



ADNDRC

hong kong

Asian Domain Name Dispute Resolution Centre

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1801103
Complainant:	BASF SE
Respondent:	Yuan Bing
Disputed Domain Name(s):	<basfdea.com >

1. The Parties and Contested Domain Name

The Complainant is BASF SE, of Carl-Bosch Strasse, Ludwigshafen, Germany.

The Respondent is Yuan Bing, of Fu Yang Qu Fu Chun Jie Dao Jin Ping Lu 11 Hao, Hang Zhou Shi Zhe Jiang 311400, China.

The domain name at issue is <basfdea.com>, registered by Respondent with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn), of Alibaba, Building No.9 Wangjing East Garden 4th Area, Chaoyang, Beijing 100102, China.

2. Procedural History

The Complainant filed the Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC) on 17 April 2018, in accordance with the Uniform Policy for Domain Name Dispute Resolution, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 (the Policy), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN Board of Directors on 28 September 2013 (the Rules) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 31 July 2015 (the Supplemental Rules).

On 18 April 2018, the Hong Kong Office confirmed receipt of the Complaint. On the same date, the Hong Kong Office sent an email to Alibaba Cloud Computing Ltd. (the Registrar of the Domain Name) requesting verification in connection with the relevant information of the Domain Name at issue. On 18 April 2018, the Registrar of the Domain Name confirmed that the Respondent is Yuan Bing and the Domain Name is registered with Alibaba Cloud Computing Ltd.

On 24 April 2018, the Hong Kong Office sent the Respondent a written notice of complaint which involved a notification that a complaint concerning the Domain Name

<basfdea.com> was submitted against the Respondent and a requirement to submit a Response within 20 days from 24 April 2018, and forwarded the Complaint (along with its Annexes) to the Respondent pursuant to the Policy, paragraph 4 of the Rules and paragraph 6 of the Supplemental Rules. The formal date of the commencement of the administrative proceeding on was 14 May 2018.

On 31 May 2018, the Hong Kong Office appointed Dr. Timothy Sze as the sole Panelist for this Domain Name dispute; and notified the Complainant and the Respondent of the appointment. Prior to the appointment the panelist had submitted to the Hong Kong Office their Declaration of Impartiality and Independence in compliance with Article 7 of the Rules. On the same date, the case file was transmitted to the panelist.

On 14 June 2018, the Hong Kong Office informed the parties that the decision of the Panel on this matter will be issued by 21 June 2018.

3. Factual background

The Complainant, BASF SE owns more than 1500 trademark rights for “BASF” worldwide, as evidenced by Annex 6. Moreover, BASF SE is notably the owner of the following trademarks registered years before the contested domain names in a very large number of jurisdictions, in particular :

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

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

Please find in Annex 7 a copy of those registration certificates.

BASF is a famous trademark. This has previously been stated by UDRP panelists, for example in decision BASF SE v. Jim Welsh, case No. D2010-2000 (a copy of which is provided in Annex 8):

“This appears to be a case of a person registering the Domain Name in the name of the Respondent in order to hide his or her identity and for the purpose of cashing in on a famous trademark.”

“ [...] which is confusingly similar to Complainant’s well-known trademarks [...]”

See also Case No. D2014-1889, a copy of which is provided in Annex 3.

“The Panel finds that the Complainant’s BASF mark is well known in connection with chemical goods and services offered by the Complainant in many countries”

The Panel also noted the “fame and notoriety of the Complainant’s BASF mark”, adding that “The Complainant and its BASF mark enjoy a widespread reputation and high degree of recognition as a result of their fame and notoriety in connection with chemical goods and services and have registered trademarks in many countries all over the world”. In a very recent case, the Panel equally recognized that “BASF is a well-known trademark”. See WIPO Case No. 2015-2245 dated February 1, 2016 (Annex 9).

