



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0900197
 Case ID HK-0800230
 Disputed Domain Name www.walmartchina.mobi
 Case Administrator Dennis CAI
 Submitted By Lyons Debrett G.
 Participated Panelist

Date of Decision 13-02-2009

Language Version : English

The Parties Information

Claimant (1) Wal-Mart Stores, Inc. (2) Wal-Mart China Co. Ltd.
Respondent Terry Wong

Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the "Center") on November 17, 2008. On November 18, 2008, the Center transmitted by email to GoDaddy.com Inc. a request for registrar verification in connection with the domain name at issue. On November 19, 2008 GoDaddy.com Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Center's Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 5, 2008. In accordance with the Rules, the due date for Response was December 29, 2008. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 30, 2008.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on February 11, 2009. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

Factual Background

For Claimant

1. The Complainant is a retailer and owner of department stores in the United States and many other countries including China. It does business under the trademark WAL-MART.
2. The Complainant has not licensed or otherwise permitted the Respondent to use the trademark or to register or use any domain name incorporating the trademark.
3. The Respondent registered the disputed domain name on November 2, 2006.
4. The disputed domain name is parked with the registrar, GoDaddy.com Inc.
5. The Complainant petitions the Panel to transfer the disputed domain name from the Respondent to Wal-Mart Stores, Inc.

For Respondent

(Refer to the previous section)

Parties' Contentions

Claimant

<https://www.adndrc.org/icann/icase.nsf/fa40f875614a7ea348256b10002b5cff/2ec4b9c4f385ca3e4...> 2/13/2009

The Complainant asserts rights in the trademark WAL-MART and states that the disputed domain name is confusingly similar to the trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant alleges that the Respondent registered and used the disputed domain name in bad faith.

The detail of the Complaint is included where necessary in Part 5 of this decision.

Respondent

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

Findings

Notwithstanding the fact that the Respondent did not offer a response to the Complaint, the Rules instruct the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

The Panel is entitled to accept reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory (See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true; see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) stating that "In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Identical / Confusingly Similar

The Complainant states that the first WAL-MART store was opened in the United States in 1962 and that since then the Complainant's business has grown enormously. The Complainant now operates over 6,800 stores and has more than 1.9 million employees spread over the US, Canada, China, Japan, Mexico, Argentina, Brazil, Germany, Puerto Rico, Costa Rica, Nicaragua, Guatemala, Honduras, El Salvador and the United Kingdom. The Complainant's global sales in the 2007-2008 US financial year exceeded US\$374 billion. The Complainant has been listed as the number one Fortune 500 company almost every year since 2002. Each week, more than 180 million customers visit the Complainant's stores.

The Complainant operates department stores in China under the trademark and its Chinese character equivalent. The first Chinese store opened in Shenzhen in 1996. The Complainant now employs over 83,000 people in China in its 99 Supercenters, 2 Neighbourhood Markets and 101 Trust-Mart Hypermarkets stores (located in the Chinese provinces of Shenzhen, Dongguan, Shantou, Foshan, Maoming, Kunming, Yuxi, Chengdu, Mianyang, Chongqing, Fuzhou, Xiamen, Zhangzhou, Jinjiang, Quanzhou, Dalian, Shenyang, Shantou, Harbin, Daqing, Qiqihar, Changchun, Shenyang, Changsha, Yueyang, Loudi, Jinhua, Jiaying, Quzhou, Ningbo, Beijing, Shanghai, Nanchang, Langfang, Jinan, Qingdao, Yantai, Weifang, Tianjin, Nanjing, Taiyuan, Datong, Wuxi, Wuhu, Guiyang, Wuhan, Xiangfan and Nanning).

The Complainant has registered numerous domain names and the Complainant's trademark has been registered in 95 countries or regions including the USA where the Respondent is located (for example, Federal Trademark Registration No. 1,322,750 from February 26, 1985) and China, the market towards which the domain name would presumably point (for example, Chinese Trademark Registration No. 837822 from June 22, 1994).

The Panel has no hesitation in finding that the Complainant has rights in the trademark acquired through both use and registration (see *State Farm Mut. Auto. Ins. Co. v. Malain*, FA 705262 (Nat. Arb. Forum June 19, 2006) finding that "Complainant's registrations with the United States Patent and Trademark Office of the trademark STATE FARM establishes its rights in the STATE FARM mark pursuant to Policy ¶ 4(a)(i)."; see also *Mothers Against Drunk Driving v. phix*, FA 174052 (Nat. Arb. Forum Sept. 25, 2003) finding that the complainant's registration of the MADD mark with the United States Patent and Trademark Office establishes the complainant's rights in the mark for purposes of Policy ¶ 4(a)(i)).

