

SINGAPORE DOMAIN NAME DISPUTE RESOLUTION SERVICE

Administrative Panel Decision

Case No. SDRP-2010/0001(F)

Alibaba Group Holding Limited v Forza Metal Industry

1. The Parties

- 1.1 The Complainant, Alibaba Group Holding Limited, is a corporation incorporated in the Cayman Islands, whose principal place of business is in China.
- 1.2 The Respondent, Forza Metal Industry (Entity No. 52878782M), is a sole proprietorship of Sio Yeok Sing, registered in Singapore, whose registered address is at 1015 Geylang East Avenue 3, #02-117, Singapore 389730.

2. The Domain Name and Registrar

- 2.1 The domain names in issue are "alibaba.sg" and "alibaba.com.sg" (collectively, the "Domain Names").
- 2.2 The Registrar of the Domain Names is Cybersite Pte Ltd of 315 Outram Road, #13-10, Tan Boon Liat Building, Singapore 169074, an accredited registrar authorised by Singapore Network Information Centre (SGNIC) Pte Ltd ("SGNIC") of 8 Temasek Boulevard, #14-00 Suntec Tower Three, Singapore 038988.

3. Procedural History

- 3.1 The Complainant submitted its complaint ("the Complaint") pursuant to the Singapore Domain Name Dispute Resolution Policy ("the Policy"), the Rules of the Singapore Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules of the Singapore Domain Name Dispute Resolution Policy ("the Supplemental Rules").
- 3.2 The Secretariat for the Singapore Domain Name Dispute Resolution Service ("the Secretariat") received the Complaint dated 21 May 2010 in hard copy on 21 May 2010 and by e-mail on 25 May 2010. After checking the Complaint for compliance with formalities requirements, the Secretariat forwarded the Complaint, together with the prescribed Complaint Notification Instructions to the Respondent in hard copy on 31 May 2010.
- 3.3 The Secretariat received the Respondent's Response dated 21 June 2010 by email as well as in hardcopy on 21 June 2010.
- 3.4 On 28 June 2010, the Secretariat notified both the Complainant and the Respondent (collectively "the Parties") of the appointment of Mr. Jim Lim as the sole panellist on the Administrative Panel ("the Panel") to decide the dispute between the Parties over the Domain Name, after the said Mr. Jim Lim had signed the Statement of Acceptance and Declaration of Impartiality and Independence. The Panel received a hard copy of the Complaint on 23 June 2010 and copies of the Complaint and the Response from the Secretariat, both in soft and hard copy on 25 June 2010.

4. Factual Background

4.1 The Complainant states that:

4.1.1 “ALIBABA” is a brand owned by the Complainant, and was first used in Hangzhou, China in December 1999. The Complainant’s group of companies has since grown to become a global leader in the field of e-commerce. The Complainant is a family of internet-based businesses that includes business-to-business (B2B) international trade, online retail and payment platforms and data-centric cloud computing services. The Complainant is a privately held company which reaches 47 million registered spanning more than 240 countries and regions, employing 17, 000 people in over 60 countries in Greater China, Japan, Korea, the United Kingdom and the United States. The Complainant’s alibaba.com platform alone turned over RMB 3 and 3.87 billion in 2008 and 2009 respectively.

4.1.2 The businesses and services provided via its subsidiaries are and have always been carried on, supplied and marketed continuously under and/or by reference to “ALIBABA”. The date of first use of the mark “ALIBABA” for which the Complainant has been commonly known worldwide in relation to e-commerce services was in December 1998. The Complainant and its subsidiaries have spent substantial sums promoting “ALIBABA” branded e-commerce services and products extensively since 1999 via the internet and through publicity and advertising in trade press and other print media.

4.1.3 In 2009, alibaba.com expended significant resources in promoting and advertising at the Singapore airport and on public transport vehicles such as taxis and buses, and participates in the annual CommunicAsia trade show in Singapore. The Complainant now also operates a Singapore website at www.Alibaba.com/countrysearch/SG-Singapore.html, which facilitates membership subscriptions and B2B trading for Singapore-based businesses.

4.2 The Respondent states as follows:

4.2.1 The name “Alibaba” refers to the well-known fable “Alibaba and the Forty Thieves”, Stories from the book “Thousand and One Nights” since 1954. The name “Alibaba” is different from the mark “ALIBABA.COM” that the Complainant has registered as a trade mark in Singapore under Classes 35 and 42 on 14 October 1999.

