

ADMINISTRATIVE PANEL DECISION

BASF SE v. 张子英 (ZhangZiYing), 杨凤鸣 (YangFengMing) Case No. D2023-3928

1. The Parties

The Complainant is BASF SE, Germany, represented by IP Twins, France.

The Respondent is 张子英 (ZhangZiYing), 杨凤鸣 (YangFengMing), China.¹

2. The Domain Name and Registrar

The disputed domain name <basfsms.com> is registered with Xin Net Technology Corp. (北京新网数码信息技术有限公司) (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on September 20, 2023. On September 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown Respondent) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on October 5, 2023.

On October 5, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On the same day, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

¹ The Panel notes that the name of the registrant is 张子英 (ZhangZiYing), and the organization name of the registrant is 杨凤鸣 (YangFengMing). These two names appear to be two individuals.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on October 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 2, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on November 21, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a chemical company listed on the Frankfurt Stock Exchange, London Stock Exchange, and Zurich Stock Exchange. The Complainant's group comprises 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. It has customers in over 200 countries and supplies products to a wide variety of industries, employing more than 112,000 people around the world. Between 1990 and 2005, it invested EUR 5.6 billion in major Chinese hubs like Nanjing and Shanghai.

The Complainant is the owner of the BASF mark in different jurisdictions, including the International Registration No. 638794 registered on May 3, 1995, designating, *inter alia*, China, in classes 3, 5, and 30; and International Registration No. 909293 registered on October 31, 2006, designating, *inter alia*, China, 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.

The Respondent is 张子英 (ZhangZiYing), 杨凤鸣 (YangFengMing), China.

The disputed domain name was registered on April 20, 2023, and does not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is highly similar to the BASF mark and likely to create confusion in the mind of the general public. The BASF mark is reproduced wholly within the disputed domain name in a highly visible and recognizable position. The additional term "sms" in the disputed domain name refers to a widely known and used form of communication. Further, it is typically permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") ".com" in assessing the identity and confusing similarity under paragraph 4(a)(i) of the Policy.

The Complainant further alleges that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name and has acquired no trade mark relating to the "basf" term. The Respondent reproduces the Complainant's trade mark without any license or authorization from the Complainant. Further, the disputed domain name resolves to an error page demonstrates the Respondent has no intent to use it in connection with a *bona fide* offering of goods or services.

The Complainant finally asserts that the Respondent had obviously the Complainant's name and trade mark in mind when registering the disputed domain name. The sole detention of the disputed domain name by the Respondent, in an attempt to prevent the Complainant from reflecting its trade mark and company name in a domain name, is strong evidence of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Procedural Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the Complainant is a French entity which is not able to communicate in Chinese; (ii) it would require additional expense and cause delay to conduct this proceeding in Chinese; and the disputed domain name contains the term "sms" which is widely known as an abbreviation of the English terms "short message service" indicating that the Respondent's ability to understand English.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term "sms" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Lastly, it is permissible for the Panel to ignore the gTLD, in this case ".com", under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify the choice of the term “basf” in the disputed domain name. Further, there is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. In addition, the Complainant has not granted the Respondent any license or authorization to use the Complainant’s BASF mark or register the disputed domain name.

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel notes that the Complainant’s BASF mark had been registered well before the registration of the disputed domain name. Through use and advertising, the Complainant’s BASF mark is known throughout the world. Search results using the term “basf” on the Internet direct Internet users to the Complainant and its business, which indicates that an exclusive connection between the BASF mark and the Complainant has been established. As such, the Respondent either knew or should have known of the Complainant’s BASF mark when registering the disputed domain name or has exercised “the kind of willful blindness that numerous panels have held support a finding of bad faith”. See *eBay Inc. v. Renbu Bai*, WIPO Case No. [D2014-1693](#); *Barclays Bank PLC v. Andrew Barnes*, WIPO Case No. [D2011-0874](#).

Section 3.1.4 of the [WIPO Overview 3.0](#) states that the “mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trade mark by an unaffiliated entity can by itself create a presumption of bad faith”. In this case, the disputed domain name incorporates the Complainant’s widely known BASF mark, thus creating a presumption of bad faith.

Panels have found that the non-use of a domain name including a “This site can’t be reached” page would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available

record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trade mark, the composition of the disputed domain name, and the Respondent's use of incomplete or false contact details when registering the disputed domain name (the Written Notice was not delivered by the courier service due to false contact details), and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <basfsms.com> be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: December 5, 2023