

EXPERT DECISION
Alibaba Group Holding Limited v. G.T.
Case No. DES2014-0020

1. The Parties

The Complainant is Alibaba Group Holding Limited of George Town, Grand Cayman, Grand Cayman Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland (the “UK”), represented by Mayer Brown JSM, China.

The Respondent is G.T. of Chaoyang District, China, self-represented.

2. The Domain Name and Registrar

The disputed domain name subject of the Complaint is <aliexpres.es>.

The Registry of the disputed domain name is Red.es and the Registrar is SCIP.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 5, 2014. On June 5, 2014, the Center transmitted by email to Red.es a request for registrar verification in connection with the disputed domain name. On June 6, 2014, Red.es transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on July 3, 2014. The Respondent sent informal communications to the Center on July 3 and 4, 2014.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the *Reglamento del procedimiento de resolución extrajudicial de conflictos para nombres de dominio bajo el código de país correspondiente a España (“.ES”) (the “Reglamento”).*

In accordance with Articles 7a) and 15a) of the *Reglamento*, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 11, 2014. In accordance with Article 15 a) of the *Reglamento*, the due date for Response was July 31, 2014.

The Center appointed Alejandro Touriño as the Expert in this matter on August 11, 2014. The Expert finds that it was properly constituted. The Expert has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with Article 5 of the *Reglamento*.

In its Complaint, the Complainant requested that the language of the proceedings be English rather than Spanish, providing the following arguments:

- The disputed domain name resolves to a website that is in the English language, which demonstrates the Respondent's ability to understand and communicate in English. Therefore, conducting the proceedings in English would not be disadvantageous to the Respondent.
- The disputed domain name resolves to a website to be operated by a business headquartered in Hong Kong. As one of the primary languages in Hong Kong is English, the Respondent may communicate in English.
- The Complainant does not speak and is not familiar with the Spanish language. Therefore, if the Complainant were to submit the Complaint in Spanish and to have the whole proceedings conducted in Spanish, the Complainant would have to incur substantial expenses for translation and may delay the proceedings.

On June 30, 2014, the Center, noting the Complaint had been filed in English, informed the parties that, as set out in Article 8 of the *Reglamento*, paragraph 1, the language of the proceedings shall be Spanish. Notwithstanding the above, the Center informed the parties that it is the Expert's authority to determine that the proceedings are in another language if the circumstances of the case so require and the parties agree. In the light of the above, the Center respectfully requested the Respondent to send its comments regarding the Complainant's request for English to be the language of the proceedings. Respondent did not respond to this request. However, Respondent sent informal communications to the Center and to Complainant in the English language. Afterwards, on July 4, 2014, the Complainant submitted the argument that it seems evident from the Respondent's emails dated July 3 and 4, 2014 that the Respondent understands and can communicate in English and it therefore seems that the Respondent has no objection to and will not be prejudiced by the proceedings being conducted in English rather than in Spanish.

The Expert determines that the language of the proceeding will be English.

4. Factual Background

The Complainant operates its business since 1999 and is nowadays a global leader in the field of e-commerce. The Complainant launched its online marketplace in April 2010 under the trademark ALIEXPRESS, a global retail marketplace targeted at consumers worldwide, which enables consumers from around the world to buy directly from wholesalers and manufacturers in China. The Complainant has been promoting the ALIEXPRESS brand and its services extensively since 2010, and has generated vast media attention. AliExpress Marketplace generated USD 2.0 billion in gross merchandise volume in 2013.

The Complainant is the owner of numerous trademarks comprising the term "Aliexpres" to protect its interest around the world, including the territories of the European Union (as of 2010), China (as of 2010) and in Hong Kong (as of 2009), China.

The disputed domain name <aliexpres.es> was registered on April 2, 2013.

5. Parties' Contentions

A. Complainant

The Complainant argues that: (i) the Respondent's domain name is identical or confusingly similar to a mark

in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name was registered and is being used in bad faith.

The Complainant's main contentions are summarized below:

The Complainant contends that the disputed domain name incorporates the Complainant's trademark in its entirety, save that the disputed domain name is missing an "s". The Respondent has engaged in "typosquatting". This conduct creates a virtually identical or confusingly similar mark to the Complainant's trademark ALIEXPRESS.

In addition, the Complainant states that the term "Aliexpress" has acquired distinctiveness through its extensive use by the Complainant and is immediately recognizable to consumers as being associated with the Complainant and its affiliated companies.

The Respondent registered the disputed domain name about three years after the first use of the trademark ALIEXPRESS by the Complainant in attention of the fame of the trademark and in full knowledge of the Complainant's prior rights.

The Complainant has not licensed, consented or otherwise authorized the Respondent's use of its trademarks. .

The Respondent is not commonly known by the disputed domain name.

The Respondent does not own any trademark registration either in Spain or in China corresponding to the disputed domain name.

The disputed domain name automatically redirected users to the domain name <lightinthebox.com>, an online marketplace that offers goods for sale to consumers, a direct competitor of the Complainant.

