

Asian Domain Name Dispute Resolution Centre
(Hong Kong Office)

Administrative Panel Decision
Case No. HK-1100394

1. Parties and Contested Domain Names

Complainants: **Alibaba Group Holding Limited (“Complainant”)**

Respondent: **Web Solution Provider (Pvt) Limited (“Respondent”)**

Domain Names:

1. **alibabac1one.net**
2. **alibabac1onescript.com**
3. **alibabadiamondscript.com**
4. **alibabaplatinumscrip1.com**
5. **clonealibaba.com**

Registrar: **Directi Internet Solutions Pvt. Ltd d/b/a
PUBLICDOMAINREGISTRY.COM**

2. Procedural Matters

Complainant filed a Complaint, dated 22 September, 2011, with the Hong Kong office of Asian Domain name Dispute Resolution Centre (“ADNDRC”), through its counsel, Hogan Lovells of Hong Kong. The Complaint was advised to Respondent, who filed his Response dated 25 October, 2011. Both Complainant and Respondent indicated their preference for a single panelist to decide the

matter. ADNDRC then appointed this panelist, Karen Mills, who confirmed her availability, freedom from conflict, and ability to act impartially and independently. The files were then forwarded to this panelist by ADNDRC.

Thereafter on 4 November 2011, the Complainant filed its request to submit a further submissions in reply to the response. This request was approved by the Panelist and the Complainant submitted its Further Reply on 17 November 2011. The Respondent submitted its Response to Complainant's Further Reply on 25 November 2011.

On 28 November 2011, the Complainant made a further submission of a newly-rendered ADNDRC award in a case between the same parties, referring to different domain names, including, *inter alia*: <alibabacome.com> and <alibabascript.com>, requesting that such award also be considered by this Panelist.

Both parties have confirmed that no legal proceedings have been commenced by the parties in conjunction with or relating to the domain name which is the subject of this dispute.

3. Factual Background

a. The Complainant

- i. The brand "Alibaba" was established in China in 1999, by the Alibaba Group (The Complainant is a company within the group). Alibaba.com Limited, one of its subsidiaries, was listed on the Hong Kong Stock Exchange in November 2007.
- ii. The Complainant runs three major websites of online business-to-business marketplaces, being www.alibaba.com, www.alibaba.com.cn, www.alibaba.co.jp, in addition to several other smaller websites.

- iii. The Complainant has registered trademarks comprising of or incorporating "ALIBABA" and "ALIBABA.COM" in several jurisdictions, including China, the United States, the European Union, Hong Kong and has registered two trademarks in the Respondent's place of domicile, Pakistan.
- iv. The Complainant sent a letter of complaint to the Respondent, on 3 August 2011 after discovering that Respondent's websites contained similarities with its own.

b. The Respondent

- i. The Respondent is domiciled in Pakistan. It was founded in 2004. It introduced itself as a hybrid between web designing and a computer consulting company.
- ii. The Respondent registered the domain name *AlibabaScript* in January 2007 and *alibabacode.net* on 16th August 2007. The purpose was to provide B2B (business to business) website designing services for the information technology sector, and it deems itself a well known company since 2007.
- iii. Besides the Disputed Domain Names, the Respondent has also registered and uses several other websites for trading scripts, including: *b2btradingscripts.com*, *userinn.com*, *myliveb2b.net*, *b2bspecial.com*, *fwta.net* and *b2bscripts.com*.
- iv. The Respondent, in 15 August 2011, has filed an application to the Pakistani Intellectual Property Organization, to register trademarks over the names "Alibaba Script" and "Alibabascript.com".
- v. After receiving the letter of complaint from the Complainant, the Respondent made an offer to the Complainant's counsel to change its logo, which Respondent believed was the source of dispute. The Complainant's

counsel replied that such offer would be considered, but no further response has as yet been received by the Respondent.

4. Parties' Contentions

a. Complainant

The Complainant contends the following:

- i. *The disputed domain names are identical and/or confusingly similar to trade or service marks in which the Complainant has rights.* Complainant's "ALIBABA" and/or "Alibaba.com" trademark was entirely included in the domain names registered and used by the Respondent. The difference between Respondent's registered Disputed Domain Names and Complainant's trademarks is only the inclusion of several ordinary words, including, *inter alia*, "clone", "diamond", "platinum" and "script". This inclusion does not negate the confusing similarity of the Disputed Domain Names with Complainant's trade mark. Furthermore, domain extensions such as (.com) and (.net) should be disregarded.
- ii. *The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.* Complainant submits that: *First:* Complainant registered the "ALIBABA" trademark in 1998, and the Respondent registered the 5 Disputed Domain Names nine to twelve years later (2007-2010). Complainant contends that this shifts the burden of proof to the Respondent to establish its legitimate rights or interest in the Disputed Domain Names. *Second:* that Complainant's trademarks have acquired extensive meaning of Complainant's commercial use. The word "ALIBABA" would typically refer to Complainant's business. *Third:* the Respondent was never authorized or permitted by the Complainant to use the *Alibaba* Trademarks. *Fourth:* the Respondent is clearly aware to the fame of the Complainant and its use of the trademark and name Alibaba. It is obvious that the Respondent's business is providing services to create

