



(Hong Kong Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1400624
<b>Complainant:</b>	Alibaba Group Holding Limited
<b>Respondent:</b>	Xu Caijun
<b>Disputed Domain Name(s):</b>	<tmall.net>

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**1. The 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 Xu Caijin, of Huangzhou, Zhejiang, 310000, China.

The domain name at issue is <tmall.net> (“*Disputed Domain Name*”), registered by Respondent with eNom Inc. (“*the Registrar*”), of 5808 Lake Washington Blvd. NE Ste.300, Kirkland, WA 98033, United States of America.

**2. Procedural History**

On 20 June 2014, pursuant to the Internet Corporation For Assigned Names And Numbers (ICANN) Uniform Domain Name Policy (“*the Policy*”), the Rules of Uniform Domain Name Dispute Resolution Policy (“*the Rules*”) and the Asian Domain Name Dispute

Resolution Centre Supplementary Rules to the ICANN Uniform Domain Name Dispute Resolution Policy and the Rules For the Uniform Domain Name Dispute Resolution Policy (*“the Supplemental Rules”*), the Complainant filed a Complaint in the English language with the Hong Kong Office of the Asian Domain Dispute Resolution Centre (*“ADNDRC-HK”*) and elected to have the case in question be dealt with by a single member panel.

On 23 June 2014, the *ADNDRC-HK* notified *the Registrar* of the *Disputed Domain Name* proceedings by email. By which, the *ADNDRC-HK* requested *the Registrar* to provide the following information, namely:-

- “1. *Whether the captioned Complaint Form has been received by ENOM, INC. from the Complainant;*
2. *Whether the above domain name(s) is/are registered with ENOM, INC.;*
3. *Whether the Respondent “Xu Caijun” is the Registrant or holder of the disputed domain name(s);*
4. *Whether the ICANN Uniform Domain Name Dispute Resolution Policy is applicable to the current dispute;*
5. *The language of the Registration Agreement of the disputed domain name(s). In accordance with the UDRP, the language of the proceedings shall be the language of the Registration Agreement, unless otherwise agreed by the parties or decided by the Panelist;*
6. *Please provide us with the Whois information regarding the disputed domain name(s);*
7. *the Status of the domain name”*

In the meantime, the **ADNDRC-HK** reminded *the Registrar* to take appropriate action towards the Disputed Domain Name, namely < tmall.net > in accordance with the rules stipulated by *the Policy*, such as prohibiting the *Disputed Domain Name* from being transferred to a third party.

On 23 June 2014, the **ADNDRC-HK** notified the Complainant by email that they received the Complaint concerning the *Disputed Domain Name*, namely <tmall.net>. The **ADNDRC-HK** requested the Complainant to submit the case filling fee on or before 3 July 2014, in accordance with Paragraph 19(c) of the *Rules* and Article 15 of the *Supplemental Rules*. The **ADNDRC-HK** also stated that:-

*“We have notified the concerned Registrar of the disputed domain name. Upon receipt of the Registrar’s confirmation on the WHOIS information, we shall proceed to review your Complaint. Once your complaint is in administrative compliance with the UDRP, we shall forward your complaint to the Respondent and formally commence the proceedings within three (3) days thereafter.”*

On 24 June 2014, *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 the **ADNDRC-HK** confirming that the *Disputed Domain Name* is registered with *the Registrar*, that Xu Caijun is the holder of the *Disputed Domain Name*, that *the 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”. Further, *the Registrar* notified the *ADNDRC-HK* that the contact information about the Respondent is as follows:-

*“Whois results for tmall.net*

*Contact Type Registrant*

*Organization Name:*

*First Name: XU*

*Last Name: CAIJUN*

*Address 1: HANGZHOU*

*Address 2:*

*City: HANGZHOU*

*StateProvince: ZHEJIANG*

*Postal Code: 310000*

*Country: CN*

*Phone: +86.57189986888*

*Fax:*

*Email Address: [XUCAIJUN708@163.COM](mailto:XUCAIJUN708@163.COM)*

*Status: registrar-lock*

*Created-date: 2001-08-06*

*registration-expiration-date: 2017-08-06”*

On 26 June 2014, the *ADNDRC-HK* issued an Amended Receipt of Complaint to the Complainant clarifying that the due date for submitting the case filing fee by the Complainant is 30 June 2014 instead of 3 July 2014 as aforesaid.

On 26 June 2014, the **ADNDRC-HK** acknowledged that it had received the case filing fee from the Complainant concerning the **Disputed Domain Name** <tmall.net> within the stipulated timeframe.

On 26 June 2014, the **ADNDRC-HK** informed the Complainant that:-

*“We forward the WHOIS information from the concerned Registrar. The registrar also confirmed that the disputed domain name of the captioned case has been locked. We are reviewing your Complaint concerning <tmall.net> as to whether it is in compliance with the Policy, the Rules and the Supplemental Rules.*

*According to Para 3 (b) (xii) of the Rules, the Complaint shall state that a copy of the complaint, including any annexes, together with the Complaint Transmittal Cover page (CTC) as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with Paragraph 2(b).*

*Please indicate to us whether you have served a copy of your Complaint as stated above to the Respondent.”*

On 26 June 2014, the Complainant filed its Statement of Complaint together with annexures with the **ADNDRC-HK** under cover of two emails.

On 26 June 2014, the **ADNDRC-HK** sent a Written Notice of Complaint (“the said Notice”), together with the Complaint Form C enclosed with annexures to the email

address of the Respondent's contact for the *Disputed Domain Name* (as recorded in the WHOIS database, the Respondent's email address is [XUCAIJUN708@163.COM](mailto:XUCAIJUN708@163.COM)). The said Notice gave the Respondent twenty (20) calendar days to file a Response, i.e. on or before 16 July 2014).

On 17 July 2014, the *ADNDRC-HK* sent an email notifying the Complainant (with a copy to the Respondent) that the Respondent failed to submit a response within the prescribed timeframe (i.e. on or before 16 July 2014).

On 18 July 2014, the *ADNDRC-HK* sent an email to Mr. Christopher To enquiring from him whether he can act and if so whether he can act independently and impartially in the matter in question.

On 19 July 2014, Mr. Christopher To sent an email to the *ADNDRC-HK* stating the following:-

*"Dear Sir,*

*I refer to your email of 18 July 2014.*

*I confirm that I am willing to act and if appointed will act independently and impartially.*

*Before you decide on the matter, I would like to raise the issue that I previously decided a disputed domain name case in which the applicant was a party - Alibaba Group Holding Limited. The case reference number is HK-1300494 and it was rendered on 12 July 2013 involving the domain name "tmall.com". The Respondent in that case was "Song Bin"*

*I shall now leave the matter for you to decide best.*

*Yours sincerely,*

*Christopher”*

On 28 July 2014, the **ADNDRCHK** sent a Notice of Appointment to Mr. Christopher To and the parties by email confirming Mr. Christopher To appointment as well as his independence and impartiality to both parties in this matter.

