



香港國際仲裁中心
Hong Kong International
Arbitration Centre

ADMINISTRATIVE PANEL DECISION Case No. DCN-1600674

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|---------------------|---------------------|
| Complainant: | BASF SE |
| Respondent : | 金大军 |
| Domain Name: | basfchem.cn |
| Registrar: | 杭州云集通信科技有限公司 |

1. Procedural History

The Complainant filed the Complaint, including a request that English be used as the language of the administrative proceeding, with the Hong Kong International Arbitration Centre (the "Centre") and chose to have a sole panelist handle the dispute, on February 29, 2016, in accordance with the CNNIC Domain Name Dispute Resolution Policy ("CNDRP") issued by the China Internet Network Information Center ("CNNIC") and effective as of November 21, 2014, the Rules for CNNIC Domain Name Dispute Resolution Policy ("Rules of CNDRP") issued by the CNNIC and effective as of November 21, 2014, and the HKIAC Supplemental Rules for CNDRP and Rules of CNDRP ("Supplemental Rules"), issued by the Hong Kong International Arbitration Centre and effective as of November 21, 2014.

On March 1, 2016, the Centre transmitted by email to 杭州云集通信科技有限公司 (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On the same day, the Centre confirmed receipt of the said Complaint. On March 7, 2016, the Centre resent the said email to the Registrar. On March 14, 2016, the Centre sent a request to the CNNIC for assistance in obtaining a response of a registrar verification from the Registrar. On April 14, 2016, the Registrar completed the said verification to the Centre. On the same day, the Respondent replied to the Centre by email (55610232@qq.com) and asked for the Complainant's contact information in order to negotiate a resolution of the dispute.

On April 14, 2016, the Centre sent the Notification of Commencement of Proceedings to the Respondent and requested the Respondent to reply within 20 days (on or prior to May 4, 2016), and forwarded the Complaint and its Attachments as well as the language request to the Respondent, in accordance with the Rules of CNDRP and the Supplemental Rules. The procedure for handling this case formally commenced on April 14, 2016. On May 9, 2016, the Centre issued a Default Notice and confirmed the Respondent had failed to file a formal reply with the Centre within the required time limit, as well as confirming the receipt of the email sent on April 14, 2016 from 55610232@qq.com. Later that day, the Respondent replied to the Centre by email (58710@qq.com) claiming the Disputed Domain Name was not used for any commercial purposes, and his wish to transfer the

said domain name to the Complainant for a value of RMB 5,000 Yuan. On May 10, 2016, the Centre confirmed the receipt of the said email from the Respondent

On May 20, 2016, the Centre appointed Mr. Matthew Murphy as the sole panelist for arbitrating this case. The Panel considered its constitution to be proper, and subsequently submitted an acceptance notice as well as a statement of impartiality and independence. The Centre formally transferred the case to the Panelist on the same day. The Panelist agreed to deliver his decision with respect to the Disputed Domain Name on or prior to June 6, 2016.

2. Factual background

For the Complainant

The Complainant, BASF, says that it is the largest chemical company in the world and is currently listed on the Frankfurt Stock Exchange, London Stock Exchange, and the Zurich Stock Exchange. The Complainant further claims that it is comprised of subsidiaries and joint ventures in more than 80 countries, and operates six integrated production sites and 390 other production sites in Europe, Asia, Australia, Americas and Africa, with more than 112,000 employees around the world. It also claims that it is currently focusing on investment in Asia, with a total of €5.6 billion invested between 1990 and 2005 in Asia, including sites near Nanjing and Shanghai, China. In addition, the Complainant claims its customer base range over 200 countries, and that it supplies products to a wide variety of industries.

The Complainant claims it owns the following International Trademark Registrations: No. 638794 registered on May 3, 1995 in classes 03, 05 and 30, and No. 909293 “BASF” registered on October 31, 2006 in 30 different classes. The said trademarks (No. G638794 and No. G909293) were registered years before the Disputed Domain Name herein, and have been granted territorial extension protection in China. The Complainant further claims that it is also the owner of many other “BASF” trademark rights in China.

For the Respondent

The Respondent, 金大军, is an individual with an email contact of 58710@qq.com. The Respondent registered the Disputed Domain Name on November 16, 2014. The Respondent did not file any Reply or any other materials with the Centre within the required time limit.

3. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights and interests:

The Complainant says it owns the International Trademark Registrations No.'s 638794 and No. 909293, which were registered years before the Disputed Domain Name, as well as many other "BASF" trademarks in China. Further, the Complainant claims these trademarks were recognized as well-known trademarks in several prior WIPO decisions, such as WIPO Case No. 2014-1899 and WIPO Case No. 2010-2000. The Complainant also claims it holds numerous domain names incorporating the BASF trademark, both within generic TLDs and geographical ones, particularly in Asia and China.

