

(Hong Kong Office)

Uniform Domain Name Dispute Resolution Policy

Panelist Decision

Case No. HK-1300494

Complainant : **Alibaba Group Holding Limited**

Respondent : **Song Bin**

Case Number : **HK- 1300494**

Contested Domain Name : **tmall.com**

Panel Member : **Christopher To**

1. Parties and Contested Domain Name

The Complainant is **Alibaba Group Holding Limited** of Fourth Floor, One Capital Place, P.O. Box 847, George Town, Grand Cayman, Cayman Islands, British West Indies.

The Respondent is **Song Bin** of Dongsanhuannanlu54-10-2803, Beijing, China 100025.

The contested domain name is "**tmall.com**" ("*Disputed Domain Name*").

The Registrar of the Disputed Domain Name is ENOM, Inc ("*Registrar*") of 5808 Lake Washington Blv. NE Ste. 300, Kirkland, WA 98033, United States of America.

2. Procedural History

On 30 April 2013, pursuant to the Internet Corporation For Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“*ICANN Policy*”), the Internet Corporation For Assigned Names and Numbers Rules for the Uniform Domain Name Dispute Resolution Policy (“*ICANN Rules*”) and the Asian Domain Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“*ADNDRC Supplemental Rules*”), the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Dispute Resolution Centre (“*ADNDRC-HK*”).

On 2 May 2013, ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee in accordance with Article 15 of the ADNDRC Supplemental Rules.

On 2 May 2013, ADNDRC-HK notified NameCheap, Inc at <mohan@namecheap.com> and <support@namecheap.com>, the Registrar of the Disputed Domain Name of the proceedings by email.

On 3 May 2013, ADNDRC-HK confirmed that it had received the case filing fee from the Complainant.

On 3 May 2013, the Registrar through the entity UDRP Compliance, eNom.com/bulkregister.com, Demand Media of 5808 Lake Washington Blvd, Suite 300, Kirkland, WA 98033, acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that Song Bin is the holder of the Disputed Domain Name, that the Internet Corporation For Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“*ICANN Policy*”) is applicable to the Disputed Domain Name, the language of the Registration Agreement of the Disputed Domain Name is English as provided by the WHOIS (See: <http://www.who.is>) information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status “*as to prevent any transfers or changes to the registration information during the proceedings*”.

On 3 May 2013, the Respondent sent an e-mail to ADNDRC-HK in Chinese, which stated that:

“你好

我是 HK-1300494 case 的域名拥有者，我收到域名注册商的通知，得知域名在 adndrc 被投诉，但我没有收到任何来自 adndrc 或投诉方的邮件，请问我应该如何答辩和跟进这个 Case?

谢谢”

On 12 May 2013, the Respondent sent an email to ADNDRC-HK in English, which stated that:

“Dear Sirs,

I am the owner of this domain name, I got an email from Namecheap, they told me there have a UDRP case HK-1300494 for me so they disabled the whois protect for this name.

So far, I didn't get email from adndrc, would you please tell me how I can follow this case and where can I reply this case?

I have sent an email in Chinese some days ago, but no reply, so I sent this in English again.

Thank you very much

Song Bin”

On 13 May 2013, the ADNDRC-HK informed the Complainant by email that the Registrar of the Disputed Domain Name should be “ENOM, Inc” rather than “NameCheap, Inc”. Furthermore, the ADNDRC-HK confirmed with the Complainant that the contact information about the Respondent is as follows:

*“Contact Type Registrant
Organization Name: Song Bin
First Name: Bin
Last Name: Song
Address 1: Dongsanhuannanlu54-10-2803
Address 2:
City: Beijing
StateProvince: Beijing
Postal Code: 100025
Country: CN
Phone: +86.1087738239
Fax: +1.5555555555
Email Address: nameablename@hotmail.com
registration-expiration-date: 2014-10-21
domain: tmall.com
status: registrar-lock”*

On 13 May 2013, the ADNDRC-HK informed the Complainant that:

*“On the basis and according to paragraph 4(b) of the Rules, may we ask the Complainant to revise and resubmit its complaint to our centre and serve a copy to the Respondent on or before **20 May 2013**, failing which the Complainant will be deemed withdraw without prejudice to submission a different complaint by the Complainant”*

On 15 May 2013, the Complainant filed its amended Statement of Complaint (“**Complaint**”) together with annexures with the ADNDR-HK.

On 15 May 2013, the ADNDRC-HK confirmed receipt of the Complaint.

On 20 May 2013, the Complainant served a copy of the Complaint together with annexures to the Respondent by email.

On 20 May 2013, the Respondent sent ADNDRC-HK an email in Chinese language requesting that the documentation be provided into the Chinese language.

