product candidates across each phase of development. View the pipeline (<http://www.merck.com/research/pipeline/home.html>).

**Senior Leadership**

Kenneth C. Frazier, chairman of the board, president and chief executive officer

View the list of Executive Committee members (<http://www.merck.com/about/leadership/executive-committee/home.html>).

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(<http://privacy.truste.com/privacy-seal/Merck-and-Co,-Inc-/validation?rid=7437b42b-c947-434e-b1f5-db06d0327616>)

(<http://privacy.truste.com/privacy-seal/Merck-and-Co,-Inc-/validation?rid=7437b42b-c947-434e-b1f5-db06d0327616>)



(<http://www.essentialaccessibility.com>)



(<https://www.facebook.com/MerckBeWell>)



(<https://twitter.com/merck>)



(<https://www.linkedin.com/company/merck>)

# Rankings per brand

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## Merck & Co Inc 2 variants



**GBIN** : 1232170585  
 RTB Score : 24 points in 2016  
 Website : [www.merck.com](http://www.merck.com)  
 Country of Origin : United States  
 Industry : **Pharmaceuticals & life sciences**  
 Social Media :

### Keep me posted on new Merck & Co Inc Rankings

E-mail address

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### OTHER BRANDS WITHIN THIS INDUSTRY

Rankings where listed	Year	Position
<a href="#">Best Pharma Brands</a> By Interbrand	2016	3
<a href="#">Best Global Websites</a> By Byte Level Research	2015	13
<a href="#">Fortune U.S. 500 (100)</a> By Fortune	2015	71
<a href="#">Green Rankings US (100)</a> By Newsweek	2015	86
<a href="#">The DiversityInc Top 50 Companies</a> By DiversityInc	2015	16
<a href="#">The FutureBrand Index Top 100</a> By Future Brand	2015	57
<a href="#">Top 50 Global Pharma Companies</a> By Pharmaceutical Executive	2015	5
<a href="#">World's Most Respected Companies</a> By Barron's	2015	23
<a href="#">Best Global Websites</a> By Byte Level Research	2014	21
<a href="#">Fortune U.S. 500 (100)</a> By Fortune	2014	65
<a href="#">The Access to Medicine Index</a> By The Access To Medicine Foundation	2014	7
<a href="#">The DiversityInc Top 50 Companies</a> By DiversityInc	2014	14
<a href="#">The FutureBrand Index Top 100</a> By Future Brand	2014	70
<a href="#">Top 50 Global Pharma Companies</a> By Pharmaceutical Executive	2014	5
<a href="#">World's Most Respected Companies</a> By Barron's	2014	43

### SyncForce Ranking The Brands Top 100 Positions

2016	52
2012	81

### All Merck & Co Inc brands

[Coppertone](#)

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<a href="#">Best Global Websites</a> By Byte Level Research	2013	21
<a href="#">Fortune U.S. 500 (100)</a> By Fortune	2013	58
<a href="#">The DiversityInc Top 50 Companies</a> By DiversityInc	2013	12
<a href="#">Top 50 Global Pharma Companies</a> By Pharmaceutical Executive	2013	3
<a href="#">World's Most Respected Companies</a> By Barron's	2013	41
<a href="#">Fortune U.S. 500 (100)</a> By Fortune	2012	57
<a href="#">Green Rankings US (100)</a> By Newsweek	2012	58
<a href="#">Social Media Effectiveness Index (SEI 100)</a> By Blue Ocean market intelligence	2012	13
<a href="#">The Access to Medicine Index</a> By The Access To Medicine Foundation	2012	4
<a href="#">The DiversityInc Top 50 Companies</a> By DiversityInc	2012	16
<a href="#">Top 50 Global Pharma Companies</a> By Pharmaceutical Executive	2012	3
<a href="#">World's Most Respected Companies</a> By Barron's	2012	44
<a href="#">Fortune U.S. 500 (100)</a> By Fortune	2011	53
<a href="#">The DiversityInc Top 50 Companies</a> By DiversityInc	2011	15
<a href="#">World's Most Respected Companies</a> By Barron's	2011	41
<a href="#">Fortune U.S. 500 (100)</a> By Fortune	2010	85
<a href="#">Global Reputation Pulse - U.S. Top 100</a> By Reputation Institute	2010	93
<a href="#">Green Rankings US (100)</a> By Newsweek	2010	68
<a href="#">Covalence Ethical Ranking</a> By Covalence Health Care	2009	17



Newsroom

# InterbrandHealth Releases 2016 Best Pharma Brands Report

March 30, 2016

*Pfizer and the Roche Group claim the #1 and #2  
positions  
for leading the way in redefining their value to HCPs*

NEW YORK, NY (March 30, 2016) – A global study released today by InterbrandHealth identifies the biopharma companies that are addressing healthcare professionals' (HCPs), payers', and policymakers' needs. A commitment to brand is a promise to address healthcare challenges and meet the needs of these healthcare professionals.



and illustrates the influence the corporate brand has in conveying that value. It reveals how leading companies are beginning to deliver on what matters to HCPs.

Looking to the future, healthcare professionals desire a commitment to innovative healthcare solutions that go “beyond the pill.” As a result, leading biopharma companies are adapting their business models, increasing transparency, exploring nontraditional solutions in areas like digital therapies, and ramping up their corporate citizenship activities.

“Biopharma is at a pivotal moment, and the time for change is now,” said Jane Parker, InterbrandHealth’s CEO.

Dr. Ronnie Hershman, a cardiologist affiliated with NYU Langone Long Island Cardiac Care and the CEO of HealthEffect, LLC, noted, “The biopharma industry has relied on blockbuster drugs for a long time, but healthcare is changing, and what physicians need has changed. Biopharma companies need to shift and think about what else they can offer.”

Best Pharma Brands ranks these leading companies by qualifying the industry’s definition of value through brand, then quantifying the corporate brand’s contribution to business performance. The ranking identifies the 10 most



brand value. Pfizer and the Roche Group secure the #1 and #2 positions on the ranking.

### **Best Pharma Brands Ranking**

*\*The ranking and brand value for each organization is outlined below*

#1 Pfizer (USD \$19.985 billion)

#2 Roche Group (USD \$15.479 billion)

#3 Merck & Co., Inc., Kenilworth, N.J., U.S.A. (USD \$13.880 billion) [Note: MSD outside of the United States & Canada]

#4 Janssen: Pharmaceutical Companies of Johnson & Johnson (USD \$13.866 billion)

#5 Novartis (USD \$13.496 billion)

#6 Amgen (USD \$13.461 billion)

#7 Gilead Sciences (USD \$13.361 billion)

#8 Novo Nordisk (USD \$10.206 billion)

#9 AstraZeneca (USD \$8.123 billion)

#10 GSK (USD \$6.778 billion)

Best Pharma Brands also sets an important industry benchmark by highlighting the need for biopharma companies to change how they interact with the market and meet the needs of the



Parker commented that “these 10 biopharma brands are embracing a strategy that is somewhat new to the health and life sciences sector: they are effectively leveraging their corporate brands and, in doing so, they are growing their businesses, fueling innovation, and developing meaningful solutions for patients on a global scale.”

Best Pharma Brands is powered by global research data, feedback from HCPs, and data-driven insights. The underlying methodology mirrors Interbrand’s Best Global Brands, which demonstrates that strong brands can withstand market volatility and are more likely to outperform key financial indices like the S&P 500.

To be considered, biopharma brands must have a global presence, generate revenue from the sale of prescription medicines, report the ratio of revenues generated from sales of prescription medicines, possess a strong pipeline of potential future prescription medicines, have awareness among HCPs, and serve as the primary external-facing manufacturer brand.

Please visit [BestPharmaBrands.com](http://BestPharmaBrands.com) to request a download of the report. To join the conversation on social media, use the hashtag #BestPharmaBrands.

### **About Best Pharma Brands**

Best Pharma Brands is InterbrandHealth’s inaugural



biopharma industry.

Best Pharma Brands is powered by Interbrand's International Organization for Standardization (ISO)–certified Brand Valuation methodology, which quantifies the measurable financial impact that a company's brand has on its overall business performance.

Best Pharma Brands reflects HCPs' current perceptions of brand value, measured through a global online survey. The report focuses on the prescription portion of a biopharma company's total revenue. Other revenue sources, including consumer health, over-the-counter products, medical device sales, diagnostics, and animal health are excluded from the analysis.

In addition to the ranking and supporting commentary, the report examines industry trends and provides data-driven insights on topics such as the impact of the corporate brand in an adoption decision, mergers and acquisitions, and corporate citizenship. The report clearly outlines how corporate brand, when leveraged, can generate significant value for a business. It sets an important industry benchmark and highlights the potential for future change.



## About InterbrandHealth

InterbrandHealth is the only full-service branding consultancy with an exclusive focus on health, and the global center of excellence for all health business at Interbrand. For more than 35 years, InterbrandHealth has combined strategy, creativity, and analytical rigor to help companies grow and achieve leadership positions in their industries. As the leader in brand valuation and the publisher of the annual Best Global Brands report, Interbrand has pioneered the idea that brands have a tangible value as business assets. As part of Interbrand and the Omnicom Group Inc. (NYSE: OMC), InterbrandHealth provides service and support in all key global markets. For more information, please visit us at [InterbrandHealth.com](http://InterbrandHealth.com) and follow us on Twitter, LinkedIn, and Facebook.

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# Brand Rankings



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## The Ranking the Brands Top 100

BY CATEGORY

BY INDUSTRY

All Categories (294)

Advertising (3)

Brand Performance (68)

Brand Popularity (64)

Brand Sustainability (14)

Brand Value (62)

Customer Satisfaction (27)

Human Resources (17)

Social Media (39)

## Top 50 Global Pharma Companies | 2015

By: [Pharmaceutical Executive](#)

























Annual ranking published by Pharmaceutical Executive. The Top Global Pharma Companies ranking is based on sales in the previous year.

2015

Category: [Brand Performance](#)  
 Region: Global  
 Ranking Type: positive

	Logo	Name	Last	SyncForce Customer
1		<a href="#">Novartis</a>	1	
2		<a href="#">Pfizer</a>	2	
3		<a href="#">Roche</a>	3	
4		<a href="#">Sanofi</a>	4	
5		<a href="#">Merck &amp; Co Inc</a>	5	
6		<a href="#">Johnson and Johnson</a>	7	
7		<a href="#">GSK</a>	6	
8		<a href="#">AstraZeneca</a>	8	
9		<a href="#">Gilead Sciences</a>	18	
10		<a href="#">AbbVie</a>	10	
11		<a href="#">Amgen</a>	11	
12		<a href="#">Teva Pharmaceutical Industries</a>	12	



13	 Bayer	<a href="#">Bayer</a>	13	
14	 Lilly	<a href="#">Eli Lilly</a>	9	
15	 Novo Nordisk	<a href="#">Novo Nordisk</a>	14	
16	 Boehringer Ingelheim	<a href="#">Boehringer Ingelheim</a>	15	
17	 Takeda	<a href="#">Takeda</a>	16	
18	 Bristol-Myers Squibb	<a href="#">Bristol-Myers Squibb</a>	17	
19	 Actavis	<a href="#">Actavis</a>	24	
20	 Astellas Leading Light for Life	<a href="#">Astellas Pharma</a>	19	
21	 Baxter	<a href="#">Baxter International</a>	22	
22	 Biogen	<a href="#">Biogen Idec</a>	27	
23	 MERCK	<a href="#">Merck KGaA</a>	23	
24	 Mylan	<a href="#">Mylan</a>	25	
25	 Daiichi Sankyo	<a href="#">Daiichi Sankyo</a>	20	
26	 Celgene	<a href="#">Celgene</a>	26	
27	 Otsuka	<a href="#">Otsuka Holdings</a>	21	
28	 ALLERGAN	<a href="#">Allergan</a>	28	
29	 SERVIER	<a href="#">Les Laboratoires Servier</a>	29	
30	 Shire	<a href="#">Shire</a>	32	
31	 Abbott A Promise for Life	<a href="#">Abbott</a>	30	
32	 SUN Pharmaceuticals	<a href="#">Sun Pharma Industries</a>	48	
33	 VALEANT Pharmaceuticals International	<a href="#">Valeant Pharmaceuticals International</a>	34	
34	 CSL	<a href="#">CSL</a>	31	

35		<a href="#">Eisai Co</a>	33
36		<a href="#">UCB</a>	35
37		<a href="#">Fresenius</a>	37
38		<a href="#">Chugai Pharmaceutical</a>	36
39		<a href="#">Menarini</a>	40
40		<a href="#">Grifols</a>	42
41		<a href="#">Aspen Pharmacare Holdings</a>	44
42		<a href="#">Hospira</a>	43
43		<a href="#">Dainippon Sumitomo Pharma</a>	41
44		<a href="#">Mitsubishi Tanabe Pharma</a>	38
45		<a href="#">STADA Arzneimittel</a>	46
46		<a href="#">Mallinckrodt Pharmaceuticals</a>	-
47		<a href="#">Endo Health Pharmaceuticals</a>	-
48		<a href="#">Alexion Pharmaceuticals</a>	-
49		<a href="#">Lundbeck</a>	45
50		<a href="#">Kyowa Hakko Kirin</a>	47



Data by  
**GlobalData**»

## Top 25 pharma companies by global sales

The rankings of the top 25 pharmaceutical companies have been compiled from GlobalData's pharmaceutical revenue figures, which are based on sales of prescription medicines, including generics drugs. The rankings include figures for 2014, 2013, 2012 and 2011.

For ease of comparison the 2012 and 2011 rankings are also displayed in the [Top Pharma List 2012 infographic](#), which also features information on the top pharmaceutical companies in the US and Japan.

**2014    2013    2012**

#	Company	2014 (\$m)	2013 (\$m)	Growth (\$m)	Growth (%)
1	<a href="#">Novartis</a>	47101	47468	-367	-1
2	<a href="#">Pfizer</a>	45708	47878	-2170	-5
3	<a href="#">Roche</a>	39120	39163	-43	0
4	<a href="#">Sanofi</a>	36437	37124	-687	-2
5	<a href="#">Merck &amp; Co.</a>	36042	37437	-1395	-4
6	<a href="#">Johnson &amp; Johnson</a>	32313	28125	4188	15
7	<a href="#">GlaxoSmithKline</a>	29580	33330	-3750	-11
8	<a href="#">AstraZeneca</a>	26095	25711	384	1
9	<a href="#">Gilead Sciences</a>	24474	10804	13670	127
10	<a href="#">Takeda</a>	20446	19158	1288	7
11	<a href="#">AbbVie</a>	20207	18790	1417	8
12	<a href="#">Amgen</a>	19327	18192	1135	6
13	<a href="#">Teva</a>	18374	18308	66	0
14	<a href="#">Lilly</a>	17266	20962	-3696	-18
15	<a href="#">Bristol-Myers Squibb</a>	15879	16385	-506	-3
16	<a href="#">Bayer</a>	15486	14854	632	4
17	<a href="#">Novo Nordisk</a>	15329	14877	452	3
18	<a href="#">Astellas</a>	14099	13508	591	4
19	<a href="#">Boehringer Ingelheim</a>	13830	15789	-1959	-12
20	<a href="#">Actavis</a>	13062	8678	4384	51
21	<a href="#">Otsuka</a>	11308	11226	82	1
22	<a href="#">Daiichi Sankyo</a>	10430	12067	-1637	-14
23	<a href="#">Biogen Idec</a>	9398	6668	2730	41
24	<a href="#">Baxter</a>	8831	8347	484	6
25	<a href="#">Merck KGaA</a>	7678	8399	-721	-9

Note: The 2013 ranking uses 2013 exchange rates for both its 2013 and 2012 values, to remove the effect of currency fluctuations. The 2012 ranking similarly uses 2012 exchange rates. Baxter's pharma 2013 revenues take account of its restructured reporting style under newly-named business units.

**GlobalData**» Data by GlobalData

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medical device industries. With the combined expertise of more than 600 researchers, market analysts and consultants, we deliver high-quality, accurate and transparent industry insight that helps our clients to achieve growth and increase business value.

