



**Regional Court of Frankfurt am Main  
6th Civil Division**

**File no.:** 2-06 0 13/16

Please quote the above file number  
in all submissions

*[Coats of Arms of the Federal State of Hesse]*

**Order**

**In the legal dispute**

Merck KGaA,

represented by personally liable shareholders in their capacity as members of the  
management Dr. Kley, Dr. Beckmann et al., Frankfurter Str. 250, 64293 Darmstadt,

– Applicant –

Counsel of record: Law firm Gleiss Lutz,  
Lautenschlagerstrasse 21, 70173 Stuttgart,  
Reference: 70024-16

versus

1. MSD Registry Holdings, Inc., 2000 Galloping Hill Road, Kenilworth, USA NJ  
07033,
2. Merck Sharp & Dohme Corp., 2000 Galloping Hill Road, Kenilworth, USA NJ  
07033,

– Respondents –

the Regional Court of Frankfurt am Main — 6th Civil Division — acting through Mr.  
Kästner, judge at the Regional Court, Dr. La Corte, judge at the Regional Court and  
Ms. Wehn-Sälzer, judge at the Regional Court **ruled** as follows on 29 January 2016:

The Respondents shall be prohibited by way of interim injunction — due to particular  
urgency, without a hearing — subject to an administrative fine of up to EUR 250,000

or imprisonment for up to six months, to be enforced on their legal representatives, for each single infringement,

1. in the course of trade within the European Union from presenting under the generic top-level domain "merckmsd" the goods and services of Respondent 2 and/or its affiliated undertakings from the pharmaceutical sector, in particular as announced in its application for said domain (Exhibit AST 22), there specifically in sections 18.1, 18.2.3, 18.2.5, 23.1.1 iv., 16.1.1b,
2. in the course of trade within the Federal Republic of Germany from presenting under the generic top-level domain "merckmsd" the company of Respondent 2 and/or its affiliated undertakings in the pharmaceutical sector, in particular as announced in its application for said domain (Exhibit AST 22), there specifically in sections 18.1, 18.2.3, 18.2.5, 23.1.1 iv.-, 26.1.1b.

The Respondents shall bear the costs of the expedited proceedings.

The value in dispute is set at EUR 100,000.

**Grounds:**

**I.**

The Applicant provided the following prima facie evidence:

The Applicant was established in 1664 [sic] and is the oldest pharmaceutical and chemical company. It has been using "Merck" as a corporate name for over 100 years. It is the owner of IR trademark no. 113 70 15 "Merck" for pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical uses, which is afforded protection throughout Europe and on which it primarily bases its trademark claims, as well as Community trademark 283 986 "Merck", in force, for pharmaceutical, veterinary and sanitary preparations, dietetic substances adapted for medical use, which it cites as an alternative. Respondent 2 is a subsidiary of Merck & Co. Inc, a former subsidiary of the Applicant, which was expropriated during the First World War. Respondent 2 is also one of the world's largest pharmaceutical companies. Respondent 1 is a wholly-owned subsidiary of Respondent 2.

A coexistence agreement was concluded – and still exists – between the Applicant and Merck & Co. Inc in 1970, which also applies to the Respondents. Accordingly, the Respondents may only operate under the name "Merck" in the U.S. and Canada. In Germany they are obliged to add a geographical indication to the designation "Merck & Co." which either identifies it as originating from the U.S. or Canada or — as used throughout the rest of the world — the designation "Merck Sharp & Dohme", whereas the Applicant is entitled to use "Merck" on its own.

Respondent 1 applied to competent authority ICANN for registration of the generic top-level domain “.merckmsd” and intends to present the company and products of the Merck Sharp & Dome [sic] Group, in particular those of Respondent 2, under this domain. Now that the Applicant had exhausted the legal remedies available to it against awarding of the top-level domain before ICANN and finally failed, as evidenced by a decision of 10 December 2015, the top-level domain “.merckmsd” is about to be awarded.

The Applicant maintains that the use of the domain “.merckmsd” infringes its trademark rights as well as the rights to its corporate mark.