On 24 May 2013, ADNDRC-HK sent a Notification of Commencement of Proceeding in English and Chinese (“**Notification**”), together with the Complaint, to the email address of the Respondent’s nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database, the Respondent’s email address is <nameable@hotmai.com>). The Notification gave the Respondent twenty (20) calendar days to file a Response (i.e. on or before 13 June 2013).

On 24 May 2013, the ADNDRC-HK responded to the Respondent’s email of 20 May 2013 in English and Chinese, by stating that in accordance with the Internet Corporation For Assigned Names and Numbers Rules for Uniform Domain Name Dispute Resolution Policy (“**ICANN Rules**”), Paragraph 11(a):

“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.”

Subsequently, the ADNDRC-HK urged the Respondent to respond to the Complaint in the English Language.

On 12 June 2013, the Respondent filed a Response to the ADNDRC-HK within the required time period (i.e. on or before 13 June 2013) in the English Language.

On 14 June 2013, ADNDRC-HK sent an email to both the Complainant and Respondent informing them that a Panelist for the Disputed Domain Name will shortly be appointed by ADNDRC-HK.

On the 25 June 2013, the Panel comprising of Mr. Christopher To as a single panelist was appointed by the ADNDRC-HK. Documents pertaining to the case were delivered to the Panel by email on 25 June 2013, followed by a hard copy on 28 June 2013.

In accordance with Paragraph 15(a) of the ICANN Rules, the Panel is of the view that

it shall decide the Complaint on the basis of statements and documents submitted. Also, in accordance to Paragraph 15(d) of the ICANN Rules, this Panel shall issue a reasoned decision.

3. Factual Background

For the Complainant

The Complainant is a company incorporated in the Cayman Islands and its principle place of Business is in the People's Republic of China ("**PRC**").

The Complainant is officially known as "Alibaba", or in Chinese "阿里巴巴", and operates its business through a number of subsidiaries (collectively referred to as "**Alibaba Group**"). Alibaba Group was originally founded in Hangzhou, China in 1999.

In May 2003, the Alibaba Group founded the brand "Taobao", in Chinese "淘宝" at www.taobao.com, which is commonly known as "淘宝网" in Chinese. The website itself is a Chinese language business-to-consumer ("**B2C**") and consumer-to-consumer ("**C2C**") internet retail platform, focused on Chinese consumers.

In the last ten years, the C2C platform operated under the "Taobao" brand ("**Taobao Marketplace**") has grown to become one of the China's largest online retail platforms as of June 2012 consisting of more than 500 million registered users. The Taobao Marketplace holds over 800 million products listings on its websites. In addition, the Taobao Marketplace receives more than 50 million unique visitors daily and is acknowledged as one of the world's top 20 most visited websites according to the information provided by Alexa and Double Click Ad Planner by Google, Inc.

As early in 2008, Alibaba Group introduced the brand of "Taobao Mall", a business-to-business consumer (B2C) platform accessible from its Taobao Marketplace, namely: <http://mall.taobao.com> or <http://mall.taobao.com.cn> ("**Taobao Mall**").

In 2010, Alibaba Group rebranded “Taobao Mall” as “Tmall” (which is an abbreviation of the Complainant’s Taobao Mall trade mark) giving it an independent website located at <www.tmall.com> (“*Tmall.com*”)(in Chinese, “*天猫*”). Since its introduction in 2008, Taobao Mall as well as the Tmall.com Marketplace has grown to become an online independent brand shopping landmark.

On 21 October 2010, the Disputed Domain Name “tmalll.com” was registered by WhoisGuard, and the holder of the contested domain name is Song Bin, as noted by the Registrar as well as the website <www.domaintools.com>.

On 1 November 2010, “Tmall.com” has more than a 50% share of the B2C online retail market in the Mainland of China (“*PRC*”).

It is noteworthy that Alibaba Group and its subsidiaries, has offices in over seventy (70) cities across China, Hong Kong, Taiwan, Korea, India, Japan, Korea, Singapore, USA as well as in Europe. For the year ended 31 December 2011 and the first quarter of 2012 ending on 31 March 2012, Alibaba.com alone reported total revenue of about RMB 6.41 billion and RMB 1.59 billion respectively, which achieved a respective year-on-year revenue growth of about 15.5% and 3.7%.

The growth of Alibaba, and the success of the “Taobao” and “Taobao Mall”/ “Tmall” services, have garnered a significant amount of media attention and resulted in a high public profile for Alibaba Group and its brands globally.

In 2013, Tmall.com has more than 400 million registered users, featuring more than 70,000 major multi-national and Chinese brands such as adidas, Lenovo, Uniqlo as well as Proctor and Gamble.

In relation to advertisement and promotion expenditures, the Complainant and its subsidiaries have been promoting the “TAOBAO” brand since 2003 via the Internet and through publicity and advertising in trade press and other print media.