4.2.2 The Respondent registered the domain names, “forza.com.sg” on 4 February 1999, “alibaba.com.sg” on 23 November 2001, “ali-ba-ba.com” on 9 February 2004 and “alibaba.sg” on 5 March 2007. The Respondent has also set up a Google group on 8 September 2005 with the Chinese name “阿里巴巴防盜技术”. This name is used by the Respondent to promote its patented product, an “Anti-Burglar Security Interlocking System”. The Respondent uses the above mentioned domain names to promote the invention, and his invention is not in the same class of goods or services for which the Complainant has registered its trademark.

4.2.3 On 1 January 2007, Singapore Network Information Centre (SGNIC) Pte Ltd opened registration for the “.sg” domain names giving all registered trademark holders, well-known mark holders and existing registrants priority to apply. The Complainant did not do so and the Respondent registered the domain name “alibaba.sg” on 5 March 2007.

4.2.4 The Respondent registered the domain name “alibaba.sg” as the registrations were being processed on a “first-come-first-serve” basis. As of 3 February 2007, the Respondent

ceased to be registered on ACRA due to financial problems and has yet to be reinstated. The Respondent is prepared to re-register with ACRA.

- 4.2.5 The Respondent has been using the Domain Name to promote the burglar-proof windows since 23 November 2001. The Respondent is not active in the same category of goods or services that the Complainant has registered its trademarks for.

5. The Parties' Contentions

5.1 *The Complainant contends:*

Domain names are identical and/or confusingly similar to the marks in which the Complainant has rights

- 5.1.1 The Complainant submits that the Domain Names are identical and/or confusingly similar to the marks in which the Complainant has rights on the basis of its company name and its trade mark registrations of marks consisting of or incorporating the word "Alibaba".
- 5.1.2 The Complainant has six (6) trade mark registrations and one (1) pending trade mark application in Singapore where the marks consist of or incorporate the word "ALIBABA" as the distinctive and dominant component.
- 5.1.3 The Complainant is also the registered proprietor of over 240 trade mark registrations worldwide of marks consisting of or incorporating the word "ALIBABA".
- 5.1.4 The Complainant submits that the Domain Names correspond directly to the dominant component of the Complainant's company name (i.e. "Alibaba"). In fact, the Complainant's group of companies (or any of the companies within the group) is often referred to simply as "Alibaba". Due to the Complainant's extensive use of the "Alibaba" name worldwide, in particular on the internet, the "Alibaba" name has become well-known among consumers worldwide, including in Singapore. Hence, the Complainant asserts that the general public (including members of the public in Singapore) now associates the name "Alibaba" with the Complainant.
- 5.1.5 It is a well established principle that in the determination of whether a domain name is identical or confusingly similar to a trademark, the domain extension (in this case, ".com.sg" and ".sg") should not be taken into account. The main component of the Domain Names, the word "Alibaba", is thus identical to the distinctive and dominant component of the Complainant's trade mark registrations in Singapore.
- 5.1.6 For the reasons set out above, the Complainant submits that the Domain Names are identical and/or confusingly similar to trade marks in which the Complainant has rights or interests for the purposes of Paragraph 4(a)(i) of the SDRP.

The Respondent has no right or legitimate interest in respect of the Domain Names:

- 5.1.7 The Complainant states that it has not at any time granted the respondent any right, licence, authorisation or consent to use the "ALIBABA" mark in Singapore or elsewhere. The Complainant's Singapore Trademark Registration for "ALIBABA.COM" in Classes 35 and 42 have been registered since 14 October 1999, which clearly pre-dates the Respondent's registration of the domain name "alibaba.com.sg" on 23 November 2001 and "alibaba.sg" on 5 March 2007.

