

## **ADMINISTRATIVE PANEL DECISION**

LFP IP, LLC v. BBE Group

Case No. D2012-0562

### **1. The Parties**

The Complainant is LFP IP, LLC of Beverly Hills, California, United States of America, represented by Lipsitz Green Scime Cambria, LLP, United States of America.

The Respondent is BBE Group of Southfield, Michigan, United States of America.

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

The disputed domain name <hustlerxxx.net> is registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 30, 2009 and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 14, 2009 (the "Supplemental Rules").

The Complaint (with accompanying Annexes 1 to 6) was filed with the WIPO Arbitration and Mediation Center (the "Center") by e-mail on March 19, 2012.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this UDRP administrative proceeding. Through the Complaint, the Complainant requested a single-member panel.

On March 20, 2012, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in that Complaint relative to the disputed domain name, and whether the disputed domain name is indeed registered with the Registrar. The Center also requested the Registrar to specify: (a) the dates on which the registrant registered that disputed domain name (or acquired the registration) and when the registration will expire, (b) whether the Policy applies to the disputed domain name, (c) the language of the registration agreement and (d) for confirmation that the disputed domain name will remain "locked" during the

proceeding.

Subsequently, on March 20, 2012, the Registrar responded to the Center through which the former stated that it had received a copy of the Complaint, confirmed it is the registrar for the disputed domain name, confirmed that the named respondent on the Complaint, as filed, is the actual registrant of the disputed domain name, and provided contact information pertinent to the disputed domain name to the extent, as it then existed, in its Whois database. The Registrar's response further indicated that: (a) the disputed domain name was registered on March 25, 2011, (b) the registration will expire on March 25, 2013, (c) the Policy applies to the disputed domain name, (d) the registration agreement is in English and (e) the disputed domain name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On March 22, 2012, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by e-mail together with the Center's "Written Notice of the Commencement of Administrative Proceeding", the notice also being sent by post/courier. The Complaint and its accompanying documents were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on March 22, 2012, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondences, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on April 11, 2012 to file its Response with the Center and the Complainant.

As of April 11, 2012, the Center had not received a formal Response to the Complaint from the Respondent. Hence, the Center, in an email letter dated April 12, 2012, notified the Respondent of its default.

Pursuant to the Rules and Supplemental Rules, by e-mail letter dated April 18, 2012, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as the sole panelist for this dispute. Later the same day, Mr. Michaelson accepted. Subsequently on April 21, 2012 and pursuant to the requirements of paragraph 7 of the Rules, he returned by e-mail attachment to the Center a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter on April 23, 2012 notified the Parties of the appointment of Mr. Michaelson as sole Panelist. The Panel finds that it was properly constituted.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel before May 7, 2012. However, due to exceptional circumstances recently experienced by the Panel, the Panel extended the deadline to May 14, 2012.

This dispute concerns one domain name, specifically <hustlerxxx.net>.

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

According to the public Whois database appearing in Annex 1 to the Complaint, the disputed domain name was registered to the Respondent on March 25, 2011 and is set to expire on March 25, 2013.

The Complainant owns 154 United States and counterpart foreign trademark registrations for the term “hustler”, appearing by itself or with additional textual terms such as “xxx”, both in block letter and stylized form. In Annex 5 to the Complaint, the Complainant has provided entries for some of its United States registrations, for its marks HUSTLER and HUSTLER XXX, from the TESS (Trademark Electronic Search System) database publicly available through the website of the United States Patent and Trademark Office. Pertinent details of a sample of these registrations are as follows:

1. HUSTLER (block letters)  
United States registration no. 1,011,001  
registered: May 20, 1975; filed: May 6, 1974  
renewed: August 16, 2004

This mark is registered for use in connection with: “entertainment magazine”, in international class 16. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of January 1, 1972.

2. HUSTLER XXX (stylized)  
United States registration no. 2,448,315  
registered: May 1, 2001; filed: May 20, 1999  
renewed: February 15, 2011

This mark is registered for use in connection with: “publications, namely an adult entertainment magazine”, in international class 16. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of September 21, 1999.

3. HUSTLER XXX (block letters)  
United States registration no. 2,453,938  
registered: May 22, 2001; filed: June 22, 1999  
renewed: May 17, 2011

This mark is registered for use in connection with: “pre-recorded discs in the field of adult entertainment”, in international class 9. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of April 4, 2000.

