



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

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### Decision Submission

[English](#)
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Version	
Decision ID	DE-0900205
Case ID	HK-0800221
Disputed Domain Name	www.沃尔玛超市.net
Case Administrator	Dennis CAI
Submitted By	Hong Xue
Participated Panelist	

Date of Decision 12-03-2009

Language Version : English

#### The Parties Information

<b>Claimant</b>	(1) Wal-Mart Stores, Inc. (2) Wal-Mart China Co., Ltd.
<b>Respondent</b>	Ningbo Haishu Old Northeast Eatery Co., Ltd.

#### Procedural History

On 13 November 2008, the Complainants submitted its Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”), in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the “Rules”), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the “ADNDRC Supplemental Rules”).

On 13 November 2008, the Centre confirmed the receipt of the Complaint. To confirm the registration information, the Centre forwarded a copy of the Complaint on 13 November 2008 to the Registrar Web Commerce Communications Limited.

On 13 November 2008, the Centre received the Registrar’s confirmation of registration information of the domain name in dispute.

On 5 December 2008, the Centre notified the Complainants that the Complaint had been confirmed and forwarded, and; the Centre notified the Respondent, the Registrar and the ICANN of the commencement of the case proceeding.

On 30 December 2008, the Centre notified the Complainants that the Response was not received within the required period of time.

On 26 February 2009, the Centre informed the Complainant and the Respondent of the appointment of Ms. Hong Xue as the Sole Panelist, and transferred the case file to the Panel by email. The decision for the captioned domain name dispute shall be rendered by the Panel by 12 March 2009.

The Panel finds that it was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

The Panel does not receive any further requests from the Complainant or the Respondent regarding other submissions, waivers or extensions of deadlines.

The language of the proceeding is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to paragraph 11(a) of the Rules, and also in consideration of the fact that there is no express agreement to the contrary by the Parties.

## **Factual Background**

### **For Claimant**

The two Complainants operate retailing business and own the trademark “Wal-Mart” and “沃尔玛”.

### **For Respondent**

The Respondent registered the domain name in dispute “沃尔玛超市.net” on 21 August 2006.

## **Parties' Contentions**

### **Claimant**

The Complainants assert their trademark rights over “Wal-Mart” and “沃尔玛” based on registration and use in China and other countries. Since the openness of the first store in 1962, the first Complainant currently operates more than 6800 stores in several countries. The second Complainant has been operating stores in China since 1996. The Complainants have registered a couple of domain names that are corresponding to their trademark “Wal-Mart” or “沃尔玛”. The Complainants assert that the trademark “Wal-Mart” is well known in the world and the trademark “沃尔玛” is famous in China.

The Complainants claim that the disputed domain name registered by the Respondent is identical with or confusingly similar to the trademarks that the Complainants have right; the Respondent has no right or legitimate interest in respect of the disputed domain name; and, the disputed domain name was registered and passively held by the Respondent in bad faith.

Complainant requests that the domain name be transferred from Respondent to the first Complainant.

### **Respondent**

The Respondent did not submit the response.

## **Findings**

Under the paragraph 4 (a) of the Policy, a domain name holder is required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The domain name holder has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove each of these three elements present.

## Identical / Confusingly Similar

Pursuant to paragraph 4(a) (i) of the Policy, a complainant must prove that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

The domain name in dispute is <沃尔玛超市.net>. Apart from the gTLD suffix ".net" that has no relevant distinguishing function, the domain name registered by the Respondent is “沃尔玛超市”.

The first Complainant claims that “沃尔玛” is both the Chinese transliteration of its world famous trademark “Wal-Mart” and its registered trademark in China. The second Complainant is licensed by the first Complainant to use the mark “沃尔玛”.

The Panel compares the disputed domain name with the Complainants’ trademark “沃尔玛” and finds that the only difference lies in the term “超市”, meaning “supermarket”, contained in the disputed domain name.

It’s been well established by the decisions made in accordance with the Policy that addition a generic word to the complainant’s mark in a disputed domain name does not preclude the findings of a finding of confusing similarity; where the word added relates to the complainant's business, it is even more likely to find confusing similarity to the complainant’s mark (See L.F.P., Inc v. Hotpics International, NAF Case No. FA0204000109576; Marriott International, Inc. v. CafÈ au lait, NAF Case No. FA0002000093670).

