



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>HK-1801104</b>
<b>Complainant:</b>	<b>BASF SE</b>
<b>Respondent:</b>	<b>Oren Hilel</b>
<b>Disputed Domain Name(s):</b>	<b>&lt;basf-co.com&gt;</b>

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**1. The Parties and Contested Domain Name**

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

The Respondent is Oren Hilel, of Av. Cabildo 2523, Buenos Aires 1428, Argentina.

The domain name at issue is basf-co.com, registered by the Respondent with 101domain GRS Limited, of 4th Floor, 3 Harbourmaster Place, IFSC, Dublin D01 K8F1, Ireland.

**2. Procedural History**

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the "Centre") on April 17, 2018 and the Complainant chose a sole panelist to review this case in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") which was adopted by the ICANN and came into effect on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") became effective on September 28, 2013 and the Supplemental Rules thereof which come into effective on July 31, 2015.

On April 18, 2018, the Centre confirmed the receipt of the Complaint and Annexures, and transmitted by email to 101domain GRS Limited (the Registrar of the domain name) a request for registrar verification in connection with the domain names at issue. On April 24, 2018, the said Registrar verified to the Centre that, the Policy is applicable to the domain name at issue.

On April 24, 2018, the Centre sent the Complainant a Notification of Deficiencies and requested the Complainant to submit the Registration Agreement of the concerned Registrar incorporating the ICANN policy on or prior to April 29, 2018. On the same day, the Complainant submitted to the Centre the Registration Agreement. On April 25, 2018, the Centre confirmed that the receipt of the said agreement.

On April 25, 2018, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or prior to May 15) in accordance with the Rules and Supplement Rules, and forwarded the Complaint as well as all the Annexures thereof. The procedures for this case formally commenced on April 25, 2018.

On 20 May, 2018, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal reply with the Centre, within the required time limit for filing a reply.

On May 29, 2018, the Panel candidate considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. On May 29, 2018, the Centre notified both parties and the Panel Mr. Matthew Murphy by Email that Mr. Matthew Murphy be the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to June 12, 2018.

### **3. Factual background**

#### *For the Complainant*

The Complainant, BASF SE, claims that, it owns more than 1500 trademark rights for öBASFö worldwide and many of them were registered years before the contested domain name in a very large number of jurisdictions, including but not limited to, International Registration No. 638794 registered on May 3, 1995, as well as No. 909293 registered on October 31, 2006, both in multiple Classes.

The Complainant claims that its öBASFö trademark is a famous trademark, a claim which has previously been supported by many UDRP panelists, such as in those in WIPO decisions in Cases No. D2010-2000, No. D2014-1889, No. 2015-2245 dated February 1, 2016 and so on.

The Complainant further claims that it holds numerous domain names incorporating the BASF trademark, both generic TLDs and country level ones, particularly in Asia and China: <basf.com>, <basf.asia>, <basf.in>, <basf.org> and many others.

#### *For the Respondent*

The Respondent, Oren Hilel, is located at Av. Cabildo 2523, Buenos Aires 1428, Argentina. The Respondent's email is amdapashapour@gmail.com. The Respondent did not file a Reply, nor any other materials with the Centre.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant claims that, the Disputed Domain Name is identical to the BASF trademark and likely to create confusion in the minds of the general public.

The Complainant claims that the use of lower case letter format and the addition of the letters õ-coõ are not significant in determining whether the domain name is identical or confusingly similar to the trademark, since it is a meaningless word which does nothing to minimize the confusing similarity which arises between the domain name at issue and the Complainant's trademark. The Complainant also claims that it is typically permissible for the Panel to ignore the generic gTLD suffix when considering these kinds of domain name matters. Thus, the Complainant contends that the average Internet user will likely believe that this domain name is specifically created by the Complainant.

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

The Complainant claims that the Respondent should be considered as having no rights or legitimate interests in the Disputed Domain Name, on the grounds that 1) the Respondent is not commonly known by the disputed domain name, nor has he/she acquired any trademark or service mark related to the BASF term; 2) the Respondent has reproduced the Complainant's trademark without any license or authorization from the Complainant's company, which is a strong evidence of the lack of any legitimate interest; 3) the Respondent's use of the domain name in dispute (or preparation to use the domain name) demonstrates a lack of intention to use the domain name with a bona fide offering of goods or services. The Complainant also claims that since the Complainant has made a prima facie case, the burden of proof shifts to the Respondent to come forward with appropriate claims, defenses and evidence demonstrating rights or legitimate interests in the domain name in dispute.

- iii. The disputed domain name has been registered and being used in bad faith.

