WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa

Case No. D2001-0745

1. The Parties

The Complainant is Playboy Enterprises International, Inc., of 680 North Lake Shore Drive, Chicago, Illinois 60611, United States of America, represented by Ms. Angelica Lodgiani, of Societa Italiana Brevetti, Rome, Italy.

The Respondent is Federico Concas, whose address as registrant of the disputed domain name appears in the Registrar's records as Via del Bosco, Pellezzano, Salerno 84080, Italy.

2. The Domain Names and Registrar

This dispute concerns the domain name <playboy-photographer.com>.

The Registrar is Network Solutions, Inc., of Herndon, Virginia, United States of America.

3. Procedural History

This is an administrative proceeding pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999, ("the Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("the Supplemental Rules") of the WIPO Arbitration and Mediation Center ("the Center").

The Complaint was received by the Center by email on June 5, 2001 and in hardcopy on June 7, 2001. The Complaint was acknowledged on June 7, 2001. Next day registration details were sought from the Registrar. On June 11, 2001, the Registrar confirmed that the disputed domain name is registered in the name of the Respondent at the address mentioned above and that the Registrar's 5 Service Agreement (which incorporates the Policy) is in effect. On June 12, 2001, the Center satisfied itself that

the Complainant had complied with all formal requirements, including payment of the prescribed fee and formally dispatched copies of the Complaint by post/courier (with enclosures) to the Respondent at his address as recorded with the Registrar and by email (without attachments) to the three email addresses of and associated with the Respondent as recorded with the Registrar. The Center also included with the material dispatched to the Respondent a letter dated June 12, 2001 containing notification of the commencement of this administrative proceeding and sent copies to the Complainant, the Registrar and ICANN.

The last day specified by the Center for a Response was July 1, 2001. No Response was filed within the time specified by the Rules. On July 3, 2001, the Center gave formal notice of the Respondent's default. On July 7, 2001 the Respondent filed an informal Response in Italian and, on July 15, 2001, declined a request by the Center for a translation into English.

On June 7, July 2 and July 12, 2001 the Complainant's representative notified the Center of communications concerning the Complaint received from the Respondent, from Mr. Franco Concas (the Respondent's father) and from a Mr. "John Smith a.k.a. Orf3vs" following the filing of the Complaint.

On July 16, 2001, by virtue of the Complainant having sought the appointment of a three-member panel, the Center notified the parties of the appointment of the undersigned to serve as panelists, each having submitted a Statement of Acceptance and Declaration of Impartiality and Independence. That day, the Center transmitted the case file to the panel and notified the parties of the projected decision date of July 29, 2001.

The panel is satisfied that the Complaint was filed in accordance with the requirements of the Rules and Supplemental Rules; payment was properly made; the panel agrees with the Center's assessment concerning the Complaint's compliance with the formal requirements; the Center discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint; no Response was filed within the time prescribed by the Rules and the administrative panel was properly constituted.

On July 18, 2001 the Panel by Procedural Order, noting that pursuant to Rule 11 the language of the proceeding was English, requested the Respondent, within five days, to submit an English translation of the informal Response. Pursuant to Rule 10 (c), the Panel extended the time for issuing its decision until August 5, 2001.

On July 20, 2001, the Respondent submitted by email an English translation of the informal Response. The Panel has considered the Response in its English translation.

4. Factual Background

The Complainant and its activities

Playboy magazine, founded by Mr. Hugh Hefner in 1953,is the best-selling men's monthly magazine in the world. Its worldwide monthly circulation, which includes 16 international editions, exceeds 4.7 million copies. It has been published in Italy for 28 years without interruption. The Complainant's business, extending beyond publication of *Playboy* magazine, is that of an international multimedia entertainment company.

The Playboy brand is one of the most recognized in the world. The Complainant's <playboy.com> and other websites incorporating the word PLAYBOY generated over 17 million visits in February 2001. The Complainant has registered the trademark PLAYBOY in many countries, including Italy, where it was first registered in 1963 and has been subsequently renewed.

In 1999 the Court of Naples, Italy, in granting the Complainant injunctive relief against the use of the domain name <playboy.it>, described the PLAYBOY mark as strong and famous, qualifying for protection even against unauthorized use for different goods or services[1]. In affirming the decision, the Board of Appeal described the mark as having remarkable distinctiveness and as being exceptionally renowned[2].

The Respondent and his activities

The disputed domain name was registered on January 4, 2001. It resolves to an active web site offering sexually-oriented photographs of women. On January 22, 2001 the Complainant received an email from a Mr. John Smith purporting to compliment the Complainant on *"your wonderful free website www.playboy-photographer.com*" and asking how to subscribe to the mailing list. The Complainant pointed out that the site was not associated or affiliated with Playboy and asked how Mr. Smith discovered the site. Mr. Smith said a friend of his had found it, the owner, Mr. Federico Concas, the Respondent.

