



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK- 1701028
Complainant:	Alibaba Group Holding Limited
Respondent:	Vyacheslav Svinarenko
Disputed Domain Name(s):	< ru-tmall.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. The authorized representative of the complainant is Mayer Brown JSM, 16th to 19th Floor, Prince's Building, 10 Chater Road, Central, Hong Kong SAR.

The Respondent is Vyacheslav Svinarenko, of Allilueva, 6/28, Vladivostok 690, 690000, Russia.

The domain name at issue is < ru-tmall.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 16 October 2017, the Complainant filed the Complaint with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the "Centre") in accordance with the Uniform Domain Name Dispute Resolution Policy ("Policy") adopted by the Internet Cooperation for Assigned Names and Numbers ("ICANN") on 24 October 1999. On the same date, the Centre transmitted by email to the Registrar a request for confirmation that the disputed domain name was registered by the Respondent and that the disputed domain name will be prohibited from being transferred to a third party.

On 17 October 2017, the Registrar confirmed by email that the Respondent was the registrant of the disputed domain name and the Disputed Domain Name had been locked. In accordance with paragraphs 2(a) and 4(a) of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 19 October 2017. In accordance with paragraph 5(a) of the Rules, the due date for the Response was 8 November 2017. The Respondent did not submit any response. Accordingly, the Centre notified the parties of the Respondent's default on 9 November 2017.

On 14 November 2017, the Centre appointed Professor Julien Chaisse as Panelist in the administrative proceeding. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rule 7. The Panel finds that the Asian Domain Name Dispute Resolution Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the Complaint, the Response, the e-mails exchanged, the evidence presented, the Policy, the Rules, the Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from the Respondent. Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Centre on or before 28 November 2017.

3. Factual background

The Complainant: Alibaba Group Holding Limited ('Alibaba')

A. The Complainant Alibaba and its activities

The Complainant is officially known as Alibaba, or “阿里巴巴” in Chinese, and operates its business through a number of subsidiaries and affiliates (collectively referred to as, “Alibaba Group”). Alibaba Group was founded in Hangzhou, China, in 1999. Since then, Alibaba Group has grown to become a global leader in the field of e-commerce. On 19 September 2014, the Complainant officially listed on the New York Stock Exchange (NYSE: BABA). According to the South China Morning Post, “Alibaba set a record for the world’s biggest initial public offering with its US\$ 25 billion listing in New York in September”.

Headquartered in Hangzhou, China, Alibaba Group, through its subsidiaries and affiliates, has offices in about seventy (70) cities across China, as well as in Hong Kong, Taiwan, Korea, India, Japan, Singapore, USA and Europe. For the year ended 31 March 2015 and 31 March 2016, Alibaba Group reported a total revenue, generated from all goods and services sold, of over USD11 billion and USD15 billion, respectively.

In 2008, Alibaba Group introduced the Tmall B2C platform designed to allow consumers to purchase products from worldwide brand owners or authorised distributors, and has since become the largest B2C retail platform in Asia. Brands and retailers can operate their own stores on the Tmall platform. As of March 31, 2016, there were over 100,000 brands on Tmall, including Apple, Zara, Estee Lauder, UNIQLO, L’Oreal, Adidas, P&G, Unilever, Gap, Ray-Ban, Nike and Levi’s.

In 2009, Tmall pioneered November 11, known as “Singles Day” in China, as an annual promotional shopping day. “Double 11” has become the most important shopping event in China and has generated the highest one-day retail sales volume in the world. On 11 November 2016, within a 24-hour period, the Tmall platform generated gross merchandise volume (“GMV”) of RMB 120.7 billion (US\$17.79 billion), covering 235 countries.

For the financial quarter ending on 31 March 2016, the combined GMV of the Tmall platform was about RMB 293 billion. The GMV transacted on the Tmall platform increased by 43% from RMB 847 billion in fiscal year 2015 to RMB 1,215 billion (about

US\$ 190 billion) in fiscal year 2016. According to iResearch, Tmall was China's largest third-party platform for brands and retailers in terms of GMV in 2016.

