



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

COMPLAINANT: BASF SE (formerly BASF AKTIENGESELLSCHAFT)
RESPONDENT: BASF GROUP (TIANJIN) CO., LTD.
PANELIST: Jeffrey P. Elkinson
DISPUTED DOMAIN NAME: basff.net

1. PARTIES AND CONTESTED DOMAIN NAME

The Complainant is BASF SE (FORMERLY BASF AKTIENGESELLSCHAFT) which has its registered address at Carl-Bosch-Strasse 38, 67056, Ludwigshafen, Germany. Its authorized representative in these proceedings is Hogan Lovells, 11th Floor, One Pacific Place, 88 Queensway, Hong Kong.

The Respondent is BASF GROUP (TIANJIN) CO., LTD, with an address at Shijiazhuang, Hebei, cn 050000. Its legal status is unknown and it has not appointed any authorized representative.

The domain name in dispute is basff.net. The Registrar of the Disputed Domain Name is Web Commerce Communications Limited, doing business as WEBNIC.CC. The Disputed Domain Name was registered on the 6th February 2012 and its expiry date is the 6th February 2013.

2. PROCEDURAL HISTORY

The Complainant filed a Complaint on the 14th June 2012 on the Form C applying to the Asian Domain Name Dispute Resolution Centre (ADNDRC) pursuant to the Uniform Policy for Domain Name Dispute Resolution (“the Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the ADNDRC Supplemental Rules”).

On the 22nd June 2012, the Hong Kong office of ADNDRC notified the Respondent that a Complaint had been filed and that the Respondent had twenty (20) calendar days to submit a response to the Complaint (“the Notification”). The Notification was by TNT delivery and was sent on the 25th June 2012. The contact fax number for the registrant and the administrative contact (being the same) had been provided by Respondent in creating the domain name but an attempt to fax the Respondent on the 25th June 2012 failed due to the machine not answering.

On the 10th August 2012, the Hong Kong office of ADNDRC notified the parties that the sole panelist had been selected and that the case administrator would be transferring the file to the Panelist with the intent that a decision would be rendered on or before the 24th August 2012. On that same day, the file was transferred to the Panelist.

The Respondent had not filed a response in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules or the Notification.

3. FACTUAL BACKGROUND

FOR THE COMPLAINANT

The Complainant is a long established supplier of chemicals, plastics, crude oil and natural gas. It was established in Germany in 1865 and the BASF Group supplies more than 8,000 products to customers in almost all industries across 200 countries and in 2011

generated €73.49 billion of sales. The Complainant owns more than 900 trademark registrations for or incorporating the name BASF in more than 170 countries. Forty of those trademarks are in the Peoples' Republic of China, Hong Kong and Taiwan,(referred to collectively as Greater China). It has also registered its mark in Chinese and the Panelist has been provided with a complete list of all of these trademark registrations (comprising Annexure 2 of the Complaint).

The name and mark are widely known and advertised. BASF expended €44 million in 2006 and, on an annual basis since that date, spends many millions on advertising. The panel was provided with evidence of BASF's ranking as a company on a worldwide basis, being placed 71st out of the Global 500 in 2011 and in previous years BASF had been ranked as the number one chemical company and top company in Germany across all industries.

BASF has been trading with China since 1885 and, in China alone, it has 6,400 employees, 24 wholly owned subsidiaries, 8 wholly owned production facilities and 16 joint ventures. It is the most influential foreign investor in the chemical industry in Greater China and in 2010, its annual revenue sales of locally manufactured and imported products in and from Greater China amounted to €5.8 billion. It has advertised extensively in China and is the subject of media attention for its business operations and financial success. It has received public recognition for its focus on social responsibility and in 2005 was presented with the China Corporate Citizenship in Action award and was cited in an article published by China Newsweek as one of China's top 10 responsible operations. In 2009, BASF invested €141 million in environmental protection and a further €669 million on operating environmental protection facilities. Its clean air technology was introduced to public buses in Beijing in an effort to reduce emissions for the Beijing Olympic Games and this received very wide publicity. In 2011, BASF achieved top ranking in the materials and energy sector in the Carbon Disclosure Leadership Index and the Carbon Performance Leadership Index and was named one of the top 100 China green companies for the fourth consecutive time. All of this extensive

media exposure, together with its successes as a company make the BASF brand globally recognizable as much so in China as anywhere else.

