

DISPUTE RESOLUTION SERVICE

D00015419

Decision of Independent Expert

Alibaba Group Holding Limited

and

Minling Zhang

1. The Parties:

Complainant:

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

Respondent:

Minling Zhang
Zhangjiabang Road 3-3-2
Guiling
Guangxi
511102
China

2. The Domain Name(s):

aliexpress.co.uk

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 might be of a 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
27 January 2015 Notification of complaint sent to parties
13 February 2015 Response reminder sent
18 February 2015 No Response Received
18 February 2015 Notification of no response sent to parties
24 February 2015 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 23 December 2013.

Based on the Complainant's submissions (see section 5 below) and a review of the materials annexed to the Complaint, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant has operated the AliExpress online marketplace since 2010. This is a global retail marketplace and in 2013 generated merchandise volumes of \$2 billion.
- b. The AliExpress marketplace has obtained significant press coverage.
- c. The Complainant has expended substantial sums of money on advertising and promoting the AliExpress marketplace.
- d. The Complainant and the AliExpress marketplace are particularly well-known in China.
- e. The Complainant owns numerous trade mark registrations for the ALIEXPRESS mark, including registrations covering the European Union and China.
- f. The Complainant has not authorised the Respondent to register or use the Domain Name.
- g. The Respondent is based in China.
- h. The Domain Name automatically resolves to the Complainant's AliExpress marketplace.

5. Parties' Contentions

Complaint

The Complainant's submissions are set out below.

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

(1) The Complainant 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"). Alibaba Group was founded in Hangzhou, China, in 1999. Since then, Alibaba Group has grown to become a global leader in the field of e-commerce. On 19 September 2014, the Complainant officially listed on the New York Stock Exchange (NYSE:BABA). According to the South China Morning Post, "Alibaba set a record for the world's biggest initial public offering with its US\$ 25 billion listing in New York in September".

(2) Headquartered in Hangzhou, China, Alibaba Group, through its subsidiaries and affiliates, has offices in about seventy (70) cities across China, as well as in Hong Kong, Taiwan, Korea, India, Japan, Singapore, USA and Europe. For the year ended 31 March 2012 and the 9 months ended 31 December 2012, Alibaba Group 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, Alibaba Group had a total revenue of over RMB 34 billion and RMB 40 billion, respectively. For the year ended 31 December 2013, Alibaba Group's total gross merchandising volume was over RMB 1.5 billion and it had over 230 million active buyers across its platforms.

(3) Alibaba Group, through its affiliate, Alibaba.com Limited and its affiliates ("Alibaba.com"), operate two online business-to-business (B2B) marketplaces under the “阿里巴巴” and "ALIBABA" brand: a global trade marketplace (www.alibaba.com) for importers and exporters and a Chinese marketplace (www.alibaba.com.cn and www.1688.com) for domestic trade in China (together, the "Alibaba.com Websites"). Alibaba.com, through its affiliates, also offers business management software and Internet infrastructure services targeting small businesses across China and incubates e-commerce talent for Chinese small businesses. As of 31 December 2012, Alibaba.com had around 36.7 million registered users from more than 240 countries and regions and showcased more than 2.8 million supplier storefronts. In the same period, Alibaba.com's Chinese marketplace (www.alibaba.com.cn and www.1688.com) had around 77.7 million registered users as and showcased more than 8.5 million supplier storefronts.

(4) Following the success of the Alibaba.com Websites, and Alibaba's other businesses including its Taobao marketplace (a Chinese language consumer-to-consumer Internet retail platform), Alibaba.com, through its affiliates, launched the beta test version of the online marketplace www.aliexpress.com in September 2009, under the brand "ALIEXPRESS" ("AliExpress Marketplace"). The AliExpress Marketplace was officially launched in April 2010. The AliExpress Marketplace is a global retail marketplace targeted at consumers worldwide, which enables

consumers from around the world to buy directly from wholesalers and manufacturers in China. In the last four years, the business-to-consumer (B2C) platform has grown to become a primary online shopping destination for global customers seeking to purchase goods from China. AliExpress Marketplace generated US\$2.0 billion in gross merchandise volume in the twelve months ended 31 December 2013.

