



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Tamara Pitts

Case No. D2006-0675

1. The Parties

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

The Respondent is Tamara Pitts, Las Vegas, Nevada, United States of America.

2. The Domain Name and Registrar

The disputed domain name <playboyclublasvegas.com> is registered with GoDaddy.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2006. On May 31, 2006, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 1, 2006, 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 for the administrative, billing, and technical contacts, all listed as the Respondent Tamara Pitts. 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 June 12, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was July 2, 2006. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 3, 2006.

The Center appointed W. Scott Blackmer, Peter L. Michaelson, and Paul E. Mason as panelists in this matter on July 26, 2006. 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 Complainant is a Delaware corporation headquartered in Chicago, Illinois. It is characterized in the Complaint as “a brand-driven, international multimedia entertainment company, perhaps best known as the publisher of *Playboy* magazine, the world’s best-selling men’s magazine.”

The Complainant states that *Playboy* has been published since 1954 and that *Playboy* now sells four million copies monthly (based on the combined circulation of the US and international editions), while the website at “www.playboy.com” (registered by the Complainant) receives more than 2.5 million unique visitors per month. The Complainant quotes *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745, in concluding that the PLAYBOY brand is “one of the most recognized in the world.”

The Complaint does not indicate precisely how the Complainant is related to the Delaware corporation Playboy Enterprises, Inc., which is listed on the New York Stock Exchange. Both corporate names appear on “www.playboy.com” and other websites cited in the Complaint. It appears from these websites and from publicly available court filings and press releases that the Complainant is the corporate entity in the Playboy group that holds and licenses many of the intellectual property assets (including various PLAYBOY marks) to which Playboy Enterprises, Inc. refers on its corporate website at “www.playboyenterprises.com” and in its 2005 Annual Report. In any event, the Complainant is the entity that holds the trademark registrations on which this UDRP proceeding is grounded, and the Panel infers from the corporate website and from the official reports and filings it has reviewed that the marketing and business activities described in the Complaint are conducted by the Complainant’s parent or affiliates if not by the Complainant itself.

The Complainant reports that the first United States trademark registration for PLAYBOY was issued in 1954 and that the Complainant currently “owns thousands of trademark registrations and active applications for PLAYBOY in the United States and worldwide.” These include the following registrations for which the Complainant submitted printouts from the website operated by the United States Patent and Trademark Office (USPTO):

| Mark | Reg. No. | Date of First Use in Commerce | Reg. Date |
|----------------------|-----------|-------------------------------|---------------|
| PLAYBOY | 2,631,654 | Aug. 29, 2001 | Oct. 8, 2002 |
| PLAYBOY | 2,482,255 | May 2000 | Aug. 28, 2001 |
| PLAYBOY’S | 1,733,661 | Sept. 1985 | Nov. 17, 1992 |
| PLAYBOY.COMVERSATION | 2,538,068 | Nov. 17, 2000 | Feb. 12, 2002 |
| PLAYBOYTV CLUB | 2,894,179 | June 6, 2002 | Oct. 19, 2004 |
| PLAYBOY CYBER CLUB | 2,322,800 | June 1997 | Feb. 29, 2000 |

These registrations cover a variety of goods and services, notably including entertainment and casino services.

From the 1960s through 1991, the Playboy group operated nightclubs in many cities. Playboy Enterprises, Inc. obtained a US trademark registration for THE PLAYBOY CLUB in 1963 (No. 0746367). That mark was cancelled sometime after the last US Playboy Club was closed in 1988. The Complainant now has a pending US trademark application for THE PLAYBOY CLUB (published for opposition in November 2003), as the Playboy group is re-entering the “location-based entertainment” business.

The Complainant provided a copy of a Playboy Enterprises, Inc. press release dated October 6, 2004 announcing its participation in a “Playboy-themed” nightclub, casino, retail store, and “sky villa” to be located in a new tower at the Palms Casino Resort in Las Vegas, scheduled for opening in 2006. Further announcements about updating and reintroducing the famed (and trademarked) BUNNY COSTUME service uniform for use at that location were widely reported in July 2005, including articles in *People* magazine, the *Los Angeles Times*, *New York Newsday*, and the *New York Post*.

The Domain Name was registered in the Respondent’s name, showing an address in Las Vegas, Nevada, on October 28, 2004 – some three weeks after the public announcement of the planned Playboy-themed nightclub and casino at the Palms Casino Resort in Las Vegas. Until May 2006, the only known use of the Domain Name was to point to a parking website hosted by the Registrar, for which the Complainant provided a printout dated May 15, 2006. That website was headed “www.playboylasvegas.com,” followed by the statement, “This page is parked free, courtesy of GoDaddy.com.” The website displayed “sponsored links” for Las Vegas hotel websites and websites offering tickets or reviews of Las Vegas shows. It also included, at the bottom of the page, links to other categories of goods, services, and information.