Since the Complainants operate the supermarkets in China and many other countries and the Complainants’ supermarkets operating in China are named as “沃尔玛超市”, the disputed domain name is confusingly similar to the Complainants’ trademark “沃尔玛”. The Panel finds that the paragraph 4(a) (i) of the Policy is proven by the Complaint.

## Rights and Legitimate Interests

The Complaints assert that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, as stated above, the Respondent has provided no information to the Panel asserting any right or legitimate interest it has in the disputed domain name.

A number of panels have held that the burden on a complainant regarding the second element is necessarily light, because the nature of the registrant’s rights or interests, if any, in the domain name lies most directly within the registrant’s knowledge (See Packaging World Inc. v. Zynpak Packaging Products Inc., NAF Case No. AF-023; Education Testing Service v. TOEFL, WIPO Case No. D2000-0044; Grove Broadcasting Co. Ltd. v. Telesystems Communications Ltd., WIPO Case No. D2000-0158). Other panels have held that once the complainant makes a prima facie showing that the registrant does not have rights or legitimate interest in the domain name, the evidentiary burden shifts to the registrant to rebut the showing by providing evidence of its rights or interests in the domain name (See Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party, WIPO Case No. D2000-1415; Inter-Continental Hotels Corporation v. Khaled Ali Soussi, WIPO Case No. D2000-0252; Electronic Commerce Media Inc. v. Taos Mountain, NAF Case No. AF0008000095344).

It is apparent from the Complaints that there is no connection between the Respondent and the Complainants or their business. Paragraph 4(c) of the Policy lists a number of circumstances which, if proven to exist by the Respondent, can be taken to demonstrate a Respondent’s rights or legitimate interests in the domain name. However, there is no evidence whatsoever before the Panel that any of the situations described in paragraph 4(c) of the Policy applies in the case of the Respondent.

Although it is possible that Respondent does have some legitimate interest in respect of this domain name, given that the Respondent’s failure to submit a Response and the fact that the disputed domain name contains both the Complainants’ trademark “沃尔玛” and the word that describes the Complainants’ business “超市”, it is not unreasonable for the Panel to infer a lack of legitimate interest. The lack of a Response constrains the Panel to draw the inference otherwise, and any resulting prejudice to Respondent is a result of its own failure to comply with the Rules.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Accordingly, the Complainant has proven paragraph 4(a)(ii) of the Policy.

## Bad Faith

When the disputed domain name was registered in 2006, the Complainants’ Wal-Mart Supermarkets (沃尔

玛超市) had been operating in China for almost ten years and the trademark “沃尔玛” had been registered with the Chinese trademark authority. In 2004, the Complainants’ mark “沃尔玛” was held by a Chinese court as well-know mark. The evidence provided by the Complainants sufficiently proves both the reputation of the Complainants’ mark and the knowledge of the Respondent in respect of the Complainants’ trademark and business. Although the Respondent does not put the disputed domain name in actual use since its registration, the Panel finds that the Respondent’ s passive holding of the disputed domain name constitutes the evidence of bad faith.

Passive holding is held sufficient under Policy 4(a)(iii) only if a mark enjoys strong reputation, and the respondent fails to respond, fails to provide evidence of good-faith use, or other conduct or circumstances cast doubt that the domain name is "used" in good faith (See Sinteplast S.A. v. Pablo Pablo, d/b/a P.S., WIPO Caso No. D2000-0815 [the panel determined that the fact that Respondent registered domain name identical to well-known mark of which he had knowledge, did not show any good faith registration and good faith use, committed unfair competition, and was in default, constituted bad faith use]; Banco do Brasil S.A. v. Sync Technology, WIPO Case No. D2000-0727 [the panel determined that the fact that Respondent slavishly copied Complainant's internationally known mark, deprived Complainant from legitimately reflecting its mark in a corresponding domain name, defaulted in the proceeding, and that the inactivity of the website might cause the public to believe that Complainant is not present on web, constitutes bad faith use.]

In the present case, the Complainants’ trademark has a strong reputation in China and other countries and the Respondent fails to provide any evidence whatsoever of any actual or contemplated good faith use by it of the domain name. Taking into account all of the above circumstances, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainants’ rights under trademark law (See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The Panel therefore finds that the Complainant has proven paragraph 4(a)(iii) of the Policy.

## Status

www.沃尔玛超市.net          Domain Name Transfer

## Decision

The Complainant has established each of the three requirements set forth in the Policy paragraph 4(a). In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel therefore directs that the registration of the disputed domain name be transferred from the Respondent to the first Complainant.

Sole Panelist: Hong Xue

Dated: 12 March 2009