



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

HONG KONG OFFICE

ADMINISTRATIVE PANEL DECISION

CASE NO: HK-1100361
COMPLAINANT: ALIBABA GROUP HOLDING LIMITED
RESPONDENT: DIGITAL DOMAINS MEPE

1. The parties and contested domain name

The Complainant is Alibaba Group Holding Limited, a company incorporated in the Cayman Islands, British West Indies and represented by Hogan Lovells, Solicitors, Hong Kong.

The Respondent is Digital Domains MEPE, of Greece, represented by Konstantinos Zournas, of Athens, Greece.

The contested domain name is <alibaba.info>, registered with Fabulous.com Pty Ltd

2. Procedural history

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (“the Centre”) on May 12, 2011. On May 16, 2011, the Center transmitted by email to Fabulous.com Pty Ltd a request for registrar verification in connection with the disputed domain name. On May 17, 2011, Fabulous .com Pty Ltd transmitted by email to the Centre its verification response that the Respondent was the registrant.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 19, 2011. In accordance with the Rules, paragraph 5(a), the due date for Response June 08, 2011. The Response was filed with the Centre on June 08, 2011.

The Center appointed M. Scott Donahey, Zhao Yun and The Honourable Neil Anthony Brown QC as panelists in this matter on June 29, 2011. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

3. Factual Background

The Complainant is an international company incorporated in the Cayman Islands, British West Indies and based in China. Although the Complaint does not say so, the Panel assumes that it is a member of the Group of Companies known as Alibaba. Another member of the group, Alibaba.com Limited has been listed on the Hong Kong Stock Exchange since November 2007. The Group is large and successful and operates in the "business to business" ("B2B") field, largely through the internet and principally in Asia.

The Complainant is the registered owner of a series of trademarks for ALIBABA registered in the Peoples' Republic of China and internationally and which have been in use since December 1998.

The Respondent registered the disputed domain name on November 26, 2004.

4. Parties' Contentions

(a) Complainant

The Complainant makes the following contentions:

1. The disputed domain name is identical or confusingly similar to trade and service marks in which the Complainant has rights. That is so because the disputed domain name incorporates the Complainant's ALIBABA trade mark in its entirety and the domain name extension <.info> should be disregarded.
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name. That is so because the Complainant's adoption and use of the ALIBABA trademark in the domain name shifted the burden of proof to the Respondent, a burden that had not been discharged, there was no connection between the disputed domain name and the Respondent's name, the Complainant had not consented to or authorized the use of the ALIBABA mark on the Respondent's pay-per-click website, it was inconceivable that the Respondent was not aware of the famous ALIBABA mark when it registered the domain name and it must be presumed to have done so to take advantage of the mark. Moreover, the Respondent had not used the disputed domain name in connection with any bona fide offering of goods and services or made any other legitimate commercial use of it. Indeed, the Respondent had used the site as a parking page featuring sponsored links including one to the Complainant's own website. Although at the time of first setting up the website the Respondent has used the expression Ali Baba as it referred to the fictional character, in 2008 the Respondent had changed the spelling of the name to "alibaba" as a single word, identical to the Complainant's trademark. The Respondent is experienced in domain name matters having been involved in many proceedings under the UDRP, thus enabling the conclusion to be drawn that he had engaged in a subterfuge to conceal his illegitimate use of the disputed domain name. The Respondent's use of the domain name to point to a website containing sponsored links is neither use for the *bona fide* offering of goods or services or a legitimate non-commercial use and is likely to encourage internet users to assume that the site is associated with the Alibaba Group.
3. The disputed domain name has been registered and is being used by the Respondent in bad faith. That is so because the Respondent does not have any legitimate right or interest in the disputed domain name, it must have been aware of the Complainant's prior rights and interest in it which amounts to *mala fides*, the website is predominantly in the Chinese language or directed to consumers in China, showing a dishonest attempt to attract traffic to it in the mistaken belief by internet users that it is associated with the Complainant's business. Moreover, the Respondent derives income from the advertisements and links on the website, responded to an anonymous offer to buy the domain name by asking for the excessive sum of EUR 25,000 and the Respondent has engaged in a pattern of registering domain names incorporating well-known trademarks and celebrity names, thus engaging in domain name hijacking in bad faith.

(b) Respondent.

