



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400611
Complainant:	Alibaba Group Holding Limited
Respondent:	Joe Lee
Disputed Domain Name(s):	<阿里巴巴.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 Joe Lee, of Suite 115, 17008 90th Ave, Edmonton, Alberta, T5T 1L6, Canada.

The domain name at issue is 阿里巴巴.com, registered by the Respondent with Moniker Online Services LLC, of 1800 SW 1st Avenue, Suite 440, Portland, OR 97201, USA.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center”) on May 16, 2014. On May 19, 2014, the Center transmitted by email to Moniker Online Services LLC (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. 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 Centre’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with Paragraphs 2(s) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 29, 2014. In accordance with the Rules, paragraph 5(a), the due date for the Response was June 18, 2014. On 11 June 2014, the Respondent requested an extension of 7 days for him to submit his Response, which was denied by the Complainant. In accordance with Paragraph 5(d) of the Rules, the Center agreed to extend the time for the Respondent to submit the Response by 23 June 2014. The Respondent submitted the Response on 23 June 2014. The Complainant filed its Supplemental Submissions and Annexes on 10 July 2014.

The Center appointed Matthew Murphy as presiding panelist, and Scott M. Donahey and Neil Brown QC as the co-panelists in this matter on July 15, 2014. 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 Center to ensure compliance with Paragraph 7 of the Rules. In accordance with Paragraph 12 of the Rules, the Panel decided in its discretion to accept the Supplemental Submissions and issued an Order to this effect on 17 July 2014 – this Order allowed for the Respondent to file a response to the Supplemental Submissions on or before 24 July 2014. On 24 July 2014, the Respondent filed a Response to the Complainant’s Supplemental Submissions.

3. Factual background

For the Complaint

The Complainant, *Alibaba Group Holding Limited*, a company incorporated in the Cayman Islands, with its principle place of business in China, claims that it 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”). It claims that Alibaba Group has become a global leader in the field of e-commerce, since it was founded in Hangzhou, China in 1999. It claims that it operates two online business-to-business marketplaces under its “阿里巴巴” and “ALIBABA” brands, including a global trade marketplace (www.alibaba.com) for importers and exporters and a Chinese marketplace (www.alibaba.com.cn) for domestic trade in China, and also operates online retail and payment platforms and data-centric cloud computing services. For the year ended 31 December 2011 and the first quarter of 2012 ended 31 March 2012, Alibaba.com Limited reported a total revenue of about RMB6.41 billion and RMB1.59 billion. For the year ended 31 December 2013, and the 9 months ended 31 December 2013, Alibaba Group had a total revenue of over RMB34 billion and RMB40 billion, respectively. For the year ended 31 December 2013, Alibaba Group’s total gross merchandising volume was over RMB1.5 billion. Further, the Complainant has submitted in evidence an online article, “Standing Up To a Giant” published on 25 April 2005 referring to annual sales being at US\$68 million at that time (Page 23 of Annexure 4 to the Complaint). The Complainant also claims that it owns more than 490 trademark applications/registrations comprising of or incorporating “ALIBABA” and “阿里巴巴” (“Alibaba trademarks”), including registrations in the US, Canada, Hong Kong, mainland China, the EU, Macau, Singapore and Taiwan, and these marks have acquired distinctiveness through extensive use by the Complaint and its affiliates in commerce.

The Complainant has provided details of various registrations for its trademarks “ALIBABA” and “阿里巴巴” as well as a selection of the registration certificates for these marks - the Panel notes that in particular the following trademark registrations, as being relevant to this case:

- (i) for Canada: the “ALIBABA.COM” Trademark Registration No.TMA594225 registered on 6 November 2003, the “ALIBABA” Trademark Registration No.TMA773117 registered on 28 July 2010, and the “阿里巴巴云计算” Trademark Registration No.TMA867554 registered on 17 December 2013,
- (ii) for China: the “阿里巴巴” Trademark Registration No.1083646 registered on 21 August 1997 and was assigned to the Complainant on 24 September 2007, the “ALIBABA” Trademark Registration No.3068458 registered on 28 April 2003, the “阿里巴巴” Trademark Registration No.1658394 registered on 28 October 2001, the “阿里巴巴” Trademark Registration No.3068456 registered on 14 July 2004, the

- “ALIBABA/阿里巴巴 and design” Trademark Registration No.1744337 registered on 7 April 2002, the “ALIBABA/阿里巴巴 and design” Trademark Registration No.1774273 registered on 21 May 2002, the “ALIBABA/阿里巴巴 and design” Trademark Registration No.1764627 registered on 7 May 2002,
- (iii) for the USA: the “ALIBABA” Trademark Registration No.2579498 registered on 11 June 2002, the “ALIBABA” Trademark Registration No.2851634 registered on 8 June 2004, and the “阿里巴巴” Trademark Registration No.3921768 registered on 22 February 2011, and
 - (iv) for the European Union: the “ALIBABA.COM” Trademark Registration No.001332899 registered on 26 October 2001 and the “阿里巴巴” Trademark Registration No.002246627 registered on 28 October 2002.

