



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version	
Decision ID	DE-0800175
Case ID	HK-0800203
Disputed Domain Name	www.香港迪士尼樂園.com
Case Administrator	Dennis CAI
Submitted By	Lulin Gao
Participated Panelist	

Date of Decision 26-11-2008

Language Version : English

The Parties Information

Claimant	Disney Enterprises, Inc.
Respondent	Sean Miller

Procedural History

On September 23, 2008, the Complainant submitted the Complaint in English on domain name “香港迪士尼樂園.com” to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the “Rules”) approved by ICANN on October 24, 1999, and Asian Domain Name Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the “ADNDRC Supplemental Rules”) effected on February 28, 2002. The Centre confirmed the receipt of the Complaint on September 29, 2008. The Complainant has sought a one-person Panel.

On September 29, 2008, the Centre transmitted by email to the Registrar, SPOT DOMAIN LLC DBA DOMAINSITE.COM, a request for Registrar verification in connection with the disputed domain name.

On September 30, 2008, the Centre received the Registrar’s confirmation on registration information of the disputed domain name.

On October 3, 2008, the Centre sent the Complaint to the Respondent. The 20-day deadline for the Respondent to respond calculated from October 3, 2008 expired on October 27, 2008.

On October 25, 2008, the Respondent filed a Response with the Centre within the required period of time.

On October 25, 2008, the Centre transmitted by email to the Complainant the Notification of Receiving Respond.

Since the Respondent did not mention the Panel selection in the Response, the Centre informed the Complainant and Respondent that the Centre would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the Centre contacted the Complainant and Respondent by email informing them that the Centre has appointed a one-member Panel, Dr. GAO Lulin to decide the dispute. The decision shall be rendered by November 25, 2008.

On November 11, 2008, the Centre transferred the case file to the Panelist by email.

Pursuant to the Paragraph 11 (a) of the Rules, unless otherwise agreed by the parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

Factual Background

For Claimant

The Complainant, Disney Enterprises, Inc. was found by Mr. Walter Disney is now listed in NYSE. The Complainant is one of the world’s top producers of movies and animation. The Complainant first opened the Disneyland theme park and resort in Los Angeles in 1955, and then operates Disneyland theme parks and resorts in Orlando, Tokyo, Paris and Hong Kong. The Complainant has started constructing a Disneyland theme park and resort in sub-urban Shanghai, China. The Complainant’s Disneyland theme parks and resorts are well known by the public over the world.

The Complainant has registered numerous "DISNEYLAND" marks in English all over the world and Chinese character marks "迪士尼" and "迪士尼乐园" in Chinese-speaking countries/cities. The Complainant has enjoyed the exclusive rights to the following registered trademarks "迪士尼樂園" in both traditional and simplified Chinese characters in mainland China in class 41(Reg. Nos. 1956167 & 1956168) and in Hong Kong covering the following 23 classes as 3, 4, 5, 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 32, 35, 41, 42, 43, 44 and 45.

For Respondent

The Respondent is Sean Miller who registered the domain name on April 17, 2005 through the Registrar SPOT DOMAIN LLC DBA DOMAINSITE.COM.

Parties' Contentions

Claimant

The Complainant's contentions are as follows:

The Disputed domain name Is Confusingly Similar To the Complainant's Trademarks

The Complainant claims that the disputed domain name "香港迪士尼樂園.com" (English meaning: Hong Kong Disneyland.com in traditional Chinese characters) is both the trade name and trademark of the Complainant. The first two characters "香港" (English meaning: Hong Kong) is a geographic indication, whereas the second part "迪士尼樂園" (English meaning: Disneyland in traditional Chinese characters) is a distinctive word and trademark with well-recognized meaning. Putting aside the geographic indication, the disputed domain name is almost identical or confusingly similar to the registered trademarks (and service marks) of the Complainant.

