Asian Domain Name Dispute Resolution Centre

ADNDRC Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	**HK-18010153**
Complainant:	**BASF SE**
Respondent:	**HAN CONG – Bei Jing Yi Qi Shang Ke Ji You Xian Gong Si Di Liu Fen Gong Si**
Disputed Domain Name(s):	**< basf-dfl.com >**

1. The Parties and Contested Domain Name

The Complainant is BASF SE, of Carl-Bosch Strasse, 67056 Ludwigshafen, Germany.

The Respondent is HAN CONG – Bei Jing Yi Qi Shang Ke Ji You Xian Gong Si Di Liu Fen Gong Si of He Bei Sheng Shi Jia Zhuang Shi Zhong.

The domain name at issue is <basf-dfl.com>, registered by Respondent with Alibaba Cloud Computing Ltd.

2. Procedural History

On 19th July 2018, the Complainant filed a complaint with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre ("the Centre") and chose to have the dispute considered and decided by a single-member panel 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 20th July 2018, the Centre, by way of email, sent a request to the Registrar of the Disputed Domain Name, Alibaba Cloud Computing Ltd **("the Registrar")** for verification in connection with the Disputed Domain Name. On the same day, the Registrar verified the following:-

(i) They are the registrar of the Disputed Domain Name.
(ii) The registrant of the Disputed Domain Name is the Respondent **HAN CONG Bei Jing Yi Qi Shang Ke Ji You Xian Gong Si Di Liu Fen Gong Si**.
(iii) The creation date of the Disputed Domain Name is 2nd May 2017;
(iv) The Disputed Domain Name status is as follows:

- Client Updated Prohibited
- Client Transfer Prohibited
- Client Delete Prohibited

On 22nd August 2018, the Centre, by way of email, informed the Complainant that the language of the proceedings should be Chinese pursuant to Article 11(a) of the Rules. On 23rd August 2018, the Complainant, by way of email, applied to change the language of the proceedings.

On 19th September 2018, the Centre issued a Written Notice of Complaint to the Respondent informing the Respondent that the proceedings officially commenced and requested the Respondent to submit a Response (in Form R and its Annexures, if any) within 20 days (i.e. on or before 9th October 2018) and forwarded the Complaint and its Attachments to the Respondent.

On 10th October 2018, the Centre issued a Notification of Respondent in Default and confirmed that the Respondent did not submit a Response with the Centre, within the required time limit.

On 19th October 2018, the Centre appointed Dr. Lewis Luk JP as the sole panelist for this case. The Panel considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence.

On 29th October 2018, the panelist issued the Administrative Panel Order No. 1 ("**the Panel Order**") that the language of the proceedings be changed from Chinese to English and requested the Complainant to submit further evidence of its trademark registration in China in relation to "BASF" or other evidence on its civil rights on the domain name in China within 14 days from the date of the Panel Order.

The Complainant submitted further evidence on 29th October 2018.

3. Factual background

The Complainant

The Complainant, BASF SE was founded in 1865 and is one of the world's largest chemical company. In 1936, the Complainant developed magnetic tape which was later integrated into consumer products such as cassette and video tapes. In 1885, the Complainant first built the first factory in China and have been operating in China for 130 years. Up to the date, the Complainant has 25 production sites in China included Guangdong, Chongqing, Nanjing.

The Complainant is the owner of the trademark "BASF" around the world, including USA and China since 1965.

(collectively "**the Complainant's Trademarks**").

The Respondent

The Respondent registered the Disputed Domain Name on 2nd May 2017.

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 registered its "BASF" as early as in 1965 and it has been using its trademark extensively in China while the Respondent created the Disputed Domain Name on 2nd May 2017. The Complainant submitted that the Disputed Domain Name incorporates the Complainant's Trademarks in its entirety with the addition for the generic term "dfl" and a hyphen symbol. According to the Complainant, the term "dfl" refers to the abbreviation for "dry film lubricant" products which is the Complainant's internationally well-known manufactured products.

