



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Sookwan Park

Case No. D2001-0778

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 Sookwan Park, residing at 106-1509 Siyoung APT Chunggye-dong Nowon-gu, Seoul, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name in this proceeding is <playboysportsbooks.com>.

The Registrar is Netpia.com, Inc., Republic of Korea.

3. Procedural History

The Complaint submitted by the Complainant, Playboy Enterprises International, Inc., was received by e-mail on June 13, 2001, and in hardcopy on June 14, 2001, by the WIPO Arbitration and Mediation Center (the *Center*). An acknowledgment of receipt was sent by the Center to the Complainant on June 14, 2001.

On June 19, 2001, a Request for Registrar Verification was transmitted to the Registrar, Netpia.com, Inc. ("*Netpia*") requesting it to: (1) confirm that a copy of the Complaint was sent to the Registrar by the Complainant, as required by WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the *Supplemental Rules*), Paragraph 4(b); (2) confirm that the domain name at issue is registered with Netpia; (3) confirm that the person identified as the Respondent is the current registrant of the domain name; (4) provide the full contact details (i.e., postal address(es), telephone number(s), facsimile number(s), e-mail address(es)) available in the Registrar's Whois

database for the registrant of the disputed domain name, the technical contact, the administrative contact and the billing contact; (5) confirm that the Uniform Domain Name Dispute Resolution Policy (the *Policy*) applies to the domain name; (6) indicate the current status of the domain name; (7) indicate the specific language of the registration agreement as used by the registrant for the disputed domain name; (8) indicate whether the domain name registrant has submitted in its Registration Agreement to the jurisdiction at the location of the principal office of the Registrar for court jurisdiction of disputes concerning or arising from the use of the domain name.

On June 22, 2001, Netpia confirmed by reply e-mail that the domain name <playboysportsbooks.com> is registered with Netpia and that the Respondent was the current registrant of the domain name. The Registrar also forwarded the requested Whois details and, also, confirmed the applicability of the Policy to the domain name at issue. Especially, the Registrar indicated that the registration agreement had been made in Korean.

In accordance with Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*) and Paragraph 5 of the Supplemental Rules, the Center has verified that the Complaint satisfies the formal requirements of the Policy, Rules and Supplemental Rules. A Formal Requirements Compliance Checklist was completed by the assigned WIPO Center Case Manager on July 10, 2001. The Panel has independently determined and agrees with the assessment of the Center that the Complaint is in formal compliance with the requirements of the Policy, the Rules, and the Supplemental Rules. Payment in the required amount to the Center has been made by the Complainant.

No formal deficiencies having been recorded, on July 10, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") was transmitted to the Respondent (with copies to the Complainant, Netpia and ICANN), setting a deadline of July 29, 2001, by which the Respondent could file a Response to the Complaint. The Commencement Notification was transmitted to the Respondent by e-mail, facsimile, and post/courier in accordance with the contact details indicated in the Complaint and specified in Netpia's Whois confirmation.

No Response was filed within the time specified by the Rules. On September 3, 2001, the Center gave formal notice of the Respondent's default.

On September 17, 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 October 1, 2001.

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. 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.

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

On February 19, 2001, the Respondent registered the domain name <playboysportsbooks.com>. The web addresses corresponding to the disputed domain name resolve to a website which does not provide a substantial amount of information nor any significant service.

5. Parties' Contentions

A. Complainant

Identity or confusing similarity

The disputed domain name is identical to the Complainant's trademark PLAYBOY SPORTSBOOK.COM. The disputed domain name also is identical to the Complainant's website address <www.playboysportsbook.com>. The disputed domain name is also confusingly similar to the Complainant's famous mark PLAYBOY. Thus, the disputed domain name is 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 the disputed domain name. The Respondent's registration of the disputed domain name and use of the domain name causes or is likely to cause consumer initial interest confusion.¹

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 name in connection with a *bona fide* offering of goods or services. The Respondent does not have trademark registrations for "playboysportsbooks" and could not obtain registrations because the Complainant's marks belong and is registered to the Complainant.

