Decision for dispute CAC-UDRP-102743

Case number	CAC-UDRP-102743
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Domain names	baidufilm.com, bocaibaidu.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Baidu Online Network Technology (Beijing) Co., Ltd.

Complainant representative

Organization	Thomsen Trampedach GmbH

Respondent

Name	Suo Jun Zhong

OTHER LEGAL PROCEEDINGS

There are no other proceedings that the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant says it has registered over 1000 trade marks incorporating the word element “Baidu” both alone and together with figurative or logo/design elements inter alia, for services in class 42. It therefore has exclusive rights to the name “Baidu” from as early as 2007 and including Chinese national registrations: No. 4650377 BAIDU (with stylized design elements), registered on 14 May 2008, in class 12 and Chinese national registration No. 5916520 BAIDU, registered on 28 March 2010, in class 42.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is Baidu Online Network Technology (Beijing) Co., Ltd, the principal subsidiary of Baidu Inc., one of the largest AI and internet companies in the world. Since 2000, the Complainant has operated the web search engine <baidu.com>, which is the most popular search engine in China, and the fourth most popular search engine in the world.

In addition to their core search engine service, the Complainant also offers a wide range of products and services through mobile devices, PCs and other smart devices. These include the world's largest search based online Chinese language social

platform, the world's largest Chinese language interactive knowledge sharing platform, and the world's largest user-edited Chinese encyclopaedia, all marketed under the BAIDU trade mark.

The Complainant also offers other BAIDU-branded products, including Maps, Images, Videos, News, Navigation and Music. The Complainant also offers data analysis and advertising placement products and services.

Since 2014, “Baidu” has been one of the top 500 brands in the world. In 2016, Baidu Group ranked second among the 50 smartest companies in the world as selected by MIT Technology Review, higher than other technology developers and second only to Facebook. By May 2018, the Complainant’s website <baidu.com> was listed as the fourth most visited website on Alexa Internet ranks globally and the most visited in China. It gained a 12.3% market share of the search engine market worldwide.

In 2015, the Complainant’s operating income exceeded 60 billion CNY. That “Baidu” is a well-known brand and business name is beyond doubt.

The Disputed Domain Names were registered on 10 September 2019 and 19 December 2018 respectively. Nothing is known of the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that each of the factors in paragraph 4 (a) of the Policy are established as follows:

a. The domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

While not identical. the Disputed Domain Names are confusingly similar to Complainant’s BAIDU Marks.

It is well established that the test of identity or confusing similarity will not be related to the addition of the gTLD suffix “.com”. See the WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition (“WIPO Overview 3.0”) at 1.11.1. In this complaint, therefore only <baidufilm> and <bocaibaidu> are to be tested.

“Baidu” is the most important trademark owned by the Complainant, and it is well-known globally. It is beyond dispute that the trade marks were registered earlier than the registration date of the Disputed Domain Names (10th September 2019 and 19th December 2018). See the registration dates.

The Disputed Domain Names are combinations of “baidu” and “film” and “bocai” and “baidu” respectively. It must therefore be examined whether the addition of “film” and “bocai” has an impact on whether the Disputed Domain Names are confusingly similar to the Baidu trade mark. In this regard, it has been consistently held by previous panels that where the relevant mark is recognisable within the Disputed Domain Name, the addition of other terms (including descriptive terms) does not prevent a finding of confusing similarity. See the WIPO Overview 3.0 at 1.8. The word “film” is undoubtedly descriptive, and it must therefore be concluded that its incorporation does not prevent “baidufilm” from being found to be confusingly similar to the Complainant’s trademark. “Bocai” can in its phonetic form be interpreted to mean both “spinach” and “gambling” in Chinese. It is thus also a descriptive term, the addition of which does not prevent a finding of confusing similarity of <bocaibaidu.com> with the Baidu trademark, which remains recognisable.

