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RANJAN NARULA

M 537404

ARBITRATOR

Appointed by the .In Registry - National Internet Exchange of India

In the matter of:

Disney Enterprises, Inc.

500 South Buena, Vista Street

Burbank, CA 91521

U.S.A

.....Complainant

Lokesh Morada

210 City Blvd West, 32

Orange,

CA 92868

U.S.A

.....Respondent

AWARD

1) The Parties:

The Complainant is Disney Enterprises, Inc. 500 South Buena, Vista Street, Burbank, CA 91521, U.S.A. The Complainant is represented by its authorized representatives Lance Griffin of Disney Enterprises, Inc., 500 South Buena, Vista Street, Burbank, CA 91521, U.S.A. through Pravin Anand of Anand and Anand, First Channel, Plot No. 17A, Sector 16A, Film City, Noida who have submitted complaint against the domain. The Respondent is Mr. Lokesh Morada, 210 City Blvd West, 32, Orange, CA 92868, U.S.A.

2) The Domain Name, Registrar & Registrant:

The disputed domain name is www.disneystore.in The Registrar is National Internet Exchange of India. The Registrant is Mr. Lokesh Morada (Respondent), 210 City Blvd West, 32, Orange, CA 92868, U.S.A

3) Procedural History:

The Complainant filed this complaint with the .IN Registry and the .IN Registry appointed "Ranjan Narula" ("The Arbitrator") as the Sole Arbitrator under clause 5 of its policy. On 07th December, 2010 the Arbitrator gave his statement of acceptance and declaration of impartiality and independence. The complaint was produced before the Arbitrator on 07th December, 2010 and the notice was issued to the Respondent on December 08, 2010 at his email address with a deadline of 10 days to submit his reply to the arbitration. The Respondent did not submit any response. On 4th Jan, the Arbitrator granted further opportunity to the Respondent to submit its response on or before 7th Jan, 2011. However, no response was submitted by the Respondent. Therefore the complaint is being decided based on materials submitted by the Complainant and contentions put forth by them.



4) Summary of the Complainant's contentions in the Complaint:

The complainant in support of its case has made the following submissions

- a. The Complainant and/or its subsidiary and affiliated companies is engaged in a variety of businesses, including the operation of theme parks around the world, producing and distributing motion pictures and television programs, producing and selling clothing, books, records, toys, and other merchandise, and providing entertainment services. A significant aspect of the complainant's business is the merchandising and licensing of distinctive elements associated with its motion pictures and television programs, including but not limited to, the world-famous characters Mickey Mouse, Minnie Mouse, Donald Duck, Daisy Duck, Goofy, Pluto and Winnie the Pooh, Piglet, Tigger, Kanga Roo, Rabbit, Hunny Pot and Owl as well as characters from animated motion pictures, including but not limited to, "Snow White and the Seven Dwarfs," "Pinocchio," "The Lion King," "Aladdin," "Beauty and the Beast," "The Little Mermaid," "Pocahontas," "Hunchback of Notre Dame," "Hercules," "Mulan," "Ratatouille", "Pirates of the Caribbean" and "Toy Story" (hereinafter collectively referred to as "Disney Characters"), the images of which serve as trademarks and also constitute copyrighted artwork.

- b. The Complainant owns all rights, title and interest in and to, and holds the exclusive rights (which have been licensed to various third parties from time to time) to market and sell merchandise, including, but not limited to, clothing, publishing, toys and services in connection with the images of the Characters (hereinafter referred to as the "Device Marks") as well as the DISNEY trade mark. The Plaintiff possesses both common law rights to the Disney Device Marks, as well as trademark registrations for certain Device Marks in more than 58 countries the world over, including but not limited to Algeria, Argentina, Australia, Bolivia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Czech Republic, Denmark, Ecuador, El Salvador, Finland, France, Germany, Greece, Guatemala, Honduras, Hong Kong, India, Indonesia, Ireland, Italy, Japan, South Korea, Latvia, Lebanon, Malaysia, Mexico, Myanmar, New Zealand, Norway, Pakistan, Panama, Paraguay, Peru, Philippines, Poland, Portugal, Russian Federation, Saudi Arabia, Singapore, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Taiwan, Thailand, Turkey, United Arab Emirates, United Kingdom, United States of America, Uruguay, Venezuela, Vietnam, and Zimbabwe. A photocopy of the list of some of the International Registrations in favour of the complainant has been filed as **Annexure A**.

- c. The complainant also owns all rights, title and interest in and to, and holds the exclusive rights to market and sell services and merchandise in conjunction with the complainant's famous trademarks and family of Disney trademarks and service marks, including but not limited to Mickey Mouse,



Minnie Mouse, Winnie the Pooh, Disney Donald Duck, Daisy Duck, Goofy, Pluto, Disney.com, Walt Disney World, and Disneyland (hereinafter collectively referred to as the ("Disney Word Marks"). The Complainant has utilized many of the Disney Word Marks in conjunction with the sale of a wide variety of products and services, for well over fifty years. Additionally, the complainant possesses numerous registrations with the United States Patent and Trademark Office for marks which consist of or include the word mark DISNEY.

