Decision for dispute CAC-UDRP-106556

Case number	CAC-UDRP-106556
Time of filing	2024-05-27 09:13:26
Domain names	xiaomilovers.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Xiaomi Inc.

Complainant representative

Organization	CSC Digital Brand Services Group AB

Respondent

Name	Touchchaphol Cherdchaisripong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Xiaomi Inc. (“Xiaomi” or “Complainant”) is the owner of various registrations for the trademark “XIAOMI” on a worldwide basis through international registrations, and, inter alia, the USA. The most relevant trademark registrations to this matter are:

- XIAOMI (WIPO Reg. No. 117761) registered on Nov. 28, 2012;
- XIAOMI (WIPO Reg. No. 1313041) registered on Apr. 14, 2016;
- XIAOMI (Chilean Reg. No. 1115836) registered on Jan. 24, 2014;
- XIAOMI (US Reg. No. 4527605) registered on May 13, 2014;
- XIAOMI (Thailand Reg. No. ม73040) registered on June 13, 2016;
- XIAOMI (Thailand Reg. No. 171122155) registered on July 14, 2017;
- MI (WIPO Reg. No. 1173649) registered on Nov. 28, 2012.

Complainant’s main website is located at its primary domain name, <mi.com>, which it gained control of on April 21, 2014.

FACTUAL BACKGROUND

Complainant was founded in April 2010 and listed on the Main Board of the Hong Kong Stock Exchange on July 9, 2018. Xiaomi is a consumer electronics and smart manufacturing company with smartphones and smart hardware connected by an Internet of Things platform at its core. In these 13 years, Complainant has grown to become one of the leading providers of innovative technology worldwide.

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. Complainant has a #3 global market share ranking in smartphones. Complainant's global user base exceeds 594 million, with an estimated 618 million IoT connected devices. In the first quarter of Fiscal Year 2023, Complainant achieved a revenue of RMB 59.5 billion and an adjusted net profit of RMB 3.2 billion.

Complainant maintains a strong internet presence, communicating with its large customer base and promoting its inventive products through its website and social media profiles. Complainant's main website is located at its primary domain name, <mi.com>, which it gained control of on April 21, 2014. SimilarWeb has ranked it the 1,038th most popular website globally, and the 79th in China, with an estimated 44.8 million individual visitors in March 2024 alone. Moreover, Complainant has 15 million Facebook followers and likes; 4.4 million Twitter followers; and 4.6 million Instagram followers.

The Disputed Domain Name registered in 2015 has been used for a web site purporting to sell the Compainant's products, using the Complainant's MI logo as a masthead and the Complainant's orange and white trade dress, but also selling products not manufactured by the Complainant.

PARTIES CONTENTIONS

The Disputed Domain Name is 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))

By virtue of its trademark and service mark registrations, Complainant is the owner of XIAOMI trademarks.

The Disputed Domain Name can be considered as capturing, in its entirety, Complainant's XIAOMI trademark and simply adding the generic term "Lovers" to the end of the trademark. The mere addition of this generic term to Complainant's trademark does not negate the confusing similarity between the Disputed Domain Name and the Complainant's trademark under Policy paragraph 4(a)(i), and the Disputed Domain Name must be considered confusingly similar to Complainant's trademark. It is well established that the addition of generic or descriptive terms is not sufficient to overcome a finding of confusing similarity pursuant to Policy paragraph 4(a)(i). See WIPO Jurisprudential Overview 3.0 at 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.").

The Respondent has no Rights or Legitimate Interests in Respect of the Disputed Domain Name

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

Respondent is not sponsored by or affiliated with Complainant in any way. Furthermore, Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademarks in any manner, including in domain names. "In the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the Disputed Domain Name could reasonably be claimed." See Sportswear Company S.P.A. v. Tang Hong, D2014-1875 (WIPO Dec. 10, 2014).

In the instant case, the pertinent Whois information identifies the Registrant as , Touchchaphol Cherdchaisripong which does not resemble the Disputed Domain Name in any manner. Thus, where no evidence, including the Whois record for the Disputed Domain Name, suggests that Respondent is commonly known by the Disputed Domain Name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the Disputed Domain Name within the meaning of ¶ 4(c)(ii). See Moncler S.p.A. v. Bestinfo, D2004-1049 (WIPO, Feb. 8, 2005) (in which the panel noted "that the Respondent's name is "Bestinfo" and that it can therefore not be "commonly known by the Domain Name" [moncler.com]").

Furthermore, at the time of filing the complaint, Respondent was using a privacy WHOIS service, which past panels have also found to equate to a lack of legitimate interest. See Jackson National Life Insurance Company v. Private WhoIs wwwjacksonnationallife.comN4892, D2011-1855 (WIPO Dec. 23, 2011) ("The Panel concludes that the Respondent possesses no entitlement to use the name or the words in the Complainant's marks and infers […] from the "Private Whois" registration that it is not known by such name. There is no evidence of the Respondent ever being commonly known by the name or words now included in the disputed domain name.").

