



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International, Inc. v. Zeynel Demirtas**

**Case No. D2007-0768**

#### **1. The Parties**

The Complainant is Playboy Enterprises International, Inc., of Chicago, Illinois, United States of America, represented by Howard, Phillips & Andersen, United States of America.

The Respondent is Zeynel Demirtas, of Mersin, Turkey, represented by Hakan Coskuner, Turkey.

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

The disputed domain name <playboyturkey.com> is registered with Directi Internet Solutions d/b/a PublicDomainRegistry.Com.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 25, 2007. On May 26, 2007, the Center transmitted by email to Directi Internet Solutions d/b/a PublicDomainRegistry.Com a request for registrar verification in connection with the domain name at issue. On June 5, 2007, Directi Internet Solutions d/b/a PublicDomainRegistry.Com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 5, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was June 25, 2007. The response was filed with the Center June 22, 2007.

The Center appointed Manoel J. Pereira dos Santos, Peter L. Michaelson and Dilek Ustun as panelists in this matter on August 9, 2007. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

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

The trademark upon which the Complaint is based is PLAYBOY. According to the documentary evidence and contentions submitted, Complainant owns a number of trademark registrations for the PLAYBOY trademark in the United States of America and around the world, including Turkey. The PLAYBOY trademark was first registered in the United States of America under No. 600,018 in 1954. Reference is made to Exhibits B, C and D to the Complaint.

According to the documentary evidence and contentions submitted, Complainant is one of the leading international multimedia entertainment companies and offers a variety of multimedia entertainment for adult audiences. Complainant is well known as the publisher of the *Playboy* magazine, launched in 1954 and one of world's best selling men's magazines.

The PLAYBOY brand name and trademark are highly recognizable and famous, as acknowledged by various prior WIPO UDRP decisions. *Playboy Enterprises International Inc. v. Concas aka Smith.*, WIPO Case No. D2001-0745; *Playboy Enterprises International Inc. v. Asia Sun*, WIPO Case No. D2005-0767; *Playboy Enterprises International Inc. v. Pitts*, WIPO Case No. D2006-0675.

The Respondent registered the disputed domain name on July 20, 2006. On December 5, 2006 Complainant sent a cease and desist letter to Respondent as per Exhibit E to the Complaint. Upon launching the website to which the domain name at issue resolves, Respondent placed announcements advising of Complainant's objections and stating that he "carried out with the idea that it would make a lot of money in the future". Reference is made to Exhibits F, G, H, I and J to the Complaint.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that the domain name <playboyturkey.com > incorporates the famous PLAYBOY trademark by adding only the geographic qualifier "Turkey" and, relying on prior WIPO UDRP decisions, argues that the disputed domain name is functionally identical and confusingly similar to Complainant's PLAYBOY trademark.

Complainant further contends that Respondent does not have legitimate rights or interests regarding the disputed domain name because (i) Respondent is not commonly known by the disputed domain name and has not been authorized by Complainant to use the PLAYBOY marks; (ii) Respondent posted news articles on his website according to which erotic content was initially included in his website and Respondent would demand payment for releasing the disputed domain name; (iii) Respondent's registration of the disputed domain name is an infringement of the PLAYBOY trademark under both the U.S. and Turkish laws and, thus, prevents Respondent from claiming that he has any legitimate rights in the disputed domain name; and

(iv) Respondent's use of the website to display information about his dispute with Complainant does not constitute a legitimate use.

Complainant further contends that the bad faith of Respondent in registering the disputed domain name results from the notoriety of PLAYBOY marks even without considering how, or whether, the domain name has been used. Relying on previous WIPO UDRP decisions, Complainant argues that Respondent knew of the existence of Complainant's trademark in view of the considerable fame of the PLAYBOY name and contends that this principle has been applied to Respondent residing in Turkey. Complainant also argues that Respondent, as reflected in his own statements to the media, registered the disputed domain name to profit from the fame of the PLAYBOY marks either by selling erotic content in competition with Complainant or by selling the domain name itself to Complainant. Finally, Complainant contends that Respondent's provision of false or inaccurate contact information is also evidence of bad faith.

