nominet®

DISPUTE RESOLUTION SERVICE

D00015407

Decision of Independent Expert

Alibaba Group Holding Limited

and

John

1. The Parties:

Complainant:	Alibaba Group Holding Limited
Address:	Fourth Floor, One Capital Place P.O. Box 847 George Town Grand Cayman British West Indies
Country:	Cayman Islands

Respondent:	John
Address:	111 Baiyun Road Guangzhou Guangdong 510010
Country:	China

2. The Domain Name(s):

tmall.co.uk ("Domain Name")

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

27 January 2015	Dispute received
27 January 2015	Complaint validated and notification of complaint sent to parties

28 January 2015	Response received and notification of response sent to parties
2 February 2015	Reply reminder sent
5 February 2015	No Reply received
5 February 2015	Mediator appointed
10 February 2015	Mediation started
16 February 2015	Mediation failed
16 February 2015	Close of mediation documents sent
18 February 2015	Expert decision payment received

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the "Policy") and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the "Procedure") unless the context or use indicates otherwise.

4. Factual Background

The Complainant is an e-commerce firm, founded in Hangzhou, China in 1999. The Complainant, through its affiliates and subsidiaries, has offices in around 70 cities across China, as well as in Hong Kong, Taiwan, Korea, India, Japan, Singapore, USA and Europe.

In May 2003 the Complainant founded a Chinese language consumer-to-consumer Internet retail platform under the brand "Taobao" at www.taobao.com (the "Taobao Marketplace"). The Taobao Marketplace is one of China's largest online retail platforms. In 2008, the Complainant introduced "Taobao Mall", a business-to-consumer ("B2C") platform accessible from its Taobao Marketplace presenting listings from brand owners or authorised distributors.

In November 2010, the Complainant rebranded Taobao Mall as "Tmall", with a website at www.tmall.com (the "Tmall.com Marketplace"). Tmall.com Marketplace features multi-national and Chinese brands through merchants' retail storefronts.

Tmall.com Marketplace and Taobao Marketplace set a record for the highest single-day transaction volume during a special promotion on 11 November 2013, facilitating the sales of goods totalling RMB 35 billion (US$ 5.78 billion) on the day.

The Complainant listed on the New York Stock Exchange on 19 September 2014.

The Respondent registered the Domain Name on 21 October 2010.

5. Parties' Contentions

The Complaint

Complainant's Rights

The Complainant asserts that it has extensive registered rights in the name Tmall and has exhibited 12 trade mark registrations relating to this name, and to "www.tmall.com", from a number of jurisdictions including the European Union, Norway, Switzerland, the United States of America, China and Hong Kong. The earliest exhibited registered mark is a Hong Kong trade mark for Tmall, TMALL, tmall and TMall (registration number 301756198) registered on 25 July 2011. The most recent exhibited is a Chinese trade mark for TMALL (registration number 8820991) registered on 14 March 2014.

The Complainant asserts that it has extensive rights in the name Taobao, arising from use since its launch in 2003, and in the name Taoboa Marketplace, which the Complainant has operated as its C2C platform over the last 10 years. The Complainant further assert rights in the name Taobao Mall, its B2C platform, arising from extensive use since its introduction in 2008 and from its trade mark registrations for Taobao Mall, the earliest exhibited registration being in China (registration number 6797102) registered on 28 April 2010.

The Complainant contends that Taobao Marketplace has grown to become one of China's largest online retail platforms. It had over 760 million product listings on its websites in March 2013, it receives more than 50 million unique visitors daily and is one of the world's top 20 most visited websites.

Two exhibited articles, one dated 1 November 2010 and a Wall Street Journal article dated 2 November 2010, cover the rebrand of Taobao Mall and the launch of Tmall and refer to a $30 million advertising campaign to attract more users to Tmall.com. The Complainant asserts that Tmall is an abbreviation of Taobao Mall.

