



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Good Samaritan Program

Case No. D2001-0241

1. The Parties

Complainant is Playboy Enterprises International, Inc., a Delaware corporation with its principal place of business in Chicago, Illinois, U.S.A. (Playboy).

Respondent is Good Samaritan Program, with an address at 9722 Groffs Mill Dr., Owings Mills, MD 21117, U.S.A (Good Samaritan).

2. Domain Name and Registrar

The domain name in issue is <hughhefner.com>.

The registrar is BulkRegister.com, 7 East Redwood Street, Third Floor, Baltimore, MD 21202 U.S.A. (BulkRegister).

3. Procedural History

The WIPO Arbitration and Mediation Center (the Center) received Playboy's complaint via email on February 14, 2001, and in hard copy on February 16, 2001. The Center verified that the complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy (the Policy), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the Supplemental Rules). Playboy made the required payment to the Center. The formal date of the commencement of this administrative proceeding is February 20, 2001.

On February 19, 2001, the Center transmitted via email to BulkRegister a request for registrar verification in connection with this case. On February 19, 2001, BulkRegister transmitted via email to the Center BulkRegister's confirmation that (1) Good Samaritan is the registrant of the domain name in issue, (2) the Policy applies to the domain name, and (3) the current status of the

domain name is “Register LOCK”.

On February 20, 2001, the Center transmitted Notification of Complaint and Commencement of the Administrative Proceeding, together with a copy of the Complaint, via facsimile to Good Samaritan via email and post/courier. The Center advised that the response was due by March 11, 2001, pointed out the response should be in accordance with specified rules, and described the consequences of a default if the response was not sent by March 11, 2001.

On March 13, 2001, the Center transmitted via email to Good Samaritan Notification of Respondent Default, advising Good Samaritan inter alia (1) it had failed to comply with the deadline for submissions of a response, (2) the Center would proceed with the appointment of an Administrative Panel, (3) the Panel would decide in its discretion whether to consider a response if one were to be submitted later.

On April 2, 2001, the Center advised the parties via email of the appointment of David W. Plant as Presiding Panelist and Frederick M. Abbott and Peter L. Michaelson as Panelists, and that the decision was due April 15, 2001.

On April 25, 2001 the Center advised the parties via email that the decision due date had been postponed by the Presiding Panelist to May 18, 2001. On April 30, 2001, in response to an inquiry from Playboy’s counsel, the Center advised the parties via email that the postponement was due to the schedule of the Presiding Panelist.

4. Factual Background; Parties’ Contentions

a. The Trademark

The complaint is based on the mark HUGH M. HEFNER.

Playboy avers that it is “a worldwide provider of adult lifestyle entertainment” through a wide variety of media, including the Internet.¹ The famous *Playboy* magazine, read by nine million readers per month, was created by Playboy’s founder, Hugh M. Hefner (Hefner). Playboy avers Hefner “was the living embodiment of the lifestyle his magazine celebrated.” Hefner is *Playboy*’s Editor-in Chief, has been a TV personality, has received a publishing award and is in the Hall of Fame of American Society of Magazine Editors.

Playboy avers Hefner “remains one of the most popular media and entertainment figures in the world.” For example, “entering the search query ‘Hugh Hefner’ in the Google.com search engine resulted in a return of more than 20,000 relevant references.”²

¹Playboy asserts that facts averred in its complaint are verified by the Declaration of Michelle A. Kaiser, Annex C to the complaint. Ms. Kaiser is Senior Intellectual Property Counsel for Playboy.

²Playboy cites the declaration of Amy B. Miner, one of its counsel in this matter, in support of this averment. That declaration is at Annex D to the complaint.

Playboy avers that Hefner has granted Playboy “permission to use his name to identify a line of high quality tobacco related products” Since 1996, Playboy and its predecessors have allegedly used HUGH M. HEFNER “in signature form in the United States and beyond to identify premium cigars.”

Playboy has registered HUGH M. HEFNER (signature) on the Principal Register in the United States Patent and Trademark Office (USPTO). A copy of the October 21, 1997 Registration No. 2,107,308 is Exhibit 1 to the Kaiser declaration. As tabulated at Exhibit 2 to the Kaiser declaration, Playboy has registered HUGH M. HEFNER in more than 40 jurisdictions around the world.