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# **ANNEX 3**

Mark	Country	Status
MERCK SHARP & DOHME AND DESIGN	Afghanistan	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Afghanistan	Registered
MERCK SHARP & DOHME AND DESIGN	Albania	Registered
MERCK SHARP & DOHME AND DESIGN	Algeria	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Algeria	Registered
MERCK SHARP & DOHME AND DESIGN	Angola	Registered
MERCK SHARP & DOHME AND DESIGN	Angola	Registered
MERCK SHARP & DOHME AND DESIGN	Angola	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Angola	Registered
MERCK SHARP & DOHME AND DESIGN	Argentina	Registered
MERCK SHARP & DOHME AND DESIGN	Argentina	Registered
MERCK SHARP & DOHME AND DESIGN	Argentina	Registered
MSD MERCK SHARP & DOHME NOROXIN	Argentina	Registered
MERCK SHARP & DOHME AND DESIGN	Armenia	Registered
MERCK SHARP & DOHME AND DESIGN	Australia	Registered
MERCK SHARP & DOHME AND DESIGN	Australia	Registered
MERCK SHARP & DOHME AND DESIGN	Australia	Registered
MERCK SHARP & DOHME CME LOGO	Australia	Registered
MERCK SHARP & DOHME AND DESIGN	Austria	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Austria	Registered
MERCK SHARP & DOHME AND DESIGN	Azerbaijan	Registered
MERCK SHARP & DOHME AND DESIGN	Bahrain	Registered
MERCK SHARP & DOHME	Bangladesh	Registered
MERCK SHARP & DOHME AND DESIGN	Bangladesh	Registered
MERCK SHARP & DOHME AND DESIGN	Bangladesh	Registered
MERCK SHARP & DOHME AND DESIGN	Bangladesh	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Bangladesh	Registered
MERCK SHARP & DOHME	Barbados	Filed
MERCK SHARP & DOHME AND DESIGN	Barbados	Registered
MERCK SHARP & DOHME AND DESIGN	Barbados	Registered
MERCK SHARP & DOHME AND DESIGN	Barbados	Registered
MERCK SHARP & DOHME AND DESIGN	Belarus	Registered
MERCK SHARP & DOHME AND DESIGN	Benelux	Registered
MSD MERCK SHARP & DOHME BV	Benelux	Registered
MSD MERCK SHARP & DOHME HEART LOGO	Benelux	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Benelux	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Benelux	Registered
MERCK SHARP & DOHME AND DESIGN	Bermuda	Registered
MERCK SHARP & DOHME AND DESIGN	Bermuda	Registered
MERCK SHARP & DOHME AND DESIGN	Bermuda	Registered
MERCK SHARP & DOHME AND DESIGN	Bolivia	Registered
MERCK SHARP & DOHME AND DESIGN	Bolivia	Registered
MERCK SHARP & DOHME AND DESIGN	Bolivia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Bolivia	Registered
	Bosnia-	
MERCK SHARP & DOHME AND DESIGN	Herzegovina	Registered
MERCK SHARP & DOHME AND DESIGN	Botswana	Registered
MERCK SHARP & DOHME AND DESIGN	Botswana	Registered
MERCK SHARP & DOHME AND DESIGN	Botswana	Registered
MERCK SHARP & DOHME AND DESIGN	Brazil	Registered

Mark	Country	Status
MERCK SHARP & DOHME AND DESIGN	Brazil	Registered
MERCK SHARP & DOHME AND DESIGN	Brazil	Registered
MERCK SHARP & DOHME AND DESIGN	Brazil	Registered
MERCK SHARP & DOHME AND DESIGN	Brazil	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Brazil	Registered
MERCK SHARP & DOHME AND DESIGN	Bulgaria	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Bulgaria	Registered
MERCK	Canada	Registered
MERCK FROSST ONCALL	Canada	Registered
MERCKCOLLOQUE E-MEETING.YOUR NEEDS. DESIGN	Canada	Registered
MERCK SHARP & DOHME AND DESIGN	Caribbean	Registered
MERCK SHARP & DOHME AND DESIGN	Netherlands	Registered
MERCK SHARP & DOHME AND DESIGN	Chile	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Chile	Registered
MERCK SHARP & DOHME AND DESIGN	China P.R.	Registered
MERCK SHARP & DOHME AND DESIGN	China P.R.	Registered
MERCK SHARP & DOHME AND DESIGN	China P.R.	Registered
MERCK SHARP & DOHME AND DESIGN IN CHINESE	China P.R.	Registered
MERCK SHARP & DOHME AND DESIGN IN CHINESE	China P.R.	Registered
MERCK SHARP & DOHME AND DESIGN IN CHINESE	China P.R.	Registered
MERCK SHARP & DOHME IN CHINESE	China P.R.	Registered
MERCK SHARP & DOHME IN CHINESE	China P.R.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	China P.R.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	China P.R.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	China P.R.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM IN CHINESE	China P.R.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM IN CHINESE	China P.R.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM IN CHINESE	China P.R.	Registered
MERCK SHARP & DOHME AND DESIGN	Colombia	Registered
MERCK SHARP & DOHME AND DESIGN	Colombia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Colombia	Registered
MERCK SHARP & DOHME AND DESIGN	Costa Rica	Registered
MERCK SHARP & DOHME AND DESIGN	Costa Rica	Registered
MERCK SHARP & DOHME AND DESIGN	Costa Rica	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Costa Rica	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Costa Rica	Registered
MERCK SHARP & DOHME AND DESIGN	Croatia	Registered
MERCK SHARP & DOHME	Cuba	Registered
THE MERCK INDEX	Cuba	Registered
THE MERCK MANUAL	Cuba	Registered
MERCK SHARP & DOHME AND DESIGN	Curacao	Registered

Mark	Country	Status
MERCK SHARP & DOHME AND DESIGN	Cyprus	Registered
MERCK SHARP & DOHME AND DESIGN	Cyprus	Registered
MERCK SHARP & DOHME AND DESIGN	Cyprus	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Cyprus	Registered
MERCK SHARP & DOHME AND DESIGN	Czech Republic	Registered
MERCK SHARP & DOHME AND DESIGN	Democratic Republic of Congo	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Democratic Republic of Congo	Registered
MERCK SHARP & DOHME AND DESIGN	Denmark	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Denmark	Registered
MERCK SHARP & DOHME AND DESIGN	Dominican Republic	Registered
MERCK SHARP & DOHME AND DESIGN	Dominican Republic	Registered
MERCK SHARP & DOHME AND DESIGN	Dominican Republic	Registered
MERCK SHARP & DOHME AND DESIGN	Ecuador	Registered
MERCK SHARP & DOHME AND DESIGN	Ecuador	Registered
MERCK SHARP & DOHME AND DESIGN	Ecuador	Registered
MERCK SHARP & DOHME AND DESIGN	Egypt	Registered
MERCK SHARP & DOHME AND DESIGN	Egypt	Registered
MERCK SHARP & DOHME AND DESIGN	Egypt	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Egypt	Registered
TRIVOLVE MERCK & CO. INC.	Egypt	Filed
MERCK SHARP & DOHME AND DESIGN	El Salvador	Registered
MERCK SHARP & DOHME AND DESIGN	El Salvador	Registered
MERCK SHARP & DOHME AND DESIGN	El Salvador	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	El Salvador	Registered
MERCK SHARP & DOHME AND DESIGN	Estonia	Registered
MERCK SHARP & DOHME AND DESIGN	Ethiopia	Registered
MERCK SHARP & DOHME AND DESIGN	Finland	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Finland	Registered
MERCK SHARP & DOHME	France	Registered
MERCK SHARP & DOHME AND DESIGN	France	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	France	Registered
MERCK SHARP & DOHME AND DESIGN	Georgia	Registered
MERCK SHARP & DOHME AND DESIGN	Ghana	Registered
MERCK SHARP & DOHME AND DESIGN	Ghana	Registered
MERCK SHARP & DOHME AND DESIGN	Ghana	Filed
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Ghana	Filed
MERCK SHARP & DOHME AND DESIGN	Great Britain	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Great Britain	Registered



Mark	Country	Status
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Great Britain	Registered
MERCK SHARP & DOHME AND DESIGN	Greece	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Greece	Registered
MERCK SHARP & DOHME AND DESIGN	Guatemala	Filed
MERCK SHARP & DOHME AND DESIGN	Guatemala	Registered
MERCK SHARP & DOHME AND DESIGN	Guatemala	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Guatemala	Registered
MERCK SHARP & DOHME AND DESIGN	Haiti	Registered
MERCK SHARP & DOHME AND DESIGN	Haiti	Registered
MERCK SHARP & DOHME AND DESIGN	Haiti	Registered
MERCK SHARP & DOHME AND DESIGN	Honduras	Registered
MERCK SHARP & DOHME AND DESIGN	Honduras	Registered
MERCK SHARP & DOHME AND DESIGN	Honduras	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Honduras	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Honduras	Registered
MERCK SHARP & DOHME AND DESIGN	Hong Kong	Registered
MERCK SHARP & DOHME AND DESIGN	Hong Kong	Registered
MERCK SHARP & DOHME AND DESIGN	Hong Kong	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Hong Kong	Registered
MERCK SHARP & DOHME AND DESIGN	Hungary	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Hungary	Registered
MERCK SHARP & DOHME AND DESIGN	Iceland	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Iceland	Registered
MERCK SHARP & DOHME	India	Registered
MERCK SHARP & DOHME AND DESIGN	India	Registered
MERCK SHARP & DOHME AND DESIGN	India	Registered
MERCK SHARP & DOHME AND DESIGN	India	Registered
MERCK SHARP & DOHME AND DESIGN	Indonesia	Registered
MERCK SHARP & DOHME AND DESIGN	Indonesia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	International Registration	Registered
MERCK SHARP & DOHME AND DESIGN	Iran	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Iran	Registered
MERCK SHARP & DOHME	Iraq	Filed
MERCK SHARP & DOHME AND DESIGN	Ireland	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Ireland	Registered
MERCK SHARP & DOHME AND DESIGN	Israel	Registered
MERCK SHARP & DOHME AND DESIGN	Israel	Registered
MERCK SHARP & DOHME AND DESIGN	Israel	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Israel	Registered
MERCK SHARP & DOHME AND DESIGN	Italy	Registered
MERCK SHARP & DOHME AND DESIGN	Jamaica	Registered
MERCK SHARP & DOHME AND DESIGN	Jamaica	Registered
MERCK SHARP & DOHME AND DESIGN	Jamaica	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Jamaica	Registered
MERCK SHARP & DOHME	Japan	Registered

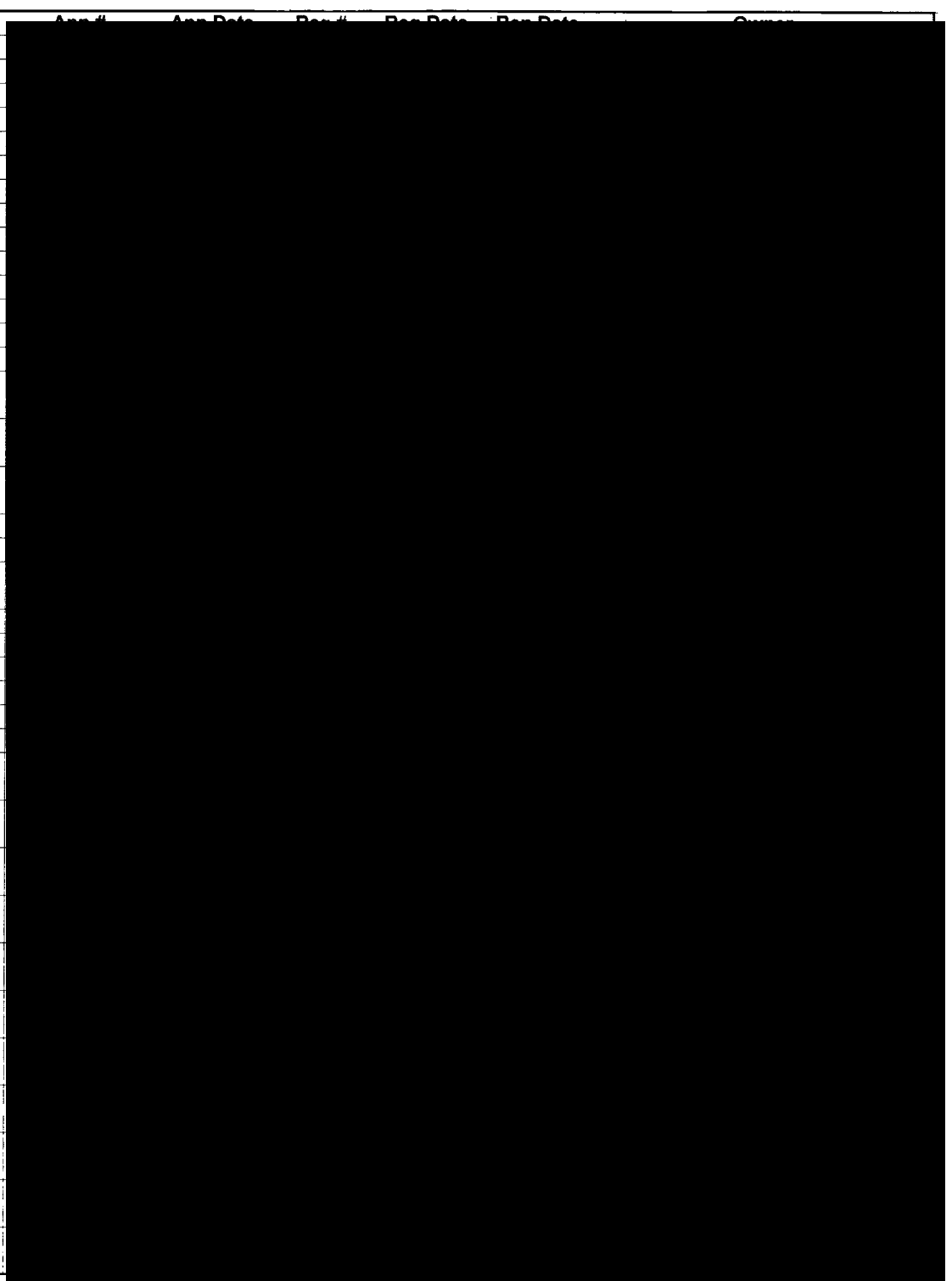
Mark	Country	Status
MERCK SHARP & DOHME	Japan	Registered
MERCK SHARP & DOHME	Japan	Registered
MERCK SHARP & DOHME AND DESIGN	Japan	Registered
MERCK SHARP & DOHME AND DESIGN	Japan	Registered
MERCK SHARP & DOHME AND DESIGN	Japan	Registered
MERCK SHARP & DOHME AND DESIGN IN KATAKANA	Japan	Registered
MERCK SHARP & DOHME IN KATAKANA	Japan	Registered
MERCK SHARP & DOHME IN KATAKANA	Japan	Registered
MERCK SHARP & DOHME IN KATAKANA	Japan	Registered
MERCK SHARP & DOHME IN KATAKANA [AMPERSAND IS IN KATAKANA]	Japan	Registered
MERCK SHARP & DOHME JAPAN	Japan	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Japan	Registered
MERCK SHARP & DOHME AND DESIGN	Jordan	Registered
MERCK SHARP & DOHME AND DESIGN	Jordan	Registered
MERCK SHARP & DOHME AND DESIGN	Jordan	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Jordan	Registered
MERCK SHARP & DOHME AND DESIGN	Kazakhstan	Registered
MERCK SHARP & DOHME AND DESIGN	Kenya	Registered
MERCK SHARP & DOHME AND DESIGN	Kenya	Registered
MERCK SHARP & DOHME AND DESIGN	Kenya	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Kenya	Registered
MERCK SHARP & DOHME AND DESIGN	Korea South	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Korea South	Registered
MERCK SHARP & DOHME AND DESIGN	Kosovo	Registered
MERCK SHARP & DOHME AND DESIGN	Kuwait	Registered
MERCK SHARP & DOHME AND DESIGN	Kuwait	Registered
MERCK SHARP & DOHME AND DESIGN	Kuwait	Registered
MERCK SHARP & DOHME AND DESIGN	Kyrgyzstan	Registered
MERCK SHARP & DOHME AND DESIGN	Laos	Registered
MERCK SHARP & DOHME AND DESIGN	Lebanon	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Lebanon	Registered
MERCK SHARP & DOHME AND DESIGN	Lesotho	Registered
MERCK SHARP & DOHME AND DESIGN	Liberia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Liberia	Registered
MERCK SHARP & DOHME	Libya	Filed
MERCK SHARP & DOHME	Libya	Filed
MERCK SHARP & DOHME	Libya	Filed
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Libya	Filed
MERCK SHARP & DOHME AND DESIGN	Lithuania	Registered
MERCK SHARP & DOHME AND DESIGN	Macao	Registered
MERCK SHARP & DOHME AND DESIGN	Macao	Registered
MERCK SHARP & DOHME AND DESIGN	Macao	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Macao	Registered
MERCK SHARP & DOHME AND DESIGN	Macedonia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Macedonia	Registered
MERCK SHARP & DOHME	Madagascar	Registered
MERCK SHARP & DOHME AND DESIGN	Malawi	Registered

Mark	Country	Status
MERCK SHARP & DOHME AND DESIGN	Malawi	Registered
MERCK SHARP & DOHME AND DESIGN	Malawi	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Malawi	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Malaya	Registered
MERCK SHARP & DOHME AND DESIGN	Malaysia	Registered
MERCK SHARP & DOHME AND DESIGN	Malaysia	Registered
MERCK SHARP & DOHME AND DESIGN	Malaysia	Registered
MERCK SHARP & DOHME AND DESIGN	Malta	Registered
MERCK SHARP & DOHME AND DESIGN	Malta	Registered
MERCK SHARP & DOHME AND DESIGN	Malta	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Malta	Registered
MERCK SHARP & DOHME AND DESIGN	Mauritius	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Mauritius	Registered
MERCK SHARP & DOHME AND DESIGN	Mexico	Registered
MERCK SHARP & DOHME AND DESIGN	Mexico	Registered
MERCK SHARP & DOHME AND DESIGN	Mexico	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Mexico	Registered
MERCK SHARP & DOHME AND DESIGN	Moldova	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Monaco	Registered
MERCK SHARP & DOHME	Mongolia	Registered
MERCK SHARP & DOHME AND DESIGN	Montenegro	Registered
MERCK SHARP & DOHME AND DESIGN	Morocco	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Morocco	Registered
MERCK SHARP & DOHME	Mozambique	Registered
MERCK SHARP & DOHME AND DESIGN	Myanmar	Registered
MERCK SHARP & DOHME AND DESIGN	Namibia	Registered
MERCK SHARP & DOHME AND DESIGN	Namibia	Registered
MERCK SHARP & DOHME AND DESIGN	Namibia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Namibia	Registered
MERCK SHARP & DOHME AND DESIGN	Nepal	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Nepal	Registered
MERCK SHARP & DOHME AND DESIGN	New Zealand	Registered
MERCK SHARP & DOHME AND DESIGN	New Zealand	Registered
MERCK SHARP & DOHME AND DESIGN	Nicaragua	Registered
MERCK SHARP & DOHME AND DESIGN	Nicaragua	Registered
MERCK SHARP & DOHME AND DESIGN	Nicaragua	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Nicaragua	Registered
MERCK SHARP & DOHME	Nigeria	Filed
MERCK SHARP & DOHME AND DESIGN	Nigeria	Registered
MERCK SHARP & DOHME AND DESIGN	Nigeria	Registered
MERCK SHARP & DOHME AND DESIGN	Nigeria	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Nigeria	Registered
MERCK SHARP & DOHME AND DESIGN	Norway	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Norway	Registered
MERCK SHARP & DOHME AND DESIGN	O.A.P.I.	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	O.A.P.I.	Registered
MERCK SHARP & DOHME	Pakistan	Registered