Respondent is not making a bona fide offering of goods or services or legitimate, noncommercial fair use of the Disputed Domain Name. Respondent's inclusion of the Complainant's official MI logo on the Disputed Domain Name's website as well as its favicon is a direct effort to take advantage of the fame and goodwill that Complainant has built in its brand, and Respondent is not only using the confusingly similar Disputed Domain Name, but is also imitating Complainant by displaying the Complainant's logo. This imitation is referred to as "passing off," and "Respondent, in [also] using [a] confusingly similar domain name to mislead Complainant's customers, is not making a bona fide offering of goods and services pursuant to Policy paragraph 4(c)(i) or a legitimate noncommercial or fair use of the domain name pursuant to Policy paragraph 4(c)(iii)." See Houghton Mifflin Co. v. Weatherman, Inc., D2001-0211 (WIPO Apr. 25, 2001) (no bona fide offering where website's use of Complainant's logo…suggested that website was the official Curious George website).

Further, the Respondent is using the Disputed Domain Name to direct internet users to a website that features the orange and white color scheme widely associated with Complainant, all as a means of deceiving internet users into believing that the website is associated with Complainant. As past Panels have held, Respondent's attempt to pass the domain name off as the Complainant is in itself evidence of the fact that Respondent does not have rights and legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii). See Herbalife International Inc. v. Perfect Privacy, LLC. / Rafaela Robles, D2016-0811 (WIPO, July 5, 2016) (The look and feel of the Respondent Website and the Complainant Website are very similar, using the same colour scheme and similar or identical images […] The Respondent is clearly trying to pass itself off as the Complainant, and does not attempt to distinguish itself or to explain its alleged relationship with the Complainant). See also Groupe Partouche v. Madarin Data LTD, Pousaz Raymond, D2010-1649 (WIPO, Nov.15, 2010) (the Respondent has used the disputed domain name for a website […] whose look and feel to a very high degree resembles the look and feel of the Complainant's official website. The Respondent thus, in the Panels' view, could not credibly claim that the disputed domain name is intended to be used for any legitimate purpose or interest).

It is important to point out that in the current case, the Respondent is not an authorized reseller. Although Panels may find that resellers or distributors using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may have a legitimate interest in such domain name, the "Oki Data test", which was devised to ascertain if a Respondent is making a bona fide offering requires the following cumulative conditions to be met:

(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.

In the present case, Respondent has failed to meet the criteria stipulated above. Firstly, Complainant is unable to ascertain the authenticity of the goods offered at the Disputed Domain Name's website. Secondly, there is no visible disclaimer on the Disputed Domain Name's website to clarify that the website is not endorsed or sponsored by the Complainant to explain the non-existing relationship with the trademark holder. Rather, the Respondent's use of the official MI logo throughout its website and favicon is likely to cause consumer confusion about the source of the Disputed Domain Name and its website. Lastly, the Disputed Domain Name's website is offering for sale products that are not manufactured by the Complainant.

Respondent registered the Disputed Domain Name on June 2, 2015, which is after Complainant's trademark registrations with WIPO, INPI and INAPI. This date also postdates the dates at which Complainant gained control of its domain names, <mi.com>, on April 21, 2014, and <xiaomi.com>, on March 11, 2013. By the time Respondent registered the Disputed Domain Name, Complainant already had a worldwide reputation in its trademark, which is fully adopted in the Disputed Domain Name. Therefore, it is evident that the Disputed Domain Name carries a high risk of implied affiliation with Complainant which cannot be considered a fair use of the Disputed Domain Name (see WIPO Jurisprudential Overview 3.0, section 2.5.1).

For the reasons set out above, it is clear from Respondent's use of the Disputed Domain Name that the sole intention is to mislead internet users as to its affiliation with Complainant and to trade off Complainant's rights and reputation by appearing to be connected to Complainant. Nothing on the website hosted on the Domain Name indicates to online users that the Disputed Domain Name is not affiliated with Complainant. Therefore, Complainant submits that Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Disputed Domain Name was Registered and is Being Used in Bad Faith

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

Complainant and its MI and XIAOMI trademarks are known internationally, with trademark registrations across numerous countries. Complainant has marketed and sold its goods and services using this trademark since 2010, which is well before Respondent's registration of the Disputed Domain Name on June 2, 2015.

By registering a domain name that comprises Complainant's XIAOMI trademark in its entirety with the mere addition of the generic term "Lovers", Respondent has created a domain name that is confusingly similar to Complainant's trademark, as well as its domain name <xiaomi.com>. As such, Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business. Moreover, the fact that Respondent is using the Disputed Domain Name to offer XIAOMI products for sale reflects their awareness of the XIAOMI brand and trademarks. In light of the facts set forth within this Complaint, it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brands at the time the Disputed Domain Name was registered. See Telstra Corp. Ltd. v. Nuclear Marshmallows, D2000-0003 (WIPO Feb. 18, 2000). The XIAOMI trademark is so closely linked and associated with Complainant that Respondent's use of this mark, or any minor variation of it, strongly implies bad faith – where a domain name is "so obviously connected with such a well-known name and products, […] its very use by someone with no connection with the products suggests opportunistic bad faith." See Parfums Christian Dior v. Javier Garcia Quintas, D2000-0226 (WIPO May 17, 2000). Further, where the Disputed Domain Name incorporates Complainant's XIAOMI trademark, and especially considering Respondent's use of the Disputed Domian Name, "it defies common sense to believe that Respondent coincidentally selected the precise domain without any knowledge of Complainant and its trademarks." See Asian World of Martial Arts Inc. v. Texas International Property Associates, D2007-1415 (WIPO Dec. 10, 2007).

