

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

RED BULL GmbH v. PakSys Software LLC

C2009-0003

Also in PDF C2009-0003

1. The Parties

The Complainant is RED BULL GmbH, a limited liability company, having its principle premise of business at Fuschl am See, A-5330, Austria. The Complainant is one of the largest worldwide producers of energy drinks. It is the producer of the famous RED BULL ENERGY DRINK.

The PKNIC Whois data base shows the registrant of the domain name in dispute <redbull.pk> to be the organization, PakSys Software LLC.

2. The Domain Name and Registrar

The disputed domain name <redbull.pk> has been registered by PakSys Software LLC, located at 116 Salem Road, North Brunswick, New Jersey 08902, USA.

3. Procedural History

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 4th March, 2009.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], DNDRC formally notified the Respondent of the Complaint via email dated 5th June, 2009 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response was not received within 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit the Response. Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence with the proceedings in default and to determine the matter based upon the Complaint. The proceedings commenced on 11th June, 2009.

Under the Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.1, which states that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Mr. Mustafa Syed as the sole Arbitrator who has verified that the Complaint satisfies the formal

requirements of the Policy and the Rules. He has accepted and declared Impartiality and Independence.

The language of the proceedings is English, being the language of the registration agreement.

4. Factual Background

The Respondent has registered the disputed domain name <redbull.pk> in its name. The domain name is being used in connection with a website that is not active (PDF version of the website has been provided as annexure).

The Complainant is the registered proprietor of the following trademarks:

- i. Pakistani Trademark No 164632 dated 05.07.2000 registered in class 33 for: alcoholic beverages (except beers), hot and mixed alcoholic drinks, in particular alcoholic energy drinks, mulled wine and mixed drinks containing milk, wines, spirits and liqueurs, alcoholic preparations for making beverages, spirit or winebased cocktails and aperitifs, beverages containing wine, all being goods falling in class 33; it has been renowned for a period of 10 years with effect from 05.07.2007;
- ii. Pakistani Trademark No 164626 dated 05.07.2000 registered in class 25 for: clothing, footwear, headgear, sportswear for sports, football boots and studs therefor, non-slipping devices for shoes, corsetry, babies' napkins of textile, all being goods falling in class 25; it has been renowned for a period of 10 years with effect from 05.07.2007;
- iii. Pakistani Trademark No 141513 dated 27.05.1997 registered in class 32 for: beers (non-alcoholic), mineral and aerated water and other non-alcoholic drinks, energy drinks, health drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, being goods included in class 32; it has been renewed for a period of 10 years with the effect from 27.05.2004;
- iv. Pakistani Trademark No 141509 dated 27.05.1997 registered in class 32 for beers (non-alcoholic), mineral and aerated water and other non-alcoholic drinks, energy drinks, health drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, being goods included in class 32; it has been renewed for a period of 10 years with the effect from 27.05.2004;
- v. Austrian Trademark 150540 with priority date of 07.09.1993 registered in classes 5, 32 and 33 for inter alia alcoholic drinks, excluding beer and wine, mineral water, fruit drinks, vitamin preparations;
- vi. CTM 52787 with priority date of 01.04.1996 registered in classes 3, 5, 9, 12, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 29, 30, 32, 33, 34, 35, 37, 39, 41, 24 for the goods and services included;
- vii. IR 612320 with priority date 7.09.1993 registered in classes 5, 32, 33 for inter alia alcoholic drinks, excluding beer and wine, mineral water, fruit drinks, vitamin preparations;
- viii. US 2494093 with the registration date 2.10.2001 registered in classes 3, 5, 12, 14, 16, 18, 20, 25, 26, 28, 29, 30, 32, 34, 35, 39, 41, 42 for the goods and services included;
- ix. US 3086964 with the registration date 2.05.2006 registered in class 32 for inter alia beers, mineral and aerated water and other non-alcoholic drinks;

- x. US 3092197 with the registration date 16.05.2006 registered for non-alcoholic beverages, namely energy drinks and hypertonic drinks;
- xi. CTM 52803 with its registered date 16.03.2001 registered in classes: 3, 5 ,9 ,12, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 29, 30, 33, 34, 35, 37, 39, 41, 42 for the goods and services included.

The Respondents have failed to provide DNDRC with a Response to the Complaint initiated against them.

5. Parties' Contentions

A. Complainant

i. Complainant's Activities

Complainant is the largest worldwide producer of energy drinks. It is the producer of the famous RED BULL ENERGY DRINK, which was first sold in Austria in 1987 and internationally since 1994. Currently, the RED BULL ENERGY DRINK is being sold in 150 countries all over the world. In 2006, the year in which the domain name was registered, Complainant has sold over 3 billion units of RED BULL ENERGY DRINK worldwide, and 1.5 million units in Pakistan.

Since its launch in 1987, Complaint's marketplace penetration was focused on TV, cinema and radio. In 2006 alone, Red Bull invested over EUR 176 million in media worldwide, and EUR 16 million in Asia. Overall marketing activities worldwide in 2006 alone amounted at over EUR 961.3 million. From 1987 to 2006 more than EUR 125.5 million were spent on marketing purposes in Asia and in 2006 more than EUR 40.5 million alone. About EUR 435,000 were spent in 2006 in Pakistan in marketing activities. Based on the above figures, the brand has become the unchallenged market leader in its market sector.

RED BULL is the most valuable brand in Austria and certainly one of the most valuable in Europe. According to information provided by the European Brand Institute in "Eurobrand 2008", RED BULL – The most valuable Austrian brand was able to extend its lead once again and could increase its brand value since 2004 from over EUR 6 billion to a total of over EUR 12 billion in 2008.

Additionally, Complainant has promoted the RED BULL trademark by very substantial international advertising. The TV broadcasts aired by 151 TV channels worldwide, were identified and documented for 14 countries (Germany, Austria, Brazil, Canada, Hungary, Italy, Japan, Middle East, Pan-Asia, Russia, South Africa, Spain, United Kingdom and USA). An essential part of Complainant's marketing activities is sponsorship of global sports teams and events, such as for example the New York's Major League Soccer team RED BULL NEW YORK and the Austrian RED BULL SALZBURG FC. Moreover, the Complainant has been extensively involved in Formula One Racing with its two teams RED BULL RACING and SCUDERIA TORO ROSSO. The Complainant organizes the RED BULL X-Fighters event and the RED BULL AIR RACE WORLD SERIES, which take place in different cities in the world and which attract thousands of spectators at each event. The RED BULL AIR RACE WORLD SERIES is now televised both live and in long-time reports through 88 TV channels (status April 2006) around the world. This involvement of Complainant in sports and other events has contributed to make the mark RED BULL well-known all over the world.

