



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Tonya Flynt Foundation

Case No. D2001-1002

1. The Parties

The Complainant is Playboy Enterprises International, Inc., a Delaware, U.S.A. corporation with its principal place of business at 680 North Lake Shore Drive, Chicago, Illinois 60611, U.S.A.

The Respondent is the Tonya Flynt Foundation whose mailing address is P.O. Box 350328, Jacksonville, Florida 32235, U.S.A.

2. The Domain Name and Registrar

The disputed domain is: <playboyonline.com>

The registrar for the disputed domain is Tucows, located at 96 Mowat Avenue, Toronto, Ontario M6K 3M1, Canada.

3. Procedural History

This dispute is to be resolved in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) and Rules (the Rules) approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999, and the World Intellectual Property Organization Arbitration and Mediation Center's Supplemental Rules for Uniform Domain Name Dispute Resolution (the Center, the Supplemental Rules).

The Complaint was filed on August 7, 2001 in hard copy. The Complainant requested and paid for a 3 person panel. On August 8, 2001, the Center requested that the registrar Tucows check and report back on the registrant for the domain name <playboyonline.com>. On August 10, 2001 Tucows reported the registrant was the Respondent, the Tonya Flynt Foundation.

On August 14, 2001 the Center forwarded a copy of the Complaint to Respondent by registered mail and by e-mail, and this proceeding officially began. Based on the Respondent's request and the Complainant's agreement, an extension to the Response

due date was granted until October 3, 2001. The Respondent did not file a response and on October 4, 2001 was declared in default per the Rules (5a and 14a). The Panel is mindful of Rule 5e which provides that in the event of Respondent default, absent exceptional circumstances, the Panel must decide the dispute based on the complaint. The Panel is not aware of any special circumstances that warrant setting aside this Rule.

The Administrative Panel members submitted a Declaration of Impartiality and Independence by October 27, 2001, and on October 30, 2001 the Center proceeded to appoint the Panel. The Panel finds the Center has adhered to the Policy and the Rules in administering this Case.

This Decision is due by November 13, 2001.

4. Factual Background

The Complainant is an international entertainment company providing adult lifestyle entertainment through a variety of media including print, cable television, videotape and the internet. The Complainant has been in business for some 45 years. The Complainant uses and licenses its "Playboy" mark around the world in connection with the promotion, advertisement and sale of Playboy goods and services. The Complainant operates websites that include the disputed domain name, e.g., <playboy.com>, <playboytv.com>, and <playboystore.com>.

The Complainant owns many Playboy mark registrations in a variety of classes in the United States and around the world.

The distinctiveness, strength and fame of the Playboy mark have been acknowledged by several United States court decisions.

The Complainant has been attempting to acquire the disputed domain name since 1997 from its list of previous registrants. The Respondent in this proceeding registered the disputed domain name on February 21, 2001. Since that time there has been correspondence between the parties. Notably, on June 25, 2001 and July 6, 2001, the Complainant sent the Respondent letters alleging trademark infringement and demanding transfer of the disputed domain name. Apparently the parties also spoke by phone. No agreement was reached however.

The Complainant now is seeking transfer of the disputed domain in this proceeding.

5. The Parties' Contentions (summarized):

Complainant's Contentions :

- The Respondent, Tonya Flynt, is the daughter of Larry Flynt, founder, editor and publisher of "Hustler" magazine, a competitor of the Complainant.
- The disputed domain name website consists of two commercial banner advertisements which link to third party websites (Complaint Annex G). The first banner advertisement directs users to DVDUniverse.com, which displays a particular page that lists videos for sale, none of which are Playboy videos (Complaint Annex H).

- The second banner advertisement is a GoTo.com "affiliate box" which is titled "Click to find Playboy Online!". When users click on this banner ad, they are not directed to Playboy.com or any other Complainant website. Instead, they are directed to a particular page on GoTo.com. The page they are directed to on GoTo.com contains search results which list many sites that are not related to, affiliated with, endorsed or sponsored in any way by Complainant (Annex I).
- According to GoTo.com's Affiliates' Rules, users of their Affiliate box receive a set fee for all internet users who enter GoTo.com through the Affiliates' websites (Complaint Annex J).
- The only function of the Respondent's website is to trick internet users into clicking on banner advertisements under the false assumption that the disputed domain name website is affiliated with or sponsored by Playboy.
- On July 26, 2001, in response to its letters, Complainant received a phone call from the Respondent. Respondent indicated she had no use for the disputed domain name but was still unwilling to transfer it to the Complainant. Respondent claimed that the domain name was then an asset of the Tonya Flynt Foundation and that she would be willing to sell it to Complainant.
- The Complainant has discovered evidence of actual confusion caused by the Respondent's use of the Playboy mark at the domain name website. On a personal webpage the webmaster lists his favorite url's. One item on this list is a link entitled "playboy" ostensibly for "playboy magazine"; however, when the users click on this link they are not directed to Playboy.com or any site associated with the Complainant, but instead to the disputed domain name and hence Respondent's website (Complaint Annex L).
- The disputed domain name <playboyonline.com> is identical to Complainant's Playboy Online and Playboy trademarks. The suffix ".com" is insignificant for determining identity or confusing similarity. (*Old Sturbridge Inc. v. S.C.I. Management Inc.*, NAF Case No. 0101000096461, March 1, 2001) The Respondent merely builds on the famous Playboy mark and web site address by adding a word, "online", that logically would refer to a product or service offered by the Complainant, or even information about the Complainant.
- Prior ICANN panels have found that the addition of a generic word or modifier to a famous trademark in a domain name does not eliminate confusion and is evidence of bad faith: in particular, consumers looking for information regarding "Microsoft Home" products would assume that the website address microsofthome.com would take them to an official Microsoft site. (see *Microsoft Corporation v. StepWeb*, WIPO Case No. D2000-1500, January 19, 2001). Thus, the disputed domain name is identical and confusingly similar to Complainant's Playboy Online and Playboy trademarks.
- The Respondent has no legitimate interest in the domain name nor does the name reflect the Respondent or its business. Respondent has no connection or affiliation with Playboy.
- The Respondent has not made a legitimate, noncommercial or fair use of the domain name. The disputed domain name website features commercial banner advertising. This evidence suggests that the Respondent registered the domain