By May 18, 2006, however (based on a dated printout provided by the Complainant), the Domain Name resolved to a website headed with the notice, “This is a free Starter Web Page courtesy of GoDaddy.com.” In large letters, the web page announced that “This Domain is Available Now!! www.PLAYBOYCLUBLASVEGAS.COM.” The text on the page included the following:

“the Best Domain Name of 2005.”

“2005 is the 100th birthday of Las Vegas and the Rebirth of Legend. Playboy Club Las Vegas returns to bring Style, Stars and Sophistication back to ‘SIN CITY’.”

“This domain name is the perfect complement for Travel & Ticket Sales, Hotel Reservations, Trips and Flights, Dining & Shows. . . .and ANYTHING LAS VEGAS has to offer.”

“With the return of the Playboy club a new chapter of Las Vegas begins, the return to ‘Sin City’ where Style, Sophistication and Excitement were King. When a ‘Night on the Town’ was truly an experience to remember. Now we can relive those days and nights only better, with everything a truly modern resort can deliver.”

“The possibilities of this multi-million dollar domain name is truly limitless..”

“this valuable domain name, www.PLAYBOYCLUBLasVegas.com, is reasonably offered at \$1,000,000.00 USD. Interesting Partial Trades and/or Joint

Ventures may be considered.”

“For more info or to tender offers email me at SinCityGlassWorks@Cox.Net.”

“Visit us at: <http://sincityglassworks.com>.”

The upper right corner of the page displayed the name “Playboy,” along with four of the Rabbit-head images that are also trademarks registered to the Complainant (e.g., US Registration No. 2,709,639, registered April 22, 2003) and a postal address and telephone number in Las Vegas.

The web page described above, advertising the Domain Name for sale, is no longer displayed. The Domain Name currently resolves to another GoDaddy.com parking page with commercial and informational links under a variety of categories and the notation, “This web page is parked free, courtesy of GoDaddy.com®.”

However, the website at “www.sincityglassworks.com” mentioned in the online advertisement quoted above currently lists the Domain Name for sale. That website advertises a shop that sells “glass adult toys” and other goods, located at the same postal address in Las Vegas that was shown on the web page to which the Domain Name resolved on May 18, 2006. The website also offers “Top Level Domain Names for Sale,” including “www.PlayboyClubLasVegas.com” and “www.PlayboyResortLasVegas.com,” with the following description:

“These domains are some of the hottest Domains available. The Playboy Club and Resort is returning to Las Vegas after a 26 year hiatus. The Playboy Club and Resort will be located in the Palms Casino, one of Las Vegas’s hottest properties, and now you can own a piece of Las Vegas and complement the hottest place in Town.”

“Perfect for Travel, Entertainment. Escort, Gaming or Nightlife, these Domains are sure to be a Winner and profitable to the right person(s) to use them to their potential.”

“Contact us for a Quote.”

On March 27, 2006, the Complainant’s law department sent the Respondent a letter giving notice of trademark infringement and asking her to transfer the Domain Name to the Complainant. The letter was sent to the email address given for the Respondent as the registered administrative and technical contact, and a paper copy was also sent by courier to the Respondent’s postal address in Las Vegas, as given in the Domain Name registration. The email version of the letter produced an error message (as indicated in the copy provided by the Complainant) reporting that “[t]he message could not be delivered because the recipient’s mailbox is full.” The Complainant also provided a copy of the courier’s notice that the paper version of the letter was returned with the notation “Recipient moved and left no forwarding address or phone number.”

A few days later, the Complainant filed the Complaint with the Center and initiated this proceeding under the Policy. The Center’s June 4, 2006 notice sent to the Respondent’s registered contact email address generated a message indicating “permanent fatal errors . . . mailbox unavailable,” as did subsequent emails from the Center to that address, which produced the additional error message “user unknown.” In addition, the Center addressed notices to “postmaster@playboyclublasvegas.com.” and received the message, “permanent fatal errors . . . relaying denied from your location . . . user unknown.” The Center’s courier package sent to the Las Vegas address under which the Respondent registered the Domain Name also failed to

produce a reply.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its famous PLAYBOY and PLAYBOY CLUB marks, incorporating them in their entirety and adding only the place name "Las Vegas." The Complainant sees no evidence that the Respondent has rights or legitimate interests in those marks, is known by them, has used them in making a *bona fide* offering of goods or services, or has made any noncommercial or fair use of the marks.