Therefore, through sales activities, television broadcasts, internet activities and events sponsored by Complainant, the RED BULL ENERGY DRINK and the trademark RED BULL have become well-known in a large number of countries in the world. The worldwide market shares value was over 60 % in 2006. Apart from the media, Complainant also promotes the RED BULL ENERGY DRINK in other marketing materials

such as sales folders, consumer information leaflets, retail displays, crowners, flyers, packaging material, sampling cars, clothes and so on.

These facts are evidenced by an Affidavit of Dr Volker Viechtbauer, General Counsel of Complainant, provided as Annex B with enclosures [1] to [6]. Further evidence of the activities of Complainant can also be found on Complainants main website at <www.redbull.com>.

Complainant is the Registrant of a large number of domain names containing the RED BULL mark, both under generic and country-code Top Level Domains. Red Bull owns (either directly or through its subsidiaries or partners) more than 200 domain names consisting of the term “redbull”, i.a. “redbull.ch”, “redbull.co.il, “redbull.be”. The list of all (both generic and country-code Top Level) Domains owned by Red Bull which consist of the “redbull” term is provided as Annex C. Complainant’s main website <www.redbull.com> contains information on the RED BULL energy drink, sport activities and video records of sport events sponsored by Red Bull GmbH and links to other RED BULL websites, all of which regard marketing activities in relation to the famous trademark RED BULL.

ii. Respondent’s Identity and Activities

Respondent has registered the disputed domain name <redbull.pk> in his name. The website under the disputed domain name <redbull.pk> is inactive. When an attempt was made to reach the web site corresponding to the said domain name at issue, the web page or site could not be displayed. The printout of the website under the disputed domain name dated February 26, 2009 is provided as Annex D.

The Complainant sent to the Respondent a cease and desist letter dated December 7, 2007 requesting him to stop infringing Red Bull’s rights. The copy of the letter is provided as Annex E. The phone conversations that followed resulted in the Respondent’s declaration that the domain name would not be renewed and would expire in June 2008, so that Complainant could register it. Although otherwise agreed, the disputed domain name has been renewed by Respondent. Currently, the website is a parking domain and can be sold to anyone interested.

iii. Legal grounds

In Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001), the Panel laid down the following 4 heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

1. Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)
2. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)
3. Legitimate interest in Domain Name (a UDRP criteria)
4. Registration and use in bad faith (a UDRP criteria)

iv. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

Under PKNIC Policy, the applicant of the domain name shall certify that to her/his knowledge the use of the domain name does not violate third parties’ trademarks or other statues. The trademark RED BULL is one of the best known trademarks all over the world, including Pakistan, and Respondent must have been aware of this fact when registering the disputed domain name incorporating the famous trademark RED BULL. In this case, the Respondent illegally registered domain name with RED BULL mark. Furthermore, the Respondent deliberately illegally renewed the <redbull.pk>. The Respondent knew full well at the time of applying for the renewal of the <redbull.pk> that the Complainant had the legitimate right to the domain name.

The Complainant has not only registered RED BULL trademarks internationally, but it has also has registered the respective trademarks in Pakistan, and this is evidenced by the certificates of registration attached. Hence, the registration of the domain name by the Respondent interferes with and infringes the Complainant’s rights.

The Respondent's activity by using the <redbull.pk> utilizes the Complainant's reputation and injures its business interests. Using the domain name, even if passive holding constitutes putting at risk the Complainant's interest, since it could be activated anytime. The users, looking for the Complainant's web based services, might end up on the disputed domain name, thinking it belongs to the Complainant, or is affiliated to the Complainant. Hence, causing confusion and ambiguity as to the authenticity of the <redbull.pk> to the Complainant's users, who utilize the web based services, offered by the Complainant, on a regular basis.

v. The Domain Name is Identical with or Confusingly Similar to trademarks in which the Complainant has rights

Complainant is the owner of multiple trademark registrations and applications consisting of or containing RED BULL. The various trademark registrations and applications RED BULL of Complainant cover an extensive range of goods and services and span all of 45 trademark classes. Complainant and its subsidiaries hold national and international trademark registrations and applications consisting of or containing RED BULL in Austria and further 202 jurisdictions worldwide such as the United States of America, Canada, Germany, the United Kingdom, the Russian Federation, Australia, Brazil, South Africa, Hong Kong, China, Taiwan, Japan and Pakistan, to name just a few. The list of some certificates of registration in Pakistan were presented in point 4 of the Complaint and the reference to many of the other jurisdictions in which it owns trademark registrations is mentioned in the affidavit submitted as Annex B.

As WIPO Panels have already stated in various cases and confirmed in very recent ones, the Complainant's trademark is famous, as it has got a very strong reputation and is widely known all over the world (see f.e. *Red Bull GmbH v. Pregio Co., Ltd.*, WIPO Case No D2006-0909, *Red Bull GmbH v. Mario Maranda*, WIPO Case No D2008-0941).

Although 'red' and 'bull' are both ordinary words in the English language, they form a highly distinctive combination. In *Red Bull GmbH v. Tony Marinelli* (WIPO case No D2001-0522) the Panel has correctly stated that "Complainant's trademark RED BULL is composed of two common words of the English language, which in their combination are arbitrarily used to distinguish the energy drink sold by the Complainant and therefore are inherently distinctive. Such trademarks are in fact very strong marks." as confirmed in *Red Bull GmbH v. Grey Design* (WIPO Case No. D2001-1035).

It is common practice with Internet domain names that blank spaces in trade names or trademarks are omitted to form a company's domain name, and so did Complainant for its main website under the domain www.redbull.com and other domain names also containing the RED BULL element [see list submitted as Annex C].

No doubt exists that the disputed domain name is identical to the Complainant's RED BULL mark. The domain name in dispute <redbull.pk> fully incorporates the famous trademark RED BULL owned by Complainant. The Respondent has done no deviation in the domain name, except of the inclusion of the country code top level domain name (ccTLD) ".pk". According to the UDRP Rules, the gTLD suffix is an integral part of the domain name and does not enter into the consideration when examining the confusing similarity. The ".pk" is one of such ccTLDs and does not serve to identify a specific enterprise as a source of goods or services.

