



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International, Inc. v. John Smith**

**Case No. D2008-0726**

#### **1. The Parties**

The Complainant is Playboy Enterprises International, Inc. of Chicago, Illinois, United States of America, represented by the law firm Howard, Phillips & Andersen, United States of America.

The Respondent is John Smith, who provided to the Registrar the following contact address: EMedia Services LLC, Los Angeles, California, United States of America.

#### **2. The Domain Names and Registrar**

The disputed domain names <bunnybridget.com>, <misterplayboy.com>, <msplayboy.com>, <playboybaby.com>, <playboytalentscout.com>, <playbun.com>, <playgirlnextdoor.com>, and <pose4playboy.com> (collectively, the “Domain Names”) are registered with Blueberry Hill Communications, Inc., d/b/a 4domains.com (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2008. On the same date, the Center transmitted by e-mail to the Registrar a request for registrar verification in connection with the disputed Domain Names. On May 12, 2008, the Registrar transmitted by e-mail to the Center its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), 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 May 15, 2008. In accordance with the Rules, paragraph 5(a), the due date for the Response was June 4, 2008. The Respondent did not submit any Response. Accordingly, the Center, on June 9, 2008, sent an e-mail addressed to the Respondent, at the address provided, confirming that the Respondent had defaulted in making any response to the Complaint and notifying the Respondent of the consequences of such default.

The Center appointed Peter L. Michaelson, Harry L. Arkin and D. Brian King as panelists in this matter on July 1, 2008. The Panel finds that it was properly constituted. Each member of 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.

#### **4. Factual Background**

The facts set out herein are based upon the information and allegations contained in the Complaint, as well as the documentary evidence submitted with it. As the Respondent has defaulted, the Complainant's allegations stand un rebutted.

The Complainant is a multimedia adult entertainment company best known as the publisher of *Playboy* magazine, in circulation since 1953. Since first securing trademark registration for PLAYBOY in 1954, the Complainant has registered trademarks for various other terms related to the PLAYBOY brand, including BUNNY, PLAYMATE and others. Many of the Complainant's more recent trademark registrations relate to its online services.

The Respondent registered the Domain Names between April 18, 2006 and September 20, 2006. On August 10, 2006, after discovering the existence of the <playboytalentscout.com> domain name, which linked to the Complainant's MySpace page, the Complainant sent the Respondent a letter objecting to his use of that domain name. This letter was returned to the Complainant by Federal Express as undeliverable, so the Complainant also sent the letter to the Respondent via e-mail on August 28, 2006. The Complainant later learned that EMedia Services LLC states that it does not employ any person named John Smith.

The following year, the Complainant sent the Respondent a further letter via e-mail complaining of the Respondent's use of <msplayboy.com>, which the Respondent was linking to <miscellanies.com>, the website of a company that "manages and control[s] Hollywood and talent-related sites." The Respondent did not respond to this letter. Subsequently, however, <msplayboy.com> and <playboytalentscout.com> were redirected to link to <openhouse.us>, a website that appears to offer online real estate services. The Complainant subsequently discovered the existence of the six other Domain Names, each of which also links to <openhouse.us>. The Complainant further discovered that the Respondent had previously owned registrations for other domain names bearing a similarity to its trademarks, those being <playboyspecial.com>, <playboyspecials.com> and <playmatespecialitions.com>.

At the time of filing of the Complaint, four of the eight Domain Names had expired. At the time of issuance of this Decision, the date of expiry of three more of the Domain Names has passed. The eighth Domain Name, <bunnybridget.com>, will expire on September 20, 2008.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that the Domain Names are confusingly similar to trademarks in which the Complainant has rights; that the Respondent has no rights or legitimate interests in respect of the Domain Names; and that the Domain Names were registered and are being used in bad faith.

In support of the foregoing contentions, the Complainant submits in summary as follows:

- The Domain Names incorporate the Complainant's PLAYBOY or BUNNY trademarks coupled with terms associated therewith, and thus the Domain Names are confusingly similar to the Complainant's trademarks.
- The Respondent is not known by the Domain Names, has not been authorized by the Complainant to utilize the Complainant's trademarks in any way, and has never made any *bona fide* use of the Domain Names.
- The Respondent's registration and use of the Domain Names in bad faith is demonstrated by several circumstances: (i) the act of registration alone, given the widespread fame of the Complainant's trademarks; (ii) the use of the Domain Names to link to the Complainant's own MySpace site, and to unrelated commercial sites, thereby generating consumer confusion; (iii) the Respondent's alleged redirection of some of the Domain Names to other sites after being sent demand letters by the Complainant; and (iv) the Respondent's earlier registration of domain names incorporating the Complainant's trademarks.

### B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

As a preliminary matter, the Panel notes that although three of the Domain Names have expired during the course of this dispute, paragraph 3.7.5.7 of the ICANN Expired Domain Deletion Policy provides that "[i]n the event that a domain which is the subject of a UDRP dispute is deleted or expires during the course of the dispute, the Complainant in the UDRP dispute will have the option to renew or restore the name under the same commercial terms as the registrant." With respect to the four Domain Names that expired prior to the filing of the Complaint, the Panel notes that the Registrar has confirmed that they have been locked pending resolution of this dispute, and thus will be available for registration by the Complainant after the present dispute is resolved. In these circumstances, the Complainant has a legitimate interest in pursuing its Complaint, even as to those Domain Names that have expired prior to or in the course of this dispute.