- d. In addition to the worldwide trademark registrations spoken of hereinabove, the complainant is also the registered proprietor of both a variety of word marks and device marks in India, as elaborated below:

Trademark	Class	Registration/ Application No.
Walt Disney	09	516177
Walt Disney	14	516178
Walt Disney	25	516180
Walt Disney	28	516181
Disney Babies	25	596825
Disney Hand	41	1236415
Disney	38 & 41	1276401
Channel		
Disneyland	16, 35 & 41	1306098
Disney fairies	3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 29, 30 & 32	1367060

The aforementioned registrations have been duly renewed, are valid, subsisting and hence in full legal force, Photocopies of the Certificate for use in legal proceedings have been filed as **Annexure B.**

- e. Thus, the Disney Characters along with the DISNEY trade mark have acquired a tremendous reputation and goodwill throughout the world including in India so much so that the unauthorized use of such characters and the trade mark DISNEY in relation to any items of merchandise and/ or over the world wide web would create a high degree of confusion and deception resulting in passing off.
- f. The Disney Characters along with the DISNEY trade mark have appeared in numerous animated motion pictures and television shows and have also been featured in thousands of different items of merchandise and publications.

- g. The Complainant has the exclusive right to use or authorize the use of the name and physical depiction of the Disney Characters and the trade mark DISNEY and unfair competition laws. As a result of the complainant's exclusive and extensive use and protection of the characters and the DISNEY trade mark, the said characters and the trade mark have achieved a secondary meaning identifying in the minds of the consuming public the goods and services of the complainant exclusively.
- h. Thus the trademark DISNEY is associated exclusively with the goods and business of the complainant and the said mark has acquired a substantial reputation and goodwill world over including in India. Due to such factors the use of an identical or even the deceptively similar trademark of any domain name will inevitably lead to confusion in the minds of the public as to whether the said domain name belongs to the complainant or have any nexus with the Complainant. Internet extract from www.interbrand.com indicating that the complainant is the ninth greatest brand in the world, according to the 2010 has been filed as **Annexure C.** An Internet extract from www.businessweek.com indicating that Plaintiff No.1 is the tenth greatest brands in the World, according to the 2009 study has been filed as **Annexure D.**
- i. Even apart from distinctiveness acquired by the complainant in the trademark DISNEY due to its wide spread use and advertisement and promotion, the said trademark is even otherwise inherently distinctive of goods of the complainant and ranks in the category of famous and well known trademarks which are entitled to protection in respect of any goods or services (including use in domain names) whatsoever. The trademark being a famous trademark is thus entitled to protection against any possible misuse whatsoever. Thus the trademark DISNEY has also acquired the status as a well known Trademark by virtue of its worldwide reach and sale. Photocopies of an extract from "The World's Greatest Brands" by Nicholas Kochan and "Brands-An International Review" by Interband have been submitted as **Annexure E** and **Annexure F** respectively.

5. Complainant's Internet Presence

The Complainant through its website www.disneystore.com provides information of products or services offered by the Complainant and its affiliates. The Complainant created the aforesaid website on 24th November 1995. The said website showcases the widespread activities of the complainant and allows the customers to buy the products of the complainant online. Colour printouts from the internet of the Complainant's website along with the Whois result have been filed as **Annexure G (Collv.)**

The Complainant through another website being www.disney.com, provides information on the wide range of activities that the Complainant is engaged



in for e.g. family entertainment, media enterprising, the business of running parks and resorts, producing and selling clothing, books, records, toys and other merchandise, merchandising and licensing of distinctive elements associated with its motion pictures and television programs etc. The said website was created on 21st March 1990. Colour printouts from the internet of the Complainant's website along with Whois result have been filed as **Annexure H Colly.**

6. Decisions Upholding The Complainant's Rights

From time to time, there have been efforts made by various parties to cash in on the reputation of the complainant by adopting their marks, and appropriate proceedings have been initiated by the company to defend its statutory and common law rights in the said marks and the Courts in India have repeatedly passed orders in favour of the Plaintiff. Photocopies of orders passed in favour of the complainant by the High court of Delhi have been filed as **Annexure I.**

7. Respondent

The Respondent has not filed any response to the Complaint though they were given opportunity to do so. The e-mails sent to their address have not been returned with any delivery failure notification thus indicating that the Respondent has received the mails and elected not to file its response. Thus the complaint had to be decided based on submissions on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 4 of the policy.

8. Discussion and Findings:

The submissions and voluminous documents provided by Complainant in support of use and registration of the mark 'TJISNEY' alone and in combination with other words leads to conclusion that the Complainant has better and prior rights in the mark DISNEY. Further, they have registered a number of domain names containing the word/mark DISNEY. Thus it can be said a) the web users associate the word DISNEY with the goods and services of the Complainant Company b) the web users would reasonably expect to find Complainant's products at the www.disneystore.in and c) they may believe it is an official store of the Complainant and the goods being sold/offered are manufactured or licensed by the Complainant.

Based on the elaborate submission and documents, I'm satisfied that the complainant has established the three conditions as per paragraph 4 of the policy:



- (1) the Respondent's domain name is identical or confusingly similar to the trademark in which he has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered in bad faith.

It may be mentioned that since the Respondent did not file any response and rebut the contentions of the Complainant, it is deemed to have admitted the contentions contained in the Complaint. As, the Respondent has not established its legitimate rights or interests in the domain name, an adverse inference as to their adoption of domain name has to be drawn. Based on the documents filed by the Complainant, it can be concluded that the domain name/mark 'DISNEY' is identified with the Complainant's product or services, therefore its adoption by the Respondent shows 'opportunistic bad faith'.

9. Decision:

For all the reasons discussed above, the Arbitrator orders that the domain name <www.disneystore.in> be transferred to the Complainant.



RANJAN NARULA
SOLE ARBITRATOR
NIXI
INDIA

17 January 2011