



Asian Domain Name Dispute Resolution Centre

hongkong

**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-18010136
<b>Complainant:</b>	Disney Enterprises, Inc.
<b>Respondent:</b>	Bai Xing You
<b>Disputed Domain Name(s):</b>	< it-disneystore.com >

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**1. The Parties and Contested Domain Name**

1. The Complainant is Disney Enterprises, Inc., of 500 S Buena Vista Street, Burbank, CA, 91521, USA.
2. The Respondent is Bai Xing You, of pu tian shi jiang han qu, putian shi, Fujian China 351100.
3. The domain name at issue is <it-disneystore.com>, registered by Respondent with GoDaddy.com, LLC.

**2. Procedural History**

4. The Complainant filed this complaint with the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 29 June 2018.
5. A copy of the Complaint was sent to the Respondent on 4 July 2018 and re-sent several times thereafter.
6. The Respondent failed to respond within 20 calendar days as required under paragraph 5 of the UDRP Rules.
7. On 20 August 2018, after confirming that he was able to act independently and impartially between the parties, the ADNDRC appointed David Allison as the sole Panelist in this matter.

**3. Factual background**

8. The Complainant, Disney Enterprises, Inc., is one of the world's top entertainment companies. The Complainant first opened the Disneyland theme park and resort in Los Angeles in 1955. The Complainant also operates Disneyland theme parks and resorts in Orlando, Tokyo, Paris, Hong Kong and Shanghai. The Complainant has registered

numerous “DISNEY” and “THE DISNEY STORE” marks in English all over the world. Such registrations include a significant number of registered “DISNEY” trademarks in China and Hong Kong (the “Trademarks”).

9. The Complainant also registered and operated the top level domain names <www.disney.com> and <www.disneyland.com> since 1990 and 1995, respectively.
10. The evidence submitted by the Complainant clearly demonstrates that the Complainant has extensive and long standing trademark rights in DISNEY, DISNEYLAND and numerous variations of the same. The Complainant is very well known to consumers throughout the world.
11. The Respondent failed to file any Response. Accordingly, little is known about the Respondent. However, based on the relevant WHOIS search report, it appears that the respondent is an individual based in Mainland China.

#### **4. Parties’ Contentions**

##### Complainant

12. The Complainant’s contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to the trademarks owned by the Complainant.
- ii. The Respondent has not been authorized by the Complainant and has no rights to the DISNEY trademarks.
- iii. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services.
- iv. The Respondent was well aware of the Complainant’s trademarks prior to registering the disputed domain name.

##### Respondent

13. The Respondent has not filed a response to the Complainant’s complaint.

#### **5. Findings**

14. The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name 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; and
- iii. Respondent’s domain name has been registered and is being used in bad faith.

15. Although the Respondent has failed to file a response, the Panel must still satisfy itself that each of the three elements noted above has been satisfied. Accordingly, each of the three elements will now be examined in turn.

#### **A) Identical / Confusingly Similar**

16. When assessing the disputed domain name in respect of confusing similarity, it is a well-accepted principle that TDL suffixes such as “.com”, “.net”, etc are to be ignored. Likewise, non-distinctive elements, such as “store” can also be disregarded.

17. The Complainant argues that the “it” prefix at the beginning of the disputed domain name would merely be regarded by consumers as a geographical indicator, namely as designating “Italy”. The Complainant provided evidence showing that the prefix “it” is regularly used by internet users to designate Italy and this evidence, together with the fact that disputed domain name appears to be written solely in the Italian language, supports this argument. Non-distinctive geographical indicators such as this “it” element are ignored for the purpose of assessing confusing similarity.

18. In light of the above, the only distinctive element of the disputed domain name which is to be assessed is the element “DISNEY”. This element is identical to the many trademarks held by the Complainant worldwide. As such, the first element is satisfied.

#### **B) Rights and Legitimate Interests**

19. The Complainant argues that the Respondent has never been authorized by the Complainant to use its trademarks. This is despite the fact that the website of the disputed domain name prominently uses the Complainant’s trademarks, which suggests to users of the website that it is somehow associated with or authorized by the Complainant.

20. The Panel also notes that the disputed domain name appears to have no discernable relationship to the Respondent’s name, nor is the Respondent’s name to be found anywhere on the website. Indeed, there is no indication whatsoever of the Respondent’s identity or business nor is there anything to suggest that the website is an authorized “DISNEY” website.

21. While the overall burden of proving this element rests with the Complainant, it also recognizes the well-established principle that once the Complainant establishes a prima facie case that the Respondent lacks sufficient legitimate rights and interests, then the burden shifts to the Respondent.

22. In this case, the Panel finds that the Complainant has adduced a sufficient prima facie case whereas the Respondent has failed to adduce any evidence whatsoever. Therefore, the Panel finds that the second element of UDRP paragraph 4(a) is made out.

#### **C) Bad Faith**

23. To establish the third element, the Complainant must establish that the Respondent both registered and used the disputed domain name in bad faith. Bad faith may be established through examination of all of the circumstances of a case to see whether the

Respondent takes unfair advantage of or otherwise abuses a Complainant's trademark. In addition, the circumstances outlined at paragraph 4(b) of the UDRP may be taken into account.

24. In this case, the Complainant has adduced evidence to show that the Respondent is indicating itself as an "official" DISNEY store and is selling a large number of DISNEY labeled products for sale. Crucially, the website does not accurately or prominently disclose the Respondent's relationship to the Complainant or its rights to display and use the Disney marks. In such a case, the clear conclusion is that the Respondent has established the disputed domain name and used the website for the purpose of confusing consumers and to attract business away from legitimate and authorized sites.
25. As a result, UDRP paragraph 4(b)(iv) is satisfied, namely that "*... by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website ...by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site ...or a product or service on your website*".
26. Accordingly, the Panel finds that the Respondent intentionally used the disputed domain name as a means to confuse and attract consumers to its site. Such use satisfies the definition of bad faith as described in UDRP paragraph 4(b)(iv).
27. In addition, the Complainant argues that due to the extensive fame and recognition of the DISNEY trademarks in mainland China (and indeed worldwide), that the Respondent could not have been unaware of the Complainant's trademarks and prior rights. Whilst the Complainant has adduced relatively little evidence to support this argument, the Panel is aware from its own knowledge that DISNEY is an extremely well-known trademark in Mainland China and as a result it is extremely unlikely that the Respondent would have been unaware of the prior rights of DISNEY. This conclusion is doubly reinforced by the fact that the Respondent almost exclusively sells DISNEY labelled merchandise on its website. Such prior knowledge is a further indication of the Respondent's bad faith.
28. Considering all of the matters described above, the evidence adduced by the Complainant and the complete lack of response/ evidence filed by the Respondent, the Panel has no hesitation in finding the Respondent has applied for and used the disputed domain name in bad faith. Accordingly, the third element of UDRP paragraph 4(a) is made out.

**6. Decision**

29. The Panel finds that the Complainant has satisfied all three elements of UDRP paragraph 4(a). Accordingly, the Panel orders that the disputed domain name <**it-disneystore.com**> be transferred to the Complainant.

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David Allison  
Panelist

Dated: 02 September 2018