

ADMINISTRATIVE PANEL DECISION

Bright Imperial Ltd. v. Cleiton da Silva Pardim
Case No. D2013-1548

1. The Parties

The Complainant is Bright Imperial Ltd. of Wanchai, Hong Kong, China, represented by Sheppard, Mullin, Richter & Hampton, United States of America.

The Respondent is Cleiton da Silva Pardim of Moscavide, Portugal.

2. The Domain Name and Registrar

The disputed domain name <redtube8.xxx> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 4, 2013. On the same date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 5, 2013, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on September 16, 2013 requesting the Complainant to confirm that a copy of the Complaint, together with the Complaint Transmittal Coversheet, had been sent or transmitted to the Respondent in accordance with Rules, Paragraph 2(b). The Complainant confirmed this on the same day.

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

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 18, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was October 8, 2013. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 9, 2013.

The Center appointed Luca Barbero as the sole panelist in this matter on October 23, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The Respondent sent a Supplemental Filing by email to the Center on October 25, 2013.

4. Factual Background

The Complainant operates an adult video website at “www.redtube.com” that was registered on January 7, 2006.

The Complainant is the owner of several trademark registrations for REDTUBE that it acquired through an assignment from its predecessor-in-interest Jager & Polacek, GmbH, in 2009. Recording of the assignment in the various trademark offices is ongoing.

The Complainant has provided evidence of ownership of several trademark registrations for REDTUBE, including the following, showing the Complainant as registered owner:

- Australian Trademark No. 1228767, registered on March 10, 2008, in classes 38, 41 and 42;
- Australian Trademark No. 1288507, registered on March 5, 2009, in classes 9, 35, 38, 41 and 42;
- United States Trademark No. 3843119, registered on August 31, 2010, in International classes 9, 10, 28, 41 and 45;
- Community Trademark No. 007408297, filed on November 19, 2008, in classes 28, 35, 42 and 45;
- Community Trademark No. 007408231, filed on November 19, 2008, in classes 9 and 38;

The Complainant is also the owner of the domain name <redtube.xxx>, that was registered on December 1, 2011.

The Respondent registered the disputed domain name <redtube8.xxx> on May 19, 2013 and has redirected it to an adult content website.

5. Parties' Contentions

A. Complainant

The Complainant asserts that its trademark REDTUBE is inherently distinctive, particularly in the context of the goods and services with which the mark is used, and that, due to the success and efforts of the Complainant, the trademark has acquired extraordinary further distinctiveness and has become famous worldwide.

The Complainant relies on its trademark registrations for REDTUBE and claims to have acquired also common law rights in the trademark REDTUBE in several countries (European Union, United States, Great Britain, Canada and Australia), by virtue of: i) the extensive use made by the Complainant and its predecessor-in-interest, since at least July 2006, to identify its products and services in commerce; ii) the Complainant's investments in advertising; and iii) the consuming public's use and association of the mark to refer to the products and services developed and marketed by the Complainant.

The Complainant states that its products and services have earned widespread notoriety on a global scale, substantiating this assumption through examples of publications and media outlets that mentioned the Complainant's REDTUBE products and services, including renown newspaper and magazines such as San Francisco Chronicle, Financial Times, New York Magazine and Forbes.

The Complainant contends that the disputed domain name is confusingly similar to the trademark REDTUBE.

The Complainant claims that the Respondent has no rights to, or legitimate interests in, the disputed domain name, since the Respondent has received no license from the Complainant to use the trademark REDTUBE or to register a domain name incorporating it and the Respondent is not commonly known by the disputed domain name or by the names "Redtube" or "Redtube8".

The Complainant also states that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name since it is generating traffic to its website for its own commercial gain by taking unfair advantage of the confusion arising out of the similarity between the disputed domain name and the REDTUBE mark.

In particular, the Complainant asserts that:

- The Respondent has copied the Complainant's website "www.redtube.com" to draw users to its website and induce them to believe that it is associated with or sponsored by the Complainant. Specifically, the Complainant points out that the Respondent's website is virtually identical to its website, since it features the term "redtube8" at the top of it in the same colors (red and white) as the REDTUBE mark/logo published at the top of the Complainant's website uses the same black backdrop, lists the same headings and links on the navigation tab and embeds many of the videos published on the Complainant's website.
- The Respondent is publishing on the website corresponding to the disputed domain name banners advertising websites of Complainant's competitors, from which the Respondent receives revenues and has offered the disputed domain name for sale to the general public since, on the bottom of the website, on July 2, 2013, the following statement was published: "REDTUBE 8 FOR SALE!!! ENJOY € PRICE INITIAL 3,000€";

As to bad faith at the time of the registration, the Complainant underlines that the Respondent certainly had actual notice of the REDTUBE mark and of the exclusive public association between said trademark and the Complainant and highlights that, by the time the Respondent registered the disputed domain name, on May 19, 2013, the Complainant had already become famous among online consumers worldwide, and had acquired common law and registered trademark rights in many countries worldwide.

