



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-18010149
Complainant:	BASF SE
Respondent:	MASTER LLS
Disputed Domain Name(s):	< basf-ppu.com >

1. The Parties and Contested Domain Name

The Complainant is BASF SE, which address is Carl-Bosch Strasse, 67056, Ludwigshafen, Germany.

The Respondent is MASTER LLS, which address is 10-59 Tevosyana St., Elektrostal, Moscow region, 144012.

The domain name at issue is < basf-ppu.com > (the “Domain Name”). The Domain Name is registered by Respondent with REG.RU LLC, passage Berezovoy Roshchi, 12, Suite 4, Moscow, 125252, Russia.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center”) on July 13, 2018. On July 17, 2018, the Center transmitted by email to REG.RU LLC a request for registrar verification for the Domain Name. On July 20, 2018, REG.RU LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint and disclosing that the language of the Registration Agreement is Russian.

The Center sent an email communication to the Complainant on July 20, 2018 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. On September 5, 2018, the Complainant submitted the amended Complaint.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for

Uniform Domain Name Dispute Resolution Policy effective from April 28, 2016 (the “Supplemental Rules”).

Under Paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 20, 2018. Under Paragraph 5 of the Rules, the due date for filing a Response by the Respondent was October 10, 2018. The Respondent submitted no response by this deadline date.

The Center appointed Olga Zalomiy as the sole panelist in this matter on October 15, 2018. The Panel finds 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 is proficient in both the English and the Russian languages.

3. Factual background

The Complainant is a German chemical company, which owns the well-known BASF trademark. Among others, the Complainant owns the following trademark registrations:

- BASF US Trademark No. 0790582 registered on June 8, 1965 in class 01;
- BASF US Trademark No. 0809060 registered on May 31, 1966 in class 01;
- BASF US Trademark No. 0791033 registered on June 15, 1965 in class 09.

The Respondent is a legal entity named MASTER LLS, which is located in Russia. The Respondent registered the Domain Name on October 3, 2017. The Domain Name resolves to a website in Russian, which offers for sale unauthorized versions of the Complainants polyurethane goods and polyurethane goods manufactured by Elastokam LLC.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Complainant asserts that the Domain Name is identical and/or confusingly similar to the BASF trademark in which the Complainant has rights. The Complainant contends that the Domain Name is identical and confusingly similar to the BASF trademark and is likely to create confusion in the mind of the general public. The Complainant contends that the Domain Name incorporates the Complainant’s BASF trademark in its entirety with the addition of the generic term "ppu" and a hyphen symbol. The Complainant claims that the term “ppu” is a Russian abbreviation for polyurethane products, for which manufacturing the Complainant is well known worldwide. The Complainant argues that addition of the generic Top-Level Domain (“gTLD”) “.com” is of no legal significance because gTLD is a functional aspect of the domain name system. The Complainant states that addition of a hyphen to the BASF trademark in the Domain Name has no impact on the confusing similarity between the Domain Name and the Complainant’s trademark.

- ii. The Complainant alleges that the Respondent has no rights or legitimate interests in the Domain Name. The Complainant alleges the Respondent is not commonly known by the Domain Name and has acquired no trademark or service mark rights related to the “BASF” term. The Complainant claims that it did not authorize, license, or permitted in any way the Respondent to use the BASF trademark or to register the Domain Name. The Complainant argues that the Respondent’s addition of the term “ppu”, which is the Russian abbreviation for polyurethane products, to the Complainant’s BASF trademark in the Domain Name, creates an impression that the Respondent’s website is an official site selling the Complainant’s goods. In the Complainant’s view, such use of the Domain Name does not amount to a *bona fide* offering of goods or services, or to legitimate non-commercial or fair use.
- iii. The Complainant asserts that the Respondent registered and is using the Domain Name in bad faith. The Complainant alleges that the Respondent knew about the Complainant’s trademark when he registered the Domain Name, because the Complainant’s BASF trademark is well-known. The Complainant contends that the Respondent’s knowledge of the Complainant and its goods is further demonstrated by the use of the Domain Name. The Complainant states that the Respondent is using the Domain Name to direct to a website, which offers for sale unauthorized versions of the Complainant’s goods. The Complainant asserts that the Respondent’s website displays the Complainant’s square logo along with the Complainant’s company name “BASF”, as well as the Complainant’s trademarked slogan, “We create chemistry”, on both header and footer of the Respondent’s website. The Complainant further claims that the Respondent’s website also features photographs of the BASF chemical plant to create an impression of the affiliation with the Complainant. The Complainant contends that the Respondent registered the Domain Name to trade on the goodwill and reputation of the BASF trademark. The Complainant argues that another indication of the Respondent’s bad faith is its use of a privacy shield to conceal the Respondent’s identity.