Mark	Country	Status	App #	App Date	Reg #	Reg Date	Ren Date	Owner
MERCK SHARP & DOHME AND DESIGN	Pakistan	Registered						
MERCK SHARP & DOHME AND DESIGN	Pakistan	Registered						
MERCK SHARP & DOHME AND DESIGN	Pakistan	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Pakistan	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Panama	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Papua New Guinea	Registered						
MERCK SHARP & DOHME AND DESIGN	Paraguay	Registered						
MERCK SHARP & DOHME AND DESIGN	Paraguay	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Paraguay	Registered						
MERCK SHARP & DOHME	Peru	Registered						
MERCK SHARP & DOHME AND DESIGN	Peru	Registered						
MERCK SHARP & DOHME AND DESIGN	Peru	Registered						
MERCK SHARP & DOHME AND DESIGN	Peru	Registered						
MERCK SHARP & DOHME AND DESIGN WITH WORD CONTIGO	Peru	Registered						
MERCK SHARP & DOHME AND DESIGN	Poland	Registered						
MANUAL MERCK	Portugal	Filed						
MERCK SHARP & DOHME AND DESIGN	Portugal	Registered						
MERCK SHARP & DOHME AND DESIGN	Portugal	Registered						
MERCK SHARP & DOHME AND DESIGN	Portugal	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Portugal	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Portugal	Registered						
MERCK & CO. INC.	Puerto Rico	Registered						
MERCK SHARP & DOHME AND DESIGN WITH ARABIC	Qatar	Registered						
MERCK SHARP & DOHME AND DESIGN WITH ARABIC	Qatar	Registered						
MERCK SHARP & DOHME AND DESIGN WITH ARABIC	Qatar	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM WITH ARABIC	Qatar	Registered						
MERCK SHARP & DOHME AND DESIGN	Romania	Registered						
MERCK SHARP & DOHME AND DESIGN	Russian Federation	Registered						
MERCK SHARP & DOHME IDEA, INC.	Russian Federation	Registered						
MERCK SHARP & DOHME IDEA, INC. IN CYRILLIC	Russian Federation	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Samoa	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Sarawak	Registered						
MERCK SHARP & DOHME AND DESIGN	Saudi Arabia	Registered						
MERCK SHARP & DOHME AND DESIGN	Saudi Arabia	Registered						
MERCK SHARP & DOHME AND DESIGN	Saudi Arabia	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Saudi Arabia	Registered						
MERCK SHARP & DOHME AND DESIGN	Serbia	Registered						
MERCK SHARP & DOHME	Seychelles Island	Registered						
MERCK SHARP & DOHME AND DESIGN	Sierra Leone	Registered						
MERCK SHARP & DOHME AND DESIGN	Sierra Leone	Registered						

Mark	Country	Status
MERCK SHARP & DOHME AND DESIGN	Sierra Leone	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Sierra Leone	Registered
MERCK SHARP & DOHME AND DESIGN	Singapore	Registered
MERCK SHARP & DOHME AND DESIGN	Singapore	Registered
MERCK SHARP & DOHME AND DESIGN	Singapore	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Singapore	Registered
MERCK SHARP & DOHME AND DESIGN	Sint Maarten	Registered
MERCK SHARP & DOHME AND DESIGN	Slovak Republic	Registered
MERCK SHARP & DOHME AND DESIGN	Slovenia	Registered
MERCK SHARP & DOHME	South Africa	Registered
MERCK SHARP & DOHME AND DESIGN	South Africa	Registered
MERCK SHARP & DOHME AND DESIGN	South Africa	Registered
MERCK SHARP & DOHME AND DESIGN	South Africa	Registered
MSD MERCK SHARP & DOHME	South Africa	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	South Africa	Registered
INDOFTOL MERCK & CO., INC.	Spain	Registered
MERCK SHARP & DOHME AND DESIGN	Spain	Registered
MERCK SHARP & DOHME DE ESPANA, S.A.E.	Spain	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Spain	Registered
MERCK SHARP & DOHME AND DESIGN	Sri Lanka	Registered
MERCK SHARP & DOHME AND DESIGN	Sri Lanka	Registered
MERCK SHARP & DOHME AND DESIGN	Sudan	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Sudan	Registered
MERCK SHARP & DOHME AND DESIGN	Suriname	Registered
MERCK SHARP & DOHME AND DESIGN	Swaziland	Registered
MERCK SHARP & DOHME AND DESIGN	Swaziland	Registered
MERCK SHARP & DOHME AND DESIGN	Sweden	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Sweden	Registered
MERCK SHARP & DOHME AND DESIGN	Switzerland	Registered
MERCK SHARP & DOHME AND DESIGN	Syria	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Syria	Registered
MERCK & CO., INC. IN CHINESE	Taiwan	Registered
MERCK IN CHINESE	Taiwan	Registered
MERCK SHARP & DOHME AND DESIGN	Taiwan	Registered
MERCK SHARP & DOHME AND DESIGN	Taiwan	Registered
MERCK SHARP & DOHME INTERNATIONAL IN CHINESE	Taiwan	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Taiwan	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM IN CHINESE	Taiwan	Registered
MERCK SHARP & DOHME AND DESIGN	Tajikistan	Registered
MSD MERCK SHARP & DOHME	Tajikistan	Registered

Mark	Country	Status
MERCK SHARP & DOHME AND DESIGN	Tanganyika	Registered
MERCK SHARP & DOHME AND DESIGN	Tanganyika	Registered
MERCK SHARP & DOHME AND DESIGN	Tanganyika	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Tanganyika	Registered
MERCK SHARP & DOHME AND DESIGN	Tangier	Registered
MERCK SHARP & DOHME	Thailand	Registered
MERCK SHARP & DOHME AND DESIGN	Thailand	Registered
MERCK SHARP & DOHME AND DESIGN	Thailand	Registered
MERCK SHARP & DOHME AND DESIGN	Thailand	Registered
MERCK SHARP & DOHME IN THAI	Thailand	Registered
MERCK SHARP & DOHME AND DESIGN	Trinidad	Registered
MERCK SHARP & DOHME AND DESIGN	Trinidad	Registered
MERCK SHARP & DOHME AND DESIGN	Trinidad	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Trinidad	Registered
MERCK SHARP & DOHME AND DESIGN	Tunisia	Registered
MSD MERCK SHARP & DOHME CHIBRET IN SPECIAL FORM	Tunisia	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Tunisia	Registered
MERCK SHARP & DOHME AND DESIGN	Turkey	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Turkey	Registered
MERCK SHARP & DOHME AND DESIGN	Turkmenistan	Registered
MERCK SHARP & DOHME AND DESIGN	Uganda	Registered
MERCK SHARP & DOHME AND DESIGN	Uganda	Registered
MERCK SHARP & DOHME AND DESIGN	Uganda	Registered
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Uganda	Registered
MERCK SHARP & DOHME AND DESIGN	Ukraine	Registered
MERCK SHARP & DOHME AND DESIGN IN CYRILLIC	Ukraine	Registered
MERCK SHARP & DOHME	United Arab Emirates	Registered
MERCK	United States	Registered
MERCK	United States	Registered
MERCK	United States	Filed
MERCK ACADEMY	United States	Registered
MERCK ACADEMY LOGO	United States	Registered
MERCK BE WELL. AND DESIGN	United States	Registered
MERCK COMPANY FOUNDATION AND DESIGN	United States	Registered
MERCK HAS HEART AND DESIGN	United States	Filed
MERCK ONCALL	United States	Registered
MERCKENGAGE	United States	Registered



Mark	Country	Status	App #	App Date	Reg #	Reg Date	Ren Date	Owner
MERCKMSD	United States	Filed						
MERCKSOURCE	United States	Registered						
MERCKVACCINES.COM	United States	Registered						
THE MERCK INDEX	United States	Registered						
THE MERCK MANUAL	United States	Registered						
THE MERCK MANUAL OF GERIATRICS	United States	Registered						
THE MERCK VETERINARY MANUAL	United States	Registered						
MERCK SHARP & DOHME AND DESIGN	Uruguay	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Uruguay	Registered						
MERCK SHARP & DOHME AND DESIGN	Uzbekistan	Registered						
MERCK SHARP & DOHME AND DESIGN	Venezuela	Registered						
MERCK SHARP & DOHME AND DESIGN	Venezuela	Registered						
MERCK SHARP & DOHME AND DESIGN	Venezuela	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Venezuela	Registered						
MERCK SHARP & DOHME AND DESIGN	Vietnam	Registered						
MERCK SHARP & DOHME	Yemeni Republic	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Yemeni Republic	Registered						
MERCK SHARP & DOHME AND DESIGN	Zambia	Registered						
MERCK SHARP & DOHME AND DESIGN	Zambia	Registered						
MERCK SHARP & DOHME AND DESIGN	Zambia	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Zambia	Registered						
MERCK SHARP & DOHME AND DESIGN	Zanzibar	Registered						
MERCK SHARP & DOHME AND DESIGN	Zanzibar	Registered						
MERCK SHARP & DOHME AND DESIGN	Zanzibar	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Zanzibar	Registered						
MERCK SHARP & DOHME AND DESIGN	Zimbabwe	Registered						
MERCK SHARP & DOHME AND DESIGN	Zimbabwe	Registered						
MERCK SHARP & DOHME AND DESIGN	Zimbabwe	Registered						
MSD MERCK SHARP & DOHME IN SPECIAL FORM	Zimbabwe	Registered						

Int. Cl.: 5

Prior U.S. Cl.: 6

United States Patent and Trademark Office  
10 Year Renewal

Reg. No. 108,566  
Registered Feb. 15, 1916  
Renewal Term Begins Feb. 15, 1996

TRADEMARK  
PRINCIPAL REGISTER

# MERCK

MERCK & CO., INC. (NEW JERSEY CORPORATION)  
ONE MERCK DRIVE  
WHITEHOUSE STATION, NJ 08889, ASSIGNEE OF MERCK & CO. (NEW YORK CORPORATION) NEW YORK, NY

OWNER OF U.S. REG. NO. 79,845.

FOR: [ALTERATIVES,] ANALGESICS, [ANAPHRODISIACS, ANESTHETICS, ANODYNES,] ANTACIDS, ANTHELMINTICS, [ANTICHLOROTICS, ANTIEMETICS, ANTIPILEPTICS, ANTI-GALACTAGOGUES,] ANTIAGONORRHEICS, [ANTIHIDROTICS, ANTLITHICS, ANTI-NEURALGICS,] ANTIPARASITICS, [ANTIPERIODICS, ANTIPLHLOGISTICS,] ANTIPIRETTICS, ANTIRHEUMATICS, [ANTISIALAGOGUES, ANTISPASMODICS, ANTISYMYOTICS APERIENTS APHRODISIACS, ASTRINGENTS, CARDIAC SEDATIVES, CARDIAC STIMULANTS, CARMINATIVES, CATHARTICS] CEREBRAL DEPRESSANTS AND STIMULANTS, [CHOLAGOGUES, CON-

STRUCTIVES,] COUNTER-IRRITANTS, [DEMULCENTS, DEOXIDIZERS, DEODORANTS, DEPIILATORIES,] DEPRESSANTS, [DIAPHORETICS, DIGESTIVES, DISCUTIENS,] DIURETICS, [ECHOLICS, EMETICS, EMMENAGOGUES, ERRHINES, ESCHAROTICS, EXPECTORANTS, GALACTAGOGUES, GASTRIC TONICS EMOSTATICS, HYPNOTICS, IRRITANTS, LAXATIVES,] MOTOR DEPRESSANTS, MOTOR EXCITANTS, [MYDRIATICS, MYOTICS, NARCOTICS, NERVINES, NUTRIENTS, OXYTOCICS, PTYALAGOGUES, PURGATIVES, PUSTULANTS, REFRIGERANTS (MEDICINAL),] RESOLVENTS, RESPIRATORY DEPRESSANTS [RESPIRATORY STIMULANTS, (CARDIAC, CEREBRAL, HEPATIC),] RESTORATIVES, RUBEFACIENTS, SEDATIVES, SIALAGOGUES, SOPORIFICS, STERNUTATORIES, STIMULANTS, STOMACHICS, STYPTICS SUDORIFICS, TENIAFUGES, TONICS, VASO-CONSTRICTORS, VASODILATORS, VASCULAR SEDATIVES, VERMICIDES, VESICANTS, ELIXIRS, FLUID

*In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on July 30, 1996.*

COMMISSIONER OF PATENTS AND TRADEMARKS



AND SOLID EXTRACTS, OINTMENTS,  
PILLS, SOLUTIONS, SYRUPS, TABLETS,  
TINCTURES, GLOBULES AND  
WATERS], IN CLASS 6 (INT. CL. 5).

FIRST USE 2-0-1887; IN COMMERCE  
2-0-1887.  
SER. NO. 71-089,989, FILED 10-21-1915.

# UNITED STATES PATENT OFFICE.

MERCK & CO., OF NEW YORK, N. Y.

TRADE-MARK FOR CERTAIN NAMED CHEMICALS, MEDICINES, AND PHARMACEUTICAL PREPARATIONS.

108,566.

Registered Feb. 15, 1910.

Application filed October 21, 1915. Serial No. 89,989.

## STATEMENT.

*To all whom it may concern:*

Be it known that MERCK & Co., a corporation duly organized under the laws of the State of New York, and located in the city, county, and State of New York, and doing business at Nos. 45 to 47 Park Place, in said city of New York, has adopted and used the trade-mark shown in the accompanying drawing.

The trade-mark has been continuously used in the business of said corporation and in the business of its predecessors, E. Merck, and the firm of Merck & Co., since February, 1887.

The class of merchandise to which the trade-mark is appropriated is Class 6, Chemicals, medicines, and pharmaceutical preparations, and the particular description of goods comprised in said class upon which said trade-mark is used is alteratives, analgesics, anaphrodisiacs, anesthetics, anodynes, antacids, anthelmintics, antichlorotics, anti-emetics, antiepileptics, antigalactagogues, antigonorrhoeics, antihidrotics, antilithics, antineuralgics, antiparasitics, antiperiodics, antiphlogistics, antipyretics, anti-rheumatics, antisialagogues, antispasmodics, antisymotics, aperients, aphrodisiacs, astringents, cardiac sedatives, cardiac stimulants, carminatives, cathartics, cerebral depressants and stimulants, cholagogues, constructives, counter-irritants, demulcents, de-

oxidizers, deodorants, depilatories, depressants, diaphoretics, digestives, discutients, diuretics, ebolicics, emetics, emmenagogues, errhines, escharotics, expectorants, galactagogues, gastric tonics, emostatics, hypnotics, irritants, laxatives, motor depressants, motor excitants, mydriatics, myotics, narcotics, nervines, nutrients, oxytocics, pyalagogues, purgatives, pustulants, refrigerants (medicinal), resolvents, respiratory depressants, respiratory stimulants, (cardiac, cerebral, hepatic,) restoratives, rubefacients, sedatives, sialagogues, soporifics, sternutatories, stimulants, stomachics, styptics, sudorifics, teniafuges, tonics, vaso-constrictors, vasodilators, vascular sedatives, vermicides, vesicants, elixirs, fluid and solid extracts, ointments, pills, solutions, syrups, tablets, tinctures, globules and waters.

The trade-mark has usually been displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown.

The corporation of MERCK & Co. is the successor of the firm of Merck & Co., and is now the owner of trade mark registration No. 79,845, which mark was registered to that firm on October 11, 1910.

MERCK & CO.,  
By GEORGE MERCK,  
*President.*

# MERCK

## DECLARATION.

State of New York county of New York ss:—

GEORGE MERCK, being duly sworn, deposes and says that he is the president of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation or association to the

best of his knowledge and belief has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said firm in commerce among the several States of the United States, and the Territories thereof, and between the United States and foreign nations, and particularly with the

SECOND EXAMINEE  
Merck & Co., Inc.  
Rahway, N.J.

British Empire, the German Empire, the Republic of Cuba, and the Republic of Mexico, and that the drawing presented truly represents the mark sought to be registered; that the facsimiles shown the mark as actually used upon the goods; and that the mark has been in actual use as a trade-mark of the applicant for ten years next preceding February 20, 1905, and that to

the best of his knowledge and belief, such use has been exclusive.

GEORGE MERCK.

Subscribed and sworn to before me, a notary public for the county of New York, this 19th day of August, 1915.

[L. s.] MILDRED E. SMITH,  
Notary Public.

Copies of this trade-mark may be obtained for five cents each, by addressing the "Commissioner of Patents, Washington, D. C."

Renewed February 15, 1936 to, Merck & Co., Inc., a corporation of New Jersey.

## UNITED STATES PATENT OFFICE.

MERCK & CO., OF NEW YORK, N. Y.

TRADE-MARK FOR CERTAIN NAMED CHEMICALS, MEDICINES, AND PHARMACEUTICAL PREPARATIONS.

108,566.

Registered Feb. 15, 1916.

Application filed October 21, 1915. Serial No. 89,989.

