



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International Inc. v. Luciano Borri**

**Case No. D2001-0866**

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

Complainant: Playboy Enterprises International Inc. (PEI) of 680 North Lake Shore Drive, Chicago, Illinois 60611, USA.

Respondent: Luciano Borri of Viale Cadorna 11, Busto Arsizio, Varese 21052, Italy.

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

Domain Names: <playboynews.net>; <playboynews.org>; <playboystory.com>;  
<playboystory.net>; <playboystory.org>

Registrar: Domain Bank Inc.

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

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at [“http://www.icann.org/services/udrp/udrp-policy-24oct99.htm”](http://www.icann.org/services/udrp/udrp-policy-24oct99.htm), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (“Supplemental Rules”).

The Complaint was filed on July 9, 2001. WIPO verified that the Complaint satisfies the Rules and the Supplemental Rules and that payment was properly made. The Panel is satisfied this is the case.

The Complaint was properly notified in accordance with Rules, paragraph 2(a) and no Response was filed by the Respondent. Hence, the Respondent is in default.

The Complainant elected to have the dispute decided by a three member Administrative Panel. On August 23, 2001, the Panel comprising Andrea Mondini and Peter Michaelson, Panelists and Dawn Osborne, Presiding Panelist was duly appointed in accordance with Rule 6(e) and the due date for the Panel's decision was set as September 6, 2001. Due to papers inadvertently not reaching Mr. Michaelson being on travel, the date for the decision was extended to be reset as September 13, 2001.

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

The Complainant is the owner of the trademark PLAYBOY and owns registrations for this mark in many countries worldwide including Italy.

The Respondent is the Managing Director of an Italian company called Gruppo Euromedia which has registered over 300 domain names (many of which containing third party trade marks) in the Italian national country code top level domain “.it”. The Complainant has been involved with Gruppo Euromedia in a domain name dispute resolution procedure in Italy concerning several domain name registrations in the “.it” domain all of which contained the famous PLAYBOY mark and obtained an arbitration order requiring transfer of all these names to the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

###### ***PEI's World-Famous PLAYBOY Mark***

The Complainant, PEI, owns rights in and to the internationally famous trademark PLAYBOY. The mark is registered in many countries of the world, including Italy. The mark has been registered in Italy since June 12, 1963, under registration no. 188866. PEI first used the mark PLAYBOY in 1953, and obtained registration in the United States in 1954. The PLAYBOY mark has been registered in a variety of classes including, but not limited to, computer services such as on-line information and entertainment services, monthly magazines, television services, pre-recorded videotapes, pre-recorded CD-ROMs and gaming-related goods such as playing cards.

The renown and fame of the PLAYBOY trademark have been the result of more than forty-six years of successful business activity, originally based upon the creation of Playboy magazine, founded by Hugh M. Hefner in 1953. The magazine quickly became an icon and pioneer of contemporary culture, one of the most successful periodicals ever printed, and an example imitated by countless other magazines and publications. Playboy magazine is the best-selling men's monthly magazine in the world. Worldwide monthly circulation, which includes 16 international editions, is more than 4.7 million copies.

The Italian edition of Playboy magazine has been published without interruption for 28 years. Other national editions are currently published in Brazil, Croatia, the Czech Republic, France, Germany, Greece, Hungary, Japan, the Netherlands,

Poland, Romania, Russia, Slovakia, Spain and Taiwan. The combined average circulation of the international editions is approximately 2 million copies monthly.

Playboy magazine features fiction and non-fiction novellas and short stories. Playboy magazine has included award winning fiction and non-fiction works by such authors as Stephen King, Ernest Hemmingway, John Steinbeck, Kurt Vonnegut, Jr., Shel Silverstein, Mickey Spillane and more. Many of these famous authors have written original stories for PEI to publish and several literary awards have been given for stories published in Playboy. Playboy magazine also has such regular features as The Playboy Advisor and The Playboy Forum. Playboy magazine also features news, such as the latest movie, record and book reviews, news of the events at the Playboy Mansion, and other current events. PEI also, when issuing a press release to the Associated Press and other media news sources, titles their information "PLAYBOY NEWS." Another feature of Playboy magazine is the Playboy Interview. This section has featured interviews with such newsworthy individuals as Jimmy Carter, Yasir Arafat, Fidel Castro, Luciano Pavarotti, Federico Fellini, Muhammad Ali, and Martin Luther King, amongst others.

