



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Asia Sun

Case No. D2005-0767

1. The Parties

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

The Respondent is Asia Sun, Taiwan, Province of China.

2. The Domain Name and Registrar

The disputed domain name <playboymobile.com> is registered with Go Daddy Software.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2005. On July 20, 2005, the Center transmitted by email to Go Daddy Software a request for registrar verification in connection with the domain name at issue. On July 20, 2005, Go Daddy Software 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 contact. 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 July 22, 2005.

On July 26, 2005, the Complainant filed a supplemental submission with the Center, the receipt of which was acknowledged on July 27, 2005. The Panel considered the supplemental submission. The Policy and Rules make no provision for unsolicited

supplemental submissions. However, it is a general principle that a panel may consider a supplemental submission if it raises facts that the Complainant could not have been expected to raise in the Complaint. See *Société pour l'œuvre et la mémoire d'Antoine de Saint Exupéry- Succession Saint Exupéry - D'Agay v. The Holding Company*, WIPO Case No. D2005-0165. The supplemental submission provides evidence of a communication from the Respondent, received by the Complainant after the date of submission of the Complaint. It is clearly a fact that the Complainant could not have included in the Complaint, and so may properly be considered by the Panel.

In accordance with the Rules, paragraph 5(a), the due date for the Response was August 11, 2005. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 12, 2005.

The Center appointed James A. Barker, Peter L. Michaelson and Hong Xue as panelists in this matter on August 26, 2005. 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 following uncontested facts are summarised from the Complaint.

The Complainant is a brand-driven, international multimedia entertainment company, perhaps best known as the publisher of "Playboy" magazine, the world's best-selling men's magazine. In addition, the Complainant operates "Playboy" television and cable networks worldwide; distributes programming via home video, DVD, and wireless networks worldwide; licenses its world-famous Playboy trademarks internationally for a wide range of consumer products; and operates several leading men's lifestyle and entertainment websites, including a website at the domain names <playboy.com> and <playboytv.com>.

The Complainant owns numerous trademark registrations for the PLAYBOY mark in the United States and worldwide. Playboy first obtained a United States Trademark Registration for the mark PLAYBOY in 1954, and has acquired numerous additional registrations for that mark.

The Complainant holds extensive trademark rights in the PLAYBOY mark outside of the United States. The Complainant holds over 1,716 registrations for the PLAYBOY mark in 163 countries.

The Playboy brand, as numerous authorities have held "is one of the most recognised in the world" (*Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745 (ordering transfer of <playboy-photographer.com>)). See also, *Playboy Enterprises International, Inc. v. Baccarat Clothing Co., Inc.*, 692 F.2d 1272, 1274 (9th Cir. 1982) (finding "PLAYBOY and RABBIT HEAD design trademarks are strong and distinctive and have acquired great fame"); *Playboy Enterprises International, Inc. v. Chucklebery Pub., Inc.*, 687 F.2d 563, 566-67 (2d Cir. 1982) (upholding the "district court's finding that the 'PLAYBOY' mark was distinctive and enjoyed wide recognition" as indisputable and finding PLAYBOY is a mark of great value, due in large part to the long standing success of "Playboy" magazine).

The Complainant has an established practice of developing and marketing content for emerging media forms and genres and of creating and using trademarks comprised of PLAYBOY and terms indicative of such media, including PLAYBOY RADIO, PLAYBOY TV, PLAYBOY TV NETWORKS, PLAYBOY TV ONLINE, PLAYBOY NET, and PLAYBOY STORE.

In 2003, the Complainant began offering wireless or mobile phone content, including still images, games and videos, in 18 countries in Europe and Asia. On March 11, 2004, the Complainant announced plans to significantly expand the licensing of both its print and video content for use on mobile platforms.

The disputed domain name was registered on March 31, 2004.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The disputed domain name is confusingly similar to the Complainant's PLAYBOY trademark. The addition of a common or descriptive word such as "Internet; mobile; network" or "web" to a well-known trademark does nothing "to reduce the confusing similarity present in... [the] domain names." (*Telstra Corporation Limited v. Ozurls*, WIPO Case No. D2001-0046 (finding domain names including <telstramobiles.com> and <telstradigital.com> confusingly similar to the TELSTRA mark and ordering transfer)). This principle has been specifically found to apply to the Complainant's PLAYBOY mark in circumstances that are identical to the present circumstances. See *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745 (holding <playboy-photographer.com> "is confusingly similar to the Complainant's registered trademark PLAYBOY, being a combination of the well-known trademark PLAYBOY with a generic term which makes explicit reference to... a field of activity (photography) in which the Complainant has gained renown").

