



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-1200459
Complainant:	ALIBABA GROUP HOLDING LIMITED
Respondent :	WEI XIE

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, Cayman Islands, British West Indies.

The Respondent is wei xie, of Shanghai, Shanghai 210000, China.

The domain name at issue is englishtaobao.com, registered by Respondent with GODADDY.COM, LLC, of 14455 N. Hayden Rd., Ste. 226, Scottsdale, AZ 85260.

2. Procedural History

A complaint in this matter was filed with the Asian Domain name Dispute Resolution Centre (Hong Kong Office) (the "**ADNDRC**") on 10 September 2012 (the "**Complaint**"). The ADNDRC notified the registrar of the Disputed Domain Name of the proceedings by email on 12 September 2012. On 14 September 2012, the registrar notified the ADNDRC that the proper respondent to the dispute is the Respondent.

The ADNDRC sent a notification of commencement of proceedings and the Complaint along with its exhibits to the Respondent by email on 20 September 2012 to two separate email addresses.

No response by the Respondent was submitted on or before the prescribed deadline of 10 October 2012. The ADNDRC informed the Respondent of the same by email on 16 October 2012.

On 30 October 2012, the ADNDRC informed the parties by email that the Sole Panelist had been appointed to the Panel.

3. Factual Background

3.1 For Complainant

The Complainant was founded in 1999. The Complainant operates its business through a group of companies that have built a strong reputation for its Chinese language business-to-consumer and consumer-to-consumer Internet retail platform (the "**Taobao Websites**"), known

by "Taobao", "taobao.com", "淘宝" and "淘宝网", amongst others (the "**Taobao Brand**"). The Taobao Brand was first used in May 2003, and its related trade marks such as "TAOBAO", "TAO", "taobao.com", "淘宝" and "淘宝网" (the "**Taobao Trade Marks**") were first registered at the same time.

Over the past 9 years the Taobao Websites under the Taobao Brand have grown to become one of China's largest online retail platforms. The Complainant also owns and operates other websites relating to, amongst others, classified listing, online payment, cloud computing and advertising. The Complainant asserts that the Taobao Brand has acquired international recognition.

The Taobao Trade Marks have been registered worldwide, including jurisdictions such as mainland China, Hong Kong, Malaysia, Taiwan, Singapore, European Union, Germany, Japan, Macau and Korea, amongst others.

3.2 Respondent

The Respondent registered the Disputed Domain Name on 22 December 2010. The Complainant's legal representatives discovered the Disputed Domain Name website (the "**Website**") and sent a cease and desist email to the Respondent on 25 August 2012. The Respondent replied on 27 August 2012 with an offer to sell the Disputed Domain Name to the Complainant for US\$6,000. There has been no further correspondence between the parties regarding this.

4. Parties' Contentions

A Complainant

The Complainant's contentions may be summarized as follows:

- i) The Disputed Domain Name "englishtaobao.com" contains a mark which is identical to the Complainant's "TAOBAO" trade mark.
- ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name on the grounds that the Respondent: (a) has never been authorised to sell products or to operate an online retail platform under the Taobao Brand; (b) has neither acquired trade mark nor service mark rights in the Disputed Domain Name; (c) has not made a legitimate non-commercial or fair use of the Disputed Domain Name; and (d) has no connection or affiliation with the Complainant and has received no licence or consent, express or implied from the Complainant to use the "TAOBAO" trade mark or any of the other Taobao Trade Marks.
- iii) The Respondent has used the Disputed Domain Name in bad faith in order to: (a) lead the public into the mistaken belief that the Website is an official website of the Complainant; and (b) intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Taobao Brand.

B Respondent

The Respondent did not file a response.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy (the "**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

The Complainant contends that the Disputed Domain Name contains a word which is identical to the Complainant's "TAOBAO" trade mark. The Panel agrees with the Complainant on its contention as the Disputed Domain Name wholly incorporates the "TAOBAO" trade mark, the only difference being the inclusion of the word "english" as a prefix. However, it is well established that such an inclusion does not in any way diminish or eliminate the confusion between a disputed domain name and a trade mark (*The Coca-Cola Company v. Whois Privacy Service*, WIPO Case No. D2010-0088). Thus, the Panel finds the Complainant has satisfied the condition under Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Paragraph 4(c) of the Policy sets out the way in which the Respondent can prove it had rights or legitimate interests in the Disputed Domain Name, including:

- Before any notice to the respondent of the dispute, the respondent's 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
- The respondent has been commonly known by the domain name, even if the respondent acquired no trademark or service mark rights; or
- The respondent is making a legitimate non-commercial 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.

As discussed above, a number of the Taobao Trademarks have been registered by the Complainant since May 2003, including the "TAOBAO" trade mark, in multiple jurisdictions. The Respondent only registered the Disputed Domain Name on 22 December 2010. The Complainant therefore has prior rights to and extensive use of the Taobao Brand and "TAOBAO" trade mark which predate the Respondent's interest in and use of the same word "taobao" by 7 years. The burden of proof shifts to the respondent when the complainant's rights or interests predated those of the respondent's (*PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)* WIPO Case No. D2003-0696). The Panel therefore finds that the burden of proof shifts to the Respondent to show that it has a legitimate interest or right in the Disputed Domain Name. The Respondent has not filed a response and has therefore not adduced any evidence to support such a legitimate interest or right.

