



Asian Domain Name Dispute Resolution Centre

beijing

## **ADMINISTRATIVE PANEL DECISION**

**Case No. CN-1801130**

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**Complainant: BEIJING JINGDONG 360 DU E-COMMERCE LTD.**

**Respondent: Hongchao Shang**

**Domain Name: jd-express.com**

**Registrar: Name.com, Inc.**

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### **1. Procedural History**

On 31 October 2017, the Complainant submitted a Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC Beijing Office) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules) approved by the ADNDRC.

On 6 November 2017, the ADNDRC Beijing Office sent to the Complainant by email an acknowledgement of the receipt of the Complaint and transmitted by email to ICANN and the Registrar, Name.com, Inc., a request for registrar verification in connection with the disputed domain name.

On 3 January 2018, the Registrar transmitted by email to the ADNDRC Beijing Office its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 5 January 2018, the ADNDRC Beijing Office notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced. On the same day, the ADNDRC Beijing Office transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the disputed domain name and the ADNDRC Beijing Office had sent the complaint and its attachments through email according to the Rules and the Supplemental Rules. On the same day, the ADNDRC Beijing Office notified ICANN and registrar, Name.com, Inc., of the commencement of

the proceedings.

On 25 January 2018 the Respondent requested to change the language to Chinese and prolong the limit to submit the response. On 27 January 2018 the ADNDRC Beijing Office transferred the Respondent's request to the Complainant. On 30 January 2018 the Complainant sent in its response. The ADNDRC Beijing Office transferred the Response to the Respondent and requested the Respondent to submit the Response on or before 5 February 2018.

The Respondent failed to submit a Response within the specified time period. The ADNDRC Beijing Office notified the Respondent's default. Since the Respondent did not mention the Panel selection in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC Beijing Office informed the Complainant and the Respondent that the ADNDRC Beijing Office would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. ZHAO Yun, the ADNDRC Beijing Office notified the parties that the Panel in this case had been selected, with Mr. ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Paragraph 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

On 15 March 2018, the Panel received the file from the ADNDRC Beijing Office and should render the Decision within 14 days, i.e., on or before 29 March 2018.

In this case, the Respondent requested to change the language to Chinese on account of the inability to understand the English language. It is noted that the Respondent chose to register the disputed domain name with a Registrar located in the United States, agreeing to the Registration Agreement in the English language. Moreover, the website of the disputed domain name contains the English language. The Complainant prepared the Complaint and relevant evidence in the English language; the use of Chinese language will no doubt add to the cost on the Complainant side and delay the whole proceeding.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

## **2. Factual Background**

### **A. The Complainant**

The Complainant in this case is BEIJING JINGDONG 360 DU E-COMMERCE LTD. The registered address is Room 222, Floor 2, Building C, No. 18, Kechuang 11 Street, Beijing Economic and Technological Development Zone, Beijing, P.R.China. The authorized representative in this case is Beijing Janlea Trademark Agency Co., Ltd.

## **B. The Respondent**

The Respondent in this case is Hongchao Shang. The registered address is Room 14, No. 31, Bao an Shenzhen China.

The Respondent is the current registrant of the disputed domain name “jd-express.com”, which was registered on 24 February 2016 according to the WHOIS information. The registrar of the disputed domain name is Name.com, Inc.

## **3. Parties’ Contentions**

### **A. The Complainant**

I. The disputed domain name is identical and confusingly similar to trademarks and service marks in which the Complainant has rights.

The Complainant’s prior registered trademark “京东”“JD”“JD EXPRESS” and “JD.COM” have accrued quite good publicity among relevant public before the filing date of the disputed domain name. The disputed domain name is confusingly similar to the Complainant’s prior registered trademarks “京东”, “JD”, “JD EXPRESS” and “JD.COM”, and is also similar to both domain name “JD.COM” and trade name “京东”, to which the Complainant holds prior rights.

