



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International, Inc. v. Universal Internet Technologies, Inc.**

**Case No. D2001-0811**

#### **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 Suzanne V. Wilson, Esq. and Carol Lally, Esq. of Arnold & Porter, Los Angeles, California, USA.

The Respondent is Universal Internet Technologies, Inc., Global Gaming Systems and Licensing, European Division, Bloomsbury, London, England WC1E 7QF, United Kingdom.

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

The disputed domain names in this proceeding are <playboysportbooks.com>, <playboysportbook.com>, <playboysportsbook.com> and <playboysportsbook.net>.

The Registrar is Tucows, Inc., of Toronto, Ontario, Canada.

#### **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, which specified two of the disputed domain names, namely <playboysportbooks.com> and <playboysportbook.com>, was received by the Center by email on June 20, 2001 and in hardcopy on June 21, 2001. The Complaint was acknowledged on June 21, 2001. Next day registration details were sought from the Registrar. On June 22 and June 28, 2001 the Registrar confirmed that the disputed domain names are registered in the name of the Respondent at the address mentioned

above and that section 7 of the Registrar's Registration Agreement incorporates the Policy.

On June 26, 2001 by email and on June 29, 2001 in hardcopy, the Complainant filed an amended Complaint, which specified all four disputed domain names. On July 2, 2001 the Center satisfied itself that the amended Complaint complied with all formal requirements (including payment of the prescribed fee) and formally dispatched copies of the amended Complaint by post/courier (with enclosures) to the Respondent at its address as recorded with the Registrar and by email (without attachments). The Center also included with the material dispatched to the Respondent a letter dated July 2, 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 21, 2001. No Response was filed within the time specified by the Rules. On July 26, 2001, the Center gave formal notice of the Respondent's default.

On August 24, 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 September 7, 2001.

The panel is satisfied that the amended 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 amended 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 amended Complaint; no Response was filed within the time prescribed by the Rules and the administrative panel was properly constituted.

The language of the proceedings was English.

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

The Complainant is a global media entertainment company, providing adult lifestyle entertainment through a wide variety of media, including print, cable television, videotape and the Internet. It entered the gaming industry when it opened a casino in 1966.

First registered in the United States in 1954 and in the United Kingdom in 1962, the Complainant's PLAYBOY trademark is internationally famous<sup>1</sup>. The Complainant also has common law rights, through use, in the trademark PLAYBOY SPORTSBOOK.COM and is the registrant of that domain name, which it uses in connection with on-line sports wagering activities.

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<sup>1</sup> The distinctiveness, strength and fame of the PLAYBOY mark has been acknowledged by a number of courts. See, e.g., *Playboy Enters., Inc. v. Baccarat Clothing Co, Inc.*, 692 F.2d 1272 (9th 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. Apr. 10, 1998) (noting that fame of PLAYBOY mark is beyond dispute).

The Complainant's websites, including <www.playboy.com>, <www.playboysportsbook.com>, and <www.playboysportsbook.co.uk>, promote fixed odds sports wagering and other entertainment services provided under the PLAYBOY SPORTSBOOK.COM mark.

On February 15, 2001 the Complainant announced its intent to operate, with Ladbrokes eGaming Ltd. in London, an on-line sports wagering website at <www.playboysportsbook.com>.

On February 21, 2001, the Respondent registered the domain names <playboyssportsbook.com> and <playboyssportsbook.net>. On March 11, 2001, the Respondent registered the domain names <playboysportbooks.com> and <playboysportbook.com>.

The web addresses corresponding to the disputed domain names resolve to a website which appears to offer on-line wagering services. They frame a page from the website <www.worldwager.net> and then redirect the user to the <www.worldwager.net> website, which is currently registered to the Respondent.

According to the Complainant the registration for the disputed domain names contains incomplete information. There is no registered legal entity called "Universal Internet Technologies, Inc." in the United Kingdom. Indeed the names of United Kingdom companies do not end in Inc but rather Limited, Plc or some variation of those designations. The Bloomsbury address is incomplete since it does not contain all the information including a street number and name that a complete address in central London would contain.

## **5. Parties' Contentions**

### **A. Complainant (omitting many citations)**

#### **Identity or confusing similarity**

The disputed domain names are identical to the Complainant's trademark PLAYBOY SPORTSBOOK.COM. They also are identical to the Complainant's website address <www.playboysportsbook.com>. The disputed domain names are also confusingly similar to the Complainant's famous mark PLAYBOY. Thus, they are identical or at the very least confusingly similar to the Complainant Marks.

Further, consumers expect to find a company on the Internet at a domain name address comprised of the company's name or marks. This is all the more so when, as here, the Complainant uses the Internet to market or sell its goods and services.

Because PLAYBOY SPORTSBOOK.COM is the trademark and <playboysportsbook.com> is the domain name for the Complainant's on-line sports wagering services and entertainment, consumers would expect to find a Complainant website at a site accessed by means of any of the disputed domain names. The Respondent's registration of the disputed domain names and use of those domain names in connection with competitive on-line sports wagering websites causes or is likely to cause consumer confusion.

