

ADMINISTRATIVE PANEL DECISION

BASF SE v. Catalin Herghelegiu

Case No. D2023-4206

1. The Parties

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

The Respondent is Catalin Herghelegiu, Romania.

2. The Domain Name and Registrar

The disputed domain name <basf.zip> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 11, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 11, 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 12, 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 17, 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 company 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 Romania, Hungary, Austria, Serbia and Ukraine; and
- International trademark registration No. 909293 for BASF registered on October 31, 2006, with designations worldwide, *inter alia* for Romania, Hungary, Austria, Serbia and Ukraine.

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 May 22, 2023. At the time the Complaint was filed and currently, the disputed domain name does not resolve to an active website.

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 the Trademark in which the Complainant has rights. BASF is a famous trademark. The Trademark is reproduced identically within the disputed domain name.

The use of lower-case letter format is not significant in determining whether the disputed 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. 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 error page.

Since the adoption and extensive use by the Complainant of the Trademark predates the registration 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 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. Furthermore, any actual use of the disputed domain name by the Respondent would *de facto* amount to bad faith active use.

The Complainant contends that the Complainant's Trademark is arbitrary and has no common or general meaning in any language.

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 error page is a further element of bad faith of the Respondent, under the doctrine of passive holding.

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, *inter alia* in Romania, where the Respondent apparently is located. [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 to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The gTLD ".zip" is a standard registration requirement and does not prevent the disputed domain name from being identical to the Trademark.

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 a disputed domain name.

The Panel further finds that the composition of the disputed domain name, identical to the Trademark, carries a high 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 BASF Trademark registrations predates the registration of the disputed domain name by many years. The registrations of the Trademark further support the Respondent's awareness of the Complainant's rights to the Trademark at the time of its registration. Based on the evidence presented, it is apparent that the Respondent had knowledge of the Complainant and the Trademark, and deliberately targeted this Trademark during the registration of the disputed domain name with an intention to leverage the Complainant's established reputation.

The disputed domain name incorporates the Trademark BASF along with the gTLD ".zip". Given the evident association of the disputed domain name with the Trademark, the Panel believes that the Respondent has intentionally targeted the Complainant and its Trademark during the disputed domain name registration. Consequently, the Panel believes that the Respondent registered the disputed domain name in bad faith.

In the present case, the Panel notes that the Complainant's Trademark 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.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the 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. While 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness or reputation of the Complainant's Trademark, and the composition of the disputed domain name, 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.

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, <basf.zip> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: November 23, 2023