1. The Complainant’s trademarks “京东” “JD”“JD EXPRESS” and “JD.COM” have accrued quite good publicity among relevant public before the filing date of the disputed domain name

#### 1) Introduction to the Complainant

The Complainant is the largest self-operated E-commerce company in China, selling 31,500,000 kinds of high quality goods across 13 categories, including computers, phones and other digital products, household appliance, auto parts, clothing and shoes, luxury goods, home and household products, cosmetics and other personal care products, food and nutrition, books and other media products, maternal & baby products and toys, sports and fitness equipment, and virtual goods, etc. In 2013, there were about 47,400,000 active users on “Joybuy”, the official JD.com global online shopping site operated by the Complainant, and about 323,300,000.00 orders were received and supplied.

In 2010, the Complainant became the first online retail enterprise of which its sales scale exceeded billions in China. On 30 January 2014, the Complainant officially

initiated IPO. On March 10, the Complainant had purchased Tencent QQ online shopping and C2C platform Paipai.com. On 2 April 2014, JD Group, the head office of the Complainant, was officially divided into two subsidiaries group, a subsidiary company and a business division, involving financial, paipai and foreign business, and the founder, Mr. Richard Liu, was confirmed to be CEO of JD Group.

In 2014, JD Group, the head office of the Complainant, was officially listed on the NASDAQ and become the third listed Internet Companies, preceded only by Tencent and Baidu. JD ranked the 79th in 2014 China Top 500 Enterprises issued by "Fortune" magazine in July 2014.

In October 2015, JD Group and Tencent Group jointly launched an entirely new strategic cooperation program in Beijing – JingTeng Program, jointly creating an innovative mode of business platform in the name of "Brand Business" based on each party's resources and products, which was the first attempt of this kind for the Chinese two large platforms.

In March 2016, JD Group released its 2015 Annual Performance Report, in which 2015 annual GMV had reached RMB 462.7 billion, increased by 78%; core GMV (excluding Paipai platform) RMB 446.5 billion, increased by 84%. The data published by Ministry of Commerce in February 12 had shown that the national online retail transaction volumes in 2015 increased by 33.3%, the growth rate of JD GMV had reached to 78%, surpassing twice times of the industry growth rate.

JD EXPRESS, as one of the business units of JD Group, is self-operated express service of Joybuy, and was granted license for express service in 2012. The advantages of JD EXPRESS include: engaging in e-commerce industry for nine years, having abundant experience in logistics and distribution; professional security monitoring system and cargo storage principle; high efficiency on picking up service within five hours; open express system platform convenient for sellers to monitor orders and check account; and a call center of 2000 customer service staffs providing consulting services for sellers anytime.

## 2) Honor certificates awarded to the Complainant and its affiliated companies

The Complainant's affiliated companies include Beijing Jingdong Century Trading Co.; Beijing Jingdong Shangke Information Technology Co.; Beijing Jingdong Century Information Technology Co.; Jiangsu Jingdong Information Technology Co.

## 3) Market operation scale of trademarks "京东" and "JD"

"京东" and "JD" have accrued high notability in the market through use by the Complainant and its affiliated companies, and it can be seen through the tax clearance certificate of each companies.

## 4) Position of "京东" and "JD" brand in the industry

The Complainant ranked 11<sup>th</sup> in the year of 2013, and 4<sup>th</sup> in the year of 2014 and 2015 according to the rank list issued by Internet Society of China.

#### 5) Information on advertising and publicity of Trademarks “京东” and “JD”

Since establishment of the company, the trademarks “京东” and “JD” have been advertised and publicized through various kind of commercial advertisements, and advertising expenditure has been gradually increased year by year.

“京东” and “JD” are not only the most important trademarks of the Complainant, but also the short name of the Complainant’s enterprises. As the Complainant has various business activities in different regions of the country, the Complainant and its associated companies have funded large amount of money in advertising and publicity, including outdoor advertisements like root advertisement, vehicle body advertisements, metro advertisements, light box advertisement, etc., covering metro, elevator, waiting room, etc. in Beijing, Nanjing, Wuhan, Shenzhen, Chengdu, Guangzhou, Shenyang, Hangzhou, Shanghai and etc.

#### 1. Protection of the trademarks “京东” and “JD” and related domain name

For years, the Complainant’s brand “京东” and “JD” has accrued great notability and good reputation and has become the target of imitation and counterfeit among illicit entities or persons, and as a result, the Complainant has made great efforts to protect its legal rights and benefits, effectively preventing the trademarks “京东” and “JD” from being imitated and reproduced in bad faith.