(5) The AliExpress Marketplace links to Alibaba Group's other online platforms, including the Alibaba.com Websites, the global and China-based business-to-business marketplaces for importers and exporters respectively; the Taobao marketplace (www.taobao.com and www.taobao.com.cn), one of China's most popular C2C online shopping destinations; Alipay platform (www.alipay.com), China's most widely used third-party payment solution; Alimama (www.alimama.com), one of China's leading online advertising platform; Alibaba Cloud Computing (www.aliyun.com), a developer of advanced data-centric cloud computing services; ALIEXPRESS.com (www.ALIEXPRESS.com), one of China's leading business-to-consumer (B2C) shopping destination for quality and brand-name goods; and Juhuasuan (www.juhuasuan.com), a comprehensive group shopping platform in China.

(6) The growth of Alibaba Group, and the success of the AliExpress Marketplace and the other services offered by the Alibaba Group, have garnered a significant amount of media attention and resulted in a high public profile for Alibaba Group and its brands globally. Annexed is a collection of articles about Alibaba Group, the AliExpress Marketplace and Alibaba Group's other businesses published before this Complaint. Among them are articles published in some of the world's most highly respected and well-read newspapers and magazines, including Reuters, The Wall Street Journal, and Business Week.

(7) Alibaba Group's services provided via the AliExpress Marketplace are and have always been carried on, supplied and marketed continuously and substantially under and/or by reference to its AliExpress Trade Marks registered in various jurisdictions around the world. Alibaba Group actively began using its AliExpress Trade Marks in 2010, and first applied to register the AliExpress Trade Marks in 2009. Since then, the AliExpress Trade Marks have acquired distinctiveness through their extensive use by the Complainant and its affiliates in commerce, so that they are immediately recognisable to consumers as being associated with the Complainant, its affiliates and their businesses. Annexed are print outs of the search results from major Internet search engines, Google, Baidu and Yahoo! indicating that the vast majority of search results returned for searches of "aliexpress" relate to the Complainant and its affiliates.

(8) Alibaba Group has been promoting the "ALIEXPRESS" brand and its services extensively since as early as 2010, via the Internet and through publicity and advertising in trade press and other print media and has expended significant time and effort in promoting its products and services available at the AliExpress Marketplace, including but not limited to, the "ALIEXPRESS" trade mark, worldwide. In addition, the Alibaba Group has been promoting its "ALIBABA" and "ALI" branded e-commerce services and products extensively since 1999 via the Internet, trade press, trade shows and other print media. Millions of dollars have been spent annually to promote its business and services and the "ALIBABA",

"ALIEXPRESS" and other "ALI" related trade marks (e.g. "ALIPAY", "ALIYUN" and "ALIMAMA"). For instance, Alibaba.com's affiliates launched a US\$30 million marketing campaign throughout 2008 and 2009 in key buyer markets such as the United States and Europe, as well as in emerging markets with meaningful buyer growth potential.

(9) As a result of the Complainant's significant investment and use, the AliExpress Trade Marks have become well-known to consumers / Internet users around the globe, including in the UK.

(10) Annexed is a spreadsheet of the Complainant's trade mark applications / registrations for marks comprising of or incorporating "ALIEXPRESS" on which the Complaint is based, including registrations in the European Union, Russian Federation, Australia, Hong Kong, mainland China and the United States of America. These trade mark applications / registrations shall collectively be referred to in this Complaint as the "AliExpress Trade Marks".

