

ADMINISTRATIVE PANEL DECISION

ANIMACCORD LTD v. Halina Yatskevich

Case No. D2022-3254

1. The Parties

The Complainant is ANIMACCORD LTD, Cyprus, represented by Inventa Capital PLC, United States of America (the “United States”).

The Respondent is Halina Yatskevich, United States.

2. The Domain Name and Registrar

The disputed domain name <mashabearcafe.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2022. On September 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 6, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

On September 6, 2022, the Center sought clarification from the Complainant about what remedy it was seeking.

The Complainant filed amended Complaint on September 11, 2022 and confirmed it was seeking transfer of the disputed domain name.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2022. The Response was filed with the Center on October 5, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on October 17, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On November 8, 2022, the Panel issued Procedural Order No. 1 pursuant to paragraph 12 of the Rules inviting the Respondent to submit some further information in clarification of a number of matters raised in the Response. On November 13, 2022, the Respondent submitted a supplemental filing in response to Procedural Order No. 1.

4. Factual Background

The Complainant is an international licensing company and studio. Amongst other things, it owns all the rights in a “hit” family animated television series “Masha and the Bear”.

According to the Complaint, this series is loosely based on a Russian folk story and focuses on the adventures of a little girl named “Masha” and the bear that keeps her safe from disasters.

The series has been broadcast and streamed throughout the world in over 100 countries including Netflix and YouTube. It has been translated into 25 languages.

The series has been very successful. It has won numerous awards. One of the episodes, entitled “Recipe for Disaster” has received over 4.3 billion views on YouTube making it the fifth most viewed video of all time and the most viewed non-music video of all time. By the 10th anniversary of the series’ first release, it was included in the Guinness World Records 2019 as the most watched cartoon on YouTube with over 50 billion views and 60 million subscribers.

In addition to the series, the Complainant has also implemented an extensive merchandising program.

The Complainant holds numerous copyright registrations including United States Registration No. VA 1-835-810, which is a “logo” design featuring cartoon representations of Masha and the Bear and the words “Masha and the Bear” presented in a fancy script.

The Complainant is the owner of:

- (a) United States Registered Trademark No. 4,790,906, MASHA AND THE BEAR, which has been registered in the Principal Register since August 15, 2015 in respect of a range of goods and services in International Classes 9 and 41 being pre-recorded DVDs and the production of motion picture films and claiming first use in commerce on September 17, 2014;
- (b) United States Registered Trademark No. 4,790,909, MASHA AND THE BEAR and cartoon device, (the ‘909 Mark) which has been registered in the Principal Register since August 11, 2015 in respect of a wide range of goods in International Classes 9, 16, 18, 25, 28 and 30 and claiming first use in commerce on April 15, 2015;
- (c) United States Registered Trademark No. 4,800,025, MASHA AND THE BEAR, which has been registered in the Principal Register since August 25, 2015 in respect of a wide range of goods in International Classes 16, 18, 25, 28 and 30 and claiming first use in commerce on April 15, 2015;

(d) United States Registered Trademark No. 5,420,550, MASHA AND THE BEAR, which has been registered in the Principal Register since March 13, 2017 in respect of a wide range of goods in International Classes 3, 12, 14, 15, 20, 21 and 24; and

(e) United States Registered Trademark No. 6,253,782, MASHA AND THE BEAR, (the '782 Mark) which has been registered in the Principal Register since January 26, 2021 in respect of restaurant, café, hotel, and a range of reservation and rental services in International Class 43.

The Respondent states she registered the disputed domain name on October 1, 2021. The Registrar's verification response supports this claim. In addition, the Respondent's supplemental filing includes a credit card receipt for a purchase, which the Respondent states records the payment for the disputed domain name. The amount, however, is much larger than the usual fee for a single year's registration in the ".com" generic Top Level Domain (gTLD). There is a further complication in that the Complainant's cease and desist letter dated May 25, 2021 addressed to the Respondent's company and another company specifically alleges infringing conduct at the disputed domain name.

However that may be, the disputed domain name now resolves to a website promoting the Respondent's restaurant in Colorado, United States, which describes itself as a family-owned restaurant offering Eastern European cuisine.

According to the Response, the restaurant was first established in 2016 and operated by some unrelated persons, Masha and the Bear LLC.

At some point (the Respondent claims this was under the former owners), the restaurant featured a number of images, which reproduce or closely resemble the representations of the characters and lettering used in the Complainant's television series and the '909 registered trademark. These representations included the prominent signage over the front door. Similar images resembling the Complainant's cartoon figures and lettering appeared on business cards. Social media reports also claimed that episodes from the Complainant's series were being shown on video screens in store.

It is not clear when the Respondent became the owner of the restaurant. In the Response, the Respondent states that she started the business in 2021. On December 19, 2018, however, the Respondent filed with the Secretary of State for the State of Colorado a "Statement of Trade Name" for "Masha and the Bear Russian Café". In addition, the company Masha and the Bear Russian Café LLC was licensed as a food service contractor on January 24, 2019.¹

On May 25, 2021, once the Complainant secured registration of United States Registered Trademark No. 6, 253,782, the Complainant's lawyers sent the Respondent's company, Masha and the Bear Russian Café LLC, and the former owner a cease and desist letter.