The Complainant infers bad-faith registration and use of the marks on four grounds:

1. The Respondent has attempted to sell the Domain Name for a sum in excess of her out-of-pocket registration costs (Policy, para. 4(b)(iv)).
2. The marks are so strong that there is no plausible reason for the Respondent to have registered the Domain Name other than in opportunistic bad faith.
3. The Respondent's use of the Domain Name to divert Internet users to a website advertising competing goods and services represents bad faith under the Policy, paras. 4(b)(iii) and (iv).
4. The Respondent demonstrates bad faith by providing false or inaccurate contact information.

B. Respondent

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

6. Discussion and Findings

Under Paragraph 15(a) of the Rules,

"A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the Domain Name, the Complainant must demonstrate each of the following:

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

As in other cases where a respondent fails to reply, the Panel must still satisfy itself that

the Complainant has met its overall burden of proof under paragraph 4 of the Policy. Thus, the uncontested facts supported by plausible evidence such as documents and statements must provide a sufficient *prima facie* basis for finding confusing similarity with the Complainant's mark and then for inferring that, more probably than not, the Respondent has no right or legitimate interest in the Domain Name and has registered and used it in bad faith. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455.

A. Identical or Confusingly Similar

The Complainant indisputably holds United States trademark registrations for PLAYBOY and for PLAYBOY combined with other relevant words, as well as identical or similar trademark registrations in other countries. It is uncontested that the PLAYBOY mark is famous and well-established, as acknowledged in numerous judicial and UDRP decisions. See, e.g., *Playboy Enterprises, Inc. v. Chuckleberry Publications, Inc.*, 687 F.2d 563, 566-67 (2d Cir. 1982); *Playboy Enterprises, Inc. v. Baccarat Clothing Co.*, 692 F.2d 1272, 1274 (9th Cir. 1982); *Playboy Enterprises International, Inc. v. Luis Sastre*, WIPO Case No. D2005-0332 (ordering transfer of <playboy-movies.com>).

The Panel does not agree with the Complainant that this proceeding can also be grounded on a PLAYBOY CLUB mark. The Complainant presented no evidence of such a mark. A US registered mark formerly held by Playboy Enterprises, Inc., THE PLAYBOY CLUB, has been cancelled. The Complainant's new application to register THE PLAYBOY CLUB as a US mark has been pending since 2003, with no indication of first use in commerce or other evidence of common-law rights in the mark.

The Panel does, however, find that the Domain Name is confusingly similar to the PLAYBOY mark. The mark is incorporated in its entirety, followed by the relevant descriptive word "club" and the geographic name "Las Vegas." The Playboy group has indeed operated "clubs" in the past and has recently announced its plans to do so again – specifically, in Las Vegas. The addition of a place name generally does not alter the likelihood of confusion with the mark to which it is added (See *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. D2000-0713). In this case, the place name actually heightens the likelihood of confusion, given the publicity over the construction of a Playboy-themed club in Las Vegas.

Thus, there is a strong likelihood of confusion in combining these particular words with the PLAYBOY mark to form a Domain Name. See *Yellow Corporation v. MIC*, WIPO Case No. D2003-0748 ("when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity"). See also *Six Continents Hotels, Inc. v. Sdf fdgg*, WIPO Case No. D2004-0384.

Here, as in earlier UDRP proceedings involving the PLAYBOY mark, the "disputed domain name incorporates the whole of the Complainant's trademark PLAYBOY, together with [a] descriptive [phrase]... associated with the Complainant and its renowned activities." *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745; see also *Playboy Enterprises International, Inc v. Federico Concas*, WIPO Case No. D2002-0074.

The Panel concludes, therefore, that the Domain Name is confusingly similar to the Complainant's PLAYBOY mark.

B. Rights or Legitimate Interests

There is no indication that the Respondent was ever authorized by the Complainant to use the PLAYBOY mark, and the Complainant's March 27, 2006 cease-and-desist letter suggests quite the contrary. The content of the web pages to which the Domain Name has resolved over time do not indicate that the Respondent or her business were ever known by the name "Playboy" (see Policy, para. 4(c)(ii)). There is no evidence of any noncommercial or fair use of the mark by the Respondent (see Policy, para. 4(c)(iii)). The Respondent appears merely to have "parked" the Domain Name before May 2006 and again more recently. For some time after the middle of May 2006, the Respondent advertised the Domain Name itself for sale on a web page to which the Domain Name resolved, and it appears that the Respondent continues to offer the Domain Name for sale on another website mentioned in that advertisement. These do not constitute the use of the Domain Name in connection with a *bona fide* offering of goods or services within the meaning of Policy, para. 4(c)(i)).

The Panel endorses the reasoning of the UDRP panel in *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455:

"Once a complainant has made a *prima facie* case, a panel may infer from a respondent's failure to contest a complainant's allegations that the respondent has no rights or legitimate interests in the domain name at issue.

