



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1701007
Complainant:	Cainiao Network Technology Co., Ltd. (菜鸟网络科技有限公司)
Respondent:	Wang Jian
Disputed Domain Name(s):	cainiaocc.com

1. The Parties and Contested Domain Name

The Complainant is Cainiao Network Technology Co., Ltd. (菜鸟网络科技有限公司) of Building 3, 999 Liangmu Road, Yuhang District, Zhejiang, Hangzhou 311121, China.

The Respondent is Wang Jian of Hangkong road 123#, Wuhan, Hubei, China, 430000.

The domain name at issue is cainiaocc.com, registered by Respondent with PDR Ltd. d/b/a PublicDomainRegistry.com of 501, IT Building No 3, NESCO IT Park, NESCO Complex, Western Express Highway, Goregaon (East), Mumbai 400063, Maharashtra, India .

2. Procedural History

On August 1, 2017, the Complainant made complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC Hong Kong Office") pursuant to the Uniform Policy for Domain Name Dispute Resolution (the "Policy") approved by the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and Asian Domain Name Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "ADNDRC Supplemental Rules"). The ADNDRC Hong Kong Office asked the Registrar for the confirmation of the registration information with regard to the disputed domain name on the same day.

On August 2, 2017, the ADNDRC Hong Kong Office received from the Registrar the registration confirmation in connection to the disputed domain name, without further detail of the real registrant of the disputed domain name.

On August 10, 2017, the ADNDRC Hong Kong Office notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced, and transmitted the notice of the Complaint to the Respondent informing that the Complainant had filed a Complaint against the registration of the disputed domain name and the ADNDRC Hong Kong Office had sent the Complaint and its attachments through email according to the Rules and the ADNDRC Supplemental Rules. On the same day, the ADNDRC Hong Kong Office notified ICANN and Registrar of the commencement of the proceedings.

The ADNDRC Hong Kong Office had received no Response by the Respondent until August 31, 2017, and notified the parties that no Response had been received yet, and the case would be heard by default.

Having received a Declaration of Independency and Impartiality and a Statement of Acceptance from Mr. Chi Shaojie, the ADNDRC Hong Kong Office informed the disputing parties of the Confirmation of the Appointment of the Sole Panelist on September 4, 2017.

The sole panelist finds that the Panel was properly constituted in accordance with the Rules and the ADNDRC Supplemental Rules.

The procedural language is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and also in conformity with the language used by the Complainant in the submitted Complaint.

3. Factual background

The Complainant Cainiao Network Technology Co., Ltd. (菜鸟网络科技有限公司) of Building 3, 999 Liangmu Road, Yuhang District, Zhejiang, Hangzhou 311121, China found that the dispute domain name cainiaocc.com was improperly registered by the Respondent of Hangkong road 123#, Wuhan, Hubei, China, 430000, and submitted the Complaint against the registration, requiring the Panel to make a decision on the transfer of the disputed domain name.

4. Parties' Contentions

A. Complainant

The Complainant submits as quoted that it has registered numerous trademarks worldwide comprising of the words "Cainiao" Trade Marks.

1. The disputed domain name is confusingly similar to the Complainant's registered trademark "Cainiao".

The Disputed Domain Name (<cainiaocc.com>) incorporates the Complainant's "CAINIAO" trade mark in its entirety. The only difference between the Disputed Domain Name and the Complainant's "CAINIAO" mark is the inclusion of the letters "cc" as a suffix. It is well established that where the distinctive and prominent element of a disputed domain name is the complainant's mark and the only deviation is the inclusion of meaningless letters or a descriptive term, such does not negate the confusing similarity between the disputed domain name and the mark. In this case, the addition of the letters "cc" does nothing to reduce the confusing similarity of the Disputed Domain Name with the Complainant's "CAINIAO" mark, and the Disputed Domain Name will inevitably confuse users into believing that it was registered by or is affiliated with the Complainant.. (See *Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI*, WIPO Case No. D2006-0768; *Alibaba Group Holding Limited v. Lu Xiao Bo; Lingping*, ADNDRC Case No. HK-1400677; and *Alibaba Group Holding Limited v. David Huber*, ADNDRC Case No. HK-1400571 attached at Annexure 7.)