B. Respondent

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

5. Findings

5.1. Language of the proceeding

Under Paragraph 11 of the Rules, “Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding 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 administrative proceeding.”

Though the default language of the administrative proceeding shall be Russian, the Complainant requested that the language of the proceeding be English because the Complainant was not able to communicate in Russian. The Complainant argues that making it translate the Complaint into Russian would unfairly disadvantage and burden the Complainant as well as delay the proceeding and adjudication of the case.

Previous UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. “Such scenarios include ... (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant’s mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, ... (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint...”¹

The evidence on file shows that the Respondent registered the Domain Name in Latin script instead of the Cyrillic one. The Domain Name, which includes the Complainant’s BASF trademark, directs to a website in Russian, which displays the Complainant’s BASF trademark, the Complainant’s slogan: “We create chemistry” and photographs of the Complainant’s chemical plant. It is likely that the Respondent understands English. Further, the Respondent did not object to the Complainant’s request for English to be the language of this administrative proceeding. Therefore, the Panel finds that it will not be unfair to the Respondent if the proceeding is conducted in English. Instead, forcing the Complainant to translate the Complaint and supporting documents into Russian will impose undue financial burden on the Complainant and delay resolution of the dispute.

5.2. Standard of review

It is a consensus view among UDRP panelists that “[a] respondent's default does not automatically result in a decision in favor of the complainant... [T]he complainant must establish each of the three elements required by paragraph 4(a) of the UDRP.”² A panel may draw inferences from a respondent's default.³

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name is 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 name; and
- iii. Respondent’s domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

To satisfy the first UDRP element, a domain name must be “identical or confusingly similar” to a trademark, in which a complainant has rights.

The Complainant has established its rights in the BASF trademark by submitting copies of BASF trademark registrations. Pursuant to section 1.2.1 of the WIPO Overview 3.0, “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

¹ Section 4.5.1, Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”).

² Paragraph 4.2., WIPO Overview 3.0”.

³ Paragraph 4.3., WIPO Overview 3.0.

“Where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”⁴ Here, the Domain Name incorporates the entirety of the Complainant’s BASF trademark. The additions of a hyphen and of the suffix “ppu” do not diminish the confusing similarity. The addition of the gTLD “.com” is disregarded under the confusing similarity test.⁵ The Panel finds, therefore, that the Domain Name is confusingly similar to the Complainant’s BASF trademark.

Thus, the Domain Name is identical or confusingly similar to the Complainant’s BASF mark and the first element of the UDRP has been satisfied.

B) Rights or Legitimate Interests

Under the second UDRP element, a complainant must make a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent⁶. Once the complainant has made out the *prima facie* case, the respondent carries the burden of producing evidence demonstrating it has rights or legitimate interests in the domain name⁷. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.⁸

Pursuant to paragraph 4(c) of the UDRP, the following may demonstrate rights or legitimate interests in the Domain Name:

- (i) before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence demonstrating that the Respondent has rights or legitimate interest in the Domain Name. First, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name because the Complainant has not authorized the Respondent to use the Complainant’s BASF trademark in any manner. Without a license or permission from the Complainant, the Respondent is, therefore, an unauthorized user of the mark. Generally, unauthorized resellers might have legitimate interests in a domain name containing complainant’s trademark if their activities comply with the following cumulative requirements (the “*Oki Data Test*”):

⁴ Section 1.7, WIPO Overview 3.0.

⁵ Section 1.11.1, WIPO Overview 3.0.

⁶ Section 2.1, WIPO Overview 3.0.

