



**(Hong Kong Office)**

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<b>Case No.</b>	HK-1300498
<b>Complainant:</b>	Alibaba Group Holding Limited
<b>Respondent:</b>	Haitao Wang
<b>Disputed Domain Name(s):</b>	haitao.com

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**1. THE PARTIES**

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 Respondents is Mr. Haitao WANG of 56 Bo Yun Road, 1st Floor, Pu-Dong, ZhangJiang, Shanghai 201203, China.

**2. THE DISPUTED DOMAIN NAME AND THE REGISTRAR**

The domain name is <haitao.com>, registered with GoDaddy.com, LLC of 14455 N. Hayden Rd. Ste. 226, Scottsdale, AZ 85260, USA (hereinafter, “the Registrar”).

**3. PROCEDURAL HISTORY**

On 22 May 2013, the Complainant submitted a Complaint in English to the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC). On 22 May 2013, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 28 May 2013, the Registrar acknowledged this notification by email, and provided the following information:

- i) GoDaddy is the registrar for the disputed domain name;
- ii) the registrant of the domain name is Mr. Haitao WANG;
- iii) the language of the registration agreement for the domain name is English
- iv) the Uniform Domain Name Dispute Resolution Policy (“UDRP”, hereinafter, “the Policy”) and the Rules for UDRP (hereinafter, “the Rules”) apply to the disputed domain name; and
- v) the domain name will remain locked during the pending proceeding.

The ADNDRC verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the ADNDRC Supplemental Rules for UDRP (hereinafter, the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC formally notified Respondent of the Complaint on 31 May 21013. The Respondent submitted a response that was notified to the Complainant on 20 June 2014.

The Complainant decided to have the Complaint decided by one panelist, whereas the Respondent elected the Complaint to be decided by three panelists. The ADNDRC elected this case to be dealt with by a three-member panel, in accordance with the UDRP, the Rules and the Supplemental Rules. On 11 July 2013, the ADNDRC appointed Prof. FAN Kun (presiding), Dr. LUO Dongchuan and Dr. Timothy SZE as panelists in this matter. The Panel finds that it was properly constituted.

On 12 July 2013, the Complainant filed a request for further statement with ADNDRC. In an objection to the Complainant’s request filed with the ADNDRC on 12 July 2013, the Respondent contended that such an additional filing would disrupt the normal process of the proceedings and would be unfair to the Respondent. On 15 July 2013, the Panel issued a Procedural Order:

- i) inviting the Complainant to file by a supplemental submission email with the ADNDRC by no later than 17:00 Hong Kong time on Friday, 19 July 2013 (Procedural Order, paragraph 1);

- ii) inviting the Respondent to file a supplemental submission by email with the ADNDRC by no later than 17:00 Hong Kong time on Thursday, 25 July 2013 (Procedural Order No. 1, paragraph 2);
- iii) extending the time by which a decision shall be issued in these proceedings until Thursday, 8 August 2013.

On 8 August 2013, the ADNDRC informed the parties, that the Panel has extended the deadline to render the decision to 16 August 2013 in accordance with Article 10(c) of the Rules.

#### **4. FACTUAL BACKGROUND**

##### **A) The Complainant**

The Complainant is Alibaba Group, which was founded in 1999 in Hangzhou, China. It operates in the field of e-commerce, through several platforms, such as Alibaba (<www.alibaba.com> and <www.alibaba.com.cn>), Taobao (<www.taobao.com> and <www.taobao.com.cn>), Tmall (<www.tmall.com>), Etao (<www.etao.com>), Juhuasuan (<www.juhuasuan.com>), Koubei (<www.koubei.com>), Alipay (<www.alipay.com>), 1688 (<www.1688.com>), Alibaba Cloud Computing (<www.aliyun.com>), China Yahoo! (<www.yahoo.com.cn>), Alimama (<www.alimama.com>) and Hitao (<www.hitao.com>).

Alibaba Group owns a large volume of trademarks registered in various jurisdictions, including a significant number of Chinese trademarks, such as “淘宝”, “Taobao.com”, “淘”, “海淘”, “Tao”, “Tao Café”, “Taohappy”, “Taooutlets”, or “Hitao.com”.

##### **B) The Respondent**

A preliminary question in this case concerns the identity of the appropriate Respondent or Respondents. The Complaint, filed with the ADNDRC originally named as Respondents both “Domains By Proxy, LLC” and “Mr. Haitao WANG”.

Article 1 of the Rules defines the respondent as “*the holder of a domain name registration against which a complaint is initiated*”.

The domain name holder can be identified through an inquiry in the WhoIs database. However, any domain name holder who is an individual shall legitimately have recourse to any proxy or privacy registration service to preserve its privacy and personal data. In such cases, the name of the domain name holder is replaced by the name of the proxy or privacy registration service provider.

It is established that the panel has discretion to determine the identity of the proper respondent(s) ([WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(“WIPO Overview 2.0”\), paragraph 4.9.](#))

In the present case, it is undisputed that Mr Haitao WANG used a proxy service offered by Domains By Proxy, LLC. It is undisputed that Mr. Haitao WANG, was duly identified by the Registrar as the holder of the domain name. Moreover, Mr Haitao WANG has acknowledged receipt of the Complainant and has replied to the Complainant.