(11) The Complainant's AliExpress Trade Marks include the following:

- European Union (CTM) trade mark "ALIEXPRESS", registration number 8508566, classes 9, 35, 36, 38, 41 and 42, registered on 8 March 2010;
- European Union (CTM) trade mark "ALIEXPRESS logo", registration number 8783011, classes 9, 35, 36, 38, 41 and 42, registered on 17 January 2013;
- Russian Federation trade mark "ALIEXPRESS", registration number 431748, classes 9, 35, 36, 38, 41 and 42, registered on 5 March 2011;
- Russian Federation trade mark "ALIEXPRESS", registration number 433980, classes 9, 35, 36, 38, 41 and 42, registered on 29 March 2011;
- Australian trade mark "ALIEXPRESS", registration number 1314820, classes 9, 35, 36, 38, 41 and 42, registered on 11 August 2009;
- Australian trade mark "ALIEXPRESS logo", registration number 1339078, classes 9, 35, 36, 38, 41 and 42, registered on 31 December 2009;
- USA trade mark "ALIEXPRESS logo", registration number 4092736, classes 9, 35, 36, 38, 41 and 42, registered on 31 January 2012;
- Chinese trade mark "ALIEXPRESS", registration number 8032464, class 9, registered on 7 April 2011;
- Chinese trade mark "ALIEXPRESS", registration number 8032493, class 35, registered on 14 March 2011;
- Chinese trade mark "ALIEXPRESS", registration number 8032513, class 36, registered on 28 March 2011;
- Chinese trade mark "ALIEXPRESS", registration number 8032553, class 38, registered on 28 March 2011;
- Chinese trade mark "ALIEXPRESS", registration number 8032574, class 41, registered on 28 February 2011;
- Chinese trade mark "ALIEXPRESS logo", registration number 7558799, class 35, registered on 7 December 2010;
- Chinese trade mark "ALIEXPRESS logo", registration number 8017387, class 36, registered on 28 March 2011;
- Hong Kong trade mark "ALIEXPRESS", registration number 301402983AA, classes 9, 35, 38 and 42, registered on 10 August 2009;
- Hong Kong trade mark "ALIEXPRESS", registration number 301402983AB, classes 36 and 41, registered on 10 August 2009;

- Hong Kong trade mark "ALIEXPRESS logo", registration number 301508328, classes 9, 35, 36, 38, 41 and 42, registered on 24 December 2009.

(11) Copies of registration certificates/extracts from the official trademark database for the above listed trade mark registrations are annexed.

(12) Therefore, the Complainant has established that it has rights in the AliExpress Trade Marks in the European Union, Russia, Australia, the USA, China, Hong Kong and other parts of the world.

(13) The Domain Name incorporates the Complainant's "ALIEXPRESS" trade mark in its entirety. Further, it is well-established that in making an enquiry as to whether or not a trade mark is identical or confusingly similar to a domain name, the first and second level suffixes, in this case <.co.uk>, may be disregarded (see Alibaba Group Holding Limited v. EastStar Web Solution, DRS 13999 and Starbucks Corporation v. James Leadbitter, DRS 02087).

(14) The Complainant accordingly submits that it has proved that the Domain Name is identical and/or similar to the registered trade marks in which the Complainant has rights for the purposes of paragraph 2(a)(i) of the Policy.

The Domain Name, in the hands of the Respondent, is an abusive registration:

(1) Since their first use by the Complainant in 2008, the AliExpress Trade Marks have acquired distinctiveness through their extensive use in commerce by the Complainant and its affiliated companies, so that the AliExpress Trade Marks, including the "ALIEXPRESS" mark, are immediately recognisable to consumers as being associated with the Complainant, its affiliates, and their business.

(2) The Respondent registered the Domain Name on 23 December 2013, which is more than 3 years after the "ALIEXPRESS" trade mark was first actively used, adopted and registered by the Complainant. The Complainant has not licensed, consented to or otherwise authorised the Respondent's use of its AliExpress Trade Marks for any reason whatsoever, nor is the Respondent an authorised representative or partner of the Complainant.

(3) The Complainant's "ALIEXPRESS" mark is a coined term, and has no meaning in English or any other language other than in relation to the Complainant. In addition, the Respondent is based in China. The Complainant and its AliExpress Trade Marks are particularly well-known in China and amongst other Chinese speaking populations. In light of the worldwide fame of the AliExpress Trade Marks, and the fact that the word "aliexpress" has no common meaning in English or any other language independent of the Complainant's "ALIEXPRESS" trade marks, makes it inconceivable that the Respondent was not aware of the Complainant's AliExpress Trade Marks at the time he registered the Domain Name.

