Decision for dispute CAC-UDRP-106943

Case number	CAC-UDRP-106943
Time of filing	2024-10-15 15:35:32
Domain names	basf-netherland.com

Case administrator

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

Complainant

Organization	BASF SE

Complainant representative

Organization	Convey srl

Respondent

Organization	Web company

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 is a manufacturer and supplier of chemicals, materials, industrial solutions, surface technologies, nutrition and care, and agricultural solutions which it distinguishes using the BASF mark for which it holds a large international portfolio of trademark and service mark registrations including the following:

International trademark BASF, registration number, 909 293 registered on October 31, 2006 for goods and services 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 Trade Mark BASF, registration number 005458518, registered on November 5, 2007 for goods and services 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 registered trademark and service mark BASF, registration number 3,786,543, registered on the Principal Register on May 11, 2010 for goods and services in intentional 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 claims rights in the BASF mark established by its ownership of the portfolio of trademark and service mark

registrations described above.

The Complainant asserts that it has established a strong international reputation and goodwill in the BASF mark and furthermore it has an established Internet presence as it owns and operates the website <www.basf.com> using the domain name <basf.com> which was registered on March 15, 1995, as well as having official accounts on the major social networks such as LinkedIn, Facebook, X, YouTube, SlideShare and Instagram.

The disputed domain name was registered by the Respondent on January 29, 2024 and has been used to host mailboxes that were used to impersonate the Complainant to engage in phishing for consumers' personal data.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's WhoIs and the information provided by the Registrar in response to the request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding.

PARTIES CONTENTIONS

Complainant's Contentions

The Complainant claims rights in the BASF mark established by its ownership of the portfolio of trademark and service mark registrations described above, and alleges that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights as it contains the Complainant's trademark BASF in its entirety with the addition of both a hyphen and the generic geographical term "netherland".

The Complainant submits that neither the hyphen nor the term "netherland" reduce the likelihood of confusion because together they infer that the disputed domain name corresponds to the Complainant's website for The Netherlands.

Furthermore, the Complainant submits that the generic Top-Level ("gTLD") extension <.com"> is merely ancillary to Internet use and cannot affect the confusing similarity of the disputed domain name to the Complainant's mark.

The Complainant secondly alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name arguing that as held in Pharmacia & Upjohn Company v. Moreonline, WIPO Case No. D2000-0134 and National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net, WIPO Case No. D2000-0118, the mere registration of a domain name does not establish rights or legitimate interests.

The Complainant adds that:

- the Respondent is not a licensee or authorized agent of the Complainant or otherwise authorized to use the Complainant's trademarks;
- the Respondent is not an authorized reseller of the Complainant;
- the Respondent has not been authorized to register and use the disputed domain name;
- upon information and belief, the Respondent is not commonly known by the disputed domain name as an individual, business, or other organization;
- the Respondent's last name is not the same as BASF or the disputed domain name;
- the Complainant did not authorize the Respondent to use its trademark;
- the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute;
- the copy email exhibited in an annex to the Complaint shows that the Respondent is not making any non-commercial or fair use of the disputed domain name but instead the disputed domain name has been used in connection with a fraudulent e-mail scheme whereby the Respondent impersonates the Complainant in e-mails to bona fide users via "[…]@basf-netherland.com".

Thirdly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith, arguing that given the Complainant's registrations and long, intensive use of the BASF trademark, including on its website, it is clear that the Respondent could not have been unaware of the existence of the Complainant's trademark, which is incorporated in the disputed domain name.

The Complainant adds that the Respondent is based in the United States, where the Complainant's trademark BASF is well known. Furthermore, the Complainant currently has 44 BASF production, research and development sites in the U.S.A., and is also quoted in many newspapers and other online media news. A quick Google search reveals the Complainant's trademark search results for U.S.A..

As the disputed domain name was registered in January 2024, several years after the Complainant obtained its first trademark registration, it follows that the registration was made in bad faith.

The Complainant adds that the exhibited email shows that the disputed domain name was used in a fraudulent email scheme; and such use and misappropriation of the Complainant's mark within the disputed domain name in order to scam bona fide users indicates that the Respondent's purpose in registering the disputed domain name was to capitalize on the reputation of the Complainant's trademark.

The Complainant adds that the Respondent failed to respond to the Complainant's authorized representative's cease and desist warning letter, further demonstrating bad faith.

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

Respondent's Contentions

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

The Complainant has provided uncontested convincing evidence of its rights in the BASF trademark and service mark established by its the ownership of the abovementioned portfolio of registered trademarks and extensive use by the Complainant in its international business as a manufacturer and provider of goods and services in the fields of chemicals, materials, industrial solutions, surface technologies, nutrition and care, and agricultural solutions

The disputed domain name < basf-netherland.com > is composed of The Complainant's mark in its entirety, in combination with the term "netherland", a hyphen and the Top-Level Domain ("gTLD") extension <.com>.

It is well established that it is sufficient for a complainant to establish that the domain name at issue contains the mark relied upon in its entirety, to satisfy the first element of the test in Policy 4(a)(i).

The Complainant's mark is recognizable as the only distinguishing feature within the disputed domain name. In the circumstances of this Complaint neither the hyphen nor the generic word "netherland" within the disputed domain name prevents a finding of confusing similarity with the BASF mark.

Neither element adds any distinguishing feature, and the word "netherland" infers a reference to the market for goods and services in The Netherlands, and the hyphen serves no purpose, except to separate the other elements and has the impact of emphasizing the Complainant's mark.

Furthermore, the gTLD extension <.com> within the disputed domain name may be ignored for the purposes of comparing the mark and the disputed domain name, because it would be considered by Internet users to be a necessary technical element for a domain name.

This Panel finds therefore that the disputed domain name is identical to the BASF mark in which The Complainant has rights and The Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain names as set out in The Complainant's detailed submissions above.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

The disputed domain name was registered on January 29, 2024, long after the date on which the Complainant registered its BASF mark on October 31, 2006 as described above.

BASF is a distinctive mark and the disputed domain name consists of the mark in its entirety with the word “netherland” infers a reference to the market for goods and services in The Netherlands and a hyphen with no inherent meaning or distinguishing characteristic.

It is implausible that the registrant of the disputed domain name was unaware of Complainant and its BASF mark when the disputed domain name was chosen and registered.

On the balance of probabilities, the disputed domain name was in fact chosen and registered with Complainant’s mark in mind intending to take predatory advantage of the goodwill and reputation that Complainant has established in the mark.

In an annex to the Complaint, the Complainant has exhibited a copy of an e-mail from an account which was created using the disputed domain name. The e-mail purports to have been sent by a named sales manager of “BASF Nederland” from <sales@basf-netherland.com> to an unsuspecting third party in a clear example of a phishing scheme.

The email falsely states: Our portfolio ranges from chemicals and materials to industrial solutions, surface technologies, nutrition & care and agricultural solutions. We have a large network of suppliers worldwide and thus work with external supplies answering effectively for the needs of wholesalers and trading companies. We received your request for Ethyl acetate and can supply in bulk. Get back to us with your order quantity so we can quote accordingly and share MSDS and TDS/COA documents.”

The Complainant denies that it has any association with the Respondent.

Such use of the disputed domain name to perpetrate an impersonation of the Complainant in the furtherance of a phishing scheme constitutes use in bad faith for the purposes of the Policy.

This Panel finds therefore that the disputed domain name was registered and is being used in bad faith and Complainant has also succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **basf-netherland.com**: Transferred

PANELLISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2024-11-13

Publish the Decision