Communications between the Complainant and the Respondent in February and March, 2001 led to an agreement by the Respondent to remove the Complainant's infringing trademarks from his web site but he refused to deactivate that site. The Respondent claimed to have received an offer for US$45,000 for the disputed domain name from an unidentified Japanese company and invited a better offer from the Complainant. The Complainant placed the matter in the hands of its Italian Counsel who, on April 12, 2001, sent a fax addressed to the Respondent, claiming that registration of the disputed domain name violated the Complainant's trademark rights and offering to reimburse the Respondent his costs of registration of the disputed domain name. A copy was also transmitted by email to the email address shown in the records of the Registrar but it was returned as "undeliverable".

Next day, however, Mr Smith, whose first contact with the Complainant is described above, communicated by email to the Complainant's Italian Counsel, saying (amongst other things): *"the more you shake, the more you increase the value of the domain in front of other possible buyers! Make a concrete offer by email. Best regards. OrF3vS"*.

By registered letter dated April 13, 2001, the Respondent's father, Avv. Franco Concas, an attorney at law, wrote to the Complainant's Italian Counsel protesting at the "unlawful" abuse of his (Avv. Franco Concas') fax number for the transmission of the fax of April 12, 2001 from the Complainant's Italian Counsel addressed to the Respondent.

Further emails were received from Mr. Smith. On April 19, 2001 he said:

> "*We are aware that your client Playboy Inc. is available to deal on the economic basis the matter www.playboy-photographer.com.*

---

1 *Playboy Enterprises Inc. v. Mario Giannattasio,* Tribunale di Napoli, January 14, 1999.
2 *Mario Giannattasio v. Playboy Enterprises Inc,.*Tribunale di Napoli, March 24, 1999.

In this regard we communicate that the costs for the registration are not certainly those which determine the value of a web site which amount to 35 $ per year but for the publicity that one makes on the Internet and for the relative management cost! Which amount to several thousands of dollars!

I tell you clearly that we have received conspicuous offers as far as the domain is concerned, thanks also and most for the interest of the company that you represent, but we would like to have an offer also by Playboy, Inc.!

We are available to an agreement and we look forward for a transaction (but only via e-mail)".

On May 15, 2001 Mr. Smith said: "…*I officially announce that the web site is for sale! …I am available to transactions…*".

The copy of the Complaint sent by the Center, with its letter addressed to the Respondent dated June 12, 2001, was in fact received on June 13, 2001 by Avv. Franco Concas, who subsequently sent a lengthy letter to the Complainant's Italian Counsel, saying (amongst other things) that he had accepted the material from WIPO for mere correctness and had acquired knowledge of it with the authority of the rightful owner. Avv. Franco Concas then proceeded to comment on the proceedings, without claiming to be representing the Respondent.

5. Parties' Contentions

A. Complainant

The panel has reviewed the supplementary material provided by the Complainant, being translations of communications from the Respondent, Mr. Smith and Avv. Franco Concas subsequent to the filing of the Complaint.

Identity / confusing similarity

The disputed domain name 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 the a field of activity (photography) in which the Complainant has gained renown.

Legitimacy

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The domain name is neither the legal name of the Respondent, who is known alternatively as Federico Concas, John Smith or Orf3vs, nor has the Respondent been commonly known by the domain name.

The Respondent's use of PLAYBOY-PHOTOGRAPHER as a domain name is an act of infringement of the Complainant's rights under applicable Italian Trademark Law, which thus does not legitimize his abusive registration.

Further, the Respondent does not have any right to the domain name: an on-line search made among Italian as well as International registrations extended to Italy and into Community trademarks, did not disclose the Respondent owning any trademark

registration or application for the Domain. Rather that the trademark PLAYBOY yielded results indicating that this mark solely resided in the name of the Complainant and not of the Respondent.

In light of the undoubted renown of the PLAYBOY mark and of all the Respondent's conduct, the Respondent's activity cannot be considered as use or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services to the public: there was never a bona fide offering of goods or services in the Respondent's conduct, starting from the supply of false personal data to the Registrar with the evident intent to avoid detection and the adoption of applicable remedies. See *Molinari Int'l S.p.A v. Lasambucamolinari.com*, (WIPO Case D 2000-1169): "*the reference to the lack of truthful information about the Respondent's name and address is quite an important element in determining Respondent's bad faith at registration date*".

Bad faith

In light of the renown and recognition of the trademark PLAYBOY in Italy, it seems incredible that the Respondent, who appears to be Italian both because of his stated name and address and because he communicates in Italian, may have registered and used the disputed domain name in the ignorance of the PLAYBOY trademark. On the contrary, in light of the actual use of the web site, the adoption of the disputed domain name shows a malicious awareness and parasitic intent unlawfully to benefit from PLAYBOY's renown.