name with the intention of trading on the reputation and goodwill associated with the Complainant by receiving potential revenue from the banner advertisements.

- Respondent has registered and is using the disputed domain name in bad faith: "Attracting internet users to a website, for commercial gain, by causing confusion with the Complainant's mark as to the sponsorship, endorsement, affiliation or source of the website is evidence of bad faith" (*Bloomberg, L.P. v. Electronic Media Services*, NAF Case No. FA0101000096438, February 19, 2001).
- The disputed domain name should be transferred to the Complainant.

6. Discussion and Findings

In order for the Complainant to prevail and have the disputed domain name <playboyonline.com> transferred to itself, Complainant must prove the following (the Policy, para 4a (i-iii)):

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

Identical or Confusingly Similar

The Complainant has offered ample evidence that it has rights in the mark Playboy. The Panel notes in e.g. the Playboy mark no. 791,734 registered on June 29, 1965 on the principal register in the United States. The Panel also notes that the Complainant owns the mark for the disputed domain name Playboy Online (U.S. registration no. 2,361,962 dated June 27, 2000) for its internet-based adult entertainment services (Complaint Annex D).

The Panel also takes ex officio notice that the Playboy mark, at least in the United States, is famous in its realm of adult entertainment.

The Respondent has added "online" and "com" to the Complainant's famous mark. The generic top level domain indicator ".com" need not detain us as it is well-settled that ".com" has no effect on any possible identity or confusing similarity in a domain name (*Old Sturbridge supra*).

As for Respondent's adding "online", there is broad consensus in cases under the Policy regarding words such as "online" that are merely descriptive or generic in the context of the internet. "Online" is a common way of saying certain things can be found on the internet. Thus the Respondent has added nothing of distinction to the Complainant's famous mark.

The Panel finds the disputed domain name, <playboyonline.com>, is confusingly similar to Complainant's famous Playboy mark and identical to Complainant's mark for online services, Playboy Online (*Microsoft Corporation supra*).

Legitimate Rights or Interests

The Complainant contends it has not licensed its Playboy mark to the Respondent and that it has no business relationship whatever with the Respondent.

The Respondent is in default in this proceeding and thus has made no effort to prove it has legitimate rights and interests in the disputed domain name per the Policy at 4c(i-iii).

Certainly, based on the evidence on record, the Respondent's practice of using the Complainant's mark to direct internet traffic to other commercial websites is not a legitimate right or interest under the Policy.

The Panel finds the Respondent has no legitimate rights or interests in the disputed domain name.

Registered and Used in Bad Faith

The Respondent undoubtedly knew about the Complainant when it registered the disputed domain name thanks to the famousness of Complainant's mark. Also, it would appear Tonya Flynt of the Tonya Flynt Foundation is an habituee of the adult entertainment environment.

As the Complainant has shown, the Respondent is using the disputed website to show commercial advertising that leads the public to other sites that sell goods such as videos. The public would expect the Complainant to offer these goods but they in fact have nothing to do with the Complainant (*Bloomberg supra*, and the Complaint Annexes G and H). The Panel finds it only logical to infer the Respondent derives income from this business operation at the disputed domain name. Therefore, the Panel finds the Respondent registered and is using the domain name in clear violation of the Policy at 4b(iv):

"by using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your 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 your web site or location or of a product or service on your web site or location."

7. Decision

The Panel has found the Respondent knowingly registered a domain name identical to the Complainant's Playboy Online mark and confusingly similar to the Complainant's other Playboy marks. The Panel did not find the Respondent had any legitimate rights or interests in the disputed domain name. And finally, the Panel has found the Respondent registered and is using the domain name in bad faith in violation of the Policy at 4 b(iv) because the Respondent is using the disputed domain name website to sell products that the public also would expect the Complainant to sell.

Pursuant to ICANN Policy para 4(i) and Rule 15, the Panel orders that the disputed domain name, <playboyonline.com>, be transferred from the Respondent, the Tonya Flynt Foundation, to the Complainant, Playboy Enterprises International, Inc.

Dennis A. Foster
Presiding Panelist

Peter L. Michaelson
Panelist

Richard Allan Horning
Panelist

Dated: November 16, 2001