In light of the information above, the Panel recognized Mr Haitao Wang as the sole Respondent.

For a better comprehension of the facts, it must be added that the Respondent is also the owner and the legal representative of Shanghai Goulong Information Technology (hereinafter, “Goulong”).

### **C) Prior Relationships Between the Complainant and the Respondent**

#### **1) The Cease and Desist Letter sent by the Complainant to Goulong**

On 22 March 2013, the Complainant issued a letter to Goulong, demanding to cease and desist from using any of the Complainant's Hitao / Taobao trademarks, remove from the website that the domain name resolves all references to the Complainant and links to the Complainant's website <www.taobao.com>, and transfer the domain name to the Complainant (Complaint, Annexure 3).

Goulong did not reply to the cease and desist letter and did not transfer the domain name. However, Parties agree on the fact that references to Complainant's trademarks were removed, even though they disagree on the date at which these references were removed.

## 2) The Promotional Agreement Between the Complainant and the Goulong

On 29 October 2008, Goulong and Alimama entered into a contractual agreement (Respondent's Annexure 2, in Chinese) by which Alimama authorized Goulong, as a promotion partner, to use certain promotional codes to promote the Taobao Marketplace on Goulong's website <tejiawang.com>.

### **D) The Domain Name and the Website**

It is undisputable that the domain name was created on 29 August 2003 (Complaint Annexure 1 and Response Annexure 3).

According to the Respondent, the Respondent acquired the domain name for the first time from a third party through the registrar BIZCN.COM on 21 November 2008. A Whois extract released on 14 February 2009 shows "Haitao" as the registrant, administrative contact and technical contact of the domain name (Response Annexure 3, page 6).

A second Whois extract released on 12 September 2010 shows "Shanghai Goulong Information Technology" as the registrant, and Mr Haitao WANG as administrative contact and technical contact (Response Annexure 3, page 7).

A third Whois extract released on 21 May 2013, and provided by the Complainant (Complaint Annexure 1) does not disclose the name of the registrant, nor the names of the administrative and technical contacts. However, this Whois extract shows that the status of the domain name was updated on 27 March 2013.

According to the Complainant, the Respondent transferred the domain name from Shanghai Goulong Information Technology to himself, a few days after Shanghai Goulong Information Technology received the Complainant's cease and desist letter dated 22 March 2013 (Complaint, Annexure 3). It is highly probable — and it is not disputed by the Parties — that

the Whois update that occurred on 27 March 2013 corresponds to the transfer operation from Shanghai Goulong Information Technology to the Respondent.

On 28 May 2013, the Registrar disclosed that the registrant of the domain name was Mr. Haitao WANG.

The Complaint provides another Whois extract dated 29 May 2013 on which Mr Haitao WANG is explicitly listed as the registrant of the domain name, as well as administrative and technical contact (Complaint Annexure 4).

As to the content of the website to which the domain name resolves, according to the Complainant, the website contained content that infringed upon the Complainant's intellectual property rights (Complaint, Annexures 10, 16 and 17). According to the Complainant, shortly after the cease and desist letter was issued and, as at 2 May 2013, references to the Complainants' trademarks had been removed from the website.

## **5. PARTIES' CONTENTIONS**

### **A) Complainant's Contentions**

The Complainant contends that the domain name <haitao.com> is identical or confusingly similar to the Complainant's registered trademarks comprising of the words "Hitao", "嗨淘", "Tao", "淘", "Taobao" and "淘宝".

The Complainant's trademark registrations comprising of the words "Hitao", "嗨淘", "Tao", "淘", "Taobao" and "淘宝" include:

- (1) PRC trademark "Taobao.com", No. 3575304, registered on 7 December 2005;
- (2) PRC trademark "淘宝", No. 3575303, registered on 7 December 2004;
- (3) Hong Kong trademark "Taobao", No. 300023282, registered on 23 May 2003;
- (4) Hong Kong trademark "淘宝", No. 30023273, registered on 23 May 2003;
- (5) PRC trademark "Hitao.com", No. 8270232, registered on 14 May 2011;
- (6) PRC trademark "嗨淘", No. 8260170, registered on 6 February 2011;

- (7) Hong Kong trademark “Hitao.com”, No. 301601559AB, registered on 8 October 2010;
- (8) Hong Kong trademark “嗨淘”, No. 301601577, registered on 29 April 2010;
- (9) Taiwan trademark “Hitao.com”, No. 1458803, registered on 16 April 2011;
- (10) PRC trademark “淘”, No. 7273777, registered on 14 January 2011;
- (11) PRC trademark “Tao”, No. 9892501, registered on 28 October 2012.

The Complainant has provided copies of trademarks certificates (Complaint, Annexure 6).

The Complainant also alleges common law unregistered trademarks on “Taobao” and “Tao” since May 2003.

Complainant furthermore states that Respondent has no legitimate interest in respect of the disputed domain name and that the disputed domain name has been registered and is used in bad faith.

The Complainant requests that the domain name <haitao.com> shall be transferred to the Complainant.

The Complainant denies the Respondent’s counterclaim of reverse domain name hijacking.

## **B) Respondent**

The Respondent denies all of the contentions raised by the Complainant in the Complaint and in its additional submission.

The Respondent denies the allegations by which the Complainant would own common law unregistered trademarks on “Taobao” and “Tao” since May 2003, refutes the assertions by which the domain name would be confusingly similar to the Complainant’s trademarks.