The malicious awareness is further proved by the Respondent's agreement, when first approached by the Complainant's Italian Counsel, to delete from his website the Complainant's trademarks, thus explicitly recognizing the Complainant's rights.

The sequence of events shows a pattern of conduct plainly inconsistent with a bona fide attitude and which reveals a scheme to receive consideration from the Complainant well in excess of the reasonable costs of registration and maintenance:

- the disputed domain name was registered on January 4, 2001 by a subject who gave as personal data a name and address which were later proven false;

- John Smith's message on January 23, 2001 was designed to give notice of the web-site in an attempt to "bait" the Complainant;

- John Smith's indication of Federico Concas as the owner of the disputed domain name was designed to lead the Complainant into contacting Federico Concas so that he might "pull the bait" by informing the Complainant that the web site would not be deactivated but, on the contrary, would remain operative and that a third party had offered U.S.$45,000 for it;

- the intention to obtain valuable consideration was further shown by the language of Mr. Smith's email of April 19, 2001 rejecting reimbursement of registration costs;

- the letter sent by the Complainant's Italian Counsel to Federico Concas was undeliverable via e-mail, yet John Smith was mysteriously aware that the Complainant's Italian Counsel were dealing with the matter. The only

explanation is that while the e-mail address of Federico Concas is "allegedly" inactive, John Smith must have a method to monitor it while remaining undetected: setting up such a monitoring device is inconsistent with any good faith attitude.

- finally, and aside from the present domain name matter, a search in the Network Solutions Registry shows that Federico Concas appears to be the owner of many domain names including many famous trademarks (in Italy) such as RIZZOLIPERIODICI (Rizzoli being a major Italian publisher) or personal names, such as BASSOLINO, former Mayor of Naples and currently Governor of the Campania Region. However, while the latter two are inactive, the disputed domain name is active and the REGISTRANT HIMSELF actually advised the Complainant of its existence.

Given the great renown of PLAYBOY it seems indeed quite indisputable that the Respondent, by using the domain name, has attempted and is attempting:

- to attract, for commercial gain, Internet users to his web site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site; or

- to create the conditions by which the Complainant would be forced to offer valuable consideration well in excess of the registration costs to acquire the domain name.

In the light of the foregoing, the Respondent's bad faith, both at registration date and subsequently, is established.

B. Respondent

The Respondent, an Italian citizen, says he is the owner “between others” [not identified] of the disputed domain name. He does not accept that he has been formally notified of the Complaint, nor that the title of Respondent is appropriate. The so-called notification from the Center of June 12, 2001 was not sent to his legal residence but to that of his father, Avv. Franco Concas, and was ineffectual.

The Response is not to be taken as acceptance of the regularity or lawfulness of the proceedings nor of the jurisdiction or participation of WIPO, which cannot affect the rights of private subjects that have not accepted its so-called jurisdiction.

In registering the disputed domain name the Respondent accepted the referral of any issues that might arise to ICANN, not to WIPO, which therefore has no right to know of nor power to decide the issue here.

The Complainant’s Italian Counsel engaged in unlawful surveillance activities and disclosed private information in seeking to gain the surrender of the disputed domain name to the Complainant.

The Respondent has not had the opportunity to defend himself, having been approached by someone claiming to be an American lawyer who somehow was aware of this dispute, who attempted to be paid by credit card and who withdrew his offer of support after a week of failing to reply to the Respondent’s messages, saying the Complainant could count on such financial support that it would be bound to win: in these issues who has more money wins!

Any decision taken in these proceedings cannot bind the Respondent.

6. Discussion and Findings

Under paragraph 15(a) of the Rules, the panel must decide this complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Procedural and jurisdictional issues

The Respondent contends that, in registering the disputed domain name, he agreed to the referral of any issues that might arise to ICANN, and that he has not agreed to the jurisdiction of WIPO.

Paragraph 4 of the Policy, which is incorporated into the Registration Agreement between the Respondent and the Registrar, requires the registrant of the domain name to submit to a mandatory administrative proceeding conducted before "one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm". WIPO was approved by ICANN as such a service provider on December 1, 1999.

The panel finds that, by entering into the Registration Agreement with the Registrar, the Respondent agreed to submit to any administrative proceeding, properly constituted in accordance with the Policy and the Rules, before any ICANN-approved service provider, of which WIPO is one.

The formal notification of the Complaint and of the commencement of this administrative proceeding was sent by the Center on June 12, 2001, to the address of the Respondent, according to the information provided by the Respondent to the Registrar when the Respondent registered the disputed domain name. According to the Response, this was not the Respondent's address at all, but that of his father, who in fact received the material next day.

Although the false information provided by the Respondent to the Registrar meant that the Center may not have succeeded in directly informing the Respondent of the Complaint, the Center nevertheless discharged its responsibility to employ reasonably available means calculated to achieve actual notice to the Respondent, by taking the steps that it did under paragraph 2(a) of the Rules.

