



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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### Decision Submission

[English](#)
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Version  
 Decision ID DE-0800180  
 Case ID HK-0800213  
 Disputed Domain Name www.沃尔玛.com  
 Case Administrator Dennis CAI  
 Submitted By Yun Zhao  
 Participated Panelist

Date of Decision 11-12-2008

Language Version : English

### The Parties Information

**Claimant** (1) : Wal-Mart Stores, Inc. (2): Wal-Mart China Co. Ltd.

**Respondent** Chiu Tien Fu

### Procedural History

On 26 September 2008, the Complainants submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 6 October 2008, the ADNDRC sent to the complainants by email an acknowledgement of the receipt of the complaint. All correspondence to and from the ADNDRC described herein was in the English language.

On 6 October 2008, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On 10 October 2008, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. On 15 October 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action and requested the Respondent to submit a Response within 20 calendar days. On 28 October 2008, the Respondent requested extension of the deadline for the Response. On the same date, the Complainant objected the request. After reviewing the opinion from both parties, the ADNDRC transmitted by email on 30 October 2008 notifying both parties of the extension of filing a Response to 18 November 2008. The Respondent submitted a Response on 18 November 2008. On 26 October 2008, the ADNDRC confirmed the receipt of the Response and transmitted the Response to the Complainant.

Since the Respondent also elected a one-person panel, the ADNDRC informed the Complainants and Respondent that the ADNDRC would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the Panel in this case had been selected, with Dr ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules. On 6 December 2008, the Panel received the file from the ADNDRC and should render the Decision within 14 days.

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

### Factual Background

#### For Claimant

There are two Complainants in this case. The 1st Complainant is Wal-Mart Stores, Inc., a corporation registered in the United States. The registered address is 702 S.W. 8th Street, Bentonville, Arkansas 72716-0520, United States of America. The 2nd Complainant is Wal-Mart China Co. Ltd. The registered address is 12/F, Tower 3, SZITIC Square, 69 Nonglin Road, Futian District, Shenzhen, Guangdong Province 518040, China. The 2nd Complainant is and was an affiliate of the 1st Complainant. Both Complainants shall be referred to in this Complaint as "the Complainant".

### For Respondent

The Respondent, Chiu Tien Fu, is the current registrant of the disputed domain name <沃尔玛.com> according to the Whois information. The registered address is 200 Garfield Avenue, Alhambra, CA 9801, United States of America.

### Parties' Contentions

#### Claimant

The Complainant is the world's largest and most well-known retailer and the operator of "WAL-MART" department stores worldwide under the WAL-MART trademark. The first WAL-MART store was opened in Rogers, Arkansas, USA in 1962. Since 1962 the Complainant's business and the number of WAL-MART stores has grown exponentially worldwide. The Complainant has been listed as the number one Fortune 500 company every year from 2002 until 2008, with the exception of 2006 when the Complainant placed second on the Fortune 500 list. The Complainant currently operates more than 6,800 stores and employs more than 1.9 million employees worldwide. The Complainant exceeded US\$374 billion in global sales in the 2007-2008 US financial year. More than 180 million customers per week visit the Complainant's stores worldwide.

The Complainant owns and operates WAL-MART department stores in China under the Wal-Mart Trade Mark and the 沃尔玛Trade Mark. The Complainant is the largest and most well-known retailer in Guangdong Province, China and one of the largest and most well-known retailers throughout China. The Complainant opened the first 沃尔玛 store in Shenzhen, China in 1996. Since 1996, the number of 沃尔玛stores in China has grown exponentially. The Complainant currently operates 99 Supercenters, 3 Sam's Clubs, 2 Neighborhood Markets and 101 Trust-Mart Hypermarkets in 15 provinces and employ over 83,000 employees in China. The Complainant procures the majority of goods sold in its 沃尔玛 stores in China from Chinese suppliers. In addition to operating 沃尔玛stores in China, the Complainant sources a substantial amount of its global retail products from China via the Wal-Mart Global Procurement Center.

The Complainant has registered numerous domain names worldwide comprising the trademark and operates its various "WAL-MART" and "沃尔玛" websites which are accessible via the Internet worldwide and to which these domain names resolve.

The trademark "WAL-MART" is one of the most well-known trade marks in the world and in China. The trademarks are invented trademarks associated by members of the public worldwide solely with the Complainant and its famous business. The 沃尔玛Trade Mark has been recognized as a "famous" trade mark in China. The Complainant spends in excess of US\$1 billion annually on advertising and promotional expenses worldwide.