For the foregoing reasons the Disputed Domain Names are confusingly similar to the Complainant’s trade mark “baidu” in accordance with Paragraph 4(a)(i) of the Policy.

b. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2)).

The Complainant submits that the Respondent has no rights or legitimate interests in the Disputed Domain Names.

As mention above, the Complainant has the exclusive right to the trade mark “baidu”, rights established prior to the Respondent’s registration of the Disputed Domain Names.

The Respondent is not a licensee of the Complainant, nor has he been otherwise granted permission by the Complainant to make any use of the Baidu trade marks whatsoever.

Trademark registration searches on www.wsjs.saic.gov.cn, the website of the Trademark Office of National Intellectual Property Administration, PRC, showed that the Respondent has neither registered nor applied for any trademark identical to “bocaibaidu”, “bocaifilm”, “baidu” or including the term “baidu”.

Further, the Respondent does not make use of the Disputed Domain Names to provide any goods or services with “baidufilm” or “bocaibaidu” as their business name, and he is not well-known amongst consumers by the Disputed Domain Names but by their own name.

The Disputed Domain Names both currently direct the user to a “502 Bad Gateway” error pages. The Respondent cannot claim that this constitutes a bona fide offering of goods or services.

Further, it should be noted that the very fact the Respondent is not making use of the domains for any discernible purpose is a strong evidence that they lack rights and legitimate interests in the disputed domain names. See e.g. WIPO Case No. D2017-0246 docmartens.xyz.

Finally, given the renown and popularity of the Complainant's “baidu” trademark worldwide, it is simply not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain Names by the Respondent that would not create a false association with the Complainant, thereby resulting in a misleading diversion or taking unfair advantage of the Complainant's rights.

Therefore, the Respondent has no rights or legitimate interests in the Disputed Domain Names, in accordance with paragraph 4(a)(ii) of the Policy.

c. The domain name(s) was/were registered and is/are being used in bad faith. (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3)).

The Disputed Domain Names were both registered during or after the year 2018 i.e. significantly later than the Complainant’s registrations of the trade mark “baidu”, and later than the time the Complainant became a famous brand and trade name in China and elsewhere because of its well-known business.

Given the Complainant's renown and goodwill in Chinese society, the “Baidu” name is inseparable from the Complainant. In 2018, it would be inconceivable for the Respondent, who is based in China, to argue that he did not have knowledge of the Complainant and its trademark “Baidu”, or that he randomly selected the terms at the time of registration of the Disputed Domain Names.

The Complainant therefore submits that the Respondent had the Complainant in mind and deliberately registered the Disputed Domain Names containing the trademark “Baidu”.

The Disputed Domain Names do not resolve to any active websites and generates an error 502 page. This error is a general indication that there is something wrong with a website’s server communication. The presence of this error is an indication

that the domain is being used for concealed, or even illegitimate, activity that may be available to some internet users and unavailable to others.

The lack of content can be interpreted as passive holding, demonstrating that the Respondent has no serious intent of using the Disputed Domain Names for a legitimate offer of goods or for a legitimate non-commercial use. This type of use must be seen as being conducted in bad faith under the passive holding doctrine. See WIPO Overview 3.0 at 3.3.

Further, the use of the Disputed Domain Names to display an error page may lead to consumer confusion in that consumers may be led into thinking that the Complainant is in fact linked to the Disputed Domain Names but neglects its online communications, thereby disrupting the Complainant's online brand image.

Lastly, it is also clear that the Respondent has engaged in a pattern of conduct preventing the Complainant from reflecting the Baidu mark in domain names. Previous panels deciding under the Policy have held that establishing a pattern of bad faith conduct requires as few as two instances of abusive domain name registrations, registered on two different occasions. See the WIPO Overview 3.0 at 3.1.2. The Disputed Domain Names were registered on 10 September 2019 and 19 December 2018 respectively, thereby fulfilling the requirements of a bad faith pattern targeting the Complainant's marks. See the registration dates.