In this regard, the panel notes that, though the Complainant contends that the fax number to which it transmitted its letter addressed to the Respondent of April 12, 2001 was indicated in the Registrar's Whois database relating to the disputed domain name, there is, so far as the panel can tell, no fax number mentioned in that database (Annexure A to the Complaint) and it was therefore not incumbent upon the Center, in discharging its responsibility under paragraph 2 (a) of the Rules, to transmit a copy of the notice of May 12, 2001 by facsimile.

Substantive issues

To qualify for cancellation or transfer, a Complainant must prove each element of paragraph 4(a) of the Policy, namely:

(i) the disputed 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 respect of the domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Identity or confusing similarity

Essential or virtual identity is sufficient for the purposes of the Policy.[3]

The test of confusing similarity under the Policy, unlike trademark infringement or unfair competition cases, can, though need not always, be confined to a consideration of the disputed domain name and the trademark.[4] Here each disputed domain name incorporates the whole of the Complainant's trademark PLAYBOY, together with the descriptive word PHOTOGRAPHER, a word associated with the Complainant and its renowned activities. The content of the Respondent's website does nothing to dissuade visitors from the misrepresentation conveyed by the disputed domain name that it is associated with the Complainant.

The panel finds the disputed domain name is confusingly similar to the Complainant's trademark PLAYBOY. The Complainant has established this element.

Illegitimacy

The Complainant has not authorized the Respondent to use its trademark nor to register the disputed domain name. The name of the Respondent is not and does not include any part of any of the disputed domain name. The Respondent cannot have been unaware of the renown of the PLAYBOY mark when he registered the disputed domain name.

It is thus apparent that the site has been designed to attract Internet users because of the renown of the PLAYBOY mark. The Respondent is trading off the Complainant's goodwill in so doing.

The panel finds the Complainant has established this element. The Respondent has no rights or legitimate interest in the disputed domain name.

Bad faith registration and use

A finding of bad faith may be made where the Respondent "knew or should have known" of the registration and use of the trademark prior to registering the domain

---

[3] See *The Stanley Works and Stanley Logistics, Inc v. Camp Creek. Co., Inc.* (WIPO Case No. D2000-0113), *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd.* (WIPO Case No. D2000-0802) and *Nokia Corporation v. Nokiagirls.com a.k.a IBCC* (WIPO Case No. D2000-0102). For a typical US case see *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 497-98 (2d Cir. 2000) (the differences between the trademark "sporty's" and the domain name <sportys.com> – specifically, an apostrophe in the trademark and the addition of .com in the domain name – are "inconsequential," such that the domain name is "indistinguishable" from and "certainly 'confusingly similar' to the protected mark").

[4] *AltaVista Company v. S.M.A., Inc.* (WIPO Case No. D2000-0927); *Gateway, Inc. v. Pixelera.com, Inc (formerly Gateway Media Productions, Inc.)* (WIPO Case No. D2000-0109); *America Online Inc. v. Anson Chan* (WIPO Case No. D2001-0004) and *Cimcities, LLC v. John Zuccarini d/b/a Cupcake Patrol* (WIPO Case No. D2001-0491).

name.[5] The panel has found that the Respondent must have known of the PLAYBOY mark before he registered the domain names.

The furnishing of false contact information to the Registrar also supports a finding of bad faith.

Whether Mr. John Smith is the same person as the Respondent or merely an associate, the panel finds he acted on behalf of and with the approval of the Respondent in drawing the Complainant's attention to the Respondent's web site (ostensibly as a person having no association with or knowledge of the Respondent) and subsequently in negotiating openly for the Respondent in soliciting an offer of a substantial sum from the Complainant for the purchase of the disputed domain name from the Respondent.

The panel finds that the disputed domain name was registered primarily for the purpose of selling it to the Complainant for valuable consideration exceeding the Respondent's documented out-of-pocket registration costs. Pursuant to paragraph 4(b)(i) of the Policy, this circumstance is evidence that the disputed domain name was registered and is being used in bad faith.

Although the Respondent has clearly attempted to attract Internet users to his web site by creating confusion with the Complainant's mark, it is unnecessary to decide whether this was for commercial gain, otherwise than to profit from the Complainant buying the disputed domain name.

The Complainant has established this element.

7. Decision

Pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules, the panel directs that the domain name <playboy-photographer.com> be transferred to the Complainant.

Alan L. Limbury
Presiding Panelist

Peter Michaelson, Esq. Panelist	Luca Barbero, Esq. Panelist

Dated: August 5, 2001

[5] *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport* (NAF Case No. FA0094956). Likewise *Marriott International, Inc. v. John Marriot* (NAF Case No. FA0094737); *163972 Canada Inc. v. Sandro Ursino* (DeC Case No. AF-0211) and *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com* (NAF Case No. FA0095037).