The Complainant says that its Tmall .com Marketplace has more than 400 million registered users and features more than 70,000 multi-national and Chinese brands from over 50,000 merchants including: Consumer Electronics mall; Book mall; Home Furnishing mall; Designer Footwear mall; and Beauty mall. Brands with retail storefronts on Tmall.com Marketplace include UNIQLO, L'Oreal, adidas, P&G, Unilever, Gap, Ray-Ban, Nike and Levis.

For the year ended 31 March 2012 and the 9 months ended 31 December 2012, the Complainant reported a total revenue of about RMB20 billion and RMB25 billion, respectively. For the year ended 31 March 2013, and the 9 months ended 31 December 2013, the Complainant had a total revenue of over RMB 34 billion and RMB 40 billion, respectively. For the year ended 31 December 2013, the Complainant's total gross merchandising volume was over RMB 1.5 billion and it had over 230 million active buyers. For the year ending on 31 March 2013, the combined gross merchandise volume of Tmall.com Marketplace and Taobao Marketplace exceeded RMB 1 trillion. According to an Alexa market survey the Complainant's B2C online retail websites are the most visited in China.

The Complainant has provided a list of around 150 articles and a similar number of press releases from 2000 to 2014, with hard copies of around 50 of these. The articles may not verify exactly the Complainant's assertions in relation to the number of product listings, daily visitors, revenue and so on, but nevertheless they do indicate the scale and extent of the success of the Taobao Marketplace, Taoboa Mall and Tmall.com Marketplace to be consistent with the Complainant's assertions.

The Complainant has exhibited print outs from search engines which it says indicates that the vast majority of searches for Tmall relate to the Complainant and its affiliates.

Finally, the Complainant asserts that the Domain Name is identical and/or similar to its registered trade marks in the name Tmall which is incorporated in its entirety in the Domain Name (disregarding the first and second level suffixes in accordance with established principles under the Nominet DRS).

Abusive Registration

The Complainant asserts that its Taboao and Tmall trade marks have acquired distinctiveness through their extensive use by the Complainant and its affiliated companies, so that they are immediately recognisable to consumers as being associated with the Complainant, its affiliates, and their business. The Complainant has not licensed, consented to or otherwise authorised the Respondent to use its Tmall trade mark nor is the Respondent an authorised representative or partner of the Complainant.

The Complainant says that its Tmall mark is a coined term that has no meaning in English or any other language other than in relation to the Complainant.

The Complainant contends that since Tmall is a coined term and the Respondent is based in China, where the Complainant's trade marks are particularly well known, and the Domain Name resolves to a webpage that is in the Chinese language, it is inconceivable that the Respondent was not aware of the Complainant's Taobao and Tmall trade marks at the time he registered the Domain Name.

The Complainant contends further that it cannot be mere coincidence that the Respondent registered the Domain Name 11 days before the Complainant officially announced the launch of the Tmall.com Marketplace on 1 November 2010. Therefore, the Respondent's registration of the Domain Name cannot conceivably be for any reason other than to take unfair advantage of the Complainant's reputation in the Taoboa and Tmall trade marks in order to make a commercial gain, and/or to block any registration by the Complainant or to unfairly disrupt the Complainant's business.

The Complainant says that it experiences a high incidence of infringers registering domain names that are confusingly similar to its Taobao and Tmall trade marks and finds that infringers often keep a very close eye on the Complainant's business (by monitoring trade mark applications, press mentions and domain name registrations) to try and anticipate new ventures and to register domain names which incorporate the Complainant's brands.

The Complainant says that the Respondent's name does not correspond with the Domain Name and, to the best of its knowledge and information (including a search carried out on the TMView database in the Respondent's name and for the name Tmall) the Respondent does not own any trade mark registrations reflecting or corresponding to the Domain Name in the UK or the European Union. The Complainant says that it is logical to presume that the UK or the European Union would be the first places in which the Respondent would seek to register a trade mark, since the Domain Name involves a <.uk> country code top level domain. Accordingly, the Complainant asserts that there is no evidence that the Respondent has been commonly known by or is legitimately connected with the Tmall name and there is no apparent need for the Respondent to use the name Tmall for the Domain Name.

