



(Hong Kong Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1400668
<b>Complainant:</b>	Alibaba Group Holding Limited
<b>Respondent:</b>	Alexey Gurov
<b>Disputed Domain Name(s):</b>	open-taobao.com; tao-0.com; tao-api.info; tao-imagine.com; tao-mama.com; tao-sp.org; tao-бао.com (xn----7sbbd7ddw.com); таobao-фопым.com (xn----7sbad1dicbsmtj.com); taobao-sp.org.

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**1. The Parties and Contested Domain Name**

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

The Respondent is Alexey Gurov, whose address is Suvorova 15-47, Tomsk, 634063, Russia

The domain names at issue are open-taobao.com; tao-0.com; tao-api.info; tao-imagine.com; tao-mama.com; tao-sp.org; tao-бао.com (xn----7sbbd7ddw.com); таobao-фопым.com (xn----7sbad1dicbsmtj.com); taobao-sp.org (the “Disputed Domain Names”). The Disputed Domain Names are registered by Respondent with the following Registrars:

The domain names <open-taobao.com>, <tao-api.info> are registered with eNom Inc., whose address is 5808 Lake Washington Blvd. NE Ste. 300, Kirkland, WA 98033, USA.

The domain name <tao-0.com> is registered with REG.RU LLC., whose address is Building 1, 3, Vasiliya Petuskova St, Moscow, Russia.

The domain names <tao-imagine.com>, <tao-mama.com>, <tao-sp.org>, <tao-бао.com>, <таobao-фопым.com>, <taobao-sp.org> are registered with Regtime Ltd, whose address is 17, Moskovskoe shosse, Office 2103, Samara 443013, Russian Federation.

**2. Procedural History**

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center”) on November 17, 2014. On November 18, 2014, the Center transmitted by email to eNom, Inc., REG.RU LLC and Regtime Ltd. requests for registrar verification for the

Disputed Domain names. On November 18, 2014, REG.RU LLC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant, providing his contact details and informing that the registrar and the Respondent did not enter into a written Registration Agreement. On November 26, 2014, the Center transmitted by email to REG.RU LLC a request to confirm language of the Registration Agreement. On December 1, 2014, the registrar notified the Center that the language of the Registration Agreement was Russian.

On November 19, 2014, eNom, Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing his identical contact details. A copy of the eNom, Inc.'s Registration Agreement on file shows that the language of the Registration Agreement is English.

On November 20, 2014, Regtime Ltd. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant, providing his contact details and informing that the language of the Registration Agreement is Russian.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Centre's Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

Under Paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 2, 2014. Under Paragraph 5(a) of the Rules, the due date for filing a Response by the Respondent was December 22, 2014. The Respondent submitted no response by this deadline date. The Center notified the Respondent of its default on December 23, 2014.

The Center appointed Olga Zalomiy as the sole panelist in this matter on December 30, 2014. The Panel finds 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. The Panel is proficient in both the English and the Russian languages.

### **3. Factual background**

The Complainant is a global leader in e-commerce. It operates its business through several subsidiaries and affiliates (the "Alibaba Group"). In May 2003, Alibaba Group founded the brand TAOBAO at "www.taobao.com," a Chinese language consumer-to-consumer ("C2C") Internet retail platform, focused on Chinese consumers. In the last ten years, its C2C platform operated by Alibaba Group under the TAOBAO brand ("Taobao Marketplace") has grown to become one of China's largest online retail platforms and the primary online shopping destination in China. The Complainant owns numerous trademark registrations in the TAO and TAOBAO trademarks around the world (the "TAOBAO trademarks"). The TAOBAO trademarks have become well-known to consumers.

The Respondent is an individual named Alexey Gurov. The Respondent has been a respondent in two prior proceedings initiated under the Uniform Rapid Suspension System, i.e. *Alibaba Group Holding Limited v. Alexey Gurov*, ADNDRC Case No. HKS-1400004 and *Alibaba Group Holding Limited v. Alexey Gurov*, ADNDRC Case No. HKS-1400012 that involved the following domain names: <tao.email> and <taobao.email>.