In accordance with Rule 15(a) of the **Rules** of the Uniform Domain Name Dispute resolution Policy, the Panel shall decide the Complaint on the basis of the statements and documents submitted.

Also, according to Rule 15(d) of the **Rules** of the Uniform Domain Name Dispute Resolution Policy 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 found in Hangzhou, China in 1999.

In May 2003, Alibaba Group founded the brand “Taobao”, in Chinese “淘宝” at [www.taobao.com](http://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 and online shopping destination which mainly focus 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 March 2013, Taobao Marketplace holds over 760 million products listing on its websites. Taobao Marketplace has also received 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 DoubleClick Ad Planner by Google, Inc. Other than the Taobao Marketplace, Alibaba Group also has the platform named “Tmall.com” ([www.Tmall.com](http://www.Tmall.com)), one of the China’s leading business-to-consumer (“B2C”) internet retail platforms for branded goods.

In 2008, Alibaba Group introduced the brand of “Taobao Mall” a 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 trademark) giving it an independent website located at [www.tmall.com](http://www.tmall.com) (“the *Tmall.com Marketplace*”) (in Chinese, “天貓”). Since its introduction in 2010, Taobao Mall as well as Tmall.com Marketplace has grown to become an online independent brand shopping landmark.

It is noteworthy that the Alibaba Group and its subsidiaries, has offices in about 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 a 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 Group and the success of Taobao Marketplace and Taobao Mall/Tmall.com Marketplace services have garnered a significant amount of media attention and resulted in a high public profile for Alibaba Group and its brands globally.

Currently Tmall.com Marketplace has more than 400 million registered users, featuring more than 7,000 major multi-national and Chinese brands from more than 50,000 merchants including but not limited to brands such as adidas, UNIQLO, Gap, Ray-Ban, Nike as well as Levis etc. Tmall.com Marketplace and Taobao Marketplace have set a record for the highest single-day transaction volume during a special promotion on 11 November 2013, facilitating the sales of goods totaling an amount of RMB 35 billion on the day. Further, for the year ending 31 March 2013, the combined gross merchandise volume of the two platforms exceeded RMB 1 trillion, being one of the most visited B2C online retail websites in China according to Alexa market survey.

The Complainant is and was at all material times the registered proprietor of the trademark “TMALL” in classes 9, 16, 35, 38, 41 and 42 of the Hong Kong Trade Marks Registry under registration no. 301756198 in respect of the following specifications. The said mark was registered on 5 November 2010 and has at all material times been valid and subsisting.

“Class 9

*Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming,*

*accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; computer programs; software for processing electronic payments to and from others; authentication software; computer software supplied on the Internet; on-line electronic publications (downloadable from the Internet or a computer network or a computer database); computer software, computer peripherals; notebook computers; laptop computers; portable computers; handheld computers; personal digital assistants; personal media players; mobile telephones; smart phones; digital cameras; computer workstations; servers; computer and telecommunications networking hardware; computer network adaptors, switches, routers and hubs; wireless and wired modems and communication cards and devices; laptop holders, computer bags; fire-extinguishing apparatus; computer hardware and firmware; computer software (including software downloadable from the Internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; mouse mats; mobile phone handsets; mobile phone accessories; downloadable games, pictures, motion pictures, movies and music; alarm systems; security cameras; mobile radio and television broadcasting units; television broadcasting equipment; cameras; video cameras; headphones; ear pieces; speakers; Global Positioning System (GPS) apparatus and equipment; computer, electronic and video games programmes and software (including software downloadable from the Internet); liquid crystal displays for telecommunications and electronic equipment; set top box; remote control; data storage programs; spectacles and sunglasses; signboards; encoded or magnetic bank credit, debit, cash and identification cards; automatic teller machines, cash dispensers; all included in class 9.*

#### Class 16

*Newspapers; magazines; periodicals; journals; paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture);*

*instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; books, pamphlets, posters, printed cards, circulars, catalogues, calendars, price tags, price labels; carry bags of paper, cardboard and plastic; printed telephone, facsimile, electronic mail and web site directories; cards in the form of debit cards, credit cards, charge cards and telephone cards other than encoded and magnetic cards; marketing and promotional materials; printed advertisements; user manuals; packaging materials; tissues; handkerchiefs made of paper; models and figurines made of paper; paper party bags; all included in class 16.*

### Class 35

*Advertising; business management; business administration; office functions; advertising agency services; advertising services provided for others; database management; compilation of information into computer databases; market research and business consulting services; business consultancy services relating to facilitating the transaction of business via local and global computer networks by locating and providing referrals for the delivery of a wide variety of business and consumer products and services; dissemination of business information of goods and services of others via local and global computer networks; business consultancy services relating to providing a web site on a global computer network by which third parties can offer and source goods and services, place, determine the status of and fulfill trade leads and orders, enter into contracts and transact business; providing computerized online ordering services; advertising of goods and services of others via local and global computer networks; international import and export agency services; rental of advertising space on communication media; online trading services relating to electronic auctioneering and providing online business evaluation relating thereto; online retail services of consumer products; providing a directory of third party web sites to facilitate business transactions; business consultancy services relating to operating an electronic marketplace for the buyers and sellers of goods and/or services on a global computer network; business assistance relating to facilitating business transaction via local and global computer networks; corporate management consultancy services; marketing and promotion services; publication of publicity materials; marketing of vacant*

*premises; dissemination of advertising materials, updating of advertising materials, compilation of advertisements for use as web pages on the Internet; rental of advertising space; computer data processing; sales, business, promotional information services; telephone answering (for unavailable subscribers); telephone answering (for others); auctioneering provided on the Internet; personnel management; provision of sales, business, advertising and promotional information through a global computer network and via the Internet; presentation of goods on communication media for retail purposes; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site and in a wholesale outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from retail outlets; retail and wholesale of telephones, mobile phone handsets, mobile phone accessories, electronic and telecommunications goods, computer hardware and computer software, batteries, battery chargers, apparatus and instruments for recording, receiving, transmitting and/or reproducing data, information, pictures, images and/or sound, precious metals, jewellery, precious stones, printed matter, stationery and magnetic and non magnetically encoded cards, furniture, picture frames, household and kitchen utensils, glassware, porcelain and earthenware, textiles, clothing, footwear, headgear, laces and embroidery, buttons, ribbons, pins and needles, artificial flowers, carpets, rugs, games and electronic toys, chemicals used in industry, science, photography and agriculture, paints, varnishes and lacquers, personal hygiene products, soaps, perfumery, cosmetics, hair and body lotions, essential oils, cleaning and bleaching preparations, lubricants, fuels, candles, pharmaceutical, veterinary and sanitary preparations, ironmongery and small items of metal hardware, machines and machine tools, cutlery, razors and hand tools, computers, calculating machines, electrical, photographic, cinematographic and optical apparatus and instruments, spectacles and sun glasses, surgical and medical apparatus and instruments, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, vehicles, firearms, fireworks, silverware, horological and chronometric instruments,*