## **Legitimacy**

The Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's marks in a domain name or in any other manner.

The Respondent has not used the disputed domain names in connection with a *bona fide* offering of goods or services. The Respondent does not have trademark registrations for "playboysportbooks," "playboysportbook," "playboyssportsbook.com," or "playboyssportsbook.net" and could not obtain registrations because the Complainant's marks belong and are registered to the Complainant. While it appears that the Respondent may offer wagering services through the <worldwager.net> website that is framed by the disputed domain names, the Respondent's unauthorized provision of information and competitive services under the Complainant's mark is not a *bona fide* offering of goods and services.

The Respondent has not made a legitimate non-commercial or fair use of the disputed domain names. There is no evidence that the Respondent, whose purported corporate name differs from the disputed domain names, is commonly known by the disputed domain names. Rather, the evidence suggests that the Respondent registered the disputed domain names with the intent of trading on the reputation of and goodwill associated with the Complainant.

## **Bad faith**

The Respondent's misappropriation of the disputed domain names is no accident. The Respondent registered the disputed domain names less than a month after the Complainant issued its press release about its on-line sports wagering site at <www.playboysportsbook.com>. Thus, the Respondent deliberately registered the disputed domain names with the bad faith intent of profiting from the Complainant and its famous PLAYBOY marks.

Further, the Respondent has engaged in a pattern of registering domain names containing third parties' trademarks. In addition to registering at least four domain names containing the Complainant marks, the Respondent recently registered the domain names <abcsportssportswager.com>, <nbc sportswager.com>, <cbssportswager.com>, and <foxsportswager.com><sup>2</sup>. The Respondent's pattern of conduct is evidence of its bad faith registration of the disputed domain names.

Moreover, the Complainant's marks are internationally famous. The fame and reputation of a trademark owner's mark can demonstrate a respondent's bad faith intent in registering a domain name that contains the famous mark.

Given the fame of the Complainant marks, "it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the [disputed domain names]. It is also not possible to conceive of a plausible situation in which the Respondent would have been unaware of this fact at the time of registration."<sup>3</sup>

In any event, the Respondent has used the disputed domain names in bad faith by redirecting them to an active website. This unauthorized use creates a likelihood of

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<sup>2</sup> See *ABC Sports*, NAF Case No. 95840 (granting ABC Sports' request to transfer the domain name containing its trademark).

<sup>3</sup> See *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-0003 at § 7.7.

confusion with the Complainant and the Complainant marks. Consumer confusion is all the more likely because the active website associated with the disputed domain names has purported to offer the same sort of on-line wagering services that the Complainant offers at its own website under its identical mark and domain name.

It is bad faith to register and use a domain name containing a trademark owner's mark to offer competitive goods and services.

Even if the Respondent had not used the disputed domain names to host an active website, however, his actions still constitute registration and use in bad faith. The Respondent must have expected that any use of the disputed domain names would cause the Complainant harm. The disputed domain names contain marks that are so "obviously indicative" of the trademark owner that the Respondent's use of the domain name would "inevitably lead to confusion of some sort."<sup>4</sup>

Indeed, the fact that the Respondent provided the registrar with incomplete information in its registration applications confirms that the Respondent must have expected that its registration and use of the disputed domain names would harm the Complainant. At the very least, the WhoIs records for the disputed domain names contain an incomplete address and a company name that does not correspond to a registered legal entity in the United Kingdom. Providing incomplete or false information to the registrar is compelling evidence of bad faith registration and use<sup>5</sup>.

## **B. The Respondent**

No Response was filed.

## **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.

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

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<sup>4</sup> *AT&T Corp. v. Fred Rice*, WIPO Case No. D2000-1276 at § 6 (November 25, 2000). "Nobody registers domain names for no purpose. . . . [T]he Respondent either registered them in order to sell them to the Complainant hoping that the Complainant would offer a large sum of money for them or he registered them in order to use them to connect to an internet facility." *Id.*; *see also eBay Inc. v. Sunho Houg*, WIPO Case No. D2000-1633 at § 6 (use of complainant's entire mark in disputed domain names makes it difficult to infer a legitimate use).

<sup>5</sup> *See, e.g., Ticketmaster Corp. v. Dmitri Penn*, WIPO Case No. D2000-1550 at § 6 (Jan. 16, 2001) (absence of complete or correct information in the application for registration suggests a desire to create a covert position and make communication difficult and constitutes bad faith); *Cabletron Systems, Inc. v. DSL Enters.*, WIPO Case No. D2000-0571 at § 6 (Aug. 18, 2000) (providing false telephone number, e-mail address and identities to the Complainant and the registrar is an act of bad faith); *Quixtar Investments, Inc. v. Scott A. Smithberger, et al.*, WIPO Case No. D2000-0138 at § 6 (Aug. 1, 2000) (use of false registration information to hide true identity is evidence of bad faith registration and use).

name; and

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

Failure to file a Response permits the panel to infer that the Respondent does not deny the facts which the Complainant asserts nor the conclusions which the Complainant asserts can be drawn from those facts”.<sup>6</sup>

### **Identity or confusing similarity**

Essential or virtual identity is sufficient for the purposes of the Policy.<sup>7</sup> 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.<sup>8</sup>

Here each disputed domain name incorporates, as its most prominent feature, the whole of the Complainant’s famous trademark PLAYBOY, together with the descriptive words SPORTS and BOOK, neither of which does anything to detract from the immediate association with the Complainant aroused by the word PLAYBOY. The content of the Respondent’s website does nothing to dissuade visitors from the misrepresentations conveyed by the disputed domain names that they are associated with the Complainant, having regard to the fame of the PLAYBOY mark and the Complainant’s activities in the gaming field.