<taobao.website>, <taobao.domains>, <taobao.ink>, <taobao.expert>, <taobao.ninja>, <taobao.partners>, <taobao.today>, <tao.land>, <tao.zone> (the "URS Cases").

The WhoIS search result for <tao-0.com> domain names reveals that that the Respondent identified "Merchant Global Enterprise Ltd" as his organization and stated the same address in Russia as his contact address stated in his registration information for the <open-taobao.com> and <tao-api.info>. The WhoIS search results for six of the Disputed Domain Names (<tao-imagine.com>, <tao-mama.com>, <tao-sp.org>, <taobao-sp.org>, <tao-bao.com> and <таobao-форум.com>) reveals that the Respondent identified "Taobao Ltd" as his organization and stated an address in China.

The Respondent registered <open-taobao.com> domain name on 18 August 2011. The "www.open-taobao.com" website is an online marketplace, which incorporates the Complainant's Taobao Trade Marks and allegedly sells products from China and Hong Kong.

The Respondent registered <tao-imagine.com> domain name on 6 November 2012. The "www.tao-imagine.com" website is a website that allegedly assists users to help search for and purchase products from the Complainant's Taobao Marketplace. It also links to the Russian online shopping website "www.выгоднокупи.рф," which incorporates Complainant's Taobao Trade Marks. "выгоднокупи" consists of two Russian words: "выгодно" and "купи", which means "buy at competitive prices."

On August 15, 2012, the Respondent registered <tao-api.info> domain name. The Respondent registered <tao-bao.com> and <таobao-форум.com> domain names on 5 May 2013. The Respondent registered <tao-mama.com> domain name on 22 February 2013. The next day, the Respondent registered <tao-sp.org> and <taobao-sp.org>. Finally, the Respondent registered <tao-0.com> on July 12, 2014. The Disputed domain names <tao-0.com>, <tao-api.info>, <tao-mama.com>, <tao-sp.org>, <tao-bao.com>, <таobao-форум.com>, <taobao-sp.org> revert to parking pages (the "Inactive Domains").

On December 2, 2014, the law firm representing the Complainant emailed to the Respondent copies of the Complaint and annexes (the "Complainant's December 2, 2014 communication"). The next day, a person identifying herself as "Diana" sent the following email to an attorney representing the Complainant: "Dear Karen, Can you please inform when our domains will be taken away? And what can we do to keep them? Is there any way to solution? Waiting for your replay. Thank you!" (the "December 3 Respondent's email"). The December 3, 2014 Respondent's e-mail string showed the forwarded Complainant's December 2, 2014 communication. On the same day, an attorney representing the Complainant wrote to the Respondent that its "client is not interested in entering into negotiations. Our client's rights have been infringed multiple times by Mr. Alexey Gurov, and, it therefore intends to let the current proceedings continue accordingly."

On December 22, 2014, the Respondent sent an e-mail to the Center with the following text: "Hello, tell me why you are interested only in these domains? There are still such as "vivatao.com", "kupunatao.com", "taobao.ru"" (the "December 22 Respondent's email"). The December 22 Respondent email's string showed the December 22, 2014 e-mail from the Center to the parties indicating that the Respondent submitted no response to the Complaint.

On December 29, 2014, the Respondent sent an e-mail to the Panel with the following text:

“Re.: НК-1400668 <open-taobao.com>, <tao-0.com>, <tao-api.info>, <tao-imagine.com>, <tao-mama.com>, <tao-sp.org>, <tao-бао.com> (xn----7sbbd7ddw.com), <таobao-форум.com> (xn----7sbad1dicbsmtj.com) & <taobao-sp.org> \_ Complaint Form and Annexures

Здравствуйте, я получил письма об этих доменных именах. Их хотят отобрать, как я понял. Скажите, есть ли способ их сохранить?”

The text in Russian means “Hello, I received messages about these domain names. As I understood, they want to take them from me. Let me know, if there a way to keep them?”