In this light, the Complainant also contends that the Respondent was clearly aware of the Complainant's ALIEXPRESS trademarks and that the Respondent's bad faith is evidenced by the fact of registering and using the disputed domain name to unfairly capitalize upon or (otherwise) take advantage of the confusing similarity between the Complainant's trademark and the disputed domain name, by means of attracting or otherwise obtaining commercial gain from such association.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. On July 3 and 4, 2014, the Respondent sent two informal communications to the Center, stating that when it bought the disputed domain name it was previously unregistered and that it "just wanted to get a small income by placing some ads for type-in traffic, but if AliExpress is not ok with that I have no problem selling the domain to them, I am sure we can reach an agreement."

The Respondent later on offered the disputed domain name at no cost and Complainant answered the following to the possible settlement email of the Center: "Our client would like to continue on with the proceedings, as it has already expended time and money on filing the Complaint and takes the protection of its intellectual property rights very seriously. Since we note that the Respondent is willing to transfer the domain name to our client, we understand that he does not dispute our client's rights to the domain name or our client's position as set out in the Complaint. As such, we trust that the proceedings will be swiftly concluded."

6. Discussion and Findings

6.1. Language of the Proceedings

Pursuant to Article 8 of the *Reglamento*, paragraph 1, the language of the administrative proceeding shall be Spanish, unless otherwise determined by the Expert if the circumstances of the case so require and the parties agree.

The Expert is satisfied that the Complainant has taken all reasonable steps to bring the present proceeding to the attention of the Respondent. In particular, the Expert notes that the material facts of this proceeding are generated in the English language: the disputed domain name; the language of the Complainant's communications; the Respondent's informal response to the Complainant and to the Center's communications. The Expert notes that the Respondent is not a native English speaker but the Expert finds that persuasive evidence has been adduced by the Complainant to suggest the likelihood that the Respondent is conversant in the English language. The Respondent has duly been notified of the Complaint and its contents. And while the Respondent has failed to formally respond to the Complainant's contentions, he has offered to firstly sell and secondly transfer at no cost the disputed domain name to the Respondent, being all these communications in English.

Pursuant to Article 8 of the *Reglamento*, paragraph 1, the Expert has the discretion to determine the language of the present proceeding and if the parties agree. After considering the circumstances of the present case, in particular, the parties' exchange of communications in the English language which the Expert considers as an indirect agreement that the proceedings be in English, the Expert decides that the proceeding should be conducted in the English language and should proceed henceforth in the English language.

6.2. Substantive Elements of the Policy

In accordance with Article 13(b)(vii) (1), (2) and (3) of the *Reglamento*, in order to succeed in this proceeding and obtain the transfer of the disputed domain name, the Complainant must establish that each of the three following elements is satisfied:

1. the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has previous rights ("*Derechos Previos*"¹ in Spanish);
2. the Respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered or is being used in bad faith.

Pursuant to Article 18 of the *Reglamento*, the Expert shall decide the Complaint on the basis of the statements and documents submitted. However, prior to the analysis of this case, the Expert wishes to indicate that in order to be able to properly interpret the circumstances of the present case, the Expert will refer to previous decisions under the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), due to the similarities between the *Reglamento* and the UDRP (See *e.g. Citigroup Inc., Citibank, N.A. v. R.G.G.*, WIPO Case No. DES2006-0001; *Ladbrokes Internacional Limited v. Hostinet, S.L.*, WIPO Case No. DES2006-0002)

On the basis of the evidence in this case, the Expert concludes as follows:

A. Identical or Confusingly Similar to Complainant's Previous Rights

The Complainant has provided sufficient evidence to support its assertion of ownership of an exclusive

¹ According to the *Reglamento* "Derechos Previos" are "1) Denominaciones de entidades válidamente registradas en España, denominaciones o indicaciones de origen, nombres comerciales, marcas registradas u otros derechos de propiedad industrial protegidos en España; 2) Nombres civiles o seudónimos notorios que identifiquen profesionalmente, entre otros, a creadores intelectuales, políticos y figuras de espectáculo o del deporte; 3) Denominaciones oficiales o generalmente reconocibles de Administraciones Públicas y organismos públicos españoles "

previous right to use the term “Aliexpress”. The Complainant is the owner of the trademark ALIEXPRESS in several jurisdictions including the European Union, China and Hong Kong. In addition, ALIEXPRESS is an unusual and distinctive mark with no common meaning. In fact, the word is not found in the Oxford Dictionary. Therefore, the Expert finds that, in this case, the Complainant has incontestable rights over the trademark ALIEXPRESS due to registration and extensive use of the term².

The disputed domain name <aliexpres.es> is confusingly similar to the Complainant’s mark. Indeed, the disputed domain name <aliexpres.es > could easily be mistaken for ALIEXPRESS.