1. The Disputed Domain Name is identical with or confusingly similar to the Complainant's Marks in which the Complainant has rights

The Complainant has numerous registrations for the trademark and its registrations are valid and subsisting and serve as prima facie evidence of its ownership and the validity of the trademarks. The Respondent's registration of the disputed domain name postdates the Complainant's registration priority dates for the trademark. The disputed domain name comprises the word "沃尔玛" in its entirety, which is identical or confusingly similar to the trademark. 沃尔玛is the Chinese phonetic equivalent of Wal-Mart. 沃尔玛is how the Wal-Mart Trade Mark is written in Chinese characters and pronounced in the Chinese language. Accordingly, the disputed domain name comprising the word "沃尔玛" is also confusingly similar to the Wal-Mart Trade Marks. The use of the TLD ".com" is not sufficient to negate the confusing similarity between the disputed domain name and the Trade Mark.

2. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name

The Respondent does not hold any registered trademark rights in respect of the trademarks. The Complainant has conducted registration searches in all classes via the online trade mark search engines, the search result did not reveal any registrations by the Respondent for any "WAL-MART" or "沃尔玛" trademarks in Hong Kong, China or the USA at all. The Complainant has prior rights in the Trade Marks, which precede by many years the Respondent's registration of the disputed domain name. The Complainant operates under the trademark in over 15 countries and is extremely well-known throughout the world. The Respondent could not therefore have been in ignorance that trademark rights were vested in the trademark, and that any use of the same without the consent of the trademark owner is prohibited. The Complainant has not authorized, licensed, endorsed or otherwise permitted the Respondent to register or use the disputed domain name or to use the trademark in relation to its business as a business name or otherwise. The Complainant has not in any way acquiesced to the Respondent's registration or use of the disputed domain name or the use of the Complainant's trademark or similar marks in relation to the Respondent's business or otherwise.

The Respondent's use of the trademark, or confusingly similar marks, is infringing. Such unlawful use of the disputed domain name <https://www.adndrc.org/icann/icase.nsf/fa40f875614a7ea348256b10002b5cff/365971...> 12/11/2008

cannot be considered bona fide. The trademark is an invented word, and as such are not words traders would legitimately choose unless seeking to create an impression of an association with the Complainant. The disputed domain name does not reflect the Respondent's common name. There is no evidence that the Respondent has ever had any bona fide interest in establishing any legitimate business or activities under the disputed domain name or any variant thereof. There can be no valid suggestion that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name. The evidence establishes clearly that the disputed domain name is not being used at all. Finally, it is well established that, where the Complainant contends the Respondent has no rights or legitimate interests in a disputed domain name, the burden of proof shifts to the Respondent to come forward with proof to the contrary. Absent a showing to the contrary by the Respondent, the Complainant has therefore established that the Respondent has no rights or legitimate interests in the disputed domain name.

### 3. The Disputed Domain Name was registered and is being used by the Respondent in bad faith

(1) The Complainant is famous worldwide, and the trademarks are used globally to designate the Complainant's products. The trademarks carry substantial goodwill throughout the world and in Greater China and the USA. It is inconceivable that the Respondent did not have knowledge of the trademarks before the registration. Such knowledge of the Complainant's rights and the Respondent's blatant willingness to profit therefrom underscores the Respondent's bad faith registration and use of the disputed domain name. Registration of a domain name containing a famous mark is strong evidence of bad faith.

(2) The Respondent has not made any use of the disputed domain name. Passive use of a domain name amounts to use of the domain name in bad faith. Such use is not a bona fide offering of goods or services, nor a legitimate non-commercial or fair use of the disputed domain name.

(3) The Respondent has no prior right to the trademark and no authorization from the Complainant to use the trademark in any form. Thus, the registration was not made with a bona fide intention.

(4) In the present case, in all the circumstances, the Complainant contends that it can be reasonably concluded that the Respondent registered the disputed domain name for the purpose of selling, renting or otherwise transferring the disputed domain name to the Complainant, who is the owner of the trademarks, or to a competitor of the Complainant, or other third party.

(5) The Respondent has expressly represented in the Registration Agreement, warranted and guaranteed, inter alia, that neither the registration of the disputed domain name nor the manner in which it is used directly or indirectly infringe the legal rights, including, but not limited to the rights of trade names, trademarks and domain names, of any other parties.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainant requests the Panel to issue a decision to transfer the Disputed Domain Name to the Complainant.

### Respondent

The Respondent is willing to donate the domain name to the Complainant (free of charge) if the Complainant really needs the domain name, however, the Respondent hopes that the decision will be fair and just, and not because the Complainant is a large company.

