



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400615
Complainant:	Alibaba Group Holding Limited
Respondent:	Puttipan Kittiarattanakul
Disputed Domain Name(s):	taobaothai.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 Respondent is Puttipan Kittiarattanakul, of 2881-2883 Sukumvit Bangjuk, Prakanong, Bangkok 10260, Thailand.

The domain name at issue is **taobaothai.com**, registered by Respondent with Public Domain Registry, of Directiplex, Next to Andhei Subway, Old Nagardas Road, Andheri (East), Mumbai, Maharashtra 400069, India.

2. Procedural History

Complainant filed a Complaint, dated 22 May, 2014, with the Hong Kong office of Asian Domain Name Dispute Resolution Centre (the “ADNDRC”), through its counsel, Mayer Brown JSM of Hong Kong. On 23, May, 2014, the ADNDRC transmitted by email to Public Domain Registry (the “Registrar”) for registrar verification regarding the Disputed Domain Name.

On the same date The ADNDRC received the reply from the Registrar in connection with its verification response, confirming that the Respondent is listed as the Registrant of the Disputed Domain Name and also providing the contact details of the Respondent. The ADNDRC verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (“the Policy”).

The ADNDRC appointed Karen Mills as sole Panelist in this matter on 19 June 2014. Ms. Mills confirmed her availability, freedom from conflict, and ability to act impartially and independently on the same date and the files related to the case then forwarded to this Panelist by ADNDRC.

Subsequently the Respondent sent a brief email to ADNDRC indicating its request for the proceedings to be held off until it could file a response before the end of June. Complainant submitted a request not to permit any delay. On 23 June, 2104 the Panelist issued Administrative Panel Order No. 1, affording the Respondent additional time until 12:00 noon on 27 June to file its Response. No response was received from Respondent whatsoever and thus the matter has been decided upon the submission of the Complainant only. The time for issuance of this award was extended until 11 July, 2014.

3. Factual background (Based Solely on Complainant’s Complaint)

A. The Complainant

- i. The Complainant is officially known as Alibaba, and operates its business through a number of subsidiaries and affiliates (collectively referred to as the “Alibaba Group”). The Alibaba Group was founded in Hangzhou, China in 1999.
- ii. In May 2003, the Alibaba Group founded the brand “Taobao” and it uses www.taobao.com as its website. Taobao is a Chinese language consumer-to-consumer (“C2C”) internet retail platform, focusing on Chinese consumers.
- iii. The Complainant has registered trademarks comprising of or incorporating *Taobao* in 2003 in several jurisdictions, including Thailand, the European Union, the United States of America, The People’s Republic of China, Hong Kong SAR, Macau, Singapore and Taiwan.

- iv. According to the WHOIS database, the Disputed Domain Name is registered to the Respondent. The Complainant claims that the Disputed Domain Name is identical or confusingly similar to Complainant's registered trademarks.

B. The Respondent

- i. The Respondent has not submitted a Response to the Complaint, either under the original time frame nor when afforded an extension of time by the Panelist, as referred to above.
- ii. The Complainant alleges in the Complaint that, on 30 September 2003 the Respondent registered the Disputed Domain Name with Public Domain Registry, whose address is Directplex, Next to Andheri Subway, Old Nagardas Road, Andheri (East), Mumbai, Maharashtra 400069, India.
- iii. The Complainant also claims that the Disputed Domain Name currently resolves to an online marketplace.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Name is identical and/or confusingly similar to trade or service marks in which the Complainant has rights.*

The Complainant asserts its rights in the trademark *Taobao* and has provided copies of registration certificates/extracts from the official trademark databases attached at Annexure 3. The only difference between the Disputed Domain Name and the Complainant's "TAOBAO" mark is the inclusion of the generic word "thai" as a suffix in the Disputed Domain Name, which this suffix does nothing to distinguish the Disputed Domain Name from Complainant's trade mark. Furthermore, domain extensions such as (.com) and (.net) should be disregarded.

- ii. The Respondent has no right or legitimate interest in respect of the Disputed Domain Name.*

The Complainant submits:

First: The Complainant registered the “TAOBAO” trademarks in 2003 and the Respondent registered the Disputed Domain Name on 30 September 2009, six years after the “TAOBAO” trademark was first registered and used by the Complainant.

Second: Complainant contends that there is no evidence to suggest that the Respondent has been commonly known by the disputed Domain Name, since the Respondent’s name and his organization do not reflect nor correspond with the Disputed Domain Name.

Third: The Disputed Domain Name resolves to an online market place, in the Thai language, which sells products from China and purports to be a partner of the Claimant and its businesses.