#### 4. Parties’ Contentions

##### A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Complainant asserts that the Disputed Domain Names are identical and/or confusingly similar to the TAOBAO trademarks in which the Complainant has rights. The Complainant claims it registered numerous TAO and TAOBAO trademarks around the world, so it has rights in the TAO and the TAOBAO marks. The Complainant alleges that the Disputed Domain Names <open-taobao.com>; <tao-0.com>; <tao-api.info>; <tao-imagine.com>; <tao-mama.com>; <tao-sp.org>; and <taobao-sp.org> incorporate its TAO or TAOBAO marks in their entirety. According to the Complainant, addition of the generic words “open,” “imagine,” “mama,” the number “0”, the hyphen and the letters “api” and “sp”, do not negate the confusing similarity between the Complainants’ TAO or TAOBAO trademarks and the abovementioned Disputed Domain Names. The Complainant further asserts that the Disputed Domain Names <tao-бао.com> (xn----7sbbd7ddw.com) and <таobao-форум.com> are also confusingly similar to the TAOBAO trademark, because they incorporate the TAOBAO trademark in its entirety. The Complainant claims that use of the Cyrillic characters “т” and “б” does not negate the confusing similarity between the trademark and the Disputed Domain Names. The Complainant asserts that the word “таobao” is a widely used as the Russian translation of the Complainant’s TAOBAO trademark. The Complainant alleges that adding the generic Russian word “форум” (which means “forum” in English) in the Disputed Domain Name <таobao-форум.com> does nothing to distinguish it from the Complainant’s trademark. Finally, the Complainant claims that the generic Top Level Domain (“gTLD”) suffix “.com” should be disregarded from consideration in the likelihood of confusion analysis.
- ii. The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The Complainant claims that the TAOBAO or TAO trademarks have no meaning in English or Russian other than in relation to the Complainant and its trademarks, which were that were registered between eight and eleven years prior to the Respondent’s registration of the Disputed Domain Names. The Complainant alleges that the Respondent owns no trademark rights in either the TAOBAO or TAO trademark. The Complainant

claims it has not licensed or otherwise authorized the Respondent to use its TAO or TAOBAO trademarks with the Disputed Domain Names. The Complainant further claims there is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Names because neither the Respondent's name- Alexey Gurov, nor his Organization's name – Merchant Global Enterprise Ltd, do not correspond to the Disputed Domain Names. The Complainant contends that in the registration information for the Disputed Domain Names <tao-imagine.com>; <tao-mama.com>; <tao-sp.org>; <taobao-sp.org>, <tao-бао.com> and <таобао-фопым.com> the Respondent identified as his organization Taobao Ltd, an organization with an address in China. The Complainant claims that the Respondent's use of the Taobao Ltd attempts to frustrate the Complainant's efforts to recover the Disputed Domain Names and it doesn't afford the Respondent with any rights or legitimate interests in the Domain Names. The Respondent asserts that passive holding of the Disputed Domain Names <tao-0.com>, <tao-api.info>, <tao-mama.com>, <tao-sp.org>, <taobao-sp.org>, <tao-бао.com> and <таобао-фопым.com> (the "Inactive Domains") confers no rights or legitimate interests on the Respondent in the abovementioned Disputed Domain Names. According to the Complainant, the Respondent is using the <open-taobao.com> and <tao-imagine.com> domain names to unfairly capitalize on the confusing similarity between the Complainant's TAOBAO and TAO trademarks and the Disputed Domain Names by attracting and redirecting Internet users to its websites associated with the Disputed Domain Names.