### STATEMENT.

*To all whom it may concern:*

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oxidizers, deodorants, depilatories, depressants, diaphoretics, digestives, discutients, diuretics, ecboolics, emetics, emmenagogues, errhines, escharotics, expectorants, galactagogues, gastric tonics, emostatics, hypnotics, irritants, laxatives, motor depressants, motor excitants, mydriatics, myotics, narcotics, nervines, nutrients, oxytocics, pyalagogues, purgatives, pustulants, refrigerants (medicinal), resolvents, respiratory depressants, respiratory stimulants, (cardiac, cerebral, hepatic,) restoratives, rubefacients, sedatives, sialagogues, soporifics, sternutatories, stimulants, stomachics, styptics, sudorifics, teniafuges, tonics, vaso-constrictors, vasodilators, vascular sedatives, vermicides, vesicants, elixirs, fluid and solid extracts, ointments, pills, solutions, syrups, tablets, tinctures, globules and waters.

The trade-mark has usually been displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown.

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MERCK & CO.,  
By GEORGE MERCK,  
*President.*

# MERCK

### DECLARATION.

State of New York county of New York ss:—

GEORGE MERCK, being duly sworn, deposes and says that he is the president of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation or association to the

best of his knowledge and belief has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said firm in commerce among the several States of the United States, and the Territories thereof, and between the United States and foreign nations, and particularly with the

British Empire, the German Empire, the Republic of Cuba, and the Republic of Mexico, and that the drawing presented truly represents the mark sought to be registered; that the facsimiles shown the mark as actually used upon the goods; and that the mark has been in actual use as a trade-mark of the applicant for ten years next preceding February 20, 1905, and that to the best of his knowledge and belief, such use has been exclusive.

GEORGE MERCK.

Subscribed and sworn to before me, a notary public for the county of New York, this 19th day of August, 1915.

[L. s.]

MILDRED E. SMITH,  
*Notary Public.*

Copies of this trade-mark may be obtained for five cents each, by addressing the "Commissioner of Patents, Washington, D. C."

**Int. Cl.: 5**

**Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52**

**Reg. No. 2,169,031**

**United States Patent and Trademark Office**

**Registered June 30, 1998**

**TRADEMARK  
PRINCIPAL REGISTER**

**MERCK**

MERCK & CO., INC. (NEW JERSEY CORPORATION)  
ONE MERCK DRIVE, P. O. BOX 100  
WHITEHOUSE STATION, NJ 088890100

OWNER OF U.S. REG. NOS. 108,566 AND  
1,217,986.

SEC. 2(F).

FOR: FULL LINE OF PHARMACEUTICALS,  
IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

SER. NO. 75-204,592, FILED 11-26-1996.

FIRST USE 2-0-1887; IN COMMERCE  
2-0-1887.

LEIGH CAROLINE CASE, EXAMINING ATTORNEY



Office de la propriété  
intellectuelle  
du Canada

Un organisme  
d'Industrie Canada

Canadian  
Intellectual Property  
Office

An Agency of  
Industry Canada

*Marques de commerce*  
*Certificat de renouvellement*

*Trade-marks*  
*Certificate of Renewal*

La présente atteste que

l'enregistrement de

cette marque de commerce

est renouvelé pour une

période de quinze ans,

conformément à l'article 46

de la *Loi sur les marques de*

*commerce.*



This is to certify that this

trade-mark registration

is renewed for a

period of fifteen years,

in accordance with section 46

of the *Trade-marks Act.*

**MERCK**

Numéro d'enregistrement  
Registration Number

**UCA40567**

Numéro de dossier  
File Number

**212462**

Registraire des marques de commerce  
Registrar of Trade-marks

Date d'échéance **13 sept/Sep 2026**  
Expiry Date

Date **11 mai/May 2011**

**Canada**

OPIC  CIPO



**Office de la propriété  
Intellectuelle  
du Canada**

Un organisme  
d'Industrie Canada

50, rue Victoria  
Place du Portage I  
Gatineau (Québec) K1A 0C9

**Canadian  
Intellectual Property  
Office**

An Agency of  
Industry Canada

50 Victoria Street  
Place du Portage I  
Gatineau, Quebec K1A 0C9

**BERESKIN & PARR LLP/S.E.N.C.R.L., S.R.L.**  
SCOTIA PLAZA  
40 KING STREET WEST  
40th FLOOR  
TORONTO  
ONTARIO M5H 3Y2

Date	11 mai/May 2011
Votre référence - Your reference	
Numéro de dossier - File number	212462
Numéro d'enregistrement - Registration Number	UCA40567

Propriétaire - Owner

Merck Frosst Canada Ltd.

Marque de commerce - Trade-mark

MERCK

**ACCUSÉ DE RÉCEPTION POUR  
RENOUVELLEMENT**

Nous accusons réception de votre requête de renouvellement.  
Vous trouverez ci-joint votre certificat de renouvellement.

**RENEWAL  
ACKNOWLEDGEMENT**

Receipt is acknowledged of your renewal request. Enclosed is  
your certificate of renewal.

Registraire des marques de commerce  
Registrar of Trade-marks

Contact: Jacques Lemieux  
Section des cessions et renouvellements/  
Assignment and Renewal Section  
819-953-4769

**Canada**

[www.opic.ic.gc.ca](http://www.opic.ic.gc.ca)  
[www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca)





**APPL'N/DEM. NO 212 462**

**REGISTRATION/ENREGISTREMENT NO UCA40567**

**FILING DATE/DATE DE PRODUCTION:**

**13 sept/Sep 1951**

**REGISTRATION DATE/DATE D'ENREGISTREMENT:**

**13 sept/Sep 1951**

**RENEWAL DATE/DATE DE RENOUELEMENT:**

**13 sept/Sep 2011**

**REGISTRANT/PROPRIÉTAIRE ORIGINAL:**

MERCK & CO. LIMITED  
560 de Courcelles Street  
Montreal  
QUEBEC  
H4C 3C3

**CURRENT OWNER/PROPRIÉTAIRE COURANT:**

Merck Frosst Canada Ltd.  
16711 Trans-Canada Highway  
Kirkland  
QUEBEC  
H9H 3L1

**REP FOR SERVICE/REP POUR SIGNIFICATION:**

BERESKIN & PARR LLP/S.E.N.C.R.L., S.R.L.  
SCOTIA PLAZA  
40 KING STREET WEST  
40th FLOOR  
TORONTO  
ONTARIO M5H 3Y2

**TRADE-MARK (WORD MARK)/MARQUE DE COMMERCE (MOT SERVANT DE MARQUE)**

**MERCK**

**WARES/MARCHANDISES:**

Chemicals, namely, industrial, medicinal, pharmaceutical, nutritional, veterinary, analytical and photographic chemicals; medicines and pharmaceuticals.

**CLAIMS/REVENDEICATIONS:**

Date of first use in CANADA 1911 on wares.

Used in UNITED STATES OF AMERICA 18870000 on wares.

Registrability Recognized under Section 28(1)(d) of the Unfair Competition Act.

**ASSOCIATED MARKS/MARQUES LIÉES:**

TMA448,196

**APPL'N/DEM. NO 212 462 REGISTRATION/ENREGISTREMENT NO UCA40567**

**FOOTNOTES/NOTES:**

**CHANGE IN TITLE/CHANGEMENT DU TITRE:**

TYPE OF CHANGE/GENRE DE CHANGEMENT: NAME/NOM  
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 30 mars/Mar 1961  
DATE OF CHANGE/DATE DE CHANGEMENT: 31 déc/Dec 1960  
COMMENTS/COMMENTAIRES: MERCK SHARP & DOHME OF CANADA LIMITED  
SEE EVIDENCE ON FILE/VOIR PREUVE SUR LE DOSSIER 67118

**CHANGE IN TITLE/CHANGEMENT DU TITRE:**

TYPE OF CHANGE/GENRE DE CHANGEMENT: NAME AND ADDRESS/NOM ET ADRESSE  
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 04 août/Aug 1981  
DATE OF CHANGE/DATE DE CHANGEMENT: 04 déc/Dec 1968  
COMMENTS/COMMENTAIRES: MERCK SHARP & DOHME CANADA LIMITED-MERCK SHARP &  
DOHME CANADA LIMITEE

**CHANGE IN TITLE/CHANGEMENT DU TITRE:**

TYPE OF CHANGE/GENRE DE CHANGEMENT: OWNER/PROPRIÉTAIRE  
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 17 oct/Oct 1983  
DATE OF CHANGE/DATE DE CHANGEMENT: 05 nov/Nov 1982  
COMMENTS/COMMENTAIRES: MERCK FROSST CANADA INC.

**CHANGE IN TITLE/CHANGEMENT DU TITRE:**

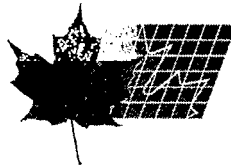
TYPE OF CHANGE/GENRE DE CHANGEMENT: AMALGAMATION/FUSIONNEMENT  
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 07 avr/Apr 1999  
DATE OF CHANGE/DATE DE CHANGEMENT: 05 déc/Dec 1998  
COMMENTS/COMMENTAIRES: FROM: MERCK FROSST CANADA INC.  
TO: MERCK FROSST CANADA & CO./  
MERCK FROSST CANADA & CIE.

Voir Preuve au dossier/See evidence on File No. 174757

**CHANGE IN TITLE/CHANGEMENT DU TITRE:**

TYPE OF CHANGE/GENRE DE CHANGEMENT: ASSIGNMENT/CESSION  
DATE REGISTERED/DATE DE L'ENREGISTREMENT: 16 août/Aug 2006  
DATE OF CHANGE/DATE DE CHANGEMENT: 05 mai/May 2006  
COMMENTS/COMMENTAIRES: FROM: MERCK FROSST CANADA & CO./  
MERCK FROSST CANADA & CIE.  
TO: Merck Frosst Canada Ltd.  
Nunc pro tunc April 30, 2005  
Voir Preuve au dossier/See evidence on File No. 174757

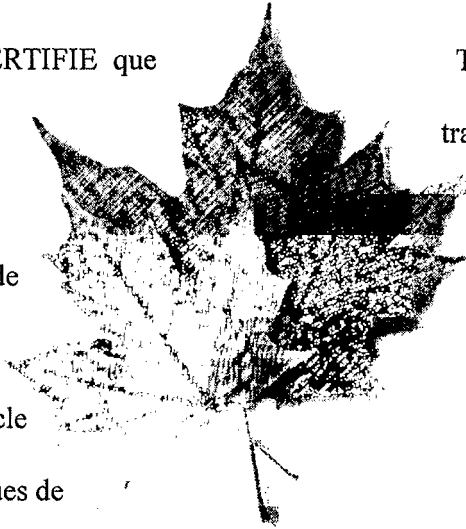
SEE AUXILIARY REGISTER FOR REGISTERED USER  
USAGER INSCRIT - VOIR REGISTRE AUXILIAIRE



# Marques de commerce / Trade-marks

## CERTIFICAT DE RENOUVELLEMENT

LA PRÉSENTE CERTIFIE que  
l'enregistrement de cette  
marque de commerce est  
renouvelé pour une période  
de quinze ans,  
conformément avec l'article  
46 de la Loi sur les marques de  
commerce.



## CERTIFICATE OF RENEWAL

THIS IS TO CERTIFY that this  
trade-mark registration is renewed  
for a period of fifteen years,  
in accordance with section  
46 of the Trade-marks Act.

**MERCK**

Numéro d'enregistrement  
Registration Number **UCA40567**

Numéro de dossier  
File Number **212462**

Date d'échéance **13 sept/Sep 2011**  
Expiry Date

Date **29 sept/Sep 1995**

Le registraire des marques de commerce  
Registrar of Trade-marks





Consumer and  
Corporate Affairs Canada

Consommation  
et Corporations Canada

Trade Marks

Marques de commerce

**Certificate of  
Renewal**

**Certificat de  
renouvellement**

REGISTERED OWNER - PROPRIÉTAIRE INSCRIT

**Merck Sharp & Dohme Canada Limited - Merck Sharp & Dohme Canada Limitée**

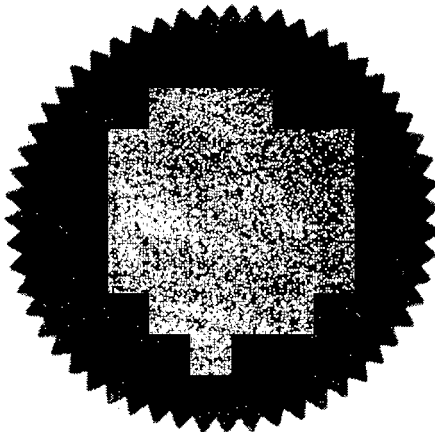
TRADE MARK - MARQUE DE COMMERCE

**MERCK**

REGISTRATION NO. - N° D'ENREGISTREMENT	EXPIRY DATE DATE D'ÉCHÉANCE D-J M Y-A	FILE NO. - N° DE DOSSIER	YOUR REFERENCE - VOTRE RÉFÉRENCE
<b>N.S. 159/40567</b>	<b>13   9   1996</b>	<b>212,462</b>	

THIS IS TO CERTIFY THAT, the renewal fee having been paid, this trade mark registration is renewed for a period of fifteen years in accordance with Section 45 of the Trade Marks Act.

LES PRÉSENTES CERTIFIENT QUE, le droit de renouvellement ayant été acquitté, l'enregistrement de cette marque de commerce est renouvelé pour une période de quinze ans, en conformité de l'article 45 de la Loi sur les marques de commerce.



Date

**August 5, 1981**

Registrar of Trade Marks  
Le registraire des marques de commerce

Attesting Officer  
Certificateur



## CANADA

**I hereby Certify that,** the requisite fee having been paid, trade mark registration No. N.S. 159/40567 is renewed for a period of fifteen years from the thirteenth day of September A.D., 1966 in accordance with the provisions of Section 45 of the Trade Marks Act. This trade mark stands in the name of Merck Sharp &

Dohme of Canada Limited.

**Je certifie par les présentes** que, le droit exigé ayant été acquitté, l'enregistrement de la marque de commerce n° est renouvelé pour une période de quinze ans à compter du jour d 19 en conformité des dispositions de l'article 45 de la Loi sur les marques de commerce. Cette marque de commerce est au nom de

**In Testimony Whereof** I have hereunto set my hand and caused the seal of the Trade Marks Office to be affixed at the City of Ottawa, Canada, this tenth day of May in the year of Our Lord one thousand nine hundred and sixty-six.

**En foi de quoi** j'ai apposé aux présentes mon seing et fait apposer le sceau du Bureau des marques de commerce, en la cité d'Ottawa, ce jour d en l'an de grâce mil neuf cent

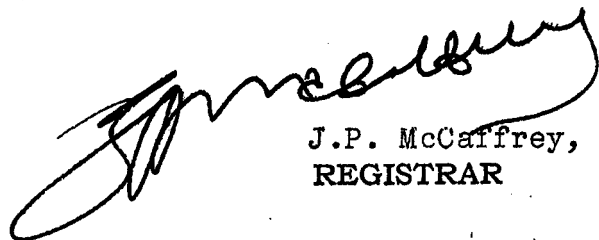
M. Robitaille  
REGISTRAR OF TRADE MARKS



CANADA

**I hereby Certify** that the Trade Mark identified on the annexed documents, which form part of this Certificate, has been registered in the Trade Marks Office, under the number and date, in the name of the person, and for use in association with the wares therein specified.

**In Testimony Whereof** I have hereunto set my hand and caused this Seal of the Trade Marks Office to be affixed at the City of Ottawa, Canada, this      fourteenth  
day of      March      in the  
year of Our Lord one thousand  
nine hundred and   fifty-two.



J.P. McCaffrey,  
REGISTRAR

OTTAWA.

1. The undersigned hereby makes application pursuant to the provisions of The Unfair Competition Act, 1932, for registration of the following trade mark:

The word mark **MERCK.**

2. The said trade mark has been used in the United States of America since 1887 by the applicant's predecessors-in-title, E. Merck; a firm trading under the name of Merck & Co.; Merck & Co., a corporation of the State of New York, one of the United States of America; and Merck & Co., Inc., a corporation of the State of New Jersey, one of the said United States of America. The said trade mark has been used in Canada by the applicant's said predecessors-in-title, Merck & Co., a corporation of the State of New York and Merck & Co., Inc., a corporation of the State of New Jersey, since on or before 1911. The said trade mark has been used in Canada by the applicant since 1929. The said trade mark is registered in the name of the applicant's predecessor-in-title, Merck & Co., Inc., a corporation of the State of New Jersey, in the United States Patent Office under Nos. 79,845 and 108,566.

3. The trade mark has been used since the said date of first use to indicate that the following wares have been sold by the owner of the trade mark: **chemicals, namely, industrial, medicinal, pharmaceutical, nutritional, veterinary, analytical and photographic chemicals; medicines and pharmaceuticals.**

4. The trade mark has been principally used in the following countries: **The United States of America and Canada.**

5. The applicant is commercially concerned with wares concisely described as **chemicals, medicines and pharmaceutical preparations.**

6. The applicant considers that having regard to the provisions of The Unfair Competition Act, it was and is entitled to adopt and use the mark in Canada in connection with the wares described.

7. E. Gordon Gowling, K.C., 56 Sparks Street, Ottawa, Canada, is appointed attorney, with full power of revocation and substitution, to execute and prosecute this application and to represent and stand in the place of the undersigned for all purposes of The Unfair Competition Act, 1932, including the service of any proceeding taken thereunder.

SIGNED at **Ottawa, Ontario,** this **13th** day of **September,** 19**51**.