Since it is difficult to prove a negative (i.e. that Respondent lacks any rights or legitimate interests in the mark) – especially where the Respondent, rather than the Complainant, would be best placed to have specific knowledge of such rights or interests – and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light (See e.g.: *De Agostini S.p.A. v. Marco Cialone*, WIPO Case No. DTV2002-0005 <deagostini.tv>). Hence, Complainant must make at least a *prima facie* showing that Respondent has no rights or legitimate interests in the mark. After Complainant has met its initial burden of proof, if Respondent fails to submit a response Complainant will be deemed to have satisfied Paragraph 4 (a) ii of the Policy."

The Panel concludes that the Complainant has made a *prima facie* case under the second element of its Complaint and that the Respondent has failed to come forward with any countervailing evidence of rights or legitimate interests to the Domain Name; nor are any such rights or interests apparent in the record. Thus, the Panel finds that the Complainant has established the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), sets forth a non-exhaustive list of circumstances indicating bad faith. The Complainant cites three of these:

- "(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 . . .
- (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 finds persuasive evidence that the Respondent registered and held the Domain Name for the purpose of reselling it at a profit, based on the advertisements for the Domain Name formerly found at "www.playboyclublasvegas.com" and currently displayed in the "Top Level Domain Names for Sale" portion of the "www.sincityglassware.com" website. The original \$1 million asking price for the Domain Name certainly exceeds the Respondent's out-of-pocket costs for the registration.

Evidence of an intent to entice the Complainant or a competitor to purchase the Domain Name at a price in excess of the Respondent's out-of-pocket costs would implicate Policy, paragraph 4(b)(i), as claimed by the Complainant. That is not clear in this case, however, since there is no evidence that the Respondent approached the Complainant or one of its competitors; rather, the Respondent offered the Domain Name for sale to the general public.

In any event, there is ample evidence of the Respondent's intention to confuse and divert Internet users for commercial gain (Policy, para. 4(b)(iv)). The PLAYBOY mark is famous, and the Respondent's advertising to sell the Domain Name expressly refers to the announced "return of the Playboy club" to Las Vegas. The Respondent's May 2006 advertisement used the PLAYBOY mark elsewhere on the web page, as well as the Complainant's registered RABBIT HEAD design mark. Indeed, the Respondent registered the Domain Name just three weeks after the Complainant publicly announced its plans for a "Playboy-themed" nightclub and casino venture in Las Vegas. Clearly, the Respondent, who registered the Domain Name with a Las Vegas address and referred to the planned Las Vegas "Playboy Club" in advertising the Domain Name, was aware of the Complainant's famous marks and its announced plans to use them in connection with the Las Vegas venture. The Respondent's advertisement touted the resulting "multi-million dollar" value of a Domain Name with the potential to drive visitors to a website having to do with "ANYTHING LAS VEGAS."

The Domain Name is still being offered for sale on the "www.sincityglassworks.com" website, with the suggestion that the Respondent would also consider a "joint venture" rather than a sale – presumably a venture in which the Respondent would participate in the profits generated by attracting Internet users to a website with the Domain Name. Thus, it is reasonable to conclude that the Respondent harbors the intent of profiting either from selling the Domain Name or participating in its exploitation for a commercial website.

It is likely, in addition, that the Respondent has received "click-through fees for diverting Internet users to competing websites" while parking the Domain Name on a web page filled with commercial advertising links, and this has also been held to constitute commercial gain for purposes of Policy, para. 4(b)(iv). See, e.g., *Disney Enterprises, Inv. v. PX Publishing Ltd.*, Case No. FA0506000506604 (NAF August 18, 2005).

The instances of bad faith listed in Policy, paragraph 4(b) are expressly without limitation. The Panel agrees with the Complainant that the Respondent's registration of

a Domain Name incorporating a very famous mark of which she was clearly aware, without any evident right to do so, can itself be taken as evidence of bad faith. See, e.g., *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745. It is hard to imagine a good-faith reason for the Respondent's registration of the Domain Name incorporating the famous PLAYBOY mark and the suspiciously timely reference to a "club" in "Las Vegas," nor for her subsequent attempt to sell the Domain Name for \$1 million. The Respondent's failure to maintain current contact information with the Registrar also suggests an effort to avoid accountability for misusing a famous trademark, supporting the inference of bad faith.

In sum, the Panel finds substantial and uncontested evidence of bad faith in the registration and use of the Domain Name, satisfying the third element of a Complaint under 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 <playboyclublasvegas.com> be transferred to the Complainant.

W. Scott Blackmer
Presiding Panelist

Peter L. Michaelson
Panelist

Paul E. Mason
Panelist

Dated: August 3, 2006