In the course of protection of its intellectual property, the Complainant filed a domain name dispute against other entities who registered domain names “京东.商城” and “京东商城.商城” before Asian Domain Name Dispute Resolution Centre (ADNDRC). The ADNDRC ascertained through comprehensive examination that “京东” and “京东商城” are prior registered trademarks of the Complainant, and that the two domain names constituted confusingly similarity to “京东” serial trademarks of the Complainant, and then determined that the two disputed domain names should be transferred to the Complainant. It can be seen from the aforesaid domain name dispute result that the Complainant’s “京东” serial trademarks have been given favorable protection. Likewise, in this case, we earnestly request the examiners in charge of this case to refer to the proceedings and results of the prescribed two domain names, and to determine that the disputed domain name is confusingly similar to the Complaint’s “京东” and “JD” serial trademarks and should be transferred to the Complainant.

To sum up, trademarks “京东” and “JD” have accrued high notability and influences in relevant public through extensive registration, long-term use, widely advertising and publicity. Seeing or hearing “京东” and “JD”, consumers will firstly and directly think of

the Complainant. Because of familiarity and habituation of one's perception, the trademarks “京东” and “JD” have been solely corresponding with the Complainant, and the relevance is also widely accepted by the consumers.

2. The disputed domain name is confusingly similar to the Complainant's prior registered trademarks “京东”, “JD”, “JD EXPRESS” and “JD.COM”, etc.

Firstly, “.com” in the disputed domain name is a suffix without any meaning. Consequently, the main distinctive part of the disputed domain name is “jd-express”, which totally contains the only or main letter combination “jd” of the “JD” series of trademarks to which the Complainant holds exclusive prior trademark rights in China. Between the disputed domain name and the series of trademarks, there is only slight difference in respect of uppercase or lowercase letters. Moreover, “jd” is the preceding part of the two parts. Therefore, the disputed domain name is confusingly similar to the Complainant's “JD” series of trademarks.

Secondly, the distinctive element “jd-express” of the disputed domain name is totally identical in respect of word composition, letters arrangement order, pronunciation and meaning with the Complainant's prior registered trademark “JD EXPRESS” in China, and the difference between the disputed domain name and this series of trademark are the dash mark “-”, the difference in respect of which is insufficient for relevant public to distinguish the disputed domain name with the Complainant's trademark.

Thirdly, the meaning of “express” in the distinctive element “jd-express” of the disputed domain name is “A rapid, efficient system for the delivery of goods and mail”, and the letter combination “jd” is the initial letters of the phonetic symbols of the Complainant's Chinese trademark “京东”. Consequently, the Chinese meaning of “jd-express” is “Jing Dong Express (京东快递)”, which is totally identical with the meaning of the Complainant's prior registered Chinese trademark “京东快递”, confusingly similar to the trademark.

Finally, the Complainant has registered not only “JD” “京东” “JD EXPRESS” and “京东快递” series of trademarks, but also several series of trademarks in the form of “JD+X” and “京东+X”, such as “JD Cloud” “JD Chat” “JD Finance” “JD Export” “JD Mobile” “JD FASHION” and “JD RUN”. Therefore, the disputed domain name “jd-express”, a combination of “jd” with the generic and interpretive word “express”, is of the same type as the Complainant's prior registered trademarks “JD Cloud” “JD Chat” “JD Finance” “JD Export” “JD Mobile” “JD FASHION” and “JD RUN”, likely misleading the consumers to assume that “jd-express” is: one of the complainant's “JD” series of marks, further causing confusion and misapprehension.

3. The disputed domain name is confusingly similar to the Complainant's prior registered domain name “JD.COM”

“JD.COM” is not only the registered trademark of the Complainant, but also a domain name used by the Complainant. The domain name “JD.COM” has been registered since 29 September 1929, far earlier than the filing date (24 February 2016) of the disputed domain name. Both the disputed domain name and “JD.COM” belong to “COM” gTLD domain names, and their primary distinctive element are “JD” while the word “EXPRESS” indicates the generic name in the industry of express delivery service provided by the Complainant. As a result, the disputed domain name likely misleads the consumers to assume that it is a domain name subordinate to the Complainant for service in express and delivery business. Therefore, the disputed domain name is confusingly similar to the Complainant’s prior registered domain name “JD.COM”.

