



DECISION

Playboy Enterprises International Inc. v Web Management
Claim Number: FA0101000096339

PARTIES

The Complainant is **Playboy Enterprises International Inc.**, Chicago, IL, USA (“Complainant”) represented by **David J. Stewart**, of **Alston & Bird**. The Respondent is **Web Management**, Chicago, IL, USA (“Respondent”).

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are "**sexcetra.com**," "**personalplaymates.com**" registered with **Internet Domain Registrars**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge, has no known conflict in serving as a panelist in this proceeding.

Hon. Carolyn Marks Johnson, Peter L. Michaelson, Esq. and the Hon. James A. Carmody, as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on December 28, 2000; the Forum received a hard copy of the Complaint on December 28, 2000.

On January 2, 2001, Internet Domain Registrars confirmed by e-mail to the Forum that the domain names "**sexcetra.com**", "**personalplaymates.com**" are registered with Internet Domain Registrars and that the Respondent is the current registrant of the name. Internet Domain Registrars has verified that Respondent is bound by the Internet Domain Registrars registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On January 2, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 22, 2001 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@sexcetra.com, personalplaymates.com by e-mail.

Having received no Response from Respondent, using the same contact details and methods as were used for the Commencement Notification, the Forum transmitted to the parties a Notification of Respondent Default.

On February 5, 2001, pursuant to Complainant's request to have the dispute decided by a Three Member panel, the Forum appointed the Hon. Carolyn Marks Johnson, Peter L. Michaelson and the Hon. James A. Carmody as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its Decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any Response from the Respondent.

RELIEF SOUGHT

The Complainant requests that the domain names be transferred from the Respondent to the Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant alleges that Respondent has registered and is using the domain names at issue and that they are identical or confusingly similar to earlier federal registrations of trademarks and service marks owned and used by Complainant. Further, Complainant asserts that Respondent has no rights or legitimate interests in respect of the domain names at issue and that they were registered and are being used in bad faith.

B. Respondent

Respondent has not filed a Response of any kind in this proceeding.

FINDINGS

Complainant is an international publishing and entertainment company with its principal place of business in Chicago, Illinois. Since its founding more than forty-seven years ago, Complainant has revolutionized the adult lifestyle entertainment field. Among Complainant's many products and services is its well-known men's entertainment

magazine *Playboy*, which features articles of general interest, celebrity interviews and photographs of beautiful women. *Playboy* magazine is read by approximately ten million readers each month and is published worldwide in sixteen international editions.

Beginning with its January 1954 issue, one of the most popular features of *Playboy* magazine has been the PLAYMATE OF THE MONTH, which includes photographs of a model and background information regarding the model. Complainant identifies the various models who pose for this feature as PLAYMATE models.

Leveraging upon the fame of its PLAYMATE mark, Complainant uses or licenses others to use the mark to identify a wide variety of products, including numerous special edition magazines (e.g., *Playboy's Playmate Review*, *Playboy's Playmates of the Year*, *Playboy's Calendar Playmates*, *Playboy's International Playmates*, and *Playboy's Playmates in the Spotlight*); television programming; videocassettes; CD-ROMs; and an array of merchandise that includes lingerie, clothing, cigars, watches, jewelry and playing cards. All of the foregoing products are sold in interstate commerce throughout the United States and beyond, and Complainant has continuously used its PLAYMATE mark in connection with these products since well prior to the acts of Respondent complained of herein.

Another prominent service of Complainant is Playboy TV, an international cable and satellite broadcast channel. One of the most popular programs on Playboy TV is Complainant's hour-long program SEXCETERA. SEXCETERA is an hour-long investigative program that sends reporters to cover stories on adult related topics. The show is produced monthly and each episode airs an average of ten times per month. SEXCETERA first aired in December 1982 and ran continually until 1985. The show was reintroduced in July 1998 and has been broadcast continually since that date throughout the United States. The show is also aired in the U.K., Japan, Iberia, Scandinavia, Hong Kong, Turkey, Israel and Latin America.

Complainant owns and operates prominent Internet websites located at the URLs www.playboy.com and www.playboytv.com. These sites feature the PLAYMATE and SEXCETERA marks (the "Marks"), as well as photographs, articles of interest, Complainant's merchandise, videos and Playboy TV broadcast schedules. The sites are among the most popular destinations on the Internet, currently attracting more than twenty-four million visitors a month collectively.

By virtue of Complainant's long-standing, continuous and exclusive use of the Marks in international commerce, Complainant owns valid and enforceable trademark and service mark rights in the Marks. In recognition of these rights, the United States Patent and Trademark Office ("PTO") has issued Complainant thirty-two registrations on the Principal Register for marks that consist in whole or in part of the PLAYMATE mark (including Reg. Nos. 721,987; 1,462,569; 1,664,570; 2,191,045; and 2,191,054). No less than seven of these registrations are incontestable pursuant to 15 U.S.C. § 1065, and thus constitute conclusive evidence of Complainant's ownership of and exclusive right to use the marks in commerce in the United States. 15 U.S.C. § 1115 (b). The PTO has further

granted registration on the Principal Register for the SEXCETERA mark (Reg. No. 2,316,371).