Since, the introduction of Taobao Mall in 2008, the Complainant has spent millions of dollars annually to promote the “TAOBAO MALL” or “TMALL” trademarks. For instance, the Complainant invested approximately RMB 270 million in 2010 and

more than RMB 480 million in 2011 in advertising as well as promoting the “TAOBAO MALL” and “TMALL” brands in the PRC.

The Complainant is the owner of Hong Kong trademark registration number 301029339 (“*Trade Mark*”) with an actual registration date of 10 January 2008. The Trade Mark relates to a mark make up of letters “淘宝网 Taobao.com”. The Trade Mark is currently registered in Class 9, Class 35, Class 38 and Class 42:

“Class 9

Software for processing electronic payments to and from others; authentication software; recorded computer programs; recorded computer programs; computer programs (downloadable software); computers; computer peripheral devices; electronic publications (downloadable), pre-recorded audio tapes, CD-ROMs, discs and video tapes featuring information in the fields of hobbies, collecting and auctions; computer software for use in the search and retrieval of computerized information on hobbies, collectibles, auctions and products accessed from global information networks and network systems; parts and fittings for all the aforesaid goods; all included in Class 9.

Class 35

Business advisory services relating to facilitating the transaction of business via local and global computer networks, providing computerized online ordering services, advertising of goods and services of other via local and global computer networks; international import and export agency services; rental of advertising space on communication media; advertising services; market research and consulting services; on-line trading services relating to electronic auctioneering and providing online business evaluation relating thereto; online retail services of consumer products; all included in Class 35.

Class 38

Providing electronic mail and electronic mail forwarding service providing access to a web site on a global computer network by which third parties can offer goods and services, place and fulfill orders, enter into contracts and transact business; providing computer links to third party web sites to facilitate e-commerce and real world business transactions; providing access to electronic

bulletin boards for the posting and transmission of messages among and between computer users concerning products, services and business opportunities; providing access to electronic calendar; address book and notes feature, via local and global computer networks; providing access to an interactive web sites on a global computer network for third parties to post information, respond to requests and place and fulfill orders for products, services and business opportunities; messages and images; telecommunications services; electronic transmission of data and information; information, advisory and consultancy services relating to all aforesaid services; providing an online interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network; providing computer access and leasing access time to online interactive bulletin boards and databases for all the aforesaid purposes; all included in Class 38.

Class 42

Computer services; computer programming; computer system software services; providing direct connection services between computer users for exchanging data; computer software design; computer system design; design and development of computer software and hardware; design and development of web pages; hosting web pages of others; information, advisory and consultancy services relating to all the aforesaid services; all included in Class 42.”

The Complainant is also the owner of Hong Kong trademark registration number 301756198 (“**Trade Mark**”) with an actual registration date of 5 November 2010. The Trade Mark relates to a mark make up of letters “TMALL”. The Trade Mark is currently registered in Class 9, Class 16, Class 35, Class 38, Class 41 and Class 42.

In the PRC, the Complainant is the owner of the PRC trademark registration number 3575304 (“**Trade Mark**”) with an actual registration date of 7 December 2004. The Trade Mark relates to a mark make up of letters “Taobao.com”. The Trade Mark is currently registered in Class 9:

“计算机软件(已录制);磁性识别卡;电子字典;已录制的计算机操作程序;计算机游戏软件;电子出版物(可下载);计算机程序(可下载软件);已录制的计算机程序(程序)”

The Complainant is also the owner of PRC trademark registration number 3575305 (“*Trade Mark*”) with an actual registration date of 7 April 2008. The Trade Mark relates to a mark make up of letters “Taobao.com”. The Trade Mark is currently registered in Class 35:

“核定服务项目（第 35 类）

数据通讯网络上的在线广告；替他人作中介（替其他企业购买商品及服务）；在计算几档案中进行数据检索（替他人）；在通讯媒体上出租广告空间；直接邮件广告；商业信息代理；组织商业或广告展览；推销（替他人）；将信息编入计算机数据库；广告代理；广告宣传本的出版；广告传播；货物展出；广告策划（截止）”

Additionally, the Complainant is also the owner of PRC trademark registration number 6797102 (“*Trade Mark*”) with an actual registration date of 28 April 2010. The Trade Mark relates to a mark make up of letters “淘宝商城 Taobao mall”. The Trade Mark is currently registered in Class 38.

Furthermore, the Complainant is the owner of PRC trademark registration number 6797103 (“*Trade Mark*”) with an actual registration date of 21 December 2010. The Trade Mark relates to a mark make up of letters “淘宝商城 Taobao mall”. The Trade Mark is currently registered in Class 35.

In 14 May 2013, the Complainant, through its Complaint, asserted that, “*Due to vast number of trade mark registrations and the Complaint has for Taobao/Tmall Trade Marks, it is impracticable for the Complainant to provide copies of all registration certificates/extracts from official trademarks databases*”. Nevertheless, the Complainant reinstated that they would, “*be happy to provide copies of registration certificates and/or extracts from the official trademarks databases for any Taobao / Tmall Trade Marks apart from the ones provided, upon the request by the Panel*”.