Moreover, "It is well-established that the incorporation of a complainant's mark in full within a disputed domain name, may be sufficient to establish confusing similarity between the mark and the disputed domain name – see for example, *Nokia Group v. Mr. Giannattasio Mario*, WIPO Case No. D2002-0782, referred to in the three-member Panel decision *The Ritz Hotel Ltd v. Damir Kruzicevic*, WIPO Case No. D2005-1137, and *Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, WIPO Case No. D2006-1643" - as the Panel stated in case *Roust Trading Limited v. AMG LLC* (WIPO Case No D2007-1857).

The identity between the contested domain name and the earlier marks of the Complainant will undoubtedly cause confusion to the Internet users intending to access Complainant's website through their mobile devices to reach a website that has no link whatsoever to the Complainant and its activities. Consumers would be lead to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship exists at all.

For all these reasons, there is an identity between Complainant's trademark RED BULL and the disputed domain name that will lead to confusion, and so the first element required by the Policy is satisfied.

vi. 8.2.3 Respondent has no Rights or Legitimate Interests in Respect of the Domain Name

Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or any variations thereof, or to register or use any domain name incorporating any of those marks or any variations thereof. A combination of the words "red" and "bull" is purely fanciful, as there does not exist a red colored bull. Therefore, nobody would legitimately choose this combination or any variation thereof, unless seeking to create an association to Complainant. It is inconceivable that Respondent had been unaware of Complainant before registering the disputed domain name

Based on the fame and reputation of the RED BULL mark and the activities of Complainant all over the world, it can be concluded beyond any doubt that Respondent purposefully created a domain name, which consists of the Complainant's well-known mark and the ".pk" extension. By creating a domain name that includes the Complainant's famous mark, Respondent simply intends to attract customers looking for information on Complainant and its products. Apparently, Respondent intended to directly divert potential customers of Complainant to its website.

Respondent has registered the domain name in dispute to create the misleading impression of being in some way associated with Complainant, which is not the case, and it has been intended for commercial gain, that constitutes an illegitimate commercial use of the disputed domain name. Respondent is quite obviously trying to exploit the fame and reputation of Complainant's trademarks and products all over the world.

None of the circumstances listed under para 4(c) of the UDRP, possibly demonstrating rights or legitimate interests, are present. Respondent has not used the disputed domain name with a *bona fide* offering of goods or services. Furthermore, Respondent is not authorized or related to Complainant in any way. Respondent intends to have a free ride on the fame and goodwill of Complainant's trademarks and profit from consumer confusion as to an economic relationship of Respondent with Complainant.

vii. The Disputed Domain Name was registered and is Being Used in Bad Faith

The trademark RED BULL is one of the best known trademarks all over the world and Respondent has been aware of this fact deliberately registering the disputed domain name incorporating the famous trademark RED BULL. Respondent's obvious intent was to misleadingly divert the consumers to its website, causing confusion among consumers in the way of creating the impression of economic relation with or sponsorship or endorsement of Respondent by Complainant. It is apparent that the intent of Respondent was to exploit the reputation of Complainant and RED BULL trademark.

There is substantial authority that registration of a domain name that is confusingly similar to a famous trademark by any entity that has no relationship to that mark is itself evidence of bad faith registration and use (see: *AT&T Corp. v. John Zuccarini d/b/a Music Wave and RaveClub Berlin*, WIPO Case No. D2002-0440). As Panel stated in *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.* (WIPO Case No. D2000-0163) use of a name connected with such a well-known product by someone with no connection with the product suggests opportunistic bad faith.

"Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorisation and no legitimate purpose to use the mark is a strong indication of bad faith", as the Panel stated in case *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry -Succession Saint Exupéry - D'Agay v Perlegos Properties* (WIPO case No D2005-1085), considering passive holding as indication of bad faith. Therefore, given the Complainant's numerous trademark registrations for, and its wide reputation in, the word "redbull", as evidenced by the facts established above, it is absolutely impossible that the Respondent would have been unaware of this fact at the time of registration. On the contrary, Respondent itself recognizes RED BULL's fame to exist. The bad faith is therefore undisputable.

Furthermore, Respondent can activate its website of the disputed domain name at any time since no undertaking was given by him to Complainant. Parking the disputed domain easy to be resold or activated at any time by the Respondent shall be treated as acting in bad faith. The lack of any operational website resolvable through that name constitutes passive holding. A number of Panels have held that, under appropriate circumstances, passive holding evidences bad faith use.

Taking into account Respondent's behavior (registering and actively renewing the domain name - after having been given notice of this domain infringing Red Bull's rights - identical with famous trademark with no effort to distinguish the domain name from the Complainant's marks and lack of any operations on website), it is not possible to imagine any plausible actual or contemplated active use of <redbull.pk> domain name by the Respondent that would not be illegitimate. Considering all circumstances of the case, in particular Complainant's trademark strong reputation and Respondent's behavior, as recommended by the Panel in *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003) it shall be concluded that the disputed domain name has been registered and "is being used in bad faith" by Respondent.

For all the above reasons, the Complainant requests a transfer of the disputed domain name.

B. Respondent

The Respondent failed to provide a Response to the Complainant's contentions even though the opportunity to do so was provided to them by DNDRC. Thus the Panel shall proceed with the decision by deciding the dispute based upon the Complainant issued by the Complainant in line with section 5(e) of the UDRP Rules.

6. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules.

The Respondent applied for, was granted registration of the disputed domain name on the basis of and has submitted to the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

7. Discussion and Findings

The application for the registration of the domain name in dispute <[redbull.pk](#)> on behalf of the Complainant is regulated by the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the UDRP Rules. The PKNIC Policy states:

"You, the applicant who wants to register a domain name under .PK is presumed to have read and agreed to this PKNIC Internet Domain Registration Policy".

The Respondent applied for registration of the disputed domain name <redbull.pk> on the basis of these regulations and was allowed registration subject to the same. Hence the relationship between the Respondent and PKNIC with respect to PKNIC's domain name registration service is governed by the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 and the UDRP Rules and thus the Respondent's registration must be legitimate as per the requirement of these regulations and Rules.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 paragraph 6 states that:

“PKNIC has neither the resources nor the legal obligation to screen requested Domain Names to determine if the use of a Domain Name by an Applicant may infringe upon the right(s) of a third party. Consequently, as an express condition and material inducement of the grant of an applicant's ("Applicant") request to register a Domain Name, Applicant represents, agrees and warrants the following four statements and a failure to comply with them, or any other parts of the PKNIC policy, will cause PKNIC to cancel the domain registration of the non-compliant domains of Applicant:

- 1. Applicant's statements in the application are true and Applicant has the right to use the Domain Name as requested in the Application;*
- 2. Applicant has a bona fide intention to use the Domain Name on a regular basis on the Internet;*
- 3. The use or registration of the Domain Name by Applicant does not interfere with or infringe the right of any third party in any jurisdiction in Pakistan, with respect to trademark, service mark, tradename, company name or any other intellectual property right;*
- 4. Applicant is not seeking to use the Domain Name for any unlawful purpose, including, without limitation, tortious interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or for the purpose of confusing or misleading a person, whether natural or incorporated.”*

Additionally the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 paragraph 4 states that:

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, agitates the right to cancel or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Correspondingly the UDRP lays down three basic requirements under paragraph 4(a) on the basis of which a domain name Complaint shall be decided:

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

Therefore in the present context the decision of the dispute shall be addressed with respect to the following aspect:

- i. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 criteria).
- ii. Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).
- iii. Legitimate interest in the domain name (a UDRP criteria).
- iv. Registration and use of the domain name in bad faith (a UDRP criteria).

I. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration of the domain name

In terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, a domain name is registered subject to inter alia paragraph 1 & 4 and is held invalid if it:

- a. *infringes upon a registered tradename,*
- b. *is not bona fide as recognized by international best practice,*
- c. *is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. *has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. *in the opinion of PKNIC is not appropriate for registration.*

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 4 also states that:

If a party claims that a domain name already registered with PKNIC violates their registered trade name, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, agitates the right to cancel or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Hence, any registration in contravention of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007. ver 4.2 would be ab initio void and as well as voidable under the requirements of paragraph 4 of The PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

For the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration in order to determine whether the application and registration of the domain name in dispute “<redbull.pk>” is ab initio illegal with respect to the following aspects in the context of which this dispute shall be assessed:

- i. Whether the Domain Name in dispute “<redbull.pk>” infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Domain Name in dispute “<redbull.pk>” is bona fide?
- iii. Whether the application and/or registration of the Domain Name in dispute “<redbull.pk>” contravene the Pakistan Penal Code or any applicable criminal law?

The Panel will deal each of these sub-issues sequentially below.

- i. Whether the Domain Name in dispute “<redbull.pk>” infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The facts indicate that the domain name in dispute “<redbull.pk>” is not merely an obvious derivation to the registered trade marks/names of the Complainant, but in fact identical to the registered trade names/marks of the Complainant that are being used by the Complainant as a producer of energy drinks that has an extensive national and international market. The Complainant has also registered the following domain names in order to protect and facilitate its customers and its products from infringement:

- i. redbull.ac
- ii. redbull.ad

- iii. redbull.aero
- iv. redbull.af
- v. redbull.ag
- vi. redbull.am
- vii. redbull.as
- viii. redbull.asia
- ix. redbull.at
- x. redbull.az
- xi. redbull.be
- xii. redbull.bi
- xiii. redbull.biz
- xiv. redbull.bo
- xv. redbull.bs
- xvi. redbull.by
- xvii. redbull.bz
- xviii. redbull.ca
- xix. redbull.cc
- xx. redbull.cd
- xxi. redbull.cg
- xxii. redbull.ch
- xxiii. redbull.ci
- xxiv. redbull.cl
- xxv. redbull.cn
- xxvi. redbull.co.at
- xxvii. redbull.co.ck
- xxviii. redbull.co.cr
- xxix. redbull.co.gg
- xxx. redbull.co.hu
- xxxi. redbull.co.il
- xxxii. redbull.co.im
- xxxiii. redbull.co.je
- xxxiv. redbull.co.jp
- xxxv. redbull.co.ke
- xxxvi. redbull.co.ma
- xxxvii. redbull.co.mu
- xxxviii. redbull.co.mz
- xxxix. redbull.co.nz
- xl. redbull.co.pn
- xli. redbull.co.tt
- xlii. redbull.co.uk
- xliii. redbull.co.uz
- xliv. redbull.co.ve
- xlv. redbull.co.vi
- xlvi. redbull.co.za
- xlvii. redbull.com
- xlviii. redbull.com.af
- xliv. redbull.com.ag
- l. redbull.com.ai
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- lii. redbull.com.au
- liii. redbull.com.az
- liv. redbull.com.bd
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lxii.	redbull.com.ec
lxiii.	redbull.com.es
lxiv.	redbul.com.fj
lxv.	redbull.com.gi
lxvi.	redbull.com.gr
lxvii.	redbull.com.gt
lxviii.	redbull.com.hn
lxix.	redbull.com.jm
lxx.	redbull.com.kg
lxxi.	redbull.com.ki
lxxii.	redbull.com.lc
lxxiii.	redbull.com.lv
lxxiv.	redbull.com.mt
lxxv.	redbull.com.mx
lxxvi.	redbull.com.nf
lxxvii.	redbull.com.ni
lxxviii.	redbull.com.om
lxxix.	redbull.com.pa
lxxx.	redbull.com.pe
lxxxi.	redbull.com.ph
lxxxii.	redbull.com.pk
lxxxiii.	redbull.com.pl
lxxxiv.	redbull.com.pr
lxxxv.	redbull.com.ps
lxxxvi.	redbull.com.py
lxxxvii.	redbull.com.ro
lxxxviii.	redbull.com.ru
lxxxix.	redbull.com.sb
xc.	redbull.com.sg
xci.	redbull.com.sv
xcii.	redbull.com.tj
xciii.	redbull.com.tr
xciv.	redbull.com.tw
xcv.	redbull.com.uy
xcvi.	redbull.com.vc
xcvii.	redbull.com.ve
xcviii.	redbull.com.vn
xcix.	redbull.cr
c.	redbull.cx
ci.	redbull.cz
cii.	redbull.de
ciii.	redbull.dj
civ.	redbull.dk
cv.	redbull.dm
cvi.	redbull.dz
cvii.	redbull.ec
cviii.	redbull.es