Following the continuing success of Playboy magazine, PEI expanded its business activities. PEI is a brand-driven, international multimedia entertainment company and its expansion into other media has been highly successful. In particular, PEI's Entertainment Group operations include the production and marketing of programming through domestic TV networks, international TV and worldwide home video.

In connection with its PLAYBOY marks, PEI has established Internet web sites, including those located at <playboy.com>, <playboytv.com>, <playboynews.com>, PLAYBOY CYBER CLUB, PLAYBOY STORE and PLAYBOY AUCTIONS, amongst others (the "PEI Web sites"). The PEI Web sites allow computer users throughout the U.S. and the world to access information regarding PEI and its products and services. The PEI sites provide users with a variety of news ranging from reviews of recent books and movies to news of PEI sponsored events and happenings, as well as commentary on current events. The PEI Web sites also allow users to access archives of excerpts from the fiction and non-fiction stories appearing in Playboy magazine, as well as excerpts from the archived interviews, images and original articles.

PEI has spent substantial time, effort and money advertising and promoting its trademarks throughout the United States, Europe and the world. As a result, the PLAYBOY mark has become internationally famous and PEI has developed an enormous amount of goodwill in its PLAYBOY marks. In fact, the distinctiveness, strength and fame of the PLAYBOY mark has been acknowledged by a number of courts, including courts in the U.S. and in Italy. *See, e.g., Playboy Enters., Inc. v. Baccarat Clothing Co, Inc.*, 692 F.2d 1272 (9<sup>th</sup> Cir. 1982), (PLAYBOY trademark is distinctive, strong and has acquired great fame); and *Playboy Enters., Inc. v. AsiaFocus Int'l, Inc.*, 1998, WL 724000 (E.D.Va. April 10, 1998), (noting that fame of PLAYBOY mark is beyond dispute). Also, *see Playboy v. Giannattasio*, (Court of Naples, January 14, 1999, *Giurisprudenza Annotata di Diritto Industriale*, Giuffrè, 1040, 1999): "*The trademark PLAYBOY for its certain renown at worldwide level, is entitled to complete, full and total protection...*" *See also*, (Board of Appeal of Naples,

March 24, 1999, *id.*) “*the PLAYBOY trademark...belonging to the category of the so-called strong trademarks, is precisely in the name PLAYBOY, name which for its remarkable distinctiveness impresses itself with particular strength in the perception of the consumer. And this is the more so since such name has become exceptionally renown....*” .

Finally, the “exceptional renown” of PLAYBOY in Italy is further shown by a simple search in Italian media. For instance, the largest national Italian newspaper, *Il Corriere della Sera*, published three stories relating to PLAYBOY in the month of May 2001, two of which concerned the opening in Milan (by the way the same city where Respondent lives) of the new PLAYBOY “In Store Boutique” created in collaboration with internationally acclaimed stylist Fiorucci.

### ***Respondent’s Registration and Use of the Infringing Domain Names***

PEI discovered the Domain Names and the Respondent’s activities while working on a matter closely related to the case at issue. On April 14, 2000, an Italian company, Gruppo Euromedia s.r.l., had registered several domain names under the cc TLD “.it”, that included the famous PLAYBOY trademark, namely <playboytv.it>, <playboytelevision.it>, <playboyonline.it> and <playboyweb.it>. PEI’s counsel contacted Gruppo Euromedia on August 7, 2000. PEI’s correspondence to Gruppo Euromedia regarding their unauthorized use of the mark in their domain names was replied to by Mr. Ferrari. Mr. Ferrari is the counsel representing Gruppo Euromedia as well as the Respondent in this matter, Mr. Borri. In his response to PEI, Mr. Ferrari stated that his client’s registration of the domain names was lawful.