The Complainant also submitted with support of authorities that it has been held that domain names are identical or confusingly similar to a trademark when the domain name includes the trademark or a confusingly similar approximation, regardless of the other terms in the domain name. There is also no legal significance on the use of a hyphen symbol or <.com> when one is to assess whether a domain name is identical or confusingly similar to a trademark as it is a functional element. The Complainant therefore submitted that the disputed domain name is "identical or confusingly similar" to the Complainant's Trademark.

ii. ***The Respondent has no rights or legitimate interests in respect of the domain name***
The Complainant confirms that there is no relationship between the Complainant and the Respondent and that the Respondent is not duly authorized, licensed, or permitted in any way by the Complainant to register or use the Disputed Domain Name or the BASF trademark.

The Complainant also submitted evidence of commercial fraudulent activity on the part of the Respondent which revealed that the Respondent operated a website of the Disputed Domain Name selling counterfeit which the Complainant confirmed that none of the products for sale by the Respondent had originated from the Complainant. The Respondent is using the Disputed Domain Name to misrepresent itself as being the Complainant.

The Complainant also submitted that where the Complainant had made a prime facie case on the lacking of rights or legitimate interests on the part of the Respondent, the burden of proof would then shift to the Respondent for rebuttal with evidence. The Respondent had failed to submit any response nor evidence in this case. Thus, the Complainant shall be deemed to have satisfy this requirement of proving that the Respondent does not have any legitimate interest in the Disputed Domain Name.

iii. The Disputed Domain Names(s) has/have been registered and is/are being used in bad faith

The Complainant has been operating in China for 130 years and has attained a high degree of fame and reputation in in China. To date, the Complainant has 25 production sites in China. A search of the term "BASF" on the google search engine yields results only relating to the Complainant. The Complainant's trademark is distinctive and famous worldwide. It is unthinkable for the Respondent to argue that he had no knowledge of the Complainant and the Complainant's trademark as the Respondent had even made use of one of the Complainant's trademark which was in a square logo along with the Complainant's company name "BASF" and its trademark slogan "The Chemical Company" on the website operated by the Respondent under the Disputed Domain Name.

The Complainant also submitted with support of evidence that the Respondent was not only familiar with the Complainant's trademark but also the company. The Respondent had included photos purporting to be photos of the Complainant's chemical plant and a large metal storage tank bearing the words "BASF" painted across the whole tank on the website under the Disputed Domain Name.

The Respondent wrongfully and fraudulently registered the Disputed Domain Name for the sole purpose of utilizing the goodwill and reputation of the Complainant to mislead innocent consumers through such unfair and dishonest means. The Complainant also averred that the conduct of the Respondent was causing damage and injury to the Complainant's business, reputation and goodwill.

B. Respondent

The Respondent did not submit a Response.

5. Findings

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

The Panel finds the Complainant's Trademarks duly registered in China and USA are all valid and effective. The Panel accepted the Complainant's submissions that the term "dfl" referred to "dry film lubricant" product which is one of the manufacturing product of the Complainant. The Panel finds that the Disputed Domain Name, which contains the Complaint's Trademarks in its entirety, to be identical to the Complainant's Trademarks and it is very likely to cause confusion to the public. The Complainant has fulfilled the first condition.

B) Rights and Legitimate Interests

The Panel accepts the confirmation by the Complainant that it has no connection with the Respondent at all. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has fulfilled the second condition.

C) Bad Faith

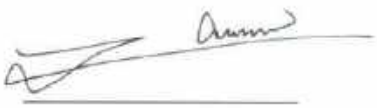
The Panel finds that the Complainant enjoys high degree of reputation and goodwill in respect of the chemicals production and synthetic dyes worldwide including China.

The Panel also finds that the Respondent should have constructive or actual knowledge of the Complainant both worldwide or in China. According to the evidence showing the website operated by the Respondent with the Disputed Domain Name submitted by the Complainant, the Respondent represented itself to the general public with an intention to create an impression that it was related to the Complainant or as one of the Complainant's chemical plants in China. The Panel finds that it is very likely for the consumers to be misled into believing that the Respondent is related to the Complainant and thus causing damage to the Complainant's business and reputation.

The Panel finds that the Respondent has registered and used the Disputed Domain Name in bad faith. The Complainant has fulfilled the third condition.

6. Decision

The Panel orders that the Disputed Domain Name <basf-dfl.com> be transferred to the Complainant.



Panelist: Dr. Lewis Luk JP

Dated: 16th November 2018