



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

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(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1100393
Complainant:	Alibaba Group Holding Limited
Respondent :	Web Solution Provider (Pvt)

1. The Parties and Contested Domain Names

The Complainant is Alibaba Group Holding Limited, located Fourth Floor, One capital Place, P.O. Box 847, George Town Grand Cayman, Cayman Islands, British West Indies, represented by Hogan Lovells, Hong Kong.

The Respondent is Web Solution Provider (Pvt) Limited, of 1-D 2/15 Nazimabad No.1, Karachi, 74600 Pakistan, represented by Ch. Tanveer Amjad & Associates, Karachi, Pakistan.

The Disputed Domain Names are <alibabacome.com> and <alibabascript.com>, registered by the Respondent with Direct Internet Solutions Pvt. Ltd (publicdomainregistry.com), Directiplex, of Mumbai, Maharashtra, 400069 India.

2. Procedural History

The Complaint was filed with the Honk Kong Office of the Asian Domain Name Dispute Resolution Centre (referred to as the “Center”) on September 20, 2011. On September 23, 2011, the Center transmitted by email to Direct Internet Solutions (Pvt) a request for Registrar verification in connection with the disputed domain names. By email dated September 30, 2011, the Center requested to be provided with additional information regarding the Registrar.

On October 3, 2011, Direct Internet Solutions (Pvt) transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requestments of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999.

In accordance with the Policy, the Center formally notified the Respondent of the Complaint and the proceedings commenced on October 6, 2011. It further specified that the due date for Response was October 26, 2011.

The Respondent submitted a response on October 20, 2011.

By email dated October 24, 2011, the Complainant requested to file further submissions in order to reply to the Respondent's Response in particular because the response did not comply with the Policy and its applicable Supplemental Rules regarding the limitation of words of a response (3000 words).

By email dated October 24, 2011, the Respondent answered on these points and requested the Panel to accept its response.

The Center appointed Marie-Emmanuelle Haas as the sole panelist in this matter, on October 26, 2011. The Panel finds that it was properly constituted. 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.

On October 30, 2011, the Complainant requested to file further submissions in reply to the Response. The Panel accepted this request and set up new deadlines. The Complainant had to file supplemental submission before November 11, 2011, whereas the Respondent could file a reply before November 18, 2011. The date of the decision has been set on November 23, 2011.

Each Party has filed submissions within these deadlines.

On November 22, 2011, the Respondent sent an email to the Panel, requesting to provide a copy of a copyright registration certificate, without any other information.

The Panel decided not take it into account, since the Respondent had already been able to contest the Complaint and to produce every necessary piece of evidence to support its position.

3. Factual background

A. Concerning Alibaba Group Holding Limited

The Complainant is an international company incorporated in the Cayman Islands, British West Indies and based in China. It is a member of the Alibaba Group.

Founded in 1999 in Hangzhou, China, the Alibaba Group is large and successful in e-commerce for small businesses. The Group operates in particular in Asia, via its subsidiaries and affiliates, through its online marketplaces in the "business-to-business" ("B2B") field. Alibaba.com Limited has been listed on the Hong Kong Stock Exchange since November 2007.

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

The Complaint is based on 392 trademarks or pending trademark registrations comprising the term "ALIBABA" and/or the term "ALIBABA.COM" and, in China, Hong Kong or

even Benelux, the transliteration thereof. These trademarks are worldwide protected, for example in Pakistan, People's Republic of China, Hong Kong, Taiwan, Singapore, Australia, New Zealand, European Union, Japan, Macau and United States. They are owned by Alibaba Group Holding Limited and its affiliates Alibaba.com Corporation, Alibaba Technology Co. Ltd (China) and Hangzhou Alibaba Advertising Co.Ltd and.

The complaint is also based on up to 333 domain names registered by the Complainant and its affiliates and subsidiaries and including the term "ALIBABA" such as <alibaba.com> which has been registered on April 14, 1999.

B. Concerning Web Solutions Provider

The Respondent is a Pakistani company, founded in 2004. It operates as a webdesigner and a computer consulting company and provides B2B design and development of professional websites for small, medium and corporate sized business organizations.