The Tmall platform links to Alibaba Group's other online platforms, including Alibaba.com International and China Marketplaces (www.alibaba.com, www.alibaba.com.cn and www.1688.com), the global and China-based business-to-business marketplaces for importers and exporters respectively; the Taobao marketplace (www.taobao.com), a Chinese language consumer-to-consumer Internet retail platform; and AliExpress (www.aliexpress.com), a leading global e-marketplace made up of small business sellers that offer a wide variety of consumer products at great prices.

B. The Complainant Alibaba and its Trade Marks

The growth of Alibaba Group, and the success of the Tmall platform and other services offered by Alibaba Group, have garnered a significant amount of media attention and resulted in a high public profile for Alibaba Group and the Tmall Trade Marks globally.

The services provided via the Tmall platform are carried on, supplied and marketed continuously and substantially under and/or by reference to the Tmall Trade Marks registered by the Complainant in various jurisdictions around the world. Since their first use, Tmall Trade Marks have acquired distinctiveness through extensive use by the Complainant and its affiliates in commerce, so that the Tmall Trade Marks are immediately recognisable to consumers as being associated with the Complainant and its business.

The Alibaba Group has expended significant time and effort to extensively promote the "TMALL" and "天猫" brand, and the products and services available through the Tmall platform, for several years via the Internet and through publicity and advertising in trade press and other print media.

The Respondent

No information of significance is available about the Respondent except for the contact details provided for the purpose of registration of the disputed domain names. The Disputed Domain Name was registered on 26 November 2010. The Disputed Domain Name currently resolves to a website that allegedly enables users in Russia to search for and purchase products via the Complainant's Tmall, Taobao and Alibaba platforms.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. Identical or confusingly similar

The Complainant submits that the Disputed Domain Name is identical or confusingly similar to marks in which the Complainant has rights on the basis of its Tmall's marks registrations. The Disputed Domain Name and the Complainant's registered Tmall's marks are identical.

The Complainant has registered numerous trademarks comprising the Tmall Trade Marks to protect its interests around the world, including the following:

- Russia trade mark “TMALL”, Registration Number 515237, classes 9, 16, 35, 38, 41 and 42, registered on 9 June 2014;
- EU trade mark “TMALL”, Registration Number 10519395, classes 9, 16, 35, 38, 41 and 42, registered on 21 December 2013;
- EU trade mark “ TMALL.COM”, Registration Number 012114401, classes 9, 16, 35, 38, 41, 42 and 45, registered on 1 February 2015;
- China trade mark “TMALL”, Registration Number 8820963, class 9, registered on 21 November 2011;
- China trade mark “TMALL”, Registration Number 8820991, class 35, registered on 14 March 2014;
- China trade mark “TMALL”, Registration Number 8821002, class 38, registered on 28 January 2014;
- Hong Kong trade mark “TMALL”, Registration Number 301756198, classes 9, 16, 35, 38, 41 and 42, registered on 5 November 2010;



- Hong Kong trade mark “”, Registration Number 302066940, classes 9, 16, 35, 38, 41 and 42, registered on 25 October 2011;

Copies of registration certificates/extracts from the official trademark database for the above listed trade mark registrations were submitted to the Panel so the Complainant has established that it has rights in the Tmall Trade Marks.

The Disputed Domain Name (<ru-tmall.com>) incorporates the Complainant’s “TMALL” trade mark in its entirety. The only difference between the Disputed Domain Name and the Complainant’s “TMALL” mark is the inclusion of “ru-” as a prefix. The Complainant submits that “ru” is simply a geographical reference to Russia, especially taking into account the content and language of the website to which the Disputed Domain Name resolves, and the fact that the Respondent appears to be based in Russia.

The Complainant accordingly submits that it has proved that the Disputed Domain Name is identical and/or confusingly similar to its registered trademarks in which the Complainant has rights or interests for the purposes of paragraph 4(a)(i) of the Policy.

ii. No rights or legitimate interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a) (ii) and particular 4(c) of the Policy.

