



सत्यमेव जयते

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Dr. V. K. AGARWAL,
Sole Arbitrator
NATIONAL INTERNET EXCHANGE OF INDIA
6C, 6D, 6E, Hansalaya Building,
15, Barakhamba Road,
New Delhi – 110 001

Disney Enterprises, Inc., v. Aven

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CASE NO. INDRP/1199**AWARD****1. The Parties**

The Complainant is Disney Enterprises, Inc., 500, South Buena Vista Street, Burbank, California - 91521, United States of America

The Respondent is Mr. Aven, ajgmd, daj, dl, IN, Pin Code 348045. GB.

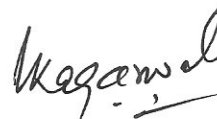
2. The Domain Name and Registrar

The disputed domain name is <www.shopdisney.co.in>. The said domain name is registered with Dynadot LLC, P 210 S, Ellsworth Avenue, #345 San Mateo, California – 94401, United States of America. The details of registration of the disputed domain name, as indicated in WHOIS (Annexure 1 to the Complaint) are as follows:

(a) Registrar:	Dynadot LLC,
(b) Date of creation:	November 14, 2019
(c) Expiry date:	November 14, 2020

3. Procedural History

(a) A Complaint dated January 20, 2020 has been filed with the National Internet Exchange of India. The Complainant has made the registrar verification in connection with the domain name at issue. The print outs so received are attached with the Complaint as Annexure 1. It is confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian



Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.

- (b) The Exchange appointed Dr. Vinod K. Agarwal, Advocate and former Law Secretary to the Government of India as the sole arbitrator in this matter. The arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (b) In accordance with the Policy and the Rules, an attempt was made to send a copy of the Complaint to the Respondent on the given address. However, due to incomplete address the copy of the Complaint could not be served on the Respondent. Hence, the present proceedings have to be ex parte.

4. **Factual Background**

From the Complaint and the various Annexure to it, the Arbitrator has found the following facts:

Complainant's activities

According to the Complaint, in the year 1923 Mr. Walt Disney founded a company in the United States. The Company adopted the name of the founder and became popularly known as **DISNEY**. The Complainant "Disney Enterprises Inc." is an affiliate of the Walt Disney Company and is based in the State of Delaware, United States of America. The word **DISNEY** being a unique and rare surname with no denotative meaning has all the taping of an invented word. It is distinctive in nature and serves as a source identifier of the goods and services offered or licensed by the Complainant.



The Complainant is engaged in various businesses and offers a wide range of products and services, particularly as creators and distributors of creative and entertaining animated motion pictures and various television programmes.

The Complainant is well known in India also. The Complainant and its affiliated companies own, operate and broadcast three TV Channels in India, namely, DISNEY Channel, DISNEY Junior and DISNEY XD, which primarily telecast the Complainant's programmes and movies. According to the Complaint, The Complainant has grown over the years to become the world's largest online broadcaster, with stand along websites in **India**,

Respondent's Identity and Activities

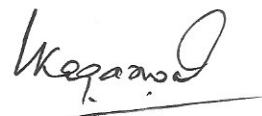
The Respondent's activities are not known.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the .IN Domain Name Dispute Resolution Policy is applicable to the present dispute. The said elements are as follows:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and



In relation to the said element (i), the Complainant contends that it is the exclusive owner and proprietor of the trademark DISNEY. The trademark DISNEY is registered by the Complainant in many countries, including India, in various classes. Consequently, the Complainant has exclusive right to use and/or authorize/license the use, in any manner whatsoever of the DISNEY mark. A copy of the list of trademarks owned by the Complainant incorporating the word DISNEY is annexed as Annexure 3. Copies of the registration certificates of trademarks owned by the Complainant incorporating the word DISNEY are annexed as Annexure 4.

The Complainant has further contended that the disputed domain name is identical with and/or confusingly similar to the Complainant's **DISNEY** mark. The disputed domain name incorporates the Complainant's trade name and registered trademark **DISNEY** in its entirety along with the descriptive word "shop" as a prefix.

Complainant owns a large number of domain names with the word "Disney". The Complainant even owns a domain name with the word "shop" as follows: <www.shopdisney.com>. The Complainant has also registered several country specific and other domain names and websites at international and domestic levels incorporating the designation **DISNEY**. The other domain names possessed and owned by the Complainant are -
www.disney.com; (created on 21st March 1990)
www.disneyanimation.com; www.thewaltdisneycompany.com;
www.disneynow.com; www.disneyinternational.com;
www.disneyholidays.co.uk; www.disneyresearch.com;
www.waltdisneystudio.com; etc. These domain names were created by the

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Complainant much before the registration of the disputed domain name by the Respondent.

The Complainant is also the owner of India specific domain name www.disney.in. The aforesaid domain names have been registered and have been continuously in use and updated since 09th March 2006.

