



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

[English](#)
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Version
 Decision ID DE-0800181
 Case ID HK-0800210
 Disputed Domain Name
 www.迪士尼乐园.biz
 www.迪士尼樂園.biz
 www.迪斯尼乐园.biz
 www.迪斯尼樂園.biz
 Case Administrator Dennis CAI
 Submitted By David Kreider
 Participated Panelist

Date of Decision 11-12-2008

Language Version : English

The Parties Information

Claimant Disney Enterprises, Inc.
Respondent Wei Zhu

Procedural History

On 24 September 2008, the Complainant submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC), and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 29 September 2008, the ADNDRC sent to the Complainant by email an acknowledgement of its receipt of the Complaint and reviewed the format of the Complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language.

On 29 September 2008, the ADNDRC transmitted by email to the Registrar, Web Commerce Communications Ltd., a request for registrar verification in connection with the Disputed Domain Names. On 29 September 2008, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 9 October 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action by email. The Respondent failed to submit a Response within the specified period of time. Accordingly, on 31 October 2008, the ADNDRC notified the Respondent's default.

Since the Respondent defaulted and did not mention the Panel selection in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC informed the Complainant and Respondent that the ADNDRC 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 ADNDRC notified the parties that the panel in this case had been selected, with Mr. David KREIDER ("Panel"), acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 4 December 2008, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 18 December 2008.

Pursuant to 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 in this case is Disney Enterprises, Inc., a corporation registered in California, USA. The Complainant is the owner of several trademarks, including “迪士尼”, “迪斯尼”, “迪士尼乐园” and “迪斯尼乐园” .

For Respondent

The Respondent, Wei Zhu, is the current registrant of the Disputed Domain Names <迪士尼乐园.biz>, <迪斯尼乐园.biz>, <迪士尼樂園.biz> and <迪斯尼樂園.biz> according to the Whois information. The registered address of the Respondent is No. 6 Kazimen Street, Nanjing, China; the telephone number is +86.13813377992; and the email address is ityuming@mainone.cn.

Parties' Contentions

Claimant

The Complainant's contentions may be summarized as follows:

I. The Disputed Domain Names are Confusingly Similar To the Complainant's Trademarks

(a) The Disputed Domain Names <迪士尼乐园.biz>, <迪斯尼乐园.biz>, <迪士尼樂園.biz>, and <迪斯尼樂園.biz> (English meaning: “Disneyland”, comprising two variations of the name in simplified, followed by the same names, only in traditional Chinese characters, respectively), are both the trade names and trademarks of the Complainant. “迪士尼乐园” and “迪斯尼乐园” (English meaning: “Disneyland”) are distinctive words and Trademarks with well-recognized meaning. The Disputed Domain Names are identical or confusingly similar to the registered Trademarks (and service marks) of the Complainant. Although ICANN treats simplified and traditional Chinese characters as two different puny codes, under the Implementing Regulations to the PRC Trademark Law, registration for a trademark in simplified Chinese characters will cover the traditional Chinese characters, and vice versa.

(b) It is further submitted that a domain name containing the word “Disney/Disneyland” 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.

II. The Respondent has no Rights or Legitimate Interests in Respect of the Disputed Domain Names

(a) The Disputed Domain Names are the trade names and trademarks of the Complainant. The Respondent is not entitled to or otherwise authorized or licensed by the Complainant by 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 Names or names corresponding to the Disputed Domain Names 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 Names; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names, 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 Names in dispute.

III. The Respondent Registered and is Using the Disputed Domain Names in Bad Faith

(a) As set forth below, the Respondent's bad faith is established under paragraphs 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 Names.

(b) The Respondent has deliberately registered the Disputed Domain Names, which are identical to the Complainant's famous trademarks “迪士尼乐园” and “迪斯尼”, 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, for the purpose of diverting the traffic of Chinese-speaking web-users to the Respondent's website.

The Respondent, who is situated in the China, should be well aware of the Complainant and its group of companies, which are well known in China and Hong Kong. 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 “迪士尼乐园” and “迪斯

尼” trademarks. It cannot be a mere co-incidence that the Respondent has chosen the Disputed Domain Names, which are identical to the Complainant’s Trademarks, as his/her domain Names.

(c) If one looks at the contents of www.迪士尼乐园.biz, www.迪士尼樂園.biz, and www.迪斯尼樂園.biz, it can be observed that three of the Disputed Domain Names are inactive. However, the contents of one of the Disputed Domain Names, www.迪斯尼乐园.biz, are identical to Disney’s official website www.disney.cn. In other words, the Respondent “hijacked” the contents of official Disney’s website as well as Disney’s domain names. The act of the Respondent itself is an act of serious trademark and copyright infringement under the PRC Laws.

