

कृमिपुत्रादि तमिलनाडु TAMILNADU

AT 004357

P.S. SHANMUGASUNDARAM
STAMP VENDOR,
L No B4 / 109 / 88
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

D. SARAVANAN
Advocate & Arbitrator
"Orient Chambers", 4th & 5th Floor,
No. 90 / 73, Armenian Street,
Chennai - 600 001.

15 MAY 2014

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: <disneyindia.in>

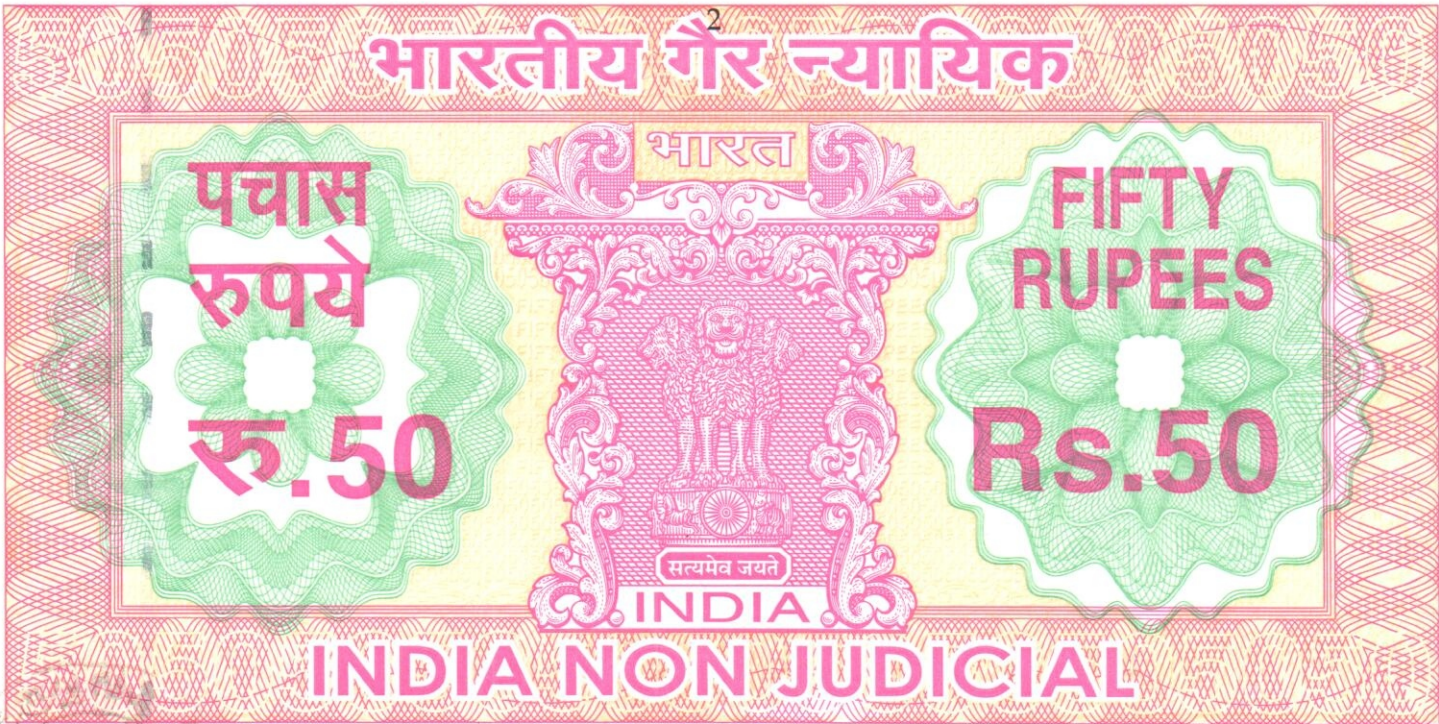
1. Disney Enterprises Inc.
500, South Buena Vista Street,
Burbank, California 91521
USA
2. The Walt Disney Company (India) Pvt Ltd
1st Floor, Building No. 14,
Solitaire Corporate Park,
Guru Hargovindji Marg,
Chakala, Andheri (East),
Mumbai- 40009

.. Complainants

Versus

...2/





தமிழ்நாடு தமில்நாடு TAMILNADU

5 MAY 2014

D. SARAVANAN
Advocate & Arbitrator
"Orient Chambers", 4th & 5th Floor,
No. 90 / 73, Armenian Street,
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AE 155654
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-2-

Registrant ID: DI_7305075
Domain Administrator,
19 Moulton Park Office Village
Northampton
NN36AP
GB

..Respondent

1. The Parties:

The Complainant No.1 is Disney Enterprises Inc., having its place of business at 500, South Buena Vista Street, Burbank, California 91521, USA.

The Complainant No.2 is The Walt Disney Company (India) Pvt. Ltd., having its registered office at 1st Floor, Building No.14, Solitaire Corporate Park, Guru Hargovindji Marg, Chakala, Andheri (East), Mumbai- 400 093.

..3/



The respondent is Registrant ID: DI_7305075, Domain Administrator, 19 Moulton Park Office Village, Northampton, NN36AP, GB.

