



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-18010155
Complainant:	Disney Enterprises, Inc.
Respondent:	bai xing you
Disputed Domain Name:	<disneysale.net >

1. The Parties and Contested Domain Name

The Complainant is Disney Enterprises, Inc. (“the Complainant”) of 500 S Buena Vista Street, Burbank, CA 91521, USA, represented by Mr William Hang LAW of ATL Law Offices, 16/F, China HK Tower, 8 Hennessy Road, Wanchai, Hong Kong.

The Respondent is bai xing you (“the Respondent”) of pu tian shi jiang han qu, pu tian shi, Fujian, CN 351100, unrepresented.

The contested domain name is <disneysale.net >, registered with GoDaddy.com, LLC of 14455 North Hayden Road, Suite 219, Scottsdale, AZ 85260, USA (“the Registrar”).

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the “Center”) on 24 July, 2018. On that same day the Center transmitted by email to the Registrar a request for registrar verification in connection with the domain name at issue. On 25 July, 2018 the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”), and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on 25 July, 2018. In accordance with the Rules, the due date for Response was 14 August, 2018. No Response was received by the Center.

The Center appointed Debrett G. Lyons as panelist in this matter on 24 August, 2018. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

A. For Complainant

1. The Complainant has a long established, well-known business providing entertainment and related goods and services by reference to the trademark **DISNEY**.
2. The Complainant is the owner of, amongst others, HK Trademark Regn. No. 1987B2624 in class 28 for the trademark **DISNEY**, registered since 1987.
3. The Complainant has not licensed or otherwise permitted the Respondent to use the trademark or to register or use any domain name incorporating the trademark.
4. The Complainant petitions the Panel to order transfer the disputed domain name from the Respondent to the Complainant.

B. For Respondent

5. The Respondent registered the contested domain name on 9 February 2018.
6. The contested domain name resolves to a website which poses as an official “Disney Store” and lists for sale a large number merchandising products normally sold by Complainant.

4. Parties’ Contentions

A. Complainant

The Complainant asserts rights in the trademark **DISNEY** and states that the contested domain name is confusingly similar to the trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the contested domain name.

The Complainant alleges that the Respondent registered and used the contested domain name in bad faith.

B. Respondent

No Response was filed and there were no other submissions from Respondent.

5. Findings

Paragraph 4(a) of the Policy states that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name be identical or confusingly similar to a trademark or service mark in which Complainant has rights;

- 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.

A) Identical / Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the contested domain name is identical or confusingly similar to the trademark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trademark rights. It is accepted that a trade mark registered with a national authority is evidence of trademark rights for the purposes of the Policyⁱ. The Panel finds that the Complainant has trademark rights in **DISNEY** acquired through registration.

For the purposes of comparing the trademark with the contested domain name, it has long been held that generic top-level domains, such as “.net” in this case, can be ignoredⁱⁱ. The contested domain name otherwise differs from the trademark simply by addition of the descriptive word “sale”, which is of no distinctive value. The Panel finds that the contested domain name is confusingly similar to the trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the contested domain name. Nevertheless, it is well-settled that the Complainant need only make out a *prima facie* case, after which the onus shifts to the Respondent to rebut such *prima facie* case by demonstrating rights or legitimate interestsⁱⁱⁱ.

Paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The publicly available WhoIs database identifies the registrant as “bai xing you” and so does not support any conclusion that the Respondent might be commonly known by the

contested domain name. There is no evidence that the Respondent has trademark rights in the contested domain name, registered or not.

There is no evidence that the contested domain name has ever been used in connection with a *bona fide* offering of goods or services. The evidence accompanying the Complaint shows that the domain name resolves to a website which prominently shows the trademark DISNEY in the same stylized form commonly used by Complainant, followed by the word “STORE”. The resolving website then shows images of and lists for sale a large number merchandising products normally sold by Complainant. The Panel finds that the resolving website attempts to pass itself off as an official website either belonging to, or authorized by, Complainant^{iv}. Complainant does not allege that the goods offered for sale at the resolving website are counterfeit goods; instead it relies on the fact that Respondent is not authorized to sell those goods and has not otherwise adhered to conduct UDRP panelists have required of resellers of genuine merchandise, in particular, the requirement that the resolving website must accurately and prominently disclose the domain name registrant’s relationship with the trademark holder^v. In this case there is no such disclosure and the inclusion on the resolving website of a 2017 copyright notice only strengthens the false suggestion that the website is maintained by Complainant.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the contested domain name and so the onus shifts to the Respondent to show a right or legitimate interest in the name. In the absence of a Response that onus is not met. The Panel finds that the Respondent has no rights or legitimate interests in the contested domain name and so the Complainant has satisfied the second element of the Policy.

C) Bad Faith

Policy ¶ 4(b) sets out the circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

- (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 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 your website or location or of a product or service on your website or location.

The Panel finds that Respondent's conduct falls squarely under paragraph 4(b)(iv) above. The Panel has already found the contested domain name confusingly similar to the trademark. The resolving website exists for commercial gain. There is no legitimate reason why Respondent has adopted the trademark and the Panel finds that Respondent's intention was to attract Internet users to the resolving website by creating a likelihood of confusion with the trademark as to the source, sponsorship, affiliation, or endorsement of that website.

The Panel finds that Respondent registered and used the contested domain name in bad faith and so finds that the Complainant has established the third limb of the Policy.

6. Decision

Having established all three elements required under the Policy, the Panel decides that relief shall be **GRANTED**.



Debrett G. Lyons

Panelist

Dated: 6 September 2018

ⁱ See, for example, *Mothers Against Drunk Driving v. phix*, FA 174052 (FORUM Sept. 25, 2003).

ⁱⁱ See, for example, *Am. Int'l Group, Inc. v. Domain Admin. Ltd.*, FA 1106369 (FORUM Dec. 31, 2007).

ⁱⁱⁱ See, for example, *Do The Hustle, LLC v. Tropic Web*, D2000 0624 (WIPO Aug. 21, 2000).

^{iv} See, for example, *Kmart of Mich., Inc. v. Cone*, FA 655014 (FORUM Apr. 25, 2006) where the panel found the respondent's attempt to pass itself off as the complainant was not a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).

^v See, *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No.D2001-0903.