



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400610
Complainant:	Alibaba Group Holding Limited
Respondent:	Pavel Polukhin
Disputed Domain Name(s):	< tao6ao.com >

1. The Parties and Contested Domain Name

The Complainant is Alibaba Group Holding Limited, of Fourth floor, One Capital Place, PO Box 847, George Town, Grand Cayman, Cayman Islands, British West Indies.

The Respondent is Pavel Polukhin , of Ovchinnikova str. 20-54, Vladivostok, Primorsky Krai 690000, Russia.

The domain name at issue is < tao6ao.com >, registered by Respondent with Melbourne IT Limited of Level 3, 469 La Trobe St. Melbourne, Victoria 3000, Australia.

2. Procedural History

On 14 May 2014, the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (the "ADNDRC Hong Kong") received a Complaint (the "Complaint") in English filed by the Complainant pursuant to the Uniform Domain Name Dispute Resolution Policy, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN Board of Directors on 30 October 2009 (the "Rule") and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 26 July 2012 (the "Supplemental Rules). The Complainant selected to have the case decide by a single member Panel.

The Registrar was notified of the Complaint on 14 May 2014. The Registrar was requested to confirm that the domain name at issue was registered by the Respondent with them. On 15 May 2014, the Registrar confirmed that the Disputed Domain Name was registered with it by the Respondent.

On 22 May 2014, the ADNDRC Hong Kong Office by email notified the Respondent of the Complaint and provided copy of the Complaint to the Respondent; and confirmed that the Commencement of the Proceedings was 22 May 2014. The Respondent was asked to

submit a Response to the Complaint in accordance with Article 5 of the Rules on or before 11 June 2014.

On 12 June 2014, the ADNDRC Hong Kong Office notified the parties that a Response to the Complaint has not been submitted by the Respondent within the required time, and the Case Administrator will shortly appoint Panelist for the matter.

On 13 June 2014, the ADNDRC Hong Kong Office wrote to panelists for availability to deal with the case. On the same day, Mr Anthony Wu confirmed availability and that he would be able to act independently and impartially between the parties.

On the same day, the ADNDRC Hong Kong Office appointed Mr Anthony Wu to serve as Panelist and notified the parties of the appointment. All documents submitted by the parties were sent to the Panelist by email on the same day. The Panelist was to render the decision on or before 27 June 2014.

On 27 June 2014, at the request of the Panelist, the due date for the Panelist to render a decision for the case is extended to 4 July 2014.

Note: As the Registration Agreement is in English and there did not appear to be exceptional circumstances, the Panelist, pursuant to paragraph 11 of the Rules, decides to use English for the proceeding.

3. Factual background

The Complainant is officially known as Alibaba, or “阿里巴巴” in Chinese, and is a global leader in the field of e-commerce operating its business through a number of subsidiaries and affiliates (collectively referred to as, "Alibaba Group") in some 70 cities worldwide.

In May 2003, Alibaba Group founded the brand “Taobao” (in Chinese “淘宝”) at www.taobao.com (also known as “淘宝网” in Chinese), a Chinese language consumer-to-consumer ("C2C") Internet retail platform, focused on Chinese consumers. In the last ten years, its C2C platform operated by Alibaba Group's affiliates under the Taobao brand ("Taobao Marketplace") has grown to become one of China's largest online retail platforms and the primary online shopping destination in China.

Alibaba Group, through its onshore affiliates operates two platforms, www.taobao.com and www.taobao.com.cn (the "Taobao Websites") under the Taobao Marketplace. Other than the Taobao Marketplace, there are also a number of other trading or shopping platforms. The Taobao Websites also links to Alibaba Group's other online platforms. Alibaba Group's business and services of the Taobao Marketplace are and have always been carried on, supplied and marketed continuously and substantially under and/or by reference to the Taobao Trade Marks.

Taobao Marketplace's transaction volume exceeded RMB200 billion (US\$29 billion) in 2009. Alibaba Group, through its affiliates, has expended significant time and effort in promoting the Taobao Trade Marks and the products and services available at the Taobao Websites since 2003 via the Internet and through publicity and advertising in trade press and other print media.

The growth of Alibaba Group, and the success of the Taobao branded services, have garnered a significant amount of media attention and resulted in a high public profile for Alibaba Group and its brands globally. As a result of the Complainant's significant investment and use, the Taobao Trade Marks have become well-known to consumers / Internet users in Russia. The Alibaba Group and the Taobao Trade Marks are well-known in Russia. The Taobao Trade Marks have acquired distinctiveness through extensive use by the Complainant and its affiliates in commerce over the years, so that the Taobao Trade Marks are immediately recognisable to consumers as being associated with the Complainant, its affiliates and their business.

The Respondent has not filed a Response. The Disputed Domain Name was registered on 29 October 2010. 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 Complainant has registered numerous trade marks comprising the Taobao Trade Marks to protect its interests around the world. Amongst the first registrations was the Hong Kong trade mark "TAOBAO", registration number 300023282, registered on 23 May 2003. The Complainant has been using the Taobao Trade Marks since then. The Disputed Domain Name incorporates the Complainant's Taobao Trade Marks in its entirety, the only differences being the use of the Russian letters "т" and "б" instead of the English letters "t" and "b". The use of the Russian letters "т" and "б" instead of the English letters "t" and "b" does nothing to detract from the confusing similarity between the Disputed Domain Name and the Complainant's Taobao Trade Marks, as they are still confusingly similar both visually and phonetically. Further, the words "таobao.com" is widely known and accepted as the Russian translation of the Complainant's Taobao Trade Marks and would add to the confusion. This proves that the Disputed Domain Name is identical and/or confusingly similar to its registered trade marks in which the Complainant has rights or interests in the terms of Paragraph 4(a)(i) of the Policy.
- ii. The facts that the Taobao Trade Marks had acquired distinctiveness through the extensive use in commerce by the Complainant and its affiliated companies, that the Respondent registered the Disputed Domain Name 7 years after the "TAOBAO" trade mark was first registered and used by the Complainant, and the Complainant has not licensed, consented to or otherwise authorised the Respondent's use of the Taobao Trade Marks, have 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.
- iii. The Disputed Domain Name resolves to an online marketplace (the "Website") that sells products from China. From the content of the Website, it is clear that the Respondent is aware of the Complainant and its rights in the Taobao Trade Marks. The Website even describes itself as "Таobao.com в России" (i.e. "Taobao.com in Russia") and has the following tagline at the top of the Website: "Покупать в Китае, не выходя из дома? Легко! Есть Таobao" (i.e. "Buy in China without leaving home? Easy! There's Taobao"). It also claims to act as an intermediary to enable buyers in Europe to purchase

