

ADMINISTRATIVE PANEL DECISION

LEADR Case No. auDRP_11_06

Domain Name: redbullmobile.com.au
Name of Complainant: Red Bull Gmbh
Name of Respondent: Callaghan & Callaghan
Provider: LEADR
Panelist: Alan L. Limbury
Date: 9 June, 2011

1. THE PARTIES

The Complainant is Red Bull Gmbh, of Fuschl am See, Austria, represented by Lisa Lennon of Gilbert + Tobin Lawyers, of Sydney, New South Wales, Australia.

The Respondent is Callaghan & Callaghan, of Bayview, New South Wales, Australia.

2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

The domain name at issue is **redbullmobile.com.au** ("the Domain Name").

The Registrar with which the Domain Name is registered is Netregistry Pty Ltd (ABN 13 080 859 721).

The Provider in relation to this proceeding is LEADR.

3. PROCEDURAL HISTORY

This is a proceeding under the .au Dispute Resolution Policy ("the Policy") and Rules For .au Dispute Resolution Policy ("the Rules") published by .au Domain Administration Limited ABN - 38 079 009 340 ("auDA") on August 13, 2010. The procedural history in this matter is set out in Annexure 'A' to this determination.

LEADR appointed me sole Panellist in this matter on May 25, 2011. I have had no prior association with either party and have no conflict of interest. The Panel has been properly constituted.

The Policy applies to the Domain Name.

4. FACTUAL BACKGROUND

The Complainant is an Austrian company which produces an energy drink under the trade mark RED BULL, which it has registered in many countries including Australia (Regd. Nos. 645166, dated February 24, 1995 and 1259214, dated March 19, 2008). The drink has been sold in Australia since 1999 by the Complainant's subsidiary, Red Bull Australia Pty Ltd (ACN 085 840 259). Unit sales in Australia rose from over 50 million in 2005 to over 120 million in 2010.

The Complainant has also applied to register in the European Community the device mark RED BULL MOBILE, Application. No. 009600032, dated December 15, 2010 and has

registered and uses numerous generic and country-code domain names incorporating the words Red Bull and Red Bull Mobile, including <redbull.com>, <redbull.com.au>, <redbullmobile.com>, <redbullmobile.eu>, <redbullmobile.de>, <redbullmobile.dk>, <redbullmobile.net> and <redbullmobile.us>.

The Domain Name was registered on July 18, 2009. It does not lead to a website.

5. PARTIES' CONTENTIONS

Complainant

The Complainant says it has established a substantial reputation in the RED BULL mark both overseas and in Australia; that the Domain Name is identical to its European device mark application and almost identical or confusingly similar to its RED BULL trade marks; that the Respondent has no rights or legitimate interests in respect of the Domain Name, which was registered or is subsequently being used in bad faith.

As to legitimacy, the Complainant says the Respondent does not satisfy the eligibility criteria to hold the Domain Name and is making no commercial use of it, since no website is operated nor is any *bona fide* offering of goods or services made *via* the Domain Name.

As to bad faith, the Complainant points to the passive holding of the Domain Name as evidence of bad faith registration either to prevent the Complainant from registering it or to disrupt the Complainant's business. The RED BULL trade mark is one of the best known trade marks in the world and the Respondent must have been aware of this fact when it deliberately registered the Domain Name, to prevent the Complainant from registering it in Australia.

The Complainant seeks the transfer to it of the Domain Name.

Respondent

The Respondent says it is a private investigations firm, which conducts covert surveillance for government agencies and for the insurance industry. The nature of its business requires that it securely store highly confidential and highly sensitive information. Hence the Respondent needed to introduce a secure real time online web interface for its staff.

The Respondent was asked by several companies to introduce its own case management webpage, separate from the Respondent. As the Respondent holds highly confidential information, the webpage will not be directly linked to the Respondent for security reasons. It will be utilised for interoffice use and will allow the Respondent's field agents to upload confidential and sensitive material. Only staff and field agents will have access to this page via secure password.

Members of the public will not be confused with <redbullmobile.com.au> as they will not have access to this webpage and no facet will be similar to <redbull.com.au>. The Respondent is not associated with any type of sports drink, nor does it claim to be, so it does not know where the confusion or conflict could be between <redbull.com.au> and the Domain Name.

The Respondent was given several years to comply with the storage management changes and agreed on the Domain Name, which was registered on July 18, 2009, almost 2 years ago. The Respondent asks: Why does the Complainant suddenly want our Domain Name now, after almost 2 years of registration?

The Respondent notes that RED BULL is registered as a Trade Mark under all classes. However the Complainant is not using that mark in the following classes in a *bona fide* way and removal should be made on the grounds of non-use: Class 5: Pharmaceutical, Class 10: Surgical, Veterinary, Class 13: Firearms & Ammunition, Class 15: Musical Instruments, Class 21: Household & Kitchen utensils, Class 29: Meat, Fish & Poultry, and Class 31: Agricultural, Horticultural & Forestry.

