Decision for dispute CAC-UDRP-107133

Case number	CAC-UDRP-107133
Time of filing	2024-12-05 14:03:07
Domain names	xiaomistores.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Xiaomi Inc

Complainant representative

Organization	CSC Digital Brand Services Group AB

Respondent

Name	noonecoa noonecoa

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, including Russia (through its international registrations) and the USA. The most relevant trademark registrations to this matter are:

XIAOMI (PH Reg. No. 4-2012-6779) registered on Feb. 13, 2014;
XIAOMI (PH Reg. No. 4-2012-6780) registered on Feb. 27, 2014;
MI (PH Reg. No. 4-2012-6500) registered on Apr. 15, 2012;
XIAOMI (WIPO Reg. No. 1177611) registered on Nov. 28, 2012;
XIAOMI (WIPO Reg. No. 1313041) registered on Apr. 14, 2016;
MI (WIPO Reg. No. 1173649) registered on Nov. 28, 2012.

FACTUAL BACKGROUND

Xiaomi is a Chinese consumer electronics company that designs, manufactures, and sells smartphones, smart hardware, home appliances, and other products.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant states that the disputed domain name <xiaomistores.com> is confusingly similar to its trademark XIAOMI. Indeed, the domain name incorporates the trademark in its entirety with the addition of the word “stores” which creates the overall impression of the designation as being connected to Complainant’s line of products. "Stores" reinforces the association with the Complainant and fosters the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its associated domain names.

The Complainant states further that prior to the filing of this Complaint, the Respondent made use of the sub-domain https://huangruohong.xiaomistores.com of the disputed domain name which contributes to the confusion. The Respondent was apparently using the sub-domain to resolve to a website that displays the Complainant’s official MI logo and purports to offer XIAOMI branded products for sale, the authenticity of which the Complainant states it is unable to confirm at present. As shown in the Complainant's submitted evidence, the disputed domain name resolves or at that time resolved d to a website impersonating the Complainant.

The Complainant states further that the registration of <xiaomistores.com constitutes a fraudulent scheme of impersonation by which the Respondent it taking advantage of Complainant and consumers by posing as an official XIAOMI store offering for sale, potentially counterfeited Xiaomi products.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Pursuant to Paragraph 4(a) of the Policy the Complainant is required to prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

(ii) respondent has no rights or legitimate interests in respect of the domain name; an

(iii) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations and adduced proof pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint and annexes as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, WIPO Case No. D2000-0009 (WIPO February 29, 2000) ("In the absence of a response, it is appropriate to accept as true all [reasonable] allegations of the Complaint.").

Identical or Confusingly Similar to a Mark in which Complainant has a Right:

To succeed under the first element, a complainant must pass a two-part test by first establishing that it has rights, and thereafter that the disputed domain name is either identical or confusingly similar to the mark. The first element of a UDRP complaint “serves essentially as a standing requirement.” Here, the Complainant has established that it has rights in the word mark XIAOMI by providing the Panel with the evidence that it has numerous registrations in many jurisdictions for its mark. The consensus view which the Panel adopts is that a national or an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established that it has a right in the word mark XIAOMI. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0 at 1.2.1 (“Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.”).

The second part of the test calls for comparing the Complainant’s mark with the disputed domain name entails “a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark." See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin; WIPO Overview 3.0 at section 1.7.

The Panel observes that the single difference in this case is the addition of the word “stores”. Where the relevant trademark is recognizable within the disputed domain name it is sufficient to establish confusing similarity. The addition of the word "stores" rather enhances the confusing similarity because it is through stores that the Complainant offers it XIAOMI products. The top level domain does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant in determining the confusing similarity between XIAOMI and <xiaomistores.com>. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. (“It is also well established that the specific top level of a domain name such as ‘.com’, ‘.org’ or ‘.net’ does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.”).

Accordingly, Complainant has satisfied Paragraph 4(a)(i) of the Policy.

Determining Whether Respondent Lacks rights or legitimate interests in the disputed domain name:

To establish the second of the three elements, the Complainant must first demonstrate that Respondent lacks rights and legitimate interests in the disputed domain name. Recognizing that the proof for establishing this element is under the Respondent's control, the Complainant may satisfy this burden by offering a prima facie case based on such evidence as there is, thus shifting the burden to the Respondent to produce evidence to overcome the presumption that it lacks rights or legitimate interests in the disputed domain name. See Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it did not authorize the Respondent to register the disputed domain name, the Respondent is not using the disputed domain name for any bona fide use, nor can it claim to be known by the name " XIAOMI " as the Registrar disclosed personal name is noonecoa and also the same word is used for the surname. For the reasons further noted below this name is most certainly a nonsense name.

The Complainant has adduced evidence based on the use of the disputed domain name that Respondent is not using it for any non-commercial or fair use. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy).

The Panel finds that the Complainant's contentions and proof satisfy the presumptive burden that Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the burden shifts to respondent to rebut the presumption that it lacks rights or legitimate interests. It has the opportunity to controvert the prima facie case by adducing evidence demonstrating that it has rights or legitimate interests. The Policy sets forth the following nonexclusive list of factors:

(i) "[B]efore any notice to you of the dispute, your 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."

(ii) "[Y]ou (as an individual, business, or other organization) have been commonly known by the domain name, even if you have

acquired no trademark or service mark rights."

(iii) "[Y]ou are 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 trademark or service mark at issue."

