

## **ADMINISTRATIVE PANEL DECISION**

BASF SE v. hbj g, ghbj

Case No. D2023-4139

### **1. The Parties**

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

The Respondent is hbj g, ghbj, Hong Kong, China.

### **2. The Domain Name and Registrar**

The disputed domain name <basffoam.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 4, 2023. On October 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 5, 2023, 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 (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 9, 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 October 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 3, 2023.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on November 15, 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 and is active in more than 80 countries through its subsidiaries. The Complainant services customers in over 200 countries and employs more than 112,000 people worldwide.

The Complainant is the owner of *inter alia* the following trademark registrations:

- International trademark registration No. 638794 for BASF, registered on May 3, 1995, with designations worldwide, *inter alia* for China, France, Spain, and the Russian Federation; and
- International trademark registration No. 909293 for BASF, registered on October 31, 2006, with designations worldwide, *inter alia* for China, France, Spain, and the Russian Federation.

Both registrations have been duly renewed and are still valid, and will hereafter together referred to in singular as the "Trademark".

Further, it is undisputed that the Complainant operates *inter alia* the domain names <basf.com>, <basf.asia>, <basf.in>, and <basf.org>.

The disputed domain name was registered on April 11, 2023, and currently resolves to an active page containing pornographic content.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it is one of the largest chemical companies in the world, being listed on the Frankfurt Stock Exchange, London Stock Exchange, and Zurich Stock Exchange.

The Complainant contends that the disputed domain name is confusingly similar to a Trademark in which the Complainant has rights. BASF is a famous trademark. The Trademark is reproduced identically within the disputed domain name, in highly visible and recognizable position. The BASF Trademark is associated with the term "foam" in the disputed domain name. The Complainant produces chemicals used in various forms including foam, and therefore this term is highly related to the Complainant's business. The addition of this term to the BASF Trademark not only does nothing to diminish the confusing similarity. The use of lower-case letter format is not significant in determining whether the domain name is identical or confusingly similar to the mark.

For the purposes of assessing identity and confusing similarity, it is typically permissible for the Panel to ignore the generic Top-Level Domain ("gTLD").

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent is not commonly known, as an individual or an organization, by the disputed domain name. This is evidenced by the fact that the Whois record does not reflect the disputed domain name in the Respondent field.

The Respondent has acquired no trademark or service mark related to the “basf” term.

The Respondent reproduces the Complainant's Trademark without any license or authorization from the Complainant.

The Respondent's use of the disputed domain name demonstrates no intent to use it in connection with a *bona fide* offering of goods or services at the time of original filing of the Complaint. On the contrary, the disputed domain name resolves to an active page containing pornographic content.

The Respondent has never been granted authorization, license, or any right whatsoever to use the Complainant's Trademark.

Since the adoption and extensive use by the Complainant of the Trademark 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 disputed domain name.

None of the circumstances which set out how a respondent can prove his or her rights or legitimate interests, are present in this case.

The disputed domain name was registered and is being used in bad faith.

The Trademark is so widely known that it is inconceivable that the Respondent ignored the Complainant's earlier rights in the term “basf”. The Respondent had obviously the Complainant's name and Trademark in mind when registering the disputed domain name.

The Complainant sees no possible way whatsoever that the Respondent would use the disputed domain name in connection with a *bona fide* offering of products or services. The sole detention 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 strong evidence of bad faith.

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.

It is very likely that the Respondent chose the disputed domain name because of its identity with or similarity to a Trademark in which the Complainant has rights and legitimate interests. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's site.

The Complainant's Trademark registrations significantly predate the registration date of the disputed domain name. Knowledge of the Complainant's intellectual property rights, including the Trademark, at the time of registration of the disputed domain name, proves bad faith registration. A quick trademark search would have revealed to the Respondent the existence of the Complainant and its Trademark.

The current use of the disputed domain name in connection with an active pornographic website is a further element of bad faith of the Respondent, in an attempt by the Respondent to trade on the goodwill and reputation of the Complainant.

The Complainant requests that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission, as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's Trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, "foam" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel could not establish any indication that any of the circumstances as described in paragraph 4(c) of the Policy in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name.

The current use of the disputed domain name, a webpage with pornographic content, cannot be considered a *bona fide* offering of goods or services, but rather evidence of bad faith, noting the lack of an apparent connection between the term "basffoam" and such content, see below.

The Panel further finds that the composition of the disputed domain name, reproducing the entirety of the Trademark, with only the addition of the term "foam", carries a risk of implied affiliation with the Complainant.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's rights predate the Respondent's registration of the disputed domain name. The Respondent has provided no evidence of any actual or contemplated good faith use and taken steps to conceal its identity. The Panel cannot see any plausible actual or contemplated active good faith use of the disputed domain name by the Respondent.

The disputed domain name has been used to resolve to a website containing pornographic content. It suggests that the Respondent's intent in registering the disputed domain name was most likely to profit in some fashion or otherwise exploit the reputation of the Complainant's Trademark, by creating a likelihood of confusion with the Complainant's Trademark.

Based on the available record, the Panel finds the third element of the Policy has been established.

## **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 <basffoam.com> be transferred to the Complainant.

/Richard C.K. van Oerle/

**Richard C.K. van Oerle**

Sole Panelist

Date: November 29, 2023