The Tmall Trade Marks have acquired distinctiveness through their extensive use by the Complainant in commerce, so that the Tmall Trade Marks are immediately recognisable to consumers as being associated with the Complainant and its businesses. The

Complainant's "TMALL" mark is also a coined term, and has no meaning in English or any other language other than in relation to the Complainant.

The Respondent registered the Disputed Domain Name on 26 November 2010, which is 2 years after the Complainant's Tmall platform was established and after the "TMALL" trade mark was first used and registered by the Complainant.

The Complainant has not licensed or otherwise authorised the Respondent's use of its Tmall Trade Marks, nor is the Respondent an authorised representative or partner of the Complainant. Given the fame of the Tmall Trade Marks, the fact that they consist of a made-up word uniquely associated with the Complainant and the Tmall platform, and the fact that the Complainant's first use of the Tmall 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).

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 "tmall" in the Disputed Domain Name.

Further, to the best of the Complainant's knowledge and information, the Respondent does not own any trade mark registrations reflecting or corresponding to the Disputed Domain Name in Russia. It is logical to presume that Russia would be the first country in which the Respondent would seek to register a trade mark corresponding to the Disputed Domain Name, since the Respondent is allegedly domiciled in Russia.

The Complainant accordingly submits that it has proved that the Respondent has no right or legitimate interest in respect of any of the Disputed Domain Name for the purposes of Article 4(a)(ii) of the Policy.

iii. Registered and used in bad faith

The Complainant contends that the Respondent actual use of the Disputed Domain Name demonstrates that it is registered and used in bad faith, with a view to free-riding the substantial reputation and goodwill enjoyed by the Complainant in the trade names / marks "Tmall" and "Alibaba".

The Complainant accordingly submits that it has proved that the Respondent has registered and used the Disputed Domain Name in bad faith for the purposes of Article 4(a)(iii) of the Policy.

B. Respondent

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

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Complainant must prove that it has rights in a trademark to which each disputed domain name is confusingly similar.

It is well established that in cases where the distinctive and prominent element of a disputed domain name is the complainant's mark and the only deviation from this is the inclusion of a geographic indicator as a prefix or a suffix, such prefix or suffix does not negate the confusing similarity between the disputed domain name and the mark. See *Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI*, WIPO Case No. D2006-0768; *BASF SE v nanchangbasifuhuangongyouxiangongsiJianKangChen*, ADNDRC Case No. HK-1100390; *Alibaba Group Holding Limited ("ALIBABA", formerly known as Alibaba.com Corporation) v. Lai Qixing*, ADNDRC Case No. HK-0900273; and *Alibaba Group Holding Limited v. heilongjianghoubanyitongwangluokejiyouxiangongsi*, ADNDRC Case No. HK-1300519. The dominant part of the Disputed Domain Name is "tmall", and the addition of "ru-" as a prefix does nothing to distinguish the Disputed Domain Name from the Complainant's trade mark.

Moreover, 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. Pertshire Marketing, Ltd*, WIPO Case No. D2006 0762).

The Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B) Rights and Legitimate Interests

The Respondent has not responded to the Complaint to assert any rights or legitimate interests. The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and thereby the burden of production shifts to the Respondents to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see for example *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455).

Paragraph 4(c) of the Policy sets out ways in which a Respondent may establish they have rights and legitimate interests. These are: "(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 non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

In substance, the Disputed Domain Name currently resolves to a website that allegedly enables users in Russia to search for and purchase products via the Complainant's Tmall, Taobao and Alibaba platforms in the Russian language. However, the Respondent is not an authorised representative or partner of the Complainant, and the Complainant has never authorised the Respondent to use its Tmall Trade Marks or to operate the Respondent Website. It is inconceivable that the Respondent was not aware of the Complainant's Tmall Trade Marks at the time it registered the Disputed Domain Name for the following reasons:

- (a) the Respondent Website includes numerous references to and information on the Complainant and its Tmall, Taobao and Alibaba platforms, and purports to be established for the specific purpose of enabling users in Russia to purchase products from the Complainant's Tmall, Taobao and Alibaba platforms;
- (b) the Respondent Website includes numerous links to the Complainant's Tmall, Taobao and Alibaba platforms; and
- (c) the Respondent Website uses and prominently displays the Complainant's registered trade marks, including the following:



