



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0900201
 Case ID HK-0800231
 Disputed Domain Name www.wal-martstores.info
 Case Administrator Dennis CAI
 Submitted By Lyons Debrett G.
 Participated Panelist

Date of Decision 25-02-2009

Language Version : English

The Parties Information

Claimant Wal-Mart Stores, Inc.
Respondent Pavel Tkachev

Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the "Center") on November 18, 2008. On November 19, 2008, the Center transmitted by email to Name.com LLC. a request for registrar verification in connection with the domain name at issue. On November 20, 2008 Name.com LLC. 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 for Uniform Domain Name Dispute Resolution 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 December 5, 2008. In accordance with the Rules, the due date for Response was December 29, 2008. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 30, 2008.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on February 16, 2009. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

Factual Background

For Claimant

1. The Complainant is a retailer and owner of department stores in the United States and many other countries. It does business under the trademark WAL-MART.
2. 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.
3. The Complainant petitions the Panel to order transfer the disputed domain name from the Respondent to the Complainant.

For Respondent

1. The Respondent is an Estonian resident.
2. The Respondent registered the disputed domain name on April 17, 2008.
3. The disputed domain name is not in use.

Parties' Contentions

Claimant

<https://www.adndrc.org/icann/icase.nsf/fa40f875614a7ea348256b10002b5cff/5f69d2a4c6a3d362...> 2/25/2009

The Complainant asserts rights in the trademark WAL-MART 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.

The detail of the Complaint is included where necessary in Part 5 of this decision.

Respondent

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

Findings

Notwithstanding the fact that the Respondent did not offer a response to the Complaint, the Rules instruct the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles 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:

- 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.

The Panel is entitled to accept reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory (See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true; see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) stating that "In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Identical / Confusingly Similar

The Complainant states that the first WAL-MART store was opened in the United States in 1962 and that since then the Complainant's business has grown enormously. The Complainant now operates over 6,800 stores and has more than 1.9 million employees spread over the US, Canada, China, Japan, Mexico, Argentina, Brazil, Germany, Puerto Rico, Costa Rica, Nicaragua, Guatemala, Honduras, El Salvador and the United Kingdom. The Complainant's global sales in the 2007-2008 US financial year exceeded US\$374 billion. The Complainant has been listed as the number one Fortune 500 company almost every year since 2002. Each week, more than 180 million customers visit the Complainant's stores.

The Complainant has registered numerous domain names and the Complainant's trademark has been registered in 95 countries or regions (for example, United States Federal Trademark Registration No. 1,322,750 from February 26, 1985).

The Panel has no hesitation in finding that the Complainant has rights in the trademark acquired through both use and registration (see *State Farm Mut. Auto. Ins. Co. v. Malain*, FA 705262 (Nat. Arb. Forum June 19, 2006) finding that "Complainant's registrations with the United States Patent and Trademark Office of the trademark STATE FARM establishes its rights in the STATE FARM mark pursuant to Policy ¶ 4(a)(i)."; see also *Mothers Against Drunk Driving v. phix*, FA 174052 (Nat. Arb. Forum Sept. 25, 2003) finding that the complainant's registration of the MADD mark with the United States Patent and Trademark Office establishes the complainant's rights in the mark for purposes of Policy ¶ 4(a)(i)).

Applying the principles developed and now broadly accepted under the Policy, the Panel also finds the disputed domain name to be confusingly similar to the trademark. The disputed domain name wholly incorporates the Complainant's trademark. The addition of the purely descriptive word, "stores", and the gTLD, ".info" are trivial and do nothing to defeat the Complainant's claim of confusing similarity (see *Rollerblade, Inc. v. McCrady*, WIPO Case No. D2000-0429 finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar; see also *Wal-Mart Stores, Inc. v MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662 holding confusing similarity when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other non-distinctive terms in the domain name).

The Panel finds that the Complainant has satisfied the first element of the Policy.

Rights and Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the 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 demonstrate rights or legitimate interests (see *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. D2000 0624; *Hanna Barbera Prods., Inc. v. Entm't Commentaries*, NAF Case No. 741828; *AOL LLC v. Gerberg*, NAF Case No. 780200). Paragraph 4(c) of the Policy states that any of the following circumstances which if found by the Panel to be proved based on its evaluation of the evidence, demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii):

- (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 Complainant has established its trademark rights. There is no evidence that the Respondent has similar rights, registered or not. The WHOIS data does not support any argument that the Respondent might be commonly known by the domain name. The Complainant has stated there to be no relationship between the parties.