After this initial correspondence with Gruppo Euromedia and further investigation by PEI, the Domain Names came to the attention of PEI. The Domain Names were registered on August 29, 2000. PEI noticed the possibility of a connection between the Respondent and Gruppo Euromedia since they shared similar contact information. The Domain Names were registered after PEI’s original notification of its rights in and to their famous PLAYBOY trademark to Gruppo Euromedia. PEI’s counsel wrote to the Respondent, Mr. Borri, on October 27, 2000.

The Domain Names are currently, and as at October 27, 2000, were active and resolved to an “under construction” web page for Gruppo Euromedia.

When PEI’s counsels wrote to the Respondent regarding the Domain Names on October 27, 2000, they received a response from Mr. Ferrari dated November 24, 2000, stating that he had already informed PEI that his client’s registration of the Domain Names was not unlawful and he disputed that PLAYBOY was a famous mark. At this point, PEI’s counsel further investigated the activities of Gruppo Euromedia and the Respondent. It is shown in the records of the Milan Chamber of Commerce that the Respondent in this matter is the legal representative of Gruppo Euromedia, namely the Managing Director. It is also reported in the Milan Chamber of Commerce that Gruppo Euromedia has only five employees. Gruppo Euromedia was also found to have registered over 300 domain names under the ccTLD IT, many that contain famous trademarks of other companies. These names include but are not limited to <blockbusteronline.it>, <blockbustertv.it>, and many well-known Italian marks.

It then came to PEI's attention that Gruppo Euromedia had registered five more ".IT" domain names containing their famous PLAYBOY trademark, having done so after they received PEI's original letter dated August 7, 2001.

On April 26, 2001, PEI and its European affiliate filed a Complaint in Italy with the Arbitration Body Centro Risoluzione Dispute Domini, over the matter of Gruppo Euromedia's registrations of the ccTLD IT domain names. The decision was issued on June 1, 2001. The sole Panelist, Ms. Francesca D'Orsi, Esq., ordered the Italian Registration Authority to transfer the ".it" domain names to PEI. She found that PEI had successfully demonstrated its rights in and to their PLAYBOY mark.

The decision stated that PLAYBOY "*is an internationally reputed trademark...(and) that the domain names are confusingly similar to (PEI'S) trademark.*" Further, the Panelist also found that "*the defendant failed to show that he is any way entitled to the domain names.*" The Panelist concluded that, "*The circumstances set forth by the plaintiff clearly prove the bad faith of the registration and maintenance of the domain names at issue... It thus seems that the registration of such contested domain names is part of a more general strategy of registration of domain names over which Gruppo Euromedia has absolutely no rights. In other words, it would appear that we have before us a typical cybersquatting scheme.*" The Panelist also added, in relation to the Domain Names, "*The fact that the legal representative of this company is the same person who, after the first cease-and-desist letter received by the company represented by this person, proceeded to register playboynews.net, playboynews.org, playboystory.com, playboystory.net, playboystory.org, appears to be no less relevant, as it shows the continuation of the cybersquatting activities.*"

Subsequently, when the Domain Names were checked at this time, it was discovered that <playboynews.net>, <playboynews.org> were now hyperlinked with <globalmotors.it>, while <playboystory.com>, <playboystory.net> and <playboystory.org> were now hyperlinked with <playboystory.it> which had been activated. <globalmotors.it> is a Web site registered to and controlled by Gruppo Euromedia. <playboystory.it> is also currently registered to and controlled by Gruppo Euromedia, though it subsequently has been ordered by the Panelist to be transferred to PEI. This site's creation and the linking of the Domain Names was done after PEI's notification to the Respondent of its rights in and to their famous PLAYBOY trademark.

The Complainant alleges that the linkage appears to be an effort on the Respondent's part to show use of the Domain Names, though there is no evidence of any relevant connection between the Domain Names and the sites to which they link. The <playboystory.it> Web site appears to have only been created as an effort to show use of the name.

