



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

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(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1200421
Complainant:	Alibaba Group Holding Limited
Respondent:	microit technology (M) co ltd

1. The Parties and Contested Domain Name

The Complainant is:

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

The Respondent is:

microit technology (M) co ltd
66 Jalan Hang Jebat
Taman Sri Tiram, Ulu Tiram
Johor Bahru, Johor 81800
Malaysia

The domain name at issue is:

onlinetaobao.com

which is registered with GODADDY.COM, LLC

2. Procedural History

On 7 February 2012, the Complainant, through its authorized legal representative, lodged a “Complaint in Accordance with the Uniform Domain Name Dispute Resolution Policy” (hereinafter referred to as “Form C”) with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (hereinafter referred to as “ADNDRC-HK”) concerning the domain name <onlinetaobao.com> in accordance with:

- the Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (hereinafter referred to as “ICANN”);
- the Rules for the Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “Rules”), and

- the Asian Domain Name Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “Supplemental Rules”).

According to Form C, the Complainant elected to have this dispute decided by one panellist.

ADNDRC-HK contacted the registrar of the disputed domain name, GoDaddy.com, Inc. by e-mail dated 8 February 2012. GoDaddy.com, LLC replied by e-mail dated 9 February 2012 stating that:

- the *Registrant* of the contested domain name is microit technology (M) co ltd with the identical address as the Respondent above;
- the disputed domain name was created on 5 May 2007;
- the disputed domain name is registered through GoDaddy.com, LLC;
- the Uniform Domain Name Dispute Resolution Policy applies to the disputed domain name; and,
- that the language of the registration agreement for said domain name is English.

On or about 14 February 2012, ADNDRC-HK notified the Respondent in this matter by e-mail of the complaint filed by the Complainant. This e-mail was addressed to:

- the Respondent’s registered Administrative Contact/Technical Contact;
- sales@taobao.com.my; and,
- postmaster@onlinetaobao.com.

On the same date, ADNDRC-HK received an automatic response from sales@taobao.com.my stating:

We have received your email.
We will get back to you as soon as possible.. [sic]

Thank you.

Taobao Online Team
Sales@taobao.com.my

On or about 16 February 2012, ADNDRC-HK forwarded the hard copies of the relevant documents by courier to the Respondent’s registered Administrative Contact. The record provided to this Panellist does not appear to indicate receipt or acknowledgement of receipt by the Respondent.

By e-mail dated 6 March 2012, ADNDRC-HK notified both parties to this dispute that the Respondent had not submitted a Response. On the same date, ADNDRC-HK received an automatic response from sales@taobao.com.my stating:

We have received your email.
We will get back to you as soon as possible.. [sic]

Thank you.

Taobao Online Team
Sales@taobao.com.my

On 20 March 2012, the undersigned, then a potential Panellist for this dispute, confirmed his availability to act as a Panellist and his ability to act independently and impartially between the parties to this dispute. Subsequently, on 22 March 2012, ADNDRC-HK via several e-mails:

- appointed the undersigned as the sole Panellist in this dispute;
- transmitted electronically the documents; and,
- requested that a decision to be rendered by 5 April 2012.

The Panel finds that it was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. Therefore, this Panel has jurisdiction over this domain name dispute. The proceeding is in English, being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and in consideration that there is no express agreement between the Parties to the contrary.

3. Factual Background

3.1 For Complainant

The Complainant, Alibaba, is one of the largest e-commerce companies internationally. Founded in 1999, Alibaba and its affiliated companies reported total revenue for 2010 of approximately RMB 5.56 billion with a year-on-year growth of approximately 43%.

In May 2003, Alibaba created the <taobao> brand name at www.taobao.com to be a Chinese language consumer-to-consumer internet retail outlet. Since its founding, <taobao> brand has become China's largest online retail platform and the primary online shopping destination in the country. The transaction volume of the <taobao> brand is stated to be more than RMB 200 billion. Additionally, the name <taobao> appears internationally. This international operation includes the registered home of the Respondent (Malaysia), where <taobao> is served through authorized agents. (See, e.g., Complainant's Annexures 4-6)

Complainant states that it has owned the Chinese trademark registration for the <taobao> brand name in various Classes with Registration Dates ranging from 2005 to 2011. (Complainant's Annexure 2) In Malaysia, the <taobao> brand name has been filed in several Classes with the relevant authority on 5 May 2010. (Complainant's Annexure 2) Complainant further provided evidence of the registration and use of the <taobao> brand name in Malaysia on various dates in 2011. (Complainant's Annexure 3).

3.2 For Respondent

The Respondent failed to file its Form R Response or any response other than the automatic e-mail replies noted above.