In WIPO Case No. DMX 2015-0032, the Panel concluded that the Respondent took advantage of the reputation of the BASF trademarks: “[...] en el momento del registro el Titular tenía en mente las MARCAS BASF de la Promovente dado que el Titular se aprovecha de la reputación de las MARCAS BASF [...]”.

Equally, the Arbitrator in a case before the National Internet Exchange of India recently ruled that “the evidence on record show the Complainant’s trademark is well known”. See INDRP decision No. 752 rendered on January 28, 2016.

Moreover, the Complainant holds numerous domain names incorporating the BASF trademark, both within generic TLDs and geographical ones, particularly in Asia and China: <basf.com>, <basf.asia>, <basf.in>, <basf.org> and many others. Extracts of WHOIS databases pertaining to these domain names are attached thereto as Annex 10.

The Respondent registered this domain name on 27 November 2017. According to the Registrar, the Respondent is Yuan Bing, of Fu Yang Qu Fu Chun Jie Dao Jin Ping Lu 11 Hao, Hang Zhou Shi Zhe Jiang 311400, China.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

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 contested domain name is <basfdea.com>.

The Complainant contends that the disputed domain name is identical to the BASF trademark and likely to create confusion in the mind of the general public.

The use of lower case letter format and the addition of the word “dea” 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.

Takin into account the word “dea” added by the Respondent, it appears that it is worldwide know as the acronym of Drug Enforcement Administration. Moreover, the word “dea” itself could be interpreted with its Latin meaning “goodness”. However, its presence linked to the well know trademark BASF, as in this case, will surely lead to confusion. Even if the

word itself could have other meanings, it is a generic word, which does nothing to minimize the confusing similarity. See *Archer-Daniels-Midland Company v. tao bang hua*, Case No. D2016-0990.

The contested domain name fully incorporates the Complainant's prior trademark BASF. Therefore, the Complainant contends that the contested domain name is identical or highly similar to the Complainant's earlier trademarks BASF.

The first condition under the Policy is deemed satisfied.

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

The Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint. Indeed, the Respondent is not commonly known by the disputed domain name and has acquired no trademark or service mark rights related to the "BASF" term.

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 owner of the disputed domain name. (See Annex 11 for trademark database searches conducted by the Complainant.)

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

Thirdly, the Respondent's use of the disputed domain name or preparation to use the domain name demonstrate no intent to use it in connection with a bona fide offering of goods or services. On the contrary, the domain name has not been used in any way whatsoever. To the best of the Complainant's knowledge, the Respondent has not intended or made preparations to use the disputed domain name in connection with a bona fide offer of goods or services.

Moreover, by acting shortly after the registration of the disputed domain name, the Complainant wishes to reinforce the idea that it does not acquiesce to any use or preparation to use this domain name in any way.

Fourthly, the Respondent has never been granted authorization, license or any right whatsoever to use the Complainant's BASF trademarks. Moreover, 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 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. See *PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No. D2003-0174 (See Annex 12).

None of the circumstances which set out how a respondent can prove his rights or legitimate interests, are present in this case. In light of all the elements mentioned above,

the Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint.

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 production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

The second condition under the Policy should be deemed satisfied.

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

Firstly, the Complainant states that the BASF trademarks are so widely well-known, as stated above, that it is inconceivable that the Respondent ignored the Complainant's earlier rights on the term BASF.

It is clear that the Respondent had the Complainant's name and trademark in mind when registering the domain name. The Respondent's choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant's trademark. Indeed, a simple search on an online search engine yields results only related to the Complainant. Annex 13 to this Complaint shows search results for "BASF" on an internet search engine. All results relate to the Complainant, and in particular the first result is www.basf.com. Therefore, at the very least, the Respondent knew or should have known that, when registering and using the domain name, he would do so in violation of the Complainant's earlier rights.

