



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1000301
Complainant:	Alibaba Group Holding Limited
Respondent:	Mr. Gao Shi Qiang

1. The Parties and Contested Domain Name

The Complainant is **Alibaba Group Holding Limited**, of Fourth Floor, One Capital Place, P.O. Box 847, George Town, Grand Cayman, Grand Cayman Islands, British West Indies.

The Respondent is **Mr. Gao Shi Qiang**, of No. 235 GuangyuanXi Road, Guangzhou, Guangdong, 510010, People's Republic Of China.

The domain name at issue is **<aliexpress.org>** registered by Respondent with eNom, Inc. of 15801 NE 24th St., Bellevue, WA 98008, USA.

2. Procedural History

On 6 July 2010, pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Rules for the Uniform Domain Name Dispute Resolution Policy ("the Rules") and the Asian Domain Name Dispute resolution centre Supplemental Rules ("the ADNDRC Supplemental Rules"), the Complainant submitted a complaint in the English language to the Hong Kong International Arbitration Centre (the "HKIAC"), an office of the Asian Domain Name Dispute Resolution Centre and elected this case to be dealt with by a one-person panel. On 9 July 2010, the HKIAC sent to the complainants by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language. On the same date the HKIAC sent the Registrar a request for verification. The Registrar confirmed that it was the registrar of the domain name at issue and that Respondent was the registrant of the domain name at issue. On 3 August 2010, HKIAC sent Respondent notification of the complaint, and the HKIAC received a timely response from Respondent.

On 13 August 2010 the HKIAC notified the parties that the Panel in this case had been selected, with Sandra J. Franklin acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 16 August 2010, the Complainant sent a request for permission to make an additional submission on the grounds that Respondent raised issues in his response which required

Complainant's counter-arguments. On 17 August 2010 the Panel granted permission to both parties to file additional information on the allegation that Complainant sells counterfeit goods, but not on the remainder of the arguments presented in the Response, as they were foreseeable and should have been addressed in the Complaint. The deadline for the additional submissions was close of business 23 August 2010. Complainant states that it did not receive the Order until 20 August 2010. Both parties asked for additional time and it was denied.

3. Factual background

Complainant is the owner of the "Alibaba" brand, which has been used to conduct various global online businesses since 1999. Complainant has its headquarters in the People's Republic of China (PRC) in Hangzhou and also operates 60 offices across the PRC, as well as in Hong Kong, Taiwan, Korea, Japan, Singapore, the USA, and Europe. Complainant widely uses the prefix "ALI" in several of its spin-off brands, such as Alimama, Ali-Institute, Alipay, and Ali-Soft. Complainant holds registered trademarks for ALIEXPRESS, including one filed in Hong Kong on 10 August 2009.

Respondent filed the <aliexpress.org> domain name on 16 August 2009. The domain name resolves to an advertising page with generic content and links to other websites, as well as a logo that looks similar to Complainant's ALIEXPRESS logo. Respondent has registered other domain names containing "aliexpress", but they do not resolve to active websites.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. Respondent's <aliexpress.org> domain name is confusingly similar to Complainant's ALIEXPRESS mark.
- ii. Respondent does not have any rights or legitimate interests in the <aliexpress.org > domain name.
- iii. Respondent registered and used the <aliexpress.org> domain name in bad faith.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. Complainant did not have rights in the ALIEXPRESS trademark at the time Respondent registered the <aliexpress.org> domain name.
- ii. Respondent intends to use the <aliexpress.org> domain name to express-ship products under the name "American Lighting in Express".
- iii. Respondent did not register or use the <aliexpress.org> domain name in bad faith because he did not know of Complainant's trademark ALIEXPRESS.

- C. Complainant did not file a timely additional submission. Respondent's filed a brief additional submission, which did not contain any evidence, as well as a late additional submission. The Panel did not consider either of the late additional submissions.

5. Discussion and Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

Complainant asserts rights in the ALIEXPRESS mark through its registrations of the mark, including the earliest filed in Hong Kong with an application dated 10 August 2009. The Panel finds this registration sufficiently establishes Complainant's rights in the mark pursuant to Policy ¶ 4(a)(i). *See Expedia, Inc. v. Tan*, FA 991075 (Nat. Arb. Forum June 29, 2007) ("As the [complainant's] mark is registered with the USPTO, [the] complainant has met the requirements of Policy ¶ 4(a)(i)."); *see also Metro. Life Ins. Co. v. Bonds*, FA 873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that a trademark registration adequately demonstrates a complainant's rights in a mark under Policy ¶ 4(a)(i)).