- iii. The Complainant asserts that the Disputed Domain Names have been registered and are being used by the Respondent in bad faith because the Respondent has no rights or legitimate interest in the Disputed Domain Names. The Complainant claims that the Respondent has engaged in a pattern of bad faith because besides the Disputed Domain Names the Respondent also registered <tao.email>, <taobao.email>, <taobao.website>, <taobao.domains>, <taobao.ink>, <taobao.expert>, <taobao.ninja>, <taobao.partners>, <taobao.today>, <tao.land> and <tao.zone> that incorporated the Complainant's TAO or TAOBAO trademarks. The Complainant alleges that the Respondent is also connected with respondent in a previous domain name dispute involving <Taobao.com> domain name because websites associated with the <Taobao.com> domain name and the <open-taobao.com> Disputed Domain Name, and the registrant company's name, address and banking information were virtually identical. The Complainant alleges that the Respondent knew about the Complainant's trademarks when he registered the Disputed Domain Names, because the Complainant registered the TAO and TAOBAO trademarks eight years before the Respondent registered the first of the Disputed Domain Names, the Complainant's TAO and TAOBAO trademarks are well-known and because neither TAO, nor TAOBAO terms has meaning in English or Russian. The Complainant asserts that the Respondent must have known about the Complainant's rights because his "www.open-taobao.com" website falsely claims that the Respondent is an official partner of the Complainant's Taobao marketplace. Further, the Complainant alleges that the Respondent's registration and use of the Disputed Domain Names must involve mala fides 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 TAO and TAOBAO trademarks. The Complainant claims that the Respondent's use of "Taobao Ltd" is further

evidence of bad faith, as it further misleads users into believing that the Disputed Domain Names are operated by a company that is associated with the Complainant. The Complainant asserts that the open-taobao.com> and <tao-imagine.com> were registered to mislead and confuse Internet users into believing they are associated with the Complainant and its Taobao Trade Marks. The Complainant submits that the Respondent's use of the Inactive Domains amount to bad faith use based on the combination of all of the facts. Finally, the Complainant asserts that during 2011-2014, it filed 76 complaints against infringing domain names.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 5. Findings

### 5.1. Jurisdiction over dispute involving <tao-0.com> domain name.

In its November 18, 2014 email to the Center, the registrar REG.RU LLC advised the Center it did not enter into a written Registration Agreement with the Respondent. The Panel, therefore, feels compelled to determine whether the Panel has jurisdiction over the dispute concerning <tao-0.com> domain name.

Under Article 437 of the Civil Code of the Russian Federation, an offer to enter into an agreement for domain name registration services is a public offer. Such offer is deemed accepted by registrant when he/she pays for the registrar's services. See, Art. 438 of the Civil Code of the Russian Federation. Therefore, as soon as the Respondent paid to REG.RU LLC for its registration services, the Registration Agreement between him and the Registrar was concluded. Because the Uniform Domain Name Dispute Resolution Policy is incorporated by reference and made a part of the Registration Agreement, the Respondent submitted to jurisdiction of this Panel under paragraph 4 of the UDRP.

### 5.2. Language of the proceeding

Under Paragraph 11 of the Rules, "Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

Because there is no evidence on file showing that the Parties agreed otherwise and because the language of the REG.RU LLC's and Regtime Ltd.'s Registration Agreements is Russian, the language of the administrative proceeding regarding the following Disputed Domain Names: <tao-0.com>, <tao-imagine.com>, <tao-mama.com>, <tao-sp.org>, <tao-obao.com>, <taoobao-фопым.com> and <taobao-sp.org> shall be Russian. The language of the administration proceeding regarding <open-taobao.com> and <tao-api.info> domain names shall be English because the language of the Registration Agreement is English.

The Panel, however, determines that English should be language of this administrative proceeding regarding all of the Disputed Domain Names. It is a consensus among the UDRP panelists that the Panel's discretion to choose the language of the proceeding must be exercised in the spirit of fairness and justice to both parties considering matters such as

command of the language, time and costs<sup>1</sup>. English is a fair choice for the language of the proceeding under the circumstances of this case.

First, it is more likely than not that the Respondent understands English because the December 3 Respondent's email and the December 22 Respondent's emails were written in English and because the December 29 Respondent's email indicates that he understood text of the documents in English that the Complainant and the Center sent him.

Second, the Respondent has been involved in two Uniform Rapid Suspension System cases where English was language of the administrative proceedings: *Alibaba Group Holding Limited v. Alexey Gurov*, ADNDRC Case No. HKS-1400004 and *Alibaba Group Holding Limited v. Alexey Gurov*, ADNDRC Case No. HKS-1400012 (the "**URS Cases**").