The Complainant has an established pattern and practice, moreover, of branding its entertainment services with trademarks comprised of PLAYBOY and terms descriptive of the genre in which the Complainant's content is delivered. The Complainant's subscribers are familiar with that practice and will assume that the disputed domain name is affiliated with the Complainant.

Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not known by that name and has never made any *bona fide* use of the domain name. The Respondent registered the disputed domain name in order to sell it for \$28,000 and, in the meantime, directed Internet users to websites unrelated to the Complainant.

The Respondent, Asia Sun, appears to be the alter ego of Mr. Liang-Jun Ma. Asia Sun is not a corporate or other entity authorised to do business by any governmental body in Taiwan, where it is located according to the WhoIs information provided by the Respondent.

There is no evidence that either Asia Sun or Mr. Liang-Jun Ma is, or ever has been, known by the disputed domain name. The Respondent has no connection or affiliation with the Complainant and has not been licensed or authorized to register <playboymobile.com> or to make any use of the Complainant's PLAYBOY mark.

The Respondent has never made a *bona fide*, legitimate non-commercial fair use of the disputed domain name or any use in connection with a *bona fide* offering of goods or services. The Respondent uses the disputed domain name to host a webpage displaying sponsored links to third-party websites and displaying an offer to sell the disputed domain name for a minimum of \$28,000, including a window in which prospective purchasers are invited to type in and submit purchase offers.

The sponsored links on the website to which the disputed domain name reverts, offer goods and services of the Complainant's competitors. The Respondent receives so called "click-through" referral fees or commissions from the operators of such websites when visitors access the websites through the disputed domain name. Essentially, the Respondent uses the Complainant's trademarks to divert or lure Internet users to the disputed domain name, and then directs their business elsewhere.

Registered and Used in Bad Faith

The Respondent has registered and used the disputed domain name in bad faith, within the meaning of paragraphs 4(b)(i) and (iv) of the Policy.

The Respondent has also engaged in a pattern of bad faith conduct contrary to paragraph 4(b)(ii) of the Policy, demonstrated by the fact that the Respondent has registered numerous domain names, including <warnermobile.com>, <cokemobile.com> and <pepsimobile.com>, incorporating the famous trademarks of others and offered these domain names for sale. The Respondent clearly registered the disputed domain name to take advantage of the fact that some Internet users will attempt to reach the Complainant by combining PLAYBOY with the word "mobile". The disputed domain name was registered well after the first use of the Complainant's mark, and after the Complainant publicly announced plans to significantly expand its mobile offerings worldwide.

The Respondent registered the disputed domain name to prevent the Complainant from reflecting its mark in a corresponding domain name, contrary to paragraph 4(b)(ii) of the Policy.

The Respondent's bad faith is also demonstrated by the fact that the Respondent provided false contact information in registering the disputed domain name. The Complainant's Taiwanese counsel conducted an investigation of the Respondent's address (as given in the WhoIs details for the disputed domain name) revealing that the address the Respondent provided is for an unoccupied building and that the phone number is invented and found in the lyrics of a song sung by a Hong Kong-based singer.

B. Respondent

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

The only evidence of a communication from the Respondent is an email sent to the Complainant on July 24, 2005, after notification of the Complaint (evidenced in the Complainant's supplemental submission). The Respondent's complete reply, obviously

with reference to the disputed domain name, stated “can have it @US\$60,000?”.

6. Discussion and Findings

Under the Policy, paragraphs 4(a)(i)-(iii), for the Complainant to succeed and have the disputed domain name transferred to it, the Complainant must prove that:

- the 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 domain name was registered and is being used in bad faith.

Paragraph 4(a) of the Policy provides that the Complainant must prove all of these three elements, which are discussed as follows.

A. Identical or Confusingly Similar

The Complainant provided substantial evidence of its rights in the trademark PLAYBOY. The Complainant’s rights in its PLAYBOY mark have previously been recognised in numerous decisions under the Policy. Although the Complaint refers to only one such case (*Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745) there have been many others. It is notable that in all decided cases, the decision was made in the Complainant’s favour. See, for example, *Playboy Enterprises International, Inc. v. Luis Sastre*, WIPO Case No. D2005-0332 (transferring the domain name <playboy-movies.com>); *Playboy Enterprises International, Inc. v. Domain Active Pty Limited*, WIPO Case No. D2002-1156 (in which 74 domain names incorporating the Complainant’s mark were ordered to be transferred to the Complainant). The Complainant is obviously an attractive target for cybersquatters.