## **B. Complainant**

The HUSTLER-based marks have been used by the Complainant, its affiliates, its licensees and/or its predecessors-in-interest for approximately 40 years. The Complainant with its affiliates is currently a large manufacturer, wholesaler and retailer of adult entertainment goods and services in the United States and throughout much of the world.

The mark HUSTLER was first used in connection with a string of gentlemen’s clubs called the “Hustler Club” and an adult entertainment newsletter entitled “Hustler.” By 1972, this mark was being used in commerce in connection with Hustler magazine, a full-length men’s periodical with national distribution.

Over the ensuing decades, the Complainant’s business conducted under its HUSTLER-based marks has expanded to include, among other things: adult video production, on-line versions of all Hustler content and a TV/video-on-demand service providing access to Hustler videos and other LFP content.

By 1998, the Complainant was also using the mark HUSTLER in connection with a chain of adult-themed retail-stores called “HUSTLER HOLLYWOOD RETAIL”. Presently, these stores are located in, e.g.: Los Angeles, CA; San Diego, CA; Ft. Lauderdale, FL; Lexington, KY; New Orleans, LA; St. Louis, MO; Monroe, MO; Nashville, TN; Tacoma, WA; and Las Vegas, NV.

Further, Hustler Clubs are now present in various locations from New York City to Paris. A casino bearing

the mark HUSTLER exists in the Western United States. Also, a clothing line, Hustler apparel, provides hundreds of HUSTLER-branded and originally-designed items including, e.g., shirts, shorts, hats, lingerie, infant and toddler wear. In addition to its physical stores, the Complainant has created an online marketplace, the "Hustler Store" (<hustlerstore.com>), where it offers HUSTLER-branded products, including: DVDs, adult toys & novelties, books, magazines and subscriptions, lingerie, bath and body products.

### **C. Respondent**

A copy of a screen shot of the home page of the Respondent's website, to which the disputed domain name resolves, appears in Annex 6 to the Complaint. This page has essentially the same format and some of the same artwork as on the Complainant's websites. For example, the top of the home page of the Respondent's site contains text in bold letters reading: "HUSTLER XXX OFFICIAL SITE - HUSTLER MAGAZINE PORN FREE DVD XXX HUSTLER VIDEO." The top left-hand corner of the same page displays the mark HUSTLER including the trademark registration symbol(®). The upper-right hand corner of the same page contains a stylized "Larry Flynt" signature which is also used on various products provided by the Complainant.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark HUSTLER because the name contains the formative term "hustler" to which the generic term "xxx" has been appended. Addition of the letters "xxx" fails to provide any distinctiveness to the disputed domain name that would sufficiently abate confusion of Internet users, as that term, when used as here as a suffix, is generally understood to mean pornography or adult-sexually-explicit content. Furthermore, the name completely incorporates the Complainant's mark HUSTLER XXX.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent has used the name in connection with offering, through its website, the same goods or services as the Complainant does and under the Complainant's mark HUSTLER. In that regard, the website includes the term HUSTLER in a large font at the top of the page, the phrases "#1 in Adult Entertainment", "HUSTLER XXX OFFICIAL SITE " and "HUSTLER MAGAZINE PORN FREE DVD XXX HUSTLER VIDEO" - all without authorization from the Complainant and in violation of the Complainant's exclusive trademark rights in its HUSTLER-based marks.

Second, the Respondent is not commonly known by the domain name nor has it acquired any rights in the term "Hustlerxxx" or could it have done so as those rights, by virtue of the Complainant's registrations, lie solely with the Complainant.

#### **(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Given the long-use associated with and the ensuing fame achieved by the Complainant's HUSTLER-based marks, the Respondent knew or should have known that the name included the Complainant's mark HUSTLER. This view is bolstered by the fact that the name, by inclusion of the term "xxx", merely describes goods and services already offered by the Complainant and made available to consumers through the Complainant's websites at <hustlertv.com>, <hustlerhd.com> and <hustlervideo.com>. Accordingly, the Respondent registered the name with the intent of attracting Internet users for commercial gain by creating, through the name, a likelihood of confusion with the Complainant's marks as to source, sponsorship, affiliation or endorsement.