The Respondent argues that it has a legitimate right and/or interest on the domain name and that the domain name has been registered and is used in good faith.

The Respondent also asks the Panel to make a finding of reverse domain name hijacking, pursuant to paragraph 15(e) of the Rules.

## **6. DISCUSSION AND FINDINGS**

Before engaging in the threefold discussion of paragraph 4(a) of the Policy, the Panel will need to address some preliminary issues.

### **A) Preliminary Issues**

#### **1) Language of the Proceedings**

According to Article 11 (a) of the Rules, “[u]nless 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.” In the present case, the language of the registration contract is English. Even though both parties are Chinese, they have agreed the proceedings to be conducted in English and they have proven sufficient and equal ability to express in English. Accordingly, the proceedings and the decision shall be in English.

Nevertheless, a large number of evidence provided by the parties is in Chinese. This raises the issue of the admissibility of such evidence. According to Article 10 (d) of the Rules, “[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence.” Article 11 (b) of the Rules also provides that “[t]he Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding”. In the present case, each member of the Panel can read and understand Chinese perfectly. Thus, the Panel considers that evidence provided in Chinese is admissible.

#### **2) Admissibility of Supplemental Submissions**

In a request for further statement filed with the ADNDRC on 12 July 2013, the Complainant requested that an order be made enabling it to file a reply to the Respondent’s Response, prior to any decision being rendered in this case. In an objection to the Complainant’s request filed with the ADNDRC on 12 July 2013, the Respondent contended that such an additional

filing would disrupt the normal process of the proceedings and would be unfair to the Respondent.

The Panel has noted that the Policy and the Rules do not afford any Party a right to submit supplemental submissions, but the Panel may request, in addition to the Complaint and the Response, further statements or documents from either of the Parties (Article 12 of the Rules); and this Panel can consider such submissions at its discretion under Article 10(d) of the Rules ([Fred T. Elsberry, Jr. v. Mechanic's Responds News Publication, WIPO Case D2012-1295](#)). Furthermore, Article 10(b) of the Rules imposes on this Panel the responsibility to “ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case”. The Panel has formed the preliminary view that the Response contains allegations, ie the counterclaim of reverse domain name hijacking, which did not arise until after the submission of the Complaint ([Top Driver, Inc. v. Benefits, WIPO Case No. D2002-0972](#)). The Panel also notes that in [St Andrews Links Ltd v. Refresh Design, WIPO Case No. D2009-0601](#), the panel suggested that when a party wished to file a supplemental submission, and in order that the proceedings were not unduly delayed, the way to deal with this was not to file a stand alone request, application or motion. Instead, it suggested as follows:

*“..., in a case where a party wishes to file a supplemental submission not formally prescribed by the Policy or Rules,... the appropriate way to proceed is to prepare a set of reasons as to why it should be allowed to do so. This should then be filled **in or together with that supplemental submission**. The reasons given should set out clearly and cogently why the additional submission falls within the scope of one of the limited sets of circumstances in which additional submission are submitted”*  
(emphasis added)

On 15 July 2013, the Panel, pursuant to Articles 10 and 12 of the Rules, issued a Procedural Order inviting the Complainant “to file by email with the Hong Kong Office of ADNDRC by no later than 17:00 Hong Kong time on Friday, 19 July 2013 a supplemental submission addressing the matters related to the Respondent’s counterclaim of reverse domain name hijacking” (Procedural Order, paragraph 1). The Panel stated that “if the supplemental submission contains allegations beyond such matter, a set of reasons as to why it should be allowed to do so must be provided together with that supplemental submission. The reasons

*given should set out clearly and cogently why the additional submission falls within the scope of one of the limited sets of circumstances in which additional submission are permitted”* (Procedural Order, paragraph 1).

According to the Procedural Order No. 1, the Respondent “*was invited to file by email with the Hong Kong Office of ADNDRC by no later than 17:00 Hong Kong time on Thursday, 25 July 2013 a supplemental submission addressing any submission filed by the Complainant pursuant to paragraph (1) of this Order (including, if appropriate, the admissibility of any supplemental submission by the Complainant beyond the matters related to the Respondent’s counterclaim of reverse domain name hijacking)*” (Procedural Order No. 1, paragraph 2).

The Complainant and the Respondent both filed supplemental submissions within the prescribed time limit. The Complainant’s supplemental submissions contain allegation beyond the Respondent’s counterclaim of reverse domain name hijacking, *i.e.*, issues related to the promotional agreement. The Complainant contends that such additional submissions should be taken into account, because the Respondent has made a number of allegations not contemplated by the Complainant at the time of its submissions.

This Panel needs to decide whether allegations in the Complainant’s supplemental submissions beyond the Respondent’s counterclaim of reverse domain name hijacking are admissible. This Panel notes that the limited sets of circumstances in which additional submission are permitted may include the existence of new, pertinent facts that did not arise until after the submission of the Complaint, ([Top Driver, Inc. v. Benefits Benifits, WIPO Case No. D2002-0972](#)), the desire to bring new, relevant legal authority to the attention of the Panel, ([Pet Warehouse v. Pets.Com, Inc., WIPO Case No. D2000-0105](#)), or the need to rebut factual arguments that could not have been anticipated in the Complaint, ([Radan Corp. v. Rabazzini Winery, WIPO Case No. D2003-0353](#)). Conversely, a mere longing to reargue the same issues already submitted is not a valid reason for additional submissions ([World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles, WIPO Case No. D2000-1306](#)). On reviewing the case file the Panel formed the view that the Respondent’s factual submissions as to promotional agreement could not have been anticipated in the Complaint. Accordingly, this Panel decides that Complainant’s supplemental submissions are admissible.