Complainant also asserts rights through, and provided evidence of, the wide use of its well-known international brand "Alibaba" since 1999, including marks such as Alimama, Ali-Institute, Alipay, and Ali-Soft. While the Panel does not accept this as evidence of secondary meaning in the mark ALIEXPRESS, the Panel considers it relevant to establish the likelihood of Respondent being aware of Complainant's international branding and the announcement of its new business under ALIEXPRESS, as well as its trademark application for ALIEXPRESS, prior to Respondent filing the <aliexpress.org> domain name. *See Zee TV USA, Inc. v. Siddiqi*, FA 721969 (Nat. Arb. Forum July 18, 2006) (finding that the complainant need not own a valid trademark registration for the ZEE CINEMA mark in order to demonstrate its rights in the mark under Policy ¶ 4(a)(i)); *see also Bibbero Sys., Inc. v. Tseu & Assoc.*, FA 94416 (Nat. Arb. Forum May 9, 2000) (finding, while the complainant had registered the BIBBERO SYSTEMS, INC. mark, it also had common law rights in the BIBBERO mark because it had developed brand name recognition with the word "bibbero").

The Panel finds that Complainant's rights in the ALIEXPRESS mark date from 10 August 2009 when Complainant filed its trademark application, which is prior to Respondent filing the <aliexpress.org> domain name. As stated in *Digital Vision, Ltd v. Advanced Chemill Systems*, [WIPO Case No. D2001-0827](#) and other cases, Paragraph 4(a) (i) of the Policy does not require that the trademark be *registered* prior to the domain name.

The Panel also notes that it is not necessary for the Complainant to have registered its mark specifically in the country where Respondent resides. *See The Royal Bank of Scot. Group plc & Nat. Westminster Bank plc v. Soloviov*, FA 787983 (Nat. Arb. Forum Nov. 3, 2006) (“Complainant’s trademark registrations for the NATWEST mark with the United Kingdom Patent Office . . . establish Complainant’s rights in the mark pursuant to Policy ¶4(a)(i).”); *see also Renaissance Hotel Holdings, Inc. v. Renaissance Cochin*, FA 932344 (Nat. Arb. Forum Apr. 23, 2007) (finding that it does not matter whether the complainant has registered its trademark in the country in which the respondent resides, only that it can establish rights in some jurisdiction).

Respondent’s <**aliexpress.org**> domain name is identical to Complainant’s ALIEXPRESS mark pursuant to Policy ¶ 4(a)(i). Respondent’s disputed domain name contains Complainant’s ALIEXPRESS mark and merely eliminates the space between the words and adds the generic top-level domain (“gTLD”) “.org.” The Panel finds that these changes do not distinguish the disputed domain name from Complainant’s mark. *See Hannover Ruckversicherungs-AG v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2001) (finding <hannoverre.com> to be identical to HANNOVER RE, “as spaces are impermissible in domain names and a generic top-level domain such as ‘.com’ or ‘.net’ is required in domain names”); *see also Trip Network Inc. v. Alviera*, FA 914943 (Nat. Arb. Forum Mar. 27, 2007) (concluding that the affixation of a gTLD to a domain name is irrelevant to a Policy ¶ 4(a)(i) analysis); *see also Diesel v. LMN*, 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)”). Therefore, pursuant to Policy ¶ 4(a)(i), the Panel finds that Respondent’s disputed domain name is identical to Complainant’s ALIEXPRESS mark.

The Panel finds that Policy ¶ 4(a)(i) has been satisfied.

B) Rights and Legitimate Interests

The Panel finds that Complainant has made a *prima facie* case in support of its allegations, and the burden shifts to Respondent to prove that it does have rights or legitimate interests pursuant to Policy ¶ 4(a)(ii). Complainant states that it announced its new brand ALIEXPRESS and filed for trademark protection as early as 10 August 2009. Respondent filed the <**aliexpress.org**> domain name on 16 August 2009. At that time, Complainant had been using its ALIBABA family of marks, including several with the prefix “ali”, for approximately 10 years. Respondent, however, provided no evidence of any previous business or name related to the disputed domain name. Certainly, the WHOIS information suggests no such thing. The Panel therefore finds that Respondent is not commonly known by the <**watchgrammy.com**> domain name under Policy ¶ 4(c)(ii). *See Coppertown Drive-Thru Sys., LLC v. Snowden*, FA 715089 (Nat. Arb. Forum July 17, 2006) (concluding that the respondent was not commonly known by the <coppertown.com> domain name where there was no evidence in the record, including the WHOIS information, suggesting that the respondent was commonly known by the disputed domain name).