### ***Legal Argument and Grounds***

Under these circumstances, it is PEI's belief that the Domain Names are confusingly similar to the PLAYBOY trademark, in which PEI has rights. Further, that the Respondent has no rights or legitimate interests in respect of the Domain Names. Finally, that the Domain Names were registered and are being used in bad faith. Given the Respondent's refusal to turn the Domain Names over

to the trademark owner, PEI decided to take recourse via the present procedure by asserting the following legal arguments and grounds:

- The Domain Names are allegedly confusingly similar with, and make use of, PEI's registered and famous trademark, PLAYBOY. The distinctive term of all the Domain Names is PLAYBOY, given the complete descriptiveness of NEWS and STORY. This should be considered a sufficient condition to establish that between the trademark PLAYBOY and the Domains there is a strong likelihood of confusion which may also include a likelihood of association. PEI features news and stories in their publications as well as on the PEI Web sites. Internet users searching for news on PEI, for stories about or associated with PEI, or for those stories appearing in *Playboy* magazine, will likely be confused by the Respondent's use of the famous PLAYBOY trademark in the Domain Names.
- The Respondent allegedly has no rights or legitimate interests with respect to the Domain Names. The Domain names are neither the legal name of the Respondent, an individual whose name is Luciano Borri. Nor has the Respondent been commonly known by the Domain Names. Further, the Respondent has no right to the Domain Names or any use of the famous PLAYBOY trademark. An on-line search made among Italian as well as International registrations extended to Italy and of Community trademarks, did not disclose the Respondent owning any trademark registrations or applications for the PLAYBOY trademark or any variant thereof. These results show the trademark PLAYBOY to be in the name of PEI and not of the Respondent.
- Respondent's activity on the Internet does not comply with the paragraph 4(c)(i) of the Policy, according to which Respondent may show rights or legitimate interests to the domain name if “*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*” Before any notice of the dispute was communicated, the Domain Names were only used to post a page with an advertisement for Gruppo Euromedia. It was only after the Respondent, (and Gruppo Euromedia) were put on notice by PEI of their rights in and to their famous PLAYBOY trademark that use began. Therefore, Respondent's activity does not constitute a legitimate noncommercial or fair use of the Domain Names and can only lead to customer confusion.
- PEI believes that the aforementioned circumstances indicate that the Domain Names were registered and are being used in bad faith. PEI's trademark PLAYBOY is internationally famous, as well as declared “renown” by the Italian courts. Furthermore, Respondent is the legal representative of a company which operates in the media world, i.e. in the same field where PEI has been active and operating for the last 47 years. Thus, it is quite unbelievable that Respondent was not aware of PEI's activity and of its rights in and to the famous PLAYBOY trademark, and never denied awareness of such rights.

- Further, the Respondent is the legal representative of a company (consisting of five people) that registered <playboytv.it>, <playboytelevision.it>, <playboyonline.it>, <playboyweb.it>, <playboystory.it>, <playboystore.it>, <playboynews.it>, and many more domain names corresponding to famous trademarks. Such activity indicates that the registrations were intentional and shows a pattern of cybersquatting activities, and thus proves bad faith. As also pointed out by the Panelist in the Italian re-assignment procedure: “ The fact that the legal representative of this company is the same person who, after the first cease-and-desist letter received by the company represented by this person, proceeded to register <playboynews.net>, <playboynews.org>, <playboystory.com>, <playboystory.net>, <playboystory.org>, appears to be no less relevant, as it shows the continuation of the cybersquatting activities.”

The following table shows quite graphically the development of the registrations:

GRUPPO EUROMEDIA		LUCIANO BORRI		GRUPPO EUROMEDIA	
Domain name	Date	Domain name	date	Domain name	date
PLAYBOYWEB.IT	14/4/2000				
PLAYBOYTV.IT	14/4/2000				
PLAYBOYTELEVISION.IT	14/4/2000				
PLAYBOYONLINE.IT	14/4/2000				
---PEI'S 1 <sup>st</sup> LETTER ---	8/7/00 ---				
		PLAYBOYNEWS.NET	29/8/2000		
		PLAYBOYNEWS.ORG	29/8/2000		
		PLAYBOYSTORY.COM	29/8/2000		
		PLAYBOYSTORY.NET	29/8/2000		
		PLAYBOYSTORY.ORG	29/8/2000		
				PLAYBOYNEWS.IT	30/8/2000
				PLAYBOYSTORE.IT	30/8/2000
				PLAYBOYSTORY.IT	30/8/2000

Bad faith is allegedly even more apparent when one considers that the registration of the Domain Names took place after the company which the Respondent legally represents, (and thus, under Italian law, he bears the ultimate liability for the company's actions), had been officially made aware of PEI's rights in and to the famous trademark PLAYBOY. PEI believes that such circumstance per se is the strongest evidence of bad faith, and further, the case in hand fits squarely in to Paragraph 4(b) of the Policy.