2. The Domain Name and Registrar:

The disputed domain name is: <www.disneyindia.in>

The disputed domain name is registered with Web Services Pvt. Ltd.

3. Procedural History:

04.04.2014	The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
04.04.2014	Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
23.04.2014	The .IN Registry sent an email communication to the Arbitral Tribunal, marking a copy of the same to the Respondent and Claimant, stating that the complaint with annexure sent by them to the Respondent vide Consignment No.7653047684 has been undelivered due to consignee's incorrect address.
25.04.2014	Arbitral Tribunal sent an email directing the Claimant to send a soft copy of the complaint and annexures to the Respondent and upon receipt of the same the Respondent was directed to file his response within 10 days.
01.05.2014	Pursuant to the directions of this Tribunal the Complainant had sent a soft copy of the complaint and annexures to the Respondent.
10.05.2014	Due date for filing response.
15.05.2014	Notice of default was sent to the respondent notifying his failure in filing the response, a copy of which was marked to the Complainant's representative and .IN Registry.



4. Factual Background

4.1 The Complainants:

The Complainant No.2 is the master licensee of the Complainant No.1 in respect of its intellectual properties in India and is responsible for granting license for commercial exploitation of the Complainant No.1 and thus any unauthorized and illegal use of trademarks of Complainant No.1 detrimentally affects the business interest of Complainant No.2 in India. Complainant No.2 is therefore an affected and interested party, whenever Complainant No.1's intellectual property rights are infringed/ violated.

4.2 Complainants' Activities:

The Walt Disney Company is the largest media company in the world founded in 1923 by Mr. Walt Disney. The Complainants are the affiliates of the Walt Disney Company. The Complainants are exert in creating and distributing highly creative and entertaining animated motion pictures and television programmes whose unique characters have achieved mythic proportions in popular culture. The Complainants have also built theme parks and merchandise industry around numerous such characters. The Complainants are popularly and commonly known as DISNEY, which word, apart from being a house mark, also forms a prominent, inseparable and integral part of their corporate names. Any use or reference to the mark/word DISNEY would connote and denote a Walt Disney Company.

4.3 Complainant's Trading Name:

The trade mark DISNEY was adopted in the year 1923, by virtue of its long and continuous use since its adoption, across an array of Goods and services in relation to Complainants' business, and has become immensely popular. The DISNEY name and trademark has become well-known all across the globe including India. The Complainants own and operate three television channels in India, DISNEY Channel, DISNEY Junior and DISNEY XD which are reflective of the immense popularity that the trade mark DISNEY enjoys in the Indian market.



The Complainants are the owner of the trademark DISNEY. The Complainants have registered the following trademarks:-

Mark	Registration No.	Class
DISNEY	596822	24
WALT DISNEY	516177	9
WALT DISNEY	516178	14
WALT DISNEY	516180	25
WALT DISNEY	516181	28
DISNEYLAND	1306098	99
DISNEY TIME	820225	16
DISNEY BABIES	596821	16
DISNEY BABIES	596824	24
DISNEY BABIES	596826	28
DISNEY ADVENTURES	664114	25
DISNEY ADVENTURES	664115	28
DISNEY HAND	1236416	36
DISNEY HAND	1236415	41
DISNEY BLANKETEERS	1236417	41
DISNEY VOLUNTEARS	1236418	41
DISNEY CHANNEL	1276401	99
TOON DISNEY CHANNEL	1320856	99
PLAYHOUSE DISNEY	1276406	41
DISNEY FAIRIES	1367060	99
DISNEY ARTIST	1487797	35
DISNEY CHANNEL'S MASTI EXPRESS	1502799	
DISNEY INTERACTIVE STUDIOS	1552185	9



IN THE NAME OF DISNEY ENTERPRISES, INC. WITH DEVICE	1479528	99
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The Complainant No.1 is the exclusive owner and proprietor of the trademark DISNEY. Thus, any unauthorized use of the Complainant No.1's DISNEY marks is detrimental to the distinctive character or reputation of the trademark and such unauthorized use and/or misappropriation of the Complainant No.1's trademark DISNEY would also result in causing a high degree of confusion and deception amongst a substantial part of the public leading to dilution of the Complainant No.1's well-known and reputed trademark DISNEY and a violation of their common law, trade mark rights, amounting to passing off. Under the trademark DISNEY, the Complainants maintain a formidable presence over the internet. Apart from www.disney.com, the Complainants also maintain www.thewaltdisneycompany.com, www.disneystore.com, www.disneyanimation.com, www.disneyjunior.com, www.disneyinternational.com, www.disneyholidays.co.uk, www.disneyresearch.com, www.waltdisneystudios.com and possess several domain name registration which incorporate the trademark DISNEY. The Complainants also operate an India specific website www.disney.in since 9th March, 2006. The website operations clearly reflect the considerable value that the trademark DISNEY holds for the Complainants.

5. Respondent's Identity and activities:

According to WHOIS search database, the respondent in this administrative proceeding is Registrant ID: DI_7305075, Domain Administrator, 19 Moulton Park Office Village, Northampton, NN36AP, GB.