Fourth: The Respondent is not an authorized representative nor partner of the Complainant, and the Respondent was never authorized nor permitted by the Complainant to use the TAOBAO trademarks.

Fifth: The Respondent is clearly aware of the Complainant and its Taobao Marketplace as Disputed Domain Name website includes numerous references to the Complainant and its *Taobao* Marketplace, and the Disputed Domain Name website uses and prominently displays marks virtually identical to the Complainant’s own trademark, which are featured on the Complainant’s Taobao Marketplace, to unfairly capitalize upon or otherwise take advantage of the confusing Complainant’s trademarks and the Disputed Domain Name.

Lastly: The Complainant claims that any provision of goods or services via the Disputed Domain Name website cannot be *bona fide* as the Respondent is clearly using the Disputed Domain Name and the website to mislead users into believing that they are associated with or authorized by the Complainant.

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

The Complainant submits that the Respondent is using the Disputed Domain Name in bad faith, as the Respondent has no rights nor legitimate interest in the Disputed Domain Name and the Disputed Domain Name does not reflect or correspond with the Respondent’s own name nor the name of his organization. The Complainant also submits that the Complainant had already used the TAOBAO trademarks for six years since 2003 before the Respondent registered the Disputed Domain Name. The

Complainant also submits that as the Respondent must have been aware of the Complainant's rights and interest in Disputed Domain Name, the Respondent's registration of the Disputed Domain Name cannot possibly be for any reason other than to take advantage of the Complainant's reputation in Taobao trademarks. The Complainant claims that the Respondent's registration and use of the Disputed Domain Name involve *mala fides* as the Respondent did not seek permission from the Complainant, as the owner of the trade marks, for such registration. Further, due to the confusing similarity between the Disputed Domain Name and the *Taobao* trademarks, the Complainant contends that it is reasonable for the Complainant to infer that the Disputed Domain Name was registered to mislead and confuse Internet users into believing that the Disputed Domain Name is associated with the Complainant, for Respondent's commercial gain. Lastly, the Complainant states that it experiences a high incidence of infringers registering domain names that are confusingly similar to its *Taobao* trademarks and other trademarks and the Complainant has also found that infringers often monitor the Complainant's business to try and anticipate their new ventures and register domain names which incorporate these brands, with a view to later selling them to the Complainant or its competitors.

B. Respondent

The Respondent did not submit any response to Complainant's submission. Therefore, it has not contested the allegations made by the Complainant.

5. Findings

In determining the substantive matters of the dispute, the Panel is instructed, under Article 15 (a) of the Rules, to decide a complaint upon the basis of the statements and documents submitted to it and in accordance with the Policy, the Rules and any rules and principle of law that it deems applicable.

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. These are:

- 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

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

1. The Panel finds that the Disputed Domain Name “taobaothai.com” is, if not identical, certainly confusingly similar to the *Taobao* trade marks in which the Complainant has rights. To confirm its own rights in the trademark, the Complainant provided, as Annexure 3, a list of copies of registration certificates from the official trademark databases of some countries where the Complainant has registered its trademarks, including Thailand. From the registration certificates list provided by the Complainant, it is shown that the Complainant has registered the *Taobao* trademarks since 2003 and thus has rights in the Trademark *Taobao*.
2. The word *Taobao* is identical to the trademark registered by Complainant. The Panel is cognizant that additions of suffix such as “*thai*” does not distinguish the trademark name when used by Respondent. The meaning of the suffix ‘*thai*’ is simply a geographical reference to Thailand and does not alter the main trademark name, *Taobao*. Upon some minor research it is evident that the word “*taobao*” has no meaning in the Thai language. Thus it would appear that the intent of the use of the Disputed Domain Name is to give the impression that the Respondent’s website and business is the Thai branch of that of the Complainant.
3. Thus the Panel finds that the Disputed Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

B) Rights and Legitimate Interests

1. The Respondent registered the Disputed Domain Name starting in 30 September 2009, six years after the Complainant had first registered its trademarks in 2003.
2. The Complainant has the burden of proof to establish that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant’s assertion is sufficient to establish a *prima facie* case under Paragraph 4(a)(ii), therefore

the burden of proof shifted to the Respondent to provide evidence to allow the Panel to assess whether Respondent does have any rights or legitimate interest. Respondent has provided no explanation as to what basis he determined he had the right to use the name, already registered to Complainant, nor evidence of any such right or interest.