websites which 'clone' the Alibaba.com website, and it constantly refers to the Complainant, its trademarks and website. *Lastly*, the Respondent is violating the Complainant's intellectual property rights by operating the cloned Alibaba.com website as a demonstration site.

- iii. *The disputed domain names have been registered and are being used by the Respondent in bad faith.* Registering the Disputed Domain Names without having legitimate rights or interest in them in itself indicates bad faith. Respondent's failure to seek permission from Complainant, despite being aware of the Complainant's prior rights and interest also indicates bad faith. Bad faith of the Respondent can also be seen from the use of the "Gold Supplier" logo taken from the Alibaba.com website and the use of the exact same tagline: "Global Trade Starts Here" in Respondent's "faribaba.com" logo, an imitation of the "Alibaba.com" logo. Furthermore the layout of the Disputed Domain Names' home pages are confusingly similar to those of Complainant's website homepage. The Complainant also argues that by using a privacy service to register the Disputed Domain Names, the Respondent was attempting to shield its identity, which in itself supports an inference of bad faith. Further indication of bad faith of the Respondent can be seen by its refusal to comply with the Complainant's letter of complaint. Lastly, the Complainant claims the Respondent intentionally confuses internet users and seeks to divert traffic from Complainant's to Respondent's websites, in order to gain profits. This would also constitute bad faith.

In its Further Reply, the Complainant submitted, beside the substantial issues, the following procedural issues:

1. The Complainant clarified that the Respondent referred to in this case is Web Solution Provider (Pvt) Limited, not PrivacyProtect.org as mentioned in the Complaint. It claims this confusion was due to the action of the registrar in not revealing the identity of the underlying registrant of the Disputed Domain Names. Web Solution

Provider (Pvt) Limited was proven as Respondent in this case after enlisting the company name in the Response.

2. The Complainant submitted that the Response does not comply with Article 13 of the ADNDRC Supplemental Rules in that the Response exceeds the limit of 3,000 words for written statements imposed by such rule and therefore requests the Panel to disregard the contents of the Response beyond the initial 3,000 words, claiming that it would otherwise be unfair for the Complainant.

b. Respondent

Challenging the Complaint, the Respondent submits the following:

- i. The inclusion of "alibaba" in the Disputed Domain Names of the Respondent does not constitute infringement of the Alibaba.com trademarks, since Complainant's trademark registration for classes 9 (covers computer softwares, electronic documents, global computer networks, and several other electronic-linked documents and informations) and 16 (covers printed papers, brochures, magazines and other types of printed materials) contain a disclaimer stipulating that the word "Ali" shall be used separately and apart from the mark as a whole, whereas the Respondent has applied for trademark registration in August 2011 to the Pakistani Intellectual Property Organization for the names "Alibaba", "Alibaba Script", "Alibaba Script.com" and "Alibaba Clone.com". Up to now, there is no indication whether these applications have been approved. Furthermore, Respondent's use of other domain names that were not mentioned by the Complainant, such as b2btradingscript.com, userinn.com, myliveb2b.net indicates the absence of the Respondent's bad intention to use the Complainant's trademark. As for the Disputed Domain Names, those were registered for demonstration purposes only. Therefore the Respondent claims that it has rights or legal interest to the Disputed Domain Names.

- ii. The Respondent contends that the nature of business of the Parties differ, seeing that the Claimant's business is operation of a trading marketplace website for importers and exporters, while the Respondent considers its business as a web designing company which develops B2B scripts for webmasters.
- iii. Respondent highlights differences between its and features and that of Complainant, contending that the resemblance among these does not indicate infringement by the Respondent. Moreover, the Respondent also highlights its good faith by pointing out the fact that the Respondent has already offered the Complainant's legal counsel to change the disputed logo, receiving no response.
- iv. The Respondent claims that the Complainant used "money power to beat the Respondent", and for which the Complainant committed a "reverse domain hijacking". The Respondent delivers this contention to show that the Complainant submitted inadequate and insufficient evidences to monopolize an Arabic expression, that is, "Alibaba".
- v. Lastly, the Respondent challenges the Complainant's view that its "Alibaba" trademark is widely recognized. The Respondent considers the name "alibaba" as a common trading name, that many persons use the name as a trading name, and are entitled to do so. Further to that, it also claimed that the Complainant has not proven adequate and sufficient evidences that it has the right to "monopolize" that particular name.