Numerous UDRP decisions have recognized that incorporating a trademark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a registered trademark. See for example the following decisions: *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. D2002-0615; *Compagnie Générale des Etablissement MICHELIN v. Lost in Space, SA*, WIPO Case No. D2002-0504; *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903; *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047; *Toyota France and Toyota Motor Corporation v. Computer-Brain*, WIPO Case No. D2002-0002, and *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd*, WIPO Case No. D2000-0802.

Indeed, this is clearly a “typosquatting” case where the disputed domain name is a slight misspelling of a registered trademark to divert Internet traffic. In fact, the disputed domain name comprises the Complainant’s trademark ALIEXPRESS with a single misspelling of an element of the mark: a single consonant “s” at the end, instead of the double “s”, as in the original one. As a result, this is an example of confusing similarity and/or virtual identity brought about through easily made typing errors made by an Internet user: rather than typing the double “s” to visit Complainant’s website, an Internet user could easily type a single “s” and be diverted to a different website.

The practice of “typosquatting” has been consistently regarded in previous UDRP decisions as creating domain names confusingly similar to the relevant mark. See for example the following decisions: *ACCOR v. Brigit Klostermann*, WIPO Case No. D2005-0627 (finding that “typosquatting”, the practice of misspelling an element of the mark, has consistently been regarded as creating domain names confusingly similar to the relevant mark); *Sharman License Holdings, Limited v. Icedlt.com*, WIPO Case No. D2004-0713 (finding the circumstances of “typosquatting” to constitute confusing similarity); *Ross-Simons, Inc. v. Domain.Contact, supra* (finding that disputed domain names are confusingly similar to the marks which they misspell).

In addition, a visual and phonetic comparison between the trademark ALIEXPRESS and the disputed domain name shows a clear confusing similarity. .

The Expert finds that the first element is established.

B. Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name. There is no evidence in the record to support the Respondent’s rights or legitimate interests in the disputed domain name.

As prior UDRP panels have decided (*Document Technologies, Inc. v. International Electronic Communications, Inc.*, WIPO Case No. D2000-0270; *CHANEL, INC V ESTCO TECHNOLOGY GROUP*, WIPO Case No. D2000-0413; *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. D2000-0252), once a complainant establishes a *prima facie* showing that none of the circumstances establishing legitimate interests or rights apply, the burden of production on this element shifts to the

² According to Article 2 of the *Reglamento*, trademarks registered in Spain are considered “*Derechos Previos*”. Therefore, the Community trademark owned by the Complainant are sufficient for this Expert for the purposes of the *Reglamento*.

respondent to rebut the showing.

Moreover, prior UDRP panels (*Singapore Airlines Limited v. European Travel Network*, WIPO Case No. D2000-0641; *Bayerische Motoren Werke AG v. Null*, WIPO Case No. D2002-0937), have accepted that the silence of the respondent might support a finding, based on other relevant circumstances, that the respondent has no rights or legitimate interests in respect of the disputed domain name.

Considering the above, the Expert finds that in this case the Complainant established a *prima facie* showing that the Respondent has no rights to or legitimate interests in the disputed domain name. The Expert, referring to the Respondent, has no indication whatsoever of any use or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant holds a distinctive trademark and the Complainant did not authorize the Respondent in any way to use its mark.

In sum, the Complainant has satisfied its burden of providing sufficient evidence to show that Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has failed to provide the Expert with any evidence from which the Expert might conclude that Respondent has any rights or legitimate interests in the disputed domain name (*Berlitz Investment Corp. v. S.T.* , WIPO Case No. D2003-0465).

The Expert finds that the second element is established.

C. Registered or Used in Bad Faith

The Expert finds that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

As discussed above, it is more than likely that the Respondent was well aware of the Complainant and its use of its ALIEXPRESS mark, given the Complainant's widespread use of the mark in connection with its online activity. Accordingly, the Expert finds that the Respondent's registration and use of the disputed domain name that incorporates the Complainant's ALIEXPRESS mark in its entirety with a minor misspelling constitutes bad faith.

The Expert also finds bad faith evidenced by the fact that the Respondent has not used the disputed domain name in connection with a legitimate offering of any goods or services, but redirecting to a direct competitor of the Complainant.

Finally, the Expert finds that the Respondent's offer to sell the disputed domain name compounded the bad faith nature of the Respondent's conduct.

The Expert determines that in the present case, bad faith is shown in that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark.

The Expert agrees with the Complainant that this is a typosquatting case, or *i.e.* "the intentional misspelling of words with intent to intercept and siphon off traffic from its intended destination, by preying on users who make common typing errors" (*National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. J.Z.* , WIPO Case No. D2002-1011). The Expert determines that the typosquatting nature of the disputed domain name provides a further ground of bad faith in registration and use.

The fact that the disputed domain name currently resolves to a parked website with advertisement links does not change the Expert's findings above but is a further indication of bad faith.

The Expert finds that the third element is established.

7. Decision

For the foregoing reasons, in accordance with Article 21 of the *Reglamento*, the Expert orders that the disputed domain name <aliexpres.es> be transferred to the Complainant.

Alejandro Touriño

Expert

Date: August 23, 2014