### 3) Scope of the Policy

Parties have recognized that a promotional agreement was signed between Alimama and Goulong in 2008.

Prior UDRP panels have rejected complaints where the dispute is primarily contractual in nature and therefore outside the scope of the policy (see for examples: [\*Clinomics Biosciences, Inc v. Simplicity Software, Inc.\*, WIPO Case No. D2001-0823](#); [\*Adaptive Molecular Technologies, Inc. v. Pricilla Woodward and Charles R. Thornton\*, WIPO Case No. D2000-0006](#); [\*Peregrine Financial Group, Inc. d/b/a PFG v. Andrey A. Barchenkov\*, WIPO case No. D2007-1384](#); [\*Pelikan Vertriebsgesellschaft mbH & Co. KG. v. Pelikan Iran\*, WIPO Case No. DIR2010-0005](#); [\*Spa Logic Inc v. Arctic Numacorp / Numa Technologies Corporation aka Numacorp\*, WIPO case No. D2012-1781](#)).

In [\*Heel Quik, Inc. v Michael H. Goldman & Barbara S. Goldman\*, NAF Case No. 92527](#), the Panel ruled in a situation where there was only one contract between the parties involved. In examining that one document, the learned panel in that case could determine easily the extent to which the Respondent was authorized to use the trademark(s) of the Complainant and to what extent that authorization would permit the creation of a domain name that contained said trademark(s).

In this case, the Panel has formed the view that the dispute is not primarily contractual and does not fall outside the scope of the policy, for the following reasons:

- first, the promotional agreement was signed between Alimama and Goulong, not with the Respondent;
- second, the promotional agreement granted to Goulong only the right to use certain promotional codes to promote the Taobao Marketplace, and it is not disputed that the agreement did not grant to Goulong nor to the Respondent any right to use the Complainants' trademarks;
- third, the promotional agreement expressly provided that the rights granted to Goulong could not be transferred to any third party (e.g. to the Respondent);

- fourth, the promotional agreement referred to the domain name <tejiawang.com> (registered to Goulong), and not to the disputed domain name.

The Panel is of the view that i) this agreement is not relevant for the purpose of these proceedings, ii) the dispute falls within the scope of the policy, and iii) the Panel has jurisdiction to decide on the dispute.

#### **4) Applicable Law**

According to Article 15 (a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

In the present case:

- the Respondent is established in Shanghai, China;
- as it is stated in the Complaint, the Complainant has its headquarter in Hangzhou, China; and
- both parties perform the essential of their economic activities in China.

Thus the Panel considers that, beyond the policy, it shall take into consideration principles of Chinese law.

#### **B) 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.

## 1) Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with or confusingly similar to the Complainant's trademark rights. There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

### a. General Observations

The Panel has formed the view that it is crucial to take into consideration the relevant market, and the fact that both parties essentially target Chinese speaking consumers. As a consequence, the domain name and the trademarks must be compared by taking into account not only the visual similarities, but also the phonetic similarities and their respective meanings for the Chinese public.

### b. The Domain Name <haitao.com> and the “Hitao” / “嗨淘” Registered Trademarks

The Complainant claims that the domain name <haitao.com> is confusingly similar to the Chinese trademarks “Hitao”, on which the Complainant has rights, for examples:

- PRC trademark “Hitao.com”, No. 8270232, registered on 14 May 2011;
- PRC trademark “嗨淘”, No. 8260170, registered on 6 February 2011;
- Hong Kong trademark “Hitao.com”, No. 301601559AB, registered on 8 October 2010;
- Hong Kong trademark “嗨淘”, No. 301601577, registered on 29 April 2010; and
- Taiwan trademark “Hitao.com”, No. 1458803, registered on 16 April 2011.

It is the case of the Complainant that the choice of the domain name constitutes a typosquatting case. According to the Complainant, the domain name was purposefully misspelled by the addition of the letter “a” after the letter “h” and before “itao”, which is supported by the fact that the addition of the letter “a” does not add any distinctiveness to the look and sound of the Complainant's “Hitao.com” trademark.

Furthermore, the Complainant asserts that the words “hitao” and “haitao” are similar not only visually but also phonetically, in English, and in Chinese (“嗨淘” and “海淘”). Lastly, the Complainant asserts that the domain name is confusingly similar to the Complainant's domain name <hitao.com>, which was registered by the Complainant on 13 January 2009.

The Respondent denies all allegations of the Complainant and asserts that the domain name <haitao.com> is not identical or confusingly similar to any of the Complainant's trademarks.

According to the Respondent, the choice of the domain name cannot constitute a case of typosquatting since the domain name was acquired in 2008, before the Complainant registered the domain name <hitao.com> in 2009 and before the Complainant registered the trademarks “Hitao.com” and “嗨淘” between 2010 and 2011. The Respondent also adds that it did not need to misspell any words to come up with his own first name, which is a common, ordinary, and generic words broadly used by the public.

