



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International, Inc. v. Caracas Dating LLC**

**Case No. D2008-0511**

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

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

Respondent is Caracas Dating LLC, Beverly Hills, California, United States of America.

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

The disputed domain name <caracasplayboy.com> is registered with Moniker Online Services, LLC.

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 3, 2008. On April 3, 2008, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the domain name at issue. On April 11, 2008, Moniker Online Services, LLC transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent notice of change in registrant information to Complainant on April 16, 2008 providing the registrant and contact information disclosed by the Registrar and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on April 21, 2008. The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on April 29, 2008. In accordance with the Rules, paragraph 5(a), the due date for Response was May 19, 2008. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on May 23, 2008.

The Center appointed Lynda J. Zadra-Symes, Peter L. Michaelson and James H. Grossman as panelists in this matter on June 24, 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**

Complainant is an international multimedia entertainment company and publisher of *Playboy* magazine. Complainant also operates Playboy television and cable networks worldwide; distributes programming via home video, DVD and wireless networks worldwide; licenses its PLAYBOY trademarks internationally for a wide range of consumer goods and services; and operates several men's lifestyle and entertainment websites, including "www.playboy.com", "www.playboystore.com" and "www.playboytv.com".

Complainant owns thousands of trademark registrations and active applications for marks including the term PLAYBOY in the United States and worldwide. Complainant first obtained a United States Trademark Registration for PLAYBOY in 1954 and has acquired many additional registrations covering entertainment and adult entertainment online. These registrations include the following:

PLAYBOY'S	U.S. Reg. No. 1,733,661	Registered November 17, 1992
PLAYBOY	U.S. Reg. No. 2,482,255	Registered August 28, 2001
PLAYBOY	U.S. Reg. No. 2,631,654	Registered October 8, 2002
PLAYBOY TV	U.S. Reg. No. 2,190,905	Registered September 22, 1998

Complainant holds over 2,287 registrations for the mark PLAYBOY and 717 registrations for PLAYBOY variation marks in 198 countries, including in Venezuela. Complainant acquired its first registration for PLAYBOY in Venezuela in 1963, and has since acquired many registrations covering a wide variety of goods and services, several of which were summarized in exhibits attached to the Complaint.

Complainant also owns several marks consisting of a RABBIT HEAD design which is often used in connection with Complainant's PLAYBOY marks. Complainant has also acquired registrations for this mark in the United States and worldwide, including in Venezuela and including registrations specifically covering use of the RABBIT HEAD design on the Internet.

On November 25, 2002 and December 4, 2002, Complainant sent demand letters to the then registrant of the disputed domain name notifying it of Complainant's trademark objections to its registration and use of the domain name. The registrant did not respond to Complainant's demand letters and continued to use the domain name to host

a commercial website that prominently displayed materials and marks that infringed Complainants trademarks and copyrights.

Some time prior to March 1, 2007, the registrant transferred its registration to a domain name proxy service using the name “Whois Data Shield.” Subsequently, Respondent used the name “Domain Privacy Service.” Neither of these names are affiliated with Moniker Online Services, LLC, the registrar of the domain name. Moreover, neither Whois Data Shield nor Domain Privacy Service is registered as a business entity with the Florida Department of State. Other than the information in the WhoIs record for <caracasplayboy.com>, Complainant could not locate any information about these business names or find any evidence of their existence as a legitimate proxy service. The registrant name subsequently changed to Caracas Dating LLC, with an address in Beverly Hills, California. The State of California has no record of any type of corporate entity with that name. The phone number shown in the WhoIs record for the office of a medical doctor located in Santa Ana, California, who has no knowledge of this matter.

## **5. Parties’ Contentions**

### **A. Complainant**

Complainant contends that the domain name is confusingly similar to its PLAYBOY mark, in which Complainant has rights, that Respondent has no rights or legitimate interests in the domain name, and that the domain name was registered and is being used in bad faith.

### **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## **6. Discussion and Findings**

In order to succeed on its claim, Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

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

Paragraph 15(a) of the Rules instructs this Panel to 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.”

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

The disputed domain name incorporates Complainant’s PLAYBOY trademark in its entirety. The addition of the geographic city name “Caracas” in the domain name does not avoid a finding of confusing similarity.

The Panel finds that the first criterion is satisfied.

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

Complainant contends that Respondent has no rights or legitimate interests in the domain name because Respondent is not known by the domain name, has not been authorized by Complainant to use the PLAYBOY marks in any connection, and has never made a *bona fide* use of the domain name.

The domain name was registered on October 17, 2002, long after Complainant had adopted and used its PLAYBOY trademark and established significant Internet presence. The domain name has been used to host a commercial website offering adult-content entertainment and services online. The website prominently featured Complainant's registered RABBIT HEAD design, including a logo incorporating an exact counterfeit of Complainant's RABBIT HEAD design. The website displayed copyrighted images belonging to Complainant and promoted an escort and massage service allowing clients to make private appointments with women pictured on the website. Complainant does not offer such services, which are often associated with illegal conduct and are potentially offensive to Complainant's customers and advertisers.

The website also displayed images of female models in frames adorned with Complainant's RABBIT HEAD design and labeled with various calendar months, thereby copying a distinctive element of Complainant's PLAYBOY magazine in which a new model is featured in each monthly issue.

Such infringing use of Complainant's trademarks and copyrighted materials is not a *bona fide* use of the domain name.

The website appears to have been used in a similar fashion over a number of years although in some cases without Complainant's RABBIT HEAD design, and currently resolves to a landing page featuring links of an adult nature.

The Panel finds that Respondent has no rights or legitimate interests in the domain name.

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

Paragraph 4(b) of the Policy states circumstances which, if found, shall be evidence of the registration and use of the domain name in bad faith:

- (i) circumstances indicating that Respondent has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) Respondent has 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, providing that Respondent has engaged in a pattern of such conduct; or

- (iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, Respondent has intentionally attempted to attract for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website or location of a product or service on Respondent's website or location.

By using the disputed domain name, Respondent is attempting to attract for commercial gain Internet users to Respondent's website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website. Furthermore, in view of the worldwide fame in the PLAYBOY mark, and Respondent's unauthorized use of Complainant's trademarks and, at some point, copyrighted materials on the website located at the disputed domain name, it is clear that Respondent had actual knowledge of the Complainant's well-known known PLAYBOY mark. Respondent's registration of the domain name appears to be deliberately intended to misdirect web traffic of individuals in order to trade off the goodwill in Complainant's PLAYBOY mark.

Furthermore, Respondent appears to have a pattern of such conduct. Respondent's email address, "quantum1@adelphia.net", appears in the WhoIs records of numerous domain names that incorporate the famous trademarks of others or obvious misspelling of such trademarks, including, for example, <chicagowhitesox.com>, <crownplazahotel.com>, <houstonastros.com>, <marysmaids.com>, <scottradee.com>, <spongbobmovi.com> and <spongbobmoves.com>.

Thus, the Panel finds that Respondent has registered and used the domain name in bad faith in accordance with paragraph 4(b)(iv) of the Policy.

## 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 name <caracasplayboy.com> be transferred to Complainant.

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Lynda J. Zadra-Symes  
Presiding Panelist

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Peter L. Michaelson  
Panelist

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James H. Grossman  
Panelist

Date: July 8, 2008