¹ For the concept of "initial interest confusion," see *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999).

The Respondent has not made a legitimate non-commercial or fair use of the disputed domain name.

Bad faith

The Respondent's misappropriation of the disputed domain name is no accident. The Respondent registered the disputed domain name just four days 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 name with the bad faith intent of profiting from the Complainant and its famous PLAYBOY marks.

The Complainant learned that Respondent had registered the domain name <playboysportsbooks.com> when Respondent sent an e-mail to the Complainant on February 23, 2001, offering to negotiate the terms of the release or transfer of the disputed domain name. Especially, the Respondent demanded payment of \$1,000 in return for the transfer of the disputed domain name in an e-mail dated April 12, 2001.

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 name. 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."

The fact that the only link or information on the Respondent's website is his email address next to the tag line "contact me" implies to the Internet users that the domain name is for sale. That implication is confirmed by the Respondent's active solicitation of \$1000 from the Complainant in exchange for transferring the domain name. Even if the Respondent had not used the domain name to host an active website, his action still constitutes registration and use in bad faith.

B. The Respondent

No Response was filed.

6. Discussion and Findings

Language of the Proceeding

According to Paragraph 11 of the Rules for Domain Name Dispute Resolution Policy ("Rules"), the language of the administrative proceeding shall be the language of the Registration Agreement, which is Korean language in this case. Given the fact that Para. 11 of the Rules is designed to provide the Respondent with a fair opportunity to present its case and the fact that the Respondent has insisted upon the communication to him to be made in Korean rather than in English, the relevant communications between the Case Manager and the Respondent shall be made in Korean and, fortunately, the Case Manager in this case No. D2001-0778 did so accordingly. On the other hand, one of the panelists does not understand Korean language and, probably, all three panelist candidates on the list provided by the Complainant may not understand Korean

language. Thus, forcing panelists to use Korean language may sound unfair to the Complainant. Although the language of the administrative proceeding shall be the language of the Registration Agreement, it is subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. With all the above circumstances in mind, the administrative panel decides that all the communications between the WIPO Center and the Parties be made in Korean and, on the other hand, that the remainder of the administrative proceeding including panel decision be made in English.

Identical or confusing similarity as between the domain name and trademarks

According to Paragraph 4(a) of the Policy, the Complainant must prove **each** of the following:

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

Essential or virtual identity is sufficient for the purposes of the Policy.² The test of confusing similarity under the Policy can be confined to a consideration of the disputed domain name and the trademark.³

Here the 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.⁴ Thus, the panel finds that the disputed domain name is confusingly similar to the Complainant's famous registered trademark PLAYBOY.

Having ignored the plural suffix "s" of the domain name <playboysportsbooks.com>, the panel also finds the disputed domain name is virtually identical to the Complainant's common law trademark PLAYBOY SPORTSBOOK.COM.⁵

² 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").

³ *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).

⁴ *The Stanley Works and Stanley Logistics, Inc v. Cam Creek Co., Inc* (WIPO Case No. D2000-0113) and *Nokia Corporation v. Nokiagirls.com* (WIPO Case No. D2000-0102), *Canon Kabushiki Kaisha v. Price-Less Inkjet Cartridge Company* (WIPO Case No. D2000- 0878).

⁵ *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v. S&S Enterprises Ltd.* (WIPO Case No. D2000-0802).

Respondent's rights or legitimate interests in the domain name

The Complainant has not authorized the Respondent to use its trademarks nor to register the disputed domain names. The Respondent is not known by the disputed domain name. The Respondent cannot have been unaware of the renown of the PLAYBOY mark when it registered the disputed domain name⁶.

It is clear from the Center's printout of the disputed Webpage that the Respondent is not operating an active website under the disputed domain name. The fact that the only link or information on the Respondent's website is his email address next to the tag line "contact me" indicates that the domain name is not for offering bona fide services but only for sale. Mere assertions by the Respondent of preparation or nominal preparations to use the domain name are not enough to entitle the Respondent to the domain name.⁷ Furthermore, the Respondent's active solicitation of \$1000 from the Complainant in exchange for transferring the domain name overcomes his assertion of rights or legitimate interest in the domain name by way of his use or demonstrable preparations.⁸ Accordingly, the panel finds the Respondent has no rights or legitimate interest in the disputed domain name.