The Panel has formed the view that it is crucial to take into consideration the relevant market, and the fact that both parties essentially target Chinese speaking consumers. As a consequence, the domain name <haitao.com> (“海淘”) and registered trademarks “hitao” (“嗨淘”) must be compared by taking into account not only the visual similarities, but also the phonetic similarities and their respective meanings.

Visually, the two pair of signs “haitao” (“海淘”) and “hitao” (“嗨淘”) have a similar spelling in pinyin and a similar writing in Chinese characters. Nevertheless, as pointed out by the Respondent, “hǎi táo” (“海淘”) and “hitao” (“嗨淘”) do not have the same pronunciation. The Panel follows the Respondent's assertion by which in the Chinese language, the tone is an integral part of the pronunciation: 海 shall be pronounced with a falling-rising tone (三声) whereas 嗨 shall be pronounced with a straight falling tone (四声). Furthermore, with respect to the meaning, the Complainant alleges that “海淘” (transliterated as “haitao” in English), although independently are generic words (meaning “ocean” (海) and “dig” or “flush out” (淘)), in combination, do not constitute a common word or phrase in Chinese, other than being phonetically the same as and visually significantly similar to the Complainant's registered trade mark “嗨淘”. The Respondent argues that “海淘” is a very popular expression which is largely used in China (Response, Annexures 5 to 12). According to

Baidu online encyclopedia, “hǎi táo” (“海淘”) means overseas / offshore online shopping (“海淘, 即海外/境外网站购物”).<sup>1</sup> The Panel is of the view that the term “haitao” (“海淘”) is a generic and suggestive expression. Accordingly, the Panel considers that the domain name is not confusingly similar to the registered trademarks “Hitao” (“嗨淘”).

c. The Domain Name <haitao.com> and the “Taobao” / “淘宝” Registered Trademarks

The Complainant has demonstrated that it owns the following registered trademarks:

- PRC trademark “Taobao.com”, No. 3575304, registered on 7 December 2005;
- PRC trademark “淘宝”, No. 3575303, registered on 7 December 2004;
- Hong Kong trademark “Taobao”, No. 300023282, registered on 23 May 2003; and
- Hong Kong trademark “淘宝”, No. 30023273, registered on 23 May 2003.

Visually, the two pair of signs “haitao” (“海淘”) and “taobao” (“淘宝”) are different in spelling in pinyin, writing in Chinese characters, and pronunciation. As stated earlier, “haitao” (“海淘”) must be considered as a generic and suggestive expression. Accordingly, the Panel considers that the domain name is not confusingly similar to the registered trademarks “Taobao” (“淘宝”).

d. The Domain Name <haitao.com> and the “Tao” / “淘” Registered Trademarks

The Complainant has demonstrated that it owns the following registered trademarks:

- PRC trademark “淘”, No. 7273777, registered on 14 January 2011; and
- PRC trademark “Tao”, No. 9892501, registered on 28 October 2012.

The Complainant alleges that the use of the word “Tao” in any mark is recognized as being associated with the Complainant’s subsidiaries and affiliates, in the minds of consumers. The Respondent argues that the Complainant cannot claim exclusive rights on the combination words that include “TAO” or “淘”, and has provided ample examples of trademarks formed by combination words that include “TAO” but have no connection with the Complainant, such as LETAO (“乐淘”), TAOXIE (“淘鞋”), TAOMEE (“淘米”), TAO3C.COM and

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<sup>1</sup>. <http://baike.baidu.com/view/5171653.htm>

TAOCZ.COM (“淘常州”) (Response, Annexure 4). The Policy does not grant the panel with the power to address the issue of the validity of the trademark. Thus, the Panel will thus take the trademarks as granted and valid, and will only compare the domain name <haitao.com> (“海淘”) and registered trademarks “Tao”/ “淘”.

Visually, the domain name <haitao.com> reproduces the element of “Tao”, with identical spelling in pinyin, identical writing in Chinese characters, and identical pronunciation. In terms of meaning, as stated earlier, the term “haitao” (“海淘”) together means overseas / offshore online shopping, and must be considered as a generic and suggestive expression. Whereas the term “tao” (“淘”) means to rinse off the impurity with water (“用水洗去杂质”), according to the Xinhua Dictionary and Baidu online encyclopedia.<sup>2</sup> The Panel is of the view that the domain name is not confusingly similar to the trademarks “Tao” / “淘”.

#### 4) The Domain Name <haitao.com> and the Alleged “Tao” / “淘” and “Taobao” / “淘宝” Unregistered Trademarks

The Complainant asserts that it has been using the “Taobao” and “Tao” trademarks since May 2003, and considers that even though the Complainant had not registered the “Hitao.com” and “Tao” trademarks until 2010 and 2011, respectively, “Tao” and any combinations of words that include “Tao” (such as “Hitao” or “Etao”) had been and is still closely associated with the Complainant's “Taobao” trademark, which the Complainant first registered in May 2003. The Complainant also alleges that the use of the word “Tao” in any mark is recognized as being associated with the Complainant’s subsidiaries and affiliates, in the minds of consumers. The Complainant concludes that it had therefore acquired unregistered common law trademark rights in “Taobao” and “Tao” before its trademark registrations.