In sum, Playboy avers it “owns valid and enforceable trademark rights in and to its mark.”

b. The Complaint Re Respondents’ Activities

Playboy avers that all three elements of Policy 4.(a) are met because:

1. the domain name in issue is identical or confusingly similar to a mark in which Playboy has rights,
2. Good Samaritan has no rights or legitimate interests in the domain name; and
3. the domain name was registered and is being used in bad faith by Good Samaritan.

Good Samaritan registered the domain name <hughhefner.com> with BulkRegister on September 12, 1998. Playboy avers that currently, when the domain name is entered,

“the user is automatically redirected to <http://www.instealthmode.com/inactive>. Thus, [Good Samaritan] is currently using the domain name to host a Web site which states ‘This Domain Is Inactive. For further information, please e-mail us.’ The site then contains a link that opens an e-mail window and allows an Internet user to send an e-mail to [Good Samaritan].”

A copy of the Good Samaritan site appears at Exhibit 3 to the Kaiser declaration.

Playboy avers that until recently Good Samaritan maintained a Web site entitled “DreamSeller Good Samaritan Program” under the domain name <goodsamaritanprogram.com>. A copy of pages from that web site appear at Exhibit 4 to the Kaiser declaration. Playboy avers the domain name currently redirects users to the Internet under the domain name <instealthmode.com>, the same domain name as in the current web site, and whose owner has the same address as Good Samaritan. According to this recent Good Samaritan site, Good Samaritan is “dedicated to fighting domain name piracy.” However, Playboy avers that Good Samaritan is “every bit as much a cybersquatter as the pirates it castigates.”

The recent site refers to Good Samaritan, DreamSeller and The Dream Factory. Playboy avers they are all the same entity. Playboy quotes from the <thedreamfactory.com> web site:

“The Dream Factory is a wholly-owned division of DreamSeller responsible for developing next-generation products, services and businesses. ... Many of our projects have launched and continue to operate ‘in stealth mode’ (confidential) and there are more ‘dreams’ to be dreamt.”

Playboy quotes further from the web site:

“We target many industries by staying focused on subjects that we have an active/direct interest in.”

Playboy notes the first subject on the list of those Good Samaritan has an interest in is “celebrities”. Playboy points out that Good Samaritan (1) owns the domain name <celebritychannel.com> and (2) states it has “previously registered” domain names <donaldtrump.com>, <cindycrawford.com>, <brucewillis.com>, etc.³

Playboy asserts that Good Samaritan registers celebrity domain names for the purpose of attracting celebrities and general Internet traffic to Good Samaritan’s sites “so that it can promote its goods and services to these individuals and solicit investments in [Good Samaritan’s] ventures from them.”⁴

Playboy avers that upon discovering the domain name in issue, Playboy sent to Good Samaritan an email, on February 10, 2000, demanding that Good Samaritan transfer the domain name to Playboy.

A copy of the email is Exhibit 10 to the Kaiser declaration. Playboy asserts that Good Samaritan failed to respond, and accordingly, Playboy sent follow-up letters by email and registered mail (copies at Exhibit 11 to the Kaiser declaration). As shown in Exhibit 11, a representative of Good Samaritan signed for the two copies sent by registered mail. Playboy asserts Good Samaritan never responded.

Playboy contends that it acquired its trademark rights “well prior” to the date Good Samaritan registered the domain name in issue. Playboy asserts that the second-level portion of the domain name is confusingly similar to Playboy’s HUGH M. HEFNER mark, and is “plainly intended” by Good Samaritan to be confusingly similar to Hefner’s name and Playboy’s mark.

Playboy asserts it has no connection with Good Samaritan and has never licensed or consented to Good Samaritan’s use of the domain name in issue. Playboy contends that Good Samaritan’s “recognition of the evils” of cyberpiracy, and its public representations that it registers domain names to “save” them from cyberpirates, are virtual admissions by Good Samaritan that it has no rights or legitimate interests in the domain name in issue.