Bad faith on the part of the Respondent

Copy of the emails sent by the Respondent (Exhibits L and N attached to the Complaint) clearly shows that there was reiterated offer by the Respondent to sell his domain name for an amount in excess of out-of-pocket expenses directly related to the domain name, being a circumstance of evidence of bad faith registration and use pursuant to paragraph 4(b)(i) of the Policy. Similar cases have been held to be classic cases of cybersquatting.⁹

A finding of bad faith may also be made where the Respondent "knew or should have known" of the registration and use of the trademark prior to registering the domain name.¹⁰ The panel has found that the Respondent must have known the PLAYBOY mark before it registered the domain name. 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 the domain name registration.

⁶ For a similar case see *A.P. Møller v. Web Society* (WIPO Case No. D2000-0135).

⁷ *World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles* (WIPO Case No. D2000-1306); *Helen Fielding v. Anthony Corbert aka Anthony Corbett* (WIPO Case No. D2000-1000).

⁸ *United Feature Syndicate, Inc. v. All Business Matters, Inc.* (WIPO Case No. D2000-1001).

⁹ *The British Broadcasting Corporation v. Jaime Renteria, Case No. D2000-0050 and CBS Broadcasting, Inc. v. Gaddoor Saidi* (WIPO Case No. D2000-0243).

¹⁰ *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).

7. Decision

- a) In light of the foregoing, the Panel decides that the Complainant has proven each of the three elements in paragraph 4(a) of the Policy in relation to the domain name <playboysportsbooks.com>.
- b) Pursuant to paragraph 4 of the Policy and paragraph 15 of the Rules, the Panel requires that the Registrar, Netpia.com, Inc., transfer the domain name <playboysportsbooks.com > to the Complainant, Playboy Enterprises International, Inc.

Sang Jo JONG
Presiding Panelist

Peter L. Michaelson, Esq.
Panelist

Boh Young HWANG, Esq.
Panelist

Dated: October 1, 2001



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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 the disputed domain name. The Respondent's registration of the disputed domain name and use of the domain name causes or is likely to cause consumer initial interest confusion.¹

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 name in connection with a *bona fide* offering of goods or services. The Respondent does not have trademark registrations for "playboysportsbooks" and could not obtain registrations because the Complainant's marks belong and is registered to the Complainant.

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B. The Respondent

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6. Discussion and Findings

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Having ignored the plural suffix "s" of the domain name <playboysportsbooks.com>, the panel also finds the disputed domain name is virtually identical to the Complainant's common law trademark PLAYBOY SPORTSBOOK.COM.⁵

² 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").

³ *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).

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Respondent's rights or legitimate interests in the domain name

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⁷ *World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles* (WIPO Case No. D2000-1306); *Helen Fielding v. Anthony Corbert aka Anthony Corbett* (WIPO Case No. D2000-1000).

⁸ *United Feature Syndicate, Inc. v. All Business Matters, Inc.* (WIPO Case No. D2000-1001).

⁹ *The British Broadcasting Corporation v. Jaime Renteria, Case No. D2000-0050 and CBS Broadcasting, Inc. v. Gaddoor Saidi* (WIPO Case No. D2000-0243).

¹⁰ *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).

7. Decision

- a) In light of the foregoing, the Panel decides that the Complainant has proven each of the three elements in paragraph 4(a) of the Policy in relation to the domain name <playboysportsbooks.com>.
- b) Pursuant to paragraph 4 of the Policy and paragraph 15 of the Rules, the Panel requires that the Registrar, Netpia.com, Inc., transfer the domain name <playboysportsbooks.com > to the Complainant, Playboy Enterprises International, Inc.

Sang Jo JONG
Presiding Panelist

Peter L. Michaelson, Esq.
Panelist

Boh Young HWANG, Esq.
Panelist

Dated: October 1, 2001