The Complainant contends that the disputed domain name contains the entire trademark of the Complainant, that is, DISNEY.

The addition of the generic word TLD, i.e. “.co.in” in the domain name is insignificant. It does not lead to any distinctiveness or reduce the similarity to the trademark “DISNEY” of the Complainant. It will not be perceived by the relevant public as a different, eligible to distinguish the Respondent or the services offered under the disputed domain name from the Complainant. Further that, it does not help in distinguishing the disputed domain name from the Complainant’s trademark. On the contrary, the disputed domain name leads the public to believe that it relates to the services rendered by the Complainant.

Therefore, the disputed domain name is identical and/or confusingly similar to the registered trademark ‘DISNEY’ of the Complainant.

In relation to the aforesaid element (ii), the Complainant contends that the Respondent (as an individual, business, or other organization) has not been commonly known by the mark “DISNEY”. The Respondent does not own any trademark registration as “DISNEY” or a mark that incorporates the expression DISNEY. The Respondent has no license or authorization or permission from the Complainant to either use the mark DISNEY or to register the disputed domain name.

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Further, the Respondent does not have any rights or legitimate interest in the domain name because the Respondent has not exhibited any preparatory steps for using the domain name in connection with a *bona fide* offering of goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public. The Respondent's use of the disputed domain name is for fraudulent purposes, namely, to imitate a legitimate, well-reputed and trustworthy entity, i.e. the Complainant, so as to deceive e-commerce users into purchasing products through the impugned website that are never provided.

Therefore, the Respondent has no legitimate right, justification or interest in the disputed domain name.

Regarding the said element at (iii), the Complainant contends that the Respondent has registered the disputed domain name in bad faith and for its actual use in bad faith. The main object of registering the domain name <www.shopdisney.co.in> by the Respondent is to mislead the customers of the Complainant and internet users and the general public

Further that, absence of use and passive holding of a domain name constitutes bad faith. The Complainant has stated that the use of a domain name that appropriates a well-known trademark to promote competing or infringing products cannot be considered a "*bona fide offering of goods and services*".

The Complainant has further stated that the Respondent has parked the disputed domain name <www.shopdisney.co.in> for sale, with sponsored listings, adduces that the disputed domain name was acquired by the Respondent primarily to unlawful gain from such sponsored listings/squatting of the domain name and to usurp huge amount of money from the

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Complainant or any of its competitor, in return for transferring the domain name.

In support of its contentions, the Complainant has relied on a number of decisions by different entities. They have been duly considered. However, it has not been considered necessary to make their references during the aforesaid discussion.

B. Respondent

The Respondent did not submit any response.

6. Discussion and Findings

The Rules instructs this arbitrator as to the principles to be used in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

According to the Policy, the Complainant must prove that:

- (ii) The Registrant’s domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (iv) The Registrant’s has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (v) The Registrant’s domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name <www.shopdisney.co.in> was registered by the Respondent on November 14, 2019. The registration of the said disputed

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domain name will expired on November 14, 2020.

The Complainant is an owner of the registered trademark "DISNEY". It is registered in several countries of the world. The Complainant is also the owner of a large number of domains with the trademark DISNEY as stated above and referred to in the Complaint. Most of these trademarks and the domain names have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. The disputed domain name is <www.shopdisney.co.in>. Thus, the disputed domain name is very much similar or identical to the name and the trademark of the Complainant.

The Hon'ble Supreme Court of India has in a case recently held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for products of the Complainant in India or elsewhere would mistake the disputed domain name as of the Complainant.

Therefore, I hold that the domain name <www.shopdisney.co.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's 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

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- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial 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 Respondent's response is not available in this case. There is no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant/Respondent is Mr. Aven. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "DISNEY" or to apply for or use the domain name incorporating said mark. The domain name bears no relationship with the Respondent/ Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name as per INDRP Policy, Paragraph 4(ii).

C. *Registered and Used in Bad Faith*

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

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- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant's has 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 the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public. Further that, according to the Complainant, the Respondent has offered the disputed domain name for sale.

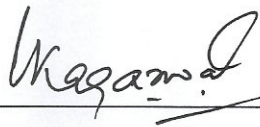
The Respondent's registration of the domain name <www.shopdisney.co.in> is likely to cause immense confusion and deception and lead the general public into believing that the said domain name enjoys endorsement or authorized by or is in association with and/or originates from the Complainant.

The foregoing circumstances lead to the presumption that the domain name in dispute was registered and used by the Respondent in bad faith.

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7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to a mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name, and that the domain name was registered in bad faith and is being used in bad faith, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <www.shopdisney.co.in> be transferred to the Complainant.



Vinod K. Agarwal
Sole Arbitrator
Date: February 17, 2020