(4) In addition, the Respondent's name (Minling Zhang) in no way corresponds with the Domain Name, such that there is no apparent need for the Respondent to use "aliexpress" which, as mentioned above, has no common meaning outside of the Complainant's AliExpress Trade Marks. Further, to the best of the

Complainant's knowledge and information, the Respondent does not own any trade mark registrations reflecting or corresponding to the Domain Name in the UK or the European Union. A copy of a proprietorship search carried out on the TMView database in the name of the Respondent is annexed. 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. There is therefore no evidence that the Respondent has been commonly known by or is legitimately connected with the "ALIEXPRESS" mark.

(5) The Domain Name automatically resolves to the Complainant's AliExpress Marketplace (see annexure). The Respondent is therefore clearly aware of the Complainant, its businesses and its AliExpress Trade Marks. The Respondent has never been authorised to register or make such use of the Domain Name, and such use cannot amount to a legitimate interest or right in the Domain Name. No goods or services are actually bona fide offered by the Respondent for sale via the Domain Name, as the Domain Name resolves to the Complainant's AliExpress Marketplace, which is not owned, controlled or operated by the Respondent. It is also reasonable to infer that the Respondent earns pay-per-click or other related revenue whenever a user accesses the Domain Name. In such circumstances, the Complainant submits that the Domain Name was registered and is being used by the Respondent to mislead and confuse users into believing that the Domain Name is associated with the Complainant and its AliExpress Trade Marks, in order to increase the number of users that access the Domain Name, for commercial gain (i.e. to incur pay-per-click or related revenue).

(6) As was held in *Baum, Jutzi und Partner, Inc v. Netconsultancy*, DRS 01521, "the trade mark...and the name...are unique to the Complainant. No one else uses this name and it is not generic. There is no obvious connection between the Complainant and the Respondent and nothing to explain why the latter should have chosen to register the former's name as its domain name and then to link it to the Complainant's own website – something which, in the experience of the Expert, is highly unusual. It may have been in a desire to, eventually, sell the name to the Complainant; it may have been with a view to, at some later date, using the site to denigrate the Complainant; it may have been to benefit in some undisclosed way from the Complainant's reputation or goodwill... The key to this case is the sheer impossibility of there being any innocent explanation as to why the Respondent should have chosen to adopt the Complainant's name and trade mark other than to the detriment of the Complainant. In the circumstances, the Expert is unable to think of any good reason why the Respondent could reasonably be said to have any legitimate rights or interest in the disputed domain name." The Complainant relies on the same reasoning as the foregoing case in relation to the Respondent's use of the Domain Name

(7) In addition, paragraph 3a of the Policy is only intended to provide a non-exhaustive list of examples that may give rise to a finding of abusive registration, and other circumstances not expressly listed in paragraph 3a of the Policy may also constitute abusive registration. In this case, the Complainant also contends that the Respondent made an abusive registration as: (i) its AliExpress Trade Marks and AliExpress Marketplace are well-known, particularly in China where the Respondent is based; (ii) the Respondent's name is in no way connected to the

Domain Name; (iii) the Respondent has not been authorised by the Complainant to register and/or use the Domain Name, and the Respondent has no connection or relationship with the Complainant which could give rise to such authorisation; (iv) the Respondent must have been aware of the Complainant's AliExpress Trade Marks for the reasons stated above; and (v) even if the Respondent only intended to register and/or use the Domain Name to redirect users to the Complainant's AliExpress Marketplace, it did so without the Complainant's permission.

(8) It is inconceivable that the current or any future use of the Domain Name will result in anything but confusion amongst Internet users, who will wrongly believe that the Domain Name is owned, operated or affiliated with the Complainant. This is because the Domain Name is identical to the Complainant's well-known "ALIEXPRESS" trade mark, and use of the Domain Name will inevitably mislead users into believing that the Domain Name is associated with the Complainant and may divert users to the Domain Name, enabling the Respondent to make a commercial gain.