It is a well-established rule that in making an enquiry as to whether or not a trade mark is identical or confusingly similar to a domain name, the generic top-level domain extension, in this case <.com>, may be disregarded (see *Rohde & Schwarz GmbH & Co. KG v. Perthshire Marketing, Ltd*, WIPO Case No. D2006-0762 attached at Annexure 8).

2. The Respondent has no right or legitimate interest in the disputed domain name.

The Respondent registered the Disputed Domain Name on 18 November 2013, which is about 6 months after the Complainant was established and first began using its Cainiao Trade Marks. The Complainant has not licensed or otherwise authorised the Respondent's use of its Cainiao Trade Marks for any reason whatsoever, nor is the Respondent an authorised representative or partner of the Complainant. Given the fame of the Cainiao Trade Marks and the fact that the Complainant's first use of the Cainiao Trade Marks predate the Respondent's registration and use of the Disputed Domain Name, has the practical effect of shifting to the Respondent the burden of proof in establishing that it has rights and/or legitimate interests in the Disputed Domain Name (see *PepsiCo, Inc v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No. D2003-0174, attached at Annexure 9).

There is no evidence that the Respondent has been commonly known by the Disputed Domain Name. The Respondent's name does not reflect or correspond with the Disputed Domain Name, and there is no justification or apparent need for the Respondent to use "cainiao" in the Disputed Domain Name.

Further, to the best of the Complainant's knowledge and information, the Respondent has not registered or applied for any trade marks in China reflecting or corresponding to the Disputed Domain Name. Copy of a proprietor search carried out on the database of the China Trademark

Office in the name of the Respondent is attached at Annexure 10. It is logical to presume that China would be the first country in which the Respondent would seek to register a trademark, as the Respondent is apparently domiciled in China and the website to which the Disputed Domain Name resolves purports to provide services in China and is in the Chinese language.

The Disputed Domain Name resolves to a website that offers storage and logistics services in China, and which therefore competes with the Complainant's business ("Respondent's Website") (Annexure 6). The Respondent's Website also includes references to "菜鸟", which is identical to the Complainant's "菜鸟" trade mark and confusingly similar to the Complainant's "菜鸟驿站" trade mark. The Respondent's Website is in Chinese and purports to provide services from China. The Complainant is particularly well-known in China. Further, the Respondent's Website includes references to "淘宝" (i.e. Taobao) and "天猫" (i.e. Tmall), which are well-known e-commerce websites operated by Alibaba Group. The Complainant is an affiliate of Alibaba Group. In light of the foregoing, it cannot be mere coincidence that the Respondent registered a Disputed Domain Name that is confusingly similar to the Complainant's "CAINIAO" trade mark soon after the Complainant was established, and which provides services that directly compete with the Complainant in the Complainant's primary market (China).

Internet users who are seeking the Complainant's official website may mistakenly visit the Disputed Domain Name, and thereby get redirected to the Respondent's Website. This arrangement is clearly an attempt by the Respondent to attract more visitors to the Respondent's Website for commercial gain (i.e. to increase its number of customers). The Respondent will therefore not be able to claim that it is using the Disputed Domain Name for a bona fide offering of goods or services or legitimate non-commercial or fair use. See *Alibaba Group Holding Limited v. FLORENCIO DIAZ VILCHES / ANF AC*, NAF Case No. 1614763; *Madonna Ciccone p/k/a Madonna v Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847 and *Viacom International, Inc., Paramount Pictures Corporation, and Blockbuster Inc. v TVdot.net, Inc. f/k/a Affinity Multimedia*, WIPO Case No. D2000-1253 (attached at Annexure 11), which held that the intentional infringing use of another's trademark could not constitute a bona fide offering of goods or services. The Complainant also refers to *Microchip Technology, Inc. v. Milos Krejcik and EDI Corporation, d/b/a Aprillog.com*, WIPO Case No. D2001-0337 (a copy of which is attached at Annexure 12), where the panel held that although the respondent had been offering legitimate goods for sale prior to any notice of dispute, as the respondent used the domain name to resolve to a website where users were likely to be confused as to whether the site was affiliated with the complainant, the respondent could not be bona fide and did not have legitimate rights or interest in the domain name. The same reasoning would apply in this case.

