



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400623
Complainant:	Alibaba Group Holding Limited
Respondent:	Nikolay Aleksandrovich Tarasenko
Disputed Domain Name(s):	<taobao-russia.com>

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, represented by Mayer Brown JSM, Solicitors of Hong Kong, PRC.

The Respondent is Nikolay Aleksandrovich Tarasenko of g.Vladivostok, ul. Irtyshskaya, d.2, kv.7., Vladivostok, Russia, unrepresented.

The disputed domain name is <taobao-russia.com>, registered with Onlinenic Inc. of 909 Marina Village Pkwy #236, Alameda, CA94501, USA.

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the "Center") on 19 June, 2014. That same day the Center transmitted by email to Onlinenic Inc. a request for registrar verification in connection with the domain name at issue. On 19 June, 2014, Onlinenic Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules of Procedure under the Policy (the "Rules"), and the Center's Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on 26 June 2014. In accordance with the Rules, the due date for Response was 16 July, 2014. A timely Response was submitted.

The Center appointed Debrett G. Lyons as panelist in this matter on 18 July, 2014. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

A. For Complainant

1. The Complainant is part of a Chinese company group engaged primarily in the provision of C2C services.
2. The Complainant (either itself or with the license of the company group) has used the trademark TAOBAO (and its Chinese equivalent, 淘宝) in relation to those services since 2003.
3. The Complainant is the owner of a large international portfolio of trademark registrations for TAOBAO dating from the year 2004 onwards, including Russian Federation trademark registration number 469493 from 28 August 2012.
4. The Complainant has not licensed or otherwise permitted the Respondent to use the trademark or to register or use any domain name incorporating the trademark.
5. The Complainant petitions the Panel to order transfer the disputed domain name from the Respondent to the Complainant.

B. For Respondent

6. The Respondent registered the disputed domain name on 12 August 2010.
7. A Russian language website corresponding with the disputed domain name is alleged to have been established in good faith.

4. Parties' Contentions

A. Complainant

The Complainant asserts rights in the trademark TAOBAO and states that the disputed domain name is confusingly similar to the trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant alleges that the Respondent registered and used the disputed domain name in bad faith.

B. Respondent

The Respondent is self-represented. The Response is a compilation of largely unsupported assertions and anecdotal side stories which appears not to have been tempered by a guiding legal hand and which generally pays no regard to the Policy and what it requires the Respondent to show. So far as it can be distilled into statements which have some possible pertinence to the Policy, the following emerges:

The Respondent claims that he is known by the term (or nickname) “TAO” by reason of the fact that those letters appear in his family name, **Tarasenko**. It is alleged that friends and relatives have called the Respondent that name for 36 years. It is also alleged that TAO is a common abbreviation in Russian for that family name.

The Respondent points out that the word TAO is a geographical placename, one example being the name of an island in Thailand.

It is said that the term “BAO” is commonly used in Russian, one example being in the form of the name SHAOBAO (pronounced similarly to TAOBAO by Russians), the name of a Russian popular music group of which the Respondent is a fan.

The Respondent is a tertiary educated computer programmer and invented the expression TAOBAO in 2001 before the domain name was registered to use as the name for its “TAOBAO” File System.

The Respondent disputes that it acted in bad faith but admits linking its website to Complainant’s website since “there is nothing illegal” in doing so.

Complainant’s trademark had not been registered in Russia at time of registration of the domain name.

The domain name could only be transferred by the order of a Russian court.

5. Findings

Paragraph 4(a) of the Policy states that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- 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

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to the trademark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trademark rights. It is accepted that a trade mark registered with a national authority is evidence of trademark rights for the purposes of the Policy. The Panel finds that the Complainant has trademark rights in TAOBAO acquired through registration since Complainant provides evidence of its existing registrations in Russia (where Respondent is domiciled) and many other countries.

It is convenient to here dispose of the Respondent's objection that the domain name was registered before the trademark was registered in Russia. Paragraph 4(a)(i) of the Policy requires proof of trademark rights. It does not require proof of antecedent trademark rights. All UDRP decisions are nowadays in accord that questions of priority are only relevant to matters of legitimacy or bad faith under paragraphs 4(a)(ii) or (iii) of the Policy. In any event, a trademark registration in a respondent's seat is not a requirement under the Policy and in this case although Complainant has a registration in Russia it has many Chinese trademark registrations for TAOBAO from well before the date of registration of the domain name.