The Complainant further claims that a domain name containing the word "Disney/Disneyland" and a generic word (such as "Hong Kong") in a word string will be confusing to the public and diluting the distinctiveness of the "DISNEYLAND" and "DISNEY" trademarks and the following CIETAC decided cases under the CNNIC Dispute Resolution Procedures in respect of "disney.cn", "disney.net.cn", "disneyland.cn", "disneyland.com.cn", "hkdisney.cn", "hkdisney.com.cn", "hongkongdisney.cn", "hongkongdisney.com.cn", "hongkongdisneyland.cn", "disneyfamily.cn", "disneyfamily.com.cn", "disneyshanghai.cn", "disneysports.cn", "disneybaby.cn" and "disneyenglish.com.cn" in CIETAC cases numbers 2003000025, 2007000006, 2006000221, 2005000021, 2007000008, 2006000222, 2006000223, 2006000187, 2006000193, 2007000114, 2008000012, 2008000071, 2008000072 and 2008000075 and WIPO case No. D2001-0489 (Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol), respectively, are authorities in this regard.

The Respondent Has No Rights Or Legitimate Interests In The Disputed domain name

The Complainant claims that the disputed domain name is the trade name and trademark of the Complainant. The Respondent is not entitled to or otherwise authorized or licensed by the Complainant in whatsoever means to use the trademark in any goods or services. The Respondent will not be able to demonstrate that his conduct satisfies any of the conditions in paragraph 4(c) of the Policy. Specifically, (i) the Respondent is not using and has not demonstrated an intent to use the disputed domain name or names corresponding to the disputed domain name in connection with a bona fide offering of goods or services in the course of trade; (ii) the Respondent, being an individual, is not and has not been doing business under any business name referable to or commonly known by the disputed domain name; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent to misleadingly divert consumers or to tarnish the Complainant's marks for commercial gain. Therefore, the Respondent has no rights or legitimate interests in respect of the domain name in dispute.

The Respondent Registered And Is Using The Disputed domain name In Bad Faith

As set forth below, the Respondent's bad faith is established under paragraphs 4(b)(ii), 4(b)(iii) and 4(b)(iv) of the Policy, as well as by the other circumstances surrounding the Respondent's registration and use of the disputed domain name.

The Respondent has deliberately registered the disputed domain name which is identical to the Complainant's famous trademark "迪士尼樂園", with an intention of causing confusion to the public that the Respondent and/or the Respondent's website is related to or authorized by the Complainant and/or the Complainant's website and diverting the traffic of the web-users from the Chinese speaking countries/cities.

The Respondent, who is situated in the USA, should be well aware of the Complainant and its group of companies, which are well known in America. Further, given the substantial fame of the Complainant and its Disneyland theme parks and resorts throughout the world, it is most unlikely that the Respondent is unaware of the Complainant's rights in the "迪士尼樂園" trademark. It cannot be a mere co-incidence that the Respondent has chosen the disputed domain name, which is identical to the Complainant's Mark, as his domain name. If one looks at the contents of www.香港迪士尼樂園.com, there are various mentions of "Disney" or "Disneyland" in either English or Chinese on its front page.

As a result, the members of the public in the Chinese-speaking countries/cities will likely be confused into believing that the Respondent and/or the Respondent's website is related to or authorized by the Complainant and/or the Complainant's website. As mentioned above, due to extensive use and advertisement of the Complainant's Disneyland theme parks and resorts, the public will easily associate the disputed domain name exclusively with the Complainant's business.

Further, the Respondent, Sean Miller, has previously registered domain names using others' famous Chinese language trademarks such as www.永利澳門.com (English meaning: Wynn Macao), a famous resort in Macao operated by Wynn Resorts Holdings LLC (see ADNDRC Decision No. DE-0800135 Wynn Resorts Holdings LLC v Sean Miller).