3. The Disputed Domain Name has been registered and is being used by the Respondent in Bad Faith

The Disputed Domain Name has been registered and is being used by the Respondent in bad faith based on the following:

- (a) The Disputed Domain Name does not reflect or correspond to the Respondent's name. The Respondent's Website and business directly competes with the Complainant in China (where the Complainant is particularly well-known). The Respondent's Website also includes references to "菜鸟", which is identical to the Complainant's "菜鸟" trade mark, and references to "淘宝" (i.e. Taobao) and "天猫" (i.e. Tmall), which are well-known e-commerce websites operated by the Complainant's parent company, Alibaba Group. This lends support to the presumption that the Respondent's registration of the Disputed Domain Name, which incorporates the word "cainiao" in its entirety, was motivated solely to take advantage of the Complainant's reputation in the Cainiao Trade Marks and make undue profits (see *Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Kil Inja*, WIPO Case No. D2000-1409, a copy of which is attached at Annexure 13).
- (b) Furthermore, the Complainant first began using the Cainiao Trade Marks in March 2013 – 6 months before the Disputed Domain Name was registered. Based on the fact that the Respondent registered the Disputed Domain Name after the Complainant was established by Alibaba Group and the Respondent has been using it to offer services that compete with the Complainant, it is inconceivable that the Respondent was not aware of the Complainant's Cainiao Trade Marks at the time it registered the Disputed Domain Name. In light of the worldwide fame of the Alibaba Group, infringers often keep a very close eye on the business of the Alibaba Group (e.g. monitoring trade mark applications, press mentions and domain name registrations) to try and anticipate their new ventures and register domain names which incorporate these brands, with a view to taking unfair advantage of them for profit. The Complainant submits that the Respondent has acted in such a manner, by registering the Disputed Domain Name several months after the Alibaba Group announced the launch of its logistics arm, i.e. the Complainant.
- (c) Due to the confusing similarity between the Disputed Domain Name and the Cainiao Trade Marks; the fact that the Respondent's name does not in any way correspond to the Disputed Domain Name; the fact that the Respondent's Website competes with the Complainant's business; and the fact that the Respondent had to have been aware of the Complainant and its Cainiao Trade Marks (for the reasons stated above), it is inconceivable that the Respondent registered and is using the Disputed Domain Name for any other reason other than to create a false impression that the Disputed Domain Name is associated with the Complainant in order to make an unfair commercial gain.
- (d) It is well established that the Respondent's registration and use of the Disputed Domain Name must involve mala fides in circumstances where the registration and use of the Disputed Domain Name was and continues to be made in the full knowledge of the Complainant's prior rights in the Cainiao Trade Marks, and in circumstances where the Respondent did not seek permission from the Complainant, as the owner of the trade marks, for such registration and use. See *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163 (attached at Annexure 14).
- (e) The current use of the Disputed Domain Name by the Respondent is likely to mislead users into falsely believing that the Disputed Domain Name and any resulting website relates to the Complainant. As stated by the panel in *Paris Hilton v. Deepak Kumar*, WIPO Case No.