In light of the above, it is inconceivable that the Respondent was not aware of the Complainant's Tmall Trade Marks at the time it registered the Disputed Domain Name which suggests that the Respondent is using the Disputed Domain Name to unfairly capitalise upon or otherwise take advantage of the confusing similarity between the Complainant's Tmall Trade Marks and the Disputed Domain Name, to attract and redirect Internet users to the Respondent Website for commercial gain, which cannot provide the Respondent with a right or legitimate interest in the Disputed Domain Name. See *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, which held that the intentional infringing use of another's trade mark cannot constitute a *bona fide* offering of goods or services.

Further, as recently reminded in *Worldpay Limited v. Surojit Manna, Worldpay*, WIPO Case No. D2017-0160, any provision of goods or services via the Respondent Website cannot be *bona fide*, as the Respondent is using the Disputed Domain Name and Respondent Website to mislead users into believing that they are associated with or authorized by the Complainant (which is false). In this respect, as earlier held by the panel in *Microchip Technology, Inc. v. Milos Krejcik and EDI Corporation, d/b/a Aprilog.com*, WIPO Case No. D2001-0337, 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. Similarly, in *Option One Mortgage Corporation v. Option One Lending*, WIPO Case No. D2004-1052, where the respondent in that case was using the domain name <optiononelending.com> to provide mortgage related services which competed with the complainant's business, it was held that the "Respondent's use of a confusingly similar Domain Name on a website offering for sale overlapping products and services is neither a bona fide offering of goods or services, nor is it a legitimate non-commercial or fair use pursuant to Policy."

The Respondent has not responded to the complaint to present any evidence to establish rights or legitimate interests under these heads. None of the circumstances in paragraph 4(c) of the Policy are, therefore, present in this case. The second element of paragraph 4(a) of the Policy is therefore satisfied.

C) Bad Faith

To establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith. That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely: "... (i) *circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or (ii) Respondent has registered the disputed domain name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or (iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.*" However, those criteria are not exclusive and Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

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

- 1) The Complainant first began using the Tmall Trade Marks before the Disputed Domain Name was registered. The Tmall Trade Marks have acquired distinctiveness through their extensive use for over a decade by the Complainant and its affiliates in commerce, so that they are immediately recognisable to consumers as being associated with the Complainant. In light of the worldwide fame of the Tmall Trade Marks, the fact that the word "tmall" has no common meaning in English or any other language independent of the Complainant's Tmall Trade Marks, and for the reasons set out above in relation to the Respondent not having any legitimate interest or rights (e.g. use of the Complainant's registered trade marks, etc), it is inconceivable that the Respondent was not aware of the Complainant's Tmall Trade Marks at the time it registered the Disputed Domain Name.

- 2) 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 Tmall 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; *Ebay Inc. v. Wangming*, WIPO Case No. D2006-1107; *Mahindra & Mahindra Limited v. Guangdong Trading and Investment Ltd.*, WIPO Case No. D2016-0422.
- 3) As the panel said in *Paris Hilton v. Deepak Kumar*, WIPO Case No. D2010-1364, it is necessary to consider whether a respondent had used the domain name with the complainant's marks in mind and with a view to taking unfair advantage of those marks. The Respondent Website purports to enable users in Russia to purchase products from the Complainant's Tmall, Taobao and Alibaba platforms. The Respondent is operating the Respondent Website and has been using various trade marks registered by the Complainant, without the Complainant's authorisation. As such, the Respondent's registration of the Disputed Domain Name cannot possibly be for any reason other than to take unfair advantage of the Complainant's reputation in the Tmall Trade Marks in bad faith in order to redirect users to the Respondent Website for commercial gain.
- 4) In these circumstances of blatant misappropriation of the Complainant's Tmall brand, 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 selling it for profit and/or to misappropriate the Complainant's goodwill and disrupt the Complainant's business.

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use. Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(i) thereof.

6. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name < ru-tmall.com >, be TRANSFERRED to the Complainant.

Professor Julien Chaisse
Panelist
Dated: November 24, 2017