



ADMINISTRATIVE PANEL DECISION

Case No.	HK-1901303
Complainants:	Transsnet (Shenzhen) Limited; Tecno Telecom (HK) Limited
Respondent:	Paul Shtoler
Disputed Domain Name:	<boomplay.com>

1. The Parties and Contested Domain Name

Complainant 1 is Transsnet (Shenzhen) Limited, of Room 2401-2402, 24th floor, Unit B2, Building No.9, Shenzhen Bay Eco-Technology Park Baishi Road, Yuehai Street Nansha, Shenzhen, China; Complainant 2 is Tecno Telecom (HK) Limited, of RMS 05-15, 13A/F South Tower World Finance CTR Harbour City, 17 Canton Road TST KLN, Hong Kong.

The Respondent is Paul Shtoler, of Nikoloyamskoy, Moskow, MS, Russian Federation Postal Code: 127001.

The domain name at issue is boomplay.com, registered by Respondent with NameCheap, Inc. of 4600 East Washington Street, Suite 33, Phoenix AZ 85034, United States.

2. Procedural History

On 5 November 2019, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On the next day, the ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee.

On 6 November 2019, the ADNDRC-HK informed NameCheap, Inc. (“Registrar”) of the Disputed Domain Name of the proceedings by email.

On 23 November 2019, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that Paul Shtoler is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“the Policy”) is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is English as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.

On 9 December 2019, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of the Respondent’s nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database). The Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 29 December 2019).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADRDRC-HK on 7 January 2020. The papers pertaining to the case were delivered to the Panel by email on the same day.

3. Factual background

According to the documents submitted by Complainants 1 and 2 (“Complainant”), TRANSSNET (SHENZHEN) LIMITED and its affiliated company TECNO TELECOM (HK) LIMITED constitute the Complainant in this case. The Complainant is subordinate to the TRANSSNET GROUP which is a joint venture between NetEase Group (NASDAQ: NTES), a world-leading Chinese Internet company, and Transsion Holdings Group, a global provider of intelligent terminals and mobile value-added services. According to information provided by the Complainant, it seeks to provide a variety of mobile Internet services to the African users from live streaming music, video-based social media, online news to payment service. As one of the first Chinese Internet companies to enter Africa, the Complainant has become one of the Internet enterprises with the biggest user base in Africa with an array of online applications, including Boomplay, amongst Africa's largest live streaming music platform, and Vskit, Africa's video-based social media platform.

According to the Complainant, Boomplay is a music and video streaming and download service developed by the Complainant. Boomplay's vision is to build the largest and most reliable digital music ecosystem for artistes and content creators in Africa. In 2016, the Complainant launched Boomplay APP on Google Play Store, which reached 29 million user registrations and 10 million installations and has gained high reputation among its users. In 2017, Boomplay won the “Best African APP” at “APPsAfrica Awards” in Cape Town. Boomplay which is considered as Africa's fastest growing music streaming and download platform has over 46 million users, compared to 6 million at the end of 2016 and boasts of over 400 thousand daily active users today.

To promote the Boomplay APP, the Complainant also has been advertising it on globally well-known social media platforms, such as Facebook and Linked in, and has over 1.2 million followers on Facebook.

According to the Complainant, through extensive use and continuous advertising, the Complainant and its BOOMPLAY mark enjoy a very significant and broad reputation among Internet users. The Complainant has registered the BOOMPLAY trademark in many countries, including, China, its place of incorporation; Morocco, Mozambique, its principal place of business; and Canada, United States, Mexico, Europe. A list of some of the Complainant's trademark registrations for BOOMPLAY is set out below:

No.	Trademark	Registration No.	Country	Holder	Application Date	Registration Date
1	Boomplay	TMA998671	Canada	TECNO TELECOM (HK) LIMITED	11/17/2016	6/11/2018
2	Boomplay	5444261	United States	TECNO TELECOM (HK) LIMITED	11/17/2016	4/10/2018
3	Boomplay	16052193	Europe	TRANSSNET (SHENZHEN) LIMITED	11/18/2016	3/6/2017
4	Boomplay	1793296	Mexico	TRANSSNET (SHENZHEN) LIMITED	5/24/2017	8/30/2017
5	Boomplay	1793297	Mexico	TRANSSNET (SHENZHEN) LIMITED	5/24/2017	8/30/2017
6	BOOMPLAY	21807345	China	TRANSSNET (SHENZHEN) LIMITED	11/7/2016	12/21/2017
7	BOOMPLAY	21807344	China	TRANSSNET (SHENZHEN) LIMITED	11/7/2016	12/21/2017
8	BOOMPLAY	21807342	China	TECNO TELECOM (HK) LIMITED	11/7/2016	6/28/2018
9	Boomplay	185316	Morocco	TECNO TELECOM (HK) LIMITED	6/7/2017	9/20/2017
10	Boomplay	2017034003	Mozambique	TECNO TELECOM (HK) LIMITED	6/29/2017	9/15/2017
11	BOOMPLAY	2017034004	Mozambique	TECNO TELECOM (HK) LIMITED	6/29/2017	9/15/2017