The Respondent makes the following contentions

1. The Respondent first takes issue with the trademark evidence of the Complainant and says that there is not a single trademark relied on that is for ALIBABA that predates the registration of the disputed domain name in the area where the Respondent conducts business.
2. On the issue of rights and legitimate interests the Respondent submits that anyone is entitled to register a domain incorporating a common name, which the Respondent has done and that the first to register such a name has legitimate interests in it, provided that it was not registered with the purpose of selling to the complainant, disrupting its business, preventing it from acquiring a domain incorporating its mark, or confusing internet users. The disputed domain name consists of a very well known fictional character, Ali Baba and anyone is entitled to register the name of a fictional character. The use of the domain name to provide links to websites of children's books further supports Respondent's rights in the disputed domain.
3. As to the attempt to buy the domain name, the Respondent submits that this is an admission by the Complainant of the Respondent's interests in the domain name and the reality is that as the Respondent is the legitimate owner of the domain name, it is entitled to seek whatever price he considers appropriate.
4. The Respondent submits that it did not register or use the disputed domain name in bad faith. This is so because the Respondent registered alibaba.info on 2004 when it was available for anyone to register. Complainant chose not to register it and the Respondent registered the domain as it incorporates a well known fictional character from medieval Arabic literature. Moreover, the name "Ali Baba" or "AliBaba" is subject to substantial third party use unaffiliated with the Complainant. While Complainant seems to be of the opinion that it is the only entity in the world that uses the name "AliBaba", there are numerous third parties using it, either singularly or in conjunction with other terms, to identify their name, business, products, and services that bear no association with the Complainant.
5. The Respondent submits that the domain name was also not registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant.
6. The Respondent submits that the Complainant has not explained why it waited so long to initiate this Complaint. The delay between the registration of the disputed domain name and the filing of the Complaint amounts to laches and demonstrates that the Complainant did not believe that its claims were truly warranted.
7. The extensive worldwide third party use of the term "Ali Baba" is overwhelming evidence that any value in the disputed domain derives not from any alleged fame of Complainant's mark.
8. Specifically the Respondent submits that there is no evidence of bad faith at the time of registration. Various WIPO decisions have shown that one cannot infer that just because a mark is well-known in its home country, the mark is well known in another country where the domain name registrant resides. The Complainant has presented no evidence that it has ever conducted business or that it has advertised in Greece. The Complainant does not operate in Greece. The Complainant does not have and never had an office in Greece.
9. The Respondent also submits that it has not registered the domain to prevent the Complainant from using the mark Alabama. The Complainant already owns several "corresponding domain names": alibaba.com, alibaba.net, etc.

10. The Respondent also submits that some links are in Chinese as parked.com uses Geotargeting in conjunction with Yahoo Inc. so it can provide ads to the language of each webpage visitor. When someone visits the website from Germany, ads are in German, when someone from the USA visits the website, ads are in English etc.

5. Discussion and Findings

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

(i) that 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

(ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

On the evidence before the Panel, the Complainant, as a member of the Alibaba Group of companies, has established rights in the ALIBABA mark through registration and use of many trademarks for ALIBABA registered in the Peoples Republic of China and internationally (collectively referred to as "the ALIBABA mark"). There is no need to set out the details of these marks, as substantial evidence of them was produced by the Complainant and there is no real dispute as to their validity. The Respondent did, however, submit that the Complainant should fail on the first element of paragraph 4 of the Policy as it does not have a single trademark for ALIBABA itself that predates the registration of the disputed domain name in the region of the world where the Respondent conducts business. The Panel does not accept that submission, as it has now been well-established that the requirement under the Policy is for the Complainant to be entitled to "a trademark or service mark", no matter where or when it may have been registered or acquired. The Panel also finds that the disputed domain name is identical to the ALIBABA mark and that the Complainant has thus made out the first of the three elements set out in paragraph 4(a) of the Policy that it must establish to succeed.

B. Rights or Legitimate Interests

The Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. That prima facie case consists of the facts that the Complainant has trademark rights in the ALIBABA mark, the disputed domain name consists in substance of the same trademark and the Complainant has never given any permission or authorization to the Respondent to use the trademark in its domain name or anywhere else. The burden of proof has therefore shifted to the Respondent to rebut the prima facie case and establish its right or legitimate interest in the disputed domain name.

The Respondent's claim to rights and legitimate interests in the disputed domain name rests on its claimed entitlement to register a domain name that is the name of a historic but fictional character in literature and folklore, namely Ali Baba. In this regard, the Respondent argues that the domain name is descriptive and that the name Ali Baba and its connotations in popular use are such that there is a general right and legitimate interest in everyone to register a domain name in that name, provided that the domain name thus created is not used to target the Complainant or its trademark or used for some other improper purpose.

This Panel was divided on the question as to whether the Respondent has discharged the burden of proof to establish that it has rights or legitimate interests in the disputed domain name. Panelists Donahey and Zhao Yun **are of the opinion that** the Respondent has not discharged its burden of proof, as it, the Respondent, is not commonly known by the disputed domain name; it failed to produce any evidence to prove use or preparation to use the domain name to offer goods or services in good faith; it failed to produce any evidence that it was making a legitimate noncommercial or fair use of the domain name and it failed to produce any evidence that shows or justifies on any other basis the rights and interests of the Respondent.

Panelist Brown is of the opinion that there is merit in the Respondent's argument when the domain name consists of the name of a well-known fictional character subject to wide third party use, which has been established on the evidence of the Respondent, provided that there has been no targeting of the Complainant or its trademark; the evidence in the present case is sufficient to show that the Respondent has, within that test, made a legitimate use of the domain name, thus rebutting the prima facie case.

