



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1801101
Complainant:	BASF SE
Respondent:	zhuyulin (朱玉林)
Disputed Domain Name:	<zgbasf.com>

1. The Parties and Contested Domain Name

The Complainant is **BASF SE** whose address is situate at Carl-Bosch Strasse Ludwigshafen, Germany and the authorized representative of the Complainant in this proceeding is IP Twins SAS whose address is situate at 6 rue du conservatoire 75009 Paris, France.

The Respondent is **zhuyulin (朱玉林)** whose address is situate at xihexian, suhexiang, zhuhecun, 164hao, longnanshi gansusheng 742100 China.

The domain name at issue is <zgbasf.com> (the **Disputed Domain Name**), registered by the Respondent with the registrar, **Xin Net Technology Corporation (the Registrar)** whose address is situate at Bei Gong Da Software Area Building #6, Level 1, BDA Beijing 100176 China.

2. Procedural History

On 17 April 2018, the Complainant filed a Complaint written in the English language with Hong Kong International Arbitration Centre (“**HKIAC**”), the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“**ADNDRC**”) pursuant to the Uniform Domain Name Dispute Resolution Policy (the “**Policy**”) adopted by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) with an effective date of July 31, 2015 and the Complainant elected a single member panel for the dispute in this matter. The Complaint was later amended on 23 April 2018 by the Complainant in order to satisfy the formal requirements of 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**”) after the administrative check by HKIAC. All reference to the Complaint hereafter shall mean the Complaint as amended on 23 April 2018.

On 18 April 2018, HKIAC transmitted by email to the Registrar a request for confirmation of the WHOIS records of the Disputed Domain Name and other related information.

On 19 April 2018, the Registrar confirmed by email that it is the registrar of the Disputed Domain Name, registered by the Respondent for the period from 2017-12-15 to 2018-12-15; and that the Policy is applicable to the dispute relating to this domain name and that the language of the Registration Agreement of the Disputed Domain Name is in Chinese together with the email address of the Respondent and other relevant WHOIS information.

On 24 April 2018, in accordance with Articles 2(a) and 4(a) of the Rules, HKIAC issued in both the English and Chinese languages a Written Notice of the Complaint (“**the Notice**”) and formally notified the Respondent of the Complaint. In accordance with Article 5(a) of the Rules, the due date for the Respondent to submit the Response to the Complaint was 14 May 2018. In the Notice, HKIAC specifically drew the attention of the Respondent to Article 11(a) of the Rules on the language of the administrative proceeding; and reminded the Respondent that as the Complainant requested to use English as the language of the proceeding, the Respondent might respond to such request; and a final determination on the language issue would be made by the Panel. However, the Respondent did not submit any Response to the Complainant by the due date of 14 May 2018; nor made any response to the request of the Complainant that English should be used as the language of the proceeding in this case.

On 1 June 2018, HKIAC appointed Mr. Raymond HO as the sole panelist of the Panel in this matter; and transmitted the file to the Panel on the same date. Prior to the appointment, the said sole panelist had submitted to HKIAC his Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Article 7 of the Rules.

3. Factual background

The Complainant, BASF SE, is incorporated in Ludwigshafen, Germany. The Complainant owns the famous öBASFö trademark worldwide, well-known in connection with chemical goods and services offered by the Complainant in many countries. In addition, the Complainant holds numerous domain names incorporating the BASF trademark, both within generic TLDs and geographical ones, including <basf.com>, <basf.asia>, <basf.in>, <basf.org> and others.

The Respondent is an individual with an address in the Gansu Province of China as disclosed in the WHOIS records of the Disputed Domain Name. The Respondent has registered the Disputed Domain Names for a period of one year from 15 December 2017 to 15 December 2018.