**MERCK & CO. LIMITED,**  
560 de Courcelles Street,  
MONTREAL, Quebec.

212462

WJA

Registrant:	MERCK & CO. LIMITED	
Address:	560 de Courcelles Street Montreal, Quebec, Canada	
Date of Registration:	13 September, 1951	Date of First Use: United States-1887- Canada-in or before 1911
Application Serial No.	212462	Filed: 13 September, 1951
Agent for Service:	E. Gordon Gowling, Q.C., 56 Sparks Street Ottawa, Ontario, Canada	
Mark:	MERCK	
Wares:	Chemicals, namely, industrial, medicinal, pharmaceutical, nutritional, veterinary, analytical and photographic chemicals; medicines and pharmaceuticals.	
Change of Ownership:		

Sec. 1  
(1) (c)



# **ANNEX 4**

## **ADMINISTRATIVE PANEL DECISION**

**Merck Sharp & Dohme Corp. v. Company Domain Management, Syed Hussain/ Domain Privacy Group, Inc. c/o mercksharp.com**  
Case No. D2011-0141

### **1. The Parties**

Complainant is Merck Sharp & Dohme Corp. of Whitehouse Station, New Jersey, United States of America, represented by Lowenstein Sandler PC of United States of America.

Respondent is Company Domain Management, Syed Hussain of City Closter, New Jersey, United States of America/ Domain Privacy Group, Inc. c/o mercksharp.com of Markham, Ontario, Canada.

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

The disputed domain name <mercksharp.com> is registered with Netfirms, Inc.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 26, 2011. On January 26, 2011, the Center transmitted by email to Netfirms, Inc. a request for registrar verification in connection with the disputed domain name. On January 26, 2011, Netfirms, Inc. 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 Complainant on January 28, 2011 providing the registrant and contact information disclosed by Netfirms, Inc. and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 28, 2011.

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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on February 1, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was February 21, 2011. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on February 22, 2011.

The Center appointed Nicolas Ulmer as the sole panelist in this matter on February 25, 2011. 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 one of the largest pharmaceutical companies in the world with over USD 27 billion in sales in 2009 and over 100,000 employees worldwide. Complainant has been using the MERCK mark since 1887 according to the Complaint, and has submitted a United States of America trademark registration of the MERCK mark (registration no. 0108566) under Exhibit 4 to the Complaint, which dates back to February 15, 1916; in total Complainant holds 12 United States of America Federal trademarks. In Exhibit 5 to the Complaint, Complainant submitted 10 pages containing its over four hundred international trademark registrations containing MERCK SHARP & DOHME and variations thereof. Complainant submitted a list over 700 top-level domain names under its control in Exhibit 6 to the Complaint; the "www.merck.com" website alone averaged 11,215 unique visitors per day from January 1, 2009 through November 30, 2009. No dates are given for the registration of these domain names but it is clear that Complainant actively uses and promotes its brand and name online. Among these hundreds of domain names is <mercksharp.com.br>.

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

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

Complainant contends that Respondent knowingly makes use of Complainant's world-famous name and marks in order to attract visits to Respondent's site. It is written at the bottom of Respondent's site that "[t]his page is provided to the domain owner **free** by Sedo's Domain Parking" (emphasis in original, Exhibit 7 to the Complaint); only links populate the site according to the printout provided by Complainant and Sedo.co.uk's own site states that it "helps you capture and cash in on your domain's natural traffic!" (Exhibit 8 to the Complaint). Complainant never authorized Respondent to use its name or marks. There does not seem to be any reason for the site besides the seeking of "hits" and "clicks" in order to make money by domain parking, as evidenced by the disputed domain name site extract at Exhibit 7 to the Complaint. Complainant alleges that Respondent is using the disputed domain name, and the MERCK mark, in bad faith and is in violation of paragraph 4(a) of the Policy. The detailed Complaint included a signed affidavit from Complainant's in-house counsel, D. Shelinsky Greene, as to the validity of all statements in the Complaint. Complainant asks that the disputed domain name be transferred to it.

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

Respondent did not reply to Complainant's contentions.

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

Under paragraph 4(a) of the Policy, Complainant must prove the following:

- (i) Respondent's domain names are 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 domain names; and
- (iii) Respondent's domain names have been registered and are being used in bad faith.

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

Complainant's brand, Merck, is well-known, and indeed world famous, for its activities in the field of pharmaceuticals. Complainant has held the trademark MERCK, since 1916 and has operated under that name since at least 1887. The disputed domain name reproduces Complainant's trademark, MERCK, in full, adding only "sharp" to the end. Complainant submits that this does not serve to differentiate the disputed domain name from Complainant's mark but, instead only adds to confusion as it incorporated part of Complainant's full corporate name, Merck Sharp & Dohme. Complainant holds numerous trademarks containing variations of MERCK SHARPE & DOHME (Exhibit 5 to the Complaint). Further, among Complainant's hundreds of domain names is <mercksharp.com.br>. The Panel here finds that the disputed domain name is confusingly similar to Complainant's marks; Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

Complainant submits that Respondent does not have any legitimate rights or interest in the disputed domain name, and that Complainant has never authorized Respondent to use its mark and is in no way associated or affiliated with Complainant. Complainant has submitted, and Respondent has not stated otherwise, that Respondent is not known by the Merck or Merck Sharp name and has never operated a business under that name. Indeed, Respondent's name bears no resemblance to Complainant's mark or the disputed domain name. There is no evidence or indicia in the record that Respondent has any rights or legitimate interests in the disputed domain name and in the absence of a Response by Respondent, Respondent has not rebutted Complainant's *prima facie* case in this regard. The Panel here finds that Respondent has no rights or legitimate interests in the disputed domain name; paragraph 4(a)(ii) of the Policy is satisfied.

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

Complainant has been operating under the MERCK name for over 120 years; it is an internationally known brand headquartered in New Jersey where Respondent also appears to be located. Respondent must have had full knowledge of Complainant and its name at the time it registered the disputed domain name. Reinforcing this is the fact that Respondent expanded on Complainant's best-known mark, MERCK, with another, lesser known, part of its corporate name. Complainant cites *Abraxis BioScience, LLC v. Les Rubin*, WIPO Case No. D2008-0066, which states that "[t]he fact that the webpage contains advertising links, from which Respondent likely benefits through the Registrar's 'Cash Parking' monetization program, supports the inference that the purpose of Respondent's diversion of traffic from Complainant to himself is for Respondent's own commercial gain." Complainant provides numerous other citations of UDRP decisions to support its claim of bad faith use of the dispute domain name by Respondent. The Panel finds that Complainant has proven Respondent's bad-faith registration and use of the disputed domain name and thereby satisfied paragraph 4(a)(iii) of the Policy.

## **7. Decision**

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

**Nicolas Ulmer**

Sole Panelist

Dated: March 7, 2011

## **ADMINISTRATIVE PANEL DECISION**

Merck Sharp & Dohme Corp. v. Janice Liburd

Case No. D2011-0278

### **1. The Parties**

The Complainant is Merck Sharp & Dohme Corp. of Whitehouse Station, New Jersey, United States of America, represented by Lowenstein Sandler PC.

The Respondent is Janice Liburd of Panama.

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

The disputed domain names <merckspeakersservices.com> and <mercksveterinarymanual.com> are registered with Moniker Online Services, LLC.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 9, 2011. On February 11, 2011, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the disputed domain names. On February 16, 2011, Moniker Online Services, LLC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain names.

The Center verified that the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 18, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was March 10, 2011. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 14, 2011.

The Center appointed Richard Tan as the sole panelist in this matter on March 23, 2011. 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.

The Panel has, of its own motion, pursuant to the powers granted to it under the Rules, paragraph 10(c), extended the time limit set out in the Rules, paragraph 15(c) for forwarding the decision to the Center, by reason of certain exceptional circumstances. The Panel has extended the time for forwarding this decision to the Center, to the date of this decision.

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

The Complainant is a well-known pharmaceutical company and one of the world's largest pharmaceutical companies. It owns, with its affiliates and subsidiaries, the MERCK trademark, which has been used since at least as early as 1887, as well as various other marks and trade names incorporating the "Merck" name (collectively the "MERCK Family of Marks"). The MERCK Family of Marks includes the trademark THE MERCK VETERINARY MANUAL for a veterinary medical textbook.

The Complainant currently owns 12 United States ("U.S.") federal trademark registrations (and one pending trademark application) for the MERCK Family of Marks. The U.S. federal trademark registrations include registrations for the marks, THE MERCK VETERINARY MANUAL, THE MERCK MANUAL and THE MERCK MANUAL OF GERIATRICS. The Complainant owns approximately 400 worldwide trademark registrations incorporating the MERCK Family of Marks. It also currently owns over 700 top-level and country code domain names incorporating the MERCK Family of Marks, including, but not limited to, <merck.com>, <merck.biz>, <merck.us>, <merckmanual.com>, <merckmanuals.com> and <merckspeakerservices.com>.

The disputed domain name <merckspeakersservices.com> was registered on November 20, 2010, and the disputed domain name <mercksveterinarymanual.com> on November 18, 2010.

The Respondent uses the disputed domain names as landing pages that feature pay-per-click links, including links related to the medical industry, which resolve to third-party websites.

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

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

The Complainant first contends that its MERCK Family of Marks includes the mark MERCK, which is a well-known and famous brand of pharmaceutical products; and THE MERCK VETERINARY MANUAL, which is a well-known and famous brand of veterinary reference books. The Complainant also provides speaker services, and owns and operates a website at the domain name <merckspeakerservices.com>.

The Complainant contends that it is one of the world's largest pharmaceutical companies and that in 2009 alone, the Complainant had sales of over USD 27 billion of its products worldwide. It has over 100,000 employees worldwide. It focuses its research efforts in the therapeutic areas of cardiovascular, diabetes, obesity, bone, respiratory, immunology, dermatology, infection, infectious disease, oncology, neurosciences, ophthalmology, women's health and endocrine, spending USD 5.8 billion on research and development in 2009. Given such extensive worldwide operations and sales, it contends that the MERCK Family of Marks has acquired substantial worldwide recognition.

The Complainant contends that the disputed domain names are virtually identical and confusingly similar to the MERCK mark and the MERCK Family of Marks in which it has rights. It points to the fact that the disputed domain name <mercksveterinarymanual.com> incorporates the whole of the Complainant's trademark, THE MERCK VETERINARY MANUAL. The only difference is that the <mercksveterinarymanual.com> domain name does not include the word "the" and has an "s" between the words "Merck" and "Veterinary." Similarly, the disputed domain name <merckspeakersservices.com> incorporates the MERCK trademark and is identical to the Complainant's own <merckspeakerservices.com> domain name, except that the disputed domain name <merckspeakersservices.com> adds an extra letter "s" between the words "speaker" and "services."

The Complainant relies on numerous decisions under the Policy that have held that merely adding descriptive words to a complainant's mark will not preclude a finding of confusing similarity and that the addition of the ".com" gTLD will also not remove the element of confusing similarity if otherwise found. It argues that the disputed domain names incorporate the Complainant's famous trademarks, varying them only with the addition of typos and descriptive phrases that are clearly intended to deceive Internet users. Internet users are likely to believe that the disputed domain names are related to, associated with, or authorized by the Complainant and that the Respondent registered the disputed domain names because of this association with the Complainant's MERCK Family of Marks in order to cause confusion, and that this is a classic case of typosquatting and initial-interest confusion. The Complainant contends that the Respondent appropriated the disputed domain names with the intention of causing confusion, mistake, and deception as to the Complainant and the Respondent.

The Complainant contends, secondly, that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent cannot demonstrate any legitimate interests in the disputed domain names. It registered the disputed domain names well after the Complainant established rights in the MERCK Family of Marks. The Respondent is not commonly known by the disputed domain names and to the Complainant's knowledge, the Respondent has never conducted a legitimate offline business under the name "Merckspeakersservices" or "Mercksveterinarymanual." The Respondent has not been granted a license or other rights to use the Complainant's marks as part of any domain name or for any other purpose. The Complainant is in no way associated or affiliated with the Respondent.

The Complainant contends that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names; and the only possible use of the disputed domain names is to misleadingly use them to attract customers to its websites for its own commercial gain. The Respondent's use of the disputed domain names as landing pages featuring pay-per-click links, including links to third party websites relating to the medical industry, is evidence of the Respondent's intent to mislead.

The Complainant argues that where, as here, the Complainant's marks and name are so widely recognized, and have been used in connection with pharmaceuticals and other products for so many years, there can be no legitimate use by the Respondent.

The Complainant contends, thirdly, that the disputed domain names have been registered and used in bad faith. The Complainant contends that bad faith is found where it appears more likely than not, from the evidence that the Respondent has registered a domain name in a deliberate attempt to attract users to its planned website, for commercial gain, due to confusion with Complainant's mark; and that the use of a domain name that is confusingly similar to a trademark, in order to drive traffic to a website and generate revenue, is evidence of bad faith under the Policy.

It argues that the Respondent's actions also constitute typosquatting, where a domain name is comprised of a common misspelling of a protected mark, and that typosquatting is of itself evidence of bad faith.

The Complainant further alleges that the Respondent has been engaging in a pattern of conduct where it has registered numerous distinctive domain names for improper purposes. The Complainant relies on *Shaw Industries Group, Inc., Columbia Insurance Company v. Moniker Privacy Services/Janice Liburd*, WIPO Case No. D2010-1645, *Tractor Supply Co. of Texas LP and Tractor Supply Company v. Moniker Privacy Services / Janice Liburd*, WIPO Case No. D2010-0976, *Nilfisk-Advance A/S v. Moniker Privacy Services [2466703]/Janice Liburd, Porchester Partners, Inc.*, WIPO Case No. D2010-0859 and *Européenne de Traitement de L'Information "Euro Information" v. Janice Liburd Porchester Partners, Inc.*, WIPO Case No. D2010-0751. The Complainant points out that in each of these cases, the panel found that the Respondent registered and used the disputed domain name in bad faith.

The Respondent's use of the disputed domain names was either intended to divert Internet traffic of end users seeking to find the websites of Complainant, to capitalize on consumers' typographic mistakes, and/or to suggest to potential customers that the Complainant is somehow related to, or affiliated with, the Respondent. In any case, the Respondent's registration and use of the disputed domain names is disrupting

and diverting the Complainant's business; such registration and use constitute bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Complainant has the burden of proving each of the following three elements under paragraph 4(a) of the Policy in order to be entitled to a transfer of the disputed domain name:

- (i) that the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

The Respondent is required under the Rules to submit a Response to the Complaint within twenty days of the date of commencement of the administrative proceedings. In the event of a failure to submit a Response, paragraph 5(e) of the Rules provides that absent any exceptional circumstances, the Panel is to decide the dispute "based upon the complaint." Paragraph 14(b) of the Policy further provides that if a party, in the absence of exceptional circumstances, fails to comply with any provision of the Rules, the Panel is entitled to "draw such inferences," from the Respondent's failure to comply with the Rules, "as it considers appropriate." While a panel may draw negative inferences from the respondent's default, paragraph 4 of the Policy requires the complainant to support its assertions with actual evidence in order to succeed: see for example *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. D2002-1064; *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO Case No. D1999-0001; *Telstra Corporation Limited v. Nuclear Marshmallows*; WIPO Case No. D2000-0003; and *Digital Vision, Ltd. v. Advanced Chemill Systems*, WIPO Case No. D2001-0827.

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

The Complainant is required under paragraph 4(a)(i) of the Policy to prove that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

Having regard to the evidence adduced by the Complainant in relation to the MERCK Family of Marks, which include the marks, THE MERCK VETERINARY MANUAL, THE MERCK MANUAL, and THE MERCK MANUAL OF GERIATRICS, as discussed above, the Panel finds that it can hardly be in dispute that the Complainant has established rights in its MERCK mark. The Panel accepts the evidence adduced by the Complainant that MERCK is a well-known and famous mark that the Complainant owns, and that it also owns trademark rights in the mark, THE MERCK VETERINARY MANUAL. The Panel also accepts, absent any evidence to the contrary or response from the Respondent, that the Complainant provides speaker services and owns and operates a website using the domain name <merckspeakerservices.com>.

The Panel finds that the disputed domain name <mercksveterinarymanual.com> incorporates the registered trademark MERCK and is almost identical to the Complainant's trademark THE MERCK VETERINARY MANUAL. With regard to the latter, the only difference is that the disputed domain name <mercksveterinarymanual.com> does not include the word "the" and has an "s" between the words "Merck" and "veterinary."

The disputed domain name <merckspeakersservices.com> incorporates the trademark MERCK, and is almost identical to the Complainant's own <merckspeakerservices.com> domain name, except that the



disputed domain name <merckspeakersservices.com> adds an extra letter “s” between the words “speaker” and “services.”

The Panel notes that the threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself, to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms typically being regarded as insufficient to prevent threshold Internet user confusion.

In this Panel’s view, this threshold test is satisfied. The mark MERCK is distinctive and is the dominant or principal component of the domain name. The addition of the descriptive words in the two disputed domain names, <mercksveterinarymanual.com> and <merckspeakersservices.com>, does not prevent the disputed domain names from being regarded as confusingly similar to the trade mark MERCK: see for example, *Experian Information Solutions, Inc. v. BPB Prumerica Travel (a/k/a SFXB a/k/a H. Bousquet a/k/a Brian Evans)*, WIPO Case No. D2002-0367, where the panel held that the addition of the generic term, “automotive” did not distinguish a respondent’s domain name <experianautomotive.com> from the complainant’s mark, as the domain name contained the complainant’s EXPERIAN mark in its entirety.