For the Respondent

The Respondent, Song Bin, is an individual who resides in the PRC.

On 21 October 2010, the Disputed Domain Name “tmall.com” was registered by

WhoisGuard, and the holder of the contested domain name, as noted by the Registrar as well as the website <www.domaintools.com> is Song Bin.

On 13 May 2013, upon filing the Complaint for the Disputed Domain Name, the ADNDRC disclosed that the Respondent is Song Bin from the PRC.

On 12 June 2013, the Respondent filed a Response to the ADNDRC-HK within the required time period (i.e. on or before 13 June 2013) thus contesting the allegations of the Complaint.

4. Parties' Contentions

The Complainant

The Complainant submits that the Disputed Domain Name is identical to the Complainant's "TMALL" trade mark, which the Complainant has rights in.

The Complainant contends that an abbreviation or component of a famous trademark may be confusingly similar to the trademark in the event that the abbreviation is well known. The Complainant drew to the Panel's attention two cases, namely, Research in Motion Limited v Fred Potter/ Berrystore/ Mill River Labs. (WIPO's Decision, Case No. D2009-0370)(Dated 5 June 2009) as well as Banco Itaú S.A v Veriene L. Miller, (WIPO's Decision, Case No. D2005-0748) (Dated 4 December 2005).

The Complainant submits that a domain name, which contains a common or obvious misspelling of a trademark, will normally be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principle component of the domain name.

Subsequently, the Complainant contends that the Disputed Domain Name is purposefully misspelled by the addition of an "l" after "tmall". It emphasised that the additional "l" does not add any distinctiveness to the look or sound of the Complainant's "TMALL" mark. This conduct, commonly referred to as "typo squatting" creates a virtually identical and/or confusingly similar mark to the Complainant's trademark under paragraph 4(a)(i) of the UDRP Policy.

Given the fact that the Complainant's domain name, namely: <tmall.com>, was transferred to and registered by the Complainant on 7 October 2010, two weeks before the Disputed Domain Name was registered by the Respondent, the Complainant submits that the Disputed Domain Name, namely <tmalll.com> is confusingly similar to <tmall.com>, which the Complainant has rights.

In relation to rights or legitimate interests in connection with the Disputed Domain Name, the Complainant submits that since their first registration in 2003, the "Taobao" or "Tmall" trademark have acquired distinctiveness through their extensive use and by its subsidiaries. Hence, the Complainant contends that the "Taobao" or "Tmall" trademarks, including the "TAOBAO", "淘宝", "TAOBAO MALL" and "TMALL" marks are recognisable to consumers as being associated with the Complainant, its affiliated companies, and their business.

The Complainant submits that the Respondent registered the Disputed Domain Name on 21 October 2010, seven years after the Complainant's adoption and first use of the "Taobao" trademarks and two years after the Complainant first began using its "TAOBAO MALL" and "TMALL" marks. Given the fame of the Taobao/Tmall Trade Marks coupled with the fact that the Complainant has not licensed, consented to or otherwise authorised the Respondent's use of its Taobao/Tmall Trade Marks, the Complainant is of the view that the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name.

The Complainant also submits that there is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name. The Respondent's name, Song Bin, in no way corresponds with the Disputed Domain Name, such that there is no apparent need for the Respondent to use the "TMALL"/"TAOBAO MALL" name.

For the foregoing reasons, the Complainant is of the view that the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name.

In relation to registration as well as using the Disputed Domain Name in Bad Faith, the Complainant submits that in the light of the worldwide fame of the "TaoBao" and "Tmall" trademarks, it is incontrovertible that the Respondent was not aware of the

Complainant's "Taobao" or "Tmall" trademarks and therefore of the Complainant's rights in the Disputed Domain Name at the time of registration of the Disputed Domain Name.

It is the Complainant's assertion that the Respondent has been engaged in a pattern of illegitimate domain name registrations. The Complainant submits to the Panel a list of registered domain names by the Respondent. In the list, some of the domain names contain famous brands and are linked to the Respondent. For instance the following :
<Taaobao.com>; <Taebao.com>; <Taobaog.com>; <Taobaou.com>;
<Toptaobao.com>.

Subsequently, the Complainant contends that the Respondent's registration and use of the Disputed Domain Name must involve *mala fides* in circumstances where the registration and use of it was and continues to be made in full knowledge of the Complainant's prior rights in the "Taobao" or "Tmall" trademarks. Furthermore, the Complainant contends that the Respondent did not seek permission from the Complainant for the registration or use of the Disputed Domain Name. Hence, the Respondent's registration constitutes an illegitimate and deliberate manipulation of the domain name registration system.