³In point of fact, the web site states (Exhibit 4 to the Kaiser declaration) those domain names “have been returned to their rightful owners.” It is not clear that Good Samaritan registered those domain names, although the site does state “we try to rescue/secure the names if they are available.”

⁴The recent web site, at Exhibit 4 to the Kaiser declaration, purports to “help celebrities recover their domain names, whether they chose to use the name or not.” The web site notes that sometimes celebrities “can get their domain names back by buying them for \$50,000 - \$1,000,000+ or by contributing to the current owners favorite charities,” states “Our team works hard to rescue and secure domain names for their rightful owners,” reports “we have 142 names on our ‘Hit List’ and the list grows every day,” and declares “we choose not to reveal how we do what we do. Keeping our strategy secret is vital to our success.” Good Samaritan’s site refers also to a “Domain Vault” which, when this section of the site is completed, “will list the many domain names we have secured/rescued that are waiting to be reunited with their rightful owners.” Good Samaritan states it does not charge for its service: “We do it for selected clients and usually ask that they return the favor by linking back to the GSP [Good Samaritan Program] homepage and sending us a thank you letter for our archives.”

Playboy contends that three of the four illustrative circumstances set out in Policy Paragraph 4.(b) exist in this situation and show that Good Samaritan has registered and used the domain name in bad faith.⁵

Playboy turns first to Paragraphs 4.(b)(i) and (iv). Playboy contends that Good Samaritan has registered and is using the domain name to profit from misdirected Internet traffic. Playboy urges that Good Samaritan (1) must have known of the HUGH M. HEFNER mark when it registered the domain name, and (2) admits that it intentionally registers celebrity names -- purportedly to save them, but in reality to assure Good Samaritan "first position" when it comes to cybersquatting on the celebrities' names. Playboy notes that even if Good Samaritan were to claim ignorance of the mark, Playboy's USPTO registration constitutes constructive notice of Playboy's rights under U.S. law. Playboy asserts that Internet users interested in news about Hefner are "certain" to look for such news and information under the domain name <hughhefner.com>. Further, Good Samaritan is allegedly misdirecting such users to a site which encourages the users to contact Good Samaritan, and after such contact is made, Good Samaritan has the opportunity to promote its own services and to solicit investments. Playboy cites WIPO decisions at D2000-0847, D2000-0210 and D2000-0794 to support the assertion that, in similar situations where no plausible explanation exists for adopting a domain name corresponding to the name of a famous entertainer, other Panels have found a violation of the Policy.

Playboy contends that Good Samaritan has violated Paragraph 4.(b)(ii) because Good Samaritan registered the domain name to block Playboy from owning the domain name without dealing with Good Samaritan first -- to Good Samaritan's commercial advantage. Good Samaritan's website "indicates it has engaged in the same conduct with numerous other celebrity names," citing those names referred to supra.

Playboy requests that the domain name in issue be transferred to Playboy.

The complaint concludes with the requisite certification, signed by counsel, that the information in the complaint is complete and accurate.

c. The Default

In light of Good Samaritan's failure to respond, the Panel has elected to decide this dispute based upon the complaint. Rules, Paragraphs 5.(e) and 14.(a).

5. Discussion and Findings

Paragraph 4.(a) of the Policy directs that Playboy must prove, with respect to the domain name in

⁵Playboy mistakenly refers to Paragraph 4.(c) in connection with these contentions. The relevant paragraph is Paragraph 4.(b). Playboy accurately quotes in full from Paragraphs 4.(b)(i), (ii), and (iv).

issue, each of the following:

- (i) The domain name in issue is identical or confusingly similar to a mark in which Playboy has rights, and
- (ii) Good Samaritan has no rights or legitimate interests in respect of the domain name, and
- (iii) The domain name has been registered and is being used in bad faith.

Paragraph 4.(b) of the Policy sets out four illustrative circumstances, any one of which for purposes of Paragraph 4.(a)(iii) above, if proved by a complainant, shall be evidence of a respondent's registration and use of a domain name in bad faith.