products from the Complainant's Taobao Marketplace, and claims to have translated the Complainant's Taobao website (www.taobao.com) into Russian. But the Respondent is not an authorised representative or partner of the Complainant. The Website uses and prominently displays an image (the Respondent's Orange man) which is identical to the Complainant's orange mascot known as "Tao Doll". The Respondent is using the Disputed Domain Name to unfairly capitalise upon or otherwise take advantage of the confusing similarity between the Complainant's Taobao Trade Marks and the Disputed Domain Name, to attract and redirect Internet users to the Website for commercial gain, which cannot provide the Registrant with a right or legitimate interest in the Disputed Domain Name.

iv. Further, the Respondent is seeking to sell the Disputed Domain Name in return for profit and this again cannot amount to a right or legitimate interest in respect of the Disputed Domain Name.

v. There was no evidence that the Respondent could rely on Paragraph 4(c) of the Policy and by virtue of the matters raised above, the Respondent is precluded from raising it. The Complainant accordingly has proved that the Respondent has no right or legitimate interest in respect of the Disputed Domain Name in the terms of Paragraph 4(a)(ii) of the Policy.

vi. For the reasons set out in Item (iii) above, the Respondent must have been aware of the Complainant's prior rights and interests in the Disputed Domain Name. As such, 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 the Taobao Trade Marks in bad faith for the purposes of selling it for commercial gain, and/or to take unfair advantage of the Complainant's reputation in the Taobao Trade Marks in order to redirect users to the Website. Such registration and use is in bad faith as it falls squarely within the circumstance of Paragraph 4(b)(iv) of the Policy.

vii. Further, another of the Respondent's motives for registering the Disputed Domain Name was to sell the Disputed Domain Name for profit. In the exchange of correspondence between the Complainant's agent (anonymously) and the Respondent, the Respondent had asked for a selling price of US\$5,000 which was in excess of the registration fee of the Disputed Domain Name. This falls squarely within Paragraph 4(b)(i) of the Policy as evidence of bad faith.

viii. By virtue of the circumstances, the Complainant has proved that the Respondent has registered and is using the Disputed Domain Name in bad faith for the purposes of Paragraph 4(a)(iii) of the Policy.

B. Respondent

The Respondent did not file any Response.

5. Findings

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.

A) Identical / Confusingly Similar

On the evidence, the Panelist accepts that through investment and use the Taobao Trade Marks are well known worldwide, including Russia. The Complainant clearly has rights over these marks. The Panelist also accepts the contention of the Complainant that the Disputed Domain Name has incorporated the Taobao Trade Marks in its entirety save and except the use of the Russian letters "т" and "б" for the English letters "t" and "b". They are similar visually and phonetically. While the Panelist has no personal knowledge of the Russian pronunciation, the Respondent did not respond to the Complainant's assertions as such. The Panelist would in the circumstances accept that to be true. Having regard to the fact that the Taobao Trade Marks are well known worldwide, the Panelist does find the Disputed Domain Name to be confusingly similar to the Taobao Trade Marks which the Complainant have rights. The Complainant has proved Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The Panelist accepts that by virtue of the facts that the Complainant's Taobao Trade Marks are well known worldwide, that they have been registered well before the registration of the Disputed Domain Name, that, from the contents of the Website (Paragraph 4Aiii above refers), one could reasonably infer that the Respondent knew of these trade marks when the Disputed Domain Name was registered, and that the Complainant has never authorised the use of the Taobao Trade Marks in any way by the Respondent, the Complainant has proved a prima facie case that the Respondent does not have any rights and legitimate interest in the Disputed Domain Name. The onus of prove is shifted to the Respondent to prove that he has such right and legitimate interest. The Respondent did not file any Response and has failed to discharge the onus of proof. Accordingly, the prima facie case is accepted by the Panelist to be the true facts of the case. The Complainant has proved Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Based on the facts as set out in Paragraph 4Aiii above, the Panelist accepts that the Complainant has proved that the circumstance falls within Paragraph 4 (b)(iv) of the Policy that "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." The usurpation was blatant and the reasonable inference for the usurpation was for commercial gain.

The circumstance shall be evidence that the registration and use of the Disputed Domain Name was in bad faith for the purpose of Paragraph 4(a)(iii) of the Policy and the Complainant has proved Paragraph 4(a)(iii) of the Policy.

Having regard to the Panelist finding above, it is not necessary for the Panelist to consider whether the circumstance within paragraph 4 (b)(i) of the Policy 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" also existed.

6. Decision

For the foregoing reasons, the Complainant has proved the three necessary elements under Paragraph (4)(a) of the Policy and has prevailed with its Complaint. The Panelist orders that the Disputed Domain Name < tao6ao.com > be transferred to the Complainant as requested by the Complainant.

Anthony Wu
Panelists

Dated: 4 July 2014