As aforementioned, the Disputed Domain Name is connected with an unauthorized commercial website offering XIAOMI products. Complainant's logo is prominently displayed on the website, as well as on its favicons, contributing to create a confusing similarity with Complainant. Consequently, Respondent is using the Disputed Domain Name to intentionally attempt to attract Internet users to a website for commercial gain, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website. See Policy paragraph 4(b)(iv). Respondent has clearly created a likelihood of confusion with Complainant and is then attempting to profit from such confusion by offering Complainant's products for sale, as well as those of competitor brands. As such, Respondent is attempting to cause consumer confusion in a nefarious attempt to profit from such confusion. The impression given by the Disputed Domain Name and its website would cause consumers to believe the Respondent is somehow associated with Complainant when, in fact, it is not. Respondent's actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name, and Respondent is thus using the fame of Complainant's trademarks to improperly increase traffic to the website listed at the Disputed Domain Name for Respondent's own commercial gain. It is well established that such conduct constitutes bad faith. See Xiaomi Inc. v. Renzo Cruz, D2023-3045 (WIPO, Sep. 11, 2023) (Panel finding bad faith where "the website at the Domain Name has been designed to look like a website of an official or authorized reseller of Complainant's products in Peru. Respondent's website prominently displays Complainant's XIAOMI trademark [and] offers for sale the purported Complainant's goods and third party products".

Respondent's use of the Disputed Domain Name constitutes a disruption of Complainant's business and qualifies as bad faith registration and use under Policy paragraph 4(b)(iii) because the Disputed Domain Name is confusingly similar to Complainant's XIAOMI trademark and the Disputed Domain Name's website is being used to offer Complainant's goods(though Complainant is unable to ascertain the authenticity of the products on offer), without Complainant's authorization or approval, as well as products of competitor brands. Past Panels have confirmed that using a confusingly similar domain name to mislead consumers and then offering a complainant's goods or services or competitors' products is evidence of bad faith registration and use. See Philipp Plein v. Domain Admin, Whois Privacy Corp., D2016-1519 (WIPO Sept. 12, 2016) (Respondent acted in bad faith by registering the disputed domain name to disrupt the Complainant's relationship with their customers or potential customers and/or to attempt to attract Internet users for commercial gain. Respondent purported to sell Philipp Plein products, without Complainant's authorization, from the website to which the disputed domain name resolves).

Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity, which past panels have held serves as further evidence of bad faith registration and use. See Dr. Ing. H.C. F. Porsche AG v. Domains by Proxy, Inc., D2003-0230 (WIPO May 16, 2003). See also WIPO Jurisprudential Overview 3.0 at 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.").

The Respondent has ignored Complainant's attempts to resolve this dispute outside of this administrative proceeding. Past panels have held that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith registration and use of a domain name. See Encyclopedia Britannica v. Zuccarini, D2000-0330 (WIPO June 7, 2000) (failure to positively respond to a demand letter provides "strong support for a determination of 'bad faith' registration and use").

Finally, on balance of the facts set forth above, it is more likely than not that Respondent knew of and targeted Complainant's trademark, and Respondent should be found to have registered and used the Disputed Domain Name in bad faith. See Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc., D2014-1754 (WIPO Jan 12, 2014) ("the Panel makes its finding regarding bad faith registration by asking whether it is more likely than not from the record of the evidence in the proceeding that Respondent had the ELECTRIC FOOTBALL trademark in mind when registering the Domain Name.").

Respondent

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name is 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 Name (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 Name has been registered and is 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

The Disputed Domain Name registered in 2015 consists of the Complainant's XIAOMI mark (registered, inter alia, in 2012 as an international registration for software), the generic term "lovers" and the gTLD .com.

Adding a generic term and a gTLD does not prevent confusing similarity between the Complainant's XIAOMI mark and the Disputed Domain Name.

Respondent is not commonly known by the Disputed Domain Name or authorised by Complainant.

The Disputed Domain Name has been used for a site using Complainant's MI logo as a masthead and Complainant's orange and white trade dress to purports to sell Complainant's products but which also offers products which are not manufactured by Complainant and does not explain that there is no relationship between Respondent or Respondent's site and Complainant. This use is confusing and appears designed to cause the impression that the Respondent's web site is the web site of, or authorised by, Complainant and, is, therefore, not a bona fide offering of goods or services. The use is commercial so is not legitimate non commercial or fair use.

The use of Complainant's logo and trade dress shows that Respondent is aware of Complainant and Complainant's rights business and services. Respondent has intentionally diverted and confused Internet users for commercial gain in a manner likely to disrupt Complainant's business which is registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **xiaomilovers.com**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2024-06-21

Publish the Decision