Further, the disputed domain name <mercksveterinarymanual.com> is, in the Panel’s view, clearly confusingly similar to the Complainant’s mark, THE MERCK VETERINARY MANUAL. The minor differences between the disputed domain name and the Complainant’s mark, as noted above, do not alter that conclusion. Neither would the presence of the top-level suffix “.com” be sufficient to escape a finding of substantial or confusing similarity, since that is a technical requirement of registration: see *inter alia*, *CSC Holdings, Inc. v. Elbridge Gagne*, WIPO Case No. D2003-0273; *CITGO Petroleum Corporation v. Horace A. “Woofers” Smith*, WIPO Case No. D2003-0054; *EasyGroup IP Licensing Limited v. Amjad Kausar*, WIPO Case No. D2003-0012; *Microsoft Corporation and MSNBC Cable LLC v. Seventh Summit Ventures*, WIPO Case No. D2002-0567; and *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. D2001-0015.

This Panel accordingly finds that the disputed domain names are confusingly similar to the Complainant’s trademarks, in which the Complainant has rights.

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

As several UDRP panels have found, a complainant is only required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in a domain name; and that once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In this case, the Complainant has contended that the Respondent registered the disputed domain names long after the Complainant established its rights in the MERCK Family of Marks; that the Respondent is not commonly known by the disputed domain names; that to the Complainant’s knowledge, the Respondent has never conducted a legitimate offline business under the name “Merckspeakersservices” or “Mercksveterinarymanual”; and that the Respondent has not been granted any license or other rights to use the Complainant’s Marks for any purposes and that the Complainant is in no way associated or affiliated with the Respondent.

The Complainant further contends that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, and the only possible use of the disputed domain names would be to use them to mislead and attract customers to its websites for its own commercial gain. The disputed domain names, according to the Complainant, are used as landing pages featuring pay-per-click links, including links to third party websites relating to the medical industry.

The Respondent has not filed a Response to the Complaint. It has not demonstrated that it has any rights or legitimate interests in the disputed domain names.

In the absence of a Response, the Panel is entitled to draw certain adverse inferences against the Respondent, namely that here it has no rights or legitimate interests. The Panel accepts the arguments and evidence advanced by the Complainant that the Respondent has no rights or legitimate interests in respect of the disputed domain names. As noted above, the Respondent has no known connection or affiliation with the Complainant, which has not consented to or authorized the Respondent's use of the disputed domain names. There is no evidence that the Respondent is commonly known as "Merckspeakersservices" or "Mercksveterinarymanual". The Respondent appears to be using the disputed domain names for pay-per-click links to third party websites and not for any *bona fide* offering of goods or services. Not is it making a legitimate noncommercial or fair use of the disputed domain names. It appears that the Respondent's behavior constitutes "typosquatting," by registering domain names that are close misspellings of Complainant's Marks and domain names, which use does not constitute a legitimate business use under the Policy.

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

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

Paragraph 4(a)(iii) of the Policy provides that the Complainant must, in addition to the matters set out above, demonstrate that the disputed domain names have been registered and used in bad faith.

The Complainant submits that the Respondent has registered and used the disputed domain names in bad faith. The evidence in the record establishes that the Respondent has no license or other authorization to use the MERCK trademark. There is no question that the Respondent registered the disputed domain names long after the MERCK trademark and the Complainant's other marks in the MERCK Family of Marks were registered. The MERCK trademark was, and is, a well-known mark based on the evidence adduced by the Complainant, and clearly, in the view of the Panel, the Respondent must have known about the Complainant's mark and business when registering the disputed domain names.

On the evidence presented, the Panel finds that the Respondent uses the disputed domain names as landing pages that feature pay-per-click links, including links to third party sites related to the medical industry. The Complainant's assertion that the Respondent receives payment for every user that clicks on a pay-per-click link has not been disputed. The Panel accepts from the evidence offered by the Complainant that the Respondent has registered the domain names in a deliberate attempt to attract users to its websites for commercial gain by seeking to profit from the confusion with the Complainant's marks.

The Panel accepts the Complainant's contentions and arguments that the use of a domain name that is confusingly similar to a trademark, in order to divert traffic to a website and generate revenue, is evidence of bad faith pursuant to paragraph 4(b) of the Policy.

The Panel further accepts the Complainant's contentions that the Respondent's actions also constitute typosquatting, where, as here, there has been a misspelling of a protected mark. Typosquatting is evidence of bad faith. In this case, the Respondent's disputed domain name <mercksveterinarymanual.com> differs from Complainant's trademark THE MERCK VETERINARY MANUAL only by the omission of the word "the" and by the addition of the letter "s."

Further, absent any response from the Respondent, the Panel accepts the evidence offered by the Complainant (as noted in the numerous cases cited above) that the Respondent has engaged in a pattern of conduct where it has registered numerous distinctive names for improper purposes. Such pattern of conduct is evidence of bad faith.

The Panel has no hesitation in finding on the undisputed evidence that the Respondent's registration and use of the disputed domain names was intended to disrupt and divert the Complainant's business, and that such registration and use constitute bad faith. The Respondent, it appears to the Panel, was clearly seeking to profit from the confusion created by the inclusion of the Complainant's marks in the disputed domain names. The Panel finds that by intentionally attempting to attract, for commercial gain, users to the

Respondent's website through creating a likelihood of confusion with the Complainant's marks, the Respondent's registration and use of the disputed domain names was in bad faith.

The Respondent has not submitted any evidence to rebut the Complainant's claims and assertions. In the absence of such evidence, and based on the evidence submitted by the Complainant, the Panel accepts the Complainant's contentions that the domain names were registered and used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names, <merckspeakersservices.com> and <mercksveterinarymanual.com>, be transferred to the Complainant.

**Richard Tan**  
Sole Panelist  
Dated: April 18, 2011

## **ADMINISTRATIVE PANEL DECISION**

### **Merck Sharp & Dohme Corp. f/k/a Merck & Co., Inc. v. Zhangxianqiong Case No. D2011-1898**

#### **1. The Parties**

Complainant is Merck Sharp & Dohme Corp. f/k/a Merck & Co., Inc. of Rahway, New Jersey, United States of America, represented by Lowenstein Sandler PC, United States of America.

Respondent is Zhangxianqiong of BaZhong, SiChuan, China.

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

The disputed domain names <merck-sun.com>, <mercksun.com>, <sun-merck.com>, <sunmerck.com> (the "Domain Names") are registered with Guangzhou Ming Yang Information Technology Co., Ltd.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 2, 2011. On November 2, 2011, the Center transmitted by email to Guangzhou Ming Yang Information Technology Co., Ltd. a request for registrar verification in connection with the Domain Names. On November 3, 2011, Guangzhou Ming Yang Information Technology Co., Ltd transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details. On November 3, 2011, the Center transmitted an email communication to the parties in both Chinese and English regarding the language of the proceedings. On November 4, 2011, Complainant confirmed its request that English be the language of the proceedings. Respondent did not comment on the language of the proceedings by the specified due date.

The Center verified that the 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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on November 9, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was November 29, 2011. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 30, 2011.

The Center appointed Yijun Tian as the sole panelist in this matter on December 6, 2011. 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**

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

Complainant, Merck Sharp & Dohme Corp. f/k/a Merck & Co., Inc. is a company incorporated in Rahway, New Jersey, United States of America. It is one of world largest pharmaceutical companies and has over 100,000 employees worldwide.

Complainant is the registered owner of numerous trademarks consisting or including the word “Merck” (MERCK Marks) throughout the world, including 15 trademark registrations in the U.S. (see Exhibit 4 to the Complaint) and approximately 400 trademark registrations incorporating the MERCK Marks in other countries (Exhibit 5 to the Complaint).

The MERCK Marks (e.g. the word mark MERCK was registered in the U.S. on February 15, 1916) was registered long before the registration of the Domain Names (2011). Complainant has also registered over 700 top-level and country code domain names incorporating the MERCK Marks, such as <merck.com>, <merck.biz> and <merck.us> (Exhibit 6 to the Complaint).

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

Respondent registered the Domain Names <merck-sun.com>, <mercksun.com>, <sun-merck.com>, <sunmerck.com> on April 11, 2011, which is long after Complainant operated websites with URL which contain the MERCK Marks (*i.e.* <merck.com> was registered on December 9, 1992<sup>1</sup>).

#### **5. Parties’ Contentions**

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

- (a) The Domain Names are identical or confusingly similar to the MERCK Marks

MERCK is a well-known and famous brand for pharmaceutical products.

The four Domain Names are virtually identical and confusingly similar to Complainant’s famous MERCK Marks. The only difference is that each of the Domain Name adds the word “sun” and in two cases a dash.

The word “sun” is a reference to Sun Pharmaceutical Industries, the Company with which Complainant announced the creation of a joint venture in the same month that Respondent registered the Domain Names. The word “sun” is therefore descriptive of that joint venture.

The inclusion of a dash in the Domain Names <sun-merck.com> and <merck-sun.com> does not affect the analysis because, in the context of a confusing similarity analysis, “the presence of the dash is irrelevant.”

The addition of the “.com” gTLD does not remove the confusing similarity between the Domain Names and MERCK Marks.

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<sup>1</sup> [http://www.webtask.org/whois-de-merck\\_com.html](http://www.webtask.org/whois-de-merck_com.html) and <http://www.guideddomains.com/domain-merck-dot-com.html>

- (b) Respondent has no rights or legitimate interests in the Domain Names;

Respondent cannot demonstrate any legitimate interests in the Domain Names.

Respondent is not commonly known by the Domain Names.

Respondent has been granted no license or other rights to use Complainant's MERCK Marks as part of any domain name or for any other purpose. Complainant is in no way associated or affiliated with Respondent.

Respondent is not making a legitimate non-commercial or fair use of the Domain Names, and is not using any of the Domain Names in connection with a *bona fide* offering of goods or services.

Respondent currently uses the Domain Names as landing pages stating that "This domain is for sale" and provide contact information for potential buyers interested in purchasing the Domain Names. (See Exhibit 7 to the Complaint).

- (c) The Domain Names were registered and are being used in bad faith.

Bad faith is found when "it appears more likely than not from the evidence offered by Complainant that Respondent has registered the domain name in a deliberate attempt to attract users to its planned website for commercial gain due to confusion with Complainant's mark". This is exactly the case here.

The use of a domain name that is confusingly similar to a trademark, in order to drive traffic to a website and generate revenue, is evidence of bad faith pursuant to paragraph 4(b) of the Policy. This is true whether these efforts consist of an attempt to capitalize on initial interest confusion.

The unauthorized use of Complainant's trademark for the purpose of selling the Domain Names constitutes bad faith under paragraphs 4(b)(iii) and (iv) of the Policy. This is a classic case of initial-interest confusion.

The registration of a domain name incorporating a widely recognized mark is itself evidence of bad faith registration. Respondent's registration of the Domain Names is *prima facie* evidence of such bad faith.

Respondent has no authorization from Complainant to use Complainant's famous MERCK Marks. Respondent has had years of constructive notice of Complainant's registered trademarks, under U.S. Law 15 U.S.C. S1072.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

The language of the registration agreements for the Domain Names is Chinese. Pursuant to the Rules, paragraph 11, in the absence of an agreement between the parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement. From the evidence presented on the record, no agreement appears to have been entered into between Complainant and Respondent to the effect that the language of the proceeding should be English. Complainant filed initially its Complaint in English, and has requested that English be the language of the proceeding for the following reasons:

- (a) As in the cited cases, the majority of the content featured on Respondent's websites is in the English language. Respondent's websites also include English language copyright notices. (See Exhibit 7 to the Complaint).
- (b) Respondent has also demonstrated its fluency in English through its English language communication to Complainant. (See Exhibit A to the Language Request). Respondent took it upon himself to contact Complainant and knew full well to initiate such contact in English.
- (c) It is apparent from the fluent English displayed on Respondent's websites and in Respondent's e-mail communication that Respondent is sufficiently capable of communicating in English. Further, Respondent was adequately familiar with English to target a U.S.-based company and register the four Domain Names, each of which includes MERCK Marks in its entirety.
- (d) Complainant is not in a position to participate in these proceedings in Chinese without a great deal of additional expense, burden and delay should translation be required. Given the circumstances of this proceeding, the balance of hardship lies in favor of Complainant.

Respondent did not make any submissions with respect to the language of the proceeding and did not object to the use of English as the language of the proceeding.

Paragraph 11(a) of the Rules allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding. In other words, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. (*Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd.*, WIPO Case No. D2008-0293; *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. D2006-0593). The language finally decided by the panel for the proceeding should not be prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case. (*Groupe Auchan v. xmxzl*, WIPO Case No. DCC2006-0004).

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (the "WIPO Overview 2.0") further states: "in certain situations, where Respondent can apparently understand the language of the complaint (or having been given a fair chance to object has not done so), and Complainant would be unfairly disadvantaged by being forced to translate, the WIPO Centre as a provider may accept the language of the complaint, even if it is different from the language of the registration agreement". (WIPO Overview 2.0, paragraph 4.3; see also *L'Oreal S.A. v. MUNHYUNJA*, WIPO Case No. D2003-0585).

The Panel has taken into consideration the facts that Complainant is a company incorporated in the U.A., and Complainant will be spared the burden of dealing with Chinese as the language of the proceeding. The Panel has also taken into consideration the facts that the Domain Names include English word "sun" (*Expoconsult B.V. trading as CMP Information v. Roc Guan*, WIPO Case No. D2008-1600; *Compagnie Gervais Danone v. Xiaole Zhang*, WIPO Case No. D2008-1047).

On the record, Respondent appears to be a Chinese individual and is thus presumably not a native English speaker, but the Panel finds that persuasive evidence in the present proceeding to suggest that Respondent may have sufficient knowledge of English. In particular, the Panel notes that, based on the evidence provided by Complainant, (a) the Domain Names <merck-sun.com>, <mercksun.com>, <sun-merck.com>, <sunmerck.com> are registered in Latin characters and particularly in English language, rather than Chinese script; (b) English has been displayed on Respondent's websites (See Exhibit 7 to the Complaint) and in Respondent's e-mail communication that Respondent is sufficiently capable of communicating in English. (See Exhibit A to the Language Request); (d) the Center has notified Respondent of the proceedings in both Chinese and English, and Respondent has indicated no objection to Complainant's request that English be the language of the proceeding; (e) the Center informed Respondent that it would accept a Response in either English or Chinese.

Considering these circumstances, the Panel finds the choice of English as the language of the present proceeding is fair to both Parties and is not prejudicial to either one of the Parties in his or her ability to articulate the arguments for this case. Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that English shall be the language of the proceeding, and the decision will be rendered in English.

## 6.2. Discussion and Findings

Paragraph 4(a) of the Policy requires that Complainant prove each of the following three elements to obtain an order that the Domain Names should be transferred:

- (i) the Domain Names registered by Respondent are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

On the basis of the evidence introduced by Complainant and in particular with regard to the content of the relevant provisions of the Policy (paragraphs 4(a), (b), (c)), the Panel concludes as follows:

### A. Identical or Confusingly Similar

The Panel finds that Complainant has rights in the MERCK Marks acquired through registration. The MERCK Marks have been registered worldwide including China (registration in China since December 1988; See Exhibit 7 to the Complaint) and it has a widespread reputation in pharmaceutical industry worldwide.

The Domain Names <merck-sun.com>, <mercksun.com>, <sun-merck.com>, <sunmerck.com> comprise the MERCK Marks in its entirety. The Domain Names <merck-sun.com> and <sun-merck.com> only differs from the MERCK Marks by the addition of “-” and the word “sun”. The Domain Names <mercksun.com> and <sunmerck.com> only differs from the MERCK Mark by the addition of the English word “sun”. The Panel finds that these do not eliminate the similarity between Complainant’s registered MERCK Marks and the Domain Names.

Previous UDRP panels have consistently held that a domain name is identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trade mark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662).

Generally a respondent “may not avoid likely confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it”. (*The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. D2009-0610; *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. D2001-0087; and *PCCW-HKT DataCom Services Limited v. Yingke*, HKIAC Claim No. 0500065).

Mere addition of the descriptive term “sun” or a dash to Complainant’s MERCK Marks fails to distinguish. Thus, the Panel finds that the additions are not sufficient to negate the confusing similarity between the Domain Names and the MERCK Marks in which Complainant has rights.

The Panel therefore holds that Complaint fulfils the first condition of paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that Respondent has rights or legitimate interests in the Domain Names:



- (i) use of, or preparations to use, the Domain Names in connection with a *bona fide* offering of goods or services;
- (ii) the fact that Respondent has commonly been known by the Domain Names; or
- (iii) legitimate noncommercial or fair use of the Domain Names.

The overall burden of proof on this element rests with Complainant. However, it is well established by previous UDRP panel decisions that once a complainant establishes a *prima facie* case that a respondent lacks rights or legitimate interests in a domain name, the burden of production shifts to respondent to rebut complainant's contentions. If respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. (*Danzas Holding AG, DHL Operations B.V. v. Ma Shikai*, WIPO Case No. D2008-0441; see also WIPO Overview 2.0, paragraph 2.1 and cases cited therein).

Complainant has rights in the MERCK Marks throughout the world, including 15 trademark registrations in the US (since 1916; see Exhibit 4 to the Complaint) and approximately 400 trademark registrations in other countries (Exhibit 5 to the Complaint). Complainant has also registered over 700 top-level and country code domain names incorporating the MERCK Marks (Exhibit 6 to the Complaint). According to the information provided by Complainant, as one of world largest pharmaceutical companies, it has over 100,000 employees worldwide.

Moreover, according to Complainant, Respondent is not an authorized dealers of MERCK-branded products. Complainant has therefore established a *prima facie* case that Respondent has no rights or legitimate interests in the Domain Names and thereby shifted the burden to Respondent to produce evidence to rebut this presumption (*The Argento Wine Company Limited v. Argento Beijing Trading Company, supra*; *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. D2000-0624; and *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455).

