

**IN THE MATTER OF THE ARBITRATION OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA) DOMAIN NAME
DISPUTE RESOLUTION POLICY (CDRP)**

Domain in Dispute: <basfproducts.ca>

Complainant: BASF SE

Registrant: Jean-Yves Collin

Registrar: Go Daddy Domains Canada, Inc.

Panel: Douglas M. Isenberg, Esq.

Provider: British Columbia International Commercial Arbitration Centre

BCICAC File: DCA-1999-CIRA

DECISION

1. The Parties

The Complainant is BASF SE of Vancouver, British Columbia, Canada (“Complainant”), represented by IP Twins SAS of Paris, France.

According to the Complaint, the Registrant is Jean-Yves Collin of Quebec, Canada (“Registrant”).

2. The Domain Name and Registrar

The disputed domain name is <basfproducts.ca> (the “Disputed Domain Name”), which was created on November 10, 2017. The registrar is Go Daddy Domains Canada, Inc. (“Registrar”).

3. Governing Policy and Rules

This is a proceeding filed with the British Columbia International Commercial Arbitration Centre (“BCICAC”) under the CIRA Domain Name Dispute Resolution Policy, Version 1.3 (August 22, 2011) (“CDRP”) and the CIRA Domain Name Dispute Resolution Rules, Version 1.5 (July 28, 2014) (“Rules”). Paragraph 1.8 of the Policy states: “The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding.” Paragraph 1.2 of the Rules states: “The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding.”

4. Procedural History

The history of this proceeding, according to the information provided by BCICAC, is as follows:

- a. Complainant filed a Complaint with respect to the Disputed Domain Name in accordance with the CDRP on July 16, 2018.

- b. BCICAC reviewed the Complaint and found it to be compliant. By letter and email dated July 16, 2018, BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant.
- c. The Complaint with the attachments was filed exclusively online; therefore, BCICAC delivered the Complaint to the Registrant only by email.
- d. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
- e. The Centre hereby appointed Douglas M. Isenberg, Esq., as sole arbitrator in the above-referenced matter on August 15, 2018.
- f. The Complaint was filed in English, which shall be the language of the proceeding.
- g. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel's decision is to be delivered to BCICAC by September 4, 2018.

The Panel finds that it was properly constituted and appointed in accordance with the CDRP and the Resolution Rules. Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding have been met.

5. Canadian Presence Requirement

Paragraph 1.4 of the CDRP states: "The person initiating a Proceeding (the 'Complainant') must, at the time of submitting a complaint (the 'Complaint'), satisfy the Canadian Presence Requirements for Registrants (the 'CPR') in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark." Paragraph 2 of the CPR sets forth a list of individuals and entities that may "hold and maintain the registration of, a .ca domain name," which list includes "the owner of a trade-mark which is the subject of a registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13 as amended from time to time." The Complainant states, and provides evidence to support, that the Complaint relates to the trademark BASF, which is protected by the following Canadian trademark registrations: No. TMA439824 (registered February 24, 1995) and No. TMA250942 (registered October 2, 1980) (the "BASF Trademark"). As a result, the Panel is satisfied that the Complainant meets the CPR and is eligible to initiate this proceeding.

6. Factual Background and Parties' Contentions

Complainant states that it is “the largest chemical company in the world and is listed on the Frankfurt Stock Exchange, London Stock Exchange, and Zurich Stock Exchange.” Complainant further states that BASF Group, which is a wholly owned subsidiary of Complainant, “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.”

As noted above, Complainant states, and provides evidence to support, that it is the owner of the BASF Trademark, which it says is protected by more than 1,500 registrations worldwide. Complaint states that the Disputed Domain Name “has not been used in any way whatsoever.”

Complainant contends that, as a result of the trademark registrations described above, Complainant has rights in the BASF Trademark and that “the disputed domain name is highly similar to the BASF trademark and likely to create confusion in the mind of the general public” because “the BASF term is reproduced identically within the disputed domain name, in attack position” and “is followed by the generic term ‘products’ which is likely to reinforce the likelihood of confusion in the mind of the average Internet user.”

Complainant contends that Registrant has no legitimate interest in the Disputed Domain Name because, *inter alia*, “Respondent has acquired no trademark or service mark related to the BASF term”; “Respondent reproduces the Complainant’s trademark without any license or authorization from the Complainant’s company”; “Respondent has not intended or made preparations to use the disputed domain name in connection with a bona fide offer of goods or services”; and “since the adoption and extensive use by the Complainant of the trademark BASF predates the first entry of the disputed domain name, the burden is on the Respondent to establish the Respondent’s rights or legitimate interests the Respondent may have or have had in the domain name.”