(d) It is submitted that 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 associate the Disputed Domain Names exclusively with the Complainant’s business.

(e) Finally, the Respondent has committed the above-described acts in bad faith under the provision of paragraph 4(b)(iv). Given the distinctiveness and fame of the “迪士尼乐园” and “迪斯尼” trademarks and its English equivalent “DISNEYLAND” & “DISNEY” trademarks, there is no plausible explanation for the Respondent’s registration of the Disputed Domain Names 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 failed to submit a Response to the Complaint within the specified time period.

Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall 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.” Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- i. the domain Names registered by the Respondent must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect of the domain Names; and
- iii. the domain Names have been registered and are being used in bad faith.

Identical / Confusingly Similar

The evidence submitted by the Complainant shows that the Complainant owns the trademarks “迪士尼乐园” and “迪斯尼乐园” (“Disneyland” in simplified Chinese characters), and “迪士尼樂園”, and “迪斯尼樂園” (“Disneyland” in traditional Chinese characters), (the two variants of each being indistinguishable from one another in meaning, but with a different second Chinese character in the word “Disney”, resulting in a slightly different pronunciation between them), and operates very well known and established theme parks under this name in multiple locations around the world, including one such park that is currently under construction in Shanghai, China. As the suffix “.biz” only indicates that the domain Names are registered under this gTLD and are not distinctive, the Panel finds that the major part of Disputed Domain Names <[迪士尼乐园.biz](http://www.迪士尼乐园.biz)>, <[迪斯尼乐园.biz](http://www.迪斯尼乐园.biz)>, <[迪士尼樂園.biz](http://www.迪士尼樂園.biz)>, and <[迪斯尼樂園.biz](http://www.迪斯尼樂園.biz)> are identical with the Complainant’s trademarks “迪士尼乐园” and “迪斯尼乐园” . The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy.

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the Disputed Domain Names. The Complainant’s assertion is sufficient to establish a prima facie case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests. The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Names and has defaulted. The Panel therefore finds that the Complaint fulfills the conditions provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

The Panel finds that Respondent deliberately registered the Disputed Domain Names, which are identical to the Complainant’s famous trademarks “迪士尼乐园” and “迪斯尼乐园” , 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 to divert the traffic of Chinese-speaking web-users. The Respondent, who is situated in the China, should be well aware of the Complainant and its group of companies, which are well

known in China and Hong Kong. Further, given the substantial fame of the Complainant and its Disneyland theme parks and resorts, which are heavily promoted and advertised throughout the world, including a theme park that is currently under construction in Shanghai, China, it is inconceivable that the Respondent could be unaware of the Complainant's rights in the “迪士尼乐园” and “迪斯尼乐园” trademarks. It cannot be a mere co-incidence, and the Panel finds that it was not mere coincidence, that the Respondent chose the Disputed Domain Names, which are identical to the Complainant's Trademark, as his/her domain names.

Any lingering doubts about the Respondent's bad faith, *vel non*, in registering the Disputed Domain Names must be finally dispelled and put to rest by the evidence adduced by Complainant of the Respondent's having “hijacked” and pilfered wholesale the contents of the official Disney website (www.disney.cn) for the purpose of reproducing the same on one of the Disputed Domain Names, www.迪斯尼乐园.biz.

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.

Given the distinctiveness, fame and wide recognition of the “迪士尼乐园”, “迪斯尼乐园” marks, which are “household words” that are commonly recognized throughout the Chinese-speaking world, there is no plausible explanation for the Respondent's registration of the Disputed Domain Names other than to trade upon the goodwill the Complainant has developed in its Trademarks. The Disputed Domain Names were not put into active use by the Respondent, with the exception of the above-referenced “hijacked” site. This additionally evidences that the registration of the Disputed Domain Names had no purpose other than to create confusion that such registration was endorsed by the Complainant.

In conclusion, the Panel finds that the Respondent has registered and used the domain Names in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.迪士尼乐园.biz	Domain Name Transfer
www.迪士尼樂園.biz	Domain Name Transfer
www.迪斯尼乐园.biz	Domain Name Transfer
www.迪斯尼樂園.biz	Domain Name Transfer

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <迪士尼乐园.biz>; <迪士尼樂園.biz>; <迪斯尼乐园.biz>; and <迪斯尼樂園.biz> domain Names should be TRANSFERRED from the Respondent to the Complainant.

David KREIDER
Sole Panelist