The Complainant submits that the Respondent's conduct cannot be a mere coincidence. Given the fact that the Respondent registered the Disputed Domain Name, "tmalll.com", less than two weeks after the Complainant's registered its "tmall.com" domain name, it is possible that the Respondent was attempting to capitalise on the Complainant's goodwill in its "Taobao" or "Tmall" trademarks.

The Complainant also submits that there is no evidence to show that the Disputed Domain Name has ever been used since its registration in 2012. However, the Complainant drew to the attention of the Panel that:

"... the concept of 'use in bad faith' is not limited to positive action and that inaction is within the concept, i.e. inactivity by the Respondent may therefore amount to 'the use of domain name in bad faith'..."

For the foregoing reasons, the Complainant is of the view that the Respondent has registered and is using the Disputed Domain Name in bad faith in accordance with paragraph 4(a) (iii) of the UDRP Policy.

The Respondent

The Respondent submits that the registration status of the “TMALL” trademark is “under examination”. As such, the Respondent contends that the “TMALL” trademark is yet to be registered by the Complainant in China.

The Respondent also submits that the word “T” does not merely refer to an abbreviation of “Taobao” or “Tmall”. In fact, the Respondent is of the view that “*T can mean a lot of words in English. For Example: Tesco (A famous [famous] shopping market), Target (A famous USA shopping market), toy, table, ticket, tools, text, today*”

Furthermore, the Respondent also submits that the Disputed Domain Name was registered on 21 October 2010. However, the Complainant registered the domain name <tmall.com> at a later date of 1 November 2010. Additionally, the Respondent noted that, “*I cannot know T means taobao (a chinese pinyin, T is an English letter, T should mean English word), and I cannot know tmall means taobao mall.*”

The Respondent is of the view that the Complainant’s trademark, namely “Taobao Mall” is not associated with the Disputed Domain Name. Furthermore, the Respondent is also of the view that the Disputed Domain Name is not related to the domain name <tmall.com>.

The Respondent submits that for two years the Respondent has been the owner of the Disputed Domain Name. As such, the Respondent contends that the Respondent has the legitimate rights and interests in the Disputed Domain Name.

The Respondent further submits that the Respondent has never used the Disputed Domain Name in bad faith. The Respondent contends that “*this name is in develop, I have bought webhosting for tmalll.com, this is why the DNS of this domain name is from vodien.com where I bought the webhosting*”.

The Respondent also submits a list of domain names which the Complainant has not registered, they include the following:

“

Tmall.cn

Tmall.com.cn

Tmall.net.cn

Tmall.net

Tmall.org

Tmall.biz

Tmall.us

Tmall.cc

Tmall.co.uk

Tmall.com.tw

Tmall.co.kr

Tmall.jp

Tmall.ca

Tmall.tv

Tmall.la

Tmall.vn

Tmall.in

Tmall.”*

The Respondent contends that the domain names thereon do not belong to the Complainant. As a result, the Respondent is of the view that the Complainant “*can't say only taobao mall can use tmall, complainant can't say all domain name with 'tmall' in it belong to complainant*”.

For the foregoing reasons, the Respondent is of the view that the Respondent has rights and legitimate interests in the Disputed Domain Name in question.

5. **Findings**

A. **Language of the Proceedings**

According to Paragraph 11(a) of the ICANN Rules, it states that:

“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.”

In the present case, the Parties had not agreed to a particular language for these proceedings. Nevertheless, as noted by the ADNDRC-HK, the Registration Agreement is in the English language as confirmed by the Registrar in its email of 3 May 2013. As a result, in accordance with Paragraph 11(a) of the ICANN Rules, the language of the administrative proceedings shall be in the English language. Although the Respondent did send an email to ADNDRC-HK on 20 May 2013 requesting that ADNDRC-HK provide it with details of the Complaint in the Chinese language. The ADNDRC-HK responded on 24 May 2013, stating that the proceedings shall be conducted in English language, unless the Panel decides otherwise. The Respondent subsequently filed its Response on 12 June 2013 in the English language. In these circumstances, the Panel considers that it would be appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in English language.

B. **Discussion and Findings**

Having considered all the documentary evidence submitted by the Complainant as well as the Respondent before me, in accordance with Paragraph 4(a) of the ICANN Policy, which is applicable hereto, the Complainant has the burden of proving that:

- (i). the Disputed Domain Name is **identical or confusingly similarity** to a trade mark or service mark in which the Complainant has rights; and
- (ii). the Respondent has **no legitimate interests** in respect of the Disputed Domain Name; and

(iii). the Disputed Domain Name is **registered** and is being **used in bad faith**.

(1). Identical/confusing similarity

Paragraph 4(a)(i) of the ICANN Policy requires the Complainant to prove that the Disputed Domain Name is **identical** or **confusingly similar** to a trademark or service mark which the Complainant has rights.