Based on the following reasons the Panel finds that Respondent has no rights or legitimate interests in the Domain Names:

- (a) There has been no evidence adduced to show that Respondent is using the Domain Names in connection with a *bona fide* offering of goods or services. Respondent has not provided evidence of legitimate use of the Domain Names or reasons to justify the choice of the word "Merck" in their business operations. There has been no evidence to show that Complainant has licensed or otherwise permitted Respondent to use the MERCK Marks or to apply for or use any domain name incorporating the MERCK Marks;
- (b) There has been no evidence adduced to show that Respondent has been commonly known by the Domain Names. There has been no evidence adduced to show that Respondent has any registered trademark rights with respect to the Domain Names. The four Domain Names were all registered on April 11, 2011, which are long after Complainant operated websites with URL which contain the MERCK marks (e.g. <merck.com> was registered on December 9, 1992.<sup>2</sup> The Domain Names are identical or confusingly similar to Complainant's MERCK Marks.
- (c) There has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the Domain Names.

The Panel finds that Respondents have failed to produce any evidence to establish rights or legitimate interests in the Domain Names. The Panel therefore holds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

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<sup>2</sup> [http://www.webtask.org/whois-de-merck\\_com.html](http://www.webtask.org/whois-de-merck_com.html) and <http://www.guidedomains.com/domain-merck-dot-com.html>

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

Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of the Domain Names in bad faith, namely:

- (i) circumstances indicating that Respondent has registered or acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registrations to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the Domain Names; or
- (ii) Respondent has registered the Domain Names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's websites or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's websites or locations or products.

The Panel concludes that the circumstances referred to in paragraph 4(b)(iv) of the Policy are applicable to the present case and upon the evidence of these circumstances and other relevant circumstances, it is adequate to conclude that Respondent has registered and used the Domain Names in bad faith.

#### **a) Registered in Bad Faith**

The Panel finds that Complainant has a widespread reputation in the MERCK Marks with regard to its products. Complainant has registered its MERCK Marks throughout the world (in the U.S. since 1916), including China (since 1988). Based on the information provided by Complainant, as one of world largest pharmaceutical companies, it has over 100,000 employees worldwide. It is not conceivable that Respondent would not have had actual notice of Complainant's trademark rights at the time of the registration of the Domain Names (in March 2011). The Panel therefore finds that the Domain Names are not one that one could legitimately adopt other than for the purpose of creating an impression of an association with Complainant. (*The Argento Wine Company Limited v. Argento Beijing Trading Company, supra*).

Moreover, Respondent has chosen not to formally respond to Complainant's allegations. According to the panel's decision in *The Argento Wine Company Limited v Argento Beijing Trading Company, supra*, "the failure of Respondent to respond to the Complaint further supports an inference of bad faith. (*Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. D2002-0787)."

Thus, the Panel concludes that the Domain Names were registered in bad faith with the intent to create an impression of an association with Complainant's MERCK Marks.

#### **b) Used in Bad Faith**

Complainant has adduced evidence to prove that by using the confusingly similar Domain Names, Respondent has "intentionally attempted to attract, for commercial gain, Internet users to Respondent's websites". Complainant claimed that Respondent currently uses the Domain Names as landing pages stating that "This domain is for sale" and provide contact information for potential buyers interested in purchasing the Domain Names. (See Exhibit 7 to the Complaint).

To establish an “intention for commercial gain”, evidence is required to indicate that it is “more likely than not” that intention existed (*The Argento Wine Company Limited v. Argento Beijing Trading Company, supra*; *Wal-Mart Stores, Inc. and Wal-Mart China Co. Ltd v. Liangchenyong*, ADNDRC Case No. HKcc-0800008).

Given the widespread reputation of the MERCK Marks, the Panel finds that the public is likely to be confused into thinking that the Domain Names have a connection with Complainant, contrary to the fact. There is a strong likelihood of confusion as to source, sponsorship, affiliation or endorsement of the websites to which the Domain Names are resolved. In other words, Respondent has through the use of the confusingly similar Domain Names created a likelihood of confusion with the MERCK Marks. Noting also that apparently no clarification as to Respondent’ relationship to Complainant is made on the homepages of the Domain Names, potential partners and end users are led to believe that the Domain Names are either Complainant’s sites or the sites of official authorized partners of Complainant, which they are not. Moreover, Respondent did not respond formally to the Complaint. The Panel therefore concludes that the Domain Names were used by Respondent in bad faith.

In summary, Respondent, by choosing to register and use Domain Names, which are confusingly similar to Complainant’s well-known MERCK Marks, intended to ride on the goodwill of Complainant’s trademarks in an attempt to exploit, for commercial gain, Internet users destined for Complainant. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the Domain Names and the conduct of Respondent as far as the websites to which the Domain Names resolve are indicative of registration and use of the Domain Names in bad faith.

The Panel therefore holds that the Complaint fulfils the third condition of paragraph 4(a) of the Policy.

## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names <merck-sun.com>, <mercksun.com>, <sun-merck.com>, <sunmerck.com> be transferred to Complainant.

**Yijun Tian**

Sole Panelist

Dated: December 23, 2011

## **ADMINISTRATIVE PANEL DECISION**

Merck Sharp & Dohme Corp. v. Ignitee Digital Solutions Pvt. Ltd., Amit Debnath  
Case No. D2011-2047

### **1. The Parties**

Complainant is Merck Sharp & Dohme Corp. of Rahway, New Jersey, United States of America, represented by Lowenstein Sandler PC, United States of America.

Respondent is Ignitee Digital Solutions Pvt. Ltd., Amit Debnath of Mumbai, Maharashtra, India.

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

The disputed domain name <merckconsumerhealthcare.com> is registered with BigRock Solutions Pvt Ltd.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 19, 2011. On November 21, 2011, the Center transmitted by email to BigRock Solutions Pvt Ltd. a request for registrar verification in connection with the disputed domain name. On November 23, 2011, BigRock Solutions Pvt Ltd. transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on November 24, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was December 14, 2011. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on December 15, 2011.

The Center appointed Alvaro Loureiro Oliveira as the sole panelist in this matter on December 28, 2011. 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 Merck Sharp & Dohme Corp., a corporation based in the United States of America.

Complainant, together with its affiliated companies, is the owner of all rights to the mark MERCK, as well as a large family of marks formed by the mark MERCK. Complainant has been using the mark since 1887. Complainant is one of the world's leading pharmaceutical companies and owns more than 400 trademark registrations worldwide, for marks incorporating the expression MERCK. It also is part of more than 700 domain names. Proofs of these allegations were presented.

As evidence the documents attached to the Complaint, Complainant's mark MERCK was extensively promoted, without limitation, in print advertisements, in medical journals, promotional materials, packaging, medical informational materials, television advertising and direct mailings.

The mark MERCK has acquired fame and celebrity, symbolizing the goodwill that Complainant has created in its mark. Evidence of such fame in the form of unsolicited media attention, including newspaper and magazine articles, was duly presented.

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

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

Complainant is the owner of the trademark MERCK, which is part of more than 400 trademark registrations and more than 700 domain names worldwide. Due to Complainant's operations throughout the world, trademark MERCK has acquired international recognition and is clearly linked to Complainant.

Trademark MERCK is associated to the pharmaceutical business, being this Complainant's core business. The use of the MERCK mark has started more than a hundred years ago, either alone, or associated with other elements, forming the "MERCK family of marks".

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

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

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

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

The disputed domain name <merckconsumerhealthcare.com> is, indeed, confusingly similar to the MERCK trademark, as it contains the entirety of the mark together with words of common use in relation to Complainant's line of business.

Complainant, on its turn, has presented evidence of use and ownership of the mark MERCK worldwide, as well as evidence of the renown of the MERCK mark.

Given the above, the Panel concludes that the disputed domain name is confusingly similar with the registered mark of Complainant, pursuant to the first element of the Policy.

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

Given the clear evidence that the MERCK mark is widely known as identifying Complainant's business and products, the Panel finds that Complainant has established *prima facie* that Respondent has no rights or legitimate interests in the disputed domain name. Hence, the Panel finds that the Respondent cannot claim to have been using the trademark MERCK without knowing Complainant's rights to it.

Besides, the words "consumer health care", instead of distinguishing the disputed domain name from Complainant, makes even more confusion for Internet users, as these words are descriptive and refer to Complainant's business. In fact the choice of these words leaves the impression that Respondent intended to cause confusion with Complainant's mark. This, among other facts, leads the Panel to conclude that Respondent's interests cannot have been legitimate.

Complainant has not licensed or authorized Respondent to use its trademark or to register it as a domain name. In the circumstances of this case, the fact that the website associated with the disputed domain name is inactive is a further indication that Respondent has not rights or legitimate interests.

The Panel, thus, finds for the Complainant under the second element of the Policy.

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

The facts outlined in items A and B above can be considered as further evidence of Respondent's bad faith in obtaining the disputed domain name.

The Respondent did not respond to Complaint. This behavior has been considered as a further evidence of bad faith in registering and using a domain name in several previous disputes insertion. In this case, it also supports a finding that the disputed domain name was registered and used in bad faith.

The association of the mark MERCK with the descriptive words "consumer health care" can be seen as clear evidence that Respondent wishes to give an overall impression that the disputed domain name leads to an official web site, which is not true. Even if the disputed domain name is currently not directed to any web site in particular, this attempt to mislead consumers is also evidence of bad faith from Respondent.

All the points above lead to the conclusion by this Panel that Respondent must have been aware of Complainant and that Respondent registered and is using the disputed domain name in bad faith.

The Panel finds that Complainant has also proved the third element 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 <merckconsumerhealthcare.com> be transferred to the Complainant.

**Alvaro Loureiro Oliveira**

Sole Panelist

Dated: January 16, 2012

# **ANNEX 5**

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Merck & Co, Inc. v. Merck KGaA

Case No. LRO2013-0069

### **1. The Parties**

Objector/Complainant is Merck & Co, Inc., United States of America, represented by Reed Smith LLP, United States of America.

Applicant/Respondent is Merck KGaA, Germany represented by Bettinger Schneider Schramm, Germany.

### **2. The applied-for gTLD string**

The applied-for gTLD string is <.merck> (the “Disputed gTLD String”).

### **3. Procedural History**

The Legal Rights Objection (“LRO”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the “Procedure”). An amended Objection was filed with the WIPO Center on March 27, 2013.

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the Objection on March 28, 2013 and has determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the “WIPO Rules for New gTLD Dispute Resolution”).

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified Applicant of the Objection, and the proceedings commenced on April 16, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 15, 2013.

The WIPO Center appointed Willem J. H. Leppink as the Panel in this matter on June 14, 2013. 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 WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

No consolidation request was received within the time period provided under Article 12(b) of the Procedure.



## 4. Factual Background

### Objector

Objector is a United States company, located in Whitehouse Station, New Jersey, United States. It is one of the largest pharmaceutical companies in the world.

Merck Sharp & Dohme Corp and Merck Canada Inc. are wholly owned subsidiaries of Objector.

Merck Sharp & Dohme Corp, a United States corporation, is the owner of *inter alia* a United States trademark MERCK (stylized), with a registration date of February 15, 1916 (registration number 108566) and United States trademark MERCK (word mark) with a registration date of June 30, 1998, (registration number 2169031). Merck Canada Inc., a Canadian company, is the owner of a Canadian trademark MERCK (word mark) with a registration date September 13, 1951 (registration number UCA40567). The trademarks are registered for *inter alia* pharmaceutical products.

Objector is the owner and operator of the website “www.merck.com”.

Merck Sharp & Dohme Corp also owns various trademark registrations for MERCK SHARPE & DOHME throughout the world, outside Canada and the United States. Based on the information provided by Objector, it appears that only in Cuba, Ecuador, Iran (Islamic Republic of), Myanmar, Sudan, Syrian Arab Republic and Uzbekistan the MERCK SHARPE & DOHME trademarks are owned by Objector itself.

### Applicant

The Applicant of the Disputed gTLD String, Applicant in this Procedure, is a German partnership limited by shares, located in Darmstadt, Germany. It is one of the world’s oldest chemical and pharmaceutical companies. It has been an industry leader since its founding as the Engel-Apotheke (Angel Pharmacy) in 1668. It operates its worldwide business in more than 180 countries through over 250 affiliated companies which use Merck as the sole element or as component of their company name.

Applicant is the owner of various trademark registrations in countries throughout the world for the word mark MERCK for *inter alia* pharmaceutical products, including the German trademark filed on January 11, 1900 (registration number) DD45659) and the Community Trademark applied for on April 1, 1996 (registration number 283986).

Applicant’s application for the Disputed gTLD String was originally posted on June 13, 2012 under Application ID: 1-980-7217. <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/1631>. In that application the mission/purpose of the application was described *inter alia* in the following terms: “The “.MERCK” top-level domain will enable the Merck Community to communicate with all stakeholders as one group, and to communicate information about the Merck brand in a unified and global manner. The “.MERCK” space will further help Merck unite all members of the Merck Community under one single name online, and provide the Merck Community with a universal, comprehensive forum through which to present its information to the public.”

### The common history of Objector and Applicant

The groups of companies of Objector and Applicant have a common history. Objector was founded as subsidiary of the Applicant. It has become an independent American company at the end of the First World War as a result of United States confiscation legislation.

In the 1930s the groups of companies of Objector and Applicant agreed on co-existence. The group of companies of Objector obtained the right to use the name MERCK in the United States and Canada. The group of companies of Applicant obtained the right to use the name MERCK everywhere except for the United States and Canada. The group of companies of Objector mainly uses the name and trademark MSD

for its activities outside the United States and Canada. The co-existence agreements were amended in the 1970s.

## **5. Parties' Contentions**

### **A. Objector**

Objector's case is in essence straightforward. It asserts trademark rights for MERCK, to which it contends the Disputed gTLD String is identical.

Applicant is a German-based company that long ago was part of a single organization with Objector. That single entity was split into two nearly one hundred years ago. Since then, both Objector and Applicant have used "MERCK" marks in countries around the world pursuant to a series of co-existence agreements. Those agreements, however, were drafted decades before the Internet even existed, and do not address the Parties' use of their respective MERCK-related marks on the Internet, in social media or in other aspects of today's global marketplace. Applicant cannot so easily disregard the millions of people around the world who recognize "MERCK" names and marks as corresponding to Objector.

In Section 18(c) of its application, Applicant states that its proposed ".MERCK" domain names will not be used in any way that "infringes any other third [parties] rights." While Applicant has proposed to implement geographically-based limitations that purportedly would give only parties outside of North America the ability to register domain names and access websites within the Disputed gTLD String, this geo-targeting proposition would serve only to enhance, rather than reduce, public confusion. Millions of Internet users searching for "Merck" would find themselves either rerouted from one website to another with no clear understanding of why or simply unable to access information that should be available for all to view.

More broadly, Applicant's geo-targeting proposal represents a plan to "balkanize" the Disputed gTLD String in a way that is contrary to the very nature of gTLDs and constitutes undue restrictions to the very nature of free Internet access. Given Objector's global presence as one of the largest and best known pharmaceutical companies in the world, there is no practical or legitimate manner in which Applicant can operate the Disputed gTLD String in a way that would not cause severe public confusion. Granting Applicant ownership of the Disputed gTLD String would irreparably harm the considerable brand equity that Objector has built in its MERCK marks over more than a century. It would also cause severe confusion throughout the international web-based marketplace. Objector has invested millions of dollars and countless hours for generations to build its family of MERCK marks into one of the most recognized and well-known brands in the healthcare industry. Through programs such as its "Merck for Mothers," Objector offers leadership on issues such as maternal mortality and family planning, services that it provides using its family of MERCK marks. In addition, Objector's Merck Foundation has allocated more than \$600 million to educational and non-profit organizations. Since 2008, Objector has ranked among the top three pharmaceutical companies in the Access to Medicine Index (ATMI) and number one among corporate philanthropy donors in the ATMI. Objector has also established a prominent presence on the internet. Websites based on Objector's family of MERCK marks draw more than four million visitors per year from the U.S. and Canada alone. As between Applicant and Objector, Objector has a stronger or at least equal claim to the Disputed gTLD String, and has thus filed its own standard and community applications for registration thereof. Applicant should accordingly be denied registration of the Disputed gTLD String.

Therefore Objector's key argument is that Applicant presumably wishes to use the Disputed gTLD String to promote its own family of MERCK-related marks, but cannot do so without infringing upon, and irreparably harming, Objector's own rights and/or causing considerable confusion to the relevant public. Applicant's stated intent to create a single, unified corporate brand on a global basis via the Disputed gTLD String in disregard of the considerable goodwill that Objector has built in its family of MERCK marks through nearly a century of global medical, scientific and philanthropic services contravenes both the spirit of ICANN's goal in establishing global gTLDs and Objector's long established rights.

## **B. Applicant**

Applicant expressly denies Objector's contentions.

Objector has taken numerous steps in an unauthorized attempt to dramatically expand its use of the MERCK mark in direct violation of Applicant's legal rights, and in a manner contrary to the provisions of the co-existence agreements. The violations include its applications through Objector's affiliated company Merck Registry Holdings, Inc. for the <.merck> gTLD.

Objector has also registered the domain name <merck.com> and various other domain names which include the element "merck" and also use the same name for social media such as Facebook, Twitter and LinkedIn. All of the above websites are not geo-limited to views in North America. These activities are outside the boundaries of the co-existence agreements and constitute an infringement of Applicant's rights.

Applicant and Objector (and/or its group companies) are currently involved in legal proceedings before the District Court of Hamburg, Germany and the High Court of Justice in London, United Kingdom of Great Britain and Northern Ireland.