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa

Case No. D2001-0745

1. The Parties

The Complainant is Playboy Enterprises International, Inc., of 680 North Lake Shore Drive, Chicago, Illinois 60611, United States of America, represented by Ms. Angelica Lodgiani, of Societa Italiana Brevetti, Rome, Italy.

The Respondent is Federico Concas, whose address as registrant of the disputed domain name appears in the Registrar's records as Via del Bosco, Pellezzano, Salerno 84080, Italy.

2. The Domain Names and Registrar

This dispute concerns the domain name <playboy-photographer.com>.

The Registrar is Network Solutions, Inc., of Herndon, Virginia, United States of America.

3. Procedural History

This is an administrative proceeding pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999, ("the Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("the Supplemental Rules") of the WIPO Arbitration and Mediation Center ("the Center").

The Complaint was received by the Center by email on June 5, 2001 and in hardcopy on June 7, 2001. The Complaint was acknowledged on June 7, 2001. Next day registration details were sought from the Registrar. On June 11, 2001, the Registrar confirmed that the disputed domain name is registered in the name of the Respondent at the address mentioned above and that the Registrar's 5 Service Agreement (which incorporates the Policy) is in effect. On June 12, 2001, the Center satisfied itself that

the Complainant had complied with all formal requirements, including payment of the prescribed fee and formally dispatched copies of the Complaint by post/courier (with enclosures) to the Respondent at his address as recorded with the Registrar and by email (without attachments) to the three email addresses of and associated with the Respondent as recorded with the Registrar. The Center also included with the material dispatched to the Respondent a letter dated June 12, 2001 containing notification of the commencement of this administrative proceeding and sent copies to the Complainant, the Registrar and ICANN.

The last day specified by the Center for a Response was July 1, 2001. No Response was filed within the time specified by the Rules. On July 3, 2001, the Center gave formal notice of the Respondent's default. On July 7, 2001 the Respondent filed an informal Response in Italian and, on July 15, 2001, declined a request by the Center for a translation into English.

On June 7, July 2 and July 12, 2001 the Complainant's representative notified the Center of communications concerning the Complaint received from the Respondent, from Mr. Franco Concas (the Respondent's father) and from a Mr. "John Smith a.k.a. Orf3vs" following the filing of the Complaint.

On July 16, 2001, by virtue of the Complainant having sought the appointment of a three-member panel, the Center notified the parties of the appointment of the undersigned to serve as panelists, each having submitted a Statement of Acceptance and Declaration of Impartiality and Independence. That day, the Center transmitted the case file to the panel and notified the parties of the projected decision date of July 29, 2001.

The panel is satisfied that the Complaint was filed in accordance with the requirements of the Rules and Supplemental Rules; payment was properly made; the panel agrees with the Center's assessment concerning the Complaint's compliance with the formal requirements; the Center discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint; no Response was filed within the time prescribed by the Rules and the administrative panel was properly constituted.

On July 18, 2001 the Panel by Procedural Order, noting that pursuant to Rule 11 the language of the proceeding was English, requested the Respondent, within five days, to submit an English translation of the informal Response. Pursuant to Rule 10 (c), the Panel extended the time for issuing its decision until August 5, 2001.

On July 20, 2001, the Respondent submitted by email an English translation of the informal Response. The Panel has considered the Response in its English translation.

4. Factual Background

The Complainant and its activities

Playboy magazine, founded by Mr. Hugh Hefner in 1953,is the best-selling men's monthly magazine in the world. Its worldwide monthly circulation, which includes 16 international editions, exceeds 4.7 million copies. It has been published in Italy for 28 years without interruption. The Complainant's business, extending beyond publication of *Playboy* magazine, is that of an international multimedia entertainment company.

The Playboy brand is one of the most recognized in the world. The Complainant's <playboy.com> and other websites incorporating the word PLAYBOY generated over 17 million visits in February 2001. The Complainant has registered the trademark PLAYBOY in many countries, including Italy, where it was first registered in 1963 and has been subsequently renewed.

In 1999 the Court of Naples, Italy, in granting the Complainant injunctive relief against the use of the domain name <playboy.it>, described the PLAYBOY mark as strong and famous, qualifying for protection even against unauthorized use for different goods or services[1]. In affirming the decision, the Board of Appeal described the mark as having remarkable distinctiveness and as being exceptionally renowned[2].

The Respondent and his activities

The disputed domain name was registered on January 4, 2001. It resolves to an active web site offering sexually-oriented photographs of women. On January 22, 2001 the Complainant received an email from a Mr. John Smith purporting to compliment the Complainant on *"your wonderful free website www.playboy-photographer.com*" and asking how to subscribe to the mailing list. The Complainant pointed out that the site was not associated or affiliated with Playboy and asked how Mr. Smith discovered the site. Mr. Smith said a friend of his had found it, the owner, Mr. Federico Concas, the Respondent.