4. Parties' Contentions

4.1 For Complainant

The Complainant's contentions may be summarized as follows:

- Disputed domain name is identical or confusingly similar. The disputed domain name, being the word <online> immediately preceding the Complainant's domain name <taobao> is identical or confusingly similar to the Complainant's trademarks.
- The Respondent has no legitimate interests in the disputed domain name. Related to the foregoing, the brand name <taobao> was well-established and well-known prior to the Respondent's unauthorized use of the disputed domain name. Further, Complainant contends that Respondent is not making a legitimate, non-commercial use of the disputed domain name.
- Bad faith. The disputed domain name is confusingly similar to Complainant's brand and Respondent's purpose of registering the disputed domain name is for the purposes of profit or commercial gain.

4.2 For Respondent

The Respondent has submitted no response.

5. Findings

The Rules at paragraph 15 allows a Panel to decide a complaint in accordance with the Policy, the Rules and any rules and principles of law that the Panel deems applicable. This Panel will now proceed to do so.

The preliminary question of notice to the Respondent pursuant to the Rules at paragraph 2(a) is answered in the affirmative. ADNDRC-HK has posted hardcopies of the documents to the Respondent's registered street address. It is noted that GoDaddy.com, LLC has supplied the identical street address for the Registrant, Administrative Contact, and Technical Contact. Furthermore ADNDRC-HK has sent e-mails to the Administrative Contact and Technical Contact, both of whom appear to be the same individual with the same e-mail address. Finally, ADNDRC-HK has sent e-mails to the postmaster at the disputed domain name and to the e-mail address shown or e-mail links on the subject web page. From the record, the Panel is satisfied that ANDNDRC-HK has made good faith endeavours to notify the Respondent by compliance with the Rules at paragraphs 2(a)(ii)(A), 2(a)(ii)(B), 2(a)(ii)(C) and 2(a)(iii).

The Rules at paragraph 5(e) allows a Panel to decide a dispute based upon the complaint in instances where the Respondent failed to submit a response and barring exceptional circumstances. The Respondent has failed to submit a response. No exceptional circumstances have been brought to the attention of the Panel. As the Respondent submitted no Response, the Panel may infer that the allegations of the Complainant to be true and that the Respondent knows its website is misleading. *Sony Kabushiki Kaisha (a/t/a Sony Corporation) v Inja, Kil*, WIPO Case No. D2000-1409 (Dec. 9, 2000) [citing to *Reuter Limited v Global Net 2000, Inc.* WIPO Case No. D2000-0441 (July 13, 2000)]; *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 (Oct. 28, 2003) [citing to *Encyclopaedia Britannica, Inc. v null John Zuccarini, Country Walk*, WIPO Case No. D2002-0487 (Aug. 12, 2002) and *Talk City, Inc. v Michael Robertson*, WIPO Case No. D2000-0009 (Feb. 29, 2000)]

The ICANN Policy at Paragraph 4(a) provides that each of the following three findings must be made in order for a Complainant to prevail:

- i. That the domain name of 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 or legitimate interest in respect of the domain name; and,
- iii. That the domain name has been registered and used in bad faith.

Based upon the pertinent requirements under the Policy, Rules and the Supplemental Rules, the Panel in this matter shall determine whether Complainant satisfies each of the foregoing criteria.

5.1 Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

The disputed domain name is <onlinetaobao.com>. Apart from the generic top-level domain suffix <.com>, the disputed domain name is comprised of <onlinetaobao> which combines Complainant's mark with the word <online>. The disputed domain name contains Complainant's mark in full with the addition of the word <online> which appears to have the substantial indication of an association of some kind with an electronic or cyber version of a complainant's mark for e-commerce purposes.

The Panel in the case of *Trendy International Investment Limited v Pri*, Beijing ADNDRC Case No: CN-1100433 (2011), found that the majority of disputed domain name <E-OCHIRLY.COM> to be comprised of two separate sub-parts: <E> and <OCHIRLY>. The first sub-part is not sufficiently distinctive to differentiate the disputed domain name from the Complainant's registered trademark. The second sub-part of the disputed domain name is identical to the Complainant's registered trademark <OCHIRLY>, "except for the lower case letters that has nearly no effect on distinguishing the disputed domain name and the Complainant's prior trademark." The <.COM> merely indicates the registration of the disputed domain name under the gTLD and is not distinctive. The Panel in *Trendy International Investment* concluded that the only distinctive and identifying part of the disputed domain name is <OCHIRLY>.

The case of *Lacoste SA v Eyu Lang*, Beijing ADNDRC Case No: CN-1000375 (2011) addressed the instance where the letters <IN> were inserted before <LACOSTE> to create the domain name <INLACOSTE.COM>. The panel in that dispute determined that the addition of a prefix having no substantive meaning but to restate the connection with the legitimate trademark holder does not preclude a finding of "confusingly similar to a trademark in which Complainant has rights".

