



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No. : HK-1000317
Complainant : Disney Enterprises, Inc
Respondent : Li Yen Chun
Domain Name : <disini.com>

1. THE PARTIES AND CONTESTED DOMAIN NAME

The Complainant is Disney Enterprises, Inc., of 500 S Buena Vista Street, Burbank, CA 91521, USA. The authorized representative of the Complainant in this matter is Mr. William LAW of ATL Law Offices, of 15/F, Fook Lee Commercial Center, 33 Lockhart Road, Wanchai, Hong Kong.

The Respondent is Li Yen Chun, of 4F, No. 6, Lane 79, Chienkwo S Rd. Sec. 2, Taipei, Chinese Taipei 106.

The domain name at issue (“the Disputed Domain Name”) is <disini.com>, registered by Respondent with eNOM Inc on 7 September 2001.

2. PROCEDURAL HISTORY

The Complainant filed a complaint in English in respect of <disini.com> with the Asian Domain Name Dispute Resolution Centre (Hong Kong Office) (“ADNDRC-HK”) in the prescribed Form C on 26 October 2010 pursuant to the Uniform Policy for Domain Name Dispute Resolution, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October, 1999 (“the Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on 24 October, 1999 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the Supplemental Rules”).

On 1 November 2010, ADNDRC-HK confirmed receipt of the complaint and payment from the Complainant for the fee in connection to the case. On the same day, ADNDRC-HK sought confirmation from the registrar eNOM Inc on the details of the registrant of the Disputed Domain Name. On 2 November 2010, eNOM Inc confirmed the said details to ADNDRC-HK.

On 3 November 2010, ADNDRC-HK notified the Respondent by email at the address as per the WHOIS database of the commencement of the proceedings and requested him to submit a response within 20 days (i.e. on or before 23 November 2010). There was no response submitted within the required period of time.

On 24 November 2010, ADNDRC-HK confirmed with the parties that no response to the Complaint had been received and that Panelist(s) would be shortly appointed for this matter.

On 25 November 2010, Mr Kenneth Chung, the candidate for the panelist, confirmed his availability to act as a panelist in this matter and would be in a position to act independently and impartially between the parties.

Subsequently, on 26 November 2010, ADNDRC-HK informed the parties that Mr Kenneth Chung had been appointed as the Sole Panelist for this matter. On the same day, ADNDRC-HK transferred the documents to the Panelist and requested a decision to be rendered by 10 December 2010.

3. FACTUAL BACKGROUND

Complainant

The Complainant was founded in the 1930's and is now listed in NYSE. It 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. It also operates Disneyland Theme Parks and Resorts in Orlando, Tokyo, Paris, Hong Kong and one soon in Shanghai. Further, it has started constructing the Disneyland Theme Park and Resort in Shanghai, China. The Complainant's Disneyland theme parks and resorts are well-known to the public all over the world.

The Complainant has registered many "DISNEY" marks in English all over the world and Chinese character marks such as "迪斯尼 (pronounced: Di Si Ni)" and "迪士尼 (pronounced: Di Shi Ni)" in Chinese-speaking countries/cities. The Complainant has also registered various relevant trademarks in China as shown in Annexure 3 of the complaint (the "Trademarks") before the registration of the Disputed Domain Name in 2001. In addition, it registered and operated the top level domain names www.disney.com and www.disneyland.com since 1990 and 1995 respectively.

Respondent

The Respondent registered the Disputed Domain Name on 7 September 2001 for 10 years.

4. PARTIES' CONTENTIONS

Complainant

The Complainant founds its complaint on 3 grounds:

(1) The Disputed Domain Name is Confusingly Similar to the Complainant's Trademarks

The Complainant says the Disputed Domain Name **<disini.com>** is the unique transliteration of the “迪斯尼” which is a trademark of the Complainant and the most commonly known name of Disney in China. It is said that “disini” is a distinctive word and trademark with well recognized meaning in mainland China and other Chinese-speaking region.