In the Panel’s view, the Complainant cannot claim unregistered common law trademarks in “Taobao” and “Tao”. Though common law trademarks are frequently admitted in UDRP cases, as stated earlier, the panel is on the view that Chinese law principles shall apply to the case at issue. Under Chinese law, there is no common law protection for unregistered

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<sup>2</sup> <http://baike.baidu.com/view/653434.htm>

trademarks, though a well-known trademark can reach protection without any registration, but the Complainant has not provided the Panel with any official document, which recognized “Taobao” and “Tao” as well-known trademarks in China.

Following reasons stated above, the Panel considers that the Complainant:

- failed to prove that the domain name is confusingly similar to its registered trademarks “Hitao.com” and “嗨淘”;
- failed to prove that that the domain name is confusingly similar to its registered trademarks “Taobao.com” and “淘宝”;
- failed to prove that that the domain name is confusingly similar to its registered trademarks “淘” and “Tao”.

#### e. Conclusion on the First Element

In light of the above, the Panel finds the disputed domain name is not identical or confusingly similar to a trademark in which Complainant has rights.

In order for the Panel to consider the Respondent’s counterclaim of reverse domain name hijacking, this Panel still needs to decide other elements under Paragraph 4(a) of the Policy.

## **2) Rights or Legitimate Interests**

The second element of a claim of abusive domain name registration and use is that the respondent has no rights or legitimate interests in respect of the domain name (Policy, paragraph 4(a)(ii)). The Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests:

*“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):*

*(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.” (Policy, paragraph 4(c))

As is well established now, these are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

Further, the onus of proving this requirement, like each element, falls on the Complainant.

Panels have recognized the difficulties inherent in disproving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case (see, e.g., [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(“WIPO Overview 2.0”\), paragraph 2.1.](#)).

In this case, the Complainant states that it has not authorized the Respondent to use its trademarks “Hitao”, “嗨淘”, “Tao”, “淘”, “Taobao” and “淘宝”. As stated above (see section 6A3), the promotional agreement performed between the parties did not grant to Goulong or to the Respondent any right to use the Complainants’ trademarks.

The Panel considers that the Complainant has made the requisite *prima facie* showing in this case. The burden of coming forward with evidence of rights or a legitimate interest thus shifts to the Respondent.

First, the Respondent asserts that he has owned the disputed domain name since 21 November 2008 (not since 27 March 2013 as stated by the Complainant), which is before the Complainant’s “Hitao.com” trademarks were registered (between 2010 and 2011) and before the Complainant registered the domain <hitao.com> (on 13 January 2009). The Respondent

contends that the transfer of the disputed domain name, on 27 March 2013, from Goulong (the organization he legally owned and represents) to the Respondent, did not change the Respondent's ownership of the domain to the Respondent. To support this assertion, the Respondent refers to [Intellogy Solutions, LLC v. Craig Schmidt and IntelliGolf, Inc., WIPO Case No. D2009-1244](#) (Respondent's Annexure 8). In that particular case, the C.E.O. of two affiliated entities A and B, who was listed as the administrative contact of the disputed domain name, transferred a domain name from the entity A to the entity B. As a result, that domain name remained as an asset of the same group of entities. In the present case, the situation is slightly different, since the Respondent Mr Haitao WANG, owner and representative of Goulong, and also administrative contact of the disputed domain name, transferred it to himself. As a result, since 27 March 2013 (date at which the transfer is probably to have occurred), the disputed domain name is no longer an asset of Goulong, but an asset of the Respondent. The operation of transferring a domain name must not be considered as a simple technical operation. It produces legal effects. As any other assets, the transfer of a domain name produces a transfer of ownership and this operation must be considered as an acquisition. The question as to whether this acquisition constitutes a new registration is addressed in the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \("WIPO Overview 2.0"\)](#). The Panel adopts the view expressed at the [paragraph 3.7.](#) by which *"formal changes in registration data are not necessarily deemed to constitute a new registration where evidence clearly establishes an **unbroken chain of underlying ownership by a single entity or within a genuine conglomerate**"* (emphasis added), which is clearly the case here. Thus, the Panel considers that the transfer of the disputed domain name, on 27 March 2013, from Goulong to the Respondent does not constitute a new registration. Consequently, the Respondent owns a prior right on the domain name since November 2008, before the Complainant's "Hitao.com" trademarks were registered (between 2010 and 2011) and before the Complainant registered the domain <hitao.com> (on 13 January 2009).

Second, even though it was mentioned earlier (see Section 6C1), it should be emphasized here that "hǎi táo" ("海淘") is a generic and suggestive expression that the Respondent, as any other person, has the right to use. However, *"Panels have recognized that mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase (which may be generic with respect to certain goods or services), may not of itself confer rights or legitimate interests in the domain name. Normally, in order to find rights or*

*legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase)”* ([WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \("WIPO Overview 2.0"\), paragraph 2.2.](#)). In the present case, the Respondent has shown that he makes a genuine use of <haitao.com> since this domain name is used in connection with a website providing Chinese consumers with information relating to overseas / offshore online shopping (“hǎi táo” / “海淘”).