Third, the evidence on record shows that "www.open-taobao.com" and "www.tao-image.com" websites display some content in the English language.

Fourth, the Complainant will be unfairly disadvantaged by being forced to translate the Complaint and the documents associated with this administrative proceeding into Russian.

The Panel, therefore, accepts the Complaint in the English language and determines that English should be language of this proceeding.

### **5.3. Standard of review**

It is a consensus view among UDRP panelists that "[a] respondent's default does not automatically result in a decision in favor of the complainant... [T]he complainant must establish each of the three elements required by paragraph 4(a) of the UDRP."<sup>2</sup> A panel may draw inferences from a respondent's default.<sup>3</sup>

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 is 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**

To satisfy the first UDRP element, a domain name must be "identical or confusingly similar" to a trademark, in which a complainant has rights. The Complainant demonstrated its rights in the TAO and the TAOBAO marks by submission of copies of multiple trademark registrations for the TAOBAO trademarks.

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<sup>1</sup> Paragraph 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").

<sup>2</sup> Paragraph 4.6., WIPO Overview 2.0.

<sup>3</sup> See, *Id.*

The Panel finds that the Disputed Domain Names are confusingly similar to the Complainant's TAOBAO trademarks. The test for confusing similarity under the UDRP "involves a comparison between the mark and the domain name...In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms ...typically being regarded as insufficient to prevent threshold Internet user confusion."<sup>4</sup>

The Disputed Domain Names <open-taobao.com>, <tao-0.com>, <tao-api.info>, <tao-imagine.com>, <tao-mama.com>, <tao-sp.org> and <taobao-sp.org> incorporate the Complainant's TAOBAO trademarks in their entirety. Adding merely generic or descriptive wording to the Complainant's trademark, like the prefix "open," or suffixes "0", "api," "imagine," "mama," "sp" or a hyphen where the mark constitutes the dominant part of the domain name, cannot avoid finding of confusing similarity. It is a consensus among the UDRP panelists that adding the gTLD ".com" or equivalent should be disregarded under the confusing similarity test, as it is a technical requirement of registration.<sup>5</sup>

The Disputed Domain Names <tao-бao.com> and <taobao-фorum.com> incorporate the Complainant's TAOBAO trademark in its entirety. The only differences between the TAOBAO trademark and the Disputed Domain Names are the use of the Cyrillic characters "т" and "б" instead of the English letters "t" and "b"; the addition of the hyphen ("-"); and, with regard to <taobao-фorum.com> and the addition of the generic Russian word "forum" (which means "forum" in English). The Russified spellings of the <tao-бao.com> and <taobao-фorum.com> Disputed Domain Names are confusingly similar to the TAOBAO trademark because the TAOBAO trademark remains the dominant component of the Disputed Domain Name.<sup>6</sup>

Therefore, the Panel finds that the Complainant satisfied the first UDRP element by proving that the Disputed Domain Names are identical to the Complainant's TAOBAO trademarks in which the Complainant has rights.

## **B) Rights and Legitimate Interests**

To satisfy the second UDRP element, the Complainant must make out a prima facie case showing that the Respondent has no rights or legitimate interests in the Domain Name.

It is a consensus view of the UDRP panelists that the general "standard of proof under the UDRP is "on balance" - often expressed as the "balance of probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true."<sup>7</sup>

The Panel finds it is more likely that the Respondent does not have rights or legitimate interests in the Disputed Domain Names because:

First, the Respondent probably has not been commonly known by the <tao-0.com>, <open-taobao.com> or <tao-api.info> Disputed Domain Names because neither the his name-Alexey Gurov, nor his Organization's name – Merchant Global Enterprise Ltd,

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<sup>4</sup> Paragraph 1.2., WIPO Overview 2.0.

<sup>5</sup> Paragraph 1.2. of WIPO Overview 2.0.

<sup>6</sup> See, generally, Paragraph 1.20 of WIPO Overview 2.0.