Further, the Panel also notes that “ALIBABA” is the business name of the Complainant – “阿里巴巴” is the according Chinese translation of “ALIBABA”.

The Complainant has provided evidence to show that the Complainant has advertised and promoted its “阿里巴巴” and “ALIBABA” brands extensively across the world including in China and Canada since 1999, and the “阿里巴巴” and “ALIBABA” trademarks have appeared on its various sites since 1999.

For the Respondent

The Respondent, Joe Lee, claims that he is a Canadian citizen and has been living in Canada for more than 29 years, and he had a plan in the year of 2000, to build a website to provide information about ancient China. He claims that in 2005 when the multilingual domain names became available for registration and use, he restarted his plans and successfully registered sets of Chinese character domain names, including “阿里巴巴.com”. He claims that the registration of various domain names in 2005 and 2006 were merely for personal reasons and hobby activities, and the order that various domain names were registered by him, shows that the Respondent was not targeted by the Complainant. When he registered “阿里巴巴.com”, he claims that he had in mind, to build a website for children focused on a popular fictional figure known as Ali Baba, as per the fairytale, “Ali Baba and the Forty Thieves”.

The Respondent also claims that he registered this domain name in good faith without knowing the existence of the Complainant and/or its “阿里巴巴” trademark rights, because the Complaint was based in China and did not hold a Canadian trademark registration in Canada where the Respondent was living. In May 2009, the Respondent started working on the Ali Baba website and then hooked it up with the disputed domain name. The whole story of “Ali Baba and the Forty Thieves” was put on the website together with a picture of the fictional character Ali Baba, and no links appeared on the web pages to direct visitors. Prior to setting up the Ali Baba website and after the registration of the disputed domain name, the domain name was lent to an American company for the provision of web directing services. The Respondent claims that the purpose of working with directing services was to take advantage of the functions provided on the platform to set criteria for visitors and to test the performance of newly introduced multilingual domain names, and the American company’s IP addresses were blocked in China so no one in China was able to access the site.

The Respondent claims that the Canadian Trademark “阿里巴巴云计算” (Alibaba Cloud Computing) that the Complainant presented was registered in 2013, 8 years after the

Respondent's registration of the disputed domain name, and “阿里巴巴云计算” is not the same as “阿里巴巴” anyway. Further, the “阿里巴巴” under Trademark Registration No.1083646, and the other 2 trademarks – Registration No.1072264 and No.1078919, were all registered by their original owners in 1997 and transferred to the Complainant in 2007, two years after the Respondent registered the disputed domain name, so prior to the registration of the disputed domain name the Complainant did not own any valid “阿里巴巴” trademark registrations in China where the Complainant was conducting its business.

4. Parties' Contentions

Complainant

The Complainant asserts that the disputed domain name is identical and/or confusingly similar to trade or service marks in which the Complainant has rights, since the Complainant has registered numerous Alibaba Trademarks around the world, and the disputed domain name incorporates its “阿里巴巴” trademark in its entirety.

The Complainant also asserts that the Respondent has no right or legitimate interests in respect of the disputed domain name, as the Alibaba trademarks have acquired distinctiveness through their extensive use and these marks are immediately recognizable to consumers as being associated with the Complainant, and given the fame of the Alibaba trademarks, coupled with the fact that the Complaint has not licensed, consented to or otherwise authorized the Respondent's use of the Alibaba trademarks, has the practical effect of shifting to the Respondent the burden of proof in establishing that it has right and/or legitimate interests in the disputed domain name. The Complainant contends that there is no evidence to suggest that the Respondent has been commonly known by the disputed domain name, and the disputed domain name does not currently resolve to an active website.

The Complainant also asserts that the domain name has been registered and used in bad faith, based on the following: the disputed domain name does not reflect or correspond to the Respondent's own name; the Respondent's registration and use of the disputed domain name must involve mala fides where the registration and use of it was and continues to be made in the full knowledge of the Complainant's prior rights in the Alibaba trademarks; the disputed domain name is currently not in use as at the date of filing of this Complaint; inaction can amount to use of the disputed domain name in bad faith; the disputed domain name was registered to mislead and confuse Internet users into believing that the disputed domain name is associated with the Complainant and its Alibaba Trademarks, in order to increase the number of Internet users that access any previous and future websites linked to the disputed domain name, for commercial gain; the disputed domain name is likely to mislead users into believing that the disputed domain name and any future website that it resolves to, is the website for the Complainant's operations in China; and notes that the Complainant experiences a high incidence of infringers registering domain names that are confusingly similar to its Alibaba trademarks and other trademarks.