In the case of Veuve Clicquot Ponsardin, Maison Fondée en 1772 v The Polygenix Group Co. (WIPO's Decision, Case No. D2000-0163) (Dated 1 May 2000) ("**Veuve Clicquot**"), the Presiding Panelist, the Hon. Sir Ian Barker QC noted that:

*"The Complainant is the owner of the VENVE CLICQUOT mark and name. It produces world-famous Veuve Clicquot champagne in a variety of styles and currently sells it in 120 countries. Veuve Clicquot champagne has been well-known throughout the world for 200 years. The Complaint or its predecessors and associated corporations own registered trademarks of VEUVE CLICQUOT in many counties, including France and the United States. Veuve Clicquot champagne **has been the subject of many articles and other literacy works**. It has featured in many famous movies. **The Complainant has invested much money, time and effort to develop and promote Veuve Clicquot champagne worldwide**. Veuve Clicquot is recognized as a leading champagne in many authoritative works on wine"*

Subsequently, the Presiding Panelist concluded that:

*"The domain name 'VEUVELICQUOT.ORG' is **obviously identical or confusingly similar** to a trademark to the Complaint's mark. The Panel so decides"*

Banco Itaú S.A v Veriene L. Miller, (WIPO's Decision, Case No. D2005-0748) (Dated 4 December 2005) ("**Banco Itaú**") was another WIPO's Decision, where the Panel said:

"The fact that a generic and descriptive term 'facil' has been added to the

*distinctive element ITAÚ does not deter this Panel, the **readers and users of Internet** that Internet users **will be confused and associate the domain name in the dispute with the Trademarks**, trade name and numerous domain names of the Complainant. The Panel finds that the domain name in dispute is confusingly similar with the ITAÚ Trademark of the Complainant”*

Moreover, in PepsiCo, Inc v PEPSI, SRL (a/k/a P.E.P.S.I) v EMS COMPUTER INDUSTRY (a/k/a EMS), (WIPO’s Decision, Case No. D2003-0696) (Dated 28 October 2003) (“*PepsiCo, Inc*”), the Sole Panelist, Kiyoshi I. Tsuru, emphasised that:

*“... the Panel finds that the disputed domain names are **confusingly similar** to Complainant’s trademarks ‘PEPSI’. All of the contested domain names fully incorporate the trademark ‘PEPSI’, which is a **distinctive mark**. The mere **addition of common terms** such as ‘sports’, ‘basketball’, ‘soccer’, ‘volleyball’, ‘rugby’ and the like to the ‘PEPSI’ mark, **does not change the overall impression of the designations as being a domain names connected to the Complainant ...**”*

By applying the principles stipulated in Veuve Clicquot, Banco Itaú and PepsiCo, Inc, this Panel has to consider whether the Disputed Domain Name, namely, “tamall.com” is **confusingly similar** and has a **distinctive mark** with the Complainant’s trademarks.

In the present case, the Complainant is the owner of the Hong Kong trademark registration number 301029339 (“*Trade Mark*”) with an actual registration date of 10 January 2008. The Trade Mark relates to a mark make up of letters “淘宝网 Taobao.com”. The Trade Mark is currently registered in Class 9, Class 35, Class 38 and Class 42.

The Complainant is also the owner of the Hong Kong trademark registration number 301756198 (“*Trade Mark*”) with an actual registration date of 5 November 2010. The Trade Mark relates to a mark make up of letters “TMALL”. The Trade Mark is currently registered in Class 9, Class 16, Class 35, Class 38, Class 41 and Class 42.

In the PRC, the Complainant is the owner of the PRC trademark registration number

3575304 (“*Trade Mark*”) with an actual registration date of 7 December 2004. The Trade Mark relates to a mark make up of letters “TaoBao.com”. The Trade Mark is currently registered in Class 9.

The Complainant is also the owner of PRC trademark registration number 3575305 (“*Trade Mark*”) with an actual registration date of 7 April 2008. The Trade Mark relates to a mark make up of letters “TaoBao.com”. The Trade Mark is currently registered in Class 35.

Additionally, the Complainant is also the owner of PRC trademark registration number 6797102 (“*Trade Mark*”) with an actual registration date of 28 April 2010. The Trade Mark relates to a mark make up of letters “淘宝商城 Taobao mall”. The Trade Mark is currently registered in Class 38.

However, the Respondent registered the Disputed Domain Name through a private service, namely, ECOM, Inc on 21 October 2010. In contrast, the Complainant registered the first Hong Kong trademark “Taobao.com” on 10 January 2008 and registered the first PRC “TaoBao.com” trademark on 7 December 2004, two years and almost six years retrospectively before the Respondent registered the Disputed Domain Name.