Communications between the Complainant and the Respondent in February and March, 2001 led to an agreement by the Respondent to remove the Complainant's infringing trademarks from his web site but he refused to deactivate that site. The Respondent claimed to have received an offer for US$45,000 for the disputed domain name from an unidentified Japanese company and invited a better offer from the Complainant. The Complainant placed the matter in the hands of its Italian Counsel who, on April 12, 2001, sent a fax addressed to the Respondent, claiming that registration of the disputed domain name violated the Complainant's trademark rights and offering to reimburse the Respondent his costs of registration of the disputed domain name. A copy was also transmitted by email to the email address shown in the records of the Registrar but it was returned as "undeliverable".

Next day, however, Mr Smith, whose first contact with the Complainant is described above, communicated by email to the Complainant's Italian Counsel, saying (amongst other things): *"the more you shake, the more you increase the value of the domain in front of other possible buyers! Make a concrete offer by email. Best regards. OrF3vS"*.

By registered letter dated April 13, 2001, the Respondent's father, Avv. Franco Concas, an attorney at law, wrote to the Complainant's Italian Counsel protesting at the "unlawful" abuse of his (Avv. Franco Concas') fax number for the transmission of the fax of April 12, 2001 from the Complainant's Italian Counsel addressed to the Respondent.

Further emails were received from Mr. Smith. On April 19, 2001 he said:

> "*We are aware that your client Playboy Inc. is available to deal on the economic basis the matter www.playboy-photographer.com.*

[1] *Playboy Enterprises Inc. v. Mario Giannattasio,* Tribunale di Napoli, January 14, 1999.
[2] *Mario Giannattasio v. Playboy Enterprises Inc,.*Tribunale di Napoli, March 24, 1999.

In this regard we communicate that the costs for the registration are not certainly those which determine the value of a web site which amount to 35 $ per year but for the publicity that one makes on the Internet and for the relative management cost! Which amount to several thousands of dollars!

I tell you clearly that we have received conspicuous offers as far as the domain is concerned, thanks also and most for the interest of the company that you represent, but we would like to have an offer also by Playboy, Inc.!

We are available to an agreement and we look forward for a transaction (but only via e-mail)".

On May 15, 2001 Mr. Smith said: "…*I officially announce that the web site is for sale! …I am available to transactions…"*.

The copy of the Complaint sent by the Center, with its letter addressed to the Respondent dated June 12, 2001, was in fact received on June 13, 2001 by Avv. Franco Concas, who subsequently sent a lengthy letter to the Complainant's Italian Counsel, saying (amongst other things) that he had accepted the material from WIPO for mere correctness and had acquired knowledge of it with the authority of the rightful owner. Avv. Franco Concas then proceeded to comment on the proceedings, without claiming to be representing the Respondent.

5. Parties' Contentions

A. Complainant

The panel has reviewed the supplementary material provided by the Complainant, being translations of communications from the Respondent, Mr. Smith and Avv. Franco Concas subsequent to the filing of the Complaint.

Identity / confusing similarity

The disputed domain name 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 the a field of activity (photography) in which the Complainant has gained renown.

Legitimacy

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The domain name is neither the legal name of the Respondent, who is known alternatively as Federico Concas, John Smith or Orf3vs, nor has the Respondent been commonly known by the domain name.

The Respondent's use of PLAYBOY-PHOTOGRAPHER as a domain name is an act of infringement of the Complainant's rights under applicable Italian Trademark Law, which thus does not legitimize his abusive registration.

Further, the Respondent does not have any right to the domain name: an on-line search made among Italian as well as International registrations extended to Italy and into Community trademarks, did not disclose the Respondent owning any trademark

registration or application for the Domain. Rather that the trademark PLAYBOY yielded results indicating that this mark solely resided in the name of the Complainant and not of the Respondent.

In light of the undoubted renown of the PLAYBOY mark and of all the Respondent's conduct, the Respondent's activity cannot be considered as use or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services to the public: there was never a bona fide offering of goods or services in the Respondent's conduct, starting from the supply of false personal data to the Registrar with the evident intent to avoid detection and the adoption of applicable remedies. See *Molinari Int'l S.p.A v. Lasambucamolinari.com*, (WIPO Case D 2000-1169): "*the reference to the lack of truthful information about the Respondent's name and address is quite an important element in determining Respondent's bad faith at registration date*".

Bad faith

In light of the renown and recognition of the trademark PLAYBOY in Italy, it seems incredible that the Respondent, who appears to be Italian both because of his stated name and address and because he communicates in Italian, may have registered and used the disputed domain name in the ignorance of the PLAYBOY trademark. On the contrary, in light of the actual use of the web site, the adoption of the disputed domain name shows a malicious awareness and parasitic intent unlawfully to benefit from PLAYBOY's renown.