*musical instruments, magazine, cards, paper and cardboard products, picture, typewriters and office requisites, packaging materials, rubber and plastics for manufacture use, packing and insulating materials, leather and imitations of leather and goods made from these materials, handbags, purses, wallets, leather holders, bags, luggage, umbrellas, mirrors, ropes, string, nets, tents, yarns and threads for textile use, coat hangers, place mats, dressmaker's articles, bed and table covers, playthings and sporting articles, foodstuffs and beverages, meat, fish, poultry, preserved, dried and cooked fruits and vegetables, jams and fruits sauces, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, flour, bread and cakes, condiments, fresh fruit and vegetables, beer, mineral water, fruit juices and other non-alcoholic drinks, alcoholic beverages, floral products, tobacco, smokers' articles and matches; direct mail advertising; buying and selling agency services; selection of goods and procurement of goods for individuals and businesses; ordering services [for others]; department store retailing services; supermarket retailing services; secretarial services; provision of business statistical information; organisation of exhibitions for commercial or advertising purposes; business assistance services relating to compilation and rental of mailing lists; business investigation; business administration services for the processing of sales made on the Internet; business referral services and personnel placement; import-export clearance agencies (import-export agency services); agency for newspapers subscriptions; document reproduction; transcription (including stencil-paper writing); rental of office equipment; customer relationship management; business management services relating to electronic commerce; business management and administration services relating to sponsorship programmes; accounting services; charitable services, namely organizing and conducting volunteer programmes and community service projects; consultancy, information and advisory services relating to the aforesaid services; all included in class 35.*

### Class 38

*Telecommunications services; provision of telecommunication access and links to computer database and to the Internet; electronic communication services; interactive telecommunications services; telecommunication of information (web pages), computer programs and data; providing telecommunications connections to the Internet or data bases; provision of telecommunication access to world-wide web*

*facilities and structures; communication by computer terminals; communication by fibre optic networks; computer aided transmission of messages and images; facsimile transmission; message sending; paging services; rental of modems; data communication services by electronic means; rental of telecommunication equipment; electronic message sending, receiving and forwarding services; collection, transmission and delivery of data by electronic means; collection, transmission and delivery of mail messages, still picture and/or moving picture information such as characters, messages, music and images, telegrams, information and data by mechanical, electronic, telephone, telex, cable, computer and satellite means; transmission, broadcast and reception of audio, video, still and moving images and data whether in compressed or uncompressed form and whether in real or delayed time; electronic messaging, conferencing and order-transmission services; video conferencing services; communication by electronic bulletin board that enables users to perform a real-time interactive talk between a computer terminal and an electronic bulletin board containing still picture and moving picture information and voice information such as characters; providing electronic bulletin boards and message boards for transmission of messages; provision of online discussion forums; television broadcasting services; broadcasting and transmission of radio and television programmes; music broadcasting; transmission of music, films, interactive programmes, videos, electronic computer games; transmission of information relating to on-line shopping and general retail services; video-on-demand transmission services; news agency services; providing access to computer database on the global computer network for searching and retrieving information, data, web sites and resources available on computer networks; providing user access to a computer database containing electronic publications, bulletin boards, database and information accessible via computer; operation of chat rooms (chat room services); multiple user access to global computer information networks for the transfer and dissemination of a wide range of information; providing access to a website 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 access to an interactive website 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; communication services, namely, text and numeric digital messaging services; transmission of information by data communications for*

*assisting decision making; transmission of information through video communication systems; web conferencing services; electronic communication services for establishing virtual chatrooms via text messaging; providing electronic bulletin boards for the posting and transmission of messages among and between computer users concerning products, services and business leads and opportunities; providing an online interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network; providing electronic mail and electronic mail forwarding services; audio and video communication via computers and computer networks, and via a global communications network; providing computer access and leasing access time to online interactive bulletin boards and databases; 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 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 distant video and/or telephone conferencing access and facilities; consultancy, information and advisory services relating to the aforesaid services; all included in class 38.*

#### *Class 41*

*Education; providing of training; entertainment; sporting and cultural activities; publication of texts, books and journals (others than publicity texts); publication of diagrams, images and photographs; publication of newspapers, magazines and periodicals; education, training and instruction services relating to telecommunications, computers, computer programs, web site design, e-commerce, business management and advertising; provision of education, recreation, instruction, tuition and training both interactive and non-interactive; design of educational courses, examinations and qualifications; entertainment provided via electronic and digital interactive media; electronic games services provided by means of the Internet; provision of information relating to education, training, entertainment, recreation, sporting, social and cultural activities; providing on-line electronic publications (not downloadable); arranging, organizing, hosting and conducting singing competitions; arranging, organizing, hosting and conducting concerts; arranging, organizing, hosting and conducting events and competitions for*

*education or entertainment purposes; arranging, organizing, hosting and conducting game shows and quests; entertainment ticket agency services; information relating to entertainment or education, provided online from a computer database or the Internet; providing digital music (not downloadable) from the Internet; providing digital music (not downloadable) from MP3 (Moving Picture Experts Group-1 audio layer 3) Internet web sites; entertainment and education services relating to planning, production and distribution of sound, images, digital music, movies, live or recorded audio, visual or audiovisual material for broadcasting on terrestrial cable, satellite channels, the Internet, wireless or wire-link systems and other means of communications; music entertainment services; rental of sound recordings; preparation of entertainment, educational, documentary and news programmes for broadcasting; news reporters' services; information relating to sporting or cultural events, current affairs and breaking news provided by satellite television transmission, the Internet or by other electronic means; television, radio and film production; preparation and production of television programmes; provision of information, data, graphics, sound, music, videos, animation and text for entertainment purpose; game services; provision of club recreation, sporting and gymnasium facilities; band performances; club entertainment, discotheque, fashion show and night club services; club services relating to entertainment, education and cultural services; arranging, conducting and provision of conferences, conventions, congresses, seminars and training workshops; organizing and conducting exhibitions, fashion shows, educational shows and cultural shows and performances; art exhibition and gallery services; art gallery services relating to fine arts leasing; training services in relation to occupation health and safety, environmental conservation; provision of cigar classes, wine tasting classes; providing education information about research materials and agency thereof; arranging, organizing, planning and management of seminars; animal training; direction in producing broadcasting programs; instructional services relating to operation of machines and equipment, including audiovisual equipment, which is used for the production of broadcasting programs; providing audio and visual studios; providing sports facilities; providing facilities for movies, shows, plays, music or educational training; entertainment booking agencies; rental and leasing of motion pictures (cine-films); rental and leasing of musical instruments; rental and leasing of television programmes; rental and leasing of television sets; lending libraries; archive library*