The Respondent has filed no evidence to show that it is commonly known by the Disputed Domain Name. Indeed, to the contrary, the Complainant has shown that the words "taobao" in the Disputed Domain Name are identical to the Complainant's "TAOBAO" trade marks that hold a reputation of good standing.

The use of a disputed domain name to resolve to a website cannot be seen as bona fide where users of that website were likely to be confused as to whether or not it was affiliated with the complainant (*Microchip Technology, Inc. v. Milos Krejcik and EDI Corporation, d/b/a Aprilog.com*, WIPO Case No. D2001-0337). The Website, similar to the Taobao Websites, offers goods on an online trading platform. This is likely to confuse users of the Website as to its affiliation with the Complainant. The Panel accordingly finds that the use of the Disputed

Domain Name to resolve to such an online trading platform is not a bona fide offering of goods. Further, this shows that the Respondent used the Disputed Domain Name to misleadingly divert customers from the Complainant.

As the Website offers various items of clothing and accessories for sale, it cannot be said to have been used for non-commercial purposes without intention for profit

Further, there is no apparent relationship between the Respondent's name, wei xie, and the Disputed Domain Name. The wording "taobao" from the Disputed Domain Name of itself is not from the English language, it is a transliteration from the Chinese characters "淘宝". These characters translated literally mean "clean out" and "treasure" respectively, and also have meaning when used in such a combination, however they do not constitute a commonly used word or phrase. All of the above indicates that there was in fact no reason for the Respondent to have chosen the words in the Disputed Domain Name, except to trade off the Taobao Brand in bad faith and to misleadingly divert customers from the Taobao Websites.

After considering the evidence and given that no further response has been provided by the Respondent, the Panel finds the Respondent to be using the Disputed Domain Name illegitimately with the intent of commercial gain to mislead consumers and that therefore the Complainant has satisfied the condition under Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

In Paragraph 4(b) of the Policy, a number of circumstances are illustrated as evidence of registration and use of a domain name in bad faith. These are as follows:

- 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- the respondent has 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
- the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's web site 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 your web site or location or of a product or service on your web site or location.

The Respondent registered the Disputed Domain Name and used the Website in a way that misleads internet users. As discussed above, the Disputed Domain Name incorporates the Complainant's "TAOBAO" trade mark in its entirety, the only difference being the word "english" prefixed. The combination of the Chinese characters "淘宝" does not constitute a common word or phrase and the word "taobao" in English only has meaning if read as a transliteration of the equivalent Chinese characters. The Panel considers that such usage makes reference to the Taobao Trade Marks and in particular the "TAOBAO" trademark. Therefore, given that it is improbable the Respondent chose the Disputed Domain Name by coincidence, it appears that it intended to create a likelihood of confusion as to an affiliation between the Disputed Domain Name and the Complainant's "TAOBAO" trade mark.

Both the Taobao Websites and the Respondent's Website are online trading platforms. Not only does this increase the likelihood of confusion between them, but it shows that the Respondent is using the Website for commercial gain.

Furthermore, the Website uses the word "taobao" extensively, including:

- in the logo, with the word "English" on one line and "taobao.com" underneath it;
- in the contact email address of service@englishtaobao.com;
- in the title of the Website, being "TaoBao Agent, English Taobao, Taobao Outlet – Products Online from China Taobao";
- in a copyright notice stating copyright is owned by the Disputed Domain Name; and
- in a description of the website, which states at the end "*englishtaobao.com - a Europe version of the largest online store of China C2C store*". The Website describes itself as a particular version of a trading platform and given the evidence discussed above, the "*largest online store*" likely refers to the Taobao Websites.

The Panel therefore finds that the Respondent is using the Website for commercial gain by intentionally attracting Internet users by creating a likelihood of confusion between the Website and the Taobao Brand and Taobao Trade Marks.

Moreover, it is well established that a party's use of a domain name in full knowledge of another party's prior rights of the same constitutes bad faith (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polyneux Group Co.*, WIPO Case No. D2000-0163). As discussed above, the Taobao Brand is in good standing internationally. The Complainant has also owned and registered the Taobao Trade Marks for the past 9 years. The Respondent ought to have been aware of the Complainant's prior rights in the Taobao Brand and Taobao Trade Marks. Finally, the Respondent offered to sell the Website to the Complainant in response to the Complainant's email to cease and desist. The Respondent was therefore aware of the Taobao Brand and Taobao Trade Marks even as it continued to use the Disputed Domain Name.

In light of the discussion above, the Complainant has presented adequate evidence to demonstrate that the Respondent has registered and used the Disputed Domain Name in bad faith in accordance with paragraph 4(a)(iii) of the Policy.

6. Decision

In light of all the foregoing and in accordance with Paragraph 4(a) of the Policy, the Panel holds that the Disputed Domain Name "englishtaobao.com" contains a mark which is identical to the Complainant's "TAOBAO" trade mark; the Respondent has no right to or legitimate interest in the Disputed Domain Name; and the Disputed Domain Name was registered and used in bad faith by the Respondent.

Finally, the Panel decides that the domain name "englishtaobao.com" be transferred to the Complainant.



Peter Bullock
Sole Panelist

Dated: 30 November 2012