4. Parties' Contentions

A. Complainant's Contentions

It is the contention of the Complainant that each of the conditions in Paragraph 4(a) of the Policy is present in the Complaint:

(i) The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant avers that the Complainant is the owner of the BASF trademarks that had been registered years before the Disputed Domain Name was registered, in particular:

- (a) BASF n° 638794 registered 03.05.1995 in classes 03, 05 and 30 in LV, LU, LT, VN, HR, RO, LR, DZ, HU, ME, MK, UZ, MC, MD, MA, AT, MZ, MN, IS, AZ, IT, BA, PT, UA, ES, NL, EG, AL, AM, BY, TJ, FR, BG, BE, KG, CZ, SD, KP, CU, SI, SL, SK, KZ, SM, PL, RS, CH, RU, LI, CN; and
- (b) BASF n° 909293 registered 31.10.2006 in classes 01, 02, 03, 04, 05, 06, 07, 09, 10, 12, 16, 17, 18, 19, 22, 24, 25, 27, 28, 29, 30, 31, 32, 35, 36, 37, 39, 41, 42 and 44 in LV, LU, LT, VN, HR, RO, LS, LR, DZ, HU, ME, MK, ZM, UZ, MC, MD, MA, DK, IE, AT, MZ, AU, MN, IR, IS, AZ, IT, BA, PT, UA, AG, ES, NL, AL, EG, NA, EE, AM, JP, GE, BY, TJ, GB, BT, TM, TR, NO, BG, FR, SY, SZ, BE, SX, BQ, KG, KE, FI, SD, CZ, CY, KP, SE, KR, CW, SG, CU, SI, SL, SK, SM, KZ, PL, RS, RU, CH, GR, LI, CN.

A copy of the registration certificates of these trademarks is exhibited at Annex 8 of the Complaint.

Furthermore, the Complainant points out that in a number of previous decisions under the Policy, it was determined by various panels that the Complainant's BASF trademarks are well-known trademarks which enjoy a widespread reputation and high degree of recognition as a result of their fame and notoriety in connection with chemical goods and services in many countries all over the world. For instance, WIPO cases Nos. D2010-2000, D2014-1889 and D2015-2245.

It is the Complainant's contention that the Disputed Domain Name <zgbasf.com> is identical to the BASF trademark and is likely to create confusion in the mind of the general public.

The Complainant submits that the use of lower case letter format and the addition of the letters "zg" are not significant in determining whether the domain name is identical or confusingly similar to the mark. See CBS Broadcasting Inc. v. Worldwide Webs, Inc., Case No. D2000-0834.

In addition, the Complainant contends that the letters "zg" may also refer to the People's Republic of China. Indeed, China is listed under ZG according to the list of ICAO airport codes. It may also be seen as an abbreviation of Zhōnghuá Rénmín Gònghéguó, the transliteration of the Chinese name of People's Republic of China. Thus, the Complainant contends that an average internet user may be brought to believe that the Disputed Domain Name is associated with the Complainant's activities in China.

The Complainant also submits that for the purposes of assessing identity and confusing similarity under Paragraph 4(a)(i) of the Policy, it is typically permissible for panel to ignore the generic Top-Level Domain (gTLD); and even if the letters "zg" are taken into account, they represent two letters, which do nothing to minimize the confusing similarity. They have no meaning themselves and clearly enhance the level of confusion. See Archer-Daniels-Midland Company v. tao bang hua, WIPO Case No. D2016-0990.

As the Disputed Domain Name fully incorporates the Complainant's prior and well-known "BASF" trademark, the Complainant submits that the Disputed Domain Name is identical or highly similar to the Complainant's prior "BASF" registered trademarks. Accordingly, it is the case of the Complainant that the first condition under Paragraph 4(a) of the Policy is deemed satisfied.

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

The contentions of the Complainant are as follows:

Firstly, the Respondent is not commonly known by the Disputed Domain Name. The Respondent has acquired no trademark or service mark related to the BASF term. The Complainant has conducted trademark searches and found no BASF trademark or right owned by the Respondent. A copy of trademark database searches conducted by the Complainant is exhibited at Annex 12 of the Complaint.

Secondly, the Respondent reproduces the Complainant's trademark without any license or authorization from the Complainant, which is a strong evidence of the lack of legitimate interest. See LEGO Juris A/S v. Ibnu Firdaus, WIPO Case No. D2012-1336.

Thirdly, the Respondent's use of the Disputed Domain Name or preparation to use the same demonstrates no intent to use it in connection with a bona fide offering of goods or services. On the contrary, the Disputed Domain Name resolves to a pornography website, which could damage the Complainant image. A copy of the screenshot of the website resolved by the Disputed Domain Name is exhibited at Annex 17 of the Complaint.