Secondly, the Complainant sees no possible way whatsoever that the Respondent would use the 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 repute of the trademark. The sole detention of the contested 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 trademark is arbitrary and has no common or general meaning in any language, and the disputed domain name is not generic or descriptive. See WIPO Case No. D2006-0483 where such domain name was seen as registered and used in bad faith (See Annex 14).

Thirdly, the Respondent has engaged in a pattern of behavior to cybersquat well-known trademarks. Domain names owned by the Respondent include: airasiachina.com, aliyuntongxin.com, applecash.club, denso-next.com, nintendotencent.com, orangebank.online, siriairplay.com, taobaoland.com, tencentear.com, tmallgenie.net and many others. This is a clear evidence of bad faith on the part of the Respondent.

Fourthly, the Respondent uses a well-known privacy service in order to keep its identity secret. The use of such service, although not actionable per se, is a further evidence of bad faith registration and use.

WIPO Overview 3.0 explicitly states that panels have found that the apparent lack of so-called active use of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa.

As discussed in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, the relevant issue is not limited to whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept.

In light of all the elements above, the Complainant contends that the domain name was registered and is being used in bad faith by the Respondent. The combination of all the elements listed and detailed above unequivocally show that the Respondent has acted in bad faith when registering and using the disputed domain name, in line with the UDRP doctrine developed under Paragraph 4(a)(iii) of the UDRP Policy.

The third condition under Paragraph 4(a) of the Policy is deemed satisfied.

B. Respondent

The Respondent has failed to file a response in this matter.

5. Discussion and Findings

5.1. Language of the Proceeding

Paragraph 11 of the Rules provides that:

"(a) 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."

The language of the Registration Agreement for the disputed domain name is Chinese.

In the Complaint filed by the Complainant, the Complainant requested that the language of the proceedings be in English. The Respondent did not respond to this request.

The Panel cites the following with approval:

“Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (Groupe Auchan v. xmxzl, WIPO Case No. DCC2006-0004).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:

(i) the disputed domain name consists of Latin letters, rather than Chinese characters;

(ii) the Complainant has provided evidence that other domain names owned by the Respondent containing English words:

applecash.online; cloudbank.cn; essentialhome.org; galaxydigitalholdings.com; jmpphone.com; multiplylogisticsnorth.com; nintendotencent.com; orangebank.co; playlearnclub.com.;

(iii) On the record, the Respondent appears to be Chinese individuals and are thus presumably not a native English speaker, but the Panel finds that persuasive evidence in the present proceeding to suggest that Respondent may have sufficient knowledge of English;

(iii) the Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language;

(iv) the Respondent did not object to the Complainant’s request that English be the language of the proceeding.

Upon considering the above, the Panel determines that English be the language of the proceeding.

5.2 Substantive Issues

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

Pursuant to the Policy, paragraph 4(a)(i), a complainant must prove that a disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. In line with such requirement, a complainant must prove its

trademark or service mark right and the similarity between the disputed domain name and its trademark or service mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. As the evidence shows, the Respondent is indeed the owner of the disputed domain name since the year 2017. However, the Complainant is the owner of prior to 2017 trademark registrations for the mark BASF in various designations, including in China where the Respondent resides.

The disputed domain name <basfdea.com> reproduces entirely the Complainant's BASF trademark with the addition of the components "dea" and the gTLD suffix ".com". The generic word dea does not avoid a confusing similarity to the Complainant's BASF trademarks. Also, the gTLD ".com" is without legal significance in the present case since the use of a TLD is technically required to operate a domain name.