The malicious awareness is further proved by the Respondent's agreement, when first approached by the Complainant's Italian Counsel, to delete from his website the Complainant's trademarks, thus explicitly recognizing the Complainant's rights.

The sequence of events shows a pattern of conduct plainly inconsistent with a bona fide attitude and which reveals a scheme to receive consideration from the Complainant well in excess of the reasonable costs of registration and maintenance:

- the disputed domain name was registered on January 4, 2001 by a subject who gave as personal data a name and address which were later proven false;

- John Smith's message on January 23, 2001 was designed to give notice of the web-site in an attempt to "bait" the Complainant;

- John Smith's indication of Federico Concas as the owner of the disputed domain name was designed to lead the Complainant into contacting Federico Concas so that he might "pull the bait" by informing the Complainant that the web site would not be deactivated but, on the contrary, would remain operative and that a third party had offered U.S.$45,000 for it;

- the intention to obtain valuable consideration was further shown by the language of Mr. Smith's email of April 19, 2001 rejecting reimbursement of registration costs;

- the letter sent by the Complainant's Italian Counsel to Federico Concas was undeliverable via e-mail, yet John Smith was mysteriously aware that the Complainant's Italian Counsel were dealing with the matter. The only

explanation is that while the e-mail address of Federico Concas is "allegedly" inactive, John Smith must have a method to monitor it while remaining undetected: setting up such a monitoring device is inconsistent with any good faith attitude.

- finally, and aside from the present domain name matter, a search in the Network Solutions Registry shows that Federico Concas appears to be the owner of many domain names including many famous trademarks (in Italy) such as RIZZOLIPERIODICI (Rizzoli being a major Italian publisher) or personal names, such as BASSOLINO, former Mayor of Naples and currently Governor of the Campania Region. However, while the latter two are inactive, the disputed domain name is active and the REGISTRANT HIMSELF actually advised the Complainant of its existence.

Given the great renown of PLAYBOY it seems indeed quite indisputable that the Respondent, by using the domain name, has attempted and is attempting:

- to attract, for commercial gain, Internet users to his web site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site; or

- to create the conditions by which the Complainant would be forced to offer valuable consideration well in excess of the registration costs to acquire the domain name.

In the light of the foregoing, the Respondent's bad faith, both at registration date and subsequently, is established.

B. Respondent

The Respondent, an Italian citizen, says he is the owner “between others” [not identified] of the disputed domain name. He does not accept that he has been formally notified of the Complaint, nor that the title of Respondent is appropriate. The so-called notification from the Center of June 12, 2001 was not sent to his legal residence but to that of his father, Avv. Franco Concas, and was ineffectual.

The Response is not to be taken as acceptance of the regularity or lawfulness of the proceedings nor of the jurisdiction or participation of WIPO, which cannot affect the rights of private subjects that have not accepted its so-called jurisdiction.

In registering the disputed domain name the Respondent accepted the referral of any issues that might arise to ICANN, not to WIPO, which therefore has no right to know of nor power to decide the issue here.

The Complainant’s Italian Counsel engaged in unlawful surveillance activities and disclosed private information in seeking to gain the surrender of the disputed domain name to the Complainant.

The Respondent has not had the opportunity to defend himself, having been approached by someone claiming to be an American lawyer who somehow was aware of this dispute, who attempted to be paid by credit card and who withdrew his offer of support after a week of failing to reply to the Respondent’s messages, saying the Complainant could count on such financial support that it would be bound to win: in these issues who has more money wins!

Any decision taken in these proceedings cannot bind the Respondent.

6. Discussion and Findings

Under paragraph 15(a) of the Rules, the panel must decide this complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Procedural and jurisdictional issues

The Respondent contends that, in registering the disputed domain name, he agreed to the referral of any issues that might arise to ICANN, and that he has not agreed to the jurisdiction of WIPO.

Paragraph 4 of the Policy, which is incorporated into the Registration Agreement between the Respondent and the Registrar, requires the registrant of the domain name to submit to a mandatory administrative proceeding conducted before "one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm". WIPO was approved by ICANN as such a service provider on December 1, 1999.

The panel finds that, by entering into the Registration Agreement with the Registrar, the Respondent agreed to submit to any administrative proceeding, properly constituted in accordance with the Policy and the Rules, before any ICANN-approved service provider, of which WIPO is one.

The formal notification of the Complaint and of the commencement of this administrative proceeding was sent by the Center on June 12, 2001, to the address of the Respondent, according to the information provided by the Respondent to the Registrar when the Respondent registered the disputed domain name. According to the Response, this was not the Respondent's address at all, but that of his father, who in fact received the material next day.

Although the false information provided by the Respondent to the Registrar meant that the Center may not have succeeded in directly informing the Respondent of the Complaint, the Center nevertheless discharged its responsibility to employ reasonably available means calculated to achieve actual notice to the Respondent, by taking the steps that it did under paragraph 2(a) of the Rules.