cix.	redbull.eu
cx.	redbull.fi
cxii.	redbull.fm
cxiii.	redbull.fr
cxiiii.	redbull.gen.tr
cxv.	redbull.gg
cxvi.	redbull.gl
cxvii.	redbull.gm
cxviii.	redbull.gp
cxix.	redbull.gs
cxx.	redbull.gy
cxxi.	redbull.hk
cxxii.	redbull.hm
cxxiii.	redbull.hn
cxxiv.	redbull.hr
cxxv.	redbull.hu
cxxvi.	redbull.ie
cxxvii.	redbull.im
cxxviii.	redbull.in
cxxix.	redbull.info
cxxx.	redbull.io
cxxxi.	redbull.it
cxxxii.	redbull.je
cxxxiii.	redbull.jobs
cxxxiv.	redbull.jp
cxxxv.	redbull.kg
cxxxvi.	redbull.ki
cxxxvii.	redbull.kz
cxxxviii.	redbull.la
cxxxix.	redbull.lc
cxl.	redbull.li
cxli.	redbull.lk
cxlii.	redbull.lt
cxliii.	redbull.lu
cxliv.	redbull.lv
cxlv.	redbull.ly
cxlvi.	redbull.md
cxlvii.	redbull.me
cxlviii.	redbull.mk
cxlix.	redbull.mn
cl.	redbull.mp
cli.	redbull.ms
clii.	redbull.mu
cliii.	redbull.mw
cliv.	redbull.my
clv.	redbull.na
clvi.	redbull.net
clvii.	redbull.nf
clviii.	redbull.nl
clix.	redbull.no
clx.	redbull.nr
clxi.	redbull.nu
clxii.	redbull.off.ai

clxii.	redbull.org
clxiii.	redbull.org.uk
clxiv.	redbull.pe
clxv.	redbull.ph
clxvi.	redbull.pl
clxvii.	redbull.pn
clxviii.	redbull.pr
clxix.	redbull.pro
clxx.	redbull.ps
clxxi.	redbull.pt
clxxii.	redbull.ro
clxxiii.	redbull.ru
clxxiv.	redbull.rw
clxxv.	redbull.sa.com
clxxvi.	redbull.se
clxxvii.	redbull.sg
clxxviii.	redbull.sh
clxxix.	redbull.si
clxxx.	redbull.sl
clxxxi.	redbull.sn
clxxxii.	redbull.sr
clxxxiii.	redbull.st
clxxxiv.	redbull.tc
clxxxv.	redbull.tj
clxxxvi.	redbull.tk
clxxxvii.	redbull.tl
clxxxviii.	redbull.tm
clxxxix.	redbull.to
cxc.	redbull.tt
cxci.	redbull.ua
cxcii.	redbull.ug
cxciii.	redbull.um
cxciv.	redbull.us
cxcv.	redbull.uz
cxcvi.	redbull.vc
cxcvii.	redbull.vg
cxcviii.	redbull.vn
cxcix.	redbull.vu
cc.	redbull.ws

Following the above, it is the Panel's opinion that the Complainant has taken sufficiently necessary steps, not just to protect their registered trade marks/names, but also domain names that relate to such trade marks/names, however the Respondent has prevented the Complainant from registering the disputed domain name <redbull.pk> in furtherance of such protection.

Paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 sets out the condition that if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name the registration would be deemed illegal and unlawful and for all purposes invalid. As such since, in the opinion of the Panel, this criterion has been established as, due to the lack of Response from the Respondents, the Panel is required to decide the matter based upon the Complaint. The same stand proves and constitutes adequate grounds for the transfer of the domain name in dispute "<[redbull.pk](#)>" to the Complainant.

Nonetheless for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

ii. Whether the application and/or registration of the Domain Name in dispute “<[redbull.pk](#)>” is bona fide?

It is highly unlikely that the Respondent was not fully aware of the reputable nature and large customer base of the Complainant at the time when the Respondent registered the domain name in dispute “<[redbull.pk](#)>”, a fact that creates doubt with respect to the bona fide of the Respondent. The Panel takes into account the WIPO decision of **Hollywood Foreign Press Association v. F.M.I. Case No. D2008-1610**, whereby it was noted that:

“The Complainant contends that the Respondent registered the Domain Names knowing of the existence of the Complainant’s trade mark, GOLDEN GLOBE, and with a view to exploiting the Complainant’s trade mark rights, a primary claim being that the Respondent registered the Domain Names with a view to selling them at a profit. If the Complainant’s allegations are made out, such a registration could not conceivably give rise to rights or legitimate interests in respect of the Domain Names. The Panel accepts the Complainant’s unchallenged contention that it is inconceivable that the Respondent was unaware of the Complainant’s mark, GOLDEN GLOBE, when the Domain Names were registered. The Complainant has undertaken various enquiries and has found no basis upon which the Respondent could be said to have rights or legitimate interests in respect of the Domain Names. Moreover, the Respondent’s name has no obvious connection with the Domain Names and the Complainant has granted the Respondent no license in respect of the GOLDEN GLOBE trade mark. The Complainant has made out a prima facie case under this head, a case calling for an answer from the Respondent. The Respondent has not responded to the Complaint; nor did the Respondent respond to letters from the Complainant’s representative. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.”

Given the ambit of the Complainant’s international repute, with RED BULL ENERGY DRINKS being sold in 150 countries all over the world, with 1.5 million units of the RED BULL ENERGY DRINK being sold in Pakistan in 2006 and with the Complainant investing EUR 16 million in media and advertising in Asia, the Panel finds it reasonable to deem the Respondent was well aware of the existence and value of the Complainant’s registered trade marks/names, existing domain names and customer base. This is clearly indicative of substantial proof that the Respondent’s registration of the domain name in dispute “<[redbull.pk](#)>” lacks bona fide.

Moreover, the fact that the Respondent chose specifically to register a domain name not just similar or a derivative of the Complainant’s registered trade marks/names, but in fact identical to these registered trade marks/names is also highly relevant to the consideration of the Respondent’s lack of bona fide. Furthermore the Respondent offers no bona fide services or products on the domain name in dispute, which the Panels determines to be an additional indication of lack of bona fide on the part of the Respondent.

Essentially due to failure on the part of the Respondent to provide any proof regarding the alleged non-commercial purpose and lack of bona fide behind the registration of the disputed domain name, the Respondents have not been able to discharge the burden of the allegation against them that there exists no legitimate and non-commercial purpose, with respect to the registration of the domain name in dispute, in conformity with the PKNIC- Internet Domain Registration Policy Aug 7, 2007 ver 4.2 under which the Respondents initially registered the domain name in dispute “<[redbull.pk](#)>”. Moreover, deliberate lack of Response by the Respondent regarding their intentions for the registration of the domain name in dispute “<[redbull.pk](#)>” casts further doubt upon the bona fide of the Respondent. Therefore the Panel has conclusively determined lack of bona fide on the part of the Respondent upon the registration of the domain name in dispute “<[redbull.pk](#)>”.

As per the requirements of paragraph 1 of the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2, if a Complainant simply establishes this one criteria the registration of the domain name in dispute would be deemed

illegal, unlawful or otherwise invalid. As such since, in the opinion of the Panel, this criteria has been established by the Complainant within their Complaint and no evidence to the contrary has been tendered by the Respondent thus the Panel has determined the issue on the same stands and constitutes adequate grounds for the transfer of the domain name in dispute “<[redbull.pk](#)>” to the Complainant.

iii. Whether the application and/or registration of the Domain Name in dispute “<[redbull.pk](#)>” contravene the Pakistan Penal Code or any applicable criminal law?