Complainant contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith because, *inter alia*, “the BASF trademarks are so widely well-known... that it is inconceivable that the Respondent ignored the Complainant’s earlier rights on the term BASF”; “Respondent’s choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant’s trademark”; “any use of the BASF trademark would amount to trademark infringement and damage to the repute of the trademark”; Respondent did not respond to a cease-and-desist notice sent by Complainant; and Respondent is the registrant of additional domain names that contain well-known trademarks, including <basfproduit.com>.

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant, BASF SE.

7. Discussion and Findings

To obtain a transfer of the Disputed Domain Name, Complainant must, as set forth in paragraph 4.1 of the CDRP, prove “on a balance of probabilities” that:

(a) the Registrant’s dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Rights and Confusingly Similar

With respect to paragraph 3.1(a) of the CDRP, it is obvious based on Complainant’s reference to its Canadian trademark registrations that Complainant had rights in the BASF Trademark prior to the date of registration of the Disputed Domain Name and continues to have such rights.

Paragraph 3.3 of the CDRP states: “In determining whether a domain name is ‘Confusingly Similar’ to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.” It is apparent that the Disputed Domain Name contains the BASF Trademark in its entirety. “[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.7.¹

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the CDRP.

No Legitimate Interest

With respect to paragraph 3.1(b) of the CDRP, regarding a lack of legitimate interests, the Panel is satisfied that the Complainant has established, on a balance of probabilities, that the Registrant does not have a legitimate interest in the Disputed Domain Name. By failing to submit a Response, the

¹ Although WIPO Overview 3.0 addresses the Uniform Domain Name Dispute Resolution Policy (“UDRP”), Paragraph 3.2(I) of the CIRA Domain Name Dispute Resolution Rules expressly allows references to “dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive.”

Registrant has not made any attempt to rebut Complainant's allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the CDRP, nor is there any evidence that demonstrates Registrant has a legitimate interest in the Disputed Domain Name. See, e.g., *Cointreau v. Netnic Corporation*, CIRA Case No. 00180 (“[t]here is no evidence from the ‘customer’ about its ‘interest’ in the Domain Name”); and *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 (“the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant”).

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the CDRP.

Bad Faith

The Panel evaluates whether the Complainant has established that Registrant has registered the Disputed Domain Name in bad faith, as defined by the CDRP. Pursuant to paragraph 3.5 of the CDRP, the following “shall be evidence that a Registrant has registered a domain name in bad faith”:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
- (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5(d), given the strength of the BASF Trademark, which has been used by Complainants for many years prior to Registrant's

registration of the Disputed Domain Name and which is protected by multiple trademark registrations, including in Canada. Under similar circumstances, panels have found bad faith given “the uniqueness of the name and its previous use over a long period by the Complainant.” *Caseware International Inc., c/o Mr Alan Charlton v. Mr John Lee*, CIRA Case No. 00057. See also, e.g., *The Terminix International Company Limited Partnership v. Eric Dagenais*, Resolution Canada Case No. 00327 (finding bad faith where complainant registered trademark 19 years prior to registrant’s registration of the disputed domain name and where the trademark is “a fanciful term that does not have any other meaning”); and *OSIM International Ltd. v. Yulian Hariyanto*, BCICAC Case No, DCA-1789-CIRA (finding bad faith where “the domain name was registered at a time by which the Complainant and its [trademark] brand had become entrenched internationally and had established an active and physical presence in Canada”).

Further, although the Disputed Domain Name is not being used in connection with an active website, the Panel finds that the so-called “passive holding doctrine” is applicable here. As described in section 3.3 of WIPO Overview 3.0:

Panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.

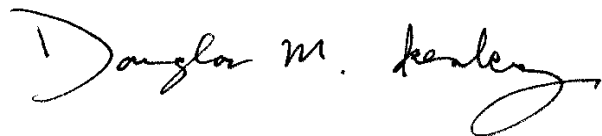
While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

Here, the Panel finds that the BASF Trademark is distinctive and has a strong reputation, based on the length of time for which the BASF Trademark has been used, the number of registrations by which it is protected, and the number of countries in which it is used; Registrant has not submitted a response in this proceeding; and it is implausible that the Disputed Domain Name could be put to any good faith use. Therefore, the Panel finds that the passive holding doctrine is applicable to this case.

In light of the above, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the CDRP.

8. Decision

For all the foregoing reasons, in accordance with paragraph 4.3 of the CDRP, the Panel orders that the Disputed Domain Name <basfproducts.ca> be transferred to Complainant, BASF SE.

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, looped initial 'D'.

Douglas M. Isenberg, Esq. (Sole Panelist)

Dated: August 31, 2018