



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-18010164
Complainant:	BASF SE
Respondent:	Jill Holder, DOW
Disputed Domain Name:	< basf-uk.com >

1. The Parties and Contested Domain Name

The Complainant is BASF SE of 67056 Ludwigshafen, Germany.

The Respondent is Jill Holder, DOW of 234 abek str lagos, 100001 NG.

The domain name at issue is <basf-uk.com>, registered by the Respondent with PDR Ltd. d/b/a PublicDomainRegistry.com of Unit No 501, 5th floor and Unit IT Building No 3, NESCO IT Park, Western Express Highway, Goregaon (East), Mumbai Maharashtra 400063, India.

2. Procedural History

The Complainant filed the Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (the “Centre”) and chose to have a sole panelist handle the dispute on 27 August 2018, in accordance with 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 Supplemental Rules).

On 28 August 2018, the Centre confirmed the receipt of the Complaint, and had notified the concerned Registrar, namely PDR Ltd. d/b/a PublicDomainRegistry.com (the Registrar), of the Complaint. On the following day, the Complainant requested the correction of a minor part of the Complaint. After obtaining permission from the Centre, the Complainant resent all of the documents including an amended Complaint and all related annexures to that Complaint to the Centre. Then, the Centre notified the Registrar of the Complaint for verification in connection with the domain name dispute at issue.

On 19 September 2018, the Centre informed the Complainant to update a deficiency in terms of the Registrar’s email address in the Complaint form as the email address of the Registrar should be arbitration@publicdomainregistry.com according to the confirmation

from the Registrar. On the same day, the Complainant sent the amended Complaint to the Centre.

On 20 September 2018, the Centre confirmed that the Complaint is compliance with the Policy and its Rules, and the proceeding of this case were formally commenced. The Centre then sent a notice of the Complaint to the Respondent, requesting the Respondent reply within 20 days (on or prior to 10 October 2018) in accordance with the Rules and Supplement Rules, and pointing out the language used in the proceedings of the Complaint was to be English.

On 16 October 2018, the Centre issued a Default Notice confirming that the Respondent did not file a formal Reply with the Centre, within the required time limit for filing a reply.

On 20 October 2018, the Centre informed Mr. Matthew Murphy that it was considering appointing him as the sole Panelist for this case. On the same day, Mr. Matthew Murphy submitted an acceptance notice as well as a statement of impartiality and independence.

On 22 October 2018, the Centre notified both parties and the Panel, Mr. Matthew Murphy, by email that Mr. Matthew Murphy be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. If there be no exceptional circumstances, a decision with respect to the disputed domain name will be rendered by the Panelist on or before 5 November 2018.

3. Factual background

For the Complainant

The Complainant, BASF SE, claims that, it is the largest chemical company in the world and is listed on the Frankfurt Stock Exchange, London Stock Exchange, and Zurich Stock Exchange. It has customers in over 200 countries and supplies products to a wide variety of industries, employing more than 112,000 people around the world. The BASF Group comprises subsidiaries and joint ventures in more than 80 countries and operates six integrated production sites and 390 other production sites in Europe, Asia, Australia, Americas and Africa.

The Complainant claims that it owns more than 1500 trademark rights for “BASF” worldwide. Moreover, it registered the “BASF” trademarks under Registration No. 638794 and 909293 in a very large number of jurisdictions in 1995 and 2006 respectively. It is much earlier than the filing date of the disputed domain names. In particular, it owns more than 36 “BASF” trademarks in different classes in Nigeria where the Respondent is located and registered years before the disputed domain name, among which the first trademark has been registered since 1987.

Furthermore, the Complainant claims the BASF Group has been active on the African continent for close to 90 years. BASF in Africa is divided into four country clusters, with headquarters in Midrand, South Africa for Southern Africa; Nairobi, Kenya for East Africa; Lagos, Nigeria for West Africa and Morocco for North-West Africa. Notably, BASF West Africa Limited was opened in 2012 and is located in Lagos where the Respondent is located. The Complainant employs around 1600 people in Africa. Since 2016, its African headquarters is based in Nairobi, Kenya.

For the Respondent

The Respondent, Jill Holder, DOW is located at 234 abek str lagos, 100001 Nigeria. The Respondent registered the disputed domain name on 12 March 2018. The Respondent did not file any Reply or other materials with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant claims that BASF is a famous trademark of the Complainant based on citations from the decisions in many cases including BASF SE v. Jim Welsh, cases No. D2010-2000 and D2014-1889, WIPO cases No. 2015-2245, 2015-2245 and DMX 2015-0032, and INDRP case No. 752.