5.1.8 There is no evidence of the Respondent's use of or demonstrable preparations to use the Domain Names in connection with a bona fide offering of goods or services:

- (a) To the Complainant's knowledge, the Respondent is not using and has not used the Domain Name "alibaba.com.sg" in connection with any bona fide offering of goods or services. The Domain Name "alibaba.com.sg" is used to divert customers to the website "forza.com.sg", which advertises in Chinese, various metal products. The word "Forza" and the Chinese transliteration of the name is prominently displayed upon entering the site.
- (b) According to a WHOIS search on the domain name "forza.com.sg", the registrant is an entity known as Top Joy Aluminium Decorator. Further searches on the ACRA Business Profile Search show that the entity is a sole proprietorship owned by a Sio Yeok Sing, (NRIC No. S1636315D). This is the same Sio Yeok Sing who is also the sole proprietor of the Respondent. It is conclusive that the diversion of consumers to "forza.com.sg" is a diversion of business to the Respondent.
- (c) The Domain Name "alibaba.sg" is not connected to any server or website, it is not used in connection with any bona fide offering of goods or services.

5.1.9 There is no evidence of the Respondent being commonly known by the Domain Names:

- (a) The Domain Names bear no resemblance nor does it reflect the name of the Respondent.
- (b) There is no evidence that the Respondent has acquired any reputation in the Domain Names in Singapore. There is also no evidence that the Respondent is being known by any other name resembling any part of the Domain Names.
- (c) Trade mark searches by the Complainant has not disclosed any registered trade mark rights in Singapore by the Respondent under the Singapore Registry of Trade Marks which reflect the Domain Names.

5.1.10 There is no evidence that the Respondent has made any legitimate non-commercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue:

- (a) The Respondent is not using the Domain Names in connection with any legitimate non-commercial or fair use.
- (b) The Domain Name "alibaba.sg" does not appear to have been put to any use.
- (c) The Complainant submits that the use of the Domain Name "alibaba.com.sg" is being used to divert traffic of internet users to the website at www.forza.com.sg. This amounts to an act to "misleadingly divert consumers" for its own commercial gain. Such action also tarnishes the Complainant's trade marks, as consumers are likely to be misled as to the original owner of the Domain.

The Domain Names have been registered by the Respondent in bad faith:

5.1.11 The Respondent had ceased to be a legal entity registered with ACRA. The Domain Name

“alibaba.sg” was registered on 5 March 2007, after the status of the Respondent with ACRA was cancelled. The registration of Domain Name “alibaba.com.sg” was also renewed after the cancellation of the Respondent. These actions indicate bad faith on the part of the Respondent.

5.1.12 The Respondent was aware of the Complainant’s prior rights:

- (a) The Complainant’s extensive use of the “Alibaba” name predates the Respondent’s registration of the Domain Names. The Complainant’s trade mark registrations were in publicly available records as well. The Complainant submits that the Respondent would have registered the Domain Names with full knowledge of the Complainant’s prior rights in the “ALIBABA” mark.
- (b) The Respondent is listed as an “Alibaba.com Member” and is allowed to post information about itself and its goods and services on the Complainant’s website at www.alibaba.com. The Respondent registered as a free member at www.alibaba.com since as early as 2000, which prior to the registration of the Domain Names.
- (c) The Respondent had full knowledge of the Complainant’s prior rights in the “ALIBABA” mark but failed to seek consent from the Complainant to register the Domain Name.

5.1.13 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 name or 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.

- (a) As an “alibaba.com member”, the Respondent advertised its products on the alibaba.com’s online platform and claimed to be the sole manufacturer and master distributor of the Anti-Burglar Security Interlocking System. Similar products are advertised on the Respondent’s website which can be accessed through the Domain Name “alibaba.com.sg”. By doing so, the Respondent is clearly attempting to create confusion among consumers by creating the belief that “alibaba.com.sg” and the goods and services offered are associated with “alibaba.com”.
- (b) The Respondent is indisputably aware of the Complainant being the registrant of the domain name “alibaba.com”. The Respondent, by the mere act of registration of the Domain Names, has clearly attempted to ride on the well-known reputation and goodwill of the Complainant.

5.2 *The Respondent*

5.2.1 The Respondent contends as follows:

5.2.2 The name “Alibaba” derives from a fable. The name “Alibaba” is different from “ALIBABA.COM”. The Complainant had registered “ALIBABA.COM” as trade marks in Singapore in Classes 35 and 42 on 14 October 1999 with a Priority Date claim of 29 July 1999.

5.2.3 The Respondent had also set up a Google group on 8 September 2005 with the Chinese name “阿里巴巴防盜技术” which is used by the Respondent to promote its patented

product, an “Anti-Burglar Security Interlocking System”. The Respondent’s invention is not in the same class of goods or services for which the Complainant has registered its trademark.