*services; subtitling services; sign language interpretation services; rental of entertainment software; providing video games, computer games, sound or images, or movies through telecommunication or computer networks; providing online computer games and contests; rental of pre-recorded video tapes; rental and leasing of game machines; lending of arcade game equipment; lending of pictures; photography; translation; language interpretation; educational and training programs in the field of risk management; educational and training programs relating to certification; provision of news; lottery services; consultancy, information and advisory services relating to the aforesaid services; all included in class 41.*


#### Class 42

*Scientific and technological services and research and design relating thereto, industrial analysis and research services; design and development of computer hardware and software; computer service relating to creating indexes of information, sites and resources on computer networks; providing search engines; design of computers, notebook computers, laptop computers, portable computers and handheld computers; design of personal digital assistants and personal media players; design of mobile telephones and smart phones; design of digital cameras; computer services; computer programming; computer integration services; computer analysis services; computer programming in relation to the defence against virus; computer system software services; providing direct connection services between computer users for exchanging data; computer software design; computer system design; design and development of webpages; hosting webpages for others; hosting computer application software for searching and retrieving information from databases and computer networks; providing technical information at the specific request of end-users by means of telephone or global computer network; consultancy services in relation to computer software; computer services relating to customized searching of computer databases and websites; providing computer links to third party web sites to facilitate e-commerce and real world business transactions; computer and electronic signal coding and decoding; conversion of physical data and documents into electronic media format; testing and evaluation services; architectural and design services; interior designs of buildings, offices and apartments; computer security services, namely, the provision of user certification authority services for*

*others to ensure the security of transmitted information; computer and network information services; computer security risk management programs; computer security information, knowledge, and testing services; quality assurance services; computer services relating to certification of business transactions and preparation of reports therefor; authentication services for computer security; access control to (security services for-) computers, electronic networks and databases; security of data transmission and of transactions via computer networks; consultancy in the field of data security; consultancy concerning securing telecommunications; consultancy, information and advisory services relating to the aforesaid services; all included in class 42.*



The Complainant is also the registered proprietor of the trademark “  ” in classes 9, 16, 35, 38, 41 and 42 of the Hong Kong Trade Marks Registry under registration no. 302066940. The said Tmall.com Mark was registered on 25 October 2011 and has been at all material times valid and subsisting.

Furthermore, the Complainant is the registered proprietor of the trademarks “  ” in Classes 9, 35 and 38 of the Trade Marks Office of the State Administration for Industry & Commerce of PRC under registration nos. 8820963, 8820991 and 8821002 in respect of the following specifications. The said marks were registered on 21 November 2011, 14 March 2014 and 28 January 2014 receptively. They have at all material times been valid and subsisting.

“9

*笔记本电脑; 计算机软件(已录制); 已录制的计算机程序(程序); 计算机周边设备; 电子出版物(可下载); 计算机程序(可下载软件); 计算机游戏软件; 手提电话; 与外接显示屏或监视器连用的娱乐器具; 测量仪器’*

“35

广告; 数据通讯网络上的在线广告; 为消费者提供商业信息和建议(消费者建议机构); 价格比较服务; 商业管理辅助; 拍卖; 替他人推销; 计算机数据库信息分类; 会计; 寻找赞助”

“38

电视广播; 计算机辅助信息和图像传送; 电子公告牌服务(通讯服务); 电讯路由节点服务; 为电话购物提供电讯渠道; 提供因特网聊天室; 提供数据库接入服务; 提供全球计算机网络用户接入服务(服务商); 信息传送; 提供与全球计算机网络的电讯联接服务。”

**淘宝商城**  
**Taobao mall**

The Complainant has registered the mark “**淘宝商城 Taobao mall**” in Classes 35 and 38 of the Trade Marks Office of the State Administration for Industry & Commerce of PRC under registration nos. 6797103 and 6797102 in respect of the following specifications. The said marks were registered on 28 April 2010 and 21 December 2010 respectively. They have at all material times been valid and subsisting.

**Tmall.com**  
**淘宝商城**

In addition, the Complainant has registered the mark “**Tmall.com 淘宝商城**” in Class 35 of the Trade Marks Office of the State Administration for Industry & Commerce of PRC under registration no. 9886069 in respect of the specification as aforementioned. The said mark was registered on 7 February 2013 and has at all material times been valid and subsisting.

The Complainant has also registered the mark “ ” in Classes 35 and 38 of the Trade Marks Office of the State Administration for Industry & Commerce of PRC under registration nos. 9208675 and 9208823 respectively in respect of the specifications as aforementioned. The said marks were both registered on 21 September 2012 and have at all material times been valid and subsisting.

Other than registration in Hong Kong and PRC, the Complainant has also registered the mark “ **TMALL** ” in Classes 9, 16, 35, 38, 41 and 42 of Taiwan Intellectual Property Office under registration no. 01508710 (verified by the Panelist) in respect of the following specifications. The said mark was registered on 1 March 2012. It has at all material times been valid and subsisting.

“Class 9

電子廣告牌；影印機及其組件；電腦螢幕顯示器、電腦鍵盤、列表機、磁碟機、記憶體、電腦滑鼠、微處理機、資料儲存機、中央處理機、資料讀取機、電腦記憶卡匣、可程式資料存取處理機、電腦、光碟機、電腦用數字輔助鍵盤、電腦程式、電腦軟體、光碟驅動器、抽取式硬碟、電腦韌體、網路防火牆、電腦工作站、電腦終端機、網路設備、觸控筆、資料耦合器、電腦硬體、網路卡、光筆、磁帶、資料載體光碟、讀卡機、程式設計機、電腦鑑識模組、微處理機模仿器、光學字元辨識機、電腦資料選擇器、電腦資料編校機、電腦輸入輸出記錄機、電腦觸摸感應輸入器、電腦儲存記憶記錄用密碼筆、電腦磁帶用程式輸入及讀出機、語言翻譯機、磁帶機、微電腦模擬器、電腦用防塵罩、磁碟置放盒、影像掃描器、辨識口令產生器、電腦數位板、電子記事簿、電子書、個人數位助理器、電腦交談輔助器、電子字典、電子資料整合器、手提電腦專用袋、信用卡交易處理機、門禁刷卡機、指紋辨識機、電腦燒錄器、數位影像儲存機、軟體保護器、光碟燒錄機、滑鼠墊、從網際網路下載之音樂、從網際網路下載之影片、從網際網路下載之書籍、從網際網路下載之圖片、電子手冊、光學字元讀取機、電腦用腕靠、電子標籤、個人數位助理器專用袋、電視遊樂器軟體、從網際網路下載之遊戲程式；資料處理設備、從網

際網路下載之軟體、電腦遊戲程式、電子出版品；計算機；聲音或影像記錄或複製用器具、照相機背帶、照相機、幻燈機、照相器材套、攝錄放影機、顯像器材、液晶投影機；個人用立體音響裝置、麥克風、電視機、自動廣告廣播器；實驗室用儀器、顯微鏡；眼鏡及其組件；電視遊樂器；電池；電線、電纜；動畫片、錄音帶；行動電話機、行動電話免持聽筒、行動電話車用固定架；電信設備、行動電話護套；晶片；行動電話用充電器、遙控儀器；自動販賣機；電防盜鎖；非車輛用防盜警報器；測距裝置；自動計量器；磁性識別卡、信用卡、電話卡、金融卡、IC卡、儲值卡、智慧卡；時間記錄器具；電暖衣服。