The Disputed Domain Names <alibabacclone.com> and <alibabascript.com> have been registered on January 20, 2007 and are being used by the Respondent to provide websites and scripts for establishing online business-to-business platforms.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Names are identical or confusingly similar to trade and services mark in which the Complainant has rights to the extent that the Disputed Domain Names incorporate the Complainant's ALIBABA Trade mark in its entirety and that the addition of the generic words "CLONE" and "SCRIPT" do not distinguish them from the Complainant's trademarks. The clearly distinctive and prominent component of the Disputed Domain Names is ALIBABA
- ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names for the following reasons:
 - the Respondent registered the Disputed Domain Names on January 20, 2007, some 9 years after the Complainant commenced use of the ALIBABA Trade mark and more than 7 years after having registered the two (2) trademarks ALIBABA.COM No.160098 and No.160096 in Pakistan (January 2000);
 - the ALIBABA Trade marks have acquired meaning through their extensive use by the Complainant;
 - the Respondent is not authorized to use the Complainant's ALIBABA trade marks and has no legitimate right or interest in respect of the Disputed Domain Names;

- given the spreadsheet articles regarding the Alibaba Group and in particular the articles dated 2000 and 2001 related to Alibaba.com and the B2B field, it would be inconceivable that the Respondent was not aware of the Complainant's ALIBABA brand and/or the ALIBABA trademarks at the time the Respondent registered the Disputed Domain Names;
 - the Respondent's business model involves creating websites which act as clones of the Alibaba.com website;
 - the Respondent uses the Disputed Domain Names to sell website script which copies the Complainant's trademarks and the look, feel and design of the Alibaba.com website.
- iii. The Disputed Domain Names have been registered and are being used by the Respondent in Bad Faith for the following reasons:
- the Respondent must have been aware of the Complainant's prior rights and interests in the Disputed Domain Names by virtue of the Complainant's reputation and the registered ALIBABA Trade marks as of the date that the Respondent registered the Disputed Domain Names;
 - the Respondent continues to use the Disputed Domain Names in the full knowledge of the Complainant's prior rights in the ALIBABA Trade Marks, without any authorization from the owner of such trade marks;
 - the websites operated through the Disputed Domain Names contain numerous references to the Alibaba.com website and reproduce logos, so that clearly indicates that the Respondent is trading off the Complainant's reputation and is aware of the Complainant's activity and rights;
 - the "FARIBABA.COM" logo on the website www.alibabascript.com clearly imitates the "ALIBABA.COM" and the Respondent has just copied the base line "Global trade strats here" which is part of the sign used by the Complainant;
 - the Respondent intentionally confuses the Internet users and diverts traffic to the Respondent's websites;
 - the behaviour of the Respondent consisting in using a privacy service to register the Disputed Domain Name and shield its identity may further support an inference of bad faith.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Respondent first takes issue that the term ALIBABA is a common name which cannot be appropriated by a company and that anyone can register a domain incorporating a common name.

- ii. As to the bad faith in registering the Disputed Domain Names, the Respondent sustains that :
- he registered the Disputed Domain Name <alibabaclone.com> in 2007 as a result of the domain suggestion tool, that anyone could register;
 - he has been using the Disputed Domain Names during nearly five years before the Complaint has been filed, estoppel by laches should prevent a party from filing a Complaint;
 - there are numerous third parties using the name “ALIBABA” in their domain name all over the world;
 - 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 Pakistan. The Complainant does not operate in Pakistan and never had an office in Pakistan;
 - the incorporation of Alibaba.com in Hong Kong Stock Exchange intervened 10 months after the registration of the Disputed Domain Names. To that extent, there is no evidence that the Complainant had an international reputation in January 2007.
- iii. The Respondent was using the Disputed Domain Names in connection with a bona fide offering of goods and services because the websites operated through the Disputed Domain Names provide webdesign services in the B2B field.
- iv. The Respondent has been commonly known by the domain name, even if he did not acquire any trademark or service mark rights, given the investments (10 Million PKR) on its script development and marketing and the numerous clients all over the world (2000 clients).
- v. The Respondent is making a legitimate non commercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or services mark at issue because the business of the Complainant (trading website for importers and exporters) and the business of the Respondent (webdesigning for webmasters) are different in nature and description.

5. Discussion and Findings

Procedural aspects

The first issue is whether the Panel will consider the non compliant Response of October 20, 2011 of the Respondent.

The Response communicated on October 20, 2011 exceeded largely the limit of 3,000 words stated in paragraph 13 of the Supplemental Rules applicable in the Center. Indeed, the part of the Response referred to “Legal grounds on which the Complaint is unfounded”

and corresponding to article 5(b)(i) of the Rules contained 3,970 words. Further, the Respondent seemed to have used the part of the Response referred to “Other relevant details” to complete its answer. This last part contained more than 4,220 words.