Evidence of any one of these defences will satisfy the rebuttal burden, but the absence of any evidence supports a complainant's contention that the respondent lacks rights or legitimate interests in the disputed domain name. The failure of a party to submit evidence on facts in its possession and under its control may permit the Panel to draw an adverse inference regarding those facts. See Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown, doing business as Big Daddy's Antiques, WIPO Case No. D2000-0004.

Here, the disputed domain name is virtually identical to the Complainant's mark. The sole difference is the addition of the word “sales.” The Complainant denies authorizing Respondent the use of XIAOMI. See Emerson Electric Co. v. golden humble /golden globals, FA 1787128 (Forum June 11, 2018) ("lack of evidence in the record to indicate a respondent is authorized to use [the] complainant's mark may support a finding that [the] respondent does not have rights or legitimate interests in the disputed domain name per Policy ¶ 4(c)(ii)").

It is well settled that impersonation of a complainant, by using its trademark in a disputed domain name and seeking to defraud or confuse users, indicates a lack of rights or legitimate interests by a Respondent. See Comme Des Garcons, Ltd. and Comme Des Garcons Co., Ltd. v. Lina543 Valen354345cia, FA 2001717 (Forum August 3, 2022) (holding: “The disputed domain name incorporates Complainant's registered mark without authorization, and it is being used for a misleading website that passes off as Complainant to promote counterfeit versions of its products and possibly for other fraudulent conduct. Such use does not give rise to rights or legitimate interests under the Policy.”). See WIPO Jurisprudential Overview 3.0 at 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”).

As the Respondent has not controverted the evidence that it lacks right or legitimate interests in the disputed domain name, and for the reasons herein stated, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad faith:

It is the Complainant's burden under Paragraph 4(a)(iii) of the Policy to prove that the Respondent both registered and is using the disputed domain name in bad faith. It is not sufficient for a complainant to rest its case on the finding under Paragraph 4(a)(ii) of the Policy, although the fact that the Respondent lacks rights or legitimate interests in the disputed domain name will be a factor in assessing its motivation for registering the disputed domain name that is virtually identical to the Complainant's mark.

In this case, the Respondent has misappropriated the Complainant’s XIAOMI trademark and pointed <xiaomistore.com> to a fraudulent website offering counterfeit merchandise at discount prices.

The Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent 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 is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on the respondent's website or location.

The preamble to Paragraph 4(b) states: "For the purposes of Paragraph 4(a)(iii) [the finding of any of the circumstances] shall be evidence of the registration [...] of a domain name in bad faith." In the absence of a respondent to explain and justify its registration and use of a domain name corresponding to a famous or well-known mark, a panel is compelled to examine the limited record for any exonerative evidence of good faith. Here, the Panel finds none.

The Complainant's proof in this case focuses the Panel's attention on the fourth factor. As there is no proof that would support the other factors, the Panel will not address them. Here, the Complainant contends and submits proof that the disputed domain name has been used to lure consumers into believing that they are purchasing merchandise manufactured and offered by Complainant. Respondent’s website is offering this merchandise at discounted prices. Using a domain name in order to offer competing goods or services is often been held to disrupt the business of the owner of the relevant mark is bad faith. See Instron Corporation v. Andrew Kaner c/o Electromatic a/k/a Electromatic Equip't, FA 768859 (Forum September 21, 2006) (holding: "Complainant asserts that Respondent registered and is using the disputed domain names to disrupt Complainant’s business, because Respondent is using the disputed domain names to operate a competing website. The panel finds that Respondent has registered and used the disputed domain names in bad faith according to Policy ¶ 4(b)(iii)."); also, Southern Exposure v. Southern Exposure, Inc., FA 94864 (Forum

07/18/2000) ("The Respondent is using the domain name to attract Internet users to its website by creating confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Complainant's website").

In addition, the Complainant contends that the Respondent is likely to be using false information in the disputed domain name´s Whois as disclosed by the Registrar. The address listed, "noonecoa, noonecoa, noonecoa, 000000 PH", is simply a chain of nonsensical combination, with its country in the Philippines, with no known street name or number specified. See McDonald's Corp. v. Holy See, FA 0155458 (Forum June 27, 2003) (holding that the respondent's use of falsified information when it registered the disputed domain name was evidence that the domain name was registered in bad faith). See also Choice Hotels Int'l, Inc. v. Windermere, FA 1364454 (Forum Feb. 28, 2011) ("Use of false contact information constitutes further evidence of bad faith"). See also Accor v. SANGHO HEO / Contact Privacy Inc., D2014-1471 (WIPO, Nov. 13, 2014) ("The evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith."). See also Twitter, Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Domain Support, D2015-1488 (WIPO, Oct. 6, 2015) ("The Panel accepts Complainant's undisputed submission that bad faith registration and use of the Domain Name is further indicated by the fact that there is strong suspicion of Respondent using the Domain Name in an elaborate common phishing scam.").

As previously noted, while <xiaomistores.com> does not currently resolve to an active website the Complainant alleges that the Respondent is also impersonating the Complainant through a subdomain incorporated in https://huangruohong.xiaomistores.com. However, subdomains are outside the scope of the UDRP. Accordingly, this decision must be limited to <xiaomistores.com>.

As the Complainant has demonstrated that the Respondent registered and is using the disputed domain name in bad faith, it has satisfied Paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **xiaomistores.com**: Transferred

PANELLISTS

Name	**Gerald Levine Ph.D, Esq.**

DATE OF PANEL DECISION 2025-01-13

Publish the Decision