### Class 16

宣傳單，雜誌，書籍，圖書，日記簿，印刷出版品，卡片，信封，信箋，紙製吊牌，卡紙板，照片，包裝用紙，包裝用紙袋，包裝用塑膠袋，紙製彩帶，事務用紙，文具，即：膠帶、膠水、漿糊、印泥、釘書針、迴紋針、圖釘、筆筒、修正液、卷宗夾、活頁夾、釘書機，筆，筆刷，筆盒，硯台，墊板，握筆器，紙製及紙板製之商品，即：紙袋、紙箱、紙筒、紙盒、紙製垃圾袋、紙製旗幟、紙製彩球、紙製裝飾用標語旗、紙製廣告牌、紙製指示牌，電話號碼簿，人名住址資料簿。

### Class 35

廣告企劃、廣告製作、提供電訊媒體廣告時段之服務、廣告代理、樣品分發、張貼廣告、廣告宣傳品遞送、直接郵遞廣告、商品示範、廣告、電腦網路之線上廣告、為他人提供促銷活動、價格型錄設計服務、為零售目的於通訊媒體上展示商品、為促進商業交易藉由區域及全球電腦網路為他人宣傳商品與服務資訊；商情提供、提供商業資訊、工商廣告資料之更新、提供企業遷移及營運方針之重新定位之資訊、為消費者提供商品資訊和購物建議、為企業採購商品及服務、為促進商業交易藉由網路目錄提供第三者購物資訊；代理國內外廠商各種產品之報價、投標、經銷，商情之提供：提供工商企業名錄；代理進出口服務；貨物公證；審計稽核、辦理會計業務、統計資料之編輯、稅務簽證；企業管理顧問、企業管理諮詢、企業管理協助、專業企業諮詢顧問、專業貿易企業諮詢顧問、企業經營協助、企業評價、企業研究、企業組織諮詢、人事管理諮詢、協尋贊助廠商、商業或工業管理輔助；櫥窗設計；秘書服務、職業介紹；拍賣；市場研究及分析、經濟預測、市場調查、企業調查；公關；電子廣告看板出租；網路廣告看板出租；為工商企業籌備商展服務、為工商企業籌備展示會服務、為工商企業籌備博覽會服務、籌備商業性或廣告目的性的展示會、籌備商業性或廣告目的性的展銷會；郵購、電視購物、網路購物（電子購物）；經由實體店鋪、電信或是全球網際網路對以下商品提

供零售批發服務；電腦軟體、硬體及其周邊配備零售批發、皮件零售批發、服飾配件零售批發、眼鏡零售批發、衣服零售批發、家庭日常用品零售批發、電器用品零售批發、布疋零售批發，家具及室內裝設品零售批發、化洋品零售批發、印刷品零售批發、文教、康樂用品零售批發，鐘錶零售批發，電子、機械及通訊器材零售批發，首飾及貴重金屬零售批發，攝影器材零售批發；藉由全球電腦網路提供拍賣服務、電腦資料庫編輯，購物中心、百貨公司，超級市場，建立電腦資訊系統資料庫、為他人提供電腦檔案資料檢索、電腦檔案管理；安排報紙訂閱；自動販賣機出租；為他人安排電訊服務預約；報章、雜誌、電視、電台之廣告、廣告牆之出租、為企業企劃折扣卡以促銷其商品或服務為目的之服務，提供廣告信函收件人名單；企業經營風險管理；帳務處理服務。

### Class 38


新聞社；通訊社；新聞傳播；電視播送；無線電廣播；提供電視購物服務之電訊頻道；電腦終端機通訊傳輸；電腦輔助訊息與圖像傳輸；電子郵件傳輸；電子佈告欄服務（電信傳輸服務）；提供與全球電腦網路之電信連接服務；電傳會議之影音與資訊傳輸服務；提供使用者進入全球電腦網路通路（伺服器提供者）；提供網路聊天室資訊傳輸；通訊服務，即訊息傳送，原文及數字數位訊息傳送服務；資料及文件之電子傳送；藉由資料通訊以協助作決定之資訊傳送；提供多位用戶進入全球電腦資訊網路以轉換及散播廣域資訊；提供使用者進入可讓第三人出價商品及服務、開出訂單及完成訂單、簽約及處理交易之網路通路；提供電腦網路連接到第三人網站以促進電子商業交易及實際交易；提供進入全球電腦網路（如電子日曆、通訊錄及筆記本）之通路服務；提供使用者進入可使第三人上傳資訊、回應要求及開出及完成產品，服務及交易機會訂單之互動式網路通路；電腦使用者之間之資料及文件之電子傳送；藉由電子通訊網路傳送資訊；藉由電視影像通訊系統傳送資訊；為建立虛擬聊天室藉由原文訊息傳送之電子通訊服務；為有關產品、服務及交易誘導及交易機會在電腦使用者之間提供訊息之上傳及傳輸之電子佈告欄；為上傳資訊、促銷、銷售及轉售，藉由全球電腦網路提供線上互動式佈告欄；有關所有上述服務之資訊、諮詢及顧問服務；藉由電腦及電腦網路及全球通訊網路之聲音及影像通訊傳輸電信路線連接服務；視訊會議電信通訊服務；傳真傳輸；電話通訊傳輸；無線電、電話或其他電子通訊方式之呼叫服務；電腦資料庫存取時間租賃服務；全球電腦網路進入時間之出租。

### Class 41

電視及娛樂節目製作，為客戶量身訂作各種書刊、雜誌、文獻等之出版、查詢、訂閱，知識或技術方面之傳授（即電訊傳輸、電腦程式及網站設計、電子商務、企業管理及廣告等之教授），舉辦各種講座、會議，影片、唱片、錄音帶、錄影片、碟影片、伴唱帶之製作及發行，電台及電視育樂節目之策劃、製作，藉由電腦網路提供線上遊戲服務，提供電子刊物線上瀏覽服務，代售各種活動、展覽、比賽入場券，藉由電腦資料庫或網路提供娛樂或教育之相關資訊，藉由網路或MP3網站提供線上數位音樂欣賞服務，透過電腦網路及電訊提供線上電子書籍及期刊之出版服務，透過電腦網路及電訊提供電子出版品之網路閱覽服務，舉辦有關商業網路解決方案及電腦系統整合研討會之服務；以網際網路及電子方式提供網路化學習之服務；網路教學；透過網際網路提供教育及訓練課程或計劃之資訊；提供一般民眾線上學習服務；教育課程、各種資格考試、執照考試之策劃與設計；對個人之技能與學術等能力程度作甄別及檢定；有關訓練課程設計之諮詢顧問服務；教育訓練及諮詢服務提供互動式電子及數位媒體娛樂設施之服務；提供培訓及其諮詢專家訓練服務各種書刊編輯。