Applying the principles developed and now broadly accepted under the Policy, the Panel also finds the disputed domain name to be confusingly similar to the trademark. The disputed domain name wholly incorporates the Complainant's trademark. The omission of the hyphen from the trademark and the addition, in the domain name, of the country name and the gTLD are trivial and do nothing to defeat the Complainant's claim of confusing similarity (see *Diesel v. LMN a/k/a L. M. Nordell*, FA 804924 (Nat. Arb. Forum Nov. 7, 2006) finding <vindiesel.com> to be identical to complainant's mark because "simply eliminat[ing] the space between terms and add [ing] the generic top-level domain ("gTLD") '.com' ... [is] insufficient to differentiate the disputed domain name from complainant's VIN DIESEL mark under Policy ¶ 4(a)(i)"; see also *Wal-Mart Stores, Inc. v Tauer*, WIPO Case No. D2000-1076 affirming the same point; see also *Rollerblade, Inc. v. McCrady*, WIPO Case No. D2000-0429 finding that the top level of the domain name such as

".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar; see also Wal-Mart Stores, Inc. v MacLeod d/b/a For Sale, WIPO Case No. D2000-0662 holding confusing similarity when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other non-distinctive terms in the domain name).

The Panel finds that the Complainant has satisfied the first element of the Policy.

Rights and Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the domain name. Nevertheless, it is well settled that the Complainant need only make out a prima facie case, after which the onus shifts to the Respondent to demonstrate rights or legitimate interests (see Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2000 0624; Hanna Barbera Prods., Inc. v. Entm't Commentaries, NAF Case No. 741828; AOL LLC v. Gerberg, NAF Case No. 780200). Paragraph 4(c) of the Policy states that any of the following circumstances which if found by the Panel to be proved based on its evaluation of the evidence, demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 or service mark at issue.

The Complainant has established its trademark rights. There is no evidence that the Respondent has similar rights, registered or not. The WHOIS data does not support any argument that the Respondent might be commonly known by the domain name. The Complainant has stated there to be no relationship between the parties.

The Respondent is not using, nor has it made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services.

The Panel finds that the Complainant has succeeded in making a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the Respondent in failing to reply has not discharged the onus which fell to it as a result. The Panel finds that the Respondent has no rights or legitimate interests in the domain name and so the Complainant has established the second limb of the Policy.

Bad Faith

Paragraph 4(b) of the Policy sets out the circumstances which shall be evidence of the registration and use of a domain name in bad faith. The Complainant does not explicitly rely on the particular scenarios described in paragraph 4(b) but chose to argue that it can be reasonably inferred that the Respondent both registered and used the domain name in bad faith.

The Complainant's principal allegations are that given the enormity of the Complainant's reputation, it is inconceivable that the Respondent had no knowledge of the Complainant and its trademark in November 2006. The Panel is in full agreement with that proposition and, absent rights or legitimate interests, finds that the domain name was registered in bad faith.

The Complainant goes on to argue bad faith use of the domain name through so-called "passive holding" in accordance with the principles laid down in the case of Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003. The Panel notes that whilst the domain name is parked with the registrar, it is not linked to any website there which might be driving pay-per-click revenue. As such, the domain name is truly not in use. Nonetheless, the Telstra case and the countless decisions which have adopted its reasoning have found that paragraph 4(a)(iii) of the Policy and, in particular, the requirement for bad faith use, can still be satisfied in circumstances where the domain name is not in use and has never been used, the Complainant's trademark is well known, the Respondent lacks any rights in the name, and no plausible scenario can be foreseen in which the Respondent might come to use the domain name in good faith. Those factors are all present and, from the Complainant's perspective, satisfied here.

The Panel finds that the Complainant has shown that the Respondent both registered and used the disputed domain name in bad faith. Accordingly, the Panel finds that the Complainant has satisfied the third and final limb of the Policy.

Status

www.walmartchina.mobi Domain Name Transfer

Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain

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name "walmartchina.mobi" be transferred to Wal-Mart Stores, Inc.

Debrett G. Lyons
Sole Panelist

Date: February 13, 2009