Though Respondent claims to have plans for a website pertaining to “American Lighting in Express”, there is no evidence of conducting, or preparing to conduct, that business on the Internet. The website resolving from the <aliexpress.org> domain name does not mention “American Lighting in Express”.

Respondent’s <aliexpress.org> domain name resolves to an advertising page with generic content and links to other websites, some of which no doubt offer products and services in competition with Complainant’s products and services. The Panel assumes Respondent profits from the advertisement and promotion of these third-party goods and services. Therefore, the Panel finds Respondent’s use of a confusingly similar domain name to Respondent’s profit does not qualify as a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). *See Summit Group, LLC v. LSO, Ltd.*, FA 758981 (Nat. Arb. Forum Sept. 14, 2006) (finding that the respondent’s use of the complainant’s LIFESTYLE LOUNGE mark to redirect Internet users to respondent’s own website for commercial gain does not constitute either a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii)).

The Panel finds Complainant has satisfied Policy ¶ 4(a)(ii).

C) Bad Faith

The Respondent claims that he was not aware of Complainant’s trademark rights in ALIEXPRESS at the time he registered the <aliexpress.org> domain name. He also claims to be in the B2C Internet business and is therefore presumably savvy in that field, conversant in searching trademark applications and aware of new eCommerce developments, particularly in Asia. Soon after Complainant announced its new brand ALIEXPRESS, launched its business under that mark, and applied for trademark registration for ALIEXPRESS, Respondent filed the disputed domain name. He uses the disputed domain name to post an advertising page with generic content and non-specific links. He does this with a logo that looks similar to Complainant’s in design and color scheme. All facts considered together, it is improbable that Respondent did not know of Complainant’s ALIEXPRESS mark when he registered the disputed domain name. The Panel therefore finds that Respondent had actual or constructive knowledge of Complainant’s rights in the ALIEXPRESS mark prior to registering the <aliexpress.org> domain name. *See Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration); *see also Pfizer, Inc. v. Suger*, D2002-0187 (WIPO Apr. 24, 2002) (finding that because the link between the complainant’s mark and the content advertised on the respondent’s website was obvious, the respondent “must have known about the Complainant’s mark when it registered the subject domain name”).

Respondent uses a confusingly similar disputed domain name, along with a confusingly similar logo, to redirect Internet users seeking Complainant’s website to a Respondent’s website, which disrupts Complainant’s business. The Panel finds that this constitutes registration and use in bad faith pursuant to Policy ¶ 4(b)(iii).

See DatingDirect.com Ltd. v. Aston, FA 593977 (Nat. Arb. Forum Dec. 28, 2005) (“Respondent is appropriating Complainant’s mark to divert Complainant’s customers to Respondent’s competing business. The Panel finds this diversion is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iii).”); *see also Classic Metal Roofs, LLC v. Interlock Indus., Ltd.*, FA 724554 (Nat. Arb. Forum Aug. 1, 2006) (finding that the respondent registered and used the <classicmetalroofing.com> domain name in bad faith pursuant to Policy ¶ 4(b)(iii) by redirecting Internet users to the respondent’s competing website).

Respondent has attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant’s ALIEXPRESS mark and logo as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. Respondent no doubt profits from the products and services it advertises at <aliexpress.org>. The Panel finds that this is also evidence of registration and use in bad faith pursuant to Policy ¶ 4(b)(iv).

Furthermore, the Panel finds that Respondent offered to sell the domain name for a price that far exceeded his out-of-pocket costs, also evidence of bad faith registration and use under innumerable previous UDRP cases.

The Panel finds Complainant has satisfied Policy ¶ 4(a)(iii).

6. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**. Accordingly, it is Ordered that the <aliexpress.org> domain name be **TRANSFERRED** from Respondent to Complainant.

Sandra J. Franklin
Sole Panelist

Dated: August 30, 2010