Prior to proceeding with this analysis the Panel feels compelled to clarify the basis and effect of this sub-issue. It is clarified that although Pakistani law does not apply by force of law over PKNIC’s jurisdiction it does however apply as a contractual term to the contract executed between the Respondent and PKNIC thus defines the scope and terms of use of the domain name under the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. As such it is clarified for future disputes, Appeals and Complaints that illegality with respect to the Application and Registration and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute in question. Conversely the fact that Pakistani law is included as part of the terms of the PKNIC-Internet Domain Registration Policy Aug 07, 2007, ver. 4.2, these terms therefore apply to PKNIC and all relevant parties by virtue of the contractual and representative clauses thus the examination of Pakistani law is undertaken to determine whether any and/or all of these terms and conditions have been breached, violated and/or if there exists any non-conformity by the applicant or PKNIC.

In this spirit and for this purpose alone the following provisions of Pakistani law are being analyzed.

Trade Marks Ordinance, 2001

“40. Infringement of registered trade mark.-

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

4. Domain name not to be misleading as to character or significance.- *(1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

Pakistan Penal Code, 1860

Of Trade, Property and Other Marks

1[478. Trade mark. A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940).]“

The Trade Mark Ordinance equates infringements of Trade Marks and Trade Names with the infringement of domain names hence, under the Trade Mark Ordinance; provisions of the Pakistan Penal Code that deal with infringement of Trade Marks would possibly also cover domain names.

The Electronic Transactions Ordinance, 2002 (“ETO”)

“3. Legal recognition of electronic forms.—No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

As such all material, documents or instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract and be subject to the provisions of the same sections of the Penal Code or any law had the material been in physical, written or printed form. Thus, the Penal Code applies equally to transactions, publications or material including the use of any trade mark made available in electronic form on the Internet through the use of a domain name as it does to physical material.

Since the Internet by its very nature is a public domain, obtaining access of the domain name that may involve use by the registrant of a registered trade mark in the form of a domain name by an entity other than the owner/rightful holder/authorized user of the registered trade mark for the purposes of export and import of data, would result in a violation of trade marks by virtue of access to such a domain as well as to the content as at the very least, use of Search engines by the public, would attract offences *inter alia* mentioned below under the Penal Code.

By the continuing registration of the domain name in dispute “<[redbull.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names, would not only give the impression to the Respondent that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

Pakistan Penal Code, 1860

479. Property mark. A mark used for denoting that movable property belongs to a particular person is called a property mark.

480. Using a false trade mark. Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

As such the use of the domain name in dispute “<[redbull.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names could constitute an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

“481. Using a false property mark. Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

482. Punishment for using a false trade-mark or property mark. Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.”

Section 481 provides not only for movable goods but moveable property as well. As such it may logically be extrapolated that the inclusion of the words “movable property” in addition to the words “goods” suggests that the draftsman and legislature intended “movable property” to refer to items other than, and in addition to, “goods” and as such intellectual property or now, with the aid of the ETO digital property, any “*document, record, information, communication or transaction*” in electronic form would also be covered under this section. Hence, it would include any electronic means of encasing, packaging, containing intellectual property or property which is movable other than goods i.e. including domain names.

As such the concept of use of a false property mark (which includes trade marks and by virtue of both the Trade Marks Ordinance, 2001 and international best practices) includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages (received from the website hosting the domain name) on the Internet with the reasonable expectation that people would be misled into believing that the trade marks/names or domain name belongs to the internationally renowned organization of the Complainant, when in fact it does not.

Therefore the use of the domain name in dispute “<[redbull.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names could constitute as an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

*“483. Counterfeiting a trade mark or property mark used by another. Whoever **counterfeits any trade mark or property mark** used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both.*

*485. Making or possession of any instrument for counterfeiting a trade mark or property mark. Whoever makes or **has in his possession any die, plate or others instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.***

*473. Making or possessing counterfeit seal, etc., with intent to commit forgery punishable otherwise. **Whoever makes or counterfeits any seal, plate or other instrument for making an impression, intending that the same shall be used for the purpose of committing any forgery which would be punishable under any section of this chapter other than section 467, or, with such intent, has in his possession any such seal, plate or other instrument, knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.***”

The use of the domain name in dispute “<[redbull.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names may also be construed to be counterfeiting of the source identifier of the trade/property marks/names and thus the use of a domain name, apart from being counterfeiting by itself, could at the least constitute possession and use of an electronic instrument being used for counterfeiting a trade mark/name, property mark or domain name.

“464. Making a false document. A person is said to make a false document: ---

*First: Who dishonestly or fraudulently **makes, signs, seals or executes a document or part of a document, or makes any mark denoting the execution of a document, with the intention of causing it***

to be believed that such document or part of a document was made, signed, sealed or executed by the authority of a person by whom or by whose authority he knows that it was not made, signed, sealed or executed, or at a time at which he knows that it was not make, signed, sealed or executed;

470. Forged document. A false document made wholly or in part by forgery is designated “a forged document”.

471. Using as genuine a forged document. Whoever fraudulently or dishonestly uses as genuine any document which he knows or has reason to believe to be a forged document, shall be punished in the same manner as if he had forged such document.

476. Counterfeiting device or mark used for authenticating documents other than those described in section 467, or possessing counterfeit marked material. Whoever counterfeit upon, or in the substance of, any material, any device or mark used for the purpose of authenticating any document other than the documents described in section 467 of this Code, intending that such device or mark shall be used for the purpose of giving the appearance of authenticity to any document then forged or thereafter to be forged on such material, or who, with such intent, has in his possession any material upon or in the substance of which any such device or mark has been counterfeited, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.”

Similarly, the use of the domain name in dispute “<[redbull.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names in a manner that could reasonably mislead the authorized user’s customers/clients, could also be equivalent to the wrongful use of an electronic message or document covered under ETO, 2002. Since, the person making, signing or executing this website, the domain name, its contents, its documents on the site and every message that suggests that the message is being executed by “<[redbull.pk](#)>” would be representing and making such a document falsely knowing that he is not authorized to do so, hence the electronic message and document would be false/forged and he would thus, contravene sections 464, 470 and 471 of the Penal Code.