⁷ *Id.*

⁸ *Id.*

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to ‘corner the market’ in domain names that reflect the trademark.”

The evidence shows that the website connected to the Domain Name offers for sale polyurethane sprays and other goods manufactured by Elastokam LLC as well as polyurethane goods purportedly manufactured by the Complainant. The home page of the website “basf-ppu.com” displays the Complainant’s BASF trademark, the Complainant’s slogan: “We create chemistry” and a photograph of a Complainant’s chemical plant, which create an impression of an affiliation between the Complainant and the Respondent. There is no disclosure of the Respondent’s relationship with the Complainant on the website. Because the Respondent’s use of the Domain Name does not comply with the requirements of the *Oki Data* Test, its use of the Domain Name have not created rights or legitimate interests in the Domain Name for the Respondent.

Second, the Complainant claims that the Respondent is not commonly known by the Domain Name, which evinces a lack of rights or legitimate interests. The Respondent’s name, “MASTER LLS”, does not resemble the Domain Name in any manner. Moreover, the website connected to the Domain Name displays photographs of Russian Certificates of Conformity issued to Elastokam LLC. The certificates evidence conformity of Elastokam LLC’s goods sold on the website, to the applicable Russian standards, technical norms or recipes. Thus, it is probable that the website associated with the Domain Name belongs to Elastokam LLC. Further, because the Respondent used a privacy shield to conceal his identity, the Respondent cannot have been commonly known by the Domain Name. See, *L’Oréal SA v. PrivacyProtect.org/ WangShanShan*, WIPO Case No. D2014-0295 (“there is no evidence that the Respondent, who is moreover hiding behind a privacy shield, has been commonly known by the Domain Name.”)

Third, the record shows that the Respondent is not making a legitimate noncommercial or fair use of the Domain Name. The Domain Name resolves to a website offering for sale polyurethane sprays purportedly manufactured by the Complainant and polyurethane goods manufactured by Elastokam LLC, from which the Respondent derives profit.

The Panel therefore finds that the Complainant has made out a *prima facie* case in respect to the Respondent’s lack of rights or legitimate interests in the Domain Name. Since the Respondent has failed to rebut the Complainant’s case, the Panel holds that the second element of the UDRP has been satisfied.

C) Bad Faith

Under the third UDRP element, the Complainant is required to prove that the Domain Name was registered and is being used in bad faith.

The Panel finds that the Respondent registered the Domain Name in bad faith because at the time of the Domain Name registration it was aware of the Complainant and its BASF

trademark. Previous UDRP panels found that “the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”⁹ Here, the Respondent registered the Domain Name, which is confusingly similar to the Complainant’s well-known trademark to direct to a website displaying the Complainant’s trademarks and offering for sale unauthorized versions of Complainant’s goods. Such registration shows Respondent’s knowledge of the Complainant’s trademark and creates a presumption of bad faith registration.

The Panel also finds that the Respondent is using the Domain Name in bad faith. The Respondent attempts to capitalize on the goodwill of the Complainant’s trademarks by using the Domain Name to attract, for commercial gain, Internet users to the Respondent’s website by creating likelihood of confusion with the Complainant’s mark as to the affiliation or endorsement of either the Respondent or its website. The evidence shows that the Domain Name, which is confusingly similar to the Complainant’s trademark, directs to the website, which displays the Complainant’s BASF trademark, the Complainant’s slogan “We create chemistry” and photographs of a Complainant’s chemical plant. The Respondent profits from the website by selling unauthorized versions of the Complainant’s polyurethane sprays and polyurethane goods manufactured by Elastokam LLC.

Third, it is possible that the Respondent provided the Registrar with the false contact information claiming to be Master LLS even though the Domain Name might belong to Elastokam LLC, which sells its goods on the website associated with the Domain Name. The Panel concludes that the Respondent registered and is using the Domain Name in bad faith.

The Panel finds that the Complainant has made out the requirements of paragraph 4(a)(iii) of the UDRP.

6. Decision

Under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <basf-ppu.com> be transferred to the Complainant.

Olga Zalomiy
Sole Panelist

Dated: October 27, 2018

⁹ Paragraph 3.1.4., WIPO Overview 3.0.