The Complainant contends that “disini” cannot be found in any English dictionary which carries any meaning other than with reference to “Disney”. The Complainant attaches a set of search results on Baidu.com or Sogou.com to demonstrate that when one uses “disini” as the keyword and conduct a search, the top matching results all refer to “Disney”. Accordingly, the Complainant submits that the Disputed Domain Name is almost identical or confusingly similar to the registered Trademarks and service marks of the Complainant in the eyes of Chinese consumers.

The Complainant further submits that a domain name containing the Romanization or transliteration of famous trademarks, registration of which will be confusing to

the public and diluting the distinctiveness of the corresponding trademarks, have always gained supports from ADNDRC panelist. The Complainant refers the Panel to a couple of decisions in [HK-0500065](#) (yingke88.com), CN-0600088 (yafang.net), CN-0600086 (yafang.com), CN-0600087 (yafang.org), CN-1000341 (huamao.com), CN-0200001 (wuliangye.com), [HK-0400051](#) (woerma.com), [DCN-0800265](#) & [DCN-0800266](#) (huanqiuziyuan.cn & huanqiuziyuan.com.cn).

The Complainant further contends that “disini” is a distinctive identifier associated with products and services provided by Disney (so-called “common-law right”) and refers the Panel to the WIPO decisions in *Uitgeverij Crux v. W. Frederic Isler* [D2000-0575](#), *Skattedirektoratet v. Eivind Nag* [D2000-1314](#), *Australian Trade Commission v. Matthew Reader* [D2002-0786](#) and *Imperial College v. Christophe Dessimoz* [D2004-0322](#).

(2) The Respondent Has No Rights or Legitimate Interests In The Disputed Domain Name

On the second ground, the Complainant contends that 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. It further argues that the Respondent is not 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 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.

For the foregoing reasons, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

(3) The Respondent Registered and Uses the Disputed Domain Name in Bad Faith

The Complainant contends that the Respondent has deliberately registered the Disputed Domain Name which is confusingly similar to the Complainant's famous trademark “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 and diverting the traffic of the web-users from the Chinese speaking countries/cities.

By referring to a few cases involving the Respondent, the Complainant tries to illustrate that the Respondent is very familiar with UDRP procedures and should be well aware of the business of the Complainant and its group of companies. It further submits that 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 before the registration.

The Complainants argues that as the Respondent is based in Taiwan, a Mandarin-speaking region, it cannot be a mere coincidence that he had chosen the Disputed Domain Name which is identical to the Complainant's Trademarks without any ill intention.

The Complainant further points out that the Disputed Domain Name is for sale as shown on the website of www.disini.com. It says the content of the website does

not contain any substantive content and it describes this kind of website as “domain parking”.

For the above reasons, the Complainant submits that the Respondent has committed bad faith under the provision of paragraph 4(b)(i) - (iv). It relies on *Telstra Corp. v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#) and submits that given the distinctiveness and fame of the “迪斯尼” trademarks and “DISNEY” trademarks, 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.

Respondent

The Respondent did not file any response within the required period of time.

5. FINDINGS

Rules for Uniform Domain Name Dispute Resolution Policy

As the complaint was submitted to ADNDRC-HK after 1 March 2010, the Rules for Uniform Domain Name Dispute Resolution Policy as approved by ICANN on 30 October 2009 (“the Rules”) shall apply.

Merits of the Complaint

The Policy provides, at paragraph 4(a), that each of three findings must be made in order for a complainant to prevail:

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

Further, paragraph 5(e) of the Rules provides that if a respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.

The Panel finds no exceptional circumstances in this matter for the purpose of paragraph 5(e) of the Rules and the Panel shall proceed to determine the dispute accordingly.

Identical or Confusingly Similar

The Complainant states that the Disputed Domain Name **<disini.com>** is the unique transliteration of the “迪斯尼” which is a trademark of the Complainant and the most commonly known name of Disney in China.

