Decision for dispute CAC-UDRP-106655

Case number	CAC-UDRP-106655
Time of filing	2024-07-03 09:53:00
Domain names	basf.email

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BASF SE

Complainant representative

Organization	Convey srl

Respondent

Organization	JP Barkley

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has demonstrated ownership of rights in the trademark BASF for the purposes of standing to file a UDRP complaint.

The Complainant is the owner of several trademark registrations for BASF, including the following, as per trademark registration certificates submitted in annexes to the Complaint:

- International trademark registration No. 909293 for BASF (word mark), registered on October 31, 2006, in classes 1, 2, 3, 4, 5, 6, 7, 9, 10, 12, 16, 17, 18, 19, 22, 24, 25, 27, 28, 29, 30, 31, 32, 35, 36, 37, 39, 41, 42 and 44;

- European Union trademark registration No. 005458518 for BASF (word mark), filed on October 31, 2006, and registered on November 5, 2007, in classes 1, 2, 3, 4, 5, 6, 7, 9, 10, 12, 16, 17, 18, 19, 22, 24, 25, 27, 28, 29, 30, 31, 32, 33, 35, 36, 37, 39, 41, 42 and 44;

- United States trademark registration No. 3786543 for BASF (word mark), filed on November 2, 2006, and registered on May 11, 2010, in international classes 1, 2, 3, 4, 5, 6, 7, 9, 16, 17, 18, 19, 22, 24, 27, 28, 31, 32, 35, 36, 37, 39, 41, 42 and 44.

FACTUAL BACKGROUND

The Complainant, originally known as Badische Anilin & Sodafabrik, is a European multinational company which is based in Germany and initially specialized in the production of dyes and inorganic chemicals.

Founded in 1865 by Friedrich Engelhorn, the Complainant successfully expanded its production over the years, adding fertilizers to its product range in 1913 which paved the way the Complainant's activities in the field of agricultural chemistry.

Further developments included a merger in 1925, with several other German chemical companies to become the chemicals conglomerate IG Farben, plastics production between 1929 and 1940's, ready coatings in the 1960s, following the acquisition of the Glasurit producer M. Winkelmann AG and in 1974, after 17 years of research and planning, the creation of Europe's largest mechanical-biological wastewater treatment plant at Ludwigshafen.

To date, the Complainant's business is organized in 11 divisions grouped into six segments: Chemicals, Materials, Industrial Solutions, Surface Technologies, Nutrition & Care, Agricultural Solutions. It comprises subsidiaries and joint ventures in more than 80 countries, six operating integrated production sites and 390 other production sites across Europe, Asia, Australia, the Americas and Africa. The Complainant has now customers in over 190 countries.

The Complainant is also the owner of the domain name <basf.com>, registered on March 15, 1995, and used by the Complainant to promote its products and services under the trademark BASF.

The disputed domain name <basf.email> was registered on April 15, 2024 and currently resolves to a registrar parking page. According to the screenshot submitted in the Complaint – which has not been contested by the Respondent -, the disputed domain name was pointed, on June 11, 2024, to an internal webpage of the domain name platform Dan.com where the disputed domain name was being offered for sale for $3,911 USD.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <basf.email> is identical to the trademark BASF in which the Complainant has rights as it reproduces the trademark in its entirety, with the sole addition of the generic Top-Level Domain (gTLD) ".email".

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name since the Respondent is in no way authorized or licensed by the Complainant to use its marks or register the disputed domain name. The Complainant also states that the Respondent is not commonly known by the disputed domain name.

The Complainant states that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use, since it has redirected the disputed domain name to a web site where the disputed domain name was offered for sale for an amount highly exceeding any reasonable out-of-pocket costs sustained by the Respondent.

As additional considerations under the frame of the Respondent's rights or legitimate interests, the Complainant also highlights that the Respondent did not publish any disclaimer as to its lack of relationship with the Complainant and that the disputed domain name, being identical to the trademark BASF, carries a high risk of implied affiliation.