4. The disputed domain name is confusingly similar to the Complainant’s prior registered and used trade name “京东”

As described above, “京东” is not only the registered trademark of the Complainant but also a registered and widely-used trade name of both the Complainant and its affiliated companies. As “jd” in the disputed domain name may refer to Chinese Characters “京东” of the Complainant, it causes the disputed domain name confusingly similar to the Complainant’s prior registered and used trade name “京东”.

To sum up, the Complainant obtained prior registered trademarks “京东”, “JD” and “JD EXPRESS” before the filing date of the disputed domain name, and have accrued higher notability among relevant public. The disputed domain name is confusingly similar to the Complainant’s prior registered trademarks “京东”, “JD”, “JD EXPRESS” and “JD. COM”. Meanwhile, it is similar to domain name “JD. COM” and trade name “京东” that the Complainant holds prior rights.

II. The Respondent does not hold any legitimate rights and benefits to the disputed domain name.

Firstly, the Complainant has never licensed the Respondent by any means to use the Complainant’s “jd” “JD EXPRESS” and “京东” series of trademarks or similar marks or logos. Nor is there any business relationship between the Complainant and the Respondent. Therefore, the Respondent does not have any trademark rights to the disputed domain name. Furthermore, all information about the Respondent—Domain Protection Services, Inc. like business name, address, etc. have nothing to do with “JD” and “jd express”. As a result, the Respondent does not hold any rights and benefits to the disputed domain name.

III. The disputed domain name has been registered and is used in bad faith.

It has been found through internet search that the website linked by the disputed domain name has a notice saying that “This domain name is for sale!” and “If you

would like to purchase this domain name, please click here to make an offer. Or contact us -->" in the homepage of the website. Obviously, the Respondent does not have bona fide intention to use this disputed domain name but wants to profit by selling it. The disputed domain name containing "jd" apparently and solely refers to JD Group and much likely confuses the relevant public. The Respondent registering the disputed domain name is obviously for the purpose of making illicit use of the good reputation and influence of the Complainant's brand "京东" and "JD" in the industry to attract potential consumers to its website and to obtain unfair interests by selling the disputed domain name. If the disputed domain name is purchased and used by other company or other person, it will absolutely mislead consumers to choose or purchase products from the website linked by the disputed domain name, finally damaging the legal rights and interests of the consumers.

The Complainant holds that the disputed domain name contains "jd", the main distinctive part of both the Complainant's trademarks and domain names, as its key component, and thus constitutes similarity to the Complainant's prior right; and that with the website linked by the disputed domain name used for sale of this domain name, at sight of the disputed domain name and its associated website, the relevant public are much likely to be confused and misguided and would assume that there are certain relations or connections between the disputed domain name and the Complainant, affecting detrimental effect on the Complainant's business. The circumstance of use of the disputed domain name satisfies requirement in paragraph (i), (ii) and (iv) for Evidence of Registration and Use in Bad Faith of the UDRP, therefore, the Respondent's bad faith can be definitely ascertained.

The aforesaid facts sufficiently proves that the disputed domain name of this case satisfies with the circumstance prescribed by paragraph 4(b)(i), 4(b)(ii) and 4(b)(iv), namely, the disputed domain name is mainly used for selling, renting or otherwise transferring the domain name registration, likely to the Complainant or a competitor; for preventing the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name; and for attempting to attract, for commercial gain, Internet users to its 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 Respondent's website or location or of a product or service on its website or location.

To sum up, the Complainant holds that the above statements satisfy three of the four requirements as set forth in paragraph 4(a) of the Policy. According to paragraph 4 and paragraph 15 of the Policy, the Complainant's claim should be supported.

The Complainant requests that the disputed domain name be transferred to the Complainant.

## **B. The Respondent**

The Respondent failed to submit a Response within the specified time limit.

## **4. Discussions and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, the Complainant shall prove the following three elements:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The registrant has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) 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 documented out-of-pocket costs directly related to the domain name; or
- (ii) The respondent 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
- (iii) The respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

## **A. Identity or Confusing Similarity**

The Complainant is a self-operated E-commerce company established in China. Having reviewed the Complainant's trademark registration certificate, the Panel finds that the word "JD" has been registered as a trademark in China on 14 January 2012. This trademark is still within the protection period. The Panel has no problem in finding that the Complainant enjoys the trademark right over "JD". It is also noted that the Complainant has also registered "JD Express" as a trademark.

