

ADMINISTRATIVE PANEL DECISION

BASF SE v. Yani Herzog

Case No. D2023-3926

1. The Parties

The Complainant is BASF SE, Germany, represented by IP Twins, France.

The Respondent is Yani Herzog, Thailand.

2. The Domain Name and Registrar

The disputed domain name, <basfplc.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2023. On September 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. On September 22, 2023, the Center sent an email communication to the Complainant, providing the registrant’s identity and contact information as disclosed by the Registrar, inviting the Complainant to submit an amendment to the Complaint by September 27, 2023. The Complainant filed an amended Complaint on September 25, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 19, 2023.

The Center appointed Philippe Gilliéron as the sole panelist in this matter on October 31, 2023. The Panel finds that 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.

4. Factual Background

The Complainant is one of the largest chemical companies in the world.

It owns numerous trademarks on worldwide basis consisting in all or in part of the term “basf”, such as the International trademarks BASF n° 638794 and 909293, respectively registered on May 3, 1995, and October 31, 2006 in numerous classes and countries.

The Complainant further owns numerous domain names incorporating its trademark BASF such as, among many others, <basf.com>, <basf.asia>, <basf.in>, and <basf.org>.

The disputed domain name was registered on April 20, 2023. The disputed domain name does not lead to any active website, but to an error page.

5. Parties' Contentions

A. Complainant

The Complainant first alleges that the disputed domain name is confusingly similar to its BASF trademark, as it entirely incorporates the term “basf” and that the addition of the acronym “plc” does not exclude the resulting likelihood of confusion.

The Complainant then affirms that the Respondent has no rights or legitimate interests in the disputed domain name as he is not commonly known under that name, does not own any trademark consisting of the term BASF, and has not been licensed or authorized in any way by the Complainant to use its trademark. The Respondent has further not made any *bona fide* offering of goods or services.

The Complainant finally is of the view that the disputed domain name was registered and is being used in bad faith. Taking into account the well-known character of the BASF trademark, the Respondent was obviously aware of the Complainant's trademark when he registered the disputed domain name. As a result of this well-known character, the Complainant sees no plausible way whatsoever that the Respondent could use the disputed domain name in good faith. The Complainant thus states that the Respondent acquired the disputed domain name to prevent the Complainant from reflecting its earlier trademarks in the corresponding domain name and in full knowledge of the Complainant and its earlier rights, which amounts to a usage in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “[...] decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

- (i) the disputed domain name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant proves to hold several trademarks consisting of the term “basf”.

UDRP panels widely agree that incorporating a trademark into a domain name, in its entirety, can be sufficient to establish that the domain name is confusingly similar to a registered trademark for purpose of the Policy (see, e.g., *Uniroyal Engineered Products, Inc. v. Nauga Network Services*, WIPO Case No. [D2000-0503](#); *Thaigem Global Marketing Limited v. Sanchai Aree*, WIPO Case No. [D2002-0358](#); and *F. Hoffmann-La Roche AG v. Relish Entreprises*, WIPO Case No. [D2007-1629](#)).

Such happens to be the case here. The trademark BASF is entirely incorporated in the disputed domain name, and the addition of an acronym such as “plc” does not prevent the confusing similarity (see, among others: *Playboy Entreprises International, Inc. v. Zeynel Demirtas*, WIPO Case No. [D2007-0768](#); *Inter-IKEA Systems B.V. v. Evezon Co. Ltd*, WIPO Case No. [D2000-0437](#); *Dell Computer Corporation .v. MTO C.A. and Diabetes Education Long Life*, WIPO Case No. [D2002-0363](#)).

As a result, the Panel considers paragraph 4(a)(i) of the Policy to be satisfied.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

As the panel stated in *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#), demonstrating that the Respondent has no rights or legitimate interests in the domain name “would require complainant to prove a negative, a difficult, if not impossible, task”. Thus, in that decision, the panel opined that “[w]here a complainant has asserted that the respondent has no rights or legitimate interests in respect of the domain name, it is incumbent upon the respondent to come forward with concrete evidence rebutting this assertion”. Following that decision, subsequent UDRP panels acknowledged that it is deemed sufficient for a complainant to make a *prima facie* case that the respondent lacks rights or legitimate interests in a domain name. Once a *prima facie* case has been made, the burden of production shifts to the respondent to come forward with evidence to demonstrate its rights or legitimate interests. If it fails to do so, the complainant is deemed to have satisfied to paragraph 4(a)(ii) of the Policy (see, e.g., section 2.1 [WIPO Overview 3.0](#)).

In the present case, the Complainant is the owner of several BASF trademarks. The Complainant has no business or other relationships with the Respondent.

The Complainant has made a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain name.

On his side, the Respondent has not answered to the Complaint.

Considering the absence of a Response and the fact that the Respondent is neither commonly known by the disputed domain name, nor has made a legitimate noncommercial or fair use of the disputed domain name, the Panel finds that the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name.

Consequently, in light of the above, the Panel considers paragraph 4(a)(ii) of the Policy to be fulfilled.

C. Registered and Used in Bad Faith

For a complaint to succeed, a panel must be satisfied that a domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)).

Bad faith typically requires the Respondent to be aware of the Complainant's trademarks. In the present case, the Complainant is the owner of numerous BASF trademarks, which enjoy a worldwide reputation. Several prior panels have acknowledged the well-known character of the Complainant's trademark (*BASF SE v. Jim Welsh*, WIPO Case No. [D2010-2000](#); *BASF SE v. jing liu/liujing*, WIPO Case No. [D2014-1889](#); *BASF SE v. kou xiansheng, bashifurunhuayouwuxiyouxiangongsi*, WIPO Case No. [D2015-2245](#); and *BASF SE v. Zhu Xumei*, WIPO Case No. [DMX 2015-0032](#)). Prior UDRP panels have held that the Respondent's registration of a disputed domain name that is confusingly similar to a well-known trademark can, in itself, create a presumption of bad faith (see, section 3.1.4 of the [WIPO Overview 3.0](#)).

Considering the worldwide reputation of the BASF trademarks, the Panel finds it hard to believe that the Respondent would have chosen and registered the disputed domain name <basfplc.com>, combining the term "plc" which refers to the legal nature of the legal entity to BASF trademarks, in good faith, without having been aware of the BASF trademarks. The Respondent, having neglected to participate in these proceedings, did not bring any evidence to support such a choice; such evidence does not result from the file, and the Respondent has to bear the consequences of its default on that regard.

There is no doubt in the Panel's opinion that the Respondent was very well aware of the Complainant's trademarks. In this Panel's view, it is indeed inconceivable that an individual apparently domiciled in Thailand would choose for some legitimate purposes a domain name such as the disputed one.

Furthermore, prior UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement) (see, e.g., section 3.3 of the [WIPO Overview 3.0](#)). In this case, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the composition of the disputed domain name, the Respondent's concealing its identity, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Consequently, the Panel is of the opinion that the disputed domain name has been registered and is being used in bad faith under the paragraph 4(a)(iii) of the Policy.

7. Decision

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

/Philippe Gilliéron/

Philippe Gilliéron

Sole Panelist

Date: November 14, 2023