The Respondent is not using, nor has it made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services.

The Panel finds that the Complainant has succeeded in making a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the Respondent in failing to reply has not discharged the onus which fell to it as a result. The Panel finds that the Respondent has no rights or legitimate interests in the domain name and so the Complainant has established the second limb of the Policy.

Bad Faith

Paragraph 4(b) of the Policy 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.

The Complainant explicitly relies on paragraph 4(b)(iii) of the Policy however nothing in the evidence suggests that the Respondent is a competitor of the Complainant and for that reason the allegation of bad faith based on paragraph 4(b)(iii) fails. The Panel would be entitled to dismiss the Complaint for that reason. However, given that the Complainant has particularized its claims of bad faith use and registration, the Panel considers it appropriate to deal with those claims independently.

The Complainant states that:

The Disputed Domain Name is not the only domain name the Respondent has cybersquatted. Annex 12 comprises copies of who-is searches for some of the domain names registered by the Respondent. This indicates a pattern of bad faith behaviour by the Respondent and indicates that the Respondent is a notorious cybersquatter.

The Panel cannot be certain that the Complaint did not carry a clerical error and that it was the Complainant's intention to cite paragraph 4(b)(ii) of the Policy rather than paragraph 4(b)(iii). The Panel gives the Complainant the benefit of that doubt but finds that on the evidence it cannot be said that the Respondent registered the domain name in order to prevent the Complainant from reflecting its trademark in a corresponding domain name. The Complainant owns literally hundreds of domain names which include its trademark, including relevantly <wal-martstores.com>.

Nevertheless, although the above allegation does not support an adverse finding under paragraph 4(b)(iii), it could nonetheless be evidence of bad faith registration.

Annex 12, added to the Complaint by way of amendment, is a collection of WHOIS data for ".us" domain names registered to the Respondent. That evidence shows the Respondent to have registered a number of generic domain names which include:

<teleshop.us>
 <teleshow.us>
 <telenews.us>

<sexylife.us>
<realprice.us>
<b2cfor.us>
<b2bfor.us>
<vip100.us>

The Panel could discern only two domain names which were of relevance to the Complainant's assertion, being:

<virgingroup.us>
<diamondvodka.us>

The Panel does not regard the evidence of Annex 12 as proof of the claim that the Respondent is a notorious cybersquatter, but it does find that it is indicative of bad faith behaviour when coupled with the Complainant's further allegation that given the enormity of the Complainant's reputation, it is inconceivable that the Respondent had no knowledge of the Complainant and its trademark in April 2008.

The Panel is in accord with that argument and, absent rights or legitimate interests, finds that the domain name was registered in bad faith.

The domain name is not in use however the Complainant goes on to argue bad faith 'use' of the domain name, stating that "passive use of a domain name amounts to use of the domain name in bad faith", in support of which it cites the case of Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003.

To be clear, the Telstra case does not stand for the bald proposition that so-called passive holding (rather than "passive use", which is a nonsense) of a domain name amounts to bad faith use. The finding of bad faith in that case rested on a number of pre-requisites which the panel there underscored as requiring analysis on a case-by-case basis. For present purposes, it is enough here that the Complainant's trademark is very well known, the Respondent lacks any rights in the name, the Respondent appears prone to registering domain names which include recognized third party trademarks, and no plausible scenario can be foreseen in which the Respondent might come to use the domain name in good faith.

The Panel finds that the Complainant has shown that the Respondent both registered and used the disputed domain name in bad faith. Accordingly, the Panel finds that the Complainant has satisfied the third and final limb of the Policy.

Status

www.wal-martstores.info Domain Name Transfer

Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name "wal-martstores.info" be transferred to the Complainant. For the sake of clarity, the Panel believes the correct transferee to be the Complainant as defined in this decision, Wal-Mart Stores, Inc., albeit that there is some ambiguity in the Complaint papers which seem to use incorrect annexure cover sheets.

Debrett G. Lyons
Sole Panelist

Date: February 19, 2009