



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1901269
<b>Complainant:</b>	Disney Enterprises
<b>Respondent:</b>	Xiu Sun
<b>Disputed Domain Name(s):</b>	< shopping-disneys.com >

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

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

The Respondent is Xiu Sun, Tsuen Wan 126, Hong Kong.

The domain name at issue is <shopping-disneys.com>, registered by Respondent with GoDaddy.com LLC, of 14455, Hayden Rd Suite 219, Scottsdale, Arizona, 85260, United States of America (USA).

**2. Procedural History**

On July 19, 2019, the Complainant submitted the Complaint in English on domain name <shopping-disneys.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 the Asian Domain Name Dispute Resolution Centre Supplemental Rules in effect as of February 28, 2002. The Complainant requested a single person panel.

After receiving the Complaint, the Centre, in accordance with the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on July 24, 2019, the Centre requested the Registrar to confirm: (1) that the disputed domain name was registered with the Registrar, (2) whether the Respondent is the registrant or holder of the name, and (3) whether the Policy applies to the name; and to specify: (4) the language of the Registration Agreement of the disputed domain name, (5) WhoIs information for the disputed domain name, and (6) the current status of the domain name.

On July 31, 2019, the Registrar provided its response to the Centre through which it (1) specified that the registrant is Xiu Sun. In addition, the Centre confirmed that: (2) the name was registered with GoDaddy.com LLC, and (3) the Policy applies to the name. The Registrar also stated that (4) the registration agreement is in the English language, (5) provided name and contact information pertinent to the name as reflected in its WhoIs database, and stated that (6) the domain name was locked and would remain locked during the pending administrative proceeding. As requested by paragraph 4 (b) of the Rules, the Centre asked the Complainant to revise the Complaint Form with regard to the details of the Registrant on or before August 5, 2019, failing which the Complaint will be deemed withdrawn without prejudice to submission of a different complaint by the Complainant.

On August 5, 2019, the Complainant submitted a revised Complainant to the Centre, within the required period of time, with regard to the registrant details only.

On August 6, 2019, the Centre sent the Complaint to the Respondent. The Respondent was then provided with a 20-calendar day period, expiring on August 26, 2019, to file its Response both with the Centre and the Complainant. As of August 26, 2019, the Respondent had not filed any Response with the Centre. Accordingly, on September 2, 2019, the Centre advised the parties by email that the Respondent had not filed any Response to the Complaint with the Centre on or before the deadline and, as such, the Centre would then proceed to appoint a Panelist for this matter.

Pursuant to the Rules and Supplemental Rules, the Centre, by email dated September 9, 2019 contacted the undersigned, Professor Julien Chaisse, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Professor Chaisse responded and affirmed his ability to act completely independently and impartially in this matter. Subsequently, the Centre, through an email dated September 9, 2019, notified the Parties of the appointment of Professor Chaisse as the Sole Panelist. The Panel finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before September 23, 2019.

### **3. Factual background**

**The Complainant:** Disney Enterprises, Inc.

The Complainant, Disney Enterprises, Inc., is one the world's most well-known 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. Furthermore, the Complainant has registered the several other relevant trademarks in China and Hong Kong (the "Trademarks").

The Complainant also registered and operated the top-level domain names [www.disney.com](http://www.disney.com) and [www.disneyland.com](http://www.disneyland.com) since 1990 and 1995, respectively.

## **The Respondent**

As indicated in the WhoIs registration record provided in Annexure I to the Complaint, the Respondent registered the disputed domain name on July 9, 2018. Since July 24, 2019, the Disputed Domain Name has been locked by the Registrar and is currently inactive. The Centre confirmed that documents have been sent to the Respondent's address as registered with the registrar GoDaddy.com LLC. However, the Centre did not receive a Response Form R from the Respondent for the Domain Name Dispute concerning Domain Name <shopping-disneys.com>.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant's contentions may be summarized as follows:

##### **i. Identical or Confusingly Similar**

The Complainant submits that the Disputed Domain Name is identical or confusingly similar to marks in which the Complainant has rights on the basis of its "DISNEY" and "THE DISNEY STORE" marks registrations. The Disputed Domain Name and the Complainant's registered Disney trade mark are identical.

The Complainant accordingly submits that it has proved that the Disputed Domain Name is identical and/or confusingly similar to its registered trade marks in which the Complainant has rights or interests for the purposes of paragraph 4(a)(i) of the Policy.

##### **ii. Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a) (ii) and particular 4(c) of the Policy.

In particular, the Respondent registered the disputed domain name on July 9, 2018, long after most of the application and registration dates of the Complainant's "DISNEY" and "THE DISNEY STORE" marks.

The Complainant accordingly submits that it has proved that the Respondent has no right or legitimate interest in respect of any of the Disputed Domain Name for the purposes of Article 4(a)(ii) of the Policy.

##### **iii. Registered and Used in Bad Faith**

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy. According to the Complainant, there are seven grounds for an inference of bad faith based on the following:

- 1) The long history and high degree of fame enjoyed by the Complainant and its trademarks in the world, including in China;
- 2) The filing dates of the Complainant's marks long before the registration date of the disputed domain name;

- 3) The incorporation of the Complainant's famous trademark in its entirety in the disputed domain name; and,
- 4) The various additional infringing domain names associated with the Respondent targeting the Complainant's "DISNEY" and "THE DISNEY STORE" marks.