According to documents submitted by the Complainant, it also owns domain names that comprise of the BOOMPLAY trademark, including <boomplaymusic.com> registered on September 20, 2016 and <theboomplayer.com> registered on September 15, 2015). <boomplaymusic.com> has been continuously used as the Complainant's primary website and associated with the Complainant and its business since its registration. The associated website is accessible to Internet users all over the world, which enables the Complainant to promote the BOOMPLAY trademark and services globally.

The Respondent, Paul Shtoler of the Russian Federation registered the disputed domain name on 2 July 2013. The Respondent did not file a Reply with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant provides documentation showing that it owns numerous BOOMPLAY trademark registrations in various countries and the Complainant thus possesses rights in BOOMPLAY trademark.

The Complainant notes that <boomplay.com> consists of the term “boomplay” combined with the “.com” generic top-level domain (“gTLD”) and argues that it is a well-established principle that the generic top-level domain suffixes including “.com” would be disregarded in assessing the similarity between a disputed domain name and a mark in which a complainant has rights. See Pfizer Inc v. Michel Merts, WIPO Case No. D2005-0150. The dominant component of the disputed domain name is “boomplay”, completely identical to the Complainant’s BOOMPLAY trademark.

Finally, the Complainant argues that the Complainant’s BOOMPLAY trademark is a coined and highly distinctive trademark which will attract Internet users’ attention. Reproduction of the Complainant’s BOOMPLAY trademark in entirety in the disputed domain name itself establishes that the disputed domain name is confusingly similar to the Complainant’s trademark. See EA Auto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., WIPO Case No. D2000-0047, “When a domain name incorporates, in its entirety, a distinctive mark, that creates sufficient similarity between the mark and the domain name to render it confusingly similar”.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name:

The Complainant argues that it is a well-established principal that the mere registration of a domain name is insufficient for claiming rights or legitimated interests. The Respondent thus does not have rights or legitimate interests in respect of the disputed domain name merely because of registering it.

The Complainant further contends that Respondent is not sponsored by or affiliated with the Complainant in any way. The Complainant has never authorized or licensed the Respondent to use the BOOMPLAY trademark in any manner, including registering domain names incorporating the BOOMPLAY trademark.

Further, the Complainant notes that the disputed domain name resolves to an invalid website, which evidences that the Respondent cannot be commonly known in respect of the disputed domain name. WhoIs information further supports a finding that the Respondent is not commonly known by the disputed domain name, especially where a privacy service has been engaged by the Respondent.

Finally, Complainant argues that there is no indication that the Respondent demonstrated, before notice of the dispute, use of or demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, or that the Respondent is making legitimate noncommercial or fair use of the disputed domain name. The Respondent is passively holding the disputed domain name. Such use has not been considered by previous panels as a bona fide offering of goods or services, or a legitimate noncommercial or fair use without intent for commercial gain. See “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246, “The Panel further finds that the Respondent is neither making a bona fide offering of goods or services or a legitimate noncommercial or fair use of the Domain Name as the Domain Name is not resolving to an active website. Therefore, there is no actual evidence on record that the Domain Name was resolving to a website containing sponsored links, as suggested by the Complainants. The Panel nevertheless finds that, taking into account the overall circumstances of this case, the Respondent’s lack of use of the Domain Name is a strong indication of its lack of rights or legitimate interests in the Domain Name.”

In sum, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name pursuant to paragraph 4(c) of the Policy. As the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name, the burden of production shifts to the Respondent.

iii. The disputed domain name has been registered and is being used in bad faith:

On the bad faith issue, the Complainant contends that the Complainant’s BOOMPLAY trademark, through continuous and extensive use in connection with Internet services, is widely known by Internet users. According to WhoIs information submitted by the Complainant, the disputed domain name was registered on July 2, 2018, later than the Complainant’s registrations of BOOMPLAY trademark.

The Complainant further argues that the Complainant’s Boomplay APP experienced a rapid development during 2017 to 2018, which enables the Complainant and its BOOMPLAY trademark to widely spread to all over the world. In 2019, users of the Complainant’s Boomplay APP have increased to 43 million. A simple search via Baidu and Google search engines using the keyword “BOOMPLAY” reveals that an exclusive connection has been built up between the Complainant and its BOOMPLAY trademark.