The Panel agrees that the word “disini” cannot be found in any English dictionary and it is not in the daily use of the language. From the documents submitted by the Complainant, the Panel accepts that the Complainant was with rights over “迪斯尼”. The Panel also accepts that “迪斯尼 (pronounced as disini)” is a distinctive

word and trademark with well recognized meaning in mainland China and other Chinese-speaking region. The search results on Baidu.com or Sogou.com submitted by the Complainant also point to a similar conclusion.

The Complainant refers the Panel to a couple of decisions in support of his submission that the registration of a domain name containing the Romanization or transliteration of famous trademarks will be confusing to the public and diluting the distinctiveness of the corresponding trademarks. Whilst these decisions are not binding on the Panel, however the Panel does share the same view contained therein.

Accordingly, the Panel accepts the Complainant's submission that the Disputed Domain Name is almost identical or confusingly similar to the registered Trademarks and service marks of the Complainant in the eyes of Chinese consumers.

In the circumstances, the Panel finds the Complainant has discharged the burden on its part to establish the element under paragraph 4(a)(i) of the Policy.

Rights and Legitimate Interests

The Complainant contends that 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 neither made any submission nor produced any evidence to the contrary.

Paragraph 4(c) of the Policy provides that, for the purpose of paragraph 4(a)(ii), a respondent may demonstrate its rights or legitimate interests in the disputed domain name by proving any one of the following circumstances:

(i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notices no direct link between the name of the Respondent and the distinctive part of the Disputed Domain Name. Further, the Respondent offers no submission or evidence to rebut the Complainant's various allegations. Accordingly, the Panel cannot find any evidence to support a finding of any of the circumstances in paragraph 4(c) of the Policy.

For the foregoing reasons, the Panel accepts that the Respondent has no right or legitimate interests in the Disputed Domain Name and the Complainant has satisfied the burden under paragraph 4(a)(ii) of the Policy.

Bad Faith

Paragraph 4(b) of the Policy provides that, for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed 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 respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the respondent has registered the disputed 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 disputed 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 the respondent's website 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 website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Respondent has deliberately registered the Disputed Domain Name 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 Complainant says, with its substantial fame throughout the world, it is most unlikely that the Respondent is

unaware of the Complainant's rights before the registration. As the Respondent made no response to the complaint, he offers no submission or evidence for rebuttal.

The Complainant further points out that the Disputed Domain Name is for sale as shown on the website of www.disini.com and the content of the website does not contain any substantive content. Again, there is no contrary submission or evidence from the Respondent with respect to this.

Considering all the evidence presented and in the absence of any contrary submission or evidence or explanation from the Respondent as to why he chose the Disputed Domain Name while he has no rights over it, the Panel is satisfied that the Respondent did have knowledge of the Complainant's name or mark when he registered the Disputed Domain Name. The Panel accepts that the Respondent registered the Disputed Domain Name primarily for the purpose of (1) selling, renting or transferring it to the Complainant or (2) for commercial gain, attracting internet users to the respondent's website or other on-line location by creating a likelihood of confusion with the Complainant's mark.

The Panel finds the Complainant has adduced sufficient evidence against the Respondent that the matter falls into the circumstances in paragraph 4(b)(i) and 4(b)(iv) of the Policy. Accordingly, the Panel finds that the Complainant has established that the Respondent has registered or used the Disputed Domain Name in bad faith as required under paragraph 4(a)(iii) of the Policy.

6. PANEL DECISION

For the reasons in the foregoing paragraphs, the Panel is satisfied that the Complainant has succeeded in proving the presence of all the 3 elements of

paragraph 4(a) of the Policy. On this basis, the Panel hereby directs the Disputed Domain Name, namely <**disini.com**>, be transferred to the Complainant.

Kenneth Chung
Sole Panelist

Date: 10 December 2010
Hong Kong