Paragraph 4(a) of the Policy sets forth three conjunctive requirements that have to be met for a complaint under the Policy to succeed. Those are:

- The respondent's domain name is identical or confusingly similar to a

trademark or service mark in which the complainant has rights; and

- The respondent has no rights or legitimate interests in respect of the domain name; and
- The respondent’s domain name has been registered and is being used in bad faith.

In proceedings before a panel, the complainant bears, in principle, the burden of proof on each of these elements. The panel has to decide the matter based on the statements, information and documents submitted, and in accordance with the Policy, the Rules and any rules or principles of law that it deems applicable (see Rules, paragraph 15(a)). A discussion of each element follows below.

#### **A. Identical or Confusingly Similar**

Each of the Domain Names combines one of the Complainant’s registered trademarks and an associated term.

- The Domain Names <misterplayboy.com>, <msplayboy.com>, <playboybaby.com>, <playboytalentscout.com>, and <pose4playboy.com> combine the Complainant’s trademark PLAYBOY – registered on several occasions, most recently in 2001 – with a prefix (Mr. or Ms.), a colloquial term for a woman (baby), or a term associated with the Complainant’s efforts to attract models for its business (pose, talent scout).
- The Domain Names <bunnybridget.com> and <playbun.com> utilize the Complainant’s trademark BUNNY – registered in 1966 – by combining it with the first name of an actress appearing on a reality show with *Playboy*’s founder, Hugh Hefner, or by abbreviating it.
- The Domain Name <playgirlnextdoor.com> combines a variation of the Complainant’s trademark PLAYBOY (playgirl) with the name of the television show (*The Girls Next Door*), which has been airing since August 2003.

The Panel takes note of the fact that the Complainant’s PLAYBOY and BUNNY trademarks have worldwide fame, as recognized by numerous panels. *See, e.g., Playboy Enterprises International Inc. v. Roger Banning*, WIPO Case No. D2006-1542 (February 26, 2007); *Playboy Enterprises International Inc. v. Tamara Pitts*, WIPO Case No. D2006-0675 (August 3, 2006); *Playboy Enterprises International Inc. v. Asia Sun*, WIPO Case No. D2005-0767 (September 6, 2005); *Playboy Enterprises International Inc. v. Vileshome*, WIPO Case No. D2001-1082 (Oct. 30, 2001). This Panel can only agree that “[t]he Playboy brand is one of the most recognized in the world.” *Playboy Enterprises International Inc. v. Federico Concas a.k.a. John Smith a.k.a. orf3vsa*, WIPO Case No. D2001-0745 (August 5, 2001).

Where, as here, a domain name combines such famous marks, or clearly and readily obvious abbreviations thereof, with other words or terms associated with the trademark holder’s business, the domain name is confusingly similar to the trademark, and the first element of the test under the Policy is met.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out three non-exclusive circumstances that, if present, will demonstrate the existence of rights or legitimate interests in respect of a domain name. Neither those circumstances nor any others suggesting the existence of rights or legitimate interests on the Respondent's part are present here.

There is no indication that the Respondent or his business (whatever that might be) has ever been known by the Domain Names. Further, the Complainant has not given the Respondent any right or authority to use its trademarks.

The Respondent has used the Domain Names, but not in connection with a *bona fide* offering of goods or services. Given the fame of the Complainant's trademarks, the Respondent was almost certainly aware of the Complainant's prior rights at the time he registered the Domain Names. By linking the Domain Names to, variously, the Complainant's own MySpace site and unrelated commercial websites – at least one of which, <miscellanies.com>, arguably competes with the Complainant in certain respects – the Respondent created a false impression of affiliation with the Complainant where none exists. Such use, whether for commercial purposes or not, is illegitimate and cannot create cognizable rights or interests in the Domain Names.

On these grounds, the Panel finds that the second element of the test under the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

The Panel has no difficulty in finding registration and use in bad faith on the facts here.

As already indicated above, when the Respondent registered the Domain Names he knew or should have known of the Complainant's trademark rights. He proceeded to use the Domain Names in ways that created a false impression of affiliation with the Complainant, and he did so at least in part for commercial purposes. This constitutes, or is at least sufficiently analogous to, the circumstance identified in paragraph 4(b) of the Policy as evidencing bad faith registration and use.

Thus, the Panel concludes that the third element of the test under the Policy has been sufficiently established.

## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names <bunnybridget.com>, <misterplayboy.com>, <msplayboy.com>, <playboybaby.com>, <playboytalentscout.com>, <playbun.com>, <playgirlnextdoor.com> and <pose4playboy.com> be transferred to the Complainant.

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D. Brian King  
Presiding Panelist

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Peter L. Michaelson  
Panelist

Harry L. Arkin  
Panelist

Date: July 16, 2008