Complainant has spent considerable time and money promoting the Marks nationwide and throughout the world. Accordingly, the Marks are so well-known that they serve in the minds of the consuming public to identify Complainant alone. See, e.g., Playboy Enters. v. AsiaFocus Int'l, Inc., 97-734-A, 1998 WL 724000 at ** 6, 8 (E.D. Va. April 10, 1998) (finding that the PLAYMATE mark is strong, distinctive and famous).

Respondent is also located in Chicago, Illinois. According to Network Solutions' WHOIS database, Respondent registered PERSONALPLAYMATES.COM and SEXCETRA.COM on December 13, 1999 and February 29, 2000, respectively, with Internet Domain Registrars. Shortly after registration, Respondent began using the domain names at issue to host for-profit adult content websites under the service marks PERSONAL PLAYMATES and SEXCETRA, respectively.

Complainant alleges that it became aware of Respondent's actions in the Spring of 2000. Thereafter, Complainant attempted to resolve the matter amicably. Through numerous e-mails and letters, Complainant and its outside counsel requested that Respondent cease and desist further use of the domain names at issue to Complainant. To date, Complainant states that it has received no response of any kind from Respondent.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules.

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
- and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The domain names at issue are confusingly similar to Complainant's Marks, because a reasonable Internet user would assume that they are somehow associated with Complainant's well-established trademarks and service marks. *See Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000) (finding that confusion would result when Internet users, intending to access Complainant's web site, think that an affiliation of some sort exists between the Complainant and the Respondent, when in fact, no such relationship would exist).

In addition, Respondent's **sexcetra.com** domain name is a common misspelling or typo of Complainant's famous mark used in television programming, which makes this domain name at issue virtually identical to Complainant's mark. *See Reuters Limited v Global Net 2000, Inc.*, D2000-441 (WIPO July 13, 2000) (finding that a domain name which differs by only one letter from a trademark has a greater tendency to be confusingly similar to the trademark where the trademark is highly distinctive). *See, also Playboy Enterprises International, Inc. v. Hector Rodruguez*, D2000-1016 (WIPO November 7, 2000) to the same effect.

Finally, Respondent's **personalplaymates.com** domain name fully incorporates Complainant's mark. *See Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (finding that "[n]either the addition of an ordinary descriptive word...nor the suffix '.com' detract from the overall impression of the dominant part of the name in each case, namely the trademark SONY" and thus Policy 4.a.(i) is satisfied).

Rights or Legitimate Interests

We find that Respondent has no rights or legitimate interests in the domain names at issue because Respondent's use is a blatant attempt to trade on the goodwill and fame associated with Complainant's famous marks. *See America Online, Inc. v. Xianfeng Fu*, D2000-1374 (WIPO Dec. 11, 2000) (finding that "[I]t would be unconscionable to find a *bona fide* offering of services in a Respondent's operation of web-site using a domain name which is confusingly similar to the Complainant's mark and for the same business).

Further, there is no indication that Respondent is commonly known by the domain names at issue, nor has Respondent received a license or consent to use the Complainant's marks in domain names or any other manner. *See Compangnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where Respondent was not commonly known by the mark or never applied for a license or permission from the Complainant to use the trademarked name).

Registration and Use in Bad Faith

We find that Respondent is using the domain names at issue to divert Internet users to its websites, strictly for commercial gain, by creating a likelihood of confusion with Complainant's famous mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web sites. *See Reuters Ltd. v. Global Net 2000, Inc.*, D2000-0441 (WIPO July 13, 2000) (finding bad faith where the Respondent attracted users to a web site sponsored by the Respondent and created confusion with the Complainant's mark as to the source, sponsorship, or affiliation of that web site).

Furthermore, given the widespread notoriety and fame associated with Complainant's "PLAYMATE" mark, we find that it is very unlikely that Respondent registered the infringing domain name **personalplaymates.com** without actual knowledge of Complainant's rights, which further demonstrates Respondent's bad faith. *See Reuters Ltd. v. Teletrust IPR Ltd.*, D2000-0471 (WIPO Sept. 8, 2000) (finding that the Respondent demonstrated bad faith where the Respondent was aware of the Complainant's famous mark when registering the domain name as well as aware of the deception and confusion that would inevitably follow if he used the domain names).

DECISION

Having established all three elements required by the ICANN Policy Rule 4(a), it is the decision of the panel that the requested relief be granted.

Accordingly, for all of the foregoing reasons, it is ordered that the domain names, "**personalplaymates.com**" and "**sexcetra.com**" be transferred from the Respondent to the Complainant.

Hon. Carolyn Marks Johnson, Panelist
Peter L. Michaelson, Esq., Panelist

Hon. James A. Carmody, Chairman
Dated: February 12, 2001