The Complainant claims that the BASF trademarks are so widely well-known that the Respondent must have had the Complainant's name and trademark in mind when registering the domain name in dispute. The Complainant claims that it sees no possible way that the Respondent would use the domain name in connection with a bona fide offering of products or services, since any use of the BASF trademark would amount to trademark infringement and damage to the reputation of the trademark. The Complainant further claims that the Respondent uses a well-known privacy service in order to keep their identity secret, which is evidence of bad faith registration and use.

#### B. Respondent

The Respondent did not submit any Reply.

### 5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made out, 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, by submitting its worldwide trademark registration information, has proved that it is entitled to ownership of the BASF trademarks. Obviously, the disputed domain name <basf-co.com> completely incorporates the Complainant's BASF trademark and such incorporation makes the disputed domain name confusingly similar with the Complainant's trademark. It is accepted that the following principle applies to this immediate case - "the first and immediately striking element in the domain name is the Complainant's name. Adoption of it in the Domain Name is inherently likely to lead people to believe that the Complainant is connected with it." - See WIPO Case *Dixons Group Plc v Mr. Abu Abdullaah*, Case No.: D2000-0146.

On the other hand, the suffix "-co" after the Complainant's "basf" trademark, in the disputed domain name, does not reduce the likelihood of confusing similarity between the trademark and disputed domain name, since 1) the suffix "-co" can be deemed as an abbreviation of a plain English word or phrase, with one of the possible words abbreviated being "company"; and 2) considering the business scale and fame of the Complainant, when people see the combination of "basf" and "-co", it would be natural for them to refer to "-co" as "company", other than anything else. In other words, the suffix "-co" added after the Complainant's trademark in the disputed domain name, contributes nothing to distinguish the disputed domain name from the Complainant's trademark. Instead, it may even increase the likelihood of confusion by giving a misguided impression that "-co" merely indicates the organizational form of the Complainant.

In conclusion, the Panelist finds that the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

#### **B) Rights and Legitimate Interests**

The Complainant claimed that the burden of proof with respect to the Respondent's rights and/or legal interest in the disputed domain name should shift to the Respondent, based on the fact that its BASF trademark predates the date of first registration of the disputed domain name. "Once a Complainant makes out a prima facie showing, the burden of production on this factor shifts to the Respondent to rebut the showing by providing concrete evidence that it has rights to or legitimate interests in the Domain Name." - See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No.: D2000-0270. Thus, the Panel agrees that it is appropriate to for the burden of proof to shift to the Respondent in this case as well.

Upon comprehensively considering the circumstances of the case, the Panel considers that the Respondent does not have the legal rights and interests in the disputed domain name on the grounds that:

- 1) Without submitting any evidence to prove that the Respondent has any legal rights and interests in the disputed domain names, the Respondent could not sufficiently prove that it "owns legal right and interest thereof" by the mere registration of the

disputed domain name ó See Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.

- 2) The Respondent did not provide evidence, and there is no indication shown, that there is any connection or association between the Respondent and the disputed domain name, nor any circumstances that imply that it has legal rights and legitimate interests in the disputed domain name, as laid out in Paragraph 4(c) of the Policy.

In conclusion, the Panelist finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

### **C) Bad Faith**

The Complainant claims that the Respondent must have had the Complainant's name and BASF trademark in mind when registering the domain name in dispute, since its BASF trademark is very well-known. Although the Respondent did not submit any response with respect to this claim, upon comprehensively considering following circumstances, it is reasonable for the Panel to infer that the Respondent probably would have known of the Complainant and its BASF trademark thereof when registering the disputed domain name, and such registration was in bad faith: 1) the fame of the Complainant and its BASF trademark; 2) the similarity between the disputed domain name and the Complainant's trademark; 3) the similarity between the disputed domain name and the Complainant's domain names (e.g. basf.com etc.); 4) the highly distinctive nature of the Complainant's trademark BASF; and 4) the fact that no evidence of any legal or factual relationship or connection between the Respondent and the disputed domain name and/or the BASF trademark, nor the Complainant, has been provided.

With respect to the use of the disputed domain name, it is noted that it has not been used at all based on the relevant evidence provided by the Complainant. As expressed in a previous decision, the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept ó See Telstra Corporation Limited v. International Electronic Communications Inc., WIPO Case No.: D2000-0003. Given the circumstances involved in this dispute as outlined above, it is reasonable for the Panel to infer that the Respondent has registered and uses uses disputed domain name in bad faith.

In conclusion, the Panelist finds that the Complainant has satisfied Paragraph 4(a)(iii) of the Policy.

## **6. Decision**

Pursuant to Paragraph 4(a) of the Policy and Article 15 of the Rules, the Panelist orders that the disputed domain name < basf-co.com > be transferred to the Complainant.

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Matthew Murphy  
Panelists

Dated: June 12, 2018