## **B. Respondent**

Respondent argues that all WIPO UDRP precedents invoked by Complainant involve commercial entities or contents of respondents' websites which were confusingly similar to Complainant's website or other materials. Respondent contends that he is not engaged in business activities, that he has purchased the disputed domain name for personal purposes only, and that the website to which the domain name at issue resolves contains personal material only. In addition, Respondent argues that the PLAYBOY trademark is owned in Turkey by three companies other than the Complainant, and that the Playboy Magazine is not published in Turkey.

Respondent further contends that the disputed domain name is not identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Respondent also argues that there is no commercial competition with Complainant because the content of Respondent's website is exclusively individual, and that Respondent is making a legitimate non-commercial or fair use of the domain name at issue without intent for commercial gain misleadingly to divert consumers or to tarnish the PLAYBOY trademark.

Finally, Respondent argues that the disputed domain name was not registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant. Respondent denies that the domain name at issue was registered in an intentional attempt to disrupt the Complainant's business or to attract for commercial gain Internet users to the Respondent's website or other on-line location.

## **6. Discussion and Finding**

### **A. Identical or Confusingly Similar**

The Panel concurs with the opinion of several prior WIPO UDRP panels which have held that, when a domain name wholly incorporates a complainant's registered mark, that may be sufficient to establish confusing similarity for purposes of the Policy. *See, e.g. Hitachi, Ltd. v. Arthur Wrangle, supra. Oki Data Americas, Inc. v. ASD, Inc.,* WIPO Case No. D2001-0903; *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.,* WIPO Case No. D2000-1525; *Eauto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.,* WIPO Case No. D2000-0047; *Bayerische Motoren Werke AG v. bmwcar.com,* WIPO Case No. D2002-0615.

That is particularly true where the trademark is highly recognizable and famous, as in the instant case. In the disputed domain name the PLAYBOY trademark stands out and leads the public to think that the disputed domain name is somehow connected to the owner of the registered trademark. *Utensilerie Associate S.p.A. v. C & M*, WIPO Case No. D2003-0159.

In addition, the Panel also concurs with the finding of previous WIPO UDRP panels that the use of a famous mark in its entirety together with a geographic term in a domain name creates a domain name that is confusingly similar to the famous mark. See e.g., *Playboy Enterprises International Inc. v. Melancia*, WIPO Case No. D2006-1106; *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. D2000-0553; *Six Continents Hotels, Inc. v. CredoNic.com / Domain Name for Sale*, WIPO Case No. D2005-0755; *Six Continents Hotels, Inc. v. Midas Search Limited*, WIPO Case No. D2004-0986; *Six Continents Hotels, Inc. Inter-Continental Hotels Corporation. v. South East Asia Tours*, WIPO Case No. D2004-0388.

Also, the addition of the suffix “.com” is non-distinctive because it is required for the registration of the domain name. *RX America, LLC v. Matthew Smith*, WIPO Case No. D2005-0540; *Sanofi-Aventis v. US Online Pharmacies*, WIPO Case No. D2006-0582. Finally, Respondent has brought no argument in support of his contention that the disputed domain name is not identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Therefore, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is met.

#### **B. Rights or Legitimate Interests**

Complainant basically contends that Respondent does not have legitimate rights or interests regarding the disputed domain name because Respondent’s registration of the disputed domain name is an infringement of the PLAYBOY trademark under both the U.S. and Turkish laws, and that Respondent’s use of the website to display information about his dispute with Complainant does not constitute a legitimate use. Complainant also reports material formerly displayed on Respondent’s website with references to the possible generation of “a lot of money in the future”.

The essence of Respondent’s defense is the argument that Respondent is not engaged in business activities and that the website to which the disputed domain name resolves contains personal material only. Therefore, Respondent would be making a legitimate non-commercial or fair use of the domain name at issue without intent for commercial gain.