Apparently, the trademark “TaoBao Mall” or “Tmall” is the same and it is a **distinctive** part of the Disputed Domain Name in question. In saying so, the Panel is of the opinion that the additional “l” does not add any distinctiveness to the look as well as the pronunciation of the Complainant’s “Tmall” trademark. On this basis, the Panel is of the view that the additional “l” **does not change the overall impression of the designations as being a domain name connected to the Complainant’s “Tmall” (or <tmall.com>) trademark.** The Panel is also of the view that such conduct creates a virtually identical and/or confusingly similar mark to the Complainant’s trademark.

On this basis, this Panel concludes that the Complainant **has discharged** its burden of proof to establish the elements of identical and confusingly similar mark in accordance with Paragraph 4(a)(i) of the ICANN Policy.

(2). **Rights or Legitimate Interests of Respondent**

Paragraph 4(c) of the ICANN Policy sets out examples of circumstances where the Respondent may have rights or legitimate interests over the Disputed Domain Name:

*“c. **How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name to Complaint** ... any of the 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 preparation 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 individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service marks; **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.**”*

In the case of PepsiCo, Inc, the Panel noted that:

*“The Respondent **has not submitted any evidence** showing that they have any rights or legitimate interests in the disputed domain names.*

*The Complainant claims that **it denies having granted the Respondents any license, permission or other right to use any domain name** incorporating the Complainant’s trademark ‘PEPSI’ (see *PepsiCo, Inc. v. Diabetes Home Care, Inc. and DHC Services, WIPO Case No. D2001-0174, (March 28,2001)*).*

By the time the Respondents registered the contested domain names, i.e., March

15,2002,; April 5, 2002,; May 24,2002,; May 31,2002,; July 9, 2002; and November 2, 2002, the Complainant had been using its trademark 'PEPSI-COLA' for more than 100 years (since 1898), and its trademark 'PEPSI' for more than 90 years (since 1911)"

Subsequently, the Panel concluded that:

"The Respondents are misleadingly diverting Internet users to a gambling website, which appears to be commercial. This Panel has found no legitimate, noncommercial, bona fide, or fair use of the contested domain names, which in turn resolve to the above mentioned gaming site."

In the present case, the "Taobao Mall" or "Tmall" trademarks **are distinctive part of the Disputed Domain Name**. As akin to the facts in PepsiCo, Inc., The Complainant had been using its "Taobao Mall" or "Tmall" trademarks for 5 years (since 2008). Also, the Panel is of the view that the word "tmall" does not in any way reflect the Respondent's name ("Song Bin") nor has the Respondent registered a company name or business name reflecting the word "tmall". Thus, there is **NO evidence** suggesting that "tmall" is the Respondent's legal name.

Likewise, as suggested by the Complainant, there is **NO evidence** suggesting that the Respondent is **commonly known** to the name of "tmall". In fact, the Complainant submits that its Group companies has **NEVER** authorized, licensed or otherwise consented the Respondent to use the marks of "Taobao" or "Tmall" or any other name or mark of the Complainant's Group.

This Panel appreciates that the Respondent has paid the registration fee to register the Disputed Domain Name and had used such for two years. Nevertheless, the Panel is of the view that the Respondent's registration of the Disputed Domain Name does constitute **misleadingly diverting Internet users, which appears to be commercial**. Thus, this Panel is of the view that **there is no legitimate, noncommercial, bona fide or fair use of the contested domain name**.

As such, this Panel concludes that the Respondent has no rights and/or legitimate interests in respect of the contested domain name.

(3). **Bad Faith**

Paragraph 4(b) of the ICANN Policy sets out four (4) factors in which the Panel will need to examine to determine whether the Respondent has registered and used the Disputed Domain Name in bad faith. The four (4) factors are as follows:-

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

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; **or***
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; **or***
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; **or***
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complaint’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.”*

In the case of Wachovia Corporation v Peter Carrington (WIPO's Decision, Case No. D2002-0775) (Dated 2 October 2002) ("*Wachovia Corporation*"), the Panel endorsed the view in AltaVista Co. v Yomtobian, (WIPO's Decision, Case No. D2000-0937) (Dated 13 October 2000) at paragraph [6], where it noted that **misspellings alone** are:

*"6. ... **sufficient to prove bad faith** under paragraph 4(b)(iv) of the Policy because Respondent has **used these names intentionally to attract, for commercial gain**, Internet users to his website by **creating a likelihood of confusion** with the Complainant's mark."*

In the meantime, in the case of Telstra Corporation Limited v Nuclear Marshmallows (WIPO's Decision, Case No. D2000-0003) (Dated 18 February 2000) ("*Telstra Corporation*"), the Panelist at paragraph [7.8] noted that:

*"7.8 Has the Complainant proved the additional requirement that the domain name 'is being used in bad faith' by the Respondent? ... There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name. There is no evidence of advertising, promotion or display to the public of the domain name. Finally, there is no evidence that the Respondent has offered to sell, rent or otherwise transfer the domain name to the Complainant, a competitor of the Complainant, or any other person. In short, **there is no positive action being undertaken by the Respondent in relation to the domain name.**"*