In the Response to Complainant's Further Reply, the Respondent disputes the procedural issues as follows:

- vi. The Respondent contends that by clarifying the identity of the Respondent in this present case, the Complainant was attempting to show that the

Respondent is not authorized to submit its Reply. Moreover, the Respondent pointed out that the purpose of privacy protecting its domain names was to protect the Respondent from scammers, spammers, harassers and data miners. These contentions of the Complainant, according to the Respondent, constitute bad faith.

- vii. The Respondent challenges Complainant's finding that the Respondent exceeds word limits as provided by the ADNDRC Supplemental Rules. It submits that the inclusion of those excessive words is legitimate, that it was necessary for the Respondent to deliver clear argumentations of the dispute to the Panelist, and therefore request the Panelist to accept the reply as it is. The Respondent stipulates that by applying such limitation the Panelist would commit unjustifiable conduct to the Respondent.

5. Findings

Procedural Findings:

With regards to Complainant's several procedural issues set out in the Further Reply, having carefully examined the Respondent's response to the particular matters, the Panelist concludes as follows:

- 1) This Panelist confirms that the Respondent in this case is Web Solution Provider (Pvt) Limited, as submitted by the Complainant. The previous inclusion of "PrivacyProtect.org" as Respondent in the Complaint was understood as a result of unclear information on the identity of the registrar of the Disputed Domain Names. Clearly the correct Respondent did receive notice and the documentation in this dispute as it submitted its Reply. Therefore the use of the incorrect name had no consequence and was therefore not relevant. As this is a procedural issue, the Panelist dismisses the additional claim by the Respondent that such clarification by the Complainant constitutes bad faith in respect of this proceeding.

2) This Panelist is aware that Respondent's Response exceeds the number of words allotted under the Rules. Overly verbose submissions can be vexatious to a panelist. However the panelists have no power to impose any kind of sanctions for such violation of the rules. In any case the decision made herein was not in any way influenced by the length of the submissions but was based upon the substance thereof, all of which has been considered. Therefore there is no necessity to truncate the submission of Respondent, but the Respondent is hereby reminded that should it make submissions for other cases in the future it would be well advised to comply with the limits imposed by the Rules, as its position could be prejudiced by failure so to do in other occasions.

Substantive Findings:

In determining the substantive matters of the dispute, the Panel is instructed, under Article 15 (a) of the Rules, to decide a complaint on the basis of the statements and documents submitted and in accordance with the Uniform Domain Name Resolution Policy (the "Policy"), the Rules and any rules and principles of law that it deems applicable.

Article 4 (a) of the Policy sets out the criteria upon which the findings of the Panel shall be based, which criteria must be established by the parties. In order to establish its rightful ownership of a domain name in dispute, a complainant must show that:

- (i) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights nor legitimate interests in respect of the domain name; and

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

Based upon the submissions by the parties and exhibits thereto, this Panel finds:

i. **Identical or Confusing Similarity:**

The Disputed Domain Names are: *alibabacclone.net*, *alibabacclonescript.com*, *alibabadiamondscript.com*, *alibabaplatinum-script.com* and *clonealibaba.com*. All of those 5 names include the word "Alibaba". The additions of suffixes such as "script", "clone" and "platinum/diamondscript" may give slight differences to the impression of the name for internet users, but most of these names would seem to indicate that they are related to, or intended as copies of, *Alibaba* itself. Clearly the registered trademark "alibaba" is consistently included in, and the focus of, the Disputed Domain Names.

The Respondent argues that the fame of the Alibaba Group through its trademark is not as distinguished as the Claimant believes, seeing that the IPO of the Complainant's company was done in 2007, subsequent to the registration of one of the Disputed Domain Names by the Respondent. However, this Panel does not deem that a persuasive or relevant argument, particularly where the Claimant's trademark, which had already been registered for some years, is known worldwide. The Claimant had registered its trademark in numerous countries, establishing its position as a significant B2B trading website. The Disputed Domain Names themselves, in particular where the term "clone" is included, would seem to indicate that they are intended to be copies of the primary trade name in which Complainant has rights. This Panelist therefore finds that the word "alibaba" included in the Disputed Domain Names are the same and/or confusingly similar to the Claimant's trademark.

ii. **Legitimate Interest:**

The Respondent registered the Disputed Domain Names starting in 2007, nearly a decade after the Complainant had registered its trademarks. Respondent runs a business in providing B2B website scripts. The Respondent claims its business, providing B2B website script, is a different type of business from that of Complainant. However, if one searches on the internet via Google search engine under keywords “*alibaba web design*” the first result listed is Complainant’s *Alibaba.com*. Thus it would appear that the scope of the Complainant’s business in linking importers and exporters also includes web design. The Complainant’s website also provides a search engine for customers seeking web design providers. Thus it would appear that the scope of business of the Parties is not entirely different.