The panel in *Diageo Ireland v Guinnessclaim*, WIPO Case No. D2009-0679 (July 26, 2009) stated:

The disputed domain name ... incorporates the GUINNESS mark in its entirety and adds only the non-distinctive term "claim" to the mark. The addition of a non-distinctive or generic term to Complainant's mark is insufficient to avoid confusion.

Likewise and for similar reasons, in the case of *Alibaba Group Holding Limited v Xushien*, Hong Kong ADNDRC Case No: HK-11000373 (2011), the panel ordered the disputed domain name <E-ALIBABA.NET> be transferred to the Complainant. See also the decisions in *Hitachi, Ltd v. Ningbo Hitachi Garment & Apparel Co., Ltd.*, Beijing ADNDRC Case No: CN-1100439 (2011) (ordering the transfer of the disputed domain name <NBHITACHI.COM> to the Complainant); *Swatch Ltd v Jianyu Zhang*, Hong Kong ADNDRC Case No. HK-1000299 (2010) (ordering the transfer of the disputed domain name <SWATCH.PRO> to the Complainant; and, *精工爱普生株式会社 v. Hua Xiao Hao*, Beijing ADNDRC Case No: CN-1100438 (2011) (ordering the transfer of the disputed domain name <OKEPSON.COM> to the Complainant).

This Panel agrees with the analyses contained in the above cited cases. This Panel finds that <onlinetaobao.com> is comprised of two sub-parts: <online> and <taobao> where the former sub-part is a generic term which contributes little if any distinctiveness to the mark. This Panel finds the latter sub-part is identical or confusingly similar to Complainant's trademark and would cause confusion among the consuming public with Complainant's trademark. Complainant has met the first requirement under Paragraph 4(a) of the Policy.

5.2 Respondent has no rights or legitimate interest in respect of the domain name.

For the purposes of Paragraph 4(a)(ii), Paragraph 4(c) of the Policy provides that a Respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:

- i. before any notice to the Respondent, 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,
- ii. the Respondent has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or,
- iii. the Respondent is 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.

Although a Complainant has the ultimate burden of proving all three elements of Paragraph 4(a) of the Policy, previous panels have consistently held that Paragraph 4(c) shifts the burden of proof to a Respondent once a Complainant has established a *prima facie* showing. *Document Technologies, Inc. v International Electronic Communications Inc.*, WIPO Case No. D2000-0270 (June 6, 2000); *Inter Ikea System BV v Isaac Goldstein*, Hong Kong ADNDRC Case No. HK-1000320 (2010); *Trendy International Investment Limited v Pri*, Beijing ADNDRC Case No: CN-1100433 (2011); and, *Seiko Epson Corp v Yao Fenglei*, Beijing ADNDRC Case No. CN-1000370 (2010). This Panel will follow established precedent.

The Complainant has established, in its Annexures 17 and 18, that the Respondent's <onlinetaobao.com> web site contained links to other online trading platforms unrelated to the Complainant's brand or its business. Consequently, the Complainant has made a *prima facie* showing of infringement of its trademark. It is thus for the Respondent to meet the burden of establishing one or more of the criteria contained in Paragraph 4(c) of the Policy.

The first of these criteria concerns the use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent's failure to respond to this dispute results in no such claim being made. The Respondent has not provided any evidence that the disputed domain name is being used in connection with a *bona fide* offering of goods or services. Respondent has not produced evidence of any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The second of these criteria requires the Respondent to have been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights. Respondent has produced no evidence that it has been commonly known by the domain name <taobao> or <onlinetaobao> even though the latter has been registered by Respondent since May 2007.

The third and last of these criteria requires the Respondent to prove 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. Respondent has failed to produce any evidence which can satisfy this criteria.

In *Rohde & Schwarz GmbH & Co. KG v Pertshire Marketing, Ltd.*, WIPO Case No. D2006-0762 (Aug. 21, 2006), the panel determined:

The Respondent filed no Response. There has been no other communications from the Respondent in connection with this case. There is nothing in the nature of the website to which the disputed domain names revert that suggests that the Respondent might have a right or legitimate interest in the disputed domain names themselves. Without a Response, there is nothing else in the case file that indicates that the Respondent has such rights or legitimate interests.

As such, the Respondent has not established a right or legitimate interest in the disputed domain names. Neither is there any other evidence, from all the evidence of this case, that points to any right or legitimate interest of the Respondent.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interest in the disputed domain names.