- 5.2.4 When the Singapore Network Information Centre open registration for the <.sg> Domain Name, the Complainant was given an opportunity during the priority period for all registered trademark holders, well-known mark holders and existing registrants to apply for a domain name with the “.sg” extension in 2007. However, the Complainant did not do so. Based on the “first-come-first-serve” basis, the Respondent registered “alibaba.sg”.
- 5.2.5 Only two of the Complainant’s trade marks, T9911525Z and T9911526H were registered before the Respondent’s use of the Domain Names since 23 November 2001.

6. Discussion and Findings

6.1 Under paragraph 4a of the Policy, the Complainant must establish the following three conditions to be entitled to the remedy under paragraph 4i of the Policy of a transfer of a domain name:

- 6.1.1 the registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights;
- 6.1.2 the registrant has no rights or legitimate interests in respect of the domain name; and
- 6.1.3 the registrant's domain name has been registered or is being used in bad faith.

6.2 *Identical/Similar to Name/Mark in Which Complainant Has Rights*

6.2.1 With respect to the first condition to be met under paragraph 4a(i) of the Policy, the Complainant must establish both of the following, namely, that:

- (a) the Complainant has rights in the name or mark "ALIBABA"; and
- (b) the Domain Name is identical or confusingly similar to the name or mark "ALIBABA".

6.2.2 *Complainant's Rights*

- (1) The Complainant has six (6) trade mark registrations and one (1) pending trade mark application in Singapore which consist of or incorporate the word “ALIBABA” as the distinctive and dominant component, as stated at paragraph 5.1.2 above.
- (2) Having expended substantial sums in promoting, publicising and advertising its “Alibaba” brand worldwide and in Singapore, the Complainant has, through its use, established a global presence, generating revenue of RMB 3.87 billion in 2009 as stated in paragraph 4.1.2 and 4.1.3. Consequently, the “Alibaba” name has become synonymous with the Complainant and the services it provides. The Respondent contends that the word “Alibaba” is generic and refers to the well-known fable sharing the same name. However, in view of the scale and global nature of the Complainant’s operations and “Alibaba” brand, such an argument is of little persuasive value in the present case.

- (3) The Complainant registered two of its six marks in Singapore in 1999, establishing its brand before the Respondent registered the Domain Names alibaba.com.sg and alibaba.sg in 2001 and 2007 respectively. Based on the fact of these prior registrations and in the absence of any evidence suggesting otherwise, the Panel finds that the Complainant has at the commencement of this Administrative Proceeding, rights in the name or mark "ALIBABA".

6.2.3 *Identical or Confusingly Similar*

- (1) The Panel accepts it as well established that the addition of gTLD and ccTLD suffixes need not be considered in determining identity or confusing similarity (see *VAT Holding AG v VAT.com* (WIPO Case No. D2000-0607) and *Croatia Airlines d.d. v Modern Empire Internet Ltd.* (WIPO Case No. D2003-0455) referred to in *McDonald's Corporation v Naturerise, Inc* (Case Number SDRP-2005/0001(F)) decided on 25 February 2005). Accordingly, the Panel finds the Domain Names "alibaba.sg" and "alibaba.com.sg" identical and/or confusingly similar to the Complainant's marks and domain(s).

6.2.4 The Panel is therefore of the view that the Complainant has satisfied the requirements of paragraph 4a(i) of the Policy that the Domain Names are identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.

6.3 *Rights or Legitimate Interests of Respondent*

6.3.1 On the second condition under paragraph 4a(ii) of the Policy, the Complainant is required to prove that the Respondent has no rights or legitimate interests in respect of the Domain Names. Pursuant to paragraph 4c of the Policy, the following in particular but without limitation, which if proved, shall demonstrate the Respondent's rights to or legitimate interests in the Domain Names for purposes of this second condition:

- (a) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services;
- (b) the Respondent has been commonly known by the Domain Name, even if it has acquired no trade mark or service mark rights; or
- (c) the Respondent is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

6.3.2 *Bona Fide Offering of Goods and Services*

The Respondent has not demonstrated use of or preparations to use the Domains for the purposes of a *bona fide* offering of goods or services. Accessing the website at the domain "alibaba.com.sg" simply results in re-direction to another website also belonging to and promoting the Respondent's own business, as stated at paragraph 5.1.8. The Panel has not received any submission or evidence whether the other domain name, "alibaba.sg" functions similarly or otherwise.