Each of those opinions depends on an analysis of the facts in the present case and as the same facts will determine the opinion of the Panel on the third element, bad faith registration and use, it is necessary to turn to those facts and how they determine the result on that element.

C Registered and Used in bad faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

In this regard it should be said at the outset that a majority of the Panel, Panelists Brown and Zhao Yun, subscribes to the well-established view that both of those elements must be proved, although it remains in any given case to be seen if it can be inferred from specific evidence whether the domain name in question has been registered in bad faith, even if that is not established by direct evidence. The essential point is that the requirement for registration in bad faith is an integral part of the Policy and it must be proved.

Accordingly, it is appropriate to state the majority's position on the debate that has arisen on this issue. The majority subscribes to the view expressed in *A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc.* WIPO Case No. D2010-0800 where the majority of the panel expressed its own view as follows:

"The majority of the present Panel is not persuaded to depart from the ordinary meaning of paragraph 4(a) (iii) of the UDRP and the long line of previous decisions which have required bad faith to be shown at the time of registration, albeit that such bad faith can be inferred in appropriate cases from the respondent's subsequent conduct.

The majority of this Panel is reinforced in this view by a number of recent decisions, including decisions of three-member Panels, which have rejected the re-evaluation of this issue in the Octogen case: see *Camon S.p.A. v. Intelli-Pet, LLC*, WIPO Case No. D2009-1716; *BioClin B.V v. MG USA*, WIPO Case No. D2010-0046; *Heraeus Kulzer GmbH v. Dr. Walt Stoll*, WIPO Case No. D2010-0137; *Tata Communications International Pte Ltd (f/k/a VSNL International Pte Ltd) v. Portmedia Inc. / TRUERROOTS.COM c/o Nameview Inc. Whois*, WIPO Case No. D2010-0217; *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. D2010-0470; *India Infoline Ltd. v. Myles Hare*, WIPO Case No. D2010-0542; *Editions Milan v.*

Secureplus, Inc., **WIPO Case No. D2010-0606**, and RapidShare AG and Christian Schmid v. The holder of the domain name rapidshare.net, **WIPO Case No. D2010-0598**.

As observed in the Octogen case, this is the generally accepted panel view. And as stated in Guildline Instruments Limited v. Anthony Anderson, **WIPO Case No. D2006-0157**,

“A long line of decisions has held that the first of these conditions requires that the original registration, or possibly a subsequent acquisition, of the Domain Name was in bad faith, and that the maintenance or renewal in bad faith of a registration originally made in good faith does not suffice: see Telaxis Communications Corp. v. William E. Minkle, **WIPO Case No. D2000-0005**, Teradyne Inc v. 4tel Technology, **WIPO Case No. D2000-0026**, Smart Design LLC v. Carolyn Hughes, **WIPO Case No. D2000-0993**, e-Duction, Inc. v. John Zuccarini, d/b/a The Cupcake Party & Cupcake Movies, **WIPO Case No. D2000-1369**, Weatherall Green & Smith v. Everymedia.com, **WIPO Case No. D2000-1528**, Village Resorts Ltd v. Steven Lieberman, **WIPO Case No. D2001-0814**, Substance Abuse Management, Inc. v. Screen Actors Modesl International, Inc., **WIPO Case No. D2001-0782**, Gamer.tv Limited v. Bestinfo, **WIPO Case No. D2004-0320**, PAA Laboratories GmbH v. Printing Arts America, **WIPO Case No. D2004-0338**, Green Tyre Company Plc. v. Shannon Group, **WIPO Case No. D2005-0877**.

In The E.W. Scripps Company v. Sinologic Industries, **WIPO Case No. D2003-0447**, the panel expressed the view that ‘registered in bad faith’ could cover maintaining a domain name on the register in bad faith, but found that the original registration had in any event been in bad faith. In **WIPO Case No. D2004-0338**, cited above, the panel considered that ‘Absent the consistency of approach which has found favour with numerous earlier panels, this Panel would have seen no good reason for a renewal not to be considered as equivalent to ‘registration’.

Having reviewed the cases, the Panel considers that the consensus view, that the original registration or subsequent acquisition must have been in bad faith, should be followed in the interest of clarity and certainty.”

Following the generally accepted view, the majority of the Panel considers the critical question in the present case to be whether on the totality of the evidence and taking into account the evidentiary presumption in paragraph 4(b) (iv) of the UDRP, the Complainant has proved that the Respondent acted in bad faith when it registered the Domain Name in 1999.”

