

DECISION OF THE THIRD-PARTY DECIDER

Complainant / Domain name holder

Case no. 444145 / Disney-store.be

1. The Parties

1.1. Complainant:

Name: Disney Enterprises, Inc.
Address: South Buena Vista Street 500, Burbank, CA 91521, United States
E-mail (mandatory): Thomas.Limouzin-Lamothe@disney.com

Representative authorized to act for the Complainant:

Name: Alissia Shchichka
Function: IP Attorney
Address: Holidaystraat 5, 1831 Diegem, Belgium
Telephone: +32 2 715 37 41
Fax: /
E-mail: alissia.shchichka@gevers.eu

1.2. Domain name holder:

Name: Koen
Rademaekers
Address: Bilzersteenweg 45
Postal code: 3770
City: Riemst
Telephone: +32 1 245 68 68
E-mail (mandatory): riemst@exellent.be

2. Domain name

Domain name: disney-store.be
Registered on: January 17, 2019

Hereafter referred to as "the domain name".

3. Procedure

Commencement of the proceeding: September, 6, 2021.

No response received.

Appointment of third-party decider on September, 30th, 2021.

No other procedure relating to the Domain Name (to the best knowledge of the Third-party decider).

Date of decision : October, 21st, 2021.

4. Factual Background information

The Complainant is a subsidiary of The Walt Disney Company, commonly known as Disney. Disney, through its subsidiaries and affiliated companies, is one of the world's leading producers and providers of media networks, entertainment, amusement parks and resorts, interactive media, and consumer products, including but not limited to clothing, printed materials, and merchandise.

The Complainant is the owner of a myriad of DISNEY trademark registrations including, but not limited to, the following ones:

- Benelux trademark registration No. 57162 DISNEY, d.d. September 1, 1971 and covering goods in classes 3, 5, 9, 15, 16, 25, 28, 29, 30, 31 and 32.
- EU trademark registration No. 000186569 DISNEY, d.d. April 1, 1996 and covering goods in classes 3, 6, 8, 9, 11, 12, 14, 15, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30 and 32 and services in classes 35, 38, 41 and 42.
- EU trademark registration No. 009005745 ,  d.d. April 6, 2010 and covering goods in classes 25 and 28 and services in class 35.

Since not all information on the registrant is visible in the WHOIS data, a request was sent by the Complainant to DNS Belgium on July 12, 2021, in order to obtain the remaining information on the Domain name holders. DNS Belgium complied with this request and provided the complete data of the Domain name holder (see here above).

The Domain Name is being used to redirect the visitors to a website displaying the Complainant's registered trademarks and a picture of a castle in a magical background.

Also, several products bearing the image of Disney's animated characters, like Mickey Mouse, are being offered for sale on the website.

5. Position of the parties

5.1. Position of the Complainant

The Complainant contends that:

- The Domain Name is identical or confusingly similar to its trademarks;
- The Respondent has no right or legitimate interests in the Domain Name;
- The Domain Name has been registered or is being used in bad faith;

(see here under for details).

5.2. Position of the Domain name holder

No response provided.

After the appointment of the third-party decider, CEPANI (with copy to the third-party decider) was contacted by e-mail by a lawyer claiming to represent the holder and contesting both CEPANI's competence and the request for transfer, but without arguing on the merits.

This lawyer's intervention does not respect the prescribed forms; it is made too late; it is draft in a language that he is not the language of the procedure; it does not provide any concrete argumentation on the merits. For these reasons, the third-party decider treats this situation as an absence of response.

For completeness, the third-party decider recalls that CEPANI's jurisdiction is provided for in the domain name registration contract and that the holder cannot validly go back on what he accepted at the time of registration.

6. Discussion and findings

Pursuant to Article 16.1 of the *CEPANI rules for domain name dispute resolution*, the Third-Party Decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

Pursuant to Article 10b (1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, the Complainant must provide evidence of the following:

- *"the Domain name holder is identical or confusingly similar to a trademark, a tradename, a social name or corporation name, a geographical designation, a*

name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and

- *the Domain name holder has no rights or legitimate interests in the domain name; and*
- *the Domain name holder's domain name has been registered or is being used in bad faith."*

6.1. The Domain Name is identical or confusingly similar to trademarks in which the Complainant has rights

It is commonly accepted that the first condition functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

If this comparison, the cc- or g- TLD is usually not taken into account.

The Domain Name includes entirely the Complainant's DISNEY word trademark. Adding descriptive and usual terms (like "shop" or "store"), or a hyphen ("-") to a registered trademark in a domain name is not likely to differentiate the domain name from that registered trademark (see Cepani Case No. 4465 Umicore, société anonyme v. Michael Hannart, and WIPO Cases No. D2010-1059 and No. D2001-0903).

Furthermore, the Domain Name is identical to the Complainant's EU figurative trademark registration No. 009005745. The word elements DISNEY and STORE of that registration are identically present in the Domain Name and since the other elements appearing in the trademark cannot be reproduced in a domain name, due to their figurative nature, it must be concluded that this figurative mark is identical to the Domain Name.

The first condition is satisfied.

6.2. The Domain name holder has no right or legitimate interests in the Domain Name

Panels have consistently recognized that proving a respondent lacks rights or legitimate interests in a domain name may often result in the impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element

shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

Complainant's claims, without being contradicted, that:

- the Respondent has not registered trademarks related or including "Disney";
- there is no evidence that Respondent holds any unregistered rights related to the term "Disney";
- the Respondent has not received any license from the Complainant ;
- all active trademarks for the term "Disney" are held by the Complainant or companies of its group.
- The Complainant's trademarks are not generic nor descriptive terms in which the Domain name holder might have a legitimate interest;

The Respondent has not answered to the Complaint.

Based on the elements presented by Complainant, the Panels finds that the second condition is satisfied.

6.3. The Domain name holder's Domain Name has been registered or is being used in bad faith

The notion of bad faith may be deduced from a set of circumstances on the basis of which one can conclude that the domain name holder was aware, or should have been aware, that by registering or using the domain name, it was perpetrating misconduct, violating a law or infringing rights.

In this case, the Panels notes that:

- It is very unlikely that the Respondent was not unaware of the existence of the Complainant when registering the Domain Name;
- The Disputed Domain Name is used to redirect the visitors to a website displaying some of the Complainant's registered trademarks and a picture of a castle in a magical background (which creates a link with the well-known characters, movies, parks and activities of the Complainant) ;
- Several products bearing the image of Disney's animated characters, like Mickey Mouse, are being offered for sale on the website.
- the Respondent's subsequent use of the Disputed Domain Name shows that it is aware of the Complainant's trademark (the image of a castle, the reproductions

of trademarks and the selling of products bearing the image of Disney's animated characters);

Based upon the foregoing, the Panel is of the opinion that the Domain name was registered for, and is being used to, create an impression of association with the Complainant.

The Panel concludes that the above is evidence that the Respondent has engaged in a pattern of bad faith conduct.

The third condition is satisfied.

7. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-Party Decider hereby rules that the domain name registration for the "**Disney-store**" domain name :

is to be transferred to the complainant.

Brussels, October, 21st, 2021.

A handwritten signature in blue ink, appearing to read 'Etienne Wery', with a large, sweeping flourish extending to the right.

Etienne WERY
The Third-party Decider