As a result of an independent access to the “playboyturkey.com” website, the Panel notes that Respondent has announced that the website is closed during the dispute between Complainant and Respondent. The Panel is of the opinion that such action on the part of Respondent is irrelevant for the decision of the Panel on the instant case. Complainant has provided copies of material previously posted on Respondent’s website, and Respondent did not deny such facts.

The critical element in finding whether Respondent may have a legitimate right or interest in the disputed domain name requires a determination of whether or not Respondent may validly argue that such domain name is “used for purely private purposes”. There are several factors which should be considered in that determination.

First, the Panel believes that Respondent has chosen the contested domain name to profit from the notoriety of the PLAYBOY trademark and from the traffic generated by the likely initial expectations of users who access a website containing the combination of the famous PLAYBOY trademark plus the geographic term “Turkey”.

Second, Respondent has not advanced any sound reason for choosing and using such a combination for “purely private purposes”. The fact that there is no commercial competition with Complainant does not mean that Respondent is making a non-commercial or fair use of the domain name because the disputed domain name creates an immediate potential for false association with the Complainant and a high degree of initial confusion.

Third, Respondent’s use of the famous PLAYBOY name in a domain name is an infringing use of Complainant’s trademark because the PLAYBOY trademark enjoys broad protection in light of its notoriety. An infringing use of complainant’s trademark can not give rise to a legitimate right or interest on the part of respondent, as prior WIPO UDRP Panels have ruled. See, e.g., *The Chase Manhattan Corp. v. Whitely*, WIPO Case No. D2000-0346. In *Chanel, Inc. v. Cologne Zone*, WIPO Case No. D2000-1809, the panel held that *bona fide* use does not exist when the intended use is a deliberate infringement of another’s rights. That ruling applies equally in the instant case. There is clear evidence that Respondent intends to infringe Complainant’s trademark rights and take advantage of the notoriety associated with the PLAYBOY name.

In light of the foregoing, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is met.

### **C. Registered and Used in Bad Faith**

Most of Complainant’s contentions to support the proposition that the disputed domain name has been registered and used in bad faith have already been addressed by the Panel. In fact, the Panel has accepted Complainant’s contention that Respondent could not have ignored the existence or the reputation of the PLAYBOY trademark and has found that, since Respondent formed the disputed domain name by adding a geographic term to a widely known trademark, Respondent’s motivation was to take advantage of the prestige of the PLAYBOY trademark.

The Panel has also found that the disputed domain name creates an immediate potential for false association with the Complainant and a high degree of initial confusion. As a result, the Panel concludes that Respondent registered the disputed domain name in bad faith.

The Panel takes further the view that the content of a website is relevant in the finding of bad faith registration and use. The materials extracted from Respondent’s website and produced by Complainant indicate that Respondent registered the disputed domain name to profit from the fame of the PLAYBOY marks either by selling the erotic content in competition with Complainant or by selling the domain name itself to Complainant.

As decided in a previous WIPO UDRP decision, “[t]he proper test in this Panel’s view is whether the objective consequence or effect of the Respondent’s conduct is to free-ride on the Complainant’s goodwill, whether or not that was the primary (subjective) intent of the Respondent. In light of the above, the Panel concludes that knowledge of the mark at the time of registration followed by use in commerce without

a legitimate interest and likely to create confusion (and thus allow the Respondent to free-ride on the Complainant's goodwill), is the proper test". See *Paule Ka v. Paula Korenek*, WIPO Case No. D2003-0453.

Accordingly, the Panel concludes that Respondent is also using the disputed domain name in bad faith. Therefore, the Panel finds that the requirement of paragraph 4(a)(iii) of the Policy is met.

## 7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <playboyturkey.com> be transferred to the Complainant.

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Manoel J. Pereira dos Santos  
Presiding Panelist

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Peter L. Michaelson  
Panelist

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Dilek Ustun  
Panelist

Dated: August 23, 2007