(1) The domain name is not identical or confusingly similar to a trademark or service mark in which the Complainant has rights. <沃尔玛.com> is an information website; it is neither a store nor is it a product, everyone knows what is .com; Wal-Mart is a store and it sells products; <沃尔玛.com> does not equal to Wal-Mart Stores; the Complainant has no 沃尔玛 trademark in USA, the domain name was registered in USA.

(2) The Respondent has rights or legitimate interests in respect of the domain name. Before any notice to the Respondent of the dispute, the domain name has been constructed a website for more than two years; <沃尔玛.com> started to use Hangzhou 365 Network Limited's DNS servers to construct website since 2006, the DNS servers are dns1.365.com, etc. <沃尔玛.com> is a classified information legitimate website and a formal legal website. The Respondent legally registered the domain and is the legitimate holder and has legal right to hold and use <沃尔玛.com>. after two years of use and promotion, <沃尔玛.com> has been commonly known; 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. Everyone can search for ownership of any domain name at whois database, <沃尔玛.com>'s owner is the Respondent.

(3) The domain name has been registered and is being used in good faith. The Complainant did not put forward any evidence to prove that the Respondent has registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or anyone; <沃尔玛.com> is a classified information website to provide a variety of information services. After two years' promotion and maintenance, the website has many visitors, a lot of people know the domain name. As a result, the Respondent has the rights and legitimate interests of the domain name, the Complainant has no right to deprive the Respondent's rights and legitimate interests. Further, the Respondent is planning to use <沃尔玛.com> to construct a charitable website.

The Respondent requests the Panel to dismiss the Complaint.

### Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the

- Complainant has rights; and  
 2) the Respondent has no rights or legitimate interests in respect of the domain name; and  
 3) the domain name has been registered and is being used in bad faith.

### Identical / Confusingly Similar

The Complainant, first established in 1962, is one of the largest retailers worldwide. The evidence submitted by the Complainant shows that the Complainant has registered the trademark "WAL-MART" worldwide since 1962. The evidence also shows that the Complainant has obtained the trademark "沃尔玛" registration in China as early as of 1994. The Panel finds that the Complainant enjoys the indisputable prior rights and interests in the trademark "沃尔玛". The Policy does not require the registration of trademarks in all jurisdictions for the protection of such rights. In this case, the registration of the trademark "沃尔玛" in China alone (not in the USA) would suffice to establish the Complainant's rights and legitimate interests in the trademark. The disputed domain name is "沃尔玛.com". As the suffix ".com" only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel has no problem in finding that the disputed domain name <沃尔玛.com> is identical to the Complainant's trademark "沃尔玛".

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

### Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant's assertion is sufficient to establish a prima facie case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

No evidence shows that the Respondent has acquired any trademark rights or other proprietary interests relevant to support its claim to the disputed domain name. The Respondent submitted that he legally registered the disputed domain name and is the legitimate holder of the disputed domain name and has legal right to the domain name. This submission is not justified. The registration of a certain domain name does not of itself confer upon the registrant rights or legitimate interests in the domain name or in the subject matter of the domain name. The Panel is not convinced by the submission that the domain name has been commonly known and the Respondent is making a legitimate non-commercial or fair use of the domain name. No evidence has been submitted for the above submission. The disputed domain name might have become commonly known not because of the Respondent's use and promotion, but because of the name and activities of the Complainant. As stated in the Response, the Respondent clearly knows the existence of the Complainant and that the Complainant is a large company. The Panel believes that the Respondent who has actual knowledge of the Complainant and its trademark has no right or legitimate interests to register a domain name that is identical to the Complainant's trademark.

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

### Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use 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 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 website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant has been continuously using the trademark "WAL-MART" since 1962 and "沃尔玛" in China since 1994. "沃尔玛" is not a name commonly used in trade. Through years of use and promotion, the Complainant's trademark "沃尔玛" has achieved a strong reputation. It is indeed one of the largest and well-known retailers worldwide. As such, the public has come to recognize and associate the Complainant's trademark "沃尔玛" as originating from the Complainant and no other. The fact that the website of the disputed domain name contains the trademark "沃尔玛" is obvious to all that the Respondent is aware of the existence of the Complainant and its trademark. The action of registering the disputed domain name per se has constituted bad faith. The Panel is not convinced by the Respondent's submission that the website is a classified information website and plans to construct a charitable website. No evidence has been submitted concerning the plan of a charitable website to substantiate the submission. Actually, it is impossible to conceive of any plausible active use of the disputed domain name by the Respondent that would not be illegitimate.

The Panel concludes that the Respondent has registered and used the domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

**Status**

www.沃尔玛.com

Domain Name Transfer

**Decision**

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <沃尔玛.com> domain name should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun  
Sole Panelist

DATED: 8 December 2008