Therefore, the position of the Respondent is fully explained in a more than 8,000 word-text although it should have been limited to 3,000.

The Response is not in compliance with the Rules and the applicable Supplemental Rules which state that “*Parties are required to observe this [limitation of words] as the Panel in their own discretion shall have liberty to ignore those words exceeding the maximum stated limit* (paragraph 13 of Supplemental Rules of the Center).

The Panel notes that it has an obligation to ensure that each party is given a fair opportunity to present its case.

In this case, the Respondent got the opportunity to contest the allegations made by the Complainant. The Panel finds that there are no exceptional circumstances to justify submitting a noncompliant Response, having in mind the fact that (i) the Respondent was assisted by a counsel, (ii) the form of response expressly specified the limitation of words and (iii) the Respondent made no effort to respect the formal requirements of the Supplemental Rules in summarizing its position and the legal grounds on which the Complaint is unfounded.

The UDRP procedure is meant to be fast and therefore Parties are required to observe the word limits set by the Rules and the respective Supplemental Rules of the ADNDRC.

Therefore, the Panel has decided to take into account the Response submitted by the Respondent and to ignore the words exceeding the maximum stated limit, pursuant to the Rules.

Substantial matters

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

A Complainant is required under paragraph 4(a)(i) of the Policy to prove that the domain name is identical or confusingly similar to a trademark in which the complainant has rights.

The Complainant has established the rights in the ALIBABA trade marks through registrations and use of many trademarks for ALIBABA in People’s Republic of China and internationally.

The Disputed Domain Names incorporate the entire trademark ALIBABA.

The addition of the generic terms “CLONE” and “SCRIPT” does not distinguish the Disputed Domain Names from the ALIBABA Trade mark.

The Panel finds that the disputed Domain Names are confusingly similar to the Complainant’s Trade mark. The condition of the paragraph 4(a)(i) of the Policy has been satisfied.

B) Rights and Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainants to prove that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Paragraph 4(c) of the Policy provides that:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

The Respondent has not been commonly known under the Domain Names and does not make a *bona fide* offering of goods and services under the Domain Names.

The Respondent has no connection or affiliation with the Complainant, and the latter asserts that it has not consented to the Respondent’s use of the Trade mark in the Disputed Domain Names.

The Registrant operates under a privacy service in order to shield its identity. Such a behavior has to be considered as another proof of the absence of any legitimate right and interest of the Registrant on the Disputed Domain Names.

Accordingly, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied.

C) Bad Faith

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name.

It provides that:

“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.”

The Alibaba.com website had 6 million registered users worldwide in 2004 and this figure grew to 24.6 million by mid-2007.

The disputed Domain Names are used to sell website scripts which are clones of the Alibaba.com website.

The Complainant submits documents demonstrating that there were numerous ALIBABA Trade mark applications, at the time of the registration of the Disputed Domain Names, including in China, Hong Kong, Pakistan (...) and that the Alibaba.com website was already successful before 2007.

For the purpose of the UDRP procedure, it is not necessary for the Complainant to justify that he has rights or a reputation in the country where the Respondent is domiciled.

Anyhow, the Complainant is the owner of two ALIBABA Trade mark applications in Pakistan since 2000.

In view of the reputation of the ALIBABA Trade mark, the Panel is of the opinion that the Respondent must have been aware of the Complainant's rights.

Indeed, the infringing content of the Respondents' websites proves that he was fully aware of the Complainants' rights.

The doctrines of acquiescence or laches do not apply in UDRP proceedings.

The Respondent appears to use the Disputed Domain Names to intentionally attempt to divert Internet traffic to its websites by creating a likelihood of confusion with the Complainant's Trade mark as to the source, sponsorship, affiliation or endorsement of its websites. This constitutes bad faith registration and use of the Domain Names in

application of paragraph 4(b)(iv) of the Policy.

For the foregoing reasons, the Panel finds that the Complainant has established the finding of bad faith registration and use within the meaning of paragraph 4(a)(iii) of the Policy.

6. Decision

For all the foregoing reasons, in accordance with paragraphs 4(a) and 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names < alibabaclone.com> and <alibabascript.com > be transferred to Alibaba Group Holding Limited.

Marie-Emmanuelle Haas
Sole Panelist

Dated: November 23, 2011