To the same effect was the more recent decision in Mile, Inc. v. Michael Burg **WIPO Case No. D2010-2011**, where the panel said:

“The current Panel recognizes the value, in appropriate cases, of inferences of original intent based on subsequent conduct. But the Panel does not find a compelling Policy or legal basis for retroactively characterizing later abuses as bad faith in the “registration” of a domain name. In company with other panels that have critiqued the Mummygold/Octogen decisions, this Panel is unwilling to overlook the plain language of paragraph 4(a)(iii) of the Policy requiring a conclusion that the domain name has been “registered” and “used” in bad faith. See, e.g., Validas, LLC v. SMVS Consultancy Private Limited, **WIPO Case No. D2009-1413**; Eastman Sporto Group LLC v. Jim and Kenny, **WIPO Case No. D2009-1688**. In the Panel’s opinion, reading “registered” as a continuous act that can be abused at any time would appear to make it essentially synonymous with “use” and deprive the conjunctive phrase of its full meaning.

The Panel is concerned as well that the Mummygold/Octogen reasoning runs counter to a decade of decisions addressing the UDRP's conjunctive requirements for a demonstration of bad faith. This Panel subscribes to the ideal of striving for a reasonable degree of predictability in Policy decisions, to guide domain name registrants and trademark owners. As articulated in the *WIPO Overview*, paragraph 4.1:

"The UDRP does not operate on a strict doctrine of precedent. However panels consider it desirable that their decisions are consistent with prior panel decisions dealing with similar fact situations. This ensures that the UDRP system operates in a fair, effective and predictable manner for all parties." "

The majority of the present panel will therefore examine the evidence to see whether, taking into account inferences that can be drawn, it enables the Panel to conclude that the domain name was both registered in bad faith and used in bad faith.

Further guidance on how to implement this requirement is to be found in paragraph 4(c) of the Policy, which sets out four circumstances, any one of which shall be evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that [the respondent has] registered or [has] 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 [the respondent's] documented out-of-pocket costs directly related to the domain name; or
- (ii) [the respondent] has 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 [the respondent] has engaged in a pattern of such conduct; or
- (iii) [the respondent] has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the] website or location.

The Complainant has rightly sought to prove both elements of the requirement in paragraph 4(a)(iii) of the Policy; that is to say, its case is that the Respondent registered the disputed domain name in bad faith and used it in bad faith. It has not submitted or implied that it was possible for it to succeed by proving only one of those criteria and not proving the other. Thus, it has not submitted that evidence of bad faith use can be given a retroactive effect and become evidence of bad faith registration.

To that end, as well as making a series of submissions, the Complainant has relied on a variety of evidentiary matters that it specifically and rightly refers to as "evidence" and it is important to understand what that evidence is.

The evidence submitted by the Complainant is as follows:

- (a) That, according to a submission from the Complainant, it had an international reputation in its ALIBABA trademark at the time the Respondent registered the domain name, i.e. on November 26, 2004.

- (b) That the Respondent's website is predominantly in the Chinese language and contains links to websites in the Chinese language or directed to consumers located in China or Hong Kong;
- (c) That the Respondent derives income from the advertisements and sponsored links posted on its website.
- (d) That on April 26, 2011 the Complainant made an anonymous offer to the Respondent to buy the domain name and the Respondent responded by asking for EUR 25,000.
- (e) That the Respondent has engaged in a pattern of registering domain names incorporating well known trademarks and the names of celebrities and has, moreover, been the Respondent in UDRP proceedings with respect to those domain names.

That is the entirety of the evidence submitted by the Complainant on the issue of bad faith in the section of the Complaint dealing with that issue and under the heading "The Disputed Domain Name has been registered and is being used by the Respondent in Bad Faith". Curiously, the Complainant does not rely under that heading specifically on other evidence it has submitted, but in fairness to the Complainant that Panel will refer to that evidence, as it is relevant to the issue presently under debate. That evidence, continuing the numbering commenced above, is as follows:

- (f) Annexure 5 to the Complaint which sets out at length a series of media extracts showing, as the Complaint says, that the Complainant has "a high profile globally". It is clear that this evidence is tendered to show the prominence of the Complainant at the present and not at the time of registration of the domain name or at any other time, namely that the Complainant is a very large, successful and enterprising company and a major economic force in China and Hong Kong and to varying degrees in other parts of the world.
- (g) Annexures 12 and 13 that set out, respectively, screen shots of the Respondent's website dated May 11, 2011 in the first place and June 12, 2006 and September 22 in the second case. These screenshots carry wording that is predominantly in the Chinese language, but in part in the English language.

The evidence submitted by the Complainant can be conveniently divided into two groups. The evidence encompassed by paragraphs (b), (c), (d), and (g) is clearly of more recent vintage and, that this is beyond doubt, can be seen from a brief examination of it and of the description given to it by the Complainant itself.

The evidence covered by paragraph (b) above, on its own terms refers to the website as it is today and can only be evidence showing the way in which the Respondent is using its website today and presumably something by way of the intention of the Respondent in how it uses its website today. That evidence is corroborated by the evidence in Annexures 12 and 13 which is to the same effect, although it more clearly relates to recent times.

The evidence covered by paragraph (c) and (d) on its plain terms relates only to the current time.