Moreover, section 476 of the Penal Code clearly makes it an offence to possess any device or material (by operation of the ETO 2002 this would extend to electronic instruments or devices including domain names, websites and electronic messages being exchanged between the domain name, the website server and any other party) which is intended to authenticate or give the impression that it authenticates (the domain name would authenticate) a document (the website and domain name or the electronic messages) when in fact such authentication would be incorrect and counterfeit and in breach of the Code.

Electronic Transactions Ordinance 2002

“3. Legal recognition of electronic forms.—No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

Prevention of Electronic Crimes Ordinance 2008

“15. Spoofing.(1) Whoever establishes a website, or sends an electronic message with a counterfeit source intended to be believed by the recipient or visitor or its electronic system to be an authentic source with intent to gain unauthorized access or obtain valuable information which later can be used for any unlawful purposes commits the offence of spoofing. (2) Whoever commits the offence of spoofing specified in sub-section (1) shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both”.

Hence it can be construed that in any event where a Respondent has established or is using a website or a domain for any purpose, in which he does not hold legitimate interests, is entitled to be charged with the offence of spoofing under s.15 of the PECO 2008. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

Therefore, it is the opinion of the Panel that the registration and/or use of the domain name in dispute “<[redbull.pk](#)>” by the Respondent would be in violation of Pakistani criminal law and the Pakistan Penal Code and therefore as a result of, would constitute a violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

The above mentioned factors would increase the likelihood of giving rise to liability under the above mentioned legislations, which in turn would raise significant doubt regarding the legitimacy and bona fide of the Respondent’s registration of the domain name in dispute.

Since in the opinion of the Panel this criteria has been established by the Complainants and no evidence to the contrary has been tendered by the Respondent, thus the Panel has decided the matter based on the Complaint hence the same stands proved and constitute adequate grounds for the transfer of the domain name in dispute “<[redbull.pk](#)>” to the Complainants.

The Panel therefore, concludes that the registration of the domain name in dispute “<[redbull.pk](#)>” would be illegal, unlawful and otherwise invalid in terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, not to mention that the Respondent’s registration and/or use of the domain name in dispute “<[redbull.pk](#)>” could very possibly give the impression that PKNIC, (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) by allowing the maintenance of such registration, would be committing a contravention of the Pakistani criminal law and a breach of its own Internet Domain Registration Policy Aug 07, 2007 version 4.2.

Although it is evident that the Complaint has succeeded in proving their Complaint in terms of the initial requirements of the PKNIC- Internet Domain Registration Policy June 07, 2007 version 4.2, and the registration of the disputed domain name is to be transferred to the Complainant, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2(which also includes the ICANN UDRP with amendments).

II. Identical or confusing similarity with a trademark or service in which the Complainant has rights

To prove this element the Complainant must have rights in a name, trade mark or service mark and the disputed domain name must be identical or confusingly similar to the Complainant’s name, trademark or service mark.

The Complainant has numerous trademarks/names in various countries and is the owner of four trademarks/names within the territory of Pakistan in the name of “RED BULL”, as detailed in section 4 of this decision. The disputed domain name <[redbull.pk](#)> contains in entirety the trademarks/names of the Complainant and as the Complainant’s trade marks/names are inherently distinctive (see *Facebook Inc v. Privacy Ltd. Disclosed Agent for YOLAPT WIPO Case No. D2007-1193*) it has been held in prior cases that when a domain name incorporates a distinctive trade mark/name in its entirety, it is confusingly similar to that mark/name (see *EAuto, L.L.C v. Triple S. AutoParts d/b/a Kung Fu Yea Enterprises, Inc. WIPO Case No. D2000-0047*)

Further more, the trade mark/name “RED BULL” belongs to the Complainant. The addition of the suffix “.pk” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s customers. In similar cases, the addition of the suffix “.pk” has not been considered to add any element of distinctiveness (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

In the case of *Atticabank S.A. v. Net Promotion, Inc.* Case No. D2006-0317 the Panel, when discussing the issue of “Identical and Confusingly Similar”, held the following:

“A. Identical or Confusingly Similar

Although the Complainant’s business is primarily based in Greece, the Complainant has for many years used the words ATTICA BANK and BANK OF ATTICA in the English language both as a corporate name and as a trademark and service mark. The Complainant has built a substantial goodwill in the use of these marks both in Greece and in other jurisdictions throughout the world for its banking and financial services.

The Complainant’s Greek registered trademark ATTICA CARD, registration no. 117698, is for a word mark. The Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141534, includes a logo but the registration document expressly includes the words as protected indications. Similarly, Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141535, includes a logo device but again the registration document expressly states that the words are protected indications. Similar protection is afforded to the word elements in the Greek registered trademarks TECHNOCARD – BANK OF ATTICA with logo, registration no. 141535 and ATTICARD EXTRACASH – BANK OF ATTICA with logo, registration no. 143339.

The Complainant has established to the satisfaction of this Panel that it has rights in the trademarks ATTICA BANK and BANK OF ATTICA through long term use, and in addition, it has rights in the marks ATTICA CARD, TECHNOCARD – BANK OF ATTICA and ATTICARD EXTRACASH – BANK OF ATTICA through its Greek registered trademarks.

The domain name <atticabank.com> is clearly identical to the Complainant’s trademark ATTICA BANK and is confusingly similar to the Complainant’s trademark BANK OF ATTICA.”

Furthermore the Complainant’s trademark/names are very well associated and connected with the products globally offered by the Complainant. Therefore the use of this domain name by any other party than the Complainant would not only cause confusion to the user(s) and customer(s) of the Complainant but would also hinder the Complainant from registering the domain name in dispute in furtherance to its business thus causes substantial and irredeemable harm to the Complainant.

Consequently, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

III. Legitimate interest in Domain Name

As per paragraph 4(c) the UDRP requires the Respondent’s claim to be of legitimate interest and shall be :

“proved based on all evidence presented” that “shall demonstrate” the Respondent’s “rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii).”

Paragraph 4(a)(ii) states that:

“(i) before any notice to you of the dispute, your 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

- (ii) you (as an individual, business, or other organization) **have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or**
(iii) you are making a **legitimate noncommercial 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.**”

Evidently the onus of proving any of the above including legitimate interest rests solely upon the Respondent as laid out in the UDRP and even otherwise under Rules of Evidence, since the party that asserts legitimate interest must be able to conclusively prove the same. It would not be feasible to put the burden of proof upon the Complainant in any event as it is not possible to prove a negative factor.

