

## **ADMINISTRATIVE PANEL DECISION**

Alibaba Group Holding Limited v. James Murphy  
Case No. D2023-3335

### **1. The Parties**

The Complainant is Alibaba Group Holding Limited, Cayman Islands, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is James Murphy, United States of America (“United States”).

### **2. The Domain Name and Registrar**

The disputed domain name <hkalibaba.com> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 3, 2023. On August 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 3, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 4, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 8, 2023.

The Center verified that the Complaint together with amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 1, 2023.

The Center appointed Andrew Brown KC as the sole panelist in this matter on September 8, 2023. 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 the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a limited liability company incorporated in the Cayman Islands. It was established in 1999. All subsidiaries and consolidated entities of the Alibaba Group of companies outside China are 100% owned directly or indirectly by the Complainant.

The Complainant's core commerce is comprised of marketplaces operating in retail commerce, wholesale commerce, logistics services and consumer services – in particular, the <alibaba.com> e-commerce platform.

The Complainant is the owner of registered trademarks for the ALIBABA trademark (the ALIBABA Trademark), including the United States registration 2579498, registered on June 11, 2002. The Complainant has multiple additional registered trademarks worldwide, including in China, Bangladesh, Cambodia, Hong Kong (province of China), India, Indonesia, Japan, Macau, Malaysia, Mongolia, Philippines, Singapore, Viet Nam, South Korea, Sri Lanka, Taiwan, Thailand, Australia, New Zealand, the European Union, the United Kingdom, and Canada. The registrations are in many classes, including classes 9, 16, 35, 36, 38, 39, 41 and 42.

The Complainant claims that its ALIBABA Trademark is well-recognized and highly valued internationally as a result of its extensive continuous and exclusive use. It claims that its ALIBABA Trademark has a significant goodwill and reputation such that the trademark is well-known.

The disputed domain name was registered on March 20, 2021. The record shows that the disputed domain name resolved to a site that offered goods and services and claimed to be "Alibaba department store".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts its rights in the ALIBABA Trademark. It states that the disputed domain name is confusingly similar to its ALIBABA Trademark given that:

- (i) The disputed domain name includes its ALIBABA Trademark with the addition of the geographic descriptive term "hk", being the common abbreviation for Hong Kong. It asserts that the ALIBABA Trademark is recognizable within the disputed domain name.
- (ii) The Hong Kong (hk) geographical term is closely linked and associated with the Complainant's brand and trademark. The Complainant owns a sub-domain <hk.alibaba.com>; one of its offices is located in Hong Kong; and it is listed on the Hong Kong Stock Exchange. It states that it raised \$12.9 billion through a sale on the Hong Kong Stock Exchange prior to registration of the disputed domain name.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard the Complainant asserts that:

- (i) The Respondent is not sponsored by or affiliated with the Complainant in any way.
- (ii) The Complainant has not given the Respondent any license, authorization or permission to use its ALIBABA Trademark in any manner, including in a domain name.

(iii) The Respondent is not commonly known by the disputed domain name and there is no evidence, including in the Whois record for the disputed domain name, that would enable that claim to be made.

(iv) At the time of filing the complaint, the Respondent was using a privacy Whois service, which previous Panels have found to equate to a lack of legitimate interest (*Jackson National Life Insurance Company v Private Whois www.jacksonnationallife.com* N4892, WIPO Case No. [D2011-1855](#)).

(v) The Respondent registered the disputed domain name well after the dates of registration of the ALIBABA Trademark in numerous countries around the world.

(vi) The Respondent has intentionally registered the disputed domain name for the purpose of making illegitimate or unfair use of the Complainant's ALIBABA Trademark.

(vii) The "About Us" page of the website located at the disputed domain name was copied from the official website of International Finance Centre, a well-known shopping centre in Hong Kong, and official description of the New World Department Store China Limited. The purported address of the 'Alibaba department store' referred to in the website located at the disputed domain name is in fact where Jardine House is located in Central Hong Kong.

The Complainant further states that the Respondent has registered and is using the disputed domain name in bad faith.

As to registration in bad faith, the grounds relied on by the Complainant are:

(i) The Respondent had constructive knowledge of the Complainant's ALIBABA Trademark and business. The Complainant states that it is not possible to conceive of a plausible situation in which the Respondent could have been unaware of the Complainant's ALIBABA Trademark at the time the disputed domain name was registered.

(ii) In addition to its numerous trademarks for the ALIBABA Trademark (filed before registration of the disputed domain name) the fame of that trademark was created and demonstrated by the earlier HK12.9 Billion share sale in Hong Kong. As a result of this the Complainant could not have been unaware of the Complainant's ALIBABA Trademark.

As to use in bad faith, the Complainant asserts that the Respondent has intentionally misappropriated its ALIBABA Trademark as a way of redirecting users to the disputed domain name only then to offer his own products or services for commercial gain. In this regard the Complainant states that the Respondent has falsely created a fictitious "Alibaba department store" and attempted to profit from such confusion by purportedly offering retail services. The Complainant asserts that the disputed domain name and the website operated from it would cause consumers to believe that the Respondent is somehow associated with the Complainant when he is not.