D2010-1364 (Annexure 15), *"it is use in bad faith ... where the registrant is using the domain name in this manner because of its similarity to a mark or name of another person in the hope and expectation that that similarity would lead to confusion on the part of Internet users and result in an increased number of Internet users being drawn to that domain name parking page...the confusion that is usually relevant here is the confusion that draws the Internet user to the respondent's website in the first place ... It does not matter that when the Internet user arrives at the pay-per-click site that it then becomes clear that the website is unconnected with the trade mark holder [emphasis added]."* Similarly, in *MathForm.com, LLC v. Weiguang Huang*, WIPO Case No. D2000-0743 (Annexure 16), the panel found that the respondent must have *"intentionally attempted to attract for commercial gain internet users to its website by using the domain name... which is likely to cause confusion with the [complainant's] website. The [respondent] has used its web site to provide... services similar to the [complainant's] services under the domain name..."*.

- (f) In these circumstances of blatant misappropriation of the Complainant's Cainiao Trade Marks, there can be no possible grounds on which to find that the Respondent's registration and use of the Disputed Domain Name has been otherwise than in bad faith and for the purpose of misappropriating the Complainant's goodwill and to disrupt the Complainant's business.

Based upon the above-said reasons, the Complainant requests for relief of the transfer of the disputed domain names.

B. Respondent

The Respondent makes no response in any form against any of the allegations and claims by the Complainant in the whole course of the proceeding.

5. Findings

It is significant for the parties to understand the legal nature of the current proceeding that is different from that of arbitration or litigation. Though the proceeding is known as administrative proceeding, it is really NOT the proceeding by a government agency. The jurisdiction by the Panel over the current dispute on the domain name registered by the Respondent comes from the authorization by the organization for the administration of domain name registration and maintenance. Anyone intends to register a domain name needs to sign a registration agreement with the administrative authority which makes no substantive examination on the registration application, but stipulates in the registration agreement that whenever a claim against the registration is submitted, the registrant is obliged to be a procedural party which has rights to make arguments against the claim, but subject to a decision made by a Panel constituted in conformity with the stipulated procedural rules. As it is, the current proceeding is a part of the whole proceeding for the registration and maintenance of domain names. As such, the fundamental feature of the Panel's making a judgment on the entitlement to the disputed domain name is to decide on a core issue of who should be the rightful holder of the disputed domain name, so as to be in conformity with the basic requirements set forth under the Policy and to help

keep the good operative order for the running of the internet, and to be beneficiary to the protection of common interests of the web-users.

The indispensable pre-condition for the Panel to find out the disputing facts is to base itself upon the allegations and defenses by the parties, which unavoidable pre-condition does not exist in the judgment of present dispute due to the lack of any defense by the Respondent. Procedural record shows that each and all documents submitted by the Complainant be properly transmitted to the Respondent; but no response by the Respondent was received. In view of this, what the Panel is going to do for the fact-finding is to base itself upon the submissions and exhibits by the Complainant alone. Unless the Panel has a reason to reject any submission or evidence by the Complainant in view of the panelist's professional sense to make judgment and personal experiences in making decisions on domain name disputes, the facts are to be held by the adoption of the Complainant's submitted evidences.

One of the prerequisites for the Respondent to register the disputed domain name through the Registrar is to accept the Policy as the binding regulations for the registration. As mentioned, the Policy applies to this dispute as the substantive criteria for making the judgment of whether the Complainant's request is to be sustained or rejected. As stipulated in the Paragraph 4(a) of the Policy, when claiming back a domain name registered by the Respondent, the Complainant must prove each and all of the following:

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

Based itself upon the stipulations under the Policy, what the Panel needs to do is to find out whether each AND all of the three basic facts can be attested by the Complainant. If the answer is yes, the Panel makes a decision in the Complainant's favor in accordance with the relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules. If not, the claim by the Complainant shall be rejected.

A) Identical / Confusingly Similar

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that the domain name at issue is identical OR confusingly similar to a trademark or service mark to which it is entitled. As stipulated in the Policy, the Complainant needs to prove either the IDENTITY or the CONFUSING SIMILARITY. To meet the requirement, the Complainant submits copies of trademark registration certificates, intending to prove that it is entitled to the trademarks "CAINIAO" which was registered earlier than the registration of the disputed domain name. The Panel examines all the relevant exhibits by the Complainant in relation to the entitlement to the registered trademark "CAINIAO" etc., and finds no reason for NOT holding the Complainant-stated fact, in particular, under the circumstance of no objection by the Respondent to whatever the Complainant states.