The panel finds the disputed domain names are identical to the Complainant’s common law trademark PLAYBOY SPORTSBOOK.COM and confusingly similar to the Complainant’s famous registered trademark PLAYBOY. The Complainant has established this element.

### **Illegitimacy**

The Complainant has not authorized the Respondent to use its trademarks nor to register the disputed domain names. The Respondent is not known by any of the disputed domain names. The Respondent cannot have been unaware of the renown of the PLAYBOY mark when it registered the disputed domain names<sup>9</sup>.

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<sup>6</sup> Rule 14(b) and see *Reuters Limited v. Global Net 2000, Inc.* (WIPO Case No. D2000-0441); *Hewlett-Packard Company v. Full System S.a.S.* (NAF Case No. FA0094637); *David G. Cook v. This Domain is For Sale* (NAF Case No. FA0094957) and *Gorstew Jamaica and Unique Vacations, Inc. v. Travel Concierge* (NAF Case No. FA0094925).

<sup>7</sup> 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”).

<sup>8</sup> *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) *Cimcities, LLC v. John Zuccarini d/b/a Cupcake Patrol* (WIPO Case No. D2001-0491) and *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa* (WIPO Case No. D2001-0745).

<sup>9</sup> For a similar case see *A.P. Møller v. Web Society* (WIPO case No.D2000-0135).

It is thus apparent that the Respondent's 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 and is not offering *bona fide* services<sup>10</sup>. The use of slight mis-spellings of well-known trademarks to attract Internet traffic has been held by other panels to negate *bona fides* and to demonstrate lack of any legitimate interest in the domain name.<sup>11</sup>

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

### **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 name.<sup>12</sup> The panel has found that the Respondent must have known of the PLAYBOY mark before it registered the domain names. The timing of the registrations so soon after the announcement of the Complainant's intention to operate an on-line sports wagering website at <www.playboysportsbook.com> indicates that the Respondent knew of that announcement, and hence of the PLAYBOY SPORTSBOOK.COM mark, at the time of those domain name registrations.

The Panel draws the inference that the Respondent, by registering the disputed domain names so soon after the Complainant's announcement, intended to prevent the Complainant from reflecting its PLAYBOY SPORTSBOOK.COM mark in a corresponding domain name. Under paragraph 4(b)(ii) of the Policy, this is evidence of both bad faith registration and bad faith use, provided there is a pattern of such conduct. The Respondent has exhibited a pattern of such conduct by registering other domain names incorporating the well-known trademarks of others. Similar cases have been held to be classic cases of cybersquatting.<sup>13</sup>

The Panel also infers from the circumstances just mentioned that the disputed domain names were registered primarily for the purpose of disrupting the business of the Complainant, a competitor of the Respondent. This is evidence of both bad faith registration and bad faith use under paragraph 4(b)(iii) of the Policy.

By intentionally diverting Internet users from what they expect to be the Complainant's site to the Respondent's competing site, the Respondent allows those users to infer a relationship between the Complainant and the Respondent that does not exist. This is evidence of both bad faith registration and bad faith use under paragraph 4(b)(iv) of the

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<sup>10</sup> *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* (WIPO case No.D2000-0847).

<sup>11</sup> See for example *Cimcities, LLC v. John Zuccarini D/B/A Cupcake Patrol* (WIPO Case No. D2001-0491) *Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol* (WIPO Case No. D2001-0489 and *Guerlain S.A. v. Peikang*, WIPO Case No. D2000-0055.

<sup>12</sup> *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).

<sup>13</sup> *Sanrio Company, Ltd and Sanrio, Inc. v. Neric Lau*, (WIPO case No.D2000-0172) and *Stanley Works and Stanley Logistics, Inc v. Cam Creek. Co., Inc.* (WIPO case No.D2000-0113); *Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil* (WIPO case No.D2000-1409) and *Warner Lambert Export Limited v. Mr Darren Darcy* (WIPO case No.D2000-0453).

Policy.

The furnishing of false or incomplete contact information to the Registrar is also prima facie evidence of bad faith registration and use.

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 names <playboysportbooks.com>, <playboysportbook.com>, <playboyssportsbook.com> and <playboyssportsbook.net> be transferred to the Complainant.

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Alan L. Limbury  
Presiding Panelist

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Peter L. Michaelson, Esq.  
Panelist

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Clive Thorne, Esq.  
Panelist

Dated: September 1, 2001