Respondent

The Respondent asserts that not the domain name is not confusingly similar to a trademark or service mark in which the Complainant has rights, since the Chinese term “阿里巴巴” is the transliteration of Ali Baba, a popular fictional figure from the ancient Arabian folk tale and the Complainant does not enjoy a monopoly over the term “阿里巴巴”.

The Respondent also asserts that he has legitimate interests in respect of the disputed domain name, since it registered the domain name in conjunction with several historic figure domain names and used them for information related to history or religion and he has an inherent legitimate interest in it as a result of its descriptiveness.

The Respondent finally asserts that no bad faith registration and use has occurred, since the Respondent is using the disputed domain name for a children's website about Ali Baba without causing confusion and not a single link has been placed on the website to direct visitors since 13 May 2009 when the Ali Baba website was created. No confusion can be caused and no visitors could possibly associate the Ali Baba website with the Complainant.

5. Findings

Under Paragraph 4 (a) of the Policy, the Panel should be satisfied that:

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

Identical / Confusingly Similar

The Panel finds that the Complainant has established that it is the owner of the trademarks comprising "ALIBABA" and "阿里巴巴". The validity and fame of these trademarks are beyond dispute in China, and possibly Canada. In accordance with Paragraph 1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition, if a complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights. The Respondent may be right in his criticism of some of the claims made by the Complainant regarding the history of ownership of some of its trademark registrations and the Complainant should have been more careful about the language it used in describing its trademarks, but there is no doubt that the Complainant owned at least one trademark registration for "ALIBABA" and "阿里巴巴" prior to the date that the Respondent registered the domain name, being 3 June 2005. The domain name registered by the Respondent includes the Complainant's trademarks, with the simple addition of the domain extension ".com". The Respondent has provided evidence designed to refute this claim and has attempted to prove that "阿里巴巴" had a generic meaning when he registered the disputed domain name in 2005. However, given the strength of the Complainant's reputation in its trademarks as proven by the evidence filed by the Complainant, the panel finds there is little use that could be made of the disputed domain name that would not give rise to consumer confusion (See *Alibaba Group Holding Limited v. Steve Johnson*, WIPO Case No.DCO2013-0018). Even if the Respondent's website located at 阿里巴巴.com is different from the Complainant's website in terms of its appearance and content, Internet users may easily understand the domain name to refer to the Complainant's operations, since the domain name includes the Complainant's trademarks and the trademarks themselves, have become distinctive trademarks that are highly attributable to the Complainant, with the

Complainant being a well-known global company. Accordingly, the Panel finds that the domain name is confusingly similar to the trademark “阿里巴巴” owned by the Complainant.

Rights and Legitimate Interests

Given the fame of the Alibaba trademarks in China and around the world as of 2005 at the latest and given that the Respondent took and incorporated the Complainant’s trademark in its domain name, the Panel agrees that a *prima facie* case has been made out that the Respondent has no rights or legitimate interests in the domain name. The burden of proof then shifts to the Respondent to establish that it has such rights and/or legitimate interests. The Panel has taken the view that the Respondent has failed to establish that he had any rights or legitimate interests in respect of the domain name, or that there was any association between the trademark “阿里巴巴” and his activities, before registering of the domain name.

The basis of the Respondent’s case that he has a right or legitimate interest in the domain name is that he has a right to build his domain name on the fictional story of “Ali Baba and the Forty Thieves” and that this was the reason why he included the word “alibaba” in the domain name. The obligation on the Respondent is to persuade the Panel that he registered the domain name for that purpose and that, if he did, it gave rise to a right or legitimate interest. The Panel has not been persuaded on the first of those criteria and the second criteria, therefore does not need to be addressed. The plain facts are that the Respondent has adduced no evidence to show that this was his real intention, has done little if anything to use the domain name to promote the fictional character Ali Baba, did what little he did for a short period of time and allowed the domain name to be used at other times for purposes that had nothing to do with Ali Baba the fictional character. Moreover, it must be remembered that the domain name itself incorporated the Complainant’s trademark in its entirety with nothing in the domain name to indicate that it would resolve to the Respondent’s website rather than to Complainant’s website. It should also be remembered that another aspect of the Respondent’s defence is that he had not heard of the Complainant in 2005 when he registered the domain name, which the Panel does not accept. By using the Complainant’s trademark, the Respondent has been diverting Internet traffic to its own site, thereby potentially depriving the Complainant of visits by Internet users looking for the Complainant’s business based on the fame of its trademarks. Further, there is evidence to show that the Respondent has acted in bad faith in registering the domain name, which goes to indicate that he does not have any rights or legitimate interests in the domain name. Accordingly, the Panel has not been persuaded by the Respondent’s case and finds that the Respondent has not rebutted the *prima facie* case against it and has no rights or legitimate interests in respect of the domain name.