Fourthly, the Respondent has never been granted authorization, license or any right whatsoever to use the Complainant's BASF trademarks. The Complainant avers that the Respondent is not commercially linked to the Complainant.

Fifthly, since the adoption and extensive use by the Complainant of the trademark BASF predates the first registration of the Disputed Domain Name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests in the Disputed Domain Name. Given that the Complainant has made a prima facie case that the Respondent lacks legitimate rights or interest in the Disputed Domain Name, the burden of proof is shifted to the Respondent to come forward with evidence demonstrating the Respondent's rights or legitimate interests in the Disputed Domain Name.

Based on the above reasons, it is the case of the Complainant that the second condition under Paragraph 4(a) of the Policy is deemed satisfied.

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

The contentions of the Complainant are as follows:

Firstly, the Complainant's BASF trademarks are so widely well-known, as stated above, that it is inconceivable that the Respondent would not have known of the Complainant's

BASF trademarks. Clearly the Respondent had the Complainant's name and trademark in mind when registering the Disputed Domain Name. The Respondent's choice of Disputed Domain Name for registration cannot have been accidental and must have been influenced by the fame of the Complainant's trademark. Indeed, a simple search of "BASF" on an online search engine yields results that only related to the Complainant. All results related to the Complainant, and in particular, the first three results is www.basf.com. Therefore, at the very least, the Respondent knew or should have known that, when registering and using the Disputed Domain Name, he would do so in violation of the Complainant's earlier rights. A copy of the search results for "BASF" on an internet search engine is exhibited at Annex 14 of the Complaint.

Secondly, the Complainant sees no possible way whatsoever that the Respondent would use the Disputed Domain Name in connection with a bona fide offer of products or services. Indeed, any use of the BASF trademark would amount to trademark infringement and damage to the reputation of the trademark. The current use of the Disputed Domain Name in relation to a pornographic website is highly detrimental to the Complainant and a clear indication of bad faith use of the domain name. Moreover, the sole retention of the Disputed Domain Name by the Respondent, in an attempt to prevent the Complainant from reflecting its trademark and company name in a domain name, is a strong evidence of bad faith. Furthermore, any actual use of the domain name by the Respondent would de facto amount to bad faith active use. Indeed, the Complainant's "BASF" trademark has no common or general meaning in any language, and the Disputed Domain Name is not generic or descriptive.

Thirdly, the Respondent also owns other 3862 domain names and a great number of them appear to be pornographic websites. By using the Disputed Domain Name for commercial pornographic websites, the Complainant contends that the Respondent has intentionally attempted to attract Internet users to his web site by creating a likelihood of confusion with the Complainant's mark. As expressed in the WIPO Case No DBZ2003-0002: "The redirection to pornographic sites from a domain name incorporating a well-known mark is evidence of bad faith." This view was also confirmed in other decisions, such as WIPO Case No. D2003-0022.

Fourthly, of the 3862 domains, a number of them reproduced well-known trademarks such as adidasporschedesignbounce.com, airjordanismvp.com, androiddiscovery.com. This is further evidence of bad faith as the Respondent is engaging in a pattern of cybersquatting.

Based on all the aforesaid, it is the Complainant's case that the Disputed Domain Name was registered and is being used in bad faith by the Respondent. Therefore, the third condition under Paragraph 4(a) of the Policy is deemed satisfied.

B. Respondent's Contentions

The Respondent did not submit any Response to the Complaint.

5. Discussion and Findings of the Panel

5.1 Language of the Proceeding

The Registration Agreement in this case is in Chinese but the Complainant filed the Complaint in English and requested that English be the language of the proceeding. The Respondent did not respond on this issue.

Paragraph 11(a) of the Rules provides that:

"[u]nless 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".

Paragraph 10(c) of the Rules provides that "[T]he Panel shall ensure that the administrative proceeding takes place with due expedition."