The Complainant indicates that, since its website is one of the top adult websites in the world, anyone operating in the adult industry, including the Respondent, would undoubtedly be aware of the website. The Complainant further states that the Respondent had actual knowledge of the REDTUBE trademark since it contacted the Complainant with an offer to sell the disputed domain name approximately one month after registering the disputed domain name.

The Complainant also contends that the Respondent had constructive notice of the Complainant's trademark, due to the prior use of REDTUBE trademark in commerce before the registration of the disputed domain name. The Complainant further alleges that a routine Internet search would have revealed the Complainant's website and its trademark.

As additional circumstances evidencing bad faith, the Complainant informs the Panel that, besides being offered for sale to public through the statement published on the Respondent's website, the disputed domain name was offered for sale by the Respondent to the Complainant, through the unsolicited email communication dated June 20, 2013, for the amount of EUR 3,000. The Complainant therefore states that the Respondent registered and used the disputed domain name for the purpose of selling it to the Complainant in bad faith for an amount in excess of the out-of-pocket costs related to the disputed domain name.

B. Respondent

The Respondent did not submit a timely Response. Through a Supplemental Filing submitted on October 25, 2013, the Respondent denied any similarity between “redtube8” and REDTUBE.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “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 directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

As mentioned in the paragraphs above, the Complainant has provided evidence of ownership of several trademark registrations for REDTUBE.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s REDTUBE trademark, since the Respondent has merely added the number “8” to the trademark, which is certainly not sufficient to exclude the confusingly similarity. See, along these lines, *Bright Imperial Ltd. v. PROXHOST International, Herr Carlos Torres*, WIPO Case No. D2012-1816 (<redtube8.net>).

In addition, as stated in many panels decisions issued under the Policy, the addition of the generic Top-Level Domain (“gTLD”) “.xxx” may be excluded from consideration as being a merely functional component of a domain name. See *inter alia*, *Kate Spade, LLC v. Ming Tuff*, WIPO Case No. D2012-1907 (<katespade.xxx>) and *La Roche-Posay Laboratoire Pharmaceutique v. WhoisGuard Protected/ Email me, n/a*, WIPO Case No. D2012-2283 (<laroche-posay.xxx>).

In view of the above, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(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.”

It is well-established that the burden of proof lies on the Complainant. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one.

Accordingly, in line with the UDRP precedents, it is sufficient that the Complainant shows a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name, in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455; *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110; *MetAmerica Mortgage Bankers v. Whois ID Theft Protection, c/o Domain Admin*, NAF Claim No. FA852581; *Banco Itau S.A. v. Laercio Teixeira*, WIPO Case No. D2007-0912; *Accor v. Eren Atesmen*, WIPO Case No. D2009-0701).

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel observes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks.

Furthermore, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name, has made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, or that it intends to make a legitimate, noncommercial or fair use of the disputed domain name.

Indeed, the Respondent has been using the disputed domain name to draw Internet users to a website offering the same kind of content provided by the Complainant under the trademark REDTUBE, thus in competition with the Complainant. In addition, according to the evidence in the record, the very same videos published on the Complainant’s website have been embedded on the Respondent’s site and also several sponsored banners have been featured therein.

Thus, in light of the above, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name, in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, 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 the disputed domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed 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 the Respondent’s documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Panel notes that, in light of the Complainant's prior registration and use of the Complainant's trademark REDTUBE for several years before the registration of the disputed domain name, and in view of the popularity of the website "www.redtube.com" among adult content websites highlighted by the documents submitted by the Complainant, the Respondent was or ought to be aware of the Complainant's trademark at the time of the registration of the disputed domain name, confusingly similar to the Complainant's trademark REDTUBE.

In addition, the Respondent's sending of an unsolicited email communication, approximately one month after the registration of the disputed domain name, to the Complainant with the offer of the disputed domain name for sale, and the use of the disputed domain name to publish the same contents as the ones displayed on the Complainant's website - including embedded videos - show, in the Panel's view, that the Respondent was indeed actually well aware of the trademark REDTUBE when opted for the registration of the disputed domain name.

Based on the evidence in the record, the Panel finds that the disputed domain name was registered by the Respondent for the purpose of selling it to the Complainant for EUR 3,000, an amount well in excess of the documented out-of-pocket costs, according to paragraph 4(b)(i) of the Policy (see, *inter alia*, *Bencom SRL v. NetCorporation*, WIPO Case No. DRO2006-0007 and *DHL Operations B.V. v. Karel Salovsky*, WIPO Case No. D2006-0520) of registration of a ".xxx" domain name.

Furthermore, the Panel finds that, by maintaining the website to which the disputed domain name resolves, the Respondent is using the disputed domain name in bad faith in an intentional attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's REDTUBE trademark as to the source, sponsorship, affiliation, or endorsement of the website according to paragraph 4(b)(iv) of the Policy.

In view of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <redtube8.xxx> be transferred to the Complainant.

Luca Barbero

Sole Panelist

Date: November 6, 2013