The Complainant considers the Disputed Domain Name has fully incorporated its prior trademark BASF, and that the addition of "chem" thereof is easily understandable in the English language as an abbreviation of the common terms "chemical" or "chemistry". The Complainant argues that, since chemistry is a related field to its field of activity and business, such addition does not reduce its confusing similarity with the Complainant's trademark. It further argues that the TLD must not be taken into account during the confusing similarity analysis.

- ii. The holder of the disputed domain name has no legitimate right or interest in the domain name or a major part of the domain name:

The Complainant argues the Respondent is neither commonly known by the Disputed Domain Name, nor has it acquired trademark or service mark rights in relation to the "BASF" term based on trademark database searches conducted by the Complainant. Thus, it considers the Respondent has no rights or legitimate interests in respect of the domain name that is the subject of the Complaint.

- iii. The holder of the disputed domain name registered or used the disputed domain name in bad faith:

The Complainant argues that, apart from the Disputed Domain Name, the Respondent also registered the following domain names <basfchemical.net> and <basfchem.net>. Such registrations indicate a pattern to prevent the Complainant from reflecting its mark in a corresponding domain name in China. The Complainant also argues that the addition of "chem" which closely corresponds with the Complainant's products, further indicates the Respondent knew or should have known of the Complainant's business and trademarks when registering the Disputed Domain Name. The Complainant further points out that the Respondent is customarily registering domain names, which reproduce third-party trademarks without such party's permission. Furthermore, it considers that the renewal of the Disputed Domain Name by the Respondent in 2016 amounts to using the Disputed Domain Name in bad faith.

B. Respondent

The Respondent did not submit any Reply within the required time limit. Nevertheless, in an email sent to the Centre on May 9, 2016, the Respondent stated

that 1) he has not used the Disputed Domain Name for any commercial use; and 2) the Disputed Domain Name has not been used since its registration. The Respondent also offered to the Complainant the sale of the Disputed Domain Name for RMB 5,000 Yuan.

4. Findings

Article 8 of CNDRP provides that a complaint against a registered domain name shall be supported if the following conditions are fulfilled:

- i. The disputed domain name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests;
- ii. The disputed domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name;
- iii. The disputed domain name holder has registered or has been using the domain name in bad faith.

Article 7 of CNDRP states that the complainant and the respondent shall bear the burden of proof for their own claims. With reference to the complaint and the attached documents, the Panel of this case considers that:-

Language of the Proceedings

The Complainant filed the Complaint with the Centre in English, and requested English be the language of the proceeding based on the following reasons: 1) the Respondent is or has been the owner of numerous domain names that contain trademarks and/or generic words in English, which indicates the Respondent has a level of English language high enough to undergo the proceedings; 2) the Complainant, as a German entity, is not able to communicate in Chinese, and therefore is not in a position to conduct the proceedings in Chinese without a great deal of additional expense and delay due to translation; and 3) since English language is not the native language for both the Complainant and its representative, the use thereof would not give the Complainant any unfair advantages over the Respondent.

Following the line of reasoning in previous cases, when deciding “whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all ‘the relevant circumstances’”. And such circumstances include “whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties” - See *WIPO Case SWX Swiss Exchange v. SWX Financial LTD, D2008-0400*.

Accordingly, the Panel notes the following circumstances in this case that may affect the determination of the language of the proceedings:

- (1) The registration of numerous domain names containing English words indicates the Respondent does have knowledge of English language to certain extent.
- (2) The Respondent had been notified of the Complaint against him/her and was invited to provide comments on the Complainant's language request through email communications written in both Chinese and English by the Centre.
- (3) The Respondent did not raise any objection with respect to the Complainant's language request at all, nor did the Respondent make any comments on the matter when he communicated with the Centre.
- (4) The Complainant, as a German entity, is not able to understand Chinese, and all the materials presented thereby are in English, which would take a lot of time and additional cost for such Chinese translation, and therefore, a delay in the proceedings will be inevitable.

Based on the above and using CNDRP precedents that were conducted in English (e.g. Case No. DCN-1500624), the Panel considers that: it is reasonable to infer that the Respondent probably has an English language ability, and therefore, should be able to understand the English used in the proceedings. Even if the Respondent might have any difficulties in understanding English, since all the email communications were written in both Chinese and English, the Respondent must have been fully aware of the language request raised by the Complainant, and should have understood that what would happen if the proceeding is determined to be conducted in English. However, with sufficient time and opportunity to comment on or object to such language request, the Respondent did nothing.

Thus, upon weighing relevant circumstances on both sides, the Panel considers it would be appropriate to exercise its discretion and conduct the proceedings in English.