Finally, the Respondent has committed bad faith under the provision of paragraph 4(b)(iv). Given the distinctiveness and fame of the "迪士尼樂園" mark and "DISNEYLAND" marks, there is no plausible explanation for the Respondent's registration of the disputed domain name other than to trade upon the goodwill the Complainant has developed in its trademarks. See *Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (finding bad faith where "[g]iven the Complainant's numerous trademark registrations for, and its wide reputation in, [Complainant's mark]... it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name [at issue].")

Respondent

The Respondent alleges that the disputed domain name was registered in good faith. As a non-native speaker relying on machine translation, it can be difficult to determine the native language meaning of certain hanzi script IDN names. In this instance machine translation translated this domain name as "Hong Kong enlightens the gentleman Nepal paradise" which the Respondent took to be a destination name of some sort.

The Respondent further alleges that he acquired thousands of .com IDN domains during a "land rush" period, principally with an eye towards the tourist space. The Respondent would maintain the registration of the disputed domain name in fact in good faith.

While the Respondent admitted that Disney has a legitimate claim to the disputed domain name. As such, the Respondent would cede the disputed domain name without prejudice.

Findings

One of the prerequisites for a domain name registration through the Registrar is to accept the Policy as the binding regulations in terms of the procurement of the entitlement. As previously mentioned, the Policy governs the procedural and substantive issues in the domain name dispute resolution. As stipulated in the Paragraph 4(a) of the Policy, when claiming a domain name registered by Respondent, the Complainant must prove each of the followings:

- (i) that the domain name of the Respondent's is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the domain name' and
- (iii) that the domain name has been registered and is being used in bad faith.

Based on the relevant stipulations under the Policy, the Rules and ADNDRC Supplemental Rules, the Panel needs to determine whether the Complainant satisfies each of the afore-said prerequisites. If the answer is yes, the Panel will make a final decision in accordance with the facts and relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules; if not, the Complainant's claims shall be rejected.

Identical / Confusingly Similar

The Complainant claims that the disputed domain name is confusingly similar to its registered trademarks. On the other hand, the Respondent does not submit any defense with regard to this point.

The Panel holds that, pursuant to Paragraph 4(a)(i) of the Policy, the Complainant must prove that the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the Complainant has right to. In order to meet this requirement, the Complainant provided proof certifying its entitlement to the registered trademark "迪士尼樂園" and "迪士尼乐园" in China, which are still valid and was registered well before the Respondent had registered the disputed domain name (April 17, 2005). As such, what the Panel needs to do is to make a conclusion on the identity or confusing similarity between the Complainant's registered trademark "迪士尼樂園" and the disputed domain name "香港迪士尼樂園.com".

When making a judgment on the issue of identity or confusing similarity, the Panel often compares the identifying part of the disputed domain name with that of the claimed trademark. "香港" is merely a geographic indication, which can't work as an identifying part, while "迪士尼樂園" plays the role of an identifying part. It is observable that the identifying part of the disputed domain name is identical with the Complainant's registered trademark.

In light of the above reasoning, the Panel holds that the identifying part of the disputed domain name is identical to the registered trademark owned by the Complainant, thus the Complainant satisfies the first requirement when claiming back a domain name registered by Respondent as set forth in the Policy.

Rights and Legitimate Interests

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the domain name in dispute, since the Respondent is not entitled to or authorized or licensed by the Complainant in whatsoever means to use the trademark in any goods or services.

The Respondent failed to submit any defense, except argued that he acquired thousands of .com IDN domains during a "land rush" period, principally with an eye towards the tourist space, which cannot prove that the Respondent has prior legitimate interests over the disputed domain name. In addition, the Respondent acknowledged that the Complainant Disney has a legitimate claim to the disputed domain name and he will cede the domain name without prejudice.

The Panel considers that, Paragraph 4(c) of the Policy stipulates how a Respondent can effectively demonstrate its rights or legitimate interests with regard to the disputed domain name, as an argument against the Complainant's claim. The Respondent obviously doesn't have legitimate rights or interests in respect of the disputed domain name due to the facts that 1) The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent; 2) the Respondent himself has acknowledged that the Complainant has legitimate rights to the domain and he will give up the domain name without prejudice.

