



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 1ED4DD94

Determination FINAL

I. PARTIES

Complainant: Xiaomi Inc., CN

Complainant's authorized representative(s): INLEX IP EXPERTISE, SOUTOUL Franck, FR

Respondent: Youssef Forsane, MA

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Name(s): XIAOMI.BOUTIQUE

Registry Operator: Binky Moon, LLC

Registrar: PDR Ltd. d/b/a PublicDomainRegistry.com

III. PROCEDURAL HISTORY

Complaint submitted: 2020-06-05 11:35

Lock of the domain name(s): 2020-06-09 10:50

Notice of Complaint: 2020-06-10 00:45

Default Date: 2020-06-25 00:00

Notice of Default: 2020-06-25 12:34

Panel Appointed: 2020-06-25 12:37

Default Determination issued: 2020-06-25 13:03

Response Submitted: 2020-07-08 21:02

Panel Re-Appointed: 2020-07-09 16:15

Final Determination issued: 2020-07-14 09:31

IV. EXAMINER

Examiner's Name: Jonathan Agmon

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the domain name be suspended for the balance of the registration period.

The Respondent requests that the domain name be unlocked and returned to its full control.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Complainant:

The Complainant was established in 2010 and is one of the world's top technology start-up. The Complainant widely uses its trademarks in connection with a chain of consumer electronics stores and electronic devices, which are well-known in China and worldwide. The Complainant has stores in Europe, Asia, Middle East & Africa, India and North and South America, and more than 16 7000 employees worldwide.

The Complainant owns several national and international trademarks composed of the denomination XIAOMI, including but not limited to:

- International Registration "XIAOMI" No 1177611 designating 62 countries (including Morocco), registered on November 28, 2012;
- International Registration "XIAOMI" No 1352685 designating 93 countries, registered on June 16, 2016;
- International Registration mark MI logo No 1516163 designating 33 countries (including Morocco), registered on October 17, 2019

The Complainant also owns a large portfolio of Xiaomi's domain names, such as "xiaomi.com.es" (registered on 2014), "xiaomi.org" (registered on 2012) and "xiaomi.tw" (registered on 2011).

The Complainant asserts the following regarding the Respondent:

1. The registered domain names are identical or confusingly similar to a word or mark [URS 1.2.6.1]: for which the Complainant holds several international registrations and that are in current use.
2. Registrant has no legitimate right or interest to the domain names [URS 1.2.6.2]
3. The domain names were registered and is being used in bad faith [URS 1.2.6.3]

B. Respondent:

The Respondent appears to be a private registrant.

The Respondent filed a Response to the Complaint on July 8, 2020, which falls within the 30 calendar days period after the Default Determination was issued [URS 5.2]. In his Response, the Respondent provided evidence of its first order dated September 5, 2017 and asserted that he has been growing the Complainant's brand and trademark since 2017 through Google Adwords, Facebook advertisements and native advertisements. The Respondent also provided evidence of product reviews and communication with potential buyers of the Complainant's goods to assert that he has built a profitable business with good reputation in Morocco of the Complainant's trademarks and brand.

C. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

Language of the Final Determination: The Complaint was filed in English and the Response was filed in English as well. Having considered the circumstances, in particular that the Respondent understands English, the Examiner decides that the language of the Final Determination be English.



Unsolicited additional submission: Given the rapid nature of the URS procedure, unsolicited additional submission is not acceptable. However, either party shall have a right to seek a de novo appeal of the Determination based on the existing record within the URS proceeding. [URS 12.1]

D. Findings of fact:

URS Procedure 1.2.6 requires Complainant to make a *prima facie* case, proven by clear and convincing evidence, for each of the following three elements to obtain an order that a domain name should be suspended.

[URS 1.2.6.1] The registered domain name(s) is/are identical or confusingly similar to a word mark:

- (i) for which the Complainant holds a valid national or regional registration and that is in current use; or
- (ii) that has been validated through court proceedings; or
- (iii) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed.

[URS 1.2.6.2] Registrant has no legitimate right or interest to the domain name.

[URS 1.2.6.3.] The domain was registered and is being used in bad faith.

E. Reasoning:

1. The domain name(s) is(are) identical or confusingly similar to a word mark

The Complainant is the owner of several international trademark registrations for “XIAOMI”.

The domain name <xiaomi.boutique> includes the Complainant’s mark in its entirety and the gTLD “.boutique”. It is well established that gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Therefore, the gTLD “.boutique” does not prevent the finding of confusing similarities under the first element.

The Complainant has satisfied URS 1.2.6.1 as the domain names are confusingly similar to the Complainant’s registered trademarks.

2. Respondent has no rights or legitimate interests to the domain name(s)

There is no evidence that the Respondent is known by the domain name.

The Complainant did not authorize the Respondent to use its “XIAOMI” mark.

The Respondent has admitted that he started using the disputed domain name in 2016, which is 4 years after the Complainant’s trademarks were registered worldwide, including in Morocco, where the Respondent conducts his business. The Respondent admitted that the disputed domain name was used to market Complainant’s goods and other goods at the same time. As such, the Respondent could not meet the second element of the Oki Data Test. (See WIPO

Overview 3.0 at para. 2.8) Furthermore, the Respondent is not an authorized reseller or distributor of the Complainant.

Therefore, the Complainant has met its burden and has satisfied URS 1.2.6.2 as the Respondent has no legitimate rights or interest to the domain names.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

A non-exclusive list of circumstances that demonstrate bad faith registration and use by the Registrant include:

- b. The domain name(s) was/were registered in order to prevent the trademark holder or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct
- d. By using the domain name(s), the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location

The Complainant has provided evidence that the Respondent is aware of the Complainant and its business and the Respondent intends to sell the domain name to the Complainant for profit in future. The Complainant has also provided evidence of the Respondent's mailbox servers set up for the disputed domain name which the Panel believes may be a phishing attempt to mislead Internet users to believe that they are in contact with the Complainant.

The Respondent has also admitted that he was aware of the Complainant and its business when he registered the disputed domain name in the year 2016 and that he was building the business while being fully aware of the Complainant and its brand. The Respondent admitted he was marketing goods which were not the Complainant's under the disputed domain name wholly incorporating the Complainant's "XIOAMI" mark. The Respondent provided additional evidence showing he was using the Complainant's "MI" registered mark comprising the same fonts and colors long used by the Complainant. The Respondent also admitted that he has 5 other domain names bearing the Complainant's trademark which he can continue his business with. In so doing, it is clear that by using the disputed domain name, the Respondent is intentionally attracting for commercial gain, Internet users to its website to create a likelihood of confusion as to the source and affiliation of its website and goods with the Complainant.

Having considered the evidence submitted by both parties, in the particular circumstances of the present case, the Panel is convinced that the Complainant has satisfied URS 1.2.6.3(b) and (d) as the Respondent registered the domain names and is using them in bad faith.

4. Abusive Complaint

The Examiner finds that the Complaint was neither abusive nor contained material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Response and remedy



Response: Rejects

Default Determination: Upholds

Domain Name(s): XIAOMI.BOUTIQUE Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Final Determination by replacing the Default Determination.

SIGNATURE

Name: Jonathan

Surname: Agmon

Date: 14 July 2020