#### Class 42

室內設計、室內裝潢設計、舞台設計、土地測量、地籍測量；電腦動畫設計及製作、電腦繪圖；電腦軟體租賃、電腦軟體設計諮詢顧問、電腦軟體諮詢、電腦系統分析、電腦系統設計、電腦軟體安裝、電腦程式複製、電腦程式規劃、電腦程式設計，電腦病毒防護服務、提供網址之登記、電腦軟體之設計及開發、網路伺服器空間出租、網路伺服器出租、藉由全球電腦網路提供廣泛領域之資訊服務、網站規劃建置、為他人建置及維護網站、電腦網站代管、提供搜尋引擎以利搜尋及檢索資料服務、提供辨識通訊網路使用者身分之服務、提供網路交易及電子公文與資料傳檔業務之電子認證服務、網路認證服務、網路安全管理服務、主持電腦網頁、為他人製作或維護網頁、網路網頁設計，將實體資料和文件轉換成電子媒體、電腦軟體維護；電腦應用軟體之設計、開發、安裝、更新及維護服務；電腦租賃、電腦資料處理；化學分析、生物學研究、物理學研究、機械研究、醫學試藥試劑之研究分析、電信工程技術之諮詢顧問、機電工程技術之諮詢顧問；服裝設計；環境保護領域的研究、生態調查；電腦硬體設備諮詢、包裝設計、圖像藝術設計、工業產品設計、電腦硬體之設計及開發；品質管制、材料測試、藝術品鑑定、珠寶鑑定；通訊系統及設備工程之規劃設計；提供氣象資訊；產品品質及服務品質檢驗測試。”

In addition, the Complainant has also registered the mark “” in Classes 9, 16, 35, 38, 41 and 42 of Taiwan Intellectual Property Office as aforementioned and under registration no. 01546406 (verified by the Panelist). The said mark was registered on 1 November 2012. It has at all material times been valid and subsisting.

Alibaba Group’s services provided via Taobao Mall/Tmall.com Marketplace are and have always been carried on, supplied and marketed continuously and substantially under and/or by reference to the Tmall Trade Marks registered in various jurisdictions around the world. The Complainant started using the mark “TMALL” since 2010, while the first use of the mark “TAOBAO MALL” commenced since 2008. Since then, the Tmall Trade Marks have acquired distinctiveness through extensive use by the Complainant and its affiliates in commerce, so that the Tmall Trade Marks are recognizable to consumers as being associated with the Complainant

### **For the Respondent**

The Respondent, Xu Caijun, is an individual residing in Hangzhou, Zhejiang, PRC.

On or around 4 February 2011, the *Disputed Domain Name* <[tmall.net](http://tmall.net)> was initially registered by Korea Information Certificate Authority, Inc. dba DomainCA.com in the name of Zheng Zhongxing.

Until on or around 31 July 2011, the ownership of the *Disputed Domain Name* was transferred to Enom, Inc. in the name of the Respondent. In the light of the WHOIS search Record dated 20 June 2014, the holder of the contested domain name as noted by the Registrar is Xu Caijun.



On 17 July 2014, the *ADNDRC-HK* sent an email notifying the Complainant (with a copy to the Respondent) that the Respondent failed to submit a response within the prescribed timeframe (i.e. on or before 16 July 2014). As such, the Respondent has not contested the allegations of the Complainant and is in default.

#### 4. Parties' Contentions

##### A. Complainant

The Complainant's contentions may be summarized as follows:

##### (i) Disputed Domain Name is confusingly similar to the Complainant's trademarks

In view of the various trademarks being registered around the world as aforementioned, which comprises the Tmall Trade Marks, the Complainant contends that it has established its rights in the Tmall Trade Marks, including "TMALL and "TAOBAO MALL" marks in China, Hong Kong and Taiwan. The Complainant submits that most of the above registered trademarks were registered prior to the registration of the *Disputed Domain Name* <tmall.net> on 11 July 2011.

The Complainant submits that the *Disputed Domain Name* <tmall.net> incorporates the Complainant's "TMALL" trade mark in its entirety and it is well established that when making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension <net> should be disregarded. With this regard, the Complainant submitted to this Panel the decision of *Rohde & Schwarz GmbH & Co. HG v. Petshire Marketing Ltd.*, WIPO Case No. D2006-0762 for the Panel's consideration.

For the foregoing reasons, the Complainant concludes that the *Disputed Domain Name* <tmall.net> is identical and/or confusingly similar to the trademarks in all aspects.

##### (ii) The Respondent has no right or legitimate interest in respect of the disputed domain name

The Complainant contended that since its first use of the Tmall Trade Marks in 2008, the Tmall Trade Marks have already acquired distinctiveness through their extensive use in commerce by the Complainant and its affiliated companies. That said, the TMALL Trade Marks, including the “TMALL” Mark are widely recognized by consumers as being associated with the Complainant, its affiliates and their business. The Complainant also submitted that “TMALL” has no literal meaning in English or any other languages, but only relates to the Complainant.

The Complainant submitted, with reference to paragraph 3.7 of the World Intellectual Property Organisation (“WIPO”) Overview of the WIPO Panel Views on Selected UDRP Questions, 2<sup>nd</sup> Edition, that the Respondent only acquired the *Disputed Domain Name* on or about 31 July 2011 from the previous owner and such a transfer of ownership is sufficient to amount to a new registration. That being the case, the Complainant contended that the Respondent only acquired and registered the *Disputed Domain Name* more than 3 years after the first use of the “TAOBAO MALL” mark by the Complainant and almost 1 year after the Complainant’s first use of its “TMALL” mark. At all material times, the Complainant has not licensed, consented to or otherwise authorized the Respondent’s use of its Tmall Trade Marks in respect of the *Disputed Domain Name*.

The Complainant drew this Panel’s attention to the authority *Pepisi Co., Inc. v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No. D2003-0174 and submitted that the burden of proof should vest on the Respondent to establish that it has rights and/or legitimate interests in the *Disputed Domain Name*. Yet, the Complainant contended that the Respondent has failed to discharge its obligation by providing evidence which can support the fact that the Respondent has been commonly known by the *Disputed Domain Name*.

The Complainant is satisfied that the Respondent’s name does not reflect or correspond with the *Disputed Domain Name* and therefore the Complainant does not see any justification or apparent need for the Respondent to incorporate the Complainant’s registered “Tmall” trade mark in the *Disputed Domain Name*. Furthermore, the Complainant submitted that the Respondent does not own any trade

mark registrations reflecting or corresponding to the *Disputed Domain Name* in China, which is clearly reflected in the proprietor search from the database of the China Trade Mark Office in the name of the Respondent who is allegedly domiciled in China.