In gist, the Presiding Panelist, Andrew F. Christie at paragraph [7.9] concluded that:

*"7.9 This fact does not, however, resolve the question ... the relevant issue is **not whether the Respondent is undertaking a positive action in bad faith** in relation to the domain name, **but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith.** The distinction between undertaking a **positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one.** The significance of the distinction is that the concept of a domain name 'being used in bad faith' is not limited to positive action; action is within the concept. That is to say, it is possible, **in certain circumstances, for inactivity by the Respondent to amount***

to the domain name being used in bad faith”

Likewise, in the case of Research in Motion Limited v Fred Potter/ Berrystore/ Mill River Labs. (WIPO’s Decision, Case No. D2009-0370)(Dated 5 June 2009) (“*Research in Motion Limited*”), the Panelist said that:

*“The disputed domain names <berrystore.app.com> and <berrystore.mobi> are **effectively unused, or passively held.** It has long been **generally accepted** that ... a **Respondent cannot avoid a finding of bad faith use** by registering a well-known trademark as a domain name and then **parking it unused** (Telestra Corporation Limited v Nuclear Marshmallows, WIPO Case No. D2000-0003).”*

In this present case, as akin to the fact in Wachovia Corporation, this Panel is of the view that the Disputed Domain Name is purposefully misspelled by the addition of an “l” after “tmall”. On this note, it conveys that the Respondent’s registration of the Disputed Domain Name does constitute “bad faith” as stipulated in Paragraph 4(b)(iv) of the ICANN Policy. This Panel is also of the view that there is a strong possibility that the Respondent **“has used these names intentionally to attract, for commercial gain ... by creating a likelihood of confusion with the Complainant’s mark.”**

Furthermore, the Respondent, being an individual resided in the PRC, **must have been aware of the Complainant’s prior rights** as well as **interests** in the Disputed Domain Name by virtue of the Complainant’s reputation in the trademarks “Taobao” and “Tmall” in the PRC and internationally as of the date when the Respondent registered the Disputed Domain Name.

Additionally, the Panel is of the view that the “Respondent registration of the Disputed Domain Name less than 2 weeks after the Complainant registered its <tmall.com> domain name” **cannot** be a **mere coincidence.**

The mere explanation of what has happened is that the Respondent’s motive in registering the Disputed Domain Name (“tmall.com”) seems to be, as the Complainant says “Respondent’s registration and use of the Disputed Domain Name must involve **mala fides** in circumstances where the registration and use of it was and continues to be made in the **full knowledge of the Complainant’s prior rights in the**

***Taobao Trade Marks**, and in circumstances where the **Respondent did not seek permission from the Complainant** ... the owner of the trade marks, for such **registration and use**.”. On this basis, the Panel is of the opinion that the Respondent registered the Disputed Domain Name in order to deliberately capture the goodwill of “Taobao Mall” or “Tmall” trademarks as well as to gain from the goodwill associated with the prescribed trademarks.*

It is noteworthy that the Disputed Domain Name was not in use and there is no evidence that the Disputed Domain Name has been used by the Respondent since its registration in 2012.

This Panel appreciates the Respondent’s submissions that the Respondent has “never use it in bad faith”. Nevertheless, by applying the principles as stipulated in Telstra Corporation and Research in Motion Limited, the Panel is of the view that the inactivity or passive holding of the Disputed Domain Name for more than two years, coupled with the indications hereinabove, does constitute evidence of registration and that the Disputed Domain Name is being used in bad faith in accordance with Paragraph 4(b) of the ICANN Policy.

By applying the principles stipulated in Wachovia Corporation, Telstra Corporation, Research in Motion Limited as well as the indications stated above, the Panel is of the view that the Respondent has **NO good cause or any justifiable reasoning** of using the Disputed Domain Name.

For the foregoing reasons, the Panel concludes that the Respondent **registered** and used the contested domain name in **bad faith**.

6. Conclusion

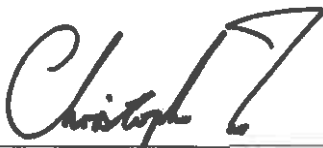
The Complainant has proved its case. It has a registered trademark in the name of “tmall” to which the contested dispute name **is confusingly similar**.

The Respondent has shown **no right or legitimate interest** in the Disputed Domain Name.

The Complainant has proved that the Respondent has **registered** and **used** the Disputed Domain Name **in bad faith**.

For the foregoing reasons and in accordance with Paragraph 4 of the ICANN Policy, the Panel concludes that the relief requested by the Complainant be granted and do hereby ordered that the Disputed Domain Name, namely, “**tmall.com**” **BE TRANSFERRED** to the Complainant **Alibaba Group Holding Limited**.

Dated: 12 July 2013

A handwritten signature in black ink, appearing to read "Christopher To", written over a horizontal line.

Christopher To