



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1500718
Complainant:	Alibaba Group Holding Limited
Respondent:	Pan Zhongyi
Disputed Domain Name(s):	<alibaba-inc.org>

1. The Parties and Contested Domain Name

1.1 The Complainant in this matter is Alibaba Group Holding Limited, a company incorporated in the Cayman Islands with its registered office at Fourth Floor, One Capital Place, P.O. Box 847, George Town Grand Cayman, Cayman Islands, British West Indies (the “Complainant”) and represented by Mayer Brown JSM.

1.2 The Respondent is Pan Zhongyi, based in China of Shaoxing Zhejiang China 312000 (the “Respondent”) and unrepresented.

1.3 The disputed domain name is, <alibaba-inc.org> (the “disputed Domain Name”) registered by the Respondent with GoDaddy.com LLC, of 1445 N. Hayden Rd. Ste. 226, Scottsdale, AZ 85260, USA (the “Registrar”).

2. Procedural History

2.1 The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC-HK) on 13 March 2015. By email of the same date a request for Registrar verification in relation to the disputed Domain Name was sent to the Registrar who in turn replied by email of 17 March 2015 to confirm that the Respondent was listed as registrant of the disputed Domain Name. By email of 18 March 2015, the Respondent was issued with written notice of the Complaint and given up to 07 April 2015 to file a Response.

2.2 By email of 08 April 2015 the Case Administrator advised the Complainant that the ADNDRC-HK did not receive a Response from the Respondent within the specified period of time.

2.3 By email of 13 April 2015 the ADNDRC- HK advised the parties that Ike Ehiribe had been appointed as a sole panelist in this matter.

3. Factual background

For the Complainant

3.1 The Complainant who is officially known as Alibaba was founded in Hangzhou, China in 1999 and since then operates its e-commerce business through various subsidiaries and affiliates based in about 70 cities across China, Hong Kong, Taiwan, India, Japan, Singapore, USA and Europe. The Complainant has grown to become a global leader in the field of e-commerce and on 19 September 2014 was officially listed on the New York Stock Exchange. For the year ended 31 December 2013, the Complainant's total gross merchandising volume is said to have been well over RMB 1.5 billion and it had over 230 million active buyers across its platforms. The Complainant is said to operate two online business-to-business marketplaces: a global trade market place (www.alibaba.com) for importers and exporters and a Chinese marketplace (www.alibaba.com.cn and www.1688.com) for domestic trade in China. The Complainant's Alibaba Trade Marks since 1999 are said to have acquired a unique distinctiveness through extensive use by the Complainant and its affiliates in e-commerce and as a result of the Complainant's huge investment and use, the Alibaba Trade Marks have become well known to consumers and Internet users all over the world.

3.2 The Complainant has attached to the case file in these proceedings a spreadsheet listing the Complainant's numerous trademark applications and registrations for trade marks incorporating the marks "ALIBABA", "ALIBABA.COM" and alibaba in Chinese, including registrations in the United States of America, Canada, Hong Kong, China, the European Union, Macau, Singapore and Taiwan. The Complainant has also attached numerous copies of official trade mark applications and registrations comprising of the "ALIBABA" Trademarks to the case file in this matter. The Complainant has also exhibited an extensive list of numerous registered domain names incorporating the mark "ALIBABA" which is also included in the case file.

For The Respondent

3.3 The Respondent is based in Shaoxing Zhejiang China and registered the disputed Domain Name on 20 June 2013 according to the WHOIS record last updated on 12 March 2015, attached to these proceedings.

4. Parties' Contentions

The Complainant

4.1 The Complainant refers to all the exhibited trade mark registration certificates and extracts attached as annexure 3 in the case file and contends that the disputed Domain Name <ALIBABA-INC.ORG> is confusingly similar to the trade marks in which the Complainant has rights namely the "ALIBABA" trade marks in that the disputed Domain Name incorporates the Complainant's "ALIBABA" trade mark entirely; the only difference being the inclusion of "-inc" as a suffix. The Complainant states that "-inc" is simply a reference to a generic abbreviation inc. (i.e.incorporated) and is used in the host name element of the email addresses of staff members of the Complainant and therefore, the inclusion of the abbreviation "-inc" in the disputed Domain Name heightens the confusing similarity between the disputed Domain Name and the Complainant's "ALIBABA" marks. The Complainant asserts that it is well established that where as in this case, the only difference between the disputed Domain Name and the complainant's mark is the inclusion of a generic term as a prefix or a suffix, such prefix or suffix does not

prevent a confusing similarity finding following the decision in *Kabushiki Kaisha Toshiba d/b/a/ Toshiba Corporation v. Distribution Purchasing & Logistics Corp.*, WIPO Case No. D2000-0464. In addition, the Complainant contends that in ascertaining whether a disputed domain name is confusingly similar to a complainant's trade mark, the domain extension, in this case <. org>, is normally disregarded. In support of this contention, reliance is placed on the case of *Rohde & Schwarz GmbH & Co. HG v. Pertshire Marketing Ltd*, WIPO Case No. D2006-0762.

