Decision for dispute CAC-UDRP-106286

Case number	CAC-UDRP-106286
Time of filing	2024-05-22 09:19:44
Domain names	xiaomicolombia.co

Case administrator

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

Complainant

Organization	Xiaomi Inc.

Complainant representative

Organization	CSC Digital Brand Services Group AB

Respondent

Organization	Celulares Tienda Radar

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it owns "various registrations for the trademark 'XIAOMI' on a worldwide basis," including WIPO Reg. No. 1,177,611 (registered November 28, 2012), designating Colombia; WIPO Reg. No. 1,313,041 (registered April 14, 2016), designating Colombia; Chilean Reg. No. 1,115,836 (registered January 24, 2014); and U.S. Reg. No. 4,527,605 (registered May 13, 2014). These registrations are referred to herein as the "XIAOMI Trademark."

FACTUAL BACKGROUND

Complainant states that it is "a consumer electronics and smart manufacturing company with smartphones and smart hardware connected by an Internet of Things platform at its core"; that it was founded in April 2010 and listed on the Main Board of the Hong Kong Stock Exchange on July 9, 2018; that its "range of products includes phones, smart home devices including vacuums or kitchen appliances, and lifestyle goods such as smart watches or electric scooters"; that its "strength is reflected in #3 global market share ranking in smartphones"; that "Complainant's global user base exceeds 594 million, with an estimated 618 million IoT connected devices"; and that "[i]n 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."

The Disputed Domain Name was created on August 12, 2002, and, according to Complainant, "Respondent is using the Disputed Domain Name to a website where it displays the official MI logo in relation to the sale of XIAOMI products, the authenticity of which

Complainant is unable to ascertain at present." An annex provided by Complainant confirms this.

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the Disputed Domain Name is confusingly similar to the XIAOMI Trademark because, inter alia, "Panels have consistently held that a disputed domain name that consists merely of a complainant's trademark and an additional term that closely relates to and describes that complainant's business is confusingly similar to that complainant's trademarks"; "Respondent has added the generic, geographical term 'Colombia' to Complainant's XIAOMI trademark, thereby making the Disputed Domain Name confusingly similar to Complainant's trademark"; "[t]he fact that such term is closely linked and associated with Complainant's brand and trademark only serves to underscore and increase the confusing similarity between the Disputed Domain Name and the Complainant's trademark" and "Colombia is one of the numerous countries where Complainant operates and promotes its wide range of products through its official distributors and partners."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent is not sponsored by or affiliated with Complainant in any way"; "Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademarks in any manner, including in domain names"; "the pertinent Whois information discloed by the registrar via CAC identifies the Registrant as 'Fabian Dario Rada, Celulares Ti enda Radar', which does not resemble the Disputed Domain Name in any manner"; "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"; "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"; "Respondent is not an authorized reseller"; and Respondent has failed to meet the criteria for resellers as set forth in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903.

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, "the Disputed Domain Name is connected with an unauthorized commercial website offering XIAOMI products" and "Complainant's logo is prominently displayed on the website, as well as on its favicons, contributing to create a confusing similarity with the Complainant" and, therefore, "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"; "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 ¶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"; "Respondent has ignored Complainant's attempts to resolve this dispute outside of this administrative proceeding" by not responding to an email sent on April 18, 2024.

Although no administratively compliant response has been filed, Respondent sent multiple emails in this proceeding, one stating: "I bought the domain in question and he told me that of course yes, that the domain was the property of whoever bought it. It is worth mentioning that in the same way I am no longer dedicated to the marketing of products, so I am willing to agree to your request to transfer." In another email, Respondent stated: "I have already dismantled the website which is no longer operating." Respondent also submitted two signed settlement forms, one of which stated that the Disputed Domain Name should be cancelled, the other of which stated that the Disputed Domain Name should be transferred to Complainant. The case file does not contain any indication from Complainant that it accepted either version of the settlement agreement and, instead, Complainant submitted a statement that "we would like to reinstate the current UDRP proceeding."

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 UDRP).

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 UDRP).

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 UDRP).

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.

The Panel notes that although Respondent has consented to the transfer remedy requested by Complainant, Complainant has refused to accept the settlement agreement and instead has indicated that it wants this proceeding to continue. As set forth in section 4.10 of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits… where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision."

PRINCIPAL REASONS FOR THE DECISION

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the XIAOMI Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the XIAOMI Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "xiaomicolombia") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains the XIAOMI Trademark in its entirety, simply adding the geographic word "Colombia". As set forth in section 1.8 of WIPO Overview 3.0: "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."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent is not sponsored by or affiliated with Complainant in any way"; "Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademarks in any manner, including in domain names"; "the pertinent Whois information discloed by the registrar via CAC identifies the Registrant as 'Fabian Dario Rada, Celulares Ti enda Radar', which does not resemble the Disputed Domain Name in any manner"; "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"; "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"; "Respondent is not an authorized reseller"; and Respondent has failed to meet the criteria for resellers as set forth in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903."

WIPO Overview 3.0, section 2.1, states: "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."

The Panel finds that Complainant has established its prima facie case and, without any evidence from Respondent to the contrary (indeed, Respondent has consented to a transfer of the Disputed Domain Name), the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for

valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the 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.

Section 3.1.4 of WIPO Overview 3.0 states, "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark:… seeking to cause confusion… for the respondent's commercial benefit, even if unsuccessful." Here, it appears that the XIAOMI Trademark is widely known, given the scope and length of Complainant's registrations and the scale and reach of its business. Further, by offering for sale on its website the same products that are associated with the XIAOMI Trademark, and without any indication that Respondent is a reseller (indeed, Respondent has agreed to transfer the Disputed Domain Name to Complainant), Respondent's actions are likely to cause confusion and, therefore, constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **xiaomicolombia.co**: Transferred

PANELLISTS

Name	**Douglas Isenberg**

DATE OF PANEL DECISION 2024-06-28

Publish the Decision