Therefore, the addition of the term "dea" and the gTLD suffix ".com" does not have the capacity to distinguish the disputed domain name from the Complainant's BASF registered trademarks and is disregarded when comparing the disputed domain names with the Complainant's trademarks. See Volkswagen AG v. Todd Garber, WIPO Case No. D2015-2175; Dassault (Groupe Industriel Marcel Dassault) v. Ma Xiaojuan, WIPO Case No. D2015-1733; Lego Juris A/S v. Chen Yong, WIPO Case No. D2009-1611; Dr. Ing. H.c. F. Porsche AG v. zhanglei, WIPO Case No. D2014-0080; Cummins Inc. v. DG Lanshan Mechanical Electrical Equipment Co., Ltd., ADNDRC Case No. HK-1000286

Furthermore, the mark BASF is inherently distinctive mark which will attract Internet users' attention. The evidence provided by the Complainant also shows that the BASF mark has accumulated a considerable reputation by 2017 when the Respondent registered the disputed domain name. Reproduction of the Complainant's BASF trademark in its entirety in the Domain Name in itself establishes that the Domain Name is confusingly similar to the Complainant's trademarks. See EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., WIPO Case No. D2000-0047,

The Panel therefore finds that the disputed domain name <basfdea.com> is confusingly similar to the Complainant's registered marks. Accordingly, the Complainant has proven the element required by the Policy, paragraph 4(a)(i).

B) Rights and Legitimate Interests

Once the Complainant establishes a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 3.0"), paragraph 2.1.

In the present case, the Complainant's prior BASF trademark registrations demonstrate *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain name.

The Panel finds that the Complainant has established a *prima facie* case in this regard, *inter alia*, due to the fact that the Complainant has not licensed or otherwise permitted the

Respondent to use the Complainant's trademarks or a variation thereof and the evidence presented indicates that the Respondent is not engaged in a *bona fide* offering of goods or services.

Given the notoriety of the BASF mark at the time of the Respondent registered the disputed domain name, the Respondent must clearly show rights or legitimate interests once the burden has shifted. However, the Respondent did not provide any reasonable explanation or evidence to show any rights or legitimate interests in the complainant's BASF trademarks to rebut the Complainant's *prima facie* case.

The Respondent is not known by the disputed domain name, the Respondent failed to show how the disputed domain name is associated with himself. Further, the Respondent has not shown any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services supported by relevant pre-complaint evidence. Accordingly, the Respondent has failed to show that he has rights or legitimate interests in respect of the disputed domain name.

The Panel finds that on the balance of probabilities, the Complainant has proven the element required by the Policy, paragraph 4(a)(ii).

C) Bad Faith

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Respondent's main contention is that he registered the disputed domain name in good faith and without knowing about the Complainant's QQ trademarks. The Complainant brought evidence to show that the QQ trademark gained notoriety in China, where the Respondent resides, well before he took the disputed domain name.

The Complainant has submitted evidence that shows that the Respondent registered the disputed domain name after the Complainant registered the BASF trademark in China. The Complainant has owned a registration for the BASF trademark since the year 1995, while the Respondent first registered the disputed domain name in November 2017. Well before the Respondent registered the disputed domain name, the Complainant BASF web site was one of the well know web sites in China. It is inconceivable that the Respondent was not aware of the Complainant's BASF mark when he registered the disputed domain name.

Moreover, the Respondent did not respond formally to the Complaint. The Panel therefore concludes that the disputed domain names were used by the Respondent in bad faith.

In summary, the Respondent, by choosing to register and use the disputed domain names, which are confusingly similar to the Complainant's well-known trademarks, intended to ride on the goodwill of the Complainant's trademarks in an attempt to exploit, for commercial gain, internet users destined for the Complainant. In the absence of evidence to the contrary and rebuttal from the Respondent, the choice of the disputed domain names and the conduct of the Respondent as far as the website on to which the disputed domain names resolves is indicative of registration and use of the disputed domain names in bad faith.

Based on the evidence that was presented to the Panel, the Panel finds that the disputed domain name was registered and is being used in bad faith.

6. Decision

For the foregoing reasons, in accordance with Paragraph 4(a) of the Policy and Paragraph 15 of the Rules, the Panel orders that the disputed domain name <basfdea.com> be transferred to the Complainant.



Timothy Sze
Sole Panelist

Dated: 21 June, 2018