Paragraph 4.(c) of the Policy sets out three illustrative circumstances any one of which, if proved by respondent, shall demonstrate respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4.(a)(ii) above.

a. Preliminary Observations

The Panel has assured itself that, in light of the various communications from the Center to Good Samaritan, the parties have been treated with equality and Good Samaritan has been given a fair opportunity to present its case. Rules, Paragraph 10.(b). Accordingly, in the Panel's view, Good Samaritan has been afforded due process.

b. Identity or Confusing Similarity

Playboy has the burden of proving this element and each of the other two elements of Paragraph 4.(a) of the Policy. It is especially important in a default situation that a complainant meet its burden of proof.

Playboy contends that its mark and Good Samaritan's domain name are confusingly similar. Playboy points to Good Samaritan's own statements that its practice has been to acquire celebrity domain names. The domain name in issue is clearly a celebrity domain name associated with the well known creator of and emissary for *Playboy* magazine.

Playboy's stylized word mark, HUGH M. HEFNER, is used without its stylized elements in the disputed domain name. The elimination of the stylized elements is dictated by technical limitations of the domain name system. Because of the close association between the HUGH M. HEFNER signature and the persona of Hefner, it is clear that Internet users viewing the <hughhefner.com> domain name will associate it with Hefner. It is plain on this record that the mark and the domain name are confusingly similar, and indeed, that such confusion must have been intended.

Playboy has carried its burden on this element of Paragraph 4.(a).

c. Rights or Legitimate Interests

Playboy has demonstrated with competent evidence (1) Playboy's ownership of the HUGH M. HEFNER mark, (2) the validity of the mark, (3) value of the mark to Playboy, (4) Playboy's continuous use of the mark since at least July 1996 -- before Good Samaritan registered the domain name, (5) the notice and acclaim associated with the mark, and (4) the lack of any right or interest in the mark or the domain name on the part of Good Samaritan. Good Samaritan's self-anointment as a private attorney general to police the Internet for celebrities falls far short of imbuing Good Samaritan with any right or interest in the HUGH M. HEFNER mark.

The Panel finds that Playboy has met its burden of proof on the second element of Paragraph 4.(a).

d. Registration and Use in Bad Faith

In appropriate circumstances, bad faith registration and use of a contested domain name can be inferred from circumstantial evidence. Both registration in bad faith and use in bad faith must be proved by Playboy. The Panel finds that Playboy has proven that Good Samaritan's conduct evidences bad faith registration and use under Paragraphs 4.(b)(i) and (iv).

With regard to Paragraph 4.(b)(i), although the consideration Good Samaritan solicits for transfer of domain names back to celebrities may (or may not) involve direct cash payment, it appears from Good Samaritan's own statements that it is seeking substantial consideration in the form of celebrity endorsement or linkage to successful commercial web sites in return for its services.⁶ The Panel concludes that Good Samaritan registered <hughhefner.com> for the purpose of transferring it to Playboy in return for valuable consideration in excess of its costs directly related to the domain name.

With regard to Paragraph 4.(b)(iv), it is beyond any dispute that Good Samaritan has used the domain name intentionally to attract for commercial gain Internet users to Good Samaritan's web site by creating a likelihood of confusion with Playboy's mark HUGH M. HEFNER. Good Samaritan has not hesitated to announce its reliance on numerous celebrity domain names as bait to conduct its business, i.e. to link its "clients" to its homepage, just as it has linked visitors to its <hughhefner.com> site to its homepage.

6. Decision

In light of the findings by the Panel, the Panel decides that Playboy has met its burden of proof with respect to each of the three elements of Policy, Paragraph 4.(a). Accordingly, the Panel requires that the registration Good Samaritan's <hughhefner.com> domain name be transferred to Playboy.

⁶"We do it for selected clients and usually ask that they return the favor by linking back to the GSP [Good Samaritan Program] homepage and sending us a thank you letter for our archives." Exhibit 4 to Kaiser declaration, supra, footnote 4.

David W Plant
Presiding Panelist

Frederick M. Abbott
Panelist

Peter L. Michaelson
Panelist

Dated: May 17, 2001