<sup>7</sup> Paragraph 4.7 of WIPO Overview 2.0.



corresponds to the <tao-0.com>, <open-taobao.com> or <tao-api.info> Disputed Domain Names. The Respondent's use of a purported Chinese company Taobao Ltd. as the "registrant's organization" in the registration information for the Disputed Domain Names <tao-imagine.com>; <tao-mama.com>; <tao-sp.org>; <taobao-sp.org>, <тао-бао.com> and <таobao-форум.com> does not confer rights in the Disputed Domain Names on the Respondent because the Complainant's registration of the TAOBAO trademarks in China predates the dates of the Respondent's registration of the Disputed Domain Names. The Respondent has also already been found lacking rights or legitimate interests in the TAOBAO mark in the URS cases.

Second, the evidence on record shows that the Respondent owns no trademark rights in the TAOBAO trademarks.

Third, the Panel accepts the Complainant's contention that the Respondent has no rights or legitimate interests in the <tao-0.com>, <tao-api.info>, <tao-mama.com>, <tao-sp.org>, <тао-бао.com>, <таobao-форум.com>, <taobao-sp.org> Disputed Domain Names that the Respondent passively holds. Passive use of a domain name "would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" ... or from "legitimate noncommercial or fair use" of the domain name..."<sup>8</sup> Even if the Respondent begins using the Inactive Domain Names, such use will not result in creation of rights or legitimate interests in the Inactive Domains because the Inactive Domains are confusingly similar to the Complainant's trademarks and any use of the Inactive Domains may enable the Respondent to make unfair profit or divert consumers from the Complainant. See *Microchip Technology, Inc. v. Milo Krejcik and EDI Corporation, d/b/a Aprilog.com*, WIPO Case No. D2001-0337.

Fourth, the evidence on file shows that the Respondent knows of the Complainant's TAOBAO trademarks and the Taobao Marketplace and has been using the Disputed Domain Names <open-taobao.com> and <tao-imagine.com> to trade on the Complainant's goodwill. Such use cannot provide the Respondent with rights or legitimate interests in the Disputed Domain Names. See, *Madonna Ciccone p/k/a Madonna v Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847. Although the word "Tao" has ordinary dictionary meanings in Russian<sup>9</sup> that is not associated with the Complainant, nothing in the record supports a conclusion that the Respondent adopted and used the term "Tao" in good faith based on its ordinary dictionary meanings. The evidence on record shows that "www.open-taobao.com" website displays the following information in English: "Open-taobao.com is the official partner or the largest Chinese online auction Taobao.com. Our goal is to provide you with Taobao such as it is, only in Russian. We ...simply integrated the entire resource Taobao into your own site." However, the Complainant did not license, consent or otherwise authorize the Respondent to use its TAOBAO trademarks with the Disputed Domain Names. The evidence on file also shows that the "www.tao-imagine.com" website allegedly assists users in finding products on the Complainant's Taobao Marketplace by use of a photograph uploaded by user. The "Войти"<sup>10</sup> and the "регистрация"<sup>11</sup> buttons redirect users to the online shopping website "www.выгоднокупи.рф"<sup>12</sup> ("Russian Website"), which is also referred to in the

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<sup>8</sup> Paragraph 2.6 of WIPO Overview 2.0.

<sup>9</sup> It means a Chinese high power or god, a historical region in Georgia, a Chinese first name and a Chinese surname and etc. See, [http://dic.academic.ru/dic.nsf/dic\\_synonims/308344/%D1%82%D0%B0%D0%BE](http://dic.academic.ru/dic.nsf/dic_synonims/308344/%D1%82%D0%B0%D0%BE)

<sup>10</sup> It means «login» in Russian.

<sup>11</sup> It means "registration" in Russian.

<sup>12</sup> It means "buy at competitive prices" in Russian.

“www.open-taobao.com” website and is virtually identical to the “www.open-taobao.com” website. The Russian Website has the same Hong Kong and China address and the same HSBC bank account details as stated in the “www.open-taobao.com” website. The both websites are allegedly operated by the same company Merchant Global Enterprise Ltd. The Russian Website also incorporates the Complainant's Taobao Trade Marks and an orange mascot owned by the Complainant (the “Tao Doll”). Under no circumstances may such use confer rights or legitimate interests in the Disputed Domain Names on the Respondent.