According to the Response, the Respondent removed the offending "cartoon" imagery soon after receipt and, over time, replaced it with the current get-up. The current get-up does not use any images resembling the Complainant's cartoon characters or lettering. This process was completed in or about October 2021 when the Respondent registered the disputed domain name.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

¹ In the supplemental filing, the Respondent seeks to explain this discrepancy on the basis that she focused on 2021 as that was the date of registration of the disputed domain name and the business was not fully operational until 2021 as a result of COVID-19 pandemic interruptions.

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

Ownership by the Complainant of the five registered trademarks identified in section 4 above has been proven.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard gTLD component as a functional aspect of the domain name system. See *e.g.* [WIPO Overview 3.0](#), section 1.11.

Similarly, it is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See *e.g.*, [WIPO Overview 3.0](#), section 1.10.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark omitting the words "and" and "the". Notwithstanding those omissions, the Complainant's '782 Mark, MASHA AND THE BEAR, is readily recognizable in the disputed domain name. Likewise for the verbal elements of the '909 Mark. As this requirement under the Policy is essentially a standing requirement, these differences are insufficient to avoid a finding of confusing similarity.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the

Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

It is not in dispute between the Parties that the Complainant has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with the Complainant in any way.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark.

At that point, the conduct falls squarely within the scope of the '782 Mark and, in addition, the Respondent was aware of the Complainant's trademark rights (having been notified in the cease and desist letter). Accordingly, such use would not qualify as offering goods or services in good faith under the Policy.

However, the Respondent appears to have acquired the restaurant business in or about December 2018 or January 2019. In addition to the name registration and certificates referred to in section 4, some of the social media posts included in the Complaint indicate the business may have been inoperative four years ago; *i.e.*, shortly before the Respondent registered the trading name. Also, there are numerous posts in 2019 and 2020 which are very complimentary of the food and service in those years. (Indeed, the print-outs from Yelp give the Respondent's restaurant a rating of 4.5.)

On that basis, the Respondent appears to have acquired the business under the name "Masha and the Bear Café" well before the Complainant's trademark rights extending to restaurant and café services were registered. The Respondent states that she chose the name because of its Russian folklore heritage. In her supplemental filing, the Respondent also appears to state that she only adopted the name Masha and the Bear Russia Café after a trademark search confirmed that the Complainant's then registered trademarks did not extend to restaurant and café services. As set out above, that was indeed the status of the Complainant's registered trademarks.

However, it was not until after receiving the cease and desist letter that the Respondent removed the signage and decorations which closely resembled the cartoon representations of "Masha and the Bear" from the Complainant's video series and trademarks. Thus, it appears the Respondent's business from the outset was using the cartoon representations and indicia to suggest some sort of association or connection with the Complainant's trademark and video series although no such connection or association existed. That is, the business was targeting the Complainant's cartoon characters and trademark. While the Complainant's

registered trademarks did not at that time extend to restaurant services, it did have a very extensive licensing program and its trademark was very well- and widely known. The Panel could not characterise the Respondent's use of the disputed domain name in those circumstances as a good faith offering of services under the Policy. See e.g. [WIPO Overview 3.0](#), section 3.8.2 (in the context of the third requirement under the Policy).

The position under paragraph 4(c)(ii) of the Policy is the same. The Respondent does have a registered trading name and a company name dating from in or about December 2018 / January 2019. Acknowledging that Masha and the Bear are figures of Russian folklore, nonetheless the Respondent adopted those names knowing that the restaurant business was, and would be, using them in the form of the cartoon characters and lettering used and widely promoted by the Complainant. The Respondent sought to take advantage of the misrepresentation that entailed to the advantage of her business. The heavy use of the Complainant's indicia colours undermines the Respondent's claim that she was just referencing the Russian folk tale. The Panel considers the Policy does not countenance such conduct as conferring rights or legitimate interests under the Policy.

In these circumstances, the Panel finds that the Complainant has established a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has not rebutted that *prima facie* case. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd* WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

As already recounted in section 5B above, the Respondent knew about the Complainant's registered trademark covering restaurant and café services when, as she states, she registered the disputed domain name on October 1, 2021. The Respondent registered the disputed domain name to use it for the very services for which the Complainant's trademark is (and was at the time) registered. It is well established that Registration of a domain name to use it without permission in direct conflict with another's trademark constitutes registration in bad faith under the Policy.

For the reasons discussed in section 5B above, the fact the Respondent appears to have been operating a restaurant business under the name Masha and the Bear Russia Café before the Complainant registered its trademark specifically covering restaurant and café services cannot exonerate the Respondent under the Policy in circumstances where the manner of use so directly misrepresented an association or connection with the Complainant.

Finally, although the Respondent has apparently ceased use of the Complainant's cartoon indicia, the Respondent is still using as a domain name the trademark registered by the Complainant, the '782 Mark MASHA AND THE BEAR, specifically for a website in connection with the services covered by that registration. The Respondent is doing so without permission from the Complainant. Such conduct very clearly constitutes use in bad faith under the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <mashabearcafe.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: November 22, 2022