The Applicant motions

for the Respondents — subject to an administrative fine of up to EUR 250,000 or, alternatively, imprisonment for up to six months for each single infringement, or up to two years in case of persistent infringement, to be enforced on the Respondents' governing bodies — to be prohibited

1. in the course of trade within the European Union from presenting under the generic top-level domain “merckmsd” the goods and services of Respondent 2 and/or its affiliated undertakings from the pharmaceutical sector, in particular as announced in its application for said domain (Exhibit AST 22), there specifically in sections 18.1, 18.2.3, 18.2.5, 23.1.1 iv., 16.1.1b,
2. in the course of trade within the Federal Republic of Germany from presenting under the generic top-level domain “merckmsd” the company of Respondent 2 and/or its affiliated undertakings in the pharmaceutical sector, in particular as announced in its application for said domain (Exhibit AST 22), there specifically in sections 18.1, 18.2.3, 18.2.3, 23.1.1 iv.-, 26.1.1b.

## II.

The application for interim relief is well-founded.

Pursuant to Article 9, 94 et seqq. CTMR, section 15 German Trademark Act in conjunction with the coexistence agreement of 1970, the Applicant may request that the Respondents refrain under the domain “.merckmsd” from presenting the goods and services of Respondent 2 and its affiliated undertakings from the pharmaceutical sector as well as the respective companies themselves.

According to the provisions cited, the Respondents are prohibited from using ".merckmsd" for the products of Respondent 2 or its companies, due to the likelihood of confusion based on the similarity of signs that can already be assumed on account of the coexistence agreement as well as the similarity of the conflicting goods, services and industries.

To this end it is irrelevant how the individual second-level domains or websites used by the Respondents to present the products and companies of Respondent 2 are structured. The mere use of the top-level domain ".merckmsd" for Respondent 2 creates confusion of affiliation among the relevant public and thus likelihood of confusion.

So-called sponsored generic top-level domains are in fact sponsored by an interest group — in this case the Merck Sharp & Dome Group — and aimed at clarifying the affiliation of a (second-level) domain or the content published thereunder with the relevant group (cf. Fezer, *Markenrecht*, 4th ed., Introd. G. para. 7). This function of generic top-level domains and the risk of the relevant public associating the domain ".merckmsd" and, consequently, content relating to Respondent 2, with the Applicant constitutes likelihood of confusion which, according to the statutory provision on signs and the coexistence agreement of 1970, the Applicant does not have to tolerate.

### **Legal remedies**

The order stipulating the interim injunction can be challenged by objection. The objection shall be filed with Frankfurt Regional Court, 60313 Frankfurt am Main, Gerichtsstrasse 2. In the objection, the objecting party shall state the grounds it wishes to assert for the order to be repealed. Objection may only be filed by a lawyer (*Rechtsanwalt*).

The order setting the value in dispute may be challenged by appeal. It shall only be admissible where received by Frankfurt Regional Court, 60313 Frankfurt am Main, Gerichtsstrasse 2 within six months of the decision on the merits having become final or the proceedings having been closed for other reasons.

Where the value in dispute is set more than a month before expiry of this deadline, the appeal may be filed with the court within a month of service or informal notice of its setting. The appeal shall only be admissible if the value of the subject matter of the appeal exceeds EUR 200.00 or the court has allowed the appeal in this order.

Anyone whose rights have been infringed by the present decision shall be entitled to appeal. The appeal shall be filed in writing with or declared before and recorded at the registrar's office of the court specified. It may also be declared before and recorded at the registrar's office of any local court, in which case the date of receipt by the court specified shall be decisive for adherence to the deadline. It shall be signed by the appellant or its authorised representative. The appeal shall identify the

contested decision and state that the appeal is directed against the same. Where only part of the decision is contested the extent of contestation shall be indicated.

**Kästner**

**Dr. La Corte**

**Wehn-Sälzer**

**Certified**

**Frankfurt am Main, 4 February 2016**

*[Stamp: Frankfurt Regional Court]*

*[signature]*

Ritz, Court Employee

Clerk of the Court

*I hereby certify that the foregoing text is a true and accurate translation of the court ruling ("Beschluss") presented to me in copy, issued by Frankfurt Regional Court under file no. 2-06 O 13/16 on 4 February 2016 and drafted in the German language.*

*Frankfurt, 9 February 2016*

*Translator for the English language, sworn and appointed by the Regional Court of Stuttgart, Germany.*

Colin Quirke