The fact that the name is identical to the Complainant's mark HUSTLER XXX is not sheer coincidence but rather an intentional act of the Respondent through which the latter is attempting to divert, from the Complainant and to the Complainant's detriment, consumers of adult video, TV, cable and/or video-on-demand to the Respondent instead. In that regard, the Respondent's website copies the format and some of the artwork contained on the Complainant's websites. Specifically and illustratively, the top of the home page of that site states in bold lettering "HUSTLER XXX OFFICIAL SITE - HUSTLER MAGAZINE PORN FREE DVD XXX HUSTLER VIDEO". At the top left-hand corner, the website displays the mark HUSTLER, including the registration symbol. Further, in the upper right-hand corner of the page, that page features a stylized signature of "Larry Flynt" who is the owner of the HUSTLER-based marks and the proprietor of the Complainant. Thus, the Respondent is clearly trading on the reputation and goodwill of the Complainant's HUSTLER brand and the Larry Flynt name.

## **B. Respondent**

The Respondent failed to file any Response to the contentions raised in the Complaint.

## **6. Discussion and Findings**

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

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

The Panel finds that the disputed domain name is, for all practical purposes, identical or, at worst, confusingly similar to the Complainant's marks HUSTLER and HUSTLER XXX.

From a simple comparison of the name to the Complainant's mark HUSTLER XXX, no doubt exists that the domain name is essentially identical to the Complainant's mark. In particular, the name <hustlerxxx.net>, apart from and the omission of a space between the terms "hustler" and "xxx" and its inclusion of the generic top level domain (gTLD) .net, is otherwise identical to the mark. The omission of a space in this instance is completely irrelevant. Further, the addition of the gTLD is irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. See *Kayak Software Corporation v. KAYAK.travel*, *KAYAK.travel Corporation*, *Kayak Las Vegas, LLC*, WIPO Case No. D2011-0425 and *Photo Tour Books, Inc. d/b/a PhotoSecrets v. Beate Chelette*, WIPO Case No. D2010-1373.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

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

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

There are no facts of record indicating that the Complainant has ever authorized the Respondent to utilize

any of the HUSTLER-based marks in conjunction with any of the goods and services in conjunction with which the Complainant uses any of those marks, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's mark HUSTLER, HUSTLER XXX or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Amy Stran v. EzDomainSearch.com*, *Juan Curtis*, WIPO Case No. D2011-1710; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc.*, v. *GoDaddysDomain.com*, *Clark Signs*, *Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, supra; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. 173362; *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited supra; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between it and the mark HUSTLER, HUSTLER XXX or even any mark similar thereto, at least for the goods and services provided by the Complainant under its marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark HUSTLER or a similar mark. Nor could the Respondent likely ever become commonly known by either the disputed domain name or any of the Complainant's HUSTLER-based marks without detriment to the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights, particularly to the mark HUSTLER which dates back to 1972 some 39 years prior to when the Respondent registered the disputed domain name in 2011, and the widespread and substantial reputation, notoriety and fame which the Complainant has gained in its mark HUSTLER ever since. See, e.g., *Amy Stran v. EzDomainSearch.com*, *Juan Curtis*, supra, *Starline Publications Inc. v. Texas International Property Associates*, WIPO Case No. D2008-1824..

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy. Moreover, the facts of record do not indicate that the Respondent's actions qualify under either paragraph 4(c)(i) or 4(c)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraphs 4(a)(ii) and 4(c) of the Policy.

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

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

There can be little, if any, doubt that the Respondent was well aware of the Complainant's marks HUSTLER and HUSTLER XXX before the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the domain name in an effort to opportunistically exploit the Complainant's reputation and goodwill in those marks to what most likely would have been the Complainant's detriment. This is plainly evident from the significant commonalities existing between the Complainant's website and that of the Respondent coupled with the latter site containing a replica of the signature of Larry Flynt, the owner of both the Complainant and the HUSTLER-based marks, which also exists on various products sold by the Complainant. See, e.g., *American Medical Software v. Belize Domain WHOIS Service Lt*, WIPO Case No. D2010-1004.

The Respondent, having effectively misappropriated the Complainant's goodwill and reputation in its marks,

caused confusion in the mind of Internet users, who likely sought the Complainant's website, by falsely suggesting to those users that the Respondent had some type of an affiliation or relationship with the Complainant - when in fact the Respondent did not. The Panel infers that the Respondent's intent in causing this confusion, by registering and subsequently using the name as it did, was to divert Internet traffic, including potential and existing customers, away from the Complainant's site and to the Respondent's site instead. By doing so, the Respondent was able to offer products and services directly competitive with those of the Complainant which, as a result, denied the Complainant revenue to which it would otherwise have been entitled - revenue that instead went to financially benefit the Respondent at the Complainant's expense.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraph 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <hustlerxxx.net> is ordered to be transferred to the Complainant.

**Peter L. Michaelson**  
Sole Panelist  
Dated: May 10, 2012