The Respondent had the opportunity to demonstrate its rights or legitimate interest in the disputed domain name in accordance with paragraph 4(c) of the Policy however they chose not to do so. In this paragraph, the following are listed as circumstances that in particular, but without limitation, would demonstrate a respondent’s legitimate interest or right in a disputed domain name:

- i. that the Respondent used or presented demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services;
- ii. that the Respondent has been commonly known by the domain name;
- iii. that the Respondent 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 of the Complainant.

The Respondent has not submitted any evidence that establishes its rights or legitimate interests based upon any of the above requirements. While failure to respond does not present conclusive evidence against the Respondent and the burden of proof lies upon the Complainant to prove mala fide on the part of the Respondent, the Panel did consider the Respondent’s lack of response indicative of the Respondent’s lack of rights or legitimate interests in the disputed domain name (See *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

Furthermore, although the Response form sent to the Respondent created a provision for the Respondent to:

“(ii) Annex any additional documentation to support the Response, together with a schedule indexing such document(s).”

The Respondent has not provided any Response, nor any proof or documentation to assert the legitimacy of their claim upon the disputed domain name, thus the Panel is required to decide the matter on the basis of the Complaint and as such cannot establish any legitimate interest on the part of the Respondent to the dispute domain name as the Respondent is not linked to the Complainant or its business in any manner of form nor does it act on the Complainant’s behalf in any capacity as the Complainant has contended that no authorization has been given to the Respondent to make use of the trade marks/names “RED BULL” as part of the disputed domain name.

The name “RED BULL” or “REDBULL” would appear to have no real value to the Respondent except as a means of obtaining advantage from the goodwill of the Complainant’s well known trade marks/names to generate traffic on to the domain name in dispute by capitalizing on the Complainant’s registered trademarks/names.

Based on the evidence submitted by the Complainant, the Panel was satisfied that the trade marks/names of the Complainant are substantially well-known and are associated with great value and esteem solely with the Complainant. The Panel was guided by previous WIPO UDRP cases in reaching this conclusion.

“In the Panel’s opinion, the use of the expression “bona fide” in Paragraph 4(c)(i) is sufficient to prevent a respondent who knowingly adopted another’s well known mark as a domain name from claiming the benefit of mere use of or demonstrable preparations to use the domain name in connection with the offering of goods or services prior to notice of a dispute. The Panel accepts that SCANIA is a well known mark in the motor

industry, particularly in Sweden, and, accordingly takes the view that the respondent would have been unlikely to have been unaware of the fame of the complainant's mark SCANIA in the motor industry before adopting the name."

(See *Scania CV AB v. Leif Westlye*, WIPO Case No. D2000-0169).

Therefore the Panel cannot determine the Respondent to be making legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks/names of the Complainant.

It is the view of the Panel that similar reasoning applies to the case at hand and based on all of the above factors, the Panel finds the Respondent to have no rights or legitimate interest in the disputed domain name. Accordingly, the Panel finds that Paragraph 4(a) (ii) of the Policy is satisfied.

IV. Registration and use of the domain name in bad faith

In regards to the issue of bad faith the Paragraph 4(b) of the UDRP states that:

*"the following circumstances, in particular but **without limitation**, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:*

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

*(iv) **by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.**"*

The Panel believes that it is improbable that the Respondent would not have been aware of the Complainant and its trade marks/name when it obtained registration of the disputed domain name in its name, given the scope of RED BULL ENERGY DRINK's retail within Pakistan and the media advertisement worldwide from 1994 onwards.

The Complainant issued to the Respondent's a cease and desist letter on 7th December, 2007 alerting them of the infringement taking place via the registration of the domain name in dispute and requesting a halt to such actions. Despite such awareness provided, the Respondent renewed their registration in the domain name in dispute upon its expiry in June, 2008.

As noted above, the name "RED BULL" or "REDBULL" would appear to have no real value to the Respondent's except as a means of obtaining advantage from the goodwill of the Complainant's internationally renowned trademarks/names.

Thus the fact that the trademarks/names of the Complainant were registered long before the registration of the disputed domain name is suggestive of bad faith on the Respondent's part as the Panel opines that the name of the Complainant and the trade marks/names "REDBULL" or "RED BULL" are well entrenched with the Complainant's entity and business and is used unstintingly as the trade marks/names of the Complainant. The facts indicate conclusively that the Complainant is an internationally renowned company and that its trade marks/names would hence be recognized publicly and the Respondent could not help but be aware of such

trademarks/names being associated with the Complainant as well as have knowledge of the products offered by the Complainant, especially given the fact that the Complainant had issued a letter making the Respondent aware of the infringement being caused of its registered trade marks/names.

Additionally, it is the Panel's view that, on the balance of probabilities, the Respondent had actual knowledge of the trademarks/names of the Complainant. As it was noted in *Herbalife International, Inc v. Surinder S. Farmaha*, WIPO Case No. D2005-0765:

“the registration of a domain name with the knowledge of the complainant’s trademark registration amounts to bad faith.”

Is also determined in several Panel decisions that registration of a domain name that is confusingly similar or identical to a famous trademark/name, that cannot claim any relation to such a mark, is evidence of bad faith (see *AT&T Corp. v. John Zuccarini d/b/a Music Wave and RaveClub Berlin*, WIPO Case No. D2002-0440).

It therefore, on the balance of probabilities, can be inferred by the facts and the evidence provided that the Respondents obtained registration of the disputed domain name to exploit the trademark of the Complainant by disrupting or free-riding on the business or activities of the Complainant and hindering the Complainant's ability to further expand its business in Pakistan.

Furthermore, in the current proceedings, no indication of any correspondence between the Complainant and/or any representative of Complainant, on one side, with Respondent, on the other, or similar evidence, have been determined to suggest or imply that the Complainant may have approved of or condoned the Respondent's use of the Complainant's registered trade marks/names. Without any form of substantial evidence to indicate that the Complainant approved of or condoned the Respondent's use of their registered trade marks/names in the disputed domain name, the Panel cannot infer that such a relationship of association/affiliation existed between the Respondent and the Complainant. (See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D 2006-0560).

Therefore, given the Complainant's numerous trademark/name rights for “REDBULL” or “RED BULL” and its wide reputation, it is difficult to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name in dispute. Thus the Panel finds that the third test under paragraph 4(a) has been established successfully by the Complainant.

8. Decision

For the foregoing reasons, the Panel therefore concludes and decides that:

- i. The Respondent's registration of the disputed domain name <redbull.pk> is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondents have no legitimate interest in the disputed domain name.
- iii. The disputed domain name is identical to the Complainant's trade marks/names and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade marks/names.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the domain name at issue <redbull.pk> to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/,

whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Mustafa Syed,
Sole Panelist

Dated: 11th June, 2009