Moreover, the Complainant holds numerous domain names incorporating the BASF trademark, both within generic TLDs and ccTLDs, notably in UK: <basf.com>, <basf.uk>, <basf-cc.co.uk>; <basf-se.co.uk>; <basf.co.uk>; <basf-usa.com>, <basf.us>, <basf.in>, <basf.asia>, <basf.org> and many others. The Complainant notably holds <uk-basf.com>, which is managed on its behalf by its representative in the present case.

Since the Complainant's well-known trademark "basf" is a striking, distinctive part of the disputed domain name because it is fully contained in and placed at the beginning of the disputed domain name, and the "uk" part actually refers to one of the countries where the Complainant uses his trademark as the average internet user will likely believe that this domain name refers to the Complainant's UK subsidiary, the disputed domain name is confusingly similar to the Complainant's trademark.

Meanwhile, the additional element of "uk" increased confusion with the Complainant's trademark as the Complainant and his trademark "BASF" are both well-known in the UK where it carried out its first sale in 1880 and has a history of 137 years.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name(s):

The Complainant claims that the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name mainly due to four reasons.

Firstly, the Complainant has conducted trademark searches, particularly in the UK and Nigeria, and found no BASF trademark or other rights owned by the owner of the disputed domain name, and thus, the Respondent is not commonly known by the disputed domain name.

Secondly, the Respondent reproduced the Complainant's trademark without any license or authorization from the Complainant, which is a strong evidence of the lack of legitimate interest. Moreover, the Respondent is neither affiliated nor commercially linked to the Complainant.

Thirdly, the Respondent's use of the disputed domain name or preparation to use the domain name demonstrates no intent to use it in connection with a bona fide offering of goods or services. On the contrary, the disputed domain name has been subject to fraudulent use as per their submissions.

Fourthly, since the adoption and extensive use by the Complainant of the trademark BASF predates the first entry of the disputed domain name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the domain names.

- iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith:

In light of the following facts, the Complainant contends that the bad faith demonstrated by the Respondent in the registration and use of the disputed domain name.

Firstly, as indicated above, the disputed domain name is confusingly similar to the Complainant's mark. The Complainant's mark is distinctive and well-known. The Respondent was undoubtedly aware of it before registering the disputed domain name.

Secondly, the Respondent has been using the disputed domain name in conjunction with a scam attempt. A travel agency has been contacted through the address Stephen.nash@basf-uk.com. The person using this address requested flight bookings to different countries through the general enquiry form of the agency's website. In those emails, the Respondent posed as "Stephen Nash", one of the Complainant's employees. The Respondent indicated "Sales manager Europe" in the email signatures, associated with the Complainant's trademark. Besides, the Respondent has once used the "Stephen Nash" name and contacted the Complainant's travel managers in Poland and Romania to ask for assistance to book the flights to Lagos and Jeddah and various other places. All these activities demonstrate that the Respondent has attempted to trick the travel agency as well as the Complainant's travel managers by using the disputed domain name and the Complainant's trademark. Those actions qualify as bad faith use of the disputed domain name.

Thirdly, by Reverse Whois Lookup, the Complainant found that the Respondent has engaged into a pattern of conduct consisting in the registration of domain names combining well-known trademarks with "uk", notably including fiat-uk.com, nokia-uk.com, haier-uk.com, clariant-uk.com, amphenoluk.com and argo-hytosuk.com.

The Complainant would like to underline that the bad faith of the Respondent "Jill Holder, DOW" has already been recognized in a previous UDRP decision in

a WIPO case No. D2017-1835. The panel considered that “by using disputed domain name to send out fraudulent emails seeking confidential information, Respondent has intentionally targeted Internet users to an operational domain name (i.e., <casappauk.com>), albeit without an obviously active website, for commercial gain by creating a likelihood of confusion with Complainant's mark”.

B. Respondent

The Respondent's contentions may be summarized as follows:

The Respondent did not submit any Reply.

5. Findings

The Panel finds that the Complainant has satisfied the Paragraph 4(a) of the Policy.

The ICANN Uniform Domain Name Dispute Resolution Policy 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

The Complainant has filed these proceedings regarding the disputed domain name based on its prior registered “BASF” trademarks in many countries including Nigeria where the Respondent is located. The relevant evidence provided by the Complainant consists of a trademark portfolio listing over a thousand of “BASF” trademarks and copies of Chinese trademark registration certificates regarding its two “BASF” trademarks No. 638794 and 909293 which were registered on 3 May 1995 and 31 October 2006 respectively.