In light of the foregoing and in light of the fame of PEI's PLAYBOY trademark, Complainant contends that it seems indisputable that it was and is the Respondent's intention to use PEI's mark to attract for commercial gain, Internet users to his Web sites by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of his Web sites (cf. Paragraph 4(b)(iv) of the Policy). Also, through the registration of the Domain Names, the Respondent prevented (and prevents) PEI from reflecting its trademark in the corresponding Domain Names. Further, the number of Domain Names registered

is prima facie evidence that the Respondent has engaged in a pattern of such conduct as stated in Paragraph 4(b)(ii) of the Policy.

Complainant alleges that all circumstances above indicate the existence of bad faith at the time of registration of the Domain Names, as well as in the Respondent's present conduct. The Respondent had early notice of PEI's claims and PEI even offered reimbursement of registration costs along with a waiver of any legal action and claim against Respondent. The Domain Names continue to be used by the Registrant with disregard for PEI's rights.

## **B. Respondent**

The Respondent has not filed a Response and is in default.

## **6. Discussion and Findings**

According to paragraph 4(a) of the Uniform Dispute Resolution Procedure Policy, the Complainant must prove that:

- The Domain Name is identical or confusingly similar to a trade mark 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 has been registered and is being used in bad faith.

### **A. Identical or confusing similarity**

The Domain Names consist of the Complainant's PLAYBOY mark and the words "news" and "story" which are non distinctive in the publishing industry in which the Complainant operates. In a comparable case, a previous panel decision has held that the domain names <playboychannel.com> and <playboynetwork.com> are confusingly similar to the trademark PLAYBOY (*Playboy Enterprises International, Inc. v. Hector Rodriguez*, WIPO Case No. D2000-1016). In the present case, the Domain Names are thus confusingly similar to the Complainant's PLAYBOY registered marks.

### **B. Rights or Legitimate Interest of the Respondent**

The Respondent has not filed a Response and does not appear to have any rights or legitimate interest in the Domain Names.

### **C Bad Faith**

Paragraph 4(b) of the Rules sets out four non exclusive criteria which shall be evidence of the registration and use of a domain name in bad faith as follows:

- the Respondent has registered or has 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 trade mark 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 domain name; or

- the Respondent has registered the domain name in order to prevent the owner of the trade mark 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
- the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its web site or location or of a product or service on its web site or location.

The Respondent was aware of the Complainant's rights in the world famous mark PLAYBOY prior to registration of the Domain Names and the company of which the Respondent is Managing Director has been ordered in domain name dispute resolution proceedings in Italy to reassign domain names registered in the ".it" domain containing the PLAYBOY trade mark back to the Complainant. The panelist in the Italian proceedings made a finding that the Respondent's company was in the business of cybersquatting.

In the absence of a Response from the Respondent, there appears to be no explanation of the facts other than that the Respondent registered the Complainant's trade marks to prevent the Complainant from reflecting its mark in a corresponding domain name and that the Respondent had indulged in a pattern of such conduct. Further, by attaching the Domain Names to web sites with which it is associated the Respondent appears to have intentionally attempted to attract Internet users to its site for commercial gain by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its web sites. Accordingly the Domain Names have been registered and used in bad faith.

## **7. Decision**

In the light of the foregoing, the panel decides that the Domain Names are confusingly similar to the Complainant's trade mark and the Respondent has no rights or legitimate interests relating to the Domain Names which were registered and used in bad faith.

Accordingly, in the light of the above, the Panel orders that the Domain Names, specifically <playboynews.net>, <playboynews.org>, <playboystory.com>, <playboystory.net> and <playboystory.org> BE TRANSFERRED to the Complainant.

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Dawn Osborne  
Presiding Panelist

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Andrea Mondini  
Panelist

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Peter Michaelson  
Panelist

Dated: September 15, 2001