Third, the Respondent explains that he acquired the domain name in November 2008 primarily because the domain matched his first name “Haitao” (“海涛”). He explains that, as an entrepreneur, he is entitled to use the domain name to offer services consistent with his ongoing business as an online shopping information provider. The Panel adopts the same view as panellists in [Ken’s Foods Inc. v. kens.com, WIPO Case No. D2005-0721](#) and [Penguin Books Limited v. The Katz Family and Anthony Katz, WIPO Case No. D2000-0264](#): *“the disputed domain name clearly reflects the Respondent’s given name, and the Panel concludes from the record as a whole that the Respondent has rights or legitimate interests in the disputed domain name under paragraph 4(c)(ii)”*. Furthermore, *“the record does not support a conclusion that the Respondent registered the domain name with the intent of appropriating the Complainant’s mark for his own use”* ([Ken’s Foods Inc. v. kens.com, WIPO Case No. D2005-0721](#)).

For the reasons stated above, the Panel finds that the Complainant has not met its burden under paragraph 4(a)(ii) to demonstrate that the Respondent has no rights or legitimate interests with respect to the disputed domain name.

### **3) Registered and Used in Bad Faith**

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and is being used in bad faith by the Respondents.

#### ***i) Registration in Bad Faith***

The Complainant submits that the domain name has been registered by the Respondent in bad faith on various grounds.

First, the Complainant contends that the Respondent's registration of the domain name was motivated solely to take advantage of the Complainant's reputation in the Haitao / Taobao trademarks and thereby make undue profits (citing [\*Sony Kabushiki Kaisha \(also trading as Sony Corporation\) v. Kil Inja\*, WIPO Case No. D2000-1409](#)). The prerequisite of this assertion is that the Respondent had knowledge of the Complainant, its Haitao / Taobao trademarks and its rights in the disputed domain name. As stated earlier (see above, Section 6D), the Respondent acquired the domain name in November 2008. At that time, the Respondent probably knew the existence of the Complainant and its “Taobao” trademarks. However, this Panel already found that the domain name was not confusingly similar to the “Taobao” trademarks. Furthermore, at the time the Respondent acquired the domain name in November 2008, he could not have been aware of the “Hitao” trademarks, which were only registered in 2010 and 2011, nor the domain name <hitao.com>, which was registered in 2009. The Respondent could have acquired the domain name for the generic and suggestive value of the domain name, and/or for the purpose of being able to use a domain name that matches with his first name. This Panel is of the view that the Complainant has not established that the Respondent has chosen to acquire the domain name to create confusion with Complainants’ trademarks.

Second, the Complainant alleges that the Respondent has engaged in a pattern of illegitimate domain name registrations, in accordance with Article 4.b.ii) of the Policy. This specific issue is addressed in the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(“WIPO Overview 2.0”\)](#). At the [paragraph 3.3.](#), the overview states that panellists have reached the following consensus: *“A pattern of conduct can involve multiple UDRP cases with similar fact situations or a single case where the respondent has registered multiple domain names which are similar to trademarks. However the registration of two domain names in the same case is not generally sufficient to show a pattern, nor is a single prior example of apparent bad faith domain name registration. Although panels will generally look to the specific circumstances, a pattern normally requires more than one relevant example”*. In the present case, the Complainant only provided a list of Whois extracts in which the Respondent appears, but failed to provide a

single judicial or extra-judicial case where Respondent's bad faith has been proven and recognized.

Third, the Complainant submits that the transfer of the domain name from Goulong to himself, no more than five days after having received the Complainant's cease and desist letter, reveals the collusion between the two. According to the Complainant, such actions clearly were aimed at obstructing the Complainant's efforts to obtain rightful title to the domain name, and are further evidence of the Respondent's registration and use of the domain name in bad faith (citing [\*Sony Kabushiki Kaisha \(also trading as Sony Corporation\) v. Kil Inja\*, WIPO Case No. D2000-1409](#)). Such conduct can be considered as similar to what it is commonly known as "cyberflight", where *"the Respondent deliberately tried to disrupt th[e] proceeding by transferring the domain name to another registrar and into the name of another registrant, after having notice of the original complaint, and during a pending administrative proceeding within the meaning of Paragraphs 8(a) and 8(b) of the Policy [...] in order to frustrate the Complainant to the greatest extent possible by increasing the costs, time and inconvenience in protecting its' trademark and service mark rights and legitimate interests"* ([\*L'Oreal S.A. v. Munhyunja\*, WIPO Case No. D2003-0585](#)). In the present case, the transfer of the domain name occurred not after having notice of the initial complaint but after the cease and desist letter. The Respondent could have registered himself as the registrant (without changing the registrar) in order to strengthen his legitimacy as to a domain name which matches his first name, a domain name in which it has been established that he has legitimate rights and interests. This Panel cannot find sufficient element to prove such behaviour is an act of bad faith.

