

## **ADMINISTRATIVE PANEL DECISION**

### **BASF SE v. MegaTron Shipping Express, MegaTron Shipping Express Case No. D2023-3491**

#### **1. The Parties**

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

The Respondent is MegaTron Shipping Express, MegaTron Shipping Express, United States of America.

#### **2. The Domain Name and Registrar**

The disputed domain name <basf-chemicals.com> is registered with HOSTINGER operations, UAB (the "Registrar").

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 17, 2023. On August 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 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 (Undisclosed Respondent/Unknown Respondent) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 21, 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 on August 24, 2023.

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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 19, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on October 3, 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 one of the largest chemical companies in the world.

The Complainant is the owner of numerous trademark registrations for BASF, such as the International Registration n° 638794, registered on May 3, 1995.

The Respondent registered the disputed domain name on March 17, 2023.

The Panel accessed the disputed domain name on October 7, 2023, and it was not linked to any active website.<sup>1</sup> The Complainant submitted evidence that the disputed domain name was recently pointing to a website reproducing the BASF brand and purportedly offering chemical products for sale.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant makes the following contentions:

- the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. BASF is a famous trademark. The BASF trademark is reproduced identically within the disputed domain name, in highly visible and recognizable position. The BASF trademark is associated with the term "chemicals" in the disputed domain name, which undoubtedly relates to the Complainant's core business. Therefore, the addition of this term to the BASF trademark not only does nothing to diminish the risk of confusion, but rather increases the risk of confusion on the part of Internet users of average attention. The use of lower-case letter format is not significant in determining whether the domain name is identical or confusingly similar to the mark. For the purposes of assessing identity and confusing similarity, it is typically permissible for the Panel to ignore the generic Top-Level Domain ("gTLD").
- the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent in this administrative proceeding is unknown at the time of the original filing of the Complaint. Further to the Center's Notice of Registrant Information, the Respondent was identified as "MegaTron Shipping Express". The Respondent is not commonly known, as an individual or organization, by the disputed domain name. The Respondent has acquired no trademark or service mark related to the BASF term. The Respondent reproduces the Complainant's trademark without any license or authorization from the Complainant. The Respondent's use of the disputed domain name or preparation to use the domain name demonstrates no intent to use it in connection with a *bona fide* offering of goods or services at the time of original filing of the Complaint. On the contrary, the disputed domain name resolves to an active website impersonating the Complainant and offering chemical products for sale. The Respondent has never been granted authorization, license or any right whatsoever to use the Complainant's BASF trademarks. Moreover, the Respondent is not

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<sup>1</sup> Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8, "[n]oting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name [...]".

commercially linked to the Complainant. Since the adoption and extensive use by the Complainant of the trademark BASF predates the registration date of the disputed domain name, the burden is on the Respondent to establish the rights or legitimate interests the Respondent may have or have had in the disputed domain name. None of the circumstances which set out how a respondent can prove its rights or legitimate interests, are present in this case.

- the disputed domain name was registered and is being used in bad faith. The BASF trademarks are so widely known that it is inconceivable that the Respondent ignored the Complainant's earlier rights in the term BASF. The Respondent had obviously the Complainant's name and trademark in mind when registering the disputed domain name. The Complainant sees no possible way whatsoever that the Respondent would use the disputed domain name in connection with a *bona fide* offering of products or services. The sole detention of the disputed domain name by the Respondent, in an attempt to prevent the Complainant from reflecting its trademark and company name in a domain name, is strong evidence of bad faith. Indeed, the Complainant's trademark is arbitrary and has no common or general meaning in any language, and the disputed domain name is not generic or descriptive. It is very likely that the Respondent chose the disputed domain name because of its identity with or similarity to a trademark in which the Complainant has rights and legitimate interests. The Complainant's BASF trademark registrations significantly predate the registration date of the disputed domain name. Knowledge of the Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain name, proves bad faith registration. The current use of the disputed domain name in connection with a website impersonating the Complainant and creating confusion in the mind of average Internet users cannot be seen as an element of good faith on the part of the Respondent.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel has no doubt that BASF is a coined term directly connected with the Complainant's trademarks.

Annexes 4 and 5 to the Complaint show trademark registrations belonging to the Complainant for BASF that date as early as in 1995.

The trademark BASF is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark BASF merely by the addition of the suffix "-chemicals", as well as of the gTLD extension ".com".

Previous UDRP decisions have found that the mere addition of symbols (such as an hyphen) and of other terms (such as "chemicals") to a trademark in a domain name does not avoid a finding of confusing similarity (see, e.g., *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#); and *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#)).

It is also already well established that the addition of a gTLD extension such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent’s default and on the *prima facie* case established by the Complainant, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name. The Respondent has not indicated any reason to justify why it has chosen the specific term “basf-chemicals” to compose the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is currently not linked to any active website and previously resolved to a website reproducing the Complainant’s brand and purportedly offering chemical products for sale. While the nature of the goods and the availability of said goods are unknown, the Panel notes that the nature of the disputed domain name, its false suggestion of affiliation to the Complainant, and the lack of a prominent and accurate disclaimer on the website at the disputed domain name demonstrate that the Respondent has no rights or legitimate interests in the confusingly similar disputed domain name. [WIPO Overview 3.0](#)”, sections 2.5.1 and 2.8.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent in 2023, the trademark BASF was already well known worldwide and directly connected to the Complainant's chemical products.

According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The disputed domain name was recently used to allegedly sell chemicals under the BASF brand. The Panel finds that Basf is a coined term, with no dictionary meaning. Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's famous trademark, as well as that the adoption of the additional term "chemicals" together with the gTLD extension ".com" could be a mere coincidence. In this Panel's opinion, the addition of the term "chemicals" even enhances the risk of confusion in the present case, as this refers to the main category of products marketed by the Complainant.

From the Panel's search, the disputed domain name does not currently resolve to any active website. However, UDRP panels have frequently found that the apparent lack of so-called active use of the domain name (passive holding) does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

The non-collaborative posture of the Respondent, *i.e.*, (a) not presently using the disputed domain name, (b) not indicating any intention to use it again, and (c) not at least providing justifications for the use of a famous third party trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion, together with (d) the lack of any plausible justification for the adoption of the term "basf-chemicals" by the Respondent, (e) the evidence provided by the Complainant regarding the previous use of the disputed domain name, and (f) the subsequent change in use of the disputed domain name, are enough in this Panel's view to characterize bad faith registration and use of the disputed domain name in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <basf-chemicals.com> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: October 18, 2023