Obviously, the identifying part of the disputed domain name “cainiaocc.com” is NOT identical to the Claimant’s registered trademark “CAINIAO, due to the extra letters of “cc” in the prefix of the domain name. As such, what the Panel needs to find out is whether there is a confusing similarity in “cainiaocc” and “cainiao”.

Since the Complainant and the Respondent are both domiciled in China, it is appropriate to make the judgment on the issue of the confusing similarity from the Chinese perspective. As is known, the Chinese characters may be expressed in Latine letters in accordance with their pronunciations; e.g. the Complainant’s registered trademark “CAINIAO’ is spelt out from the pronunciation of the Chinese characters “菜鸟 which are not only registered as trademarks of the Complainant’s, but also used by the Complainant as its trade-name; which circumstances reinforced the prominent and attractive feature of the registered trademarks of “菜鸟” and its letter-spelling equivalent “CAINIAO” in China.

Judging from the spelling of the Respondent’s name, he or she seems to be a Chinese; and the domicile of the Respondent’s makes the Panel more reliable to say that. As a Chinese, the Respondent should be familiar with the meaning of the word “cainiao”, and its equivalent Chinese characters.

Of course, not a few Chinese characters may be equivalent to the letter spelling of “cainiao”, due to the fact that there are four different tones in Chinese pronunciation. Nevertheless, the Complainant alleges and further proves that, “The Respondent's Website and business directly competes with the Complainant in China (where the Complainant is particularly well-known). The Respondent's Website also includes references to "菜鸟", which is identical to the Complainant's "菜鸟" trade mark, ……” Obviously, when the Respondent registered the disputed domain name, he or she meant to use the Latin spelling “cainiao” equivalent to the Chinese Character “菜鸟”, aiming at taking advantage of the Complainant’s commercial fame and reputation. Logically speaking, such an illegal purpose must be match to confusing similarity of the “cainiaocc” and “cainiao”; otherwise the ill-purpose of the Respondent’s may not be realized. i.e. the web-users may not be confused with the relationship between the Complainant and the Respondent.

Why did the Respondent add two letters “cc” into the prefix of the disputed domain name, and do the letters have certain particular meaning to the Respondent? The only one who knows the answer could be none other than the Respondent itself. That is to say, the addition of the letters has no special meaning to the web-users, thus being no use to deviate web-users’ attention to the key words “cainiao” in the prefix of the disputed domain name.

Based on the above reasoning, the Panel holds that the disputed domain name “cainiaocc.com” is confusingly similar to the Complainant’s registered trademark “cainiao”, and thus the Complainant meets the first requirement for the transfer of the disputed domain name.

B) Rights and Legitimate Interests

Pursuant to Paragraph 4(a)(ii), the second requirement for the Complainant to meet in terms of the request for the transfer of the disputed domain name is to prove that the Respondent does not have rights to or legitimate interests in the domain name at issue. Reading the expression of the stipulation, it seems to be the Complainant who shall take the burden of proof to establish the fact that the Respondent does NOT have rights or legitimate interests in connection to the disputed domain name. Since the Complainant claims that it is entitled to the disputed domain name and the Respondent has nothing to do with it except having registered and used it in bad faith, it can hardly submit any evidence to prove something it does not think existing. Probably for this reason, the Panel pays more attention to whatever the Respondent argues with regard to the rights or legitimate interests in respect to the disputed domain name. The Policy gives chances to the Respondent to make argument on this issue by stipulating several could-be circumstances in the relevant article of the Policy. To the disappointment of the Panel, the Respondent makes no argument to say it has certain right or legitimate interest in regard to the domain name at issue. Under the circumstances, how could the Panel hold that it is the Respondent who is entitled to the disputed domain name?