Likewise, the evidence covered by paragraph (g) relates solely to the years 2006 and 2011.

The majority of the Panel conclude that none of the evidence set out in paragraphs (b), (c), (d), and (g) shows that the Respondent registered the disputed domain name in bad faith. It clearly relates to the use to which the Respondent has put the domain name and the website to which it resolves. As such, it could be relied on as evidence to argue that the Respondent registered the domain name in bad faith, but that is the limit of its probative value, even if it were all accepted. Of course, inferences can be drawn from conduct and that has been noted in the above decisions. But it cannot be inferred from any of the evidence under discussion that the domain name was registered in bad faith. Most of it occurred several years after the registration of the domain name and, as evidence showing an intention several years earlier, it is correspondingly weakened. The same evidence is equally open to the conclusion that the Respondent registered the domain name in good faith, irrespective of whether its intention changed several years later.

That leaves for consideration, first, the evidence covered by paragraph (a) above, that, according to a submission from the Complainant, it had an international reputation in its ALIBABA trademark at the time the Respondent registered the domain name, i.e. on November 26, 2004. The Complainant asks the Panel to draw the conclusion from this statement that the Respondent "must have been aware" of the Complainant's trademark when it, the Respondent, registered the domain name on that date. Had that been proved and that conclusion drawn by the Panel, it would have gone some way to showing that the domain name was registered in bad faith, although it is not necessary to decide that issue here. The difficulty with the Complainant's argument and the conclusions the Complainant asks the Panel to reach is that there is no evidence at all that has been put before the Panel of the Complainant's international reputation in 2004 and, curiously, no attempt has been made to prove it. The Complainant's case is not helped by the way it expresses the submission it asks the Panel to accept as evidence. The Complainant alleges:

"The Respondent must have been aware of the Complainant's prior rights and interest in the Disputed Domain Name by virtue of the Complainant's reputation in the Alibaba Trade Marks including the mark "ALIBABA" in internationally (sic) as of the date that the Respondent registered the Disputed Domain Name."

Presumably this is meant to mean that because of the Complainant's international reputation, the Respondent must have been aware of the Complainant's rights and interests in the trademark when it registered the domain name. However, there is no evidence of either the Complainant's international reputation in 2004 or of anything to show why the Respondent would or should have been aware of it. It would be surprising if the Complainant did not have a reputation of some sort by 2004 and the Complainant must be possessed of whatever record or evidence of that reputation there is. Indeed, there is something of a responsibility on the Complainant to put in whatever evidence it might have that would be helpful to the Panel in resolving this and the other inevitably contentious issues in this proceeding. However, the Complainant's evidence is expressly limited to a time well after the registration of the domain name. Moreover, its other evidence on this issue, the media reports set out in Annexure 5, is described by the Complainant itself as material "published during the twelve month period preceding this Complaint", i.e. material published between May 12, 2010 and May 12, 2011, six years after the event at issue. That evidence can have no probative value on the issue of the Complainant's international reputation in 2004 or the issue of why the Respondent could or should have been aware of whatever that reputation was.

The issue under discussion is not a peripheral one, but is pivotal to the whole case and is an issue where, moreover, there has been extensive debate in recent years, as is seen from the above decisions. In any event, it is really saying no more than that if the Complainant's case is that the Respondent "must have known" of something, it should be proved by the best evidence available. That is especially so where it is alleged that the Complainant had an international reputation, for evidence must be available in some form or other of that fact, one way or another, it must be within the knowledge of the Complainant and it should be produced.

The need for such evidence is greater when the Complainant is, although a Cayman Islands company, a company operating principally in China and Hong Kong and when the Respondent operates in Greece. Moreover, the Respondent's own evidence is that there is, even today, no company of the Complainant's name operating in Greece, which makes it even more difficult to conclude that the Complainant had a reputation in Greece or Europe as a whole in 2004.

For the sake of completeness, it should be added that the evidence of the Complainant's reputation in 2011 does not allow any inferences to be drawn by the Panel about its reputation in 2004, especially in Greece or other parts of Europe, let alone inferences about the Respondent's intentions in 2004.

The Panel is therefore unable to accept that there is any evidence at all to suggest that the Complainant had an international reputation in 2004, one that extended as far as Greece or that the overt facts were such that the Respondent would or should have been aware of the Complainant or its trademark when it registered the domain name.

It should also be remembered that the Respondent was registering a domain name that was and is a well known fictional figure, an expression commonly used in expressions like "Ali Baba's cave" and an expression that was, in the present context "descriptive". As such, it would be surprising if anyone in the Respondent's position would think that registering a domain name in such a common expression could trespass on the rights and interests of anyone else.