The Complainant has presented extracts from the Internet Wayback Machine which show that on 30 April, 2 May, 15 May and 25 July 2013, the Domain Name resolved to an ecommerce website providing an "English, Russian, Spanish, Germany, French, Portuguese...Online Shopping Mall". This website included sections labelled as "My Account", "My Wishlist", My Cart", "Checkout, "Login" and a "Returns" section and it allowed payments to be made by PayPal. The Complainant contends that this website directly competed against its Tmall.com Marketplace and therefore took unfair advantage of the Complainant's goodwill in the Tmall trade mark and cannot constitute a genuine offering of goods or services.

The Complainant presented further extracts from the Internet Wayback Machine to show that on 16 May and 18 December 2014, the Domain Name resolved to a webpage in Chinese which stated that LNMP has been successfully installed and provides links and brief information regarding LNMP. The Complainant says that it is reasonable to assume that the Respondent earned pay-per-click revenue whenever a user clicked on a link on this webpage.

Finally, the Complainant asserts initial interest confusion but does not offer any evidence in support of this contention. The Complainant says that it is irrelevant that users may realise after they land on the Respondent's webpage that it is not the Complainant's Tmall.com Marketplace; what matters for the purposes of §3(a)(ii) of the Policy is the initial confusion. The Complainant refers to the expert's statement in respect of initial interest confusion in Maplin Electronics Limited v. Colours Limited (DRS 09824) in which the expert says that even if users appreciate that they have not found the complainant when they reach the respondent's website, the respondent has still used the domain name in a way to cause initial interest confusion that the domain name is registered to, operated or authorised by or otherwise connected with the complainant.

The Complaint also relies on §3.3 of the Expert's Overview to support its contention of initial interest confusion:

> *"If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose. In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived…Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)."*

The Response

The Respondent contends that the registration and/or use of the Domain Name is not an Abusive Registration on the basis that it did not know that the Complainant had any rights in the name Tmall. The Respondent asserts that it was working with the Domain Name as an international business introduction website until recent maintenance. Further, the Respondent's webpage is totally different than the Complainant's www.tmall.com.

The Respondent appears to deny that it that it sells products and/or earns money by the Domain Name and says that the Complainant hasn't provided any evidence of such activity and how much it earns.

The Respondent says that it registered the Domain Name on 21 October 2010 more than a year before the Complainant's European Union trade mark in the name Tmall, registered on 22 December 2011 (I note that the Complaint refers to this date but the trade mark was in fact registered on 21 December 2013). The Respondent contends that the other trade marks cited by the Complainant do not establish any rights in the UK or do not have any relationship with the name Tmall.

The Reply

The Complainant did not reply to the Response.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

1. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

2. *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainant's Rights

Rights is defined in §1 of the Policy as *"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"*.

The wholly generic suffix ".co.uk" is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Respondent contends that only the Complainant's European trade mark is valid and that the Complainant's other trade marks registered outside of the UK and the European Community do not establish any rights in the UK. This is not correct; §1.5 of the Expert's Overview states:

> *"1.5 Can an overseas right constitute a relevant right within the definition of Rights?*
>
> *Yes. The rights must be enforceable rights, but there is no geographical/jurisdictional restriction. If the Upper Volta Gas Board can demonstrate rights in respect of its name enforceable in Upper Volta, the Policy is broad enough to deal with a cybersqautter, for example, registering <upervolatgasboard.co.uk>. If it were otherwise, the '.uk' domain would be likely to become a haven for cybersquatters."*

The Complainant has set out details of a number of trade marks in the name Tmall, the earliest being one of its Hong Kong trade marks registered on 5 November 2010, as well as evidence of extensive trading in relation to the name Tmall from around the same time to the present day. I note, however, that the Respondent registered the Domain Name before the Complainant has evidenced rights in the name Tmall.