FOR THE RESPONDENT

The Respondent did not provide any response nor participate in any way in these proceedings.

4. PARTIES' CONTENTIONS -

COMPLAINANT'S POSITION

Complainant has highlighted how distinctive the BASF trademark is, associated with the worldwide reputation in those areas cited above. Complainant also points out that the trademark is a made up word which has no meaning in any language and was derived from the German words "Badische Anilin- und Soda-Fabrik" which in English would refer to the "Baden Aniline and Soda Factory." Respondent has sought to incorporate Complainant's trademark in the Disputed Domain Name by the incorporation of the letter "f" as a suffix. Complainant submits that the Disputed Domain Name is identical and/or confusingly similar to its registered trademarks. It submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name as Complainant has not consented to nor authorized the Respondent's use of its trademark in respect of the Disputed Domain Name or otherwise. The provenance of Respondent is unknown despite Complainant's efforts to determine the location of its registered office. It only registered the Disputed Domain Name on the 6th February 2012. The Complainant initiated a search of the official data base of the China Trademarks Office for any trademark registrations or applications in the name of the Respondent or which correspond to the Disputed Domain Name and where located but this did not yield any results. It is noteworthy that Respondent's name utilizes Complainant's trademark whilst the Disputed Domain Name incorporates the letter "f" as a suffix. Further, the website

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operated by Respondent offers chemical products for sale which are in direct competition with those of Complainant and Complainant submits that Respondent has adopted this name with a view to creating the impression that it is a legitimate business partner or a branch of Complainant. Respondent not only has a website but actively contacts potential customers by email. Complainant has put forward in evidence an email from Respondent to one of its distributors in Australia in which Respondent made an overt attempt to solicit their business (Annexure 25 to the Complaint). Complainant submits that Respondent not only has no rights or legitimate interests in the Disputed Domain Name but, in the circumstances, it has been registered and is being used by the Respondent in bad faith.

RESPONDENT'S POSITION

The Respondent did not provide any response nor participate in any way.

5. FINDINGS

Having regard to the submissions of Complainant noting that:-

(a) The Rules provide at paragraph 5(e) as follows:-

"If a Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint."

No exceptional circumstances have been raised and the Panel proceeds to decide the dispute based upon the Complaint and the submitted evidence.

(b) The language of the Proceedings – Paragraph 11(a) provides:-

"Unless otherwise agreed by the Parties, as specified otherwise in the Registration Agreement, the language of the administrative proceedings shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administration proceedings."

The language of the Registration Agreement is English. The Panel sees no reason why the language of this proceeding should not also be in English.

(c) Paragraph 4 of the Policy provides that the Complainant must prove that each of these three elements are present:-

- i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark which the Complainant has rights;
- ii. Respondent has no rights or legitimate interest in respect of the Disputed Domain Name, and
- iii. The Disputed Domain Name has been registered and is being used in bad faith.

i. Identical and Confusingly Similar

The Panelist is satisfied that the Disputed Domain Name is identical and/or confusingly similar to the mark in which Complainant has rights, namely BASF. It is clear that BASF is a unique mark, distinctive and with global exposure. The attempt to distinguish the Disputed Domain Name from that of Complainant by adding the letter “f” to the name does not negative the effect. It remains confusingly similar not least as it resolves to a website where the name BASF is prominent. The device of adding an extra letter to Complainant’s trade mark name can yield no benefit to Respondent in the face of a mark that has more than 900 registrations in more than 170 countries. Support for this rationale is seen in the cases of the *Coca-Cola Company v. Whois Privacy Service WIPO Case No. D2010 – 0088* and *Diageo Ireland v. Guinnessclaim WIPO Case No. D2009 – 0679*.

ii. Respondent has no Right or Legitimate Interest in Respect of the Disputed Domain Name.