In addition, the Complainant submitted that screenshots of Internet Wayback Machine shows that the *Disputed Domain Name* is automatically resolved to the Complainant's Tmall.com Marketplace. On that basis, the Complainant is contended that the Respondent should have knowledge of the Complainant's business and its Tmall Trade Marks. It is also submitted that the Complainant has never authorized the Respondent to register or make use of the *Disputed Domain Name*, which implies that the Complainant does not confer any legitimate interest or right to the Respondent in the *Disputed Domain Name*. No goods or services are bona fide offered by the Respondent for sale via the *Disputed Domain Name* since the *Disputed Domain Name* has been directed to the Complainant's website which is not owned and/or controlled by the Respondent. The Complainant further submitted that in fact, the Respondent earns pay-per-click or other revenue whenever a user accesses the *Disputed Domain Name*.

In support of the above submission, the Complainant drew the Panel's attention to the authorities *AT&T Corp. v Linux Security System*, WIPO Case No. DRO2002-0002 and *Expedia, Inc. v Dot Liban, Hanna El Hinn*, WIPO Case No. D2002-0433 for further consideration.

On top of the above, the Complainant submitted that intended use of the *Dispute Domain Name* by the Respondent can never amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use of the *Disputed Domain Name*. This is because the *Disputed Domain Name* is identical to the Complainant's well-known "TMALL" trademark and the use of the *Disputed Domain Name* will inevitably mislead users into believing that the *Disputed Domain Name* is associated with the Complainant and enabling the Respondent to make a commercial gain.

For the forgoing reasons, the Complainant concludes that the Respondent does not have any rights and legitimate interests in respect of the *Disputed Domain Name* pursuant to paragraph 4(a)(ii) of the *Policy*.

**(iii) The Respondent has shown bad faith in registering and using the domain name**

The Complainant contends that there is already evidence of bad faith since the Respondent has no rights or legitimate interests in the *Disputed Domain Name*.

The Complainant also submitted that the *Disputed Domain Name* does not reflect or correspond to neither the Respondent's own name nor the name of his organisation. The Complainant contended that its "TMALL" trade mark is a coined term not commonly used in English or any other language independent of the Complainant's "TMALL" trade mark. In view of the above, the Complainant submitted that the Respondent clearly has knowledge of the Complainant and its Tmall Trade Marks by the time when it registered the *Disputed Domain Name*. Further, the Complainant is of the view that the Respondent was motivated to solely take advantage of the Complainant's reputation in Tmall Trade Marks by incorporating the word "tmall" to its entirety. With this regard, the Complainant referred this Panel's attention to a supporting authority of *Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Kil Inja*, WIPO Case No. D2000-1409.

Furthermore, the Complainant submitted that the Respondent is based in China. Since the Complainant's first use of the "TAOBAO MALL" trade marks in 2008 and its "TMALL" trade marks in 2010, it has already acquired distinctiveness through their extensive use in commerce, the Complainant and its trademarks are therefore particularly well-known in China and amongst other Chinese speaking

population. In the light of the popular worldwide fame of the Tmall Trade Marks, the Complainant is of the view that it is inconceivable that the Respondent was not aware of the Complainant's Tmall Trade Marks when it registered the *Disputed Domain Name*. Needless to say, the *Disputed Domain Name* was automatically diverted to the Complainant's Tmall.com Marketplace, which can further conclude the Respondent's awareness of the Complainant's prior rights and interests in the Tmall Trade Marks and has knowingly taken advantage of the Complainant's reputation in Tmall Trade Marks in bad faith for the purposes of taking unfair advantage of the Complainant.

In addition, the Complainant also submitted that the Respondent has failed to seek permission from the Complainant as the owner of the trade marks for registering and using the *Disputed Domain Name* with its full knowledge of the Complainant's prior rights in Tmall Trade Marks. The Complainant drew the Panel's attention to the authority of *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163.

Last but not least, the Complainant also submitted that the Respondent earns some form of pay-per-click revenue whenever a user accesses the *Disputed Domain Name* and gets redirected to the Complainant's Tmall.com Marketplace. On this basis, it is reasonable to contend that the *Disputed Domain Name* was registered by the Respondent with an intention to mislead and confuse users into believing that the *Disputed Domain Name* is associated with the Complainant and its Tmall Trade Marks, in order to increase the number of users in assessing the *Disputed Domain Name* for its own commercial gain, i.e. to incur more revenue from the pay-per-click system.

For the foregoing reasons, the Complainant submits that there is a prima facie case that the Respondent has shown bad faith in registering and using the *Disputed Domain Name*.

In gist, the Complainant asserted that all of the 3 elements as aforementioned have been satisfied in this case, the Complainant seeks to ask the Panel to make an order that the *Disputed Domain Name* be transferred to the Complainant.

**B. Respondent**

The Respondent's contentions may be summarized as follows:

On or about 31 July 2011, the ownership of the *Disputed Domain Name* was transferred to Enom, Inc. in the name of the Respondent. In the light of the WHOIS search record dated 20 June 2014, the holder of the contested domain name as noted by the Registrar is *Xu Caijun*.

On 17 July 2014, the *ADNDRC-HK* sent an email notifying the Complainant (with a copy to the Respondent) that the Respondent failed to submit a response within the prescribed timeframe (i.e. on or before 16 July 2014). As such, the Respondent has not contested the allegations of the Complainant and is in default.

In gist, the Respondent has not asserted any claims, defenses or contentions, nor submitted any evidence denying the claims by the Complainant.

## 5. Findings

### A. The Language of the Proceedings

The Internet Corporation For Assigned Names and Numbers Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) Paragraph 11 (a) provides 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 use a particular language for these proceedings. As the Registration Agreement is in the English language as confirmed by the *Registrar* in its email of 24 June 2014 then in accordance with Article 11(a) of the Rules for Uniform Domain Name Dispute Resolution Policy the language of the administrative proceedings shall be in the English language. In these circumstances given that the Complaint is drafted in the English language which is in line with the Registration Agreement and that the Respondent has failed to communicate on the matter, the Panel considers that it would be appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in the English language.

### B. Discussions and Findings

Having considered all the documentary evidence before me, and the Respondent’s non-participation in these proceedings after being afforded every opportunity to do so in accordance with Paragraph 5(e) of the *Rules*, the Panel is of the view that it should proceed

to decide on the *Disputed Domain Name*, namely <tmall.net> based upon the Complaint and evidence adduced by the Complainant.

Paragraph 5 (e) of the *Rules* stipulates that:-

*“If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.”*

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.

**i. Identical / Confusingly Similar**

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

Taking into consideration of the evidence and background history submitted by the Complainant, the Panel considers that the Complainant has established that the Tmall Trade Marks have acquired distinctiveness through extensive use by the Complainant and its affiliates in commerce who have continuously carried on, supplied and marketed via the online platform in various jurisdictions around the world since 2008.