4.2 The Complainant further submits that the Respondent has no rights or legitimate interests in respect of the disputed Domain Name, as there is no evidence to suggest that the Respondent has been commonly known by the disputed Domain Name. The Complainant alludes to the fact that the Respondent's name Pan Zhongyi does not reflect or correspond with the disputed Domain Name and or there is no justification for the Respondent to include the mark "ALIBABA" in the disputed Domain Name. The Complainant asserts further that the Complainant has not licensed, consented to or otherwise authorised the Respondent's use of the "ALIBABA" trade marks, therefore, the onus of proof falls on the Respondent to establish that the Respondent has rights or legitimate interests in the disputed Domain Name. In this respect, see *PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No D2003-0174. The Complainant states further that the Respondent does not own any trade mark registrations corresponding to the disputed Domain Name in the United States of America, or in China, where the Respondent is apparently domiciled as revealed by recent searches conducted on the databases of the Trade Mark offices in both the United States and China.

4.3 The Complainant further asserts that the disputed Domain Name is currently inactive and as shown by a screen shot dated 14 May 2015 the disputed Domain Name previously resolved to a very basic website with limited and unrelated material the purpose of which is unclear except for use as a parking page. And since the Respondent clearly intended to sell the disputed Domain Name for financial gain, it is submitted that the Respondent cannot lay any claims to a right or legitimate interest in respect of the disputed Domain Name. Finally, in this regard, the Complainant submits that the Respondent cannot argue that the Respondent is making a legitimate non-commercial or fair use of the disputed Domain Name within the ambit of paragraph 4(c) of the Policy.

4.4 The Complainant also submits that the disputed Domain Name has been registered and is being used in bad faith on the following grounds. Firstly, the Complainant commenced usage of the "ALIBABA" trademarks in 1999 for a continuous period of fourteen years before the Respondent registered the disputed Domain Name on 20 June 2013. Accordingly, it is asserted that it is inconceivable that the Respondent was unaware of the Complainant's extensive rights in the "ALIBABA" trade marks before embarking upon registration of the disputed Domain Name. Therefore, it is submitted that the only possible reason for the registration of the disputed Domain Name by the Respondent is to take advantage of the Complainant's worldwide reputation in bad faith for the purposes of unfairly disrupting the Complainant's business and or selling the disputed Domain Name for commercial gain, as is clearly evidenced by an email from the Respondent dated 05 March 2015 demanding a purchase price of US\$ 100,000 from the Complainant's representative for the disputed Domain Name. Secondly, it is contended that the Respondent's registration and use of the disputed Domain Name must involve *mala fides* since the unauthorised use of it was made in the full knowledge of the Complainant's prior rights in the "ALIBABA" trade marks, particularly, as the Respondent never sought permission from the Complainant for such registration and use as held in *Veuve Clicquot*

Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163. Thirdly, reference is made to the Respondent's primary motive of registering the disputed Domain Name as being to sell the disputed Domain Name for considerable profit in excess of the Respondent's out of pocket expenses. Finally, the Complainant reveals that it experiences a relatively high incidence of infringers registering domain names that are confusingly similar to its "ALIBABA" trade marks, considering that the Complainant filed complaints for the recovery of about thirteen infringing domain names in 2011 and over 50 of such complaints in 2014. The Complainant is thus aware that a large number of infringers do try and anticipate the Complainant's new ventures and register domain names, which incorporate its "ALIBABA" trade marks with a view to selling such domain names to the Complainant or its competitors.

The Respondent

4.5 The Respondent did not file a Response to the Complaint within the required timeframe as stipulated and has therefore not denied any of the allegations of the Complainant.

5. Findings

Upon considering all the documentary evidence provided by the Complainant and the Respondent not responding to these proceedings the Panel shall decide the complaint on the basis of the statements and documents submitted in accordance with the UDRP policy and rules. 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 / Confusingly Similar

1.1) This Panel finds that the Complainant has undoubtedly established long standing and extensive intellectual property rights in the "ALIBABA" trade marks in numerous jurisdictions around the world including China where the Respondent is domiciled. The numerous trade mark certificates attached to these proceedings attest to this uncontested fact. See also in support a recent decision in *Alibaba Group Holdings Limited v. Liu Xiao BO; Lingping*, HK-1400677. The Panel is also satisfied that a comparison of the disputed Domain Name <ALIBABA-INC.ORG> with the Complainant's trade marks confirms the disputed Domain Name is clearly confusingly similar to the Complainant's trade marks and indeed the Complainant's numerous other domain names as exhibited in annexure 4, attached to the case file in these proceedings.

