

## **ADMINISTRATIVE PANEL DECISION**

Xiaomi, Inc v. PRG Trading Group s.r.o.  
Case No. DRO2023-0002

### **1. The Parties**

The Complainant is Xiaomi, Inc, China, represented by Lane IP Limited, United Kingdom.

The Respondent is PRG Trading Group s.r.o., Czech Republic.

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

The disputed domain name <xiaomi-store.ro> is registered with ROTLD (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 29, 2023. On March 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 31, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint 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 April 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 2, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on May 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.

The language of the procedure is English.

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

The Complainant, Xiaomi, Inc., established in 2010 in China, is a global consumer electronics manufacturer which develops and produces a variety of goods such as smartphones, apps and other electronic products such as watches, wristbands, scales, headphones, external batteries, chargers, cameras and TVs under the trademarks XIAOMI, Mi and REDMI.

The Complainant has experienced impressive growth since its beginning, having sold more than 61 million headsets in 2014; in June 2021 it has become the world's largest smartphone brand by market-share and it was the third-largest smartphone brand in 2020, with 146.4 million smartphones sold in the said year.

XIAOMI branded products are present in more than 100 countries and regions around the world. The Complainant also owns and runs social network accounts under the XIAOMI brand.

Starting 2019 the Complainant is listed in the Fortune 500 list and has been repeatedly been recognised as one of the world's most valuable brands by independent data and consulting companies.

The Complainant's official website is located at "www.mi.com" which has operated since at least April 22, 2014.

The Complainant owns several trademark registrations for the trademark XIAOMI in many jurisdictions around the world including in the Czech Republic where the Respondent is apparently located, and Romania, which is the designation of the disputed domain name, ".ro", such as the following:

- the European Union trademark registration number 1177611 for the stylized word XIAOMI, International Registration designating the European Union on December 2, 2013, registered on November 28, 2012, and covering goods and services in the International classes 9, 35, 38, 42; and
- the International trademark registration number 1352685 for the stylized word XIAOMI, registered on June 16, 2016, and covering goods and services in the International classes 12, 14, 16, 20, 21, 25, 28, 36 and 37.

The disputed domain name was registered in July 29, 2020. At the time of filing the Complaint, the disputed domain name was connected to a commercial website headed as "Xiaomi-Store" having the color scheme, some images and texts, as the Complainant's e-commerce website; allegedly offering a range of household consumer goods including products marked XIAOMI as well as third parties' products. At the welcome page the Respondent states that "We started as an e-shop with Xiaomi products. Today, however, we also offer other brands that we carefully select for you and use ourselves. We are not an official Xiaomi e-shop. We offer more. Soon you will be writing our new future with us".

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

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

The Complainant contends that the disputed domain name is confusingly similar to its distinctive and globally famous trademark XIAOMI, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith.

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

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

## 6. Discussion and Findings

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the XIAOMI trademark.

The disputed domain name <xiaomi-store.ro> incorporates the Complainant's XIAOMI trademark with an additional term, "store" and a hyphen. However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity, where the relevant trademark is recognizable within the domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the ".ro" Top-Level-Domain ("TLD"), being a technical requirement for registering Internet domain names, may typically be disregarded for the purpose of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark XIAOMI, pursuant to the Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the mark XIAOMI, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "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". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has made a *bona fide* use of the disputed domain name, or has been known by this disputed domain name, or is making any legitimate noncommercial or fair use of the disputed domain name. In fact, at the time of filing the Complaint the disputed domain

name resolved to a commercial website featuring the XIAOMI trademark and logos and offering purportedly products branded XIAOMI for sale, as well as third parties' products.

In certain cases, Panels have recognized that resellers or service providers using a domain name containing the complainant's mark to undertake sales or repairs related to the complainant's goods and services may have a legitimate interest in such domain name. Relevant UDRP panel decisions in relation to this issue are helpfully summarized in section 2.8 of the [WIPO Overview 3.0](#) as follows:

Normally, a reseller, distributor or service provider can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods, the site's accurately and prominently disclosing the registrant's relationship with the trademark holder and the respondent not trying to "corner the market" in domain names that reflect the trademark.

This summary is based on UDRP panel decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). At least one condition that is outlined has clearly not been satisfied by the Respondent in this case: at the time of filing the Complaint, on the website under the disputed domain name there were offered for sale third parties' goods together with XIAOMI goods. Further, images of the Complainant's trademarks and official pictures were displayed without any consent from the Complainant, thus generating a likelihood of confusion for the Internet users accessing the Respondent's website and suggesting a false commercial relationship between the website under the disputed domain name and the Complainant.

In addition, and without prejudice to the above, UDRP panels have found that domain names that consist of a trademark plus an additional term cannot constitute fair use if they effectively impersonate or suggest sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

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

The Complainant holds registered trademark rights for XIAOMI since at least 2013 and company name since 2010, according to the evidence provided, the Panel is satisfied that the XIAOMI trademark acquired worldwide reputation.

The disputed domain name was created in July 2020, and incorporates the Complainant's distinctive mark and tradename with an additional generic term "store".

For the above reasons, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business and particularly targeting the Complainant's trademark.

The Respondent is using without permission the Complainant's well-known trademark in order to get Internet traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademark in the disputed domain name, and the content on the website provided thereunder which includes the Complainant's trademarks, logo, and images of official products.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark and the website operated under the disputed domain name copied the colors of the Complainant's website, displays the Complainant's trademarks, logos, text and product images, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain.

The statement made by the Respondent on the welcome page under the disputed domain name is not satisfactory in the eyes of this Panel, since the disclaimer must be clear and sufficiently prominent in order to support a finding that the Respondent has undertaken reasonable steps to avoid unfairly passing itself off as related to the complainant, or to otherwise confuse Internet users. To the contrary, where the overall circumstances of the case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith, but to the contrary the respondent's use of the disclaimer can be considered as an admission by the respondent that users may be confused. In this case the Respondent used the color scheme, products images and text from the Complainant's official website, including its trademarks and logos and therefore this Panel finds insufficient the purported disclaimer. See section 3.7 of the [WIPO Overview 3.0](#).

Additionally, the Respondent did not participate in the present proceedings and has failed to provide a substantial response to the Complainant's allegations. Along with other circumstances in this case, such fact is another sign of bad faith. See section 3.2.1. of the [WIPO Overview 3.0](#).

It was consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark constitutes, by itself, a presumption of bad faith registration for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

## 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 <xiaomi-store.ro> be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: May 24, 2023