In view of the search engine results on the mark “tmall and taobao mall” submitted by the Complainant, the Panel accepts that the Tmall Trade Marks are also widely recognized by members of the public as being the Complainant itself and/or its affiliates.

In terms of the trademark registration, the Panel is convinced that the trademark rights are well known around the world given that the Tmall trade marks have been validly registered in Hong Kong, China, Taiwan and other parts of the world as previously stated within this decision.

Further, this Panel accepts the decision of *Rohde & Schwarz GmbH & Co. HG v. Petshire Marketing Ltd.*, WIPO Case No. D2006-0762 which provides that:-

*“It is well-established that the “.com” extension should be disregarded for determining confusing similarity.”*

In the light of the above authority in support, the Panel considers that the identifiable part of the *Disputed Domain Name* “tmall” is clearly identical to the Complainant’s Tmall Trade Marks.

As aforementioned, the Respondent has not contested the allegations of the Complaint and is in default.

For all the foregoing reasons, the Panel concludes that the Complainant has discharged its burden of proof to establish the elements of identical and confusingly similar mark as stipulated in Paragraph 4(a)(i) of the *Policy*.

**ii. Rights and Legitimate Interests**

Paragraph 4(c) of the *Policy* provides, *inter alia*, that the burden of proof vests on the Respondent to prove and satisfy with the following circumstances, in order to demonstrate that it has rights and legitimate interests in the *Disputed Domain*

**Name:-**

- (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.*

This Panel accepts the authority of *Pepisi Co., Inc. v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No. D2003-0174 submitted by the Complainant, whereby the Panel in that case held that:-

*“Since the adoption and extension use by the Complainant of the trademark “PEPSI” predates the first entry of the <pepsix.com> and <pepsixxx.com> as domain names, the burden is on the Respondent to establish the Respondent’s right and legitimate interests the Respondent may have or have had in the domain name.”*

In the present case, the Respondent has failed to contest the proceedings. The Panel accepts that the Respondent has failed to provide any evidence to support its rights and legitimate interests in using the ***Disputed Domain Name***, nevertheless the Complainant is still required to prove that the Respondent has no rights and legitimate interests.

As aforementioned, the Panel is convinced that the Complainant has acquired rights and interests in the Tmall Trade Marks worldwide, including but not limited to Hong Kong. The Complainant has been using the Tmall Trade Marks since 2008. However, the Respondent has only acquired the ***Disputed Domain Name*** on or around 31 July 2011 from the previous owner, which is 3 years after the Complainant's first use. The Panel is of the view that the word "tmall" does not reflect the Respondent's name nor has the Respondent registered any trade mark reflecting the ***Disputed Domain Name*** elsewhere including China.

Having considered the screenshot of the Internet Wayback Machine submitted by the Complainant, the Panel is convinced that the ***Disputed Domain Name*** is automatically diverted to the Complainant's Tmall.com Marketplace. This Panel considers and accepts that the decision in ***AT&T Corp. v. Linux Security Systems***, WIPO Case No. DRO2002-0002 whereby the Panel in that case states that:-

*“the fact that at one point in time, the Respondent chose to direct the Domain Name to the Complainant's corporate website is further confirmation of the Respondent's lack of legitimate interest in the Disputed Domain Name.”*

Further, this Panel accepts the decision in ***Expedia, Inc. v Dot Liban, Hanna El Hinn***, WIPO Case No. D2002-0433, whereby the Panel in that case states that:-

*“there is no other evidence suggesting that the Respondent has rights or legitimate interests in respect of the domain names. The domain names*

*have not been independently chosen.....they have been used by the Respondent to redirect traffic to the Complainant's site supports the Complainant's contention as to derivation of the domain names.”*

With regard to the use of the ***Disputed Domain Name*** by the Respondent, this Panel considered the decision of **Paris Hilton v. Deepak Kumar**, WIPO Case No. D2010-1364, whereby the Panel in that case concluded that:-

*“the assessment of rights or legitimate interests boils down to a question as to whether the Respondent is using the domain name with the Complainant's marks in mind and with a view to taking unfair advantage of the reputation of the Complainant's marks?”.*

In this case, the Panel considers that it is apparent from the prima facie evidence that the Respondent knowingly using the ***Disputed Domain Name*** notwithstanding its knowledge of the established reputation of both the Complainant and its Tmall Trade Marks in China. Such acts of the Respondent clearly shows that the Respondent deliberately misled internet users into believing that the ***Disputed Domain Name*** is identical to the Complainant's site, enabling the Respondent to obtain commercial gain from internet users who accessed the ***Disputed Domain Name***.

For the forgoing reasons, the Panel concludes that the Respondent does not have any rights and legitimate interests in respect of the ***Disputed Domain Name*** pursuant to paragraph 4(a)(ii) of the ***Policy***.

### iii. **Bad Faith**

Paragraph 4(b) of the **Policy** sets out four (4) factors in which the Panel shall take into account in determining whether the Respondent has registered and used the **Disputed Domain Name** in bad faith. The prescribed four (4) factors are as follows:-

- (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.*

In view of the evidence before this Panel, the Panel considers that the Respondent should have had knowledge of the rights of the Complainant on the Tmall Trade Marks at the time of registering the **Disputed Domain Name** on 31 July 2011, in particular to the Complainant's reputation and goodwill established in China as being a popular trading platform within the internet worldwide through its reference to the Tmall Trade Marks being registered in 2008.

Having considered the case of *Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil* (WIPO Case No. D2000-1409) submitted by the Complainant, the Panel in that case stated that:-

*“that it is inconceivable that the Respondent could make any active use of the disputed domain names without creating a false impression of association with the complainant.”*

In addition, another authority submitted by the Complainant namely *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163, the Panel in that case stated that:-

*“The Respondent’s offer to treat with persons with a property interests in this domain name is powerful evidence of bad faith.”*

This Panel also accepts that in *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. D2002-0433, as advocated by the Complainant that *“that the Respondent was acting in bad faith since the only purpose of the Respondent in registering the disputed domain names is to re-direct traffic to the Complainant’s site without obtaining permission to do so”*.

In the present case, the evidence submitted by the Complainant clearly shows that the Respondent has an intention to mislead and/or to deceive internet users into believing that the ***Disputed Domain Name*** is that of the Complainant’s Tmall.com Marketplace by registering the same on 31 July 2011 and directing the same to the Complainant’s website without consent of the Complainant, so that the Respondent can attract more users via the ***Disputed Domain Name*** with a belief that it is directed to the Complainant’s website and as such the Respondent can obtain commercial gain through the pay-per-click revenue system.

## 6. Decision

For the foregoing reasons and in accordance with Paragraph 4 of the *ICANN Policy*, the Panel is satisfied that the Complainant has sufficiently proved the existence of all three elements pursuant to Paragraph 4(a) of the *Policy*. The Panel orders that the *Disputed Domain Name* <tmall.net> be transferred to the Complainant.

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Mr. Christopher To  
Panelist

Dated: 10<sup>th</sup> August 2014