3. The Disputed Domain Name does not appear to be in use for any *bona fide* offering of goods or services, since there is no indication that the Respondent owns any trade mark registrations reflecting or corresponding to the Disputed Domain Name in Thailand, as shown by the Complainant in Annexure 11. There is likewise no evidence that the Disputed Domain Name is one that has any significance for Respondent. The images taken from the website of the Disputed Domain Name show several items for sale. However, interestingly, any attempt to access the website at this time fails entirely. No such website is found. It would appear that the Respondent has withdrawn use of the website under the Disputed Domain Name subsequent to receiving Complainant's Complaint. This would indeed indicate that the Respondent had no legitimate use for the website and thus for the Disputed Domain Name.
4. If Respondent did have any legitimate right or interest in the Disputed Domain Name, one would have expected him to submit a response to justify his use thereof. No response was forthcoming from Respondent and therefore there is no basis upon which this Panel can find any such legitimate right or interest.
5. Thus the Panel finds that the Respondent has no rights nor legitimate interests in respect of the Disputed Domain Name.

C) Bad Faith

1. The Policy, in Paragraph 4(b), sets out some guidance for determination of the existence of bad faith. In particular, but without limitation, the following circumstances shall constitute evidence of bad faith:
 - a. Circumstances indicating that registrant did so primarily for the purpose of selling, renting or otherwise transferring the domain name to the complainant who is the owner of the relevant trademark/service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name involved;

- b. The registrant did so to prevent the owner of the relevant trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
 - c. The registrant did so for the purpose of disrupting the business of a competitor; or
 - d. By using the domain name in question, the registrant intentionally attempted to attract, for commercial gain, internet users to the registrants website, by creating confusion with the complainant's mark as the source, sponsorship, affiliation, or endorsement of the registrant's website or of a product or service on the registrant's website.
2. Let us examine which, if any, of these elements appear to be present in the instant case .
- a. The Claimant alleges that the Respondent has the intention to sell the Disputed Domain Name, as the Claimant claims that it has been experiencing high incidence of infringers registering domain names that are confusingly similar to its Taobao trademarks, view to later selling the Disputed Domain Names to the Respondent. However Complainant has not indicated that there has in fact been any such approach by Respondent, nor any contact whatsoever. Nor is it possible to determine whether there has ever been any notification on the website itself that it is for sale, since the website can no longer be accessed. Therefore the Panel can find no indication that any attempt was made by Respondent to offer to sell the Disputed Domain Name to the Complainant, nor that the site or the name is for sale.
 - b. In this case, there is no indication, nor has Complainant alleged, that Respondent has engaged in a pattern of conduct in registering any other domain names. Nor has the Complainant been prevented from using or registering the same name under any other register.
 - c. There is also no indication presented to this Panel that Respondent's purpose in registering or using the Disputed Domain Name was to disrupt the business of the Complainant.
 - d. However, Complainant has established a fair case that Respondent intentionally attempted to attract, for commercial gain, internet users to the registrant's website. The website under the Disputed Domain Name did, when it was in operation, offer products similar to certain of those offered by the Complainant, and under the exact logo which is the intellectual property rights of the

Complainant. It is undisputable that the intention was to give the impression, which impression would be inescapable, that the products being offered were products associated with Complainant. The Annures show that Respondent's website was formatted similar to and appears quite similar to that of the Complainant, with the same logo, *Taobao*, and its Chinese characters below, at the top.

In this regard, the Panel refers to the decision in *TPI holdings Inc. v. JB Designs* WIPO D2000-0216 cited by the Claimant, in which the Panel found that:

“the respondent’s slavish copying of the complainant’s web site on the respondent’s web site was determinative that the respondent had registered and used the disputed domain name in bad faith.”

- e. The Respondent has declined to submit any explanation or defense, nor any indication that the purpose of its registration and use of the Disputed Domain Name was anything other than an intentional attempt to confuse internet users and attract them to his web site, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source of his web site or location of the products offered thereon, and probably to create the impression that Respondent's operation is Complainant's regional branch in Thailand.
- f. The fact that the Respondent, instead of submitting his response to Complainant's Complaint, setting out his own position and defending his conduct, has simply withdrawn and shut down the website of the Disputed Domain Name, is also an indication that the Respondent is aware that he has been acting in bad faith and now wishes to retreat from such conduct.

Thus the Panel finds that the domain name has been registered and is (or at least was) being used in bad faith.

6. Decision

Founded upon the Policy, the Complaint and the above analysis, this Panel finds that the Disputed Domain Name registered by the Respondent is identical or confusingly similar to trademarks in which the Complainant has rights; the Respondent has no legitimate right nor

interest therein; and the Disputed Domain Name was registered and used by the Respondent in Bad Faith.

Consequently, this Panel hereby orders the Disputed Domain Name *taobaothai.com* to be transferred to the Complainant.



Karen Mills

J.D F.CI Arb., F.HKI Arb., F.SI Arb.

Panelists

Dated: 7 July 2014