6. Dispute

The dispute arose when the respondent registered and used the domain name www.disneyindia.in. According to the WHOIS database, the disputed domain name was registered on 28.01.2014. The registrar with whom the domain name is



registered is Webiq Domain Solutions Pvt Ltd., PO Box 2226, Noosa Heads, Queensland 4567, Australia.

7. Parties contentions:

A. Complainant:

i. The domain name <disneyindia.in> is identical/ confusingly similar to complainant's trade mark DISNEY:

a) The complainant states that the impugned domain name www.disneyindia.in consists of the Complainants' trademark DISNEY in its entirety and the country name INDIA. It is submitted that the incorporation of the country name INDIA does not add distinctiveness to the impugned domain name and does not avoid a likelihood of confusion.

b) The Complainants cite that in Toyota Jidosha Kabushiki Kaisha a/k/a Toyota Motor Corporation versus Atma Estate WIPO Case No. D2006- 1231 where it was held that lexus-ukraine.com was confusingly similar to LEXUS trademark. The Complainants also cite that in Loreal SA versus LV Kefeng WIPO Case No.D2009-1231 wherein it was held that the addition of common geographic terms to the trademarks to form the domain names <lorealchina.org> and <maybellinechina.org> resulted in domain names which were confusingly similar to the trademarks.

ii. Respondent has no rights or legitimate interests in respect of the domain name <disneyindia.in>:

The word DISNEY is an extremely unique and rare surname with no denotative meaning. It is extremely distinctive in nature and serves as source identifier of the goods and services offered or licensed by the complainants. DISNEY is a well known trade mark around the globe. The respondent was at no point of time being known by the name/ mark DISNEY or the impugned domain name <disneyindia.in>.



iii. The domain name <disneyindia.in> was registered and is being used in bad faith:

a) The domain name has presumably been registered to gain illegitimate consideration from Complainant No.1. The respondent has clearly registered the domain name for the sole purpose of seeking commercial gain by diverting potential customers of the complainant to its website.

b) The complainant also states that the respondent has parked the impugned domain name <disneyindia.in> for sale, with sponsored listings, and adduces that the domain name was acquired primarily to unlawfully gain from such sponsored listings/ squatting of the domain name and to usurp huge amount money from the Complainant No.1 or any of its competitor, in return for transferring the domain name. The respondent is trying to dilute the distinctiveness of the complainants' trademark DISNEY.

B. Respondent:

In spite of repeated notice and reminders, the respondent did not submit any response. The respondent has not reflected his identity in the WHOIS database report.

8. Discussion and Findings:

It has to be asserted as to whether the Constitution of Arbitral Tribunal was proper? Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainants. However, the Respondent did not choose to submit any response and that non-submission of the Response by the Respondent had also been notified to the Respondent on 15.05.2014.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainants must prove each of the following three elements of its case:



- (i) The respondent's domain name <disneyindia.in> is identical to the trademark DISNEY;
- (ii) Respondent has no rights or legitimate interests in respect of the domain name <disneyindia.in>; and
- (iii) The registration and usage of domain name <disneyindia.in> by the respondent is in bad faith.

(a) Identical or confusing similarity:

- i. The Arbitral Tribunal finds that the trade mark DISNEY is identical to respondent's domain name <disneyindia.in>
- ii. The Tribunal also finds that by merely affixing a geographical name like that of a country's name as a prefix or suffix will not remove the distinctiveness of the trade mark.

The Arbitral Tribunal concludes that the Complainants have established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

- i. The Complainants contend that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in these proceedings to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name. Although, the Complainants are not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences



from the failure of the Respondent to respond. The Complainants have established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

ii. Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainants assert that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii. The Arbitral Tribunal find that there is no evidence on record to show that Respondent is known by the disputed domain name or that he has used the disputed domain name in connection with a bona fide offering of goods or has any rights in the disputed domain name.

iv. The respondent has failed to show any justification for the adoption, usage or registration of disputed domain name.

v. The Arbitral Tribunal thus holds that the circumstances listed above demonstrate rights or legitimate rights of the Complainants in the domain name and holds that the respondent has infringed the rights of the Complainants by registering the trademarks of the complainants.

vi. The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

(i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in a pattern of such conduct and the Respondent has



intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the Complainants 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 web site or location. It is the specific case of the Complainants that the respondent's modus operandi is by creation of the website under the registered <disneyindia.in> mark with generic/descriptive suffix, is seeking illegal commercial gain through its opportunistic bad faith registration of the disputed domain name.

(ii) The Arbitral Tribunal observes that the Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical to registered trademark of the Complainants. The Respondent has no affiliation or connection or any kind of relationship with the Complainants. Registration of a domain name that is identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

(iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was a malafide intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainants to have peaceful usage of the Complainants' legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainants have established that the disputed domain name was registered and is being used in bad faith.



9. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <disneyindia.in> be transferred to the Complainants.

Dated at Chennai (India) on this June 17th, 2014.


(D.SARAVANAN)
Sole Arbitrator