Indeed, the Complainant has volunteered the fact that, when the Respondent first set up its website, it used the expression as two words, Ali Baba and not Alibaba, which is more closely identified as the Complainant's name and which was adopted in that form by the Respondent only in 2008. The Complainant uses this fact as evidence of dishonesty by the Respondent. However, if anything, it suggests that the Respondent may well have been motivated solely by a recollection of the fictional character Ali Baba when it registered the domain name, rather than a company in China named Alibaba. Some support for that as being the motivation of the Respondent, although of course it is not conclusive, is found in the Respondent's evidence that it also registered similar domain names such as <alladin.info>, <tales.info>, <odyssey.org>, <character.info> and <art-book.com> and that <alladin.ino> was registered only 2 days before <alibaba.info>. In other words, it is not surprising that the Respondent should choose an exotic historic figure as a domain name as countless others have done and will do so in the future. In contrast, there is an air of unreality about the bald suggestion, which is the Complainant's case, that the Respondent "must have been aware" of the trademark when it is more likely that he was more aware of the fictional character than the trademark.

Moreover, the Complainant registered the domain name <alipay.info> on 30 November 2004 (this date is taken from Whois, although the Respondent says that the date was 29 November 2004), only 4 days after the registration of <alibaba.info>. It must be assumed from this fact that the Complainant knew of the registration of disputed domain name at that time, but waited for more than 6 years to file the present Complaint case, apparently unconcerned that another party had used its name in a domain name and, in effect, encouraging the Respondent to continue to believe it was entitled to register the disputed domain name and to keep the registration. Furthermore, the Respondent's website was designed in a way to provide links to other website (accounting, etc.); its appearance was and is in no way similar to the Complainant's website. These factors militate against the conclusion that the Respondent was motivated by bad faith in registering the domain name and, for that matter, in using it.

The one remaining area of evidence is that covered by paragraph (e). The evidence covered by paragraph (e) relates to 1 domain name registered in 1996, 2 domain names registered in 2003, 2 in 2004, 1 in 2005 and 1 in 2006. Two of the domain names are in the name Konstantinos and others are in the name Konstantinos Zouros who represents the Respondent in the present proceeding and the UDRP cases referred to occurred in 2006 – 2008. It is true, therefore, that some of the events dealt with, occurred prior to 2004, but the opinion of the panel is that when it is looking for direct evidence, or evidence that gives rise to necessary inferences, showing the intention of the Respondent when it registered the disputed domain name, it would be unsafe to form conclusions about the Respondent's or anyone else's good or bad faith on such tenuous and limited material. In any event, the majority is not prepared to say that the evidence covered in (e) shows on the balance of probabilities that the Respondent registered the domain name in these proceedings in bad faith.

The Panel is therefore left in the position that there is no evidence at all going to show that the Respondent registered the domain name in bad faith. There is, of course, as the Panel has already indicated, evidence allegedly relating to bad faith use that is more arguable, but the onus was and always is on a complainant to prove the essential elements of the Complaint and there is no evidence to support the essential element of registration in bad faith.

The majority emphasizes that its decision is based on the entirety of the evidence put in by the Complainant and in its opinion it would be wrong to make a finding on bad faith registration based on matters not put forward or relied by the Complainant, of which the Respondent is not aware and which have not been put to the Respondent to give it an opportunity to defend itself.

The conclusion therefore is that the Complainant has not proved that the domain name was registered in bad faith and as a consequence it has not succeeded on this element.

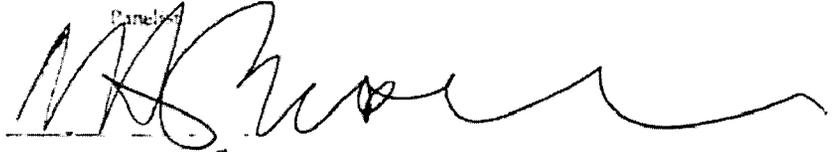
In the result, the majority of the Panel finds that the Complainant has failed to prove that the Domain Name was registered in bad faith.

6. Decision

The Complaint is dismissed.



Dr. Zhao Yun
Panelist



The Hon Neil Brown QC
Panelist

Dissent:

I must respectfully dissent from the view of my learned colleagues that bad faith registration and use has not been shown. First, I do so under the consensus view that holds that bad faith registration and use is a binary concept and that complainant has is required to show bad faith registration and bad faith use. The majority has held that Complainant failed to establish that the registration was done in bad faith. I respectfully disagree. Second, I do so under the current minority view that bad faith registration and use is a unitary concept and that the test that a domain name panelist should apply is whether, under all of the facts and circumstances, the registrant can be said to be acting in bad faith.

A. Under the Consensus View Respondent Has Registered the Domain Name at Issue in Bad Faith

The majority has correctly stated that the panel should determine the issues on the balance of the probabilities. Thus, the issue which we are to decide under the consensus view is whether it is more probable than not that Respondent registered the domain name in bad faith. The majority states that Complainant's assertion that Respondent "must have been aware" of Complainant's trademark when Respondent registered the domain name at issue on November 26, 2004, and that Complainant's failure to offer proof that "Respondent would or should have been aware of [Complainant's reputation]" is insufficient to establish that Respondent registered the domain name in bad faith. After all, the majority states, "Respondent operates in Greece," and "Respondent's own evidence is that there is, even today, no company of Complainant's name operating in Greece."