(9) In these circumstances of blatant misappropriation and use of the Complainant's "ALIEXPRESS" brand, there can be no possible grounds on which to find that the Respondent's registration and/or use of the Domain Name has been otherwise than an abusive registration for the purposes of: (i) taking unfair advantage of the Complainant's goodwill in order to confuse users and increase the number of users that access the Domain Name, for commercial gain; and (ii) preventing the Complainant from reflecting its "ALIEXPRESS" trade mark in a corresponding domain name. Due to the fame of the Complainant and its AliExpress Trade Marks around the world, particularly in China where the Respondent is based, it is inconceivable that the Respondent's registration and/or use of the Domain Name is other than an abusive registration.

(10) Lastly, Complainant experiences a high incidence of infringers registering domain names that are confusingly similar to its AliExpress Trade Marks and other trade marks. In fact the Complainant filed complaints for the recovery of about 13 infringing domain names in 2011, about 9 complaints in 2012, about 14 complaints in 2013, and over 50 complaints in 2014 in relation to its various trade marks. The Complainant has found that infringers often keep a very close eye on the business of Alibaba Group (e.g. monitoring trade mark applications, press mentions and domain name registrations) to try and anticipate their new ventures and register domain names which incorporate these brands, with a view to later selling them to Alibaba Group or its competitors.

(11) The Complainant accordingly submits that it has proved that the Domain Name is an abusive registration for the purposes of paragraph 2(a)(ii) of the Policy.

Response

The Respondent has not filed a response.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the nature of both legally protectable goodwill and registered trade marks in the name ALIEXPRESS. Disregarding the generic .co.uk suffix, the Domain Name is identical to the name and mark in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

"A Domain Name which either:

- i 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
- ii has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factors under paragraph 3a on which it is apparent the Complainant relies in this case are as follows:

- " 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;**
- 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"

In considering whether the Domain Name is an Abusive Registration, two important points should be taken into account: first, that the Domain Name is identical to the Complainant's name; and, second, that the Respondent has used the Domain Name in such a way that it automatically links to the Complainant's marketplace, clearly demonstrating that the Respondent is fully aware of the Complainant's "AliExpress" name and service.

From the second point, it is an obvious inference that the Respondent was also fully aware of the Complainant's AliExpress marketplace at the time when the Domain Name was registered.

When a domain name is identical to the name or mark of a complainant, without any adornment, barring exceptional circumstances this is almost inevitably going to lead to people being confused into believing that the domain name is owned or authorised by the complainant, at a minimum until they reach the website connected with the domain name. There is nothing to displace that likelihood in this case. In fact, the conclusion is reinforced by the fact that the Domain Names resolves to the Complainant's own marketplace, rather than any independent website.

I therefore find that such confusion will have occurred.

The Respondent has not filed any Response to explain his position in this case. The Respondent's intent is therefore a matter of inference. The two most obvious reasons in the circumstances are the ones raised by the Complainant, namely that the Respondent wished to gain from click-through revenue to the Complainant's own site and/or planned to bring about a situation where the Complainant would purchase the Domain Name from him for a significant sum. I conclude that one or both of these were the intention of the Respondent. In any case, taking everything into account, and without any submissions from the Respondent, I find it impossible to think of any bona fide reason which the Respondent can have had in registering the Domain Name.

From the conclusions which I have reached, it must follow that the Respondent intended to gain an unfair advantage by his registration and use of the Domain Name. I find that the Respondent has gained an unfair advantage. Conversely, it is also obvious that the use made of the Domain Name and the deception caused will have been detrimental to the Complainant.

In light of the above, it is clear that the Respondent's registration and use of the Domain Name has taken unfair advantage of and been unfairly detrimental to the Complainant's Rights, and that the Domain Name is therefore an Abusive Registration.

7. Decision

Having found that the Complainant has Rights in respect of a name and mark which is identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *aliexpress.co.uk* be transferred to the Complainant.

Signed: Jason Rawkins

Dated: 17 March 2015