Complainant was established in 1865 in Germany and commenced trading in the Asian region in 1885. Its first trademark registration for the name was in 1959 worldwide and in the PRC in 1988. Respondent's first use of the Disputed Domain Name appears to be February 2012. Complainant has not licensed nor authorized the use of their mark to Respondent and effectively Complainant has shifted the burden of proof to Respondent to establish that it has legitimate rights or interests in the disputed domain name. Respondent has not participated in these proceedings but in any event, the Complainant has satisfied me that Respondent has no right or legitimate interest in respect of the Disputed Domain Name.

iii. Bad Faith

Paragraph 4(b) of the Policy sets out the evidence that is required in determining whether there has been registration and use of a domain name in bad faith. Various circumstances are set out in that paragraph any of which is found by the Panelist to be present, shall be evidence of the registration and use of a domain name in bad faith. I refer in particular to two of those circumstances:-

"4(b)

- (iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or*
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of your website or location or of a product or service on your website or location."*

Given that I have already determined that Respondent has no rights or legitimate interests as regards the Disputed Domain Name, the website to which it resolves promotes and sells chemical products in the name of the BASF GROUP (TIANJIN) CO., LTD. There the information provided by Respondent seeks to give the impression that the Respondent is part of the BASF Group and refers to investment in China of 880 million (no currency specified) and otherwise gives an impression of connection with the Complainant. Chemical products are being advertised on the website, again no doubt creating confusion in the mind of visitors to that website. I accept Complainant's submission that the fact that Respondent uses the website to advertise chemical goods in direct competition with those of Complainant further indicates that Respondent was aware of Complainant's reputation and business activities and Complainant properly refers the Panelist to previous decisions which have upheld that such conduct constitutes additional evidence of bad faith – see *Bartercard Ltd & Bartercard International Pty Ltd. v. Ashton-Hall Computer Services*, WIPO Case No. D2000-0177; *Caesars World, Inc. v. Forum LLC*, WIPO Case No. D2005-0517. Complainant refers me to other domain name disputes in which BASF has been involved where it has been held that BASF has established a significant reputation in China, that BASF is a world renown supplier of chemical products but I need not rely on those decisions given the overwhelming evidence presented to me in this particular instance of such facts. I am further persuaded of the bad faith on the part of Respondent by the fact of the email sent on the 7th May 2012 from Respondent when it contacted Redox Pty. Ltd. in Sydney, Australia, a distributor of Complainant's products stating:-

"We know you are in the market for chemical goods. We can supply you the goods and hope build the cooperation with you and your company.

Please contact with us so that we quote you our best price for you.

Best regards,

Kitty

BASF Group (Tianjin) Co., Ltd."

This email was sent from an address at the Disputed Domain Name.

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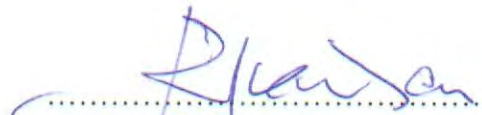
I am satisfied and find that the Disputed Domain Name has been registered and is being used by the Respondent in bad faith.

7. CONCLUSION

The Panelist has set out the reasoning for the findings that the Disputed Domain Name is confusingly similar to Complainant's registered trademark, BASF, that the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name and that the Disputed Domain Name was registered and is being used in bad faith by the Respondent.

In the circumstances, I direct that the disputed domain name, "basff.net" be transferred to the Complainant, BASF SE.

DATED this 24th day of August 2012.



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JEFFREY P. ELKINSON
PANELIST