Based upon the above reasoning, the Panel holds that the Respondent has no rights or legitimate interests in respect of the domain name and the Complainant meets the second requirement as set forth under the Policy.

Bad Faith

The Complainant also needs to establish the Respondent's bad faith as set forth in the Paragraph 4(a)(iii) of the Policy. Under Paragraph 4(b) of the Policy, the following circumstances in particular shall be considered as evidence of the registration and use of a domain name in bad faith:

- "(i) Circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have 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 you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your 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 your web site or location or of a product or service on your web site or location."

The Complainant alleges that, the Respondent has deliberately registered the disputed domain name which is confusingly similar to the Complainant's famous trademark "迪士尼樂園", with an intention of causing confusion to the public that the Respondent is related to or authorized by the Complainant.

The Complainant also alleges that given the substantial fame of the Complainant and its Disneyland theme parks and resorts throughout the world, and the Respondent is situated in U.S., it is unlikely for the Respondent has not known the Complainant and its trademark "迪士尼樂園". Thus, the Respondent registered the disputed domain name out of bad faith.

The Respondent argues that the disputed domain name was registered in good faith. As a non-native speaker relying on machine translation, it is difficult to determine the native language meaning of certain hanzi script IDN names. In this instance machine translation translated the disputed domain name as "Hong Kong enlightens the gentleman Nepal paradise" which the Respondent took to be a destination name of some sort. In addition, the Respondent acquired thousands of .com IDN domains during a "land rush" period, principally with an eye towards the tourist space.

The Panel notices that the website printout of www.香港迪士尼樂園.com provided by the Complainant reveals that the descriptions as "Disney Hong Kong", "HK Disneyland", "Disney HK", as well as "香港迪士尼樂園酒店" (English meaning: Hong Kong Disneyland Hotel), "迪士尼" appear on this website. In particular, there are "Disneyland Hong Kong" and "暢遊迪士尼必到臨近東薈城" in the Sponsored Listings. Given that, it is hard for the Panel to believe that the Respondent did not know the certain meaning and substantial fame of "香港迪士尼樂園" and registered the disputed domain name accidentally. Thus, the Panel holds that the "machine translation" argument of the Respondent is lack of credibility.

The Panel takes the view that, given the wide reputation of the Complainant and substantial fame of the claimed trademarks, the Respondent knows or shall have known the Complainant and its trademarks, and there is no other explanation for the Respondent's intention in use of the disputed domain name to trade upon the goodwill which the Complainant has developed in its trademarks. Furthermore, the printout of the website of the Respondent indicates that the use of the disputed domain name "香港迪士尼樂園.com" is for commercial purpose which is likely to cause confusion among the Chinese-speaking public in respect of the source, sponsorship, affiliation, or endorsement between the website of the Respondent and the Complainant. This is the circumstance as set out in 4 (b)(iv). Thus, the registration of the disputed domain name by the Respondent is in bad faith.

Based on the above reasoning, the Panel comes to the conclusion that the Complainant has established the criteria of bad faith, thus meeting the third requirement under the relevant articles of the Policy.

Based on all the above findings and comments, the Panel rules that the Complainant fulfills all conditions provided in Paragraph 4(a)(i)(ii) (iii) of the Policy, hence its claims shall be held.

Status

www.香港迪士尼樂園.com Domain Name Transfer

Decision

In light of all the foregoing findings and in accordance with Paragraphs 4(a) of the Policy, the Panel holds:

- a) that the disputed domain name "香港迪士尼樂園.com" is confusingly similar to the Complainant's registered trademark "迪士尼樂園"; and
- b) that the Respondent has no right or legitimate interest with regard to the disputed domain name; and
- c) that the domain name was registered and subsequently used in bad faith.

As such, the Panel requires that the domain name "香港迪士尼樂園.com" be transferred to the Complainant.

Panelist: Gao Lulin
Dated: November 24, 2008