In sum, the Complainant asserts that there can be no doubt of bad faith in the registration and use of the Disputed Domain Names in accordance with paragraphs 4(a)(iii), 4(b) of the Policy.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

There is no question that the Complainant has rights in a mark confusingly similar to the Disputed Domain Names. The Complainant owns a very substantial portfolio of registered marks internationally, particularly in its primary, and home market, China. Indeed, the Complainant's mark is a well-known or famous mark –and this is relevant to the other limbs below. In terms of the similarity analysis, the Disputed Domain Names each combine the Complainant's word mark with a descriptive or generic term. These are "Film" in "Baidufilm" and "Bocai" in "bocaibaidu." Film –it has the same ordinary meaning as in English. Bocai – means in Chinese either "Spinach" or "Gambling." We will take the Gambling meaning –as this is the one likely intended. The addition of these descriptive or generic terms offering entertainments does not prevent a finding of similarity –even when the descriptive term precedes the mark, as in "bocaibaidu." Although we know that

consumers pay more attention to the start of a name or mark, than the end –this is displaced here, by the fame of the mark. It is well established that the suffix is ignored for the identity or similarity analysis. However, the fact that the ".com" or commercial gTLD was selected may be relevant to the other limbs of the Policy below. While identity is a strict test and is not met, the Disputed Domain Names are confusingly similar to the Complainant's trade mark in accordance with Paragraph 4(a)(i) of the Policy.

As to the second Policy limb, the Panel look to see whether there was a fair or legitimate reason for the use of the confusingly similar names. Here, the parties have no connection and there is no licence or consent. If the Disputed Domain Names use common words or descriptive terms that are also in a mark, we look at whether their primary or secondary meaning is referenced—as everyone is free to use ordinary and common dictionary words in their normal or primary sense. No evidence was submitted here of a common or dictionary meaning of "Baidu." Online research by the Panel also indicates "Baidu" does not mean anything in Chinese. It may be a made-up term. If so, it appears to have been selected to reference the Complainant. The Disputed Domain Names do not resolve either and so there is only passive holding and there are no goods or services of the Complainant being resold or discussed. Although the fact the Respondent is not making use of the domains for any discernible purpose is indicative of a lack of rights and legitimate interests, see WIPO Case No. D2017-0246 (docmartens.xyz) – it is not determinative. However here, for the reasons given, and the lack of any showing or other obvious grounds for fair and legitimate use and in light of the fame of the mark; a false association with the Complainant arises and unfair advantage or free-riding on the Complainant's rights is made out. Therefore, the Respondent has no rights or legitimate interests in the disputed domain names, in accordance with paragraph 4(a)(ii) of the Policy.

As to Bad Faith, by 2018, when the Disputed Domain Names were registered, the Respondent, who is based in China, would have had certain knowledge of the Complainant and its well-known trade mark "Baidu." Due to its fame, it could not be otherwise. The Respondent must have had the Complainant in mind when he deliberately registered the Disputed Domain Names containing the trade mark. Without any fair or legitimate reason, he can only have done so to free-ride on the Complainant's goodwill and reputation. The Respondent has not come forward to provide another explanation. In these circumstances, a finding of Bad Faith will often follow –as it does here. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Under the Policy, establishing a pattern of bad faith conduct requires as few as two instances of abusive domain name registrations, registered on two different occasions. See the WIPO Overview 3.0 at 3.1.2. Here, the Disputed Domain Names were registered on 10 September 2019 and 19 December 2018 respectively, thereby fulfilling the requirements of a Bad Faith pattern targeting the Complainant's marks.

The Panel finds Bad Faith in the registration and use of the Disputed Domain Names in accordance with paragraphs 4(a)(iii), 4(b) of the Policy and a pattern of Bad Faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BAIDUFILM.COM**: Transferred
2. **BOCAIBAIDU.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2019-12-04

Publish the Decision