The dissenting panelist concedes that the typical resident of Greece operating a business in Greece in late November 2004 more probably than not was not aware of the existence of the Alibaba group of companies. However, Respondent in this case is not the typical resident of Greece operating a business in Greece.

Respondent in the present case is Digital Domains MEPE. Respondent describes its business thusly: "Respondent is a website [sic] design company that acquires domains with intent to develop them and on behalf of its customers [sic]." Respondent operates its business on the Internet, not in Greece. Respondent has registered more than 6,700 domain names. Respondent has been a respondent in numerous UDRP cases. Respondent clearly is not the prototypical resident of Greece.

We who are living in the Internet age have found that the Internet has accelerated our lives in multiple areas. Questions which used to require days, weeks, or months of painstaking research can now be answered in minutes, if not seconds. Through email, Twitter, Facebook, and other social networking vehicles, we are in constant and instantaneous communication with friends and colleagues around the world, a situation that was almost unthinkable less than twenty years ago. The time that is necessary for a brand to acquire secondary meaning on the Internet is far less than it took for brands that were established in physical space, rather than in Cyberspace.

In 1996, the founders of Google were still graduate students at Stanford University. The Google company was not incorporated until September 1998. Google became a publicly traded company in August, 2004. In the 2006 editions of Merriam Webster's Collegiate Dictionary and the Oxford English Dictionary, the definition of "google" was added to mean "to use the Google search engine."¹ Would

Google be required to produce proof that as of November 16, 2004, Respondent should have been aware of Google's reputation?

What do we know about the Alibaba group of companies? By no later than 2002, alibaba.com was the leading B2B website in China. In 2003, Alibaba launched TaoBao (see e.g., Total Telecom Internet posting of July 11, 2003, entitled, "China's Alibaba Opens Doors to Online Auctions"), an auction web site that proved so successful in China that eBay, which had invested massive amounts of money in acquisitions and promotion of its Chinese auction portal, abandoned the Chinese market entirely before the end of 2004. This competition prompted reports in Reuters and USA Today on April 13, 2004, entitled, "eBay to go Head to Head with alibaba in Chinese Auction Market."

Throughout 2004, Alibaba was participating in electronic trade shows around the world, and in early 2004, Alibaba raised some US\$ 87 million from such sophisticated investors as Softbank, Granite Global Ventures, and TDF. This unprecedented raising of funds from foreign investors by a Chinese company was widely reported, including by Reuters and the *New York Times* in an article dated February 18, 2004, entitled "World Business Briefing: Asia: China: Web Auctioneer Raises Cash." Alestron reported on January 15, 2004, that "Alibaba, the leading B2B marketplace for global trade and provider of online marketing services, would invest US\$ 37 million in a software development center . . ." In 2004, Alibaba launched Alipay, an Internet payment vehicle which competed directly with eBay's PayPal service. On November 15, 2004, *Fortune* magazine and *CNN Money* reported in an article entitled "An Upstart Takes on Mighty eBay." This appeared in print and online less than two weeks before Respondent registered <alibaba.info>.²

Is it not more probable than not that Respondent, an experienced Internet business investing in domain names and developing web sites for its customers, was aware of Complainant's reputation and of the use of the ALIBABA mark as of the time the domain name at issue was registered?

Indeed, what were the earliest uses of the domain name at issue of which Complainant was able to learn? The earliest capture from the Wayback Machine, dated June 12, 2006, shows that as of that date the domain name at issue resolved to a web site that was a link farm with links to B2B businesses and directories, predominantly in China, including a direct link to Complainant's web site. Complaint, Annex 13. The other web site capture was from September 2008. At that time the domain name at issue linked to a web site featuring links to Chinese businesses in Chinese, which included the web site addresses in ASCII characters. Complaint, Annex 12. From the annexed pages, it is apparent that Respondent began targeting Complainant soon after the domain name was registered and continuing for some time prior to this dispute. The dissenting panelist believes that it is more probable than not that the domain name at issue was registered in bad faith.

B. Under the View Espoused in the *Octogen* Line of Cases, It Is More Probable than Not That Respondent Acted in Bad Faith

In 1999, the dissenting panelist drafted the first decision under the UDRP, *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO Case No. D99-0001. That decision cited what was at the time the only legislative history available, the Second Staff Report on Implementation Documents, for the proposition that the policy required proof of both bad faith registration and bad faith use. Accordingly, the dissenting panelist played some small part in the establishment of what is now the conventional view. In 2010, while involved in an exhaustive search for any other indications of what the draftpersons of the UDRP intended by the language, "that the domain name has been

registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)), the author came across other relevant legislative history in the form of an article written by one of the five principal committee members who worked on the final language of the Policy. The article was published in 2002, so that it was not available in 1999 when the dissenting panelist had made his initial search.