Notwithstanding the earlier registration of the Domain Name, I am satisfied on the papers before me that the Complainant has registered rights in the name Tmall arising from trade mark registrations in several countries and that by March 2013 the name Tmall had acquired distinctiveness in relation to e-commerce. The name Tmall is not wholly descriptive of the Complainant's business.

I find for the purposes of the first limb of the test in §2 of the Policy that the Complainant has Rights in the name Tmall which is identical to the Domain Name.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*

2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3a of the Policy:

i. *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

   A. *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in*

excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

iv. It is independently verified that the Respondent has given false contact details to us; or

v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

A. has been using the Domain Name registration exclusively; and

B. paid for the registration and/or renewal of the Domain Name registration.

The Complainant alleges Abusive Registration under §3ai and §3aii of the Policy. The factors listed at §3aiii, §3aiv and §3av are not relevant to the Complaint.

§3ai of the Policy concerns the Respondent's motives at the time of registration of the Domain Name. The Respondent registered the Domain Name before the earliest date that the Complainant evidenced Rights in the name Tmall. The Complainant says that the Respondent must have known of the Complainant's Rights since Tmall is a coined term, the Respondent is based in China, where the Complainant's trade marks are particularly well known, and the Domain Name resolves to a webpage that is in the Chinese language. Therefore, the Complainant argues, it is inconceivable that the Respondent was not aware of the Complainant's Taobao and Tmall trade marks at the time he registered the Domain Name.

I agree with the Complainant in respect of the name Taobao but the Complainant has not demonstrated Rights in respect of the Tmall name at the time of the Respondent's registration of the Domain Name. There is no mention of the Tmall in the press articles exhibited by the Complainant until 1 November 2010, but even if the Respondent had prior knowledge of the Complainant's plans prior to this date, the Complainant presents no evidence of Rights in the name Tmall at this time.

I accept the Complainant's assertion that Tmall is a coined term and that it is a logical contraction of Taoboa Mall. The development of the eBay brand from its beginnings at ebay.com (ebay being short for echo bay) is an example of this form of popular contraction. I also consider that it is plausible that the Respondent registered the Domain Name on the basis that Tmall is an obvious contraction of Taobao Mall, and I accept that if he did so it would have been with knowledge of the Complainant's Rights in respect of its Taoboa mark. However, I find that there is insufficient evidence in the papers before me that the registration of the Domain Name in any way took unfair advantage of or was unfairly detrimental to the Complainant's Rights in the name Taoboa.

The Complainant says that, in contravention of §3aii of the Policy, the Respondent has used the Domain Name in a way which has confused or is likely to confuse people or businesses into

believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Complainant exhibits several print outs from the Internet Wayback Machine showing that the Domain Name resolved to an e-commerce website providing an online shopping mall from April to July 2013. From the Complainant's evidence, I am satisfied that the website was under construction during this period and was not operational (a lack of substantive content and repeated Latin phrases in sections of the webpage are examples of the website being under construction). There are no Wayback Machine records for the Domain Name, and no evidence presented of the Respondent's use of the Domain Name, prior to 30 April 2013.

I do not consider it likely that the Respondent commenced development around the time it registered the Domain Name given: the lack of Wayback Machine records for the 2 and a half years between registration and the first record of the website on 30 April 2013; the lack of substantive content at 30 April 2013; and the website remaining unchanged until sometime between July 2013 and 16 May 2014 when the Domain Name resolved to a webpage in Chinese which states that LNMP has been successfully installed. The Wayback Machine shows that at the end of 2014, shortly before the date of the Complaint, the Domain Name still resolved to the same LNMP website. I note that when I attempted to access the Domain Name I found that it is no longer accessible.

The Complainant says that it is reasonable to assume that the Respondent earned pay-per-click revenue whenever a user clicks on a link on the Respondent's webpage post 16 May 2014. I accept that this is a reasonable presumption given that this website had links to other websites which had links to further websites. The Respondent appears to deny that it sells products and/or earns money but offers no evidence to rebut the Complainant's assumption.