The Complainant relies on the fact that the website of the disputed domain name contains false and misleading information with lists of shops, shop hours and locations simply adopted from third parties.

As further evidence of use in bad faith, the Complainant relies on the following:

(i) The Respondent's employment of a privacy service to hide its identity at the time of original filing.

(ii) The Respondent has ignored the Complainant's attempts to resolve this dispute outside of this proceeding and has failed to respond to cease and desist letters sent to him.

(iii) The Respondent provided false Whois information to the relevant registrar by stating an inaccurate and non-existent address attempting to conceal his true location.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, a Complainant must prove each of the following elements with respect to the disputed domain name in order to succeed in this proceeding:

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

### **A. Identical or Confusingly Similar**

The Complainant has provided evidence of its rights to the ALIBABA Trademark in multiple jurisdictions. It has also provided evidence of extensive use of its ALIBABA Trademark internationally commencing in 1999. It is the Panel's view that the Complainant has clearly and sufficiently demonstrated its rights in the ALIBABA Trademark. The Panel is satisfied that the Complainant is well-known internationally by its ALIBABA Trademark in relation to a core group of services, including retail commerce, wholesale commerce, logistic services and consumer services.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's ALIBABA Trademark. This trademark is immediately recognizable in the disputed domain name. The addition of the term "hk" does not prevent a finding of confusing similarity between the disputed domain name and the ALIBABA Trademark.

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's ALIBABA Trademark and finds in favor of the Complainant in respect of paragraph 4(a) of the Policy.

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish that it has rights or legitimate interests in the disputed domain name, among other circumstances, by showing any one of the following elements:

- (i) that before notice of the dispute, the Respondent used or made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) that the Respondent has been commonly known by the disputed domain name, even if it had acquired no trademark or service mark rights; or
- (iii) that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The overall burden of proof for establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

There is no evidence of the existence of any rights or legitimate interests on the part of the Respondent in the ALIBABA Trademark pursuant to paragraph 4(c) of the Policy. The Complainant unquestionably has prior rights in the ALIBABA Trademark which well precede the Respondent's registration of the disputed domain name in 2021. The Panel is satisfied that the Complainant has never licensed or permitted the Respondent to use its ALIBABA Trademark. The Panel is further satisfied that the Respondent has never been commonly known by the disputed domain name and that the Respondent has not made a legitimate non-commercial or fair use of the disputed domain name.

The Respondent had the opportunity to demonstrate his rights or legitimate interests in the disputed domain name but has not replied to the complaint.

The Panel therefore finds that the Complainant has satisfied the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and accordingly finds that paragraph 4(a)(ii) of the Policy is satisfied in favor of the Complainant.

### **C. Registered and Used in Bad Faith**

The Panel is also satisfied that the disputed domain name has been registered in bad faith for the following reasons:

(i) The Panel has already found that the Complainant's ALIBABA Trademark is well-known for a core group of services comprising marketplaces operating in retail commerce, wholesale commerce, logistic services and consumer services and the <alibaba.com> e-commerce site. It is inconceivable, given the reputation of the ALIBABA Trademark, that the Respondent was unaware of that well-known trademark. The Panel is satisfied that the Respondent was aware of the Complainant's ALIBABA Trademark at the time of registration. This is demonstrated by the creation of a website operating from the disputed domain name which refers to a fictitious "Alibaba department store".

(ii) Paragraph 2 of the UDRP puts a burden on registrants where it states "by applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and bond to us that [...] to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of a third party [...]. It is your responsibility to determine whether your domain name infringes or violates someone else's rights." Even the most cursory trademark or other online search or any online search of existing domain names prior to the Respondent registering the disputed domain name would instantly have revealed the Complainant's and its ALIBABA Trademark. See in this regard section 3.2.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel is also satisfied that the Respondent is using the disputed domain name in bad faith for the following reasons:

(i) The registration of the disputed domain name which prominently features the Complainant's ALIBABA Trademark plus the term "hk" has been found earlier to be confusingly similar to the Complainant's ALIBABA Trademark. This creates a presumption of bad faith. The presumption is confirmed by the fact that the website (to which the disputed domain name redirects) amounts to an attempt to impersonate the Complainant. The Panel finds that the disputed domain name and its use creates a serious likelihood of confusion with the Complainant and its ALIBABA Trademark.

(ii) The fact that the Respondent has employed a privacy service to hide its identity has been regarded by previous Panels as an indication of bad faith. See [WIPO Overview 3.0](#), section 3.6 ("Panels have also viewed a respondent's use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith.")

- (iii) The Respondent has ignored the Complainant's attempts to resolve this dispute and has failed to answer to cease and desist letters. In combination with other factors, this provides strong support for a determination of bad faith registration and use (*Encyclopedia Britannica v Zuccarini*, WIPO Case No. [D2000-0330](#).)
- (iv) The Respondent has provided false Whois information to the relevant registrar.
- (v) The Respondent had the opportunity to respond to the Complaint but has not done so. The Panel is therefore entitled to draw adverse inferences from that failure or omission.

The Panel therefore finds that the domain name has been registered and is being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <hkalibaba.com> be transferred to the Complainant.

*/Andrew Brown K.C./*

**Andrew Brown K.C.**

Sole Panelist

Date: September 22, 2023