Applicant uses geo-targeting tools to ensure that visitors from North America cannot access website content in which Applicant is identified as "Merck". Internet users in North America will be redirected to "www.emdgroup.com". Applicant has expressly indicated that it will use similar geo-targeting tools with the Disputed gTLD String.

The other contentions of Applicant and rebuttals to the contentions of Objector will be discussed in the Discussion and Findings.

## **6. Discussion and Findings**

### **Introduction**

Pursuant to Section 3.2.1 of the ICANN gTLD Applicant Guidebook (version 2012-06-04 Module 3) (the "Guidebook") a formal objection to an application for a New gTLD may be filed on any one of four grounds, one of which is the Legal Rights Objection. The basis for a Legal Rights Objection is that "the applied-for gTLD string infringes the existing legal rights of the objector".

By virtue of Section 3.2.2.2 of the Guidebook: "A rightsholder has standing to file a legal rights objection. The source and documentation of the existing legal rights the objector is claiming (which may include either registered or unregistered trademarks) are infringed by the applied-for gTLD must be included in the filing."

Accordingly, for a Legal Rights Objection to succeed Objector has to satisfy the Panel that it has relevant existing legal rights and that use of the string comprising the potential new gTLD infringes those rights. In this case Objector relies upon its rights as a licensee in respect of Objector's trademark, details of which are provided in the Factual Background (Section 4 above).

Guidance as to how the Panel is to approach Legal Rights Objections may be found in Section 3.5.2 of the Guidebook, which reads as follows:

"In interpreting and giving meaning to GNSO Recommendation 3 ('Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law'), a DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark ('mark') ..., or unjustifiably impairs the distinctive character or the reputation of the objector's mark ..., or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark ...."

The Guidebook then goes on to provide that in the case where the objection is based on trademark rights, the panel will consider eight listed non-exclusive factors. The Panel will deal with each of these factors further below.

### **Objector's Existing Legal Rights**

As discussed above, Section 3.2.2.2 of the Guidebook requires that “[t]he source and documentation of the existing legal rights the objector is claiming (which may include either registered or unregistered trademarks) are infringed by the applied-for gTLD must be included in the filing.”

Objector has been relatively unclear about its standing. Objector relies mainly on rights owned by its wholly owned subsidiaries Merck Sharp & Dohme Corp and Merck Canada Inc., and in particular on trademark rights in the United States and Canada in relation to MERCK, without, however, giving detail about any licence agreement between Merck Sharp & Dohme Corp and Merck Canada Inc. as licensors and Objector as licensee. Also, although Objector refers in several places in the Objection to its name, which includes the element “Merck”, it does not make clear what rights in addition to the (registered) trademark rights it can invoke vis-à-vis third parties in certain countries, notably any common law trademarks. The Panel further finds that the Objection does not particularly address Objector's asserted ownership of the abovementioned subsidiary companies.

With the above observations, the Panel nevertheless finds adequate basis for a finding that Objector has standing in the present case, whether through controlled entities or through direct ownership of trademark rights sufficient for present purposes. To this preliminary finding, the Panel adds that in its view this case does not turn on the Parties' trademark rights.

### **Trademark Infringement**

Objector contends that Applicant cannot operate the Disputed gTLD String without infringing Objector's trademark.

Objector contends that this Objection is valid and should be upheld because the potential use of the Disputed gTLD String by Applicant:

- (i) takes unfair advantage of the distinctive character or the reputation of Objector's registered trademark; and/or
- (ii) unjustifiably impairs the distinctive character or reputation of Objector's registered trademark; and/or
- (iii) otherwise creates an impermissible likelihood of confusion between the Disputed gTLD String and Objector's mark.

If Applicant is granted the Disputed gTLD String necessarily, as contended for by Objector, Applicant will be using “MERCK” in the course of trade; it will thus be using in certain territories in the course of trade a sign, which is similar to Objector's trademark in relation to identical or similar services.

This is the essence of this dispute between the Parties. Objector has rights to use MERCK in certain parts of the world and Applicant has rights to use MERCK in other parts of the world. As a result Objector could infringe Applicant's rights would it use MERCK in those last mentioned parts of the world and Applicant could infringe Objector's rights when it uses MERCK in those first mentioned parts.

The starting point of this case is that Objector and Applicant are both *bona fide* users of the MERCK trademark, albeit for different territories.

The question is whether a *bona fide* trademark owner that owns trademark rights in certain countries but does not have rights to a certain trademark in all countries of the world, should for that reason be prevented from obtaining a gTLD. In the view of the Panel, such a proposition does not make sense. If the opposite

view would be accepted, it would be expected from any trademark owner interested in a gTLD to have trademark registrations in all countries of the world as otherwise another party could register one trademark in an “uncovered” country and thus prevent the first trademark owner from applying for and using its own gTLD.

In essence there should not be a significant difference between the criteria for the legal rights objection as included in the Guidebook on the one hand and the provisions included in the Uniform Domain Name Dispute Resolution Policy (“UDRP”). If the applicant for a new gTLD is *bona fide*, it will not be likely that one of the three criteria will be met. It might be that advantage of the distinctive character or the reputation of the objector’s registered trademark is taken, but it is then likely not unfair. It might be that the distinctive character or reputation of the objector’s registered trademark is being impaired, but it is likely justified. It might be that a likelihood of confusion between the Disputed gTLD String and the objector’s mark is created, but it is not necessarily impermissible.

Of course a rejection of the Objection does not preclude Objector from taking regular legal action should the use of the Disputed gTLD String by Applicant be infringing. It is, however, not for this Panel to anticipate on all the possible types of use Applicant could make of the Disputed gTLD.

It is also not for this Panel to interpret the existing coexistence agreements and arrangements between the Parties. Should the application of a new gTLD allegedly violate any such agreement or arrangement, it will be for the Parties to settle their dispute by means of the dispute resolution provisions of the contracts governing their relationship or as provided under applicable law.

For the aforementioned reasons the Panel rejects the Objection.

In reaching the above conclusion, the Panel has considered the following non-exclusive list of eight factors.

The Panel addresses each of them in turn:

- i. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to Objector’s existing mark.

To give effect to this factor, the Guidebook as such does not provide for any detailed. The Panel takes the view that at a global level and in relation to Internet identifiers, the most suitable detailed test to apply is the test for the first element under the UDRP The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”) in that sense may be taken to reflect internationally recognized principles of law in relation to Internet identifiers.

WIPO Overview 2.0 describes this test as follows:

“The first element of the UDRP serves essentially as a standing requirement. The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms [regarding the latter see further paragraph 1.3 below] typically being regarded as insufficient to prevent threshold Internet user confusion. Application of the confusing similarity test under the UDRP would typically involve a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name. While each case must be judged on its own merits, circumstances in which a trademark may not be recognizable as such within a domain name may include where the relied-upon mark corresponds to a common term or phrase, itself contained or subsumed within another common term or phrase in the domain name (e.g. trademark HEAT within domain name theatre.com).

However: Some panels have additionally required that, for a domain name to be regarded as confusingly similar to the complainant's trademark, there must be a risk that Internet users may actually believe there to

be a real connection between the domain name and the complainant and/or its goods and services. Such panels would typically assess this risk having regard to such factors as the overall impression created by the domain name, the distinguishing value (if any) of any terms, letters or numbers in the domain name additional to the relied-upon mark, and whether an Internet user unfamiliar with any meaning of the disputed domain name seeking the complainant's goods or services on the world wide web would necessarily comprehend such distinguishing value vis-à-vis the relevant mark.

The applicable top-level suffix in the domain name (e.g., ".com") would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark. The content of a website (whether it is similar to or different from the business of a trademark holder) would usually be disregarded in the threshold assessment of risk of confusing similarity under the first element of the UDRP, although such content may be regarded as highly relevant to assessment of intent to create confusion (e.g., within a relevant market or language group) under subsequent UDRP elements (i.e., rights or legitimate interests and bad faith)."

As the Objector's trademark MERCK is the essence of the Disputed gTLD String, the Panel finds that the Disputed gTLD String and Objector's trademark are identical.

ii. Whether Objector's acquisition and use of rights in the mark has been *bona fide*.

Objector and Applicant share a common history in relation the trademark MERCK and there is nothing before the Panel that suggests that Objector's acquisition and use of rights in the mark has not been *bona fide*.

iii. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of Objector, of Applicant or of a third party.

There is no doubt that in certain markets there is recognition in the relevant sector of the public that Merck is the mark of Objector and that in other markets that it is the sign of Applicant. No relevant information is before the Panel as to third-party rights.

iv. Applicant's intent in applying for the gTLD, including whether Applicant, at the time of application for the gTLD, had knowledge of Objector's mark, or could not have reasonably been unaware of that mark, and including whether Applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.

Applicant had – given the common history referred to above – obviously knowledge of Objector's mark. There is, however, nothing before this Panel that would lead to conclusion the Applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.

v. Whether and to what extent Applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by Objector of its mark rights.

This factor will be discussed together with the factor mentioned under vi.

vi. Whether Applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been *bona fide*, and whether the purported or likely use of the gTLD by Applicant is consistent with such acquisition or use.

Applicant has used MERCK for many years in connection with the *bona fide* offering of goods and services and owns trademarks for MERCK in many countries of the world. In the view of the Panel such *bona fide*

use as such does not interfere with the legitimate exercise by Objector of its trademark rights. If Applicant would use the Disputed gTLD String in a way that infringes the rights of Objector, Objector shall be free to take the appropriate legal measures. The purported use of the gTLD by Applicant is consistent with use Applicant has made of the MERCK trademarks.

vii. Whether and to what extent Applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by Applicant is consistent therewith and *bona fide*.

Applicant has been commonly known by the name MERCK as it is the distinctive element of its full name. Given the fact that also parts of the group of companies to which Applicant belongs uses the trademark MERCK as trading name, the Panel considers that Applicant is commonly known by a sign that corresponds to the Disputed gTLD String. As discussed above, the Panel does not see that use Applicant would make of the Disputed gTLD String would not be consistent or *bona fide* therewith.

viii. Whether Applicant's intended use of the gTLD would create a likelihood of confusion with Objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

It is possible that Applicant's use of the Disputed gTLD String could create a likelihood of confusion with Objector's mark as to the source, sponsorship, affiliation, or endorsement of the Disputed gTLD String. However, such possible confusion would not be greater than any that may already exist as a result of two similar companies using a similar trademark as the result of a common history. Applicant has made it clear that it will take all necessary measures, including geo-targeting, to avoid that Internet users in the territories in which Objector has trademark rights, will be able to visit websites that use the Disputed gTLD String. Should Applicant use the Disputed gTLD String in a way that infringes the rights of Objector, Objector shall be free to take the appropriate legal measures.

Against this background, the Panel on the record before it determines that the Objection fails. The Panel adds here that this finding is without prejudice to any judicial proceedings existing now or in future involving the Parties.

## 7. Decision

The Panel finds that the potential use of the Disputed gTLD String by Applicant does not:

- (i) take unfair advantage of the distinctive character or the reputation of Objector's registered or unregistered trademark or service mark, or
- (ii) unjustifiably impair the distinctive character or the reputation of Objector's mark, or
- (iii) otherwise create an impermissible likelihood of confusion between the Disputed gTLD String and Objector's mark.

The Panel rejects the Objection.

[signed]

**Willem J.H. Leppink**  
Sole Panel Expert  
Date: July 31, 2013

# **ANNEX 6**



January 2, 2014

Ms. Christine Willett  
12025 Waterfront Drive, Suite 300  
Los Angeles, CA 90094-2536



Re: Letter of Opposition for Application No 1-980-7217 and Letter of Support for Application No 1-1702-73085

Dear Ms. Willett:

We would like to take this opportunity to express our support for Merck & Co., Inc.'s gLTD application number 1-1702-73085 for the domain .MERCK for the "Merck Community", and to note our objection to the gTLD application number 1-980-7217 as filed by Merck KGaA for the same domain.

We would like to raise our concerns to the ICANN Board and evaluation panels regarding the Merck kGaA application and its proposed operation. Through Helen Keller International's global efforts to improve access to health care and alleviate suffering and loss of productivity caused by blindness, malnutrition and disease, we have worked closely with Merck & Co., Inc. and its community of philanthropic foundations, non-profit organizations, and health and education programs on several initiatives. Through these collaborations, we have come to appreciate and identify with the values and goals of the Merck Community, formed by Merck & Co., Inc. The Merck Community has a truly global footprint via its economic, educational and philanthropic activities across multiple health care sectors from the fight against HIV/AIDS, to the provision of vaccines and medicines to aid in the fight against diseases such as rotavirus and onchocerciasis (river blindness), to the promotion of family planning services and prevention of maternal mortality.

Helen Keller International and Merck & Co. have partnered for more than 25 years to address important health challenges. Chief among our collaborations has been our work to eliminate river blindness. In 1987, Merck & Co. established the Mectizan® Donation Program based on a community directed treatment model. This health care innovation places the power to control river blindness in the hands of community members themselves by building partnerships between communities and health care systems that can be sustained over time with minimal resources after initial technical assistance and training are provided. These systems now cover more than 100 million people each year. Our own partnership with Merck & Co. reaches more than 12 million people per year, but the impact of the collaboration is far greater as Helen Keller International utilizes this innovative delivery mechanism in service of multiple global health challenges, including malnutrition, cataract blindness, and the fight against other debilitating tropical diseases.

As we see it, the operation of the .MERCK TLD as proposed by Merck KGaA on a closed basis, exclusively for their internal, corporate use would be detrimental to the Merck Community established by Merck & Co., Inc. and the wider network of communities, initiatives and educational programs that it supports. As access to and usage of the Internet grow on a worldwide basis, more people and organizations are going to be looking for information online relating to the Merck Community and its economic, educational and philanthropic activities. They would likely be drawn to a .MERCK TLD expecting to find information relating to the Merck Community and its global network of partners. However, if the .MERCK TLD is operated in the closed manner proposed by Merck KGaA, Internet users will not only be unable to access information relating to the Merck Community, but are also likely to be confused as to the nature of the TLD and assume that there is a

genuine connection with the larger Merck Community. Beyond this possibility for confusion is the potential risk that these information seekers would be misled, thinking incorrectly that the .MERCK TLD is tied to the global reputation of the Merck Community and its educational and philanthropic activities, rather than in fact existing solely to promote Merck KGaA's own corporate activities.

This would be an undesirable situation and could have adverse impacts on the Merck Community's philanthropic activities to improve living conditions and access to health care across the world. Thus, we urge you to grant the .MERCK LTD to Merck & Co., Inc. as set forth in their application and not to grant use of this domain to Merck KGaA.

Sincerely yours,



Kathy Spahn  
President and CEO

cc: James Ciriello, President of Merck Registry Holdings, Inc.





April 1, 2016

Brenda D Colatrella  
Executive Director, Corporate Responsibility  
Merck & Co., Inc.  
2000 Galloping Hill Road  
Kenilworth, NJ 07033 USA

### Letter of Support for US Merck's Community application

Dear Brenda,

We would like to take this opportunity to express our support for Merck & Co., Inc.'s gLTD application number 1-1702-73085 for the domain .MERCK for the "Merck Community" and to note our objection to the gTLD application number 1-980-7217 as filed by Merck KGaA for the same domain.

We are writing to express our support for the application filed by Merck Registry Holdings, Inc., a subsidiary of Merck & Co., Inc. ("Merck"), to operate the .MERCK gTLD for the benefit of the Merck Community. The Merck Community is centered around the economic, educational and philanthropic activities conducted by Merck.

Through our work with Merck, the Merck Company Foundation and their many other charitable foundations and educational programs in the furtherance of our mission we identify with the values and goals of the Merck Community as we strive towards improving access to health care and the eradication of poverty and hunger.

The Task Force for Global Health has partnered with Merck for 29 years on its pioneering donation of Mectizan for the control and elimination of river blindness and lymphatic filariasis, two devastating tropical parasitic diseases. The donation of Mectizan is the longest ongoing drug donation of its kind. Merck and The Merck Mectizan Donation Program changed the face of global health by setting a precedent and creating a model for pharmaceutical donations of anti-parasitic and anti-bacterial medications that can be distributed on a massive scale for a group of diseases known as "Neglected Tropical Diseases" (NTDs). As a result of Merck's generosity, billions of people are now treated annually for NTDs, which has dramatically improved access to medicines in the developing world. Merck's Mectizan Donation Program and its partners successfully rid four countries of river blindness in Latin America and two more are not far behind. This success is also being seen in Africa as river blindness and lymphatic filariasis are disappearing due to the drugs' interference with disease transmission.

*The Task Force for Global Health is a non-profit 501(c)(3) organization.*

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Letter to Merck & Co., Inc.  
Brenda D. Colatrella

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We strongly believe that the operation of the .MERCK TLD to serve as a trusted, hierarchical, and intuitive namespace for the Merck Community will greatly assist in the continuing philanthropic endeavours of the Merck Community and the programs that they support and the beneficiaries of these programs worldwide. By operating the .MERCK TLD in a manner that restricts domain name registrations and use to members of the Merck Community, the .MERCK namespace will be providing genuine, reliable and trusted content related to the Merck Community and its economic, educational and philanthropic activities. As access to the Internet and usage of the Internet grows on a worldwide basis, it is vital that the Merck Community keeps pace with this changing landscape not only to ensure that information relating to their community activities is accessible, but also to ensure that Internet users can interact with the Merck Community and its economic, educational and philanthropic activities in a secure online environment.

As such we would like to express our support for the application filed by Merck Registry Holdings, Inc. for the .MERCK gTLD to be operated for the benefit of the Merck Community and the wider network of partners and communities who work together to improve living conditions and access to health care across the world.

Sincerely,

David Ross, ScD  
President