The Complainant accordingly submits that it has proved that the Respondent has registered and used the Disputed Domain Name in bad faith for the purposes of Article 4(a)(iii) of the Policy.

#### B. Respondent

The Centre did not receive a Response Form R from the Respondent for the Domain Name Dispute concerning Domain Name <shopping-disneys.com>. The Respondent is in default.

### 5. Findings

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.

#### i) Identical / Confusingly Similar

This element of the Policy requires the Complainant to prove that it has rights in a trademark or service mark, and that the Disputed Domain Name is identical to or confusingly similar to such trademark or service mark.

The Disputed Domain Name < shopping-disneys.com > is comprised of two words: "shopping" and "disneys". The first part is a dictionary and generic word "shopping". The second part "disneys" contains the very distinctive "DISNEY" Trademark which is well recognized meaning among the public. In fact, "disneys" is a plural form of "disney" and from trademark angle, it is almost identical to the "DISNEY" Trademark.

The word "shopping" itself is not distinctive and in many ADNDRC and WIPO decisions, the mere inclusion of a generic word does not make the rest of the domain name more distinctive. Therefore, the Disputed Domain Name is almost identical or confusingly similar to the registered Trademarks (and service marks) of the Complainant.

The disputed domain name <shopping-disneys.com> contains the Complainant's "DISNEY" and "THE DISNEY STORE" marks and the Complainant's trade name in its entirety. This striking resemblance will mislead consumers into believing that the website is operated by or associated with the Complainant.

The Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

## **ii) Rights and Legitimate Interests**

Based on the evidence of record here, the Panel finds that no basis exists which, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The Disputed Domain Name is the tradename 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, a Chinese individual, with declared address in China, has not been commonly known by the domain name; or (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.

As stated in *Madonna Ciccone v. Dan Parisi*, WIPO Case No. D2000-0847 (October 16, 2000), "use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods or services [...] to conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation which is obviously contrary to the intent of the Policy." Here, the Disputed Domain Name is "parked" (i.e. the parked domain name means that visitors see a temporary Web page when they enter the domain name in their browser) with the registrar of the Disputed Domain Name and the webpage to which the Disputed Domain Name is pointed invites offers for the purchase of the Disputed Domain Name.

The Panel infers from the above that the Respondent is not using the name on either a non-commercial or fair use basis without intent to misleadingly divert consumers or tarnish any of the Complainant's marks, or, prior to receiving notice of this dispute, in connection with any bona fide offering of goods or services or demonstrable preparations for making such an offering, thus failing to qualify under either of paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a) (ii) and 4(c) of the Policy.

## **iii) Bad Faith**

In accordance with Paragraph 4(a)(iii) of the Policy the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

The requirement of bad faith is distinct from the requirement that the Respondent lacks any right or legitimate interests in the disputed domain name. As expressed by another panel, something more is required because the Policy is not only designed to combat trademark infringement on the Internet or even questionable cases of cybersquatting, but rather abusive, bad faith cybersquatting (*Edward Van Halen v. Deborah Morgan*, WIPO Case No D2000-1313).

Paragraph 4(b) of the Policy sets forth four criteria that are to 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 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."

In the present dispute, it is apparent that the Respondent has deliberately registered the Disputed Domain Name which is confusingly similar to the Complainant's trademark "DISNEY", 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.

The Respondent, which is situated in China, should be well aware of Disney and its group of companies which are well-known in China and the rest of the world by the time of registration in 2018. Further, given the substantial fame of the Complainant and its Disney Store and the Disneyland Parks and Resorts throughout the world, it is unconceivable that the Respondent could be unaware of the Complainant's rights in the "DISNEY" trademark. It cannot be a mere co-incidence that the Respondent has chosen the Disputed Domain Name, which is identical to the Complainant's Trademark, as his/her domain name.

Further, the website constructed under the Disputed Domain Name, [www.shopping-disneys.com](http://www.shopping-disneys.com), is now used to post itself as an official "Disney Store" and listed a large number of Disney products for sale. Under the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark. (See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No.D2001-0903; *Experian Information Solutions, Inc. v. Credit Research, Inc.*, WIPO Case No.D2002-0095).

Further, the Respondent has tried to confuse the members of the public that it is related to Disney by way of creating an "ABOUT DISNEY" page with the background of the Complainant.

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use. Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(i) thereof. Thus, the Panel concludes that the Complainant has provided sufficient proof of

its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## 6. Decision

Based on the above analysis, the Panelist decides that: (1) the disputed domain name <shopping-disneys.com> is confusingly similar to the Complainant's name or mark in which the complaint has rights; (2) the Respondent has no right or legitimate interest in respect of the disputed domain names; (3) the Respondent has registered and is using the domain name in bad faith.

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panelist grants the relief sought by the Complainant. The disputed domain name, <shopping-disneys.com>, is ordered transferred to the Complainant.

A handwritten signature in dark ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

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Prof. Julien Chaisse  
Panelist

Dated: September 15, 2019