Further, the Complainant argues that its BOOMPLAY trademark is a coined and highly distinctive trademark. It is impossible that the Respondent registered the disputed domain name by coincidence without any awareness of the Complainant and its BOOMPLAY trademark.

The Complainant further points out that no Plausible explanation exists as to why the Respondent selected the trademark BOOMPLAY as part of the disputed domain name other than to exploit the goodwill of the Complainant and the BOOMPLAY trademark to make illegitimate interests. See Alstom v. Yulei, WIPO Case No. D2007-0424, “[T]he Panel finds that it is not conceivable that the Respondent would not have had actual notice of the Complainant’s trademark rights at the time of the registration of the domain name. Consequently, in the absence of contrary evidence from the Respondent, the Panel finds that the ALSTOM trademarks are not those that traders could legitimately adopt other than for the purpose of creating an impression of an association with the Complainant.”

Finally, the Complainant notes that the disputed domain name is not being actually used. The Respondent resolves the disputed domain name to an invalid website, which means that the Respondent has intention to passively hold the disputed domain name and prevent the Complainant from reflecting its BOOMPLAY trademark through the disputed domain name. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; McDonald’s Corporation v. Easy Property, WIPO Case No. D2006-1142.

B. Respondent

The Respondent’s contentions may be summarized as follows:

The Respondent did not submit a reply.

5. 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 is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent’s domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The Complainant has established its right to the “BOOMPLAY” trademark by submitting trademark registration certificates and records in a number of jurisdictions including in China. The disputed domain name <boomplay.com> contains two elements: "BOOMPLAY" and the top-level domain ".com". Numerous precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. See Abt Electronics, Inc. v. Gregory Ricks, FA 904239 (Nat Arb. Forum Mar. 27, 2007) ("The Panel also finds that Respondent’s <abt.com> domain name is identical to Complainants ABT mark since addition of a generic top-level domain ('gTLD') is irrelevant when conducting a Policy ¶ 4(a)(i) analysis."); see also Jerry Damson, Inc. v.

Tex. Int’l Prop. Assocs., FA 916991 (Nat. Arb. Forum Apr. 10, 2007) (“The mere addition of a generic top-level domain ('gTLD') '.com' does not serve to adequately distinguish the Domain Name from the mark.”).

The only distinctive part of the disputed domain should be "boomplay", which is identical to the Complainant's "BOOMPLAY" trademark. This striking resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant. The Disputed Domain Name incorporates the Complainant's BOOMPLAY Mark in its entirety.

There is no doubt that the Disputed Domain Name < boomplay.com > completely incorporates the Complainant's “BOOMPLAY” trademark which is the distinctive part of the Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

The Panel elects not to provide an analysis of the second element required under the Policy, because, as explained below, the Panel finds that Complainant has not satisfied the third element.

C) Bad Faith

In determining whether the Respondent has registered or used the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) 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."

According to information provided by the Registrar, Respondent registered the disputed domain name in 2013, and Complainant's earliest registration of its trademark was in 2017. In its Complaint, apart from establishing that it first launched the Boomplay APP on the Google Play Store in 2016, which reached 29 million user registrations and 10 million, and registration of <theboomplayer.com> in 2015 Complainant furnishes no evidence that it achieved a secondary meaning, or resulting common law rights with respect to its trademark before 2013. Thus, there is no reason for the Panel to believe that Complainant had acquired any defensible rights in its trademark prior to registration of the disputed domain name. Many UDRP panels have found such circumstances to prohibit any possible finding of bad faith registration of a disputed domain name. The Panel finds itself compelled to adhere to this reasoning, especially since the registration of the disputed domain name in this case precedes the registration of the operative trademark by more than five years. See Telecom Italia S.p.A. v. NetGears LLC, FA 944807 (Nat. Arb. Forum May 16, 2007) (determining the respondent could not have registered or used the disputed domain name in bad faith where the respondent registered the disputed domain name before the complainant began using the mark); see also MediaSpan Group, Inc. v. Rajagopalan, D2005-1282 (WIPO Feb. 20, 2006) ("As a general rule, when a domain name is registered before any trademark rights are established, the registration of the domain name is not in bad faith since the registrant could not have contemplated the complainant's non-existent right.")

Therefore, the Panel rules that Complainant has not satisfied the third element required under the Policy.

6. Decision

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be DENIED.

Accordingly, it is Ordered that the <boomplay.com> domain name REMAIN WITH Respondent.



Dr. Shahla F. Ali
Panelist

Dated: 9 January 2020