

## **ADMINISTRATIVE PANEL DECISION**

Xiaomi Inc. v. JAIZURI VERGARA

Case No. DCO2023-0055

### **1. The Parties**

The Complainant is Xiaomi Inc., China, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is JAIZURI VERGARA, Colombia.

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

The disputed domain name <mixiaomi.co> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2023. On June 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 30, 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 July 3, 2023.

The Center verified that the Complaint together with the 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 July 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Knud Wallberg as the sole panelist in this matter on August 11, 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 consumer electronics and smart manufacturing company with smartphones and smart hardware connected by an Internet of Things platform at its core. The Complainant's range of products includes phones, smart home devices including vacuums or kitchen appliances, and lifestyle goods such as smart watches or electric scooters.

The Complainant owns several trademark registrations for the trademarks MI and XIAOMI in many jurisdictions around the world including in Colombia. Colombia is thus designated in the International trademark registration number 1177611 for the stylized word XIAOMI, registered on November 28, 2012, and covering goods and services in the International classes 9, 35, 38 and 42 and in the International trademark registration number 1516163 for the logo MI, registered on October 17, 2019, and covering goods in the International classes 7, 8, 9, 11, 12, 14, 16, 18, 21, 24 and 28.

The Complainant's main website is located at its primary domain name, <mi.com>

The disputed domain name was registered on November 12, 2019. At the time of filing the Complaint, the disputed domain name was connected to a commercial website with the headline "Distribuidores para Colombia de productos marca Xiaomi" and with a reproduction of the Complainant's MI logo just below. The website allegedly offers a range of the Complainant's products.

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to each of the Complainant's MI and XIAOMI trademarks since it combines these two trademarks.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent is not making a *bona fide* offering of goods or services, or legitimate, noncommercial fair use of the disputed domain name. The Respondent is using the disputed domain name to offer a range of the Complainant's XIAOMI goods and products, but the Respondent is not an authorized reseller.

The Complainant finally submits that the disputed domain name was registered and is being used in bad faith. The Complainant, thus, submits that by registering a domain name that simply combines the Complainant's MI and XIAOMI trademarks, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. In addition, the Respondent is using the disputed domain name for an unauthorized commercial website that offers XIAOMI products and on which the Complainant's logo is prominently displayed.

##### **B. Respondent**

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the trademarks MI and XIAOMI for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of these marks is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to these marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of paragraph 4(a) of the Policy has been established.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, and taking into account that according to the Complaint, the Complainant has not licensed or otherwise permitted the Respondent to use its trademark or to apply for any domain name incorporating the mark, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel recognizes that there may be some limited situations where the registration and use of a domain name that specifically refers to and incorporates the trademark of another entity may serve legitimate purposes. As it is stated in section 2.8.1 of the [WIPO Overview 3.0](#):

"Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and, thus, have a legitimate interest in such domain name. Outlined in the '*Ok! Data* test', the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The *Okidata* test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."<sup>1</sup>

In this case, the Respondent is not an authorized dealer or reseller of the Complainant's products and services. Nevertheless, the Respondent presents himself as being a distributor of the Complainant's products and he displays the Complainant's MI logo on the website. The Respondent does, thus, clearly not meet the above-outlined requirements under the *Okidata* principles.

Moreover, the Panel notes that the disputed domain name, which incorporates the trademarks MI and XIAOMI in their entirety, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel, therefore, considers that the record of this case reflects that the Respondent is not making a legitimate noncommercial 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. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4, just as there is no evidence giving rise to rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the paragraph 4(a) of the Policy has also been established.

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

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Given the circumstances of the case and in particular the evidence on record of the use of disputed domain name, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's marks. Further, due to the nature of the Respondent's business the Panel finds that the Respondent could not have been unaware of the fact that it chose a domain name, which could attract Internet users in a manner that is likely to create confusion for such users.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The Panel considers that the record of this case reflects that the Respondent is using the disputed domain name in an attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Noting that the disputed domain name incorporates the Complainant's trademarks MI and XIAOMI in their entirety, and that there appears to be no conceivable good faith use of the disputed domain name, the Panel finds the third element of the paragraph 4(a) of the Policy has also been established.

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<sup>1</sup> See *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

## 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 <mixiaomi.co> be transferred to the Complainant.

*/Knud Wallberg/*

**Knud Wallberg**

Sole Panelist

Date: September 4, 2023