The lexical elements to the left dot of the disputed domain name “basf-uk.com” contains the Complainant's “BASF” trademark, a dash symbol and a country abbreviation of the “uk”. Considering the evidence as filed by the Complainant such as its trademark registrations and domain names including “basf-asia.com”, “basf-global.com”, “basf-usa.com” and “basf-tunisie.com”, which incorporate the “BASF” trademark with geographical names, and it being a normal practice in the commercial world to create a domain name by combination of a trademark with a location (or abbreviation of that location), it can be concluded that the disputed domain name is confusingly similar to the “BASF” trademark of the Complainant as the disputed domain name is changed from the “BASF” trademark in a indistinguishable way through adding a direction to a place where the Complainant also has had a long history of over one hundred years.

In conclusion, the disputed domain name is confusingly similar with the Complainant's “BASF” trademark since it contains the trademark as a whole and has the potential to

mislead unsuspecting users. The Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

In the Complaint, the Complainant claims that the Respondent is not commonly known by the disputed domain name according to its trademark (and general) search results which show the Respondent has not acquired any trademark or service mark related to “BASF”; “the Respondent reproduces the Complainant’s trademark without any license or authorization from the Complainant”, and “the Respondent is neither affiliated nor commercially linked to the Complainant”; it is found that the Respondent’s use of the disputed domain name was subject to fraudulent use; and the burden shall shift to the Respondent since “the adoption and extensive use by the Complainant of the trademark BASF predates the first entry of the disputed domain name”.

It is noteworthy that the Respondent has not submitted any Reply in relation to these issues, which is somewhat surprising given the grave nature of the allegations. Based on the submissions by the Complainant and the lack of Reply by the Respondent, the Panel has found that the Respondent has no rights or legitimate interests in respect of the disputed domain name. .

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

In the Complaint, the Complainant claims that both the registration and use of the disputed domain name by the Respondent is in bad faith under the following grounds:

- (1) The disputed domain name is confusingly similar to the Complainant’s “BASF” trademark which is distinctive and well-known. The Respondent should be aware of it before registering the disputed domain name.
- (2) The using of the disputed domain name in bad faith can be concluded from the Respondent’s activities to trick others by using both the disputed domain name and the Complainant’s “BASF” trademark in the communication emails.
- (3) It is found that the Respondent has engaged into a pattern of conduct consisting of the registration of domain names combining well-known trademarks including “fiat”, “nokia”, “haier”, “clariant”, “amphenol” and “argo-hytos” with “uk”.
- (4) The Respondent’s use of the disputed domain name in a scheme involving the dispatch of fraudulent emails seeking confidential information has been recognized as a bad faith one in a previous UDRP decision (WIPO case No. D2017-1835).

The Panel considers that the Complainant’s “BASF” trademark should be considered a famous trademark at least in the UK which seems to be relevant to this case, and that the brand has deep market penetration based on the following factors:

- 1) The Complainant is the largest chemical company in the world, listed on the Frankfurt Stock Exchange, London Stock Exchange, and Zurich Stock Exchange, comprises subsidiaries and joint ventures in more than 80 countries and operates six integrated production sites and 390 other production sites in Europe, Asia, Australia,

- Americas and Africa, has customers in over 200 countries and supplies products to a wide variety of industries, employing more than 112,000 people around the world.
- 2) The Complainant's "BASF" trademarks have been widely registered in relation to the goods/services in many classes in a very large number of jurisdictions for many years earlier than the registration date of the disputed domain name.
 - 3) The Complainant's "BASF" trademarks have been stated as famous one by UDRP panelists in previous cases such as BASF SE v. Jim Welsh, cases No. D2010-2000 and D2014-1889, WIPO cases No. 2015-2245, 2015-2245 and DMX 2015-0032, and INDRP case No. 752.

In accordance with the submissions filed by the Complainant, the Respondent registered 34 different domain names, including those combining well-known trademarks as mentioned above, and the disputed domain name, in about one year from 26 July 2017 to 17 August 2018.

Based on these facts, the Panel has found that it is highly likely that the Respondent should have been aware of the Complainant and its "BASF" trademark whilst registering the disputed domain name and the registration of the disputed domain name was in bad faith for taking advantage of the goodwill and reputation of the Complainant's well-known "BASF" trademark.

The activities of the Respondent involving attempts to trick others as to persons using email addresses associated with the disputed domain name are sufficient to prove that the Respondent is using the disputed domain name in bad faith as it is reasonable to conclude that the Respondent was pretending to be the Complainant or its affiliate, in these emails.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(iii).

6. Decision

Pursuant to Paragraph 4(a) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name <basf-uk.com> be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: 25 October 2018