The Respondent also notes that REDBULLMOBILE is not registered as a Trade Mark in Australia and questions when the Complainant first used REDBULLMOBILE in Australia, since the Respondent believes it has prior and concurrent use of that name. Before registering the Domain Name it did the necessary checks: ASIC business name search, trade mark search etc in Australia and says that if this name was used in any way the Respondent would not have registered the Domain Name.

It appears that <redbullmobile.net.au> has only recently been registered by Red Bull Australia Pty Ltd, leading the Respondent to believe that they have just started using the name. The domain name <redbullmobile.net.au> is redirected to "www.redbullmobile.com". The Respondent questions why the Complainant is not able to conduct its internet activities under the <redbullmobile.net.au> domain name.

The "www.redbullmobile.net.au" website displays a map of the world. Australia is not one of the Countries listed.

The Respondent says it is only a small Australian business and does not have unlimited funds like an international company such as the Complainant. The Respondent wants to protect what belongs to it. It questions why it was allowed to purchase the Domain Name in the first instance, when apparently it has no rights at all, and another company such as the Complainant can come along at any time it chooses to contest the naming rights and have the right to remove it from the original registered party?

The Respondent believes that because the Complainant is a global conglomerate, it will not stop until it gets what it wants. The Respondent spent a great deal of time and money designing the web interface and is not in a position to have the Domain Name removed. It feels the Complainant has been totally unreasonable to the point of trying to bully it into making a difficult decision about the future direction of its business due to its Domain Name.

Believing that the Respondent's only options are: (i) that it keep the Domain Name; (ii) that the Complainant takes the Domain Name; and (iii) that the Complainant purchase the Domain Name for a fair and reasonable amount for both parties, and believing that the Complainant will continue to hound the Respondent if it does not get the Domain Name, the Respondent proposed to the Complainant's solicitor that the Complainant purchase the Domain Name for a fair and reasonable amount for both parties. The solicitor responded with an offer of AUD\$500.00, which the Respondent declined on the basis that it was a totally unreasonable amount since the Respondent has spent a considerable amount of personal time working on the Domain Name. The Respondent's counter offer, which it believes was fair and would have benefited both parties, was AUD\$2,500.00. That offer expired on May 20, 2011 and the Respondent now leaves the decision of 10 hard working Australians futures in the hands of this Panel.

6. DISCUSSION AND FINDINGS

Paragraph 15(a) of the Rules instructs the Panel as to the principles it is to use in determining this dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires the Complainant to prove:

- (i) the domain names are identical or confusingly similar to a name (Note 1), trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the domain names (Note 2); and
- (iii) the domain names have been registered or subsequently used in bad faith.

Note 1

For the purposes of this policy, auDA has determined that a “name ... in which the complainant has rights” refers to:

- (a) the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority; or
- (b) the complainant’s personal name.

Note 2

For the purposes of this policy, auDA has determined that “rights or legitimate interests in respect of the domain name” are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.

Rights

The Complainant clearly has rights in many countries, including Australia, to the trade mark RED BULL. The Respondent does not contest the Complainant’s claim that the RED BULL mark is famous and the Panel so finds.

It is unnecessary for the Panel to consider whether the Complainant has common law trade mark rights in RED BULL MOBILE. As under the Uniform Dispute Resolution Policy (“UDRP”), its pending application to register that name as a trademark in the European Community does not give rise to trade mark rights: see *Aspen Grove, Inc. v. Aspen Grove*, WIPO Case No. D2001-0798 and *Spencer Douglass MGA v. Absolute Bonding Corporation*, WIPO Case No. D2001-0904.

Identity/confusing similarity

As under the UDRP, essential or virtual identity is sufficient for the purposes of the Policy, and the test of confusing similarity under the Policy is confined to a comparison of the disputed domain name and the name or trademark alone, independent of the other marketing and use factors usually considered in trademark infringement or unfair competition cases: *Global Center Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. DAU 2002-0001. The claimed “in-house” use of the Domain Name by the Respondent is irrelevant when applying this test.

The 2LD suffix “.com.au” is to be disregarded in determining identity or confusing similarity: *ESAT Communications Pty Ltd v. Kingford Promotions Pty Ltd* LEADR Case No. 03/2003.

The Domain Name wholly incorporates the Complainant’s famous and distinctive RED BULL mark, with the addition of the descriptive word “mobile” which does nothing to detract from the distinctiveness of that mark and conveys an association with the Complainant.

The Panel finds the Domain Name to be confusingly similar to the Complainant’s RED BULL mark.

The Complainant has established this element.

Rights or legitimate interests

Paragraph 4c of the Policy provides that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate a respondent’s rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

“(i) before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
(ii) you (as an individual, business, or other organisation) 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 non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue”.

