

DISPUTE RESOLUTION SERVICE

D00021023

Decision of Independent Expert

Alibaba Group Holding Limited

and

Mr Wolfgang Klein

1. The Parties:

Lead Complainant: Alibaba Group Holding Limited
4th Floor, One Capital Place, P.O. Box 847
Grand Cayman
Cayman Islands

Respondent: Mr Wolfgang Klein
6 rue des Mirabelles
57150 Dolving
France

2. The Domain Name(s):

alibaba-group.co.uk
alibaba-group.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 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.

22 January 2019 05:41 Dispute received

22 January 2019 12:35 Complaint validated

22 January 2019 12:38 Notification of complaint sent to parties

08 February 2019 01:30 Response reminder sent

13 February 2019 10:28 No Response Received

13 February 2019 10:28 Notification of no response sent to parties

14 February 2019 09:43 Expert decision payment received

4. Factual Background

The Complainant is a globally recognised e-commerce and online services company founded in 1999 in the People's Republic of China. It has been listed on the New York Stock Exchange since 2014.

From the Domain Names Registration details, it appears that the Respondent is an individual residing at an address in France. Nothing further is known about the Respondent. No Response has been received to this Complaint.

The Domain Names were registered on 26 November 2018 and currently direct to blank pages.

5. Parties' Contentions

The Complainant Rights

The Complainant submits details of a large number of trademark registrations in many jurisdictions incorporating the expressions ALIBABA and ALIBABA GROUP which are repeated in the Domain Names. Evidence is also provided of the Complainant's extensive trading activities and brand recognition data under these names.

The Complainant asserts that the addition of hyphens to separate the words ALIBABA and GROUP in the Domain Names does not serve to distinguish them from the Complainant's registered marks. The Complainant also points out that it is accepted practice to discount the <.co.uk> and <.uk> suffixes when considering similarity between domain names and a complainant's proprietary marks.

Abusive Registration

The Complainant asserts that the Domain Names fall within the definition of Abusive Registrations set out in paragraph 1 of the DRS Policy. In particular, the Complainant relies upon paragraph 5 of the Policy listing circumstances which may be evidence that the Domain Names are Abusive Registrations. The Complainant alleges that the Respondent registered the Domain Names in full knowledge of the Complainant and its rights, intending to disrupt the Complainant's business and confuse Internet users into believing that the Domain Name is controlled by the Complainant.

The Complainant argues that the Respondent sought to trade on the Complainant's goodwill by using its Marks and showing familiarity with its brand and business. The Complainant points out that the Respondent registered the Domain Names in November 2018 after ALIBABA Trade Marks were first registered and after the Complainant's registration of its <alibaba.com> and <alibabagroup.com> domain names. The Complainant believes that the Respondent would have been aware of its marks and its other domain names at the time of the Domain Name registrations.

The Complainant alleges the Respondent sent emails from the Domain Name <alibaba-group.uk> to suggest that they originated from the Complainant. These emails contained quotation requests purporting to come from the Complainant and used its UK office address. The Complainant relies upon paragraph 5.1.2 of the DRS

Policy to argue that by attempting to pass itself off as the Complainant, the Respondent used this Domain Name in a way that confused people into believing that it was operated, authorized or otherwise was connected to the Complainant. Evidence of confusion, in the form of a communication from a victim of the Respondent's fraud, is submitted by the Complainant.

The Complainant claims that the Respondent sought to obtain personal information from the recipients of these emails, intending to steal these data. The Complainant argues that the Respondent's fraudulent use of the Domain Name <alibaba-group.uk> demonstrates intent to unfairly disrupt the Complainant's business within the meaning of Section 5.1.1.3 of the DRS Policy.

The Complainant states that the Domain Name <alibaba-group.co.uk> is also suspended and resolves to a blank page. The Complainant insists that, given the Respondent's use of the Domain Name <alibaba-group.uk>, it is implausible that he registered the <.co.uk> version other than to use it for the same purposes. Thus, both registrations give rise to likely or actual confusion and have the potential to damage the Complainant's business.

Respondent

No Response has been received to this Complaint.

6. Discussions and Findings

The absence of a Response in this matter does not relieve the Complainant of its obligation to make its case on the balance of probabilities in accordance with the DRS Policy. In doing so, the Complainant must show that:

- a) it has rights in a name which is identical or similar to the Domain Names and
- b) the Domain Names in the Respondent's hands are Abusive Registrations.

Complainant's registered and unregistered Rights

The Complainant has provided details of registered trademark rights in the name ALIBABA and the expression ALIBABA GROUP, which differ from the Domain Names solely in the use of hyphens. The Complainant has also provided evidence of the Complainant's conspicuous trading presence around the world, in support of a claim of unregistered rights in these names based upon the goodwill and notoriety arising from this activity. I am satisfied that the Complainant has such rights.

Similarity to the Domain Names

The Complainant makes reference to earlier DRS decisions to argue that added punctuation, such as the hyphens employed in this case, do nothing to distinguish the Domain Names from the names in which the Complainant claims Rights under the DRS Policy. I concur with this view. Accordingly, and following the usual practice of discounting the <.co.uk> and <.uk> suffixes, I have no difficulty in finding that the Complainant has Rights under the DRS Policy sufficient to bring this Complaint.

Abusive Registration

Paragraph 1 of the DRS Policy defines 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

The Complainant relies upon paragraph 5 of the DRS Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Names are Abusive Registrations,. Those relevant to the Complainant's case are as follows:

5.1.1 Circumstances indicating that the Registrant has registered or otherwise acquired the Domain Names primarily:

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

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

5.1.6 The Domain Names are exact matches (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Names.

Having reviewed the Complainant's evidence, I accept that, on the balance of probabilities, the Respondent's registration and use of the Domain Names falls within the contemplation of the above sections of Paragraph 5 of the Policy and thus within the definition of Abusive Registration. The timing of the registrations, and the extent of the Complainant's portfolio of registered rights and commercial notoriety, clearly imply that the Respondent had full knowledge of the Complainant and its business. The subsequent use of apparently fraudulent emails sent from an address at one of the Domain Names support this, and strongly suggest that the Respondent's motives were to cause confusion as to the source of these emails and derive unfair financial advantage from misuse of the Complainant's name and notoriety.

Absent a Response to this complaint, I can find no justification for the Respondent's registration of the Domain Names, nor any comfort for the Respondent from Paragraph 8 of the DRS Policy, which offers a non-exhaustive list of circumstances which might support a finding that a registration is not an Abusive Registration.

7. Decision

The Complainant has Rights in names which are identical or similar to the Domain Names. The Domain Names are Abusive Registrations in the hands of the Respondent and should be transferred to the Complainant.

Signed

Dated 12 March 2019