Identical or Confusing Similarity

There is no doubt the Complainant, by submitting details of its International Trademark Registrations, which have been granted for territorial extension protection in many countries, including China, has proved that it is entitled to the trademark rights in the "BASF" mark. Obviously, the Disputed Domain Name <basfchem.cn> completely incorporates the Complainant's "BASF" mark at its first part, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark. That is because "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*, D2000-0146.

One the other hand, the suffix "chem" after the Complainant's "basf" trademark does not help to reduce the confusing similarity, on the grounds that 1) the suffix "chem" can be deemed as an abbreviation of an English word or phrase, with one of the possible words as "chemical" or "chemistry"; 2) the Complainant, BASF, is the largest chemical company in the world; and 3) considering the business scale and fame of the Complainant in the chemistry field, when people

see the combination of “basf” and “chem”, it would be natural for them to refer “chem” as “chemistry”, other than anything else. In other words, the suffix “chem” added after the Complainant’s mark in the Disputed Domain Name, contributes nothing to distinguish the Disputed Domain Name from the Complainant’s mark. Instead, it may even increase the likelihood of confusion by giving a misguided impression that “chem” merely indicates the nature of the Complainant’s core business/brand.

In conclusion, the Panel considers that the Complainant has satisfied Article 8.1 of the CNDRP.

Rights or Legitimate Interests of the Respondent

When it comes to determine whether the Respondent has any legal right and/or interest in the Disputed Domain Name or not, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it the owns legal right and interest thereof; otherwise, “all registrants would have such rights or interests, and no complainant could succeed on a claim of abusive registration” - See *WIPO Case Adobe Systems Incorporated v. Domain OZ, D2000-0057*.

In the current case, the Panel notes the Respondent failed to prove and there is no evidence indicating that he has used the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services, nor has the Respondent been commonly known by the Disputed Domain Name or has made a legitimate noncommercial or fair use thereof, as it is provided in the Article 10 of the CNDRP.

Furthermore, based on the evidence provided by the Complainant, it is reasonable for the Panel to infer the Respondent registered the Disputed Domain Name for the purpose of seeking profit through sale. Under the normal circumstances, registering a domain name for sale is not forbidden under the CNDRP. However, when the registration and sale of a domain name that is confusingly similar to a third party’s trademark right, is made with the intention of exploiting the fame and value of the trademark right and in the suspicious of infringing the right, then such registration does not create any legal rights and interest for the registrant, nor the sale thereof could be count for “bona fide offering of goods or services”. Not to mention, such registration and sale can be deemed as indications of bad faith registration and use.

In conclusion, the Panel considers that the Complainant has satisfied Article 8.2 of the CNDRP.

Bad Faith

As it is mentioned above, it is inferred the Respondent registered the Disputed Domain Name for the purpose of sale, based on the following circumstances:

- 1) In a reverse WHOIS search using the Respondent’s email 58710@qq.com conducted by the Complainant, the said email address was found to be in association with 222 domain names;
- 2) The same result shows the Respondent registered two other domain names that contain the Complainant’s trademark: <basfchemical.net> and <basfchem.net> as well;

- 3) Moreover, located within the 222 domain names mentioned above, are domain names containing other third parties' trademarks, such as <antashoes.net>, <cadburycandy.com>, <daewoointernational.net>, <diorcosmetics.net>, <godivafood.com>, <ferrerochocolates.net>, and so on; and
- 4) In the Respondent's email sent to the Centre on May 9, 2016, the Respondent stated "the domain name has not been put into use since its registration, if they want to buy it, I could assign it to BASF Chemical at a very low price of RMB 5,000 Yuan".

Based on the circumstances above, it can be seen that the Respondent has a pattern of registering numerous domain names, including those containing other parties' trademark, which has been registered mostly without permission. With respect to the three domain names incorporating the Complainant's trademarks, such as <basfchemical.net> and <basfchem.cn>, the way the Respondent combined the "basf" and the corresponding suffix together actually indicates that he may be well aware of the Complainant's "BASF" and its value when he registered the Disputed Domain Name, and therefore, such registration constitutes bad faith registration.

Furthermore, the registration of domain names that contain "basf" including the Disputed Domain Name herein, by the Respondent, also falls into one of the circumstances that proves bad faith registration or use provided in Article 9.2 of the CNDRP. The said article states that "the disputed domain name holder, on many occasions, registers domain names in order to prevent owners of the names or marks from reflecting the names or the marks in corresponding domain names". Thus, the Panel concludes that the registration and use of the Disputed Domain Name, is in bad faith.

In conclusion, the Panel considers that the Complainant has satisfied Article 8.3 of the CNDRP.

5. Decision

Pursuant to Article 40 of the CNDRP Rules, this Panel orders that the domain name <basfchem.cn> be transferred to the Complainant.

Panelist: Matthew Murphy

Date: May 31, 2016