1.2 The Panel therefore finds further that the disputed Domain Name wholly incorporates the Complainant's trade mark "ALIBABA" and as argued by the Complainant, the inclusion of the generic suffix "-inc" and the addition of the domain extension <.org> does absolutely nothing to preclude a confusing similarity finding. See previous UDRP decisions such as *Kabushiki Kaisha Toshiba d/b/a/ Toshiba Corporation v. Distribution*

Purchasing & Logistics Corp., supra and *Rohde & Schwarze GmbH & Co. HG v. Pertshire Marketing, Ltd., supra.*

1.3 Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

2) Rights and Legitimate Interests

2.1 On the question of rights and legitimate interests, the Panel without any hesitation finds that the Respondent is not a licensee of, or authorized dealer of, or is it in any way affiliated to the Complainant such as to conclude that the Respondent has any rights or legitimate interests in respect of the disputed Domain Name. Clearly, the Complainant's extensive use and registration of the "ALIBABA" trademarks predates the Respondent's registration of the disputed Domain Name in June 2013 by fourteen years or more. In line with *PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor, supra*, the burden of proof is on the Respondent to establish the Respondent's rights or legitimate interests in the disputed Domain Name. In arriving at this conclusion, the Panel observes that the Respondent has failed to provide any evidence that the Respondent has been making a *bona fide* use of the disputed Domain Name in connection with the offering of goods or services or has been making a legitimate non-commercial or fair use of the disputed Domain Name. On the contrary, the evidence proffered by the Complainant demonstrates that the disputed Domain Name remains currently inactive but in the recent past resolved to a very basic website with limited and unrelated material. Such unauthorized usage cannot be described as a *bona fide* offering of goods and services nor a legitimate non-commercial or fair use of the disputed Domain Name. See generally, *Oki Data Americas Inc. v. ASD Inc.*, WIPO Case No. D2001-0903. As submitted by the Complainant the Respondent has only registered the disputed Domain Name with the clear intention to sell same for commercial gain, the Panel finds such registration with the clear intention to sell for commercial gain as clearly evidenced by an email emanating from the Respondent demanding the sum of US\$100,000 for the disputed Domain Name, cannot by any stretch of imagination amount to a right and or legitimate interest in respect of the disputed Domain Name.

2.2 Accordingly, the Panel finds that the Respondent has satisfied the elements of paragraph 4(a)(ii) of the Policy.

3) Bad Faith

3.1 With regards to the question of bad faith registration and use, the Panel again has found no difficulty in concluding that the Respondent registered the disputed Domain Name in bad faith and engaged in continued bad faith use. The Panel in arriving at this conclusion has taken a number of unchallenged factors into account as follows.

3.2 Firstly, considering the worldwide fame and reputation of the Complainant's trade marks including in China where the Respondent is domiciled, the Respondent must have known or ought to have known of the Complainant's prior and exclusive rights in the "ALIBABA" trade marks dating back to 1999. According to the updated WHOIS record attached to these proceedings the Respondent elected to register the disputed Domain Name on 20 June 2013, the Panel therefore concludes that the Respondent registered the disputed Domain Name with the full knowledge of the Complainant's prior exclusive

rights with the intention of exploiting the Complainant's worldwide reputation and goodwill. See in this regard, *Arena Pharmaceuticals GMBH v. Qi Fei Gao*, Case No. DHK-1300094.

3.3 Secondly, the fact that the Respondent's primary motive for registering the disputed Domain Name was to sell the disputed Domain Name for considerable profit is clear evidence of bad faith registration and use. The Respondent in an email dated 05 March 2015 demanded the extremely high asking price of US\$100,000 for the disputed Domain Name, which said amount is undoubtedly in excess of the Respondent's out of pocket expenses. See in support, similar findings made in relation to another respondent's similar commercial intentions with regards to a disputed Domain Name <taobao.holdings> in the recent case of *Alibaba Group Holding Limited v. Rebecca Kovan*, HK-1400594.

3.4 Thirdly, the Respondent with full knowledge of the Complainant's prior extensive rights which a simple search in any trade mark registry could have revealed, in any event, failed or omitted to seek the permission of the Complainant to register and use the disputed Domain Name contrary to the decision in *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., supra*. Whilst on this factor the Panel also finds that the fact that the disputed Domain Name has remained inactive does not negate a finding of bad faith registration and use, particularly, when considered alongside other factors as discussed above and below, following *Alibaba Group Holding Limited v. Liu Xiao Bo; Lingping, supra*.

3.5 Fourthly, the Panel has invariably, drawn adverse inferences from the Respondent's failure and or refusal to respond to this complaint.

3.6 The Panel is therefore satisfied that the Complainant has established the essential elements of Paragraph 4(a)(iii) of the Policy.

6. Decision

6.1 For the foregoing reasons and in accordance with Paragraphs 4(1) of the Policy and 15 of the Rules, the Panel directs that the disputed Domain Name <ALIBABA-INC.ORG> be transferred to the Complainant, ALIBABA Group Holding Limited forthwith.

Ike Ehiribe

Dated: 28 April 2015