In this regard, the panel notes that, though the Complainant contends that the fax number to which it transmitted its letter addressed to the Respondent of April 12, 2001 was indicated in the Registrar's Whois database relating to the disputed domain name, there is, so far as the panel can tell, no fax number mentioned in that database (Annexure A to the Complaint) and it was therefore not incumbent upon the Center, in discharging its responsibility under paragraph 2 (a) of the Rules, to transmit a copy of the notice of May 12, 2001 by facsimile.

Substantive issues

To qualify for cancellation or transfer, a Complainant must prove each element of paragraph 4(a) of the Policy, namely:

(i) the disputed 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 respect of the domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Identity or confusing similarity

Essential or virtual identity is sufficient for the purposes of the Policy.[3]

The test of confusing similarity under the Policy, unlike trademark infringement or unfair competition cases, can, though need not always, be confined to a consideration of the disputed domain name and the trademark.[4] Here each disputed domain name incorporates the whole of the Complainant's trademark PLAYBOY, together with the descriptive word PHOTOGRAPHER, a word associated with the Complainant and its renowned activities. The content of the Respondent's website does nothing to dissuade visitors from the misrepresentation conveyed by the disputed domain name that it is associated with the Complainant.

The panel finds the disputed domain name is confusingly similar to the Complainant's trademark PLAYBOY. The Complainant has established this element.

Illegitimacy

The Complainant has not authorized the Respondent to use its trademark nor to register the disputed domain name. The name of the Respondent is not and does not include any part of any of the disputed domain name. The Respondent cannot have been unaware of the renown of the PLAYBOY mark when he registered the disputed domain name.

It is thus apparent that the site has been designed to attract Internet users because of the renown of the PLAYBOY mark. The Respondent is trading off the Complainant's goodwill in so doing.

The panel finds the Complainant has established this element. The Respondent has no rights or legitimate interest in the disputed domain name.

Bad faith registration and use

A finding of bad faith may be made where the Respondent "knew or should have known" of the registration and use of the trademark prior to registering the domain

---

[3] See *The Stanley Works and Stanley Logistics, Inc v. Camp Creek. Co., Inc.* (WIPO Case No. D2000-0113), *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd.* (WIPO Case No. D2000-0802) and *Nokia Corporation v. Nokiagirls.com a.k.a IBCC* (WIPO Case No. D2000-0102). For a typical US case see *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 497-98 (2d Cir. 2000) (the differences between the trademark "sporty's" and the domain name <sportys.com> – specifically, an apostrophe in the trademark and the addition of .com in the domain name – are "inconsequential," such that the domain name is "indistinguishable" from and "certainly 'confusingly similar' to the protected mark").

[4] *AltaVista Company v. S.M.A., Inc.* (WIPO Case No. D2000-0927); *Gateway, Inc. v. Pixelera.com, Inc (formerly Gateway Media Productions, Inc.)* (WIPO Case No. D2000-0109); *America Online Inc. v. Anson Chan* (WIPO Case No. D2001-0004) and *Cimcities, LLC v. John Zuccarini d/b/a Cupcake Patrol* (WIPO Case No. D2001-0491).

name.[5] The panel has found that the Respondent must have known of the PLAYBOY mark before he registered the domain names.

The furnishing of false contact information to the Registrar also supports a finding of bad faith.

Whether Mr. John Smith is the same person as the Respondent or merely an associate, the panel finds he acted on behalf of and with the approval of the Respondent in drawing the Complainant's attention to the Respondent's web site (ostensibly as a person having no association with or knowledge of the Respondent) and subsequently in negotiating openly for the Respondent in soliciting an offer of a substantial sum from the Complainant for the purchase of the disputed domain name from the Respondent.

The panel finds that the disputed domain name was registered primarily for the purpose of selling it to the Complainant for valuable consideration exceeding the Respondent's documented out-of-pocket registration costs. Pursuant to paragraph 4(b)(i) of the Policy, this circumstance is evidence that the disputed domain name was registered and is being used in bad faith.

Although the Respondent has clearly attempted to attract Internet users to his web site by creating confusion with the Complainant's mark, it is unnecessary to decide whether this was for commercial gain, otherwise than to profit from the Complainant buying the disputed domain name.

The Complainant has established this element.

7. Decision

Pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules, the panel directs that the domain name <playboy-photographer.com> be transferred to the Complainant.

Alan L. Limbury
Presiding Panelist

____

Peter Michaelson, Esq.
Panelist

____

Luca Barbero, Esq.
Panelist

Dated: August 5, 2001

[5] *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport* (NAF Case No. FA0094956). Likewise *Marriott International, Inc. v. John Marriot* (NAF Case No. FA0094737); *163972 Canada Inc. v. Sandro Ursino* (DeC Case No. AF-0211) and *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com* (NAF Case No. FA0095037).