The Panel, therefore, finds that the Complainant made out the prima facie case showing that the Respondent has no rights or legitimate interests in the Domain Name. It is a consensus view of the UDRP panelists that “[o]nce the prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.” By defaulting, the Respondent failed to satisfy its burden of production. Therefore, the Panel finds that the Complainant satisfied the second UDRP element.

### **C) Bad Faith**

To satisfy the third UDRP element, the Complainant must prove that the domain names were registered and are being used in bad faith.

The Panel finds that the Respondent registered and is using the Disputed Domain Names in bad faith. First, evidence on record shows the Respondent has engaged into a pattern of registering domain names that bear resemblance to the Complainant's TAOBAO trademarks, a pattern of conduct forbidden by paragraph 4(b)(ii) of the UDRP<sup>13</sup>. As of today, the Respondent has registered 19 domain names that incorporate the Complainant's TAOBAO trademarks.<sup>14</sup> Besides the Disputed Domain Names the Respondent also registered <tao.email>, <taobao.email>, <taobao.website>, <taobao.domains>, <taobao.ink>, <taobao.expert>, <taobao.ninja>, <taobao.partners>, <taobao.today>, <tao.land> and <tao.zone> that incorporated the Complainant's TAO or TAOBAO trademarks.

Second, the Complainant claims that during the last three years, its rights in the TAOBAO trademarks have been violated 76 times. In the Panel's view, the existence of multiple attempts by third parties to trade on the Complainant's goodwill indicates its fame. In addition, the Complainant provided evidence of its significant transaction volume and number of Internet users that use the Taobao Marketplace. This confirms that the TAOBAO trademarks have become well-known to consumers. The Panel shares the view that “opportunistic bad faith” is shown when a domain name incorporating a well-known mark is registered “by someone with no connection with the product.” Because, the Respondent registered the Disputed Domain Names, which incorporate the Complainant's well-known TAOBAO trademarks, and the Respondent has no connection with the TAOBAO or TAO products, the Panel finds that the Disputed Domain Names were registered in bad faith.

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<sup>13</sup> Paragraph 3.3. of WIPO Overview, 2.0.

<sup>14</sup> This includes the Disputed Domain Names and the domain names that were subject of dispute in the URS Cases.

Third, the Respondent registered the Disputed Domain Names at least eight years after the Complainant registered its TAOBAO trademarks. Therefore, it is likely that the Respondent knew about the Respondent's TAOBAO trademarks when it registered the Disputed Domain Names. The Respondent's claim of being the official partner of the Taobao Marketplace and the Respondent's use of the Complainant's Tao Doll in the Respondent's websites confirms this assumption.

Fourth, it is likely that the Respondent intentionally attempts to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's TAOBAO trademarks on the source, sponsorship, affiliation, or endorsement because it uses its "www.open-taobao.com" and the "www.tao-imagine.com" to divert customers to its Russian Website, which is evidence of bad faith registration and use under the Paragraph 4(b)(iv) of the UDRP.

Finally, the Respondent's registration and use of the Inactive Domain Names is also in bad faith. It is well-established that passive holding of the domain name "does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa."<sup>15</sup> The circumstances and the Respondent's pattern of registering domain names reflecting the Complainant's trademark show that the Respondent had been acting in bad faith.

The Panel, therefore, finds that the Complainant established the third element of paragraph 4(a) of the UDRP.

## **6. Decision**

Under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Names open-taobao.com; tao-0.com; tao-api.info; tao-imagine.com; tao-mama.com; tao-sp.org; tao-obao.com (xn----7sbbd7ddw.com); taobao-фopым.com (xn----7sbad1dicbsmtj.com); taobao-sp.org be transferred to the Complainant.

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Olga Zalomiy  
Sole Panelist

Dated: January 12, 2015

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<sup>15</sup> Paragraph 3.2 of WIPO Overview 2.0.