Likewise, Panel here addresses what it has best discerned as a theme to many of the Respondent's submissions, being that "Tao" and "Bao" and commonly used terms such that the Complainant has no monopoly in their combination. Once more, UDRP decisions are now in harmony in regarding arguments of descriptiveness or genericism as relevant to paragraphs 4(a)(ii) or (iii) of the Policy.

The remaining question for the purposes of paragraph 4(a)(i) of the Policy is whether the disputed domain name is confusingly similar to the Complainant's trademark. It is established that when testing confusing similarity, the generic top-level domain ".com" can be ignored. The comparison then reduces to TAOBAO-RUSSIA with TAOBAO. The Panel finds that the mere addition to the trademark of the country name, Russia, does nothing to avoid confusion since, taken as a whole, the domain name is apt to suggest simply the Complainant's business in Russia or offerings to Russian consumers. Panel readily accepts Complainant's submission that the disputed domain name is confusingly similar to the trade mark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the disputed domain name. Nevertheless, it is well-settled that the Complainant need only make out a *prima facie* case, after which the onus shifts to the Respondent to rebut such *prima facie* case by demonstrating rights or legitimate interests.

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

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

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

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The publicly available WhoIs database identifies the registrant as Nikolay Aleksandrovich Tarasenko and so does not support any conclusion that the Respondent might be commonly known by the disputed domain name. There is no evidence that the Respondent has trademark rights in the disputed domain name, registered or not.

There is no evidence that the disputed domain name has been used in connection with a bona fide offering of goods or services. The Complainant provides evidence that the disputed domain name resolves to a Russian language website which suggests an affiliation with the Complainant when one does not exist.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent makes claims which have potential relevance to paragraph 4(c)(i) and (ii) above. In relation to paragraph 4(c)(ii), the Respondent asserts that he is well known by the name “TAO”. In support of that claim the Response annexes two postcards which show use of “TA...O” and “TAO”. The Policy requires proof that a person is “commonly” known by a name corresponding with the domain name. By “commonly” Panel comprehends, publicly. Moreover, this is not the domain name but only part of it. The Panel can give no weight to this submission.

It is also alleged that TAO is a common abbreviation in Russian for that family name. There is no evidence of that claim provided and the Panel finds it counterintuitive.

In relation to paragraph 4(c)(i), the question is whether, prior to communication of the Complaint to the Respondent this year, the Respondent used, or made 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.

The Respondent alleges that he is a tertiary educated computer programmer. The Response gives a rambling account of how Respondent allegedly “invented” the expression TAOBAO in 2001 before the domain name was registered with the intention to use the name for a co-called, “TAOBAO File System”. It would appear that system has yet to be commercialized and the evidence is so lacking that the Panel could not class the described activities as “demonstrable preparations to use” the domain name. Moreover, the use to which the domain name has been put, albeit somewhat ambiguous, in no sense relates to anything that might be considered to be a “file system”.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and so the Complainant has satisfied the second element of the Policy.

C) Bad Faith

Policy ¶ 4(b) sets out the circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

(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 website 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 website or location or of a product or service on your website or location.

In 2009, the year before the domain name was registered, the volume of business conducted by the Complainant under the trademark exceeded RMB200 billion (US\$29 billion). It is inconceivable that the Respondent was unaware of the Complainant's business at the time of registration. The Panel finds that the Respondent's submissions lack credibility. The Panel finds that registration of the domain name was in bad faith. On a balance of the evidence the Panel finds that the Respondent chose the disputed domain name so as to somehow benefit commercially from the notoriety of the Complainant's trademark and business.

The Panel also finds use of the domain name in bad faith. The resolving website suggests an affiliation or association with the Complainant that does not exist. It somehow (and, on the evidence, falsely) creates an inference that the Respondent acts as an authorized agent for the Complainant. The Respondent admits linking its website to the Complainant's website, submitting that "there is nothing illegal" in doing so. In terms of the Policy, there is in fact considerable danger to a domain name registrant doing just that if it has already chosen a name confusingly similar to that of the third party to which it links.

The Panel finds that the Respondent registered and used the disputed domain name in bad faith and so finds that the Complainant has not satisfied paragraph 4(a)(iii) of the Policy.

6. Decision

Having established all three of the elements required under the Policy, the Panel decides that relief shall be **GRANTED**.

Panel orders that the domain name <taobao-russia.com> be transferred from Respondent to Complainant. Respondent disputes Panel's authority to make that Order asserting that it is only a Russian court which can do so. Respondent is incorrect and is referred to its domain name registration agreement.



Debrett G. Lyons

Panelist

Dated: 30 July, 2014