Bad Faith

The Respondent claims that he is entitled to register the disputed domain name as it consists of the name of the fictional Ali Baba character and that he did not know of the Complainant at that time. The Panel finds that this is so unlikely as to conclude on the balance of probabilities that it was not the case. That is so for the following reasons. First, the trademark “阿里巴巴” was well-known enough known in 2005 that it is presumable that the Respondent knew about its existence when registering the domain name (see *Banca Sella S.p.A. v. Mr. Paolo Parente*, [WIPO Case No. D2000-1157](#); *Expedia, Inc. v. European Travel Network*, [WIPO Case No. D2000-0137](#)). The Panel finds that it is highly probable that the Respondent would have known about the Alibaba Group and its “阿里巴巴” trademark on or before 3 June 2005 when he registered the domain

name, given evidence as to sales figures around this time, memberships claimed by Complainant, the commercial prominence of the Complainant by 2005 and other evidence it submitted.

Secondly, that view is re-inforced by the history of the Complainant set out in 2.12 of the *Supplemental Submissions filed by the Complainant*, where it is said: “As stated in the dissenting decision of *Alibaba Group Holding Limited v. Digital Domains Mepe*, ADNDRC Case No. HK-1100361 (attached at Exhibit K of the Response): ‘... What do we know about the Alibaba group of companies? By no later than 2002, alibab.com was the leading B2B website in China. In 2003, Alibaba launched Taobao (see e.g., Total Telecom Internet posting of July 11, 2003, entitled, ‘china’s Alibaba Opens Doors to Online Auctions’), an auction website that proved so successful in china that eBay, which had invested massive amounts of money in acquisitions and promotion of its Chinese auction portal, abandoned the Chinese market entirely before the end of 2004. This competition prompted reports in Reuters and USA Today on April 13, 2004, entitled, ‘eBay to go Head to Head with Alibaba in Chinese Auction Market’. Throughout 2004, Alibaba was participating in electronic trade shows around the world, and in ealy 2004, Alibaba raise some US\$87 million from such sophisticated investors as Softbank, Granite Global Ventures, and TDF. This unprecedented raising of funds from foreign investors by a Chinese company was widely reported, including by Reuters and the New York Times in an article dated February 18, 2004, entitled ‘World Business Briefing: Asia: China: Web Auctioneer Raises Cash.’ Alestron reported on January 15, 2004, that ‘Alibaba, the leading B2B marketplace for global trade and provider of online marketing services, would invest US\$37 million in a software development center...’ In 2004, Alibaba launched Alipay, an Internet payment vehicle which competed directly with eBay’s PayPal service. On November 15, 2004, Fortune magazine and CNN Money reported in an article entitled ‘An Upstart Takes on Mighty eBay.’...”

That history and all of the evidence leads the panel to the conclusion that it is inconceivable that the Respondent was unaware of the Complainant or its trademarks when he registered the disputed domain name.

The Panel concludes that the domain name has been registered in bad faith.

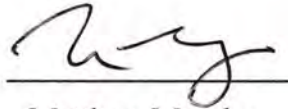
As far as use of the domain name in bad faith is concerned, the Panel concludes that the Respondent’s holding of the domain name in this particular case satisfies the requirement of Paragraph 4(a)(iii) of the Policy in that the domain name was “being used in bad faith” by the Respondent by merely holding it and not using it from 2005 to 2009 (see *Telstra Corporation Limited v Nuclear Marshmellows*, WIPO Case No. D2000-0003; *Espirito Santo Financial Group S.A. v. Peter Colman*, WIPO Case No. D2001-1214) - the Complainant’s trademarks have a strong reputation and are widely known, as evidenced by its substantial use and registration in various countries throughout the world, and the evidence filed by Respondent could not prove any actual or contemplated good faith use by it of the domain name from 2005 until 2009, which is an unreasonably long period of time for considering use of the domain name.

The Respondent put forward evidence designed to show active use of the disputed domain name to provide information and stories about Ali Baba since May 2009, four years after it was registered. The Respondent seems to have been very half-hearted about this use though, as the site seemed to lack substance and appears not to have ever been a website with any significant functionality nor promotion.

On the basis of the evidence submitted by the parties and based on the balance of probabilities the Panel concludes that the domain name has been used in bad faith.

6. Decision

Pursuant to Paragraph 4(a) of the Policy and Article 15 of the Rules, this Panel orders that the domain name < 阿里巴巴.com > be transferred to the Complainant.



Matthew Murphy
Scott M. Donahey
Neil Brown QC

Panelists

Dated: 30 July 2014