The disputed domain name “jd-express.com” ends with “.com”, this suffix only indicates that the domain name is registered under this gTLD and “.com” is not distinctive. Thus, we will only need to examine the main part of the disputed domain name.

The main part (“jd-express”) of the disputed domain name consists of two sub-parts, “jd” and “express”, linked by a hyphen. Obviously, the first sub-part (“jd”) is identical to the Complainant’s trademark “JD”. The second sub-part (“express”), as argued by the Complainant, is a generic word and thus is not distinctive. The addition of a generic word “express” to the Complainant’s trademark “JD” does not differentiate the main part of the disputed domain name from the Complainant’s trademark. Therefore, the disputed domain name is confusingly similar to the Complainant’s trademark “JD”.

When compared with the trademark “JD Express”, the main part of the disputed domain name differs only in the hyphen linking “JD” and “Express”. The existence of the hyphen cannot differentiate the main part of the disputed domain name from the Complainant’s trademark. Therefore, the disputed domain name is confusingly similar to the Complainant’s trademark “JD Express”.

Accordingly, the Panel holds that the Complaint fulfills the condition provided in Paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests of the Respondent**

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademark or the domain name. The Complainant’s assertion is sufficient to establish a *prima facie* case under Policy 4(a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. No evidence has shown that the Respondent is using or plans to use the domain name for a *bona fide* offering of goods or services. The Respondent is not commonly known by the domain name. The evidence submitted by the Complainant further shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or legitimate interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

### **C. Bad Faith**

The Complainant is a leading E-commerce company in China, selling wide range of products, including computers, phones, auto parts, clothing and shoes, luxury products, household products, cosmetic and personal care products, food and

nutrition, books and media products, toys. The evidence shows that the Complainant became the first online retail enterprise in 2010. In 2014, JD Group, the head office of the Complainant, was officially listed on the NASDAQ and became the third listed Internet company.

The Complainant and its affiliated companies have won many honors over the years, which can be exemplified by the long list of prizes and awards from 2006 to 2015. The Complainant ranked 4<sup>th</sup> in the year of 2014 and 2015 according to the rank list issued by Internet Society of China. Through the years, the Complainant has established extensive business networks in China. The evidence submitted by the Complainant sufficiently established its fame in relevant market.

The evidence further shows that the Complainant registered the trademark “JD” in China in 2012 and that the trademark is still within the protection period. This registration date is earlier than the registration date of the disputed domain name. It is also noted that the Complainant has also registered the trademark “JD Express” in China. The registration date is 7 October 2016, slightly after the registration of the disputed domain name. However, the filing date of the trademark “JD Express” was 18 August 2015, which was earlier than the registration date of the disputed domain name. The Complainant has been using the trademark “JD Express” even before the registration of this trademark. The panels will not normally find bad faith for domain names registered before the registration of the trademark. However, there are exceptions when the facts of the case establish that the Respondent’s intent in registering the domain name was to unfairly capitalize on the Complainant’s nascent trademark rights; one scenario being the registration of a domain name following the Complainant’s filing of a trademark application. (WIPO Jurisprudential Overview 3.0, Paragraph 3.8)

The top search results of the term “JD” in the search engines are all related to the Complainant and its products/services. Through extensive use, advertisement and promotion, the trademarks have achieved wide recognition. As such, the public has come to recognize and associate the Complainant’s trademarks as originating from the Complainant and no other. It is noted that the disputed domain name was registered by a Chinese citizen and that the domain name was marked for sale. The fact that the disputed domain name contains the trademarks “JD” and “JD Express” is obvious to all that the Respondent is aware of the existence of the Complainant and the value of its trademarks. The action of registering the disputed domain name per se has constituted bad faith.

Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4(a)(iii) of the Policy.

## **5. Decision**

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name <jd-express.com> should be TRANSFERRED to the Complainant, BEIJING JINGDONG 360 DU E-COMMERCE LTD.

A handwritten signature in Chinese characters, appearing to be '赵云' (Zhao Yun), written in black ink on a light background.

Dated: 29 March 2018