The Respondent contends that “*Alibaba*”, the name used by the Complainant and which Complainant has registered as a trademark, is a common name used by lots of business entities around the world. However, even if true, that would not constitute any right or interest of Respondent in the name, particularly to use it for a similar type of business to that of Complainant’s.

The Panelist cannot see that the Respondent has established that it has any legitimate interest in respect to the Disputed Domain Names, whereas the Complainant has made at least a *prima facie* case to the contrary.

iii. **Bad Faith**

The Policy sets out some guidance for determination of the existence of bad faith. In particular, but without limitation, the following circumstances shall constitute evidence of bad faith:

- (a) circumstances indicating that registrant did so primarily for the purpose of selling, renting or otherwise transferring the domain name to the complainant who is the owner of the relevant trademark/service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name involved;
- (b) the registrant did so to prevent the owner of the relevant trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (c) the registrant did so for the purpose of disrupting the business of a competitor; or
- (d) by using the domain name in question, the registrant intentionally attempted to attract, for commercial gain, internet users to the registrant's website, by creating confusion with the complainant's mark as the source, sponsorship, affiliation, or endorsement of the registrant's website or of a product or service on the registrant's website.

Below are the examinations as to whether these elements are present in the present case,

- a. Respondent itself has alleged that it did seek to sell the domain name to Complainant.
- b&c There is no indication, nor has Complainant alleged, that Respondent either sought to prevent the owner of the relevant trademark or service mark from reflecting the mark in a corresponding domain name or that purpose of Respondent's registration was to disrupt the business of a competitor.
- d. However, Complainant has made a reasonable case that Respondent intentionally attempted to attract, for commercial gain, internet users

to the registrant's website, by creating confusion with the Complainant's mark as the source, sponsorship, affiliation, or endorsement of the registrant's website or of a product or service on the registrant's website. In fact, by using the word "*clone*" together with the word "*alibaba*" it would seem that Respondent intended to convey the idea that its website, and/or services being offering thereon, was intended as a "clone" of Complainant's site. "*Clone*" means an "exact duplicate", a "copy" or a "reproduction". According to the Oxford Dictionary, "clone" refers to a person or thing regarded as an exact copy of another or an act of "making an identical copy of". But using the term "clone" rather than "copy" or "imitation" would also give the impression that the creator of the "clone" has rights in the original being cloned. Considering the already established reputation of the Complainant's business under the mark *Alibaba*, logically the term "*clone*" would be intended to draw internet users who were familiar with "Alibaba.com" at least to enter the site, believing the site to be related to the original.

On its site, Respondent puts hyperlinks that lead internet users to sample websites that look "like" alibaba.com website, indicating that Respondent can create "clones" of Complainant's site for its customers, thereby taking advantage of the already established image of the Complainant's website or business to market its own business. Furthermore the similarity of layout, designs, features logo and tagline used by the Respondent in its websites to that of Complainant would certainly seem intended to confuse internet users that the site is connected to that of Complainant, and that Respondent can create a website for its customers similar to that of Complainant. Possibly, the impression might be given that Respondent even created Complainant's website itself.

The Respondent claims that it offered to change its logo to be less similar to that of Complainant. However the logo itself is less similar than the name. What Complainant wishes is for Respondent not to use

in its websites the term *Alibaba*, which has been registered as a trademark of Complainant. This Complainant did not offer to do.

By creating a website having a name similar to that of a large and well-known company, and getting involved in a certain scope of business of that particular company, Respondent would seem to be directly targeting the Complainant's business market. As Respondent has no legitimate interest in the name *Alibaba*, and seems to be using it only for the purpose of creating confusion in the minds of internet users, this Panel concludes that Respondent has registered and used the Disputed Domain names in bad faith.

6. Decision

In summary, this Panelist concludes that the Disputed Domain Names subject to this application, as registered by Respondent, are identical or confusingly similar to the trademarks and other intellectual property in which the Complainant has rights; the Respondent has no legitimate right nor interest therein; and the said domain names were registered and used by the Respondent in bad faith. Therefore this Panel hereby directs that the Disputed Domain Names be forthwith transferred to the Complainant.

Dated 9 December, 2011



Karen Mills

J.D. F.CI Arb, F.HKI Arb., F.SI Arb.

Chartered Arbitrator

KarimSyah Law Firm

Jakarta