For the foregoing reasons, this Panel find that the Complainant has satisfied the second element of Paragraph 4(a) of the Policy, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain name.

5.3 The domain name has been registered and used in bad faith.

The Complainant in the present case has not authorized the Respondent to use the <taobao> name or any derivations or permutations thereof in any way. Furthermore, the Complainant is required to demonstrate that the Respondent's actions amount to bad faith.

A Complainant is required to establish a Respondent's bad faith as set out under Paragraph 4(a)(iii) of the Policy. Additionally, Paragraph 4(b) of the Policy sets out circumstances, in particular but without limitation, which shall be considered as evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that a Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to a Complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of said Respondent's documented out-of-pocket costs directly related to the domain name; or
- ii. a 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 said Respondent has engaged in a pattern of such conduct; or
- iii. a Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name, a Respondent has have intentionally attempted to attract, for commercial gain, Internet users to said Respondent's web site or other on-line location, by creating a likelihood of confusion with a Complainant's mark as to the source, sponsorship, affiliation, or endorsement of said Respondent's web site or location or of a product or service on said Respondent's web site or location.

The Panel in *Inter Ikea System BV v Isaac Goldstein*, Hong Kong ADNDRC Case No. HK-1000320 (2010) noted that the foregoing examples of bad faith are not exhaustive. The principal purpose of the Policy is to “curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another.” (citing to *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-003 and *Match.com, LP v Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230)

This Panel adopts the analysis used in the *Inter Ikea System BV v Isaac Goldstein* case:

... Respondent registered the Disputed Domain Name in bad faith because the Trademark is distinctively identifying the Complainant and the Respondent could not have failed to know of the Trademark before registering the Disputed Domain Name.

In the absence of any evidence provided by the Respondent legitimizing his use of the Disputed Domain Name, the Panel cannot conclude otherwise than by stating that the registration and use of the Disputed Domain Name was made in bad faith. See *Aventis Pharmaceuticals Products Inc. v. PBS Publishing LLC*, WIPO Case No. D2003-0122.

... Respondent registered the Disputed Domain Name and uses it for the purposes of monetary gain by providing links to sites which are unrelated to the ones of the Complainant or are in some cases even competing with the products of the Complainant. Such use of the Disputed Domain Name can only be explained by the intent of the Respondent to attract Internet traffic by capitalizing on the Complainant's Trademark. This type of use of the Disputed Domain Name constitutes sufficient evidence of the bad faith of the Respondent under paragraph 4(b)(iv) of the Policy. See *Rhino Entertainment Company v DomainSource.com, Inc.*, WIPO Case No. D2006-0968 and *Imperial Chemicals Industries PLC v RareNames*, WIPO Case No. D2006-0124

The Complainant has developed the <taobao> brand into an internationally known brand, e.g., through extensive investment, advertising, sponsorship and other publicity. <Taobao> has established name recognition or brand recognition. (Complainant's Annexures 4 - 6 and 10)

As a result, the consumer has come to recognize and associate the <taobao> trademark with the Complainant. The Complainant has produced proof that the <onlinetaobao.com> site provides links to electronic trading platforms unrelated to the Complainant and its <taobao> brand. (Complainant's Annexure 18)

The Respondent's failure to respond to this complaint results in no challenge to the Complainant's evidence as to the name recognition of the Complainant's trademark. The Respondent did not adduce evidence that it was unaware of the existence of the Complainant or its products or services at the time of registration. As noted above, because the Respondent submitted no Response, the Panel may accept the Complainant's allegations to be true, in particular that the Respondent knows its website is misleading. *Sony Kabushiki Kaisha (a/t/a Sony Corporation) v Inja, Kil*, WIPO Case No. D2000-1409 (Dec. 9, 2000) [citing to *Reuter Limited v Global Net 2000, Inc.* WIPO Case No. D2000-0441; *Hewlett-Packard Company v Full System* (FA 0094637); *David G. Cook v This Domain is for Sale* (FA0094957); and *Gorstew Jamaica and Unique Vacations, Inc. v Travel Concierge* (FA0094925)] This Panel therefore concludes that the registration and use of the disputed domain name was made in bad faith. *Inter Ikea System BV v Isaac Goldstein*, Hong Kong ADNDRC Case No. HK-1000320 (2010)

For the foregoing reasons, this Panel finds that the Complainant has established bad faith pursuant to Paragraph 4(a)(iii) of the Policy.

6. Panel Decision

For the reasons set out in the foregoing paragraphs, this Panel is satisfied that the Complainant has sufficiently proved the existence of all three elements of Paragraph 4(a) of the Policy. Accordingly, the Panel orders the transfer of the disputed domain name to the Complainant.

Panellist: Stephen D. Mau

Dated: 5 April 2012