The Complainant claims that the Respondent registered the disputed domain name in bad faith because, given the Complainant's world renown, it is highly unlikely that the Respondent was unaware of the Complainant at the time of registering the disputed domain name, especially considering the Complainant's rights in the BASF mark and its use of the mark also in the Respondent's country – i.e. United States, where the Complainant has 43 production, research and development sites - long predate the Respondent's registration of the disputed domain name.

The Complainant also submits that, since the disputed domain name was pointed prior to the filing of the Complaint to a website where the disputed domain name was offered for sale for $3,911 USD and no disclaimer of non-affiliation with the Complainant was provided, the Complainant's purpose in registering the disputed domain name, which incorporates the Complainant's trademark BASF, was solely to capitalize on the reputation of Complainant's mark by confusing Internet users seeking products under the trademark BASF and redirecting them to a website that was not linked to the Complainant's official website.

The Complainant also asserts that the Respondent has engaged in a pattern of registering domain names corresponding to marks held by third parties and has also been involved in a prior domain name dispute concluded with the transfer of the domain name with the complainant.

The Complainant further states that the Respondent's failure to reply to the Complainant's cease and desist letter and its provision of what appear to be inaccurate contact details in the Whois records of the disputed domain name further demonstrate the Respondent's bad faith.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The Complainant has provided evidence of ownership of valid trademark registrations for BASF.

The Panel finds that the disputed domain name is identical to the Complainant's trademark BASF as it reproduces the trademark in its entirety with the mere addition of the gTLD" .email" which, as established in a number of prior UDRP cases, is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the Complainant's submissions, the Complainant has not authorized the Respondent to register and use its trademark BASF. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

As highlighted above, the disputed domain name, currently pointing to a registrar parking page, was redirected prior to the filing of the Complaint to a website offering the disputed domain name for sale for $3,911 USD.

The Panel finds that such use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name without intent to misleadingly divert the consumers or to tarnish the Complainant's trademark.

Moreover, the disputed domain name, being identical to the Complainant's trademark, is inherently misleading and carries a high risk of implied affiliation with the Complainant.

Therefore, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the domain name according to paragraph 4(a)(i) of the Policy.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior registration and use of the trademark BASF in connection with the Complainant's products and services, including in the United States – the country where the Respondent is based according to the Whois records - and online via the website at "www.basf.com", the Respondent was or could have been aware of the Complainant's trademark when it registered the identical disputed domain name in April 2024.

Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

In the present case, the identity of the disputed domain name with the Complainant's well-known trademark BASF and its domain

name <basf.com> suggests that the Respondent was indeed aware of the Complainant and intended to target the Complainant and its trademark.

In view of the prior redirection of the disputed domain name, identical to Complainant's trademark, to a website offering the disputed domain name for sale for $3,911 USD, the Panel finds that, on balance of probabilities, the Respondent registered the disputed domain name for the purpose of selling it to the Complainant for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name according to paragraph 4(b)(i) of the Policy.

The Panel also finds that paragraph 4(b)(iv) of the Policy is applicable to the present case as the prior use of the disputed domain name demonstrated by the evidence on record suggests that the Respondent intentionally attempted to attract internet users to its website for commercial gain, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website.

The disputed domain name is currently pointed to a registrar parking page. As established in a number of prior UDRP cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. In the present case, considering i) the well-known character of the Complainant's trademark BASF, ii) the identity of the disputed domain name with the Complainant's mark; iii) the Respondent's failure to reply to the Complainant's cease and desist letter and to file a Response, iv) the implausibility of any good faith use to which the disputed domain name may be put; and v) the Respondent's provision of inaccurate contact information in the Whois of the disputed domain name, the Panel finds that the current passive holding of the disputed domain name does not prevent a filing of bad faith use.

Therefore, the Panel finds that the Complainant has also demonstrated that Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **basf.email**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2024-08-14

Publish the Decision