Accordingly, and consistently with prior decisions relating to the Complainant’s mark, the Panel finds that the Complainant has rights in the PLAYBOY mark. Evidence of trademark registration is *prima facie* evidence of rights or legitimate interests in the mark. The Respondent has not submitted any evidence to the contrary.

The Complainant also asserts common law rights in its mark. The Complainant’s continuous use of its mark since 1954, would very likely vest in it such rights. But the substantial evidence of the Complainant’s registered rights, and the absence of any contrary contention by the Respondent, makes it unnecessary for the Panel to make a finding in this respect.

It is well-established that the gTLD extension “.com” is to be disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a mark. Leaving the “.com” extension aside, the disputed domain name incorporates the Complainant’s mark entirely and subsequently adds the word “mobile”.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark. The addition of the common word “mobile” does not avoid that confusion. Panels have usually found domains names which combine a trademark with common words to be confusingly similar to the mark. See, for example, *Aventis*

Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti, WIPO Case No. D2005-0037. Panels have also found that the addition of a common word to a trade mark is only a “neutral” addition that does not avoid confusing similarity with the mark. See *Nokia Corporation v. Nokiagirls.com a.k.a IBCC*, WIPO Case No. D2000-0102; *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745 (which involved the same mark as in this case).

The dominant impression of the disputed domain name arises from the Complainant’s mark - a mark which is distinctive and famous. For this reason, confusion may be created because an Internet user may mistakenly believe that the Complainant authorises or has some control over the Respondent’s use of the mark because the Complainant’s mark is entirely incorporated in the disputed domain name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out matters by which the Respondent may demonstrate that it has rights or legitimate interests in a domain name. Panels have consistently found that the burden is on the Respondent to provide evidence of its rights or legitimate interests under paragraph 4(c). See, for example *Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor Chandler International Limited*, WIPO Case No. D2004-0753. That burden arises once the Complainant establishes a *prima facie* case against the Respondent, which the Complainant has done in this case by its argument and evidence.

The Respondent filed no response or any other communication in connection with this case, other than its email of July 24, 2005, to the Complainant. There is no evidence to show that the Respondent has any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that there is evidence of bad faith in the following relevant circumstances:

Paragraph 4(b)(i)

Paragraph 4(b)(i) of the Policy provides that there is evidence of bad faith in circumstances indicating that the Respondent registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, for valuable consideration in excess of the Respondent’s out-of-pocket costs directly related to the domain name.

The Respondent has manifestly evidenced bad faith in the circumstances described in paragraph 4(b)(i). The disputed domain name reverts to a website that advertises it for sale, with a “Minimum Offer” of \$10,000, and an “Asking Price” of \$28,000. In response to the notification of the Complaint, the Respondent also offered to sell the domain name to the Complainant for US\$60,000. All of those amounts are clearly in excess of the Respondent’s out-of-pocket costs.

Paragraph 4(b)(iv)

The Panel's finding in relation to paragraph 4(b)(i) makes it strictly unnecessary to go further. But, for completeness, the Panel notes that the evidence also demonstrates that the Respondent has registered and used the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy.

Paragraph 4(b)(iv) provides (in part) that there is evidence of bad faith registration and use where, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The Respondent was no doubt aware of the Complainant's mark when it registered the disputed domain name. The Complainant's mark is well-known and has been the previous subject of numerous panel decisions in the Complainant's favour. Moreover, the website to which the disputed domain name refers links to products and services that compete with those of the Complainant. It would be an unlikely coincidence for such links to be included on that website without the Respondent being aware of the Complainant and its mark. It is also apparent that the Respondent has sought to attract Internet users for commercial gain, since goods and services competing with those of the Complainant are offered via the disputed domain name. Accordingly, the Panel also finds that the Respondent intentionally attempted to attract Internet users by using the disputed domain name and so has demonstrated bad faith under paragraph 4(b)(iv) of the Policy.

Other evidence of bad faith

There is other evidence of bad faith in this case. For example, the furnishing by the Respondent of false contact details goes to a finding of bad faith. Such a finding was made in circumstances similar to this case. See *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a. John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745.

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 <playboymobile.com> be transferred to the Complainant.

James A. Barker
Presiding Panelist

Peter L. Michaelson
Panelist

Hong Xue
Panelist

Dated: September 6, 2005