The Disputed Domain Name comprises of non-Chinese words and scripts. In view of its composition and the fact that the Respondent has previously registered no less than 3,800 other non-Chinese domain names; and has been notified in both English and Chinese by HKIAC of the Complaint and the deadline pertaining to the proceeding as well as the issue of the language of the proceeding, the Panel does not consider it prejudicial to the Respondent if English were adopted as the language of the proceeding. The proceeding would be unduly delayed if the Complaint and annexes thereto had to be translated into Chinese. In keeping with the Policy objective of facilitating an expeditious and cost-efficient procedure for the resolution of domain name disputes, the Panel determines that it would be appropriate for English to be the language of the proceeding.

5.2 Substantial issues

The 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 shown that it has rights in the registered öBASFö trademark, namely: BASF n° 638794 registered 03.05.1995 and BASF n° 909293 registered 31.10.2006, prior to the registration of the Disputed Domain Name.

The Panel agrees that the Disputed Domain Name <zgbasf.com> is identical or confusingly similar to the öBASFö trademark in that it incorporates the Complainant's öBASFö trademark in its entirety as a distinct component of the domain name with the addition of the lower-case letters özg " before öBASFö that are not significant in determining whether the domain name is identical or confusingly similar to the Complainant's öBASFö trademark.

The Panel also agrees that even if the letters özgö may refer to China, an average internet user might be led to believe that the Disputed Domain Name is associated with the Complainant's activities in China as the Disputed Domain Name is confusingly similar to the Complainant's öBASFö trademark.

It is well established that in making an inquiry under the Policy as to whether a domain name is identical or confusingly similar to a trademark, the gTLD suffix öcomö may be disregarded in the determination as it is a required technical element of every domain name.

The Panel therefore concludes that Paragraph 4(a)(i) of the Policy has been satisfied by the Complainant.

B) Rights or Legitimate Interests

The Panel is of the view that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant did not authorize the Respondent to use its öBASFö trademark or to register the Disputed Domain Name; there is no evidence of the Respondent being commonly known by the Disputed Domain Name; and there is no evidence of a bona fide offering of goods or services under the Disputed Domain Name. Rather there is evidence that the Respondent has used the Disputed Domain Name for a commercial pornographic website.

As stated in paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (öWIPO Overview 3.0ö), once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied Paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy provides that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to the Respondent 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 non-commercial 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.

The Complainant's assertions and evidence in support of its case have not been rebutted by the Respondent. The Panel finds none of the circumstances as set out in Paragraph 4(c) is present.

The Panel therefore concludes that the Complainant has established Paragraph 4(a)(ii) of the Policy.

C) Registration and Use in Bad Faith

Paragraph 4(b) of the Policy provides that for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or the Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site 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 the Respondent's web site or location or of a product or service on the Respondent's web site or location.

Based on the evidence tendered, the Panel agrees that the Complainant's "BASF" trademark is well-known in its industry worldwide with a significant level of reputation and goodwill established. The Disputed Domain Name was registered many years after the Complainant's "BASF" trademark was first used and registered. It could not be an accidental choice by the Respondent in registering the Disputed Domain Name. The Panel has found that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, and has no difficulty concluding in the circumstances of this case that more likely than not, the Respondent chose to register the Disputed Domain Name incorporating the Complainant's famous "BASF" trademark with a view to seeking benefit from the notoriety of the Complainant's mark or otherwise to misrepresent itself to be associated with the Complainant; and to preventing the Complainant from reflecting its trademark in a corresponding domain name.

The Panel agrees that the current use by the Respondent in redirecting the Disputed Domain Name to a pornographic website is highly detrimental to the goodwill of the Complainant; and considers it a patently clear case of bad faith use.

The Panel also finds that the Respondent, having registered no less than 3,800 domain names, some incorporating well-known trademarks, with many redirected to pornographic websites, is engaging in a pattern of cybersquatting.

Based on the above findings, the Panel concludes that circumstances (ii) and (iv) of Paragraph 4(b) of the Policy are present; and accordingly, evidence of bad faith registration and use of the Disputed Domain Name is established in this case. The Panel therefore finds that the Complainant has established Paragraph 4(a)(iii) of the Policy.

6. Decision

For all the foregoing reasons, in accordance with Paragraph 4(a) of the Policy and Article 15 of the Rules, the Panel orders that the Disputed Domain Name <zgbasf.com> be transferred to the Complainant.

Raymond HO
Sole Panelist of the Panel
11 June 2018