On the other side, the Complainant submitted exhibits to certify that the key word “cainiao” in the identifying part of the disputed domain name was created by the Complainant, which was extensively registered and used as trademarks of the Complainant’s, and also used as the trade-name of the Complainant in its business operation. It is a commonly known fact that the Complainant has a high reputation in China, especially known on the web-site for its business operation. As it is, it is hardly believed that the Respondent does not know the Complainant and its business scope, and made the registration of the disputed domain name based upon its legitimate right or interest.

Furthermore, the Complainant submits that it has never and ever established linkage in any form or by any legal nature to the Respondent, with regard to the disputed domain name. The Panel holds the factual submission by the Complainant, since there is no negative submission and the evidence from the Respondent’s side.

Based upon the comprehensive analyses of all the relevant evidences by the Complainant, the Panel has sufficient reasons to ascertain that it is not the Respondent but the Complainant who has rights and legitimate interests in connection to the disputed domain name; and further holds that the Complainant meets the second requirement set forth under Paragraph 4(a)(ii).

C) Bad Faith

The Complainant has yet to establish the fact of bad faith on the part of the Respondent as set forth in the Paragraph 4(a)(iii) of the Policy.

Under the Paragraph 4(b) of the Policy, the following circumstances, in particular, shall be considered evidence of the registration and use of a domain name in bad faith: “..... (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;” Obviously, the Complainant was prevented from registering the same domain name to which the Complainant is entitled, but which was squatted by the Respondent’s registration.

Under the Paragraph 4(b) of the Policy, the following circumstances, in particular, shall be considered evidence of the registration and use of a domain name in bad faith: “..... ; (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Complainant charges that “The current use of the Disputed Domain Name by the Respondent is likely to mislead users into falsely believing that the Disputed Domain Name and any resulting website relates to the Complainant”; and submits relevant evidences to back its fact statement. Since there is no counter argument raised by the Respondent against the Complainant’s statement, the panel holds what the Complainant says on the Respondent’s misconduct of using the disputed domain name.

Furthermore, the logical thinking of the Panel is when a party registers a domain name which is NOT created by the party with its distinctive feature known in the real world, but identical or confusingly similar to a mark or logo or sign to which the other party has rights and legitimate interests with high market value, the intention of the registration is clear, namely taking illegal advantages by causing confusion to the consumers or preventing the lawful owner to register the same domain name for its business activities. On the other hand, if the registrant is NOT intentionally to take others’ advantage, it should create a distinctive domain name to make web-users easily tell the name from others. What is more, if someone registers a domain name in bad faith, it is hard for him to make use of the registered subject matter in good-faith, otherwise the ill-intention of the registrant would not be realized. This fundamental logic further supports the holding of bad-faith fact in the foregoing paragraph. In view of this, the Panel holds that the Complainant meets the requirement set forth under Paragraph 4(a)(iii) of the Policy.

Based upon all the above findings and reasonings, the Panel comes to final conclusion that the Complaint fulfills each AND all of the conditions provided in Paragraph 4(a)(i)(ii) (iii) of the Policy.

6. Decision

In light of all the foregoing findings and in accordance with Paragraphs 4(a), 8(a) of the Policy and 5(e) of the Rules, the Panel holds:

- a) That the disputed domain name “cainiaocc.com” is confusingly similar to the trademark “CAINIAO” to which the Complainant has rights and legitimate interests; and
- b) That the Respondent has no rights to or legitimate interests in the disputed domain name; and
- c) That the domain name was registered and used in bad faith.

As such, the Panel rules that the disputed domain name “cainiaocc.com” shall be transferred to the Complainant Cainiao Network Technology Co., Ltd. (菜鸟网络科技有限公司).

The Sole Panelist:

A handwritten signature in black ink, appearing to be a stylized name or set of initials, located below the text 'The Sole Panelist:'.

Dated: September 13, 2017