6.3.3 *Commonly Known by Domain Name*

The Respondent contends that it is associated with the word “Alibaba”, adducing evidence that it had in 2005, through the use of a Google group, promoted its own product (Anti-Burglar Security Interlocking System as stated in paragraph 4.2.2) using a mandarin transliteration of the word “Alibaba” (阿里巴巴防盗技术). However, this has little bearing on the present case considering that this is the only occasion in which the Respondent has used the name in conjunction with its own business. Other than this indirect use of the name “Alibaba”, no evidence has been submitted to show any other association or recognition of such association.

6.3.4 *Non-Commercial or Fair Use*

It is clear that the Respondent has not made non-commercial or fair use of the Domain Names. As stated in paragraph 5.1.13 and 6.3.2, it is apparent that the Respondent is using the Domain Names for commercial gain by diverting consumers to a website serving its own commercial ends.

6.3.5 The Panel accordingly finds that the condition under paragraph 4a(ii) of the Policy is also satisfied as the Respondent does not have any legitimate right or interest in the Domain Name, taking into account the above considerations discussed in paragraph 6.3 and in the absence of any other submission made or evidence provided by the Respondent on such right or interest in the Domain Names.

6.4 *Registration/Use of Domain Name in Bad Faith*

6.4.1 The third and final condition to be met under paragraph 4a(iii) of the Policy requires the Complainant to prove that the Domain Name has been registered or is being used in bad faith. The Policy clarifies at paragraph 4b that the following circumstances in particular but without limitation, if found to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (a) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trade mark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the registrant's out-of-pocket costs directly related to the domain name;
- (b) the registrant has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (c) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (d) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

6.4.2 *Registration or acquisition of the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant*

The evidence submitted by the Complainant at paragraph 5.1.11 show that the Respondent ceased to be a commercial entity as of 3 February 2007, yet continued to renew the Domain Names alibaba.sg and alibaba.com.sg annually. Considering that the Respondent has failed to account for its conduct in this particular instance, it is not unreasonable in the circumstances to arrive at a conclusion that the Respondent has continued to renew the Domain Names with the intention of transferring them to the Complainant or a third party for some valuable consideration in excess of the registrant's out-of-pocket costs directly related to the domain name. It is settled that such conduct constitutes bad faith registration and use for the purposes of paragraph 4(b)(iv) of the Policy. (see *J. Crew International, Inc. v crew.com* (WIPO Case No. D2000-0054) and *Government of Canada v David Bedford a.k.a. DomainBaron.com* (WIPO Case No. D2001-0470)).

6.4.3 *Attempting to attract, for commercial gain, internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location*

Firstly, in the light of submission of the Complainant set forth in paragraphs 5.1.12 and 5.1.13, the Respondent cannot deny being unaware of the domain alibaba.com, it is highly probable that the Respondent has attempted to divert unwitting internet users who have erroneously keyed-in the Domain Names to its own website (www.forza.com.sg).

Secondly, it is also probable that the Respondents attempted to create a likelihood of confusion with the Complainant's mark as to the source, affiliation or endorsement of their website. As submitted by the Complainant at paragraph 5.1.13, the fact that some of the products marketed and/or promoted on the website linked to the "forza" domain are marketed and/or promoted on the Complainant's business platform (alibaba.com) or in association with the name "Alibaba" is strongly indicative of such an intention. It is established that conduct with the aim of creating such confusion may amount to bad faith for the purposes of the Policy (*Yahoo! Inc v Data Art Corp* (WIPO Case No D2000-0587)).

6.4.4 For the reasons stated above, the Panel finds that the Domain Name has been registered or is being used in bad faith by the Respondent and that accordingly the condition under paragraph 4a(iii) of the Policy has also been satisfied.

7. **Conclusion**

In the premises, the Panel finds that the Complainant has established the three elements under paragraph 4a of the Policy and is therefore entitled to the remedy of a transfer of the Domain Names, "alibaba.sg" and "alibaba.com.sg" as provided under paragraph 4i of the Policy.

Jim Lim
Sole Panellist
12 July 2010