In the dissent authored in *A. Natterman & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc.*, WIPO Case No. D2010-0800, a case cited by and quoted extensively in the majority opinion in the present case, this dissenting panelist set forth in great detail the rules of statutory construction which this panelist believes should apply in order to determine the purpose for which the UDRP was intended. I will not repeat that extensive analysis here. At that time, the dissenting panelist reviewed all of the sources that he was able to find in an exhaustive search. One source, unavailable in 1999, described the "Small Drafting Committee" made up of five individuals, whose task was to shape the final version of the Policy. I will repeat here what I was able to find:

The only record that this panelist was able to locate which references the work of this committee were two law review articles by Professor A. Michael Froomkin: *Wrong Turn in Cyberspace, Using ICANN to Route Around the APA and the Constitution*, 50 Duke L.J. 17 (2000) ("Duke Article") and *ICANN's "Uniform Dispute Resolution Policy" – Causes and Partial Cures*, 67 Brooklyn L.Rev. No. 3, 655 (2002) (the "Brooklyn Article").

Professor Froomkin states that the "small drafting committee was established in response to criticism arising from the DNSO Names Council forwarding the Working Group report to the ICANN board for approval. Brooklyn Article, at 652, n. 139. The person who represented the President was then ICANN Counsel Louis Touton. When the "small drafting committee" was unable to reach a consensus, Mr. Touton decided the matters independently, and his recommendations became those of the staff. *Id.*

In a number of important respects Professor Froomkin's descriptions of the small drafting committee's activities coincides with that of the Second Staff Report. Professor Froomkin reported that the trademark interests pushed for bad faith registration or use. *Id.* Brooklyn Article, at 655. The registrant interests responded that registration without use should not be actionable and insisted on the language "bad faith registration and use." *Id.* However, unlike the Second Staff Report, Professor Froomkin reports the reasoning behind the registrant interests' advocacy of bad faith registration and use:

Registrant partisans countered that current trademark registration of a domain, without some kind of commercial use, did not constitute trademark infringement. Although courts had held that offering a domain for sale was commercial use, it could not follow that a plaintiff's psychic conclusion that warehousing was in bad faith could substitute for actual conduct. They also argued that, large-scale cybersquatters excepted, **the only way to tell that a registration was in bad faith was to look at subsequent conduct, i.e., use, and that the two therefore should not be separated.**

Id. (emphasis added). This statement expressly sets forth the unitary nature of bad faith registration and use.

Id. (footnotes omitted).

Curiously, the majority cites the decision in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, for the proposition that Complainant must establish both that the disputed domain name was registered in bad faith and that it is being used in bad faith.” The eminent panelist who decided *Telstra* believes that the unitary concept espoused in the *Octogen* line of cases is correct and that the *Telstra* analysis is consistent with *Octogen*. See *Ville de Paris v. Jeff Walter*, WIPO Case No. D2009-1278. In the present case, regardless of Respondent’s state of mind at the time of registration, Respondent later targeted Complainant’s trademark and Complainant’s business in an attempt to confuse Internet users and to profit from their confusion. Under the *Octogen* analysis, this constitutes bad faith registration and use.

C. Even Where a System of Precedent Has Been Instituted, Precedent is not Inviolable

The dissenting panelist agrees with the majority that, although the UDRP is not a precedential system, where it is possible to respect prior panel decisions without controverting the intent of the Policy, than prior panel decisions should be respected. The intent of the Policy is to prevent consumers from being misled as to the source of products or services they are seeking on the Internet. It is contrary to the intent of the Policy to allow a registrant who has apparently registered a domain name innocently to later use that domain name to deliberately mislead Internet users. Yet, under the consensus view, there are many decisions which sanction just such conduct.

In 1896, the Supreme Court of my country, a common law jurisdiction, established a precedent upholding the constitutionality of state laws which established racial segregation in private businesses under the doctrine of “separate but equal.” *Plessy v. Ferguson*, 163 U.S. 537 (1896). In 1954, the United States Supreme Court repudiated the *Plessy* decision which had been the law of the land for some fifty-eight years. In *Brown v. Board of Education of Topeka*, 347 U.S. 483 (1954), in a decision by all nine justices, the Supreme Court overturned the *Plessy* decision, and *de jure* racial segregation was ended.

I do not pretend that the issue with which we are dealing in this case even approaches the importance of the issues in the two cases cited above. I only cite the cases for the proposition that even in systems where precedent is an integral part, and even where that precedent has been in effect, not for a number of years, but for a number of decades, courts are able to reverse and have overruled precedents in order to reach the correct result. Surely UDRP panelists are even more free to determine that prior panel decisions, no matter how well intended, do not comport with the Policy.

Dated: 26 July 2011



M. Scott Donahey
Presiding Panelist

¹ http://en.wikipedia.org/wiki/History_of_Google

² Results of google search.