§4a of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration, including at §4a i A:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

The Respondent has not rebutted the Complaint by presenting evidence that since it registered the Domain Name, and before becoming aware of the Complainant's cause for complaint, it had made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services. Given the opportunity to do so in the Response, the Respondent has simply said that it was working with the Domain Name as an international business introduction website until recent maintenance. The Complainant has shown, however, that the webpage on 30 April 2013 indicated the preparation of an offering to sell goods (references to "Online Shopping Mall", "Shopping Cart" and a PayPal link for example) not an international business introduction website.

I am satisfied on the papers before me that, on the balance of probabilities, the Respondent changed the use (or lack of use) of the Domain Name to develop an e-commerce website at some time prior to April 2013. Given the rapid development of distinctiveness of the Complainant's Tmall name from the rebrand of Taobao Mall in November 2010 through to March 2013, as evidenced by sales volumes and independent news articles , I find it likely that the Respondent knew of the Complainant's Rights and success of the Tmall.com Marketplace, and elected to develop the Domain Name to take advantage of this.

Under §4a i B of the Policy, a factor which may be evidence that the Domain Name is not an Abusive Registration is if the Respondent has been commonly known by the name Tmall or

legitimately connected with a mark which is identical or similar to the Domain Name. The Complainant says that the Respondent is not known or associated with the name Tmall and the Respondent does not deny this. The Respondent has not offered any explanation as to why a Chinese based business has registered a UK domain name, and neither party has presented evidence of any Tmall domain names registered by the Respondent in China. Furthermore, the Complainant says that the Respondent is not an authorised representative or its partner.

There has been a number of DRS cases where a respondent's registration of a domain name pre-dates the coming into existence of the complainant's Rights. §4.7 of the Expert's Overview considers whether a respondent can make fair use of a domain name where it is a complainant's trade mark and the respondent's use is causing confusion. While, ordinarily, a confusing use of such a domain name will be regarded as unfair, it may not be regarded as unfair where, for example, the respondent's registration and use of the domain name pre-dates the complainant's rights, the respondent has not changed his use of the domain name to take advantage of the complainant's rights and the respondent's behaviour has been unobjectionable. The principles derived from decisions involving domain name registrations pre-dating the complainant's rights (DRS 02223 (itunes.co.uk), the decision and Appeal decision in DRS 04962 (myspace.co.uk), the decision and Appeal decision in DRS 05856 (t-home.co.uk) and the decision and Appeal decision in DRS 06365 (oasis.co.uk) each of which differed on their facts) are as follows:

1. *Where the domain name registration pre-dates the coming into existence of the Complainant's rights, the act of registration is unlikely to lead to a finding of Abusive Registration…….*

2. *Ordinarily, provided that the Respondent has done nothing new following the coming into existence of the Complainant's rights to take advantage of those rights, the Respondent's use of the domain name is unlikely to lead to a finding of Abusive Registration.*

3. *However, where the domain name is connected to a parking page operated on behalf of the Respondent by a third party (eg a hosting company), the Respondent is unlikely to be able to escape responsibility for the behaviour of that third party.*

On the evidence presented by the Complainant, the Respondent's registration of the Domain Name pre-dates the coming into existence of the Complainant's Rights in the name Tmall. However, the Respondent has, on the balance of probabilities, done something new since the coming into existence of the Complainant's Rights by commencing preparations for the Domain Name to be used as an e-commerce website in competition with the Complainant's Tmall.com Marketplace. The Respondent has failed to present any evidence to rebut the Complaint or to explain its preparations for a legitimate use of the Domain Name before the coming into existence of the Complainant's Rights.

Finally, I accept the Complainant's assertion that a user looking for the Complainant's Tmall may have entered the Domain Name into a browser, or clicked on a link to the Domain Name, and in doing so there would have been initial interest confusion.

Accordingly, I find that the Respondent's use of the Domain Name has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, and the Respondent's use of the Domain Name has caused initial interest confusion, which is an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an

Abusive Registration, I direct that the Domain Name (tmall.co.uk) be transferred to the Complainant.

Signed **Steve Ormand** **Dated: 23 March 2015**