In the meantime, even though the proceeding had not started at the date of the transfer (probably on 27 March 2013), the transfer of a disputed domain name right after a cease and desist letter can be done for the primarily purpose of frustrating the Complainant to the greatest extent possible by increasing the costs, time and inconvenience in protecting its' trademark rights. And in the present case, this is supported by Mr Haitao WANG's use of a proxy service. According to the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \("WIPO Overview 2.0"\)](#), *"[a]lthough use of a privacy or proxy registration service is not in and of itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. For example, registrant use of a privacy service in combination with provision of incomplete*

*contact information to such service or a continued concealment of the ‘true’ or ‘underlying’ registrant (possibly including that registrant’s actual date of acquisition) upon the institution of a UDRP proceeding may be evidence of bad faith. Identification by a registrar or privacy or proxy service of another such service as the purported registrant of the domain name may also constitute evidence of cyberflight and bad faith, as may failure in response to a UDRP provider’s request to timely confirm the identity and contact information of the registrant of the domain name where the registrant listed in the WhoIs is a privacy or proxy service (although such failure would not prevent a panel from deciding such cases, with the privacy or proxy service typically being regarded as the relevant respondent of record)” (paragraph 3.9.).* In the present case, the Respondent did use a proxy service right after the cease and desist letter, but eventually, the information contact provided was complete and reliable. Moreover, the transfer of the domain name from Goulong to Respondent and the use of a proxy service were time consuming, and these facts should be considered as indicators of bad faith. Nevertheless, this sole indicator of bad faith (the use of a proxy service right after the cease and desist letter) must not prevail the rights and legitimate interests the Respondent has on the domain name.

In consideration of all of the above circumstances, the Panel is of the view that the Respondent did not register the domain name in bad faith.

## ***ii) Use in Bad Faith***

The Complainant argues that Goulong had been using and, after registration by the Respondent, the Respondent continued to use the website in a way that infringed Complainant’s rights. To support these allegations, the Complainant provides screenshots on which the website appears to be related to the Complainant’s <www.taobao.com> website. Indeed, the Complainant proves, for example, that at some time in 2010, the top of the webpage stated “海淘网 - 淘宝秒杀”, which means “Haitao.com – Taobao Flash Sale”. Moreover, the Complainant demonstrates that the website posed itself as a website connected to the Complainant’s websites <www.taobao.com> and <www.tmall.com>. Indeed, on 22 March 2013, the bottom of the website page stated “关于我们: 海淘网 - 淘宝导购网”, which is an explicit reference to the “Taobao” trademarks in which the Complainant has rights. Complainant adds that to the best of the Complainant’s knowledge, references to the Complainant’s trademarks were removed from the website only on or around 2 May 2013.

This Panel is of the view that the Respondent's use of the domain name has misled consumers to believe that the disputed domain name and its operation were somehow sponsored or affiliated with the Complainant. Such a conduct falls within Article 4(b)(iv) of the Policy:

*“by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 cannot argue that, under the promotional agreement signed between the Complainant and his company, he was authorized to refer to Complainant's trademarks. Indeed, as stated earlier, this agreement makes no reference to the disputed domain name.

In the circumstances of the present case, after having carefully considered the Complainant's submissions, the Panel finds that the Complainant:

- has failed to prove on the balance of probabilities that the domain name was registered in bad faith;
- has demonstrated that the domain name was used in bad faith.

Since the Policy requires the Complainant to prove that the domain name was registered and is being used in bad faith, the Panel considered that the requirements of paragraph 4(a)(iii) of the Policy have not been satisfied.

*Obiter dictum*

The Panel has observed that the Respondent did attempt to associate his services with the Complainant, subsequently removed such information, and transferred back the domain name from Goulong to himself right after he received the cease and desist letter from the Complainant. However, it is the duty of the Panel to apply the UDRP. The Panel cannot grant itself the right to exceed its powers. This Panel cannot find sufficient element to prove the Respondent's registration of the disputed domain name is an act of bad faith according to the Rules and the Policy.

## F) Reverse Domain Name Hijacking

Paragraph 15(e) of the UDRP Rules provides that, if “*after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding*”. Reverse Domain Name Hijacking is defined under the UDRP Rules as “*using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name*”.

The Respondent argues that the complaint was brought in bad faith with calculated acts to deprive the Respondent of his domain name and to disrupt the Respondent’s business. The Respondent thus submits that Complainant’s behaviour constitutes an abuse of the UDRP proceeding. Therefore, the Respondent requests a decision that this complaint was an attempt of reverse domain name hijacking.

In its supplemental submissions, the Complainant denies these allegations.

According to the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(“WIPO Overview 2.0”\), paragraph 4.17](#), reverse domain name hijacking is recognized in circumstances where “*the complainant in fact knew or clearly should have known at the time that it filed the complaint that it could not prove one of the essential elements required by the UDRP*”. In the present case, the Complaint has proven that the domain was used in bad faith. In the Panel's view, at the time Complainant filed the Complaint, it had legitimate grounds for bringing the Complaint under the Policy and the Rules.

Accordingly, the Panel declines to find that Complainant engaged in attempted reverse domain name hijacking.

7. **DECISION**

On the basis of the foregoing considerations, the Panel finds that Complainant has failed to establish that:

- the domain name is identical or confusingly similar to the trademarks in which it has rights;
- the Respondent lacks legitimate rights or interests in the domain name <haitao.com>;
- the Respondent did not register the domain name in bad faith; and- the Respondent used the domain name in bad faith.

In light of the above, the Panel therefore denies the Complainant's request that the domain name be transferred from Respondent to Complainant.

The Panel declines the Respondent's counterclaim that the Complainant filed this Complaint in a bad faith attempt at reverse domain name hijacking.

**Prof. FAN Kun**  
(Presiding Panelist)

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**Dr. LUO Dongchuan**  
(Co-Panelist)

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**Dr. Timothy SZE**  
(Co-Panelist)

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Dated: 16 August 2013