The Complainant bears the onus of proof of the absence of rights or legitimate interests on the part of the Respondent. The Complainant contends that the Respondent is ineligible to hold the Domain Name. The auDA Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs (2008-05) provide that domain names in the com.au 2LD must be an exact match, abbreviation or acronym of the registrant's name or trademark or otherwise closely and substantially connected to the registrant. The Respondent's name is Callaghan & Callaghan.

The Complainant further says that the Domain Name has not been used.

The Complainant's assertions suffice to establish a *prima facie* case that the Respondent has no rights or legitimate interest in the Domain Name. Accordingly, the burden of proof shifts to the Respondent to produce evidence of any rights or relevant interest it may have.

The Respondent does not address the eligibility issue, other than to show that it chose a domain name that would not convey any connection to the Respondent. The Panel finds the Respondent to have been and to be ineligible to register the Domain Name.

As to non-use, the Respondent's language is consistent with the Complainant's contention that the Domain Name has not been used: "... the webpage will not be directly linked to the Respondent for security reasons. It will be utilised for interoffice use and will allow the Respondent's field agents to upload confidential and sensitive material. Only staff and field agents will have access to this page via secure password". There is no evidence before the Panel that the Respondent has used the Domain Name in connection with an offering of goods or services or at all nor any evidence of preparations to use the Domain Name.

Accordingly the Panel finds that the Respondent has no rights or legitimate interests in the Domain Name.

The Complainant has established this element.

Registration or use in bad faith

The Respondent has explained that it was asked by several companies to introduce its own case management webpage, separate from the Respondent, which would not be directly linked to the Respondent for security reasons. This explains why the Respondent chose a domain name that did not reflect a close association with it. However, that explanation does not address the question why the Respondent chose this particular domain name. The Panel infers that the need to avoid a direct link to the Respondent led the Respondent to choose a domain name which did more than simply not point to the Respondent but rather to choose one that pointed as far away from the Respondent as possible, namely to the Complainant.

The Panel concludes that the Respondent was well aware of the famous RED BULL trade mark when it chose the Domain Name and that it registered the Domain Name in order to convey to anyone who might come across it that the Domain Name was associated with or belonged to the Complainant. No doubt it was intended that its staff and field agents would be informed of the Domain Name as a secure means of storing and communicating confidential

information and, themselves being aware of the Complainant's RED BULL mark, would have appreciated that this was being done under the pretence of being the Complainant.

Whilst appreciating the importance to the Respondent of a domain name that, for security reasons, did not reveal a connection with its business, the Panel finds that *vis a vis* the Complainant, the Domain Name was registered in bad faith.

The Complainant has established this element.

DECISION

Having found in favour of the Complainant on all three of the required elements, the Panel orders that the Domain Name <redbullmobile.com.au> be transferred to the Complainant.

The Panel notes that the Complainant, as the registrant of the Australian registered trademark RED BULL, is eligible to hold the Domain Name under the auDA Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs (2008-05).

Dated June 7, 2011

**ALAN L. LIMBURY
SOLE PANELLIST**

Annexure "A"

Procedural History

**[redbullmobile.com.au]
[auDRP_11_06]**

1. Complaint lodged with LEADR on **12/4/2011**.
1. LEADR sent non-compliance notification via email to Complainant on **14/4/2011**.
2. The complete application was received from the Complainant by LEADR on **14/4/2011**.
3. A copy of the complaint was submitted and a request to clarify Respondent details and lock the domain name during proceedings was emailed to the registrar **Netregistry** on **21/4/2011**.
4. On the **27/4/2011** the Registrar confirmed via email that the domain name in dispute has been locked.
5. LEADR advised auDA of the complaint on **29/4/2011** via e-mail.

6. On the **29/4/2011** LEADR sent the Respondent (**Callaghan & Callaghan**) an email and written notification of the complaint.
7. LEADR received a mail delivery system error message on **29/4/2011** due to the Respondent's email address being incorrectly written.
8. On the **2/5/2011** LEADR sent the Respondent (**Callaghan & Callaghan**) a second email and written notification of the complaint.
9. After verifying the Respondent's (**John Callaghan**) correct email address via a telephone conversation on **11/5/2011**, LEADR sent the Respondent (**John Callaghan**) a third email and written notification on the **11/5/2011** of the complaint.
10. The due date for the response to the complaint was confirmed to be **22/5/2011**.
11. On the **22/5/2011**, the Respondent (**Callaghan & Callaghan**) submitted an emailed response to the domain name complaint.
12. The response by the Respondent (**Callaghan & Callaghan**) to the domain name complaint was forwarded to the Complainant via email on **23/5/2011**.
13. On **24/5/2011** the provider approached the Panellist. The Panellist confirmed his availability, informed LEADR that he had no conflict issues with the parties and accepted the matter on **25/5/2011**.
14. The Case file and relevant correspondence were forwarded to the Panellist on **26/5/2011**
15. The parties to the dispute were notified of the Panellist's allocation on the **26/5/2011**.
16. The date on which the decision is due is **9/6/2011**.