



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International, Inc. v. John Taxiarchos**

**Case No. D2006-0561**

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

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

The Respondent is John Taxiarchos, Andover, Massachusetts, United States of America.

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

The disputed domain name <playboyatthepalms.com> is registered with eNom, Inc.

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2006. On May 5, 2006, the Center transmitted by e-mail to eNom a request for registrar verification in connection with the domain name at issue. On May 5, 2006, eNom transmitted by e-mail to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the Respondent. 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 May 12, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was June 1, 2006. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 2, 2006.

Complainant elected to have the dispute decided by a 3-member panel.

The Center appointed Douglas M. Isenberg as the presiding panelist and Peter L. Michaelson and Justin Hughes as panelists in this matter on June 30, 2006. The Panel finds that it was properly constituted. Each member of 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

Complainant states that it is “a brand-driven, international multimedia entertainment company, perhaps best known as the publisher of *Playboy* magazine, the world’s best-selling men’s magazine.” Complainant states that it “owns thousands of trademark registrations and active applications for PLAYBOY in the United States and worldwide,” including the following, for which it provided copies of printouts from the U.S. Patent and Trademark Office’s website:

Mark	Reg. No.	Date of First Use in Commerce	Reg. Date
PLAYBOY <sup>1</sup>	769,702	Nov. 11, 1959	May 12, 1964
PLAYBOY	2,631,654	Aug. 29, 2001	Oct. 8, 2002
PLAYBOY	2,482,255	May 2000	Aug. 28, 2001
PLAYBOY’S	1,733,661	Sept. 1985	Nov. 17, 1992
PLAYBOY.COMVERSATION	2,538,068	Nov. 17, 2000	Feb. 12, 2002
PLAYBOYTV CLUB	2,894,179	June 6, 2002	Oct. 19, 2004
PLAYBOY RADIO	2,778,583	Sept. 3, 2002	Oct. 28, 2003

Complainant alleges that the PLAYBOY brand is “one of the most recognized in the world” (citing *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745).

Complainant states that it published the first edition of its *Playboy* magazine in 1954 and that it now has a worldwide paid circulation of approximately 4 million copies per month. Complainant further states that its website using the domain name <playboy.com> receives more than 2.5 million unique visitors per month.

Complainant states that, in the fall of 2004, it announced its participation in an entertainment venture in Las Vegas in a tower under construction at The Palms Casino Resort, known as “The Palms.” Complainant alleges that this announcement received “substantial publicity,” including related articles in *New York Newsday* (July 11, 2005), *People* (July 8, 2005), *Los Angeles Times* (July 8, 2005) and *New York Post* (July 5, 2005).<sup>2</sup> Complainant states that while it “has not yet announced a

<sup>1</sup> The registration record for U.S. Reg. No. 769,702 lists the owner as “Playboy Enterprises, Inc.,” while the Complainant in this case is Playboy Enterprises International, Inc., and Complainant provides no explanation for this discrepancy. Nevertheless, given the other trademark registrations cited by Complainant that are indeed owned by Complainant, this discrepancy is irrelevant to the decision in this case.

<sup>2</sup> Complainant did not provide copies of the cited articles, which would have been appreciated but the Panel, but review of the articles is not necessary for the Panel’s decision in this case.

name” for this venture, it “has a recognized practice of naming its entertainment services with trademarks comprised of PLAYBOY and terms descriptive of the genre or venue in which Playboy’s content is delivered.”

The Domain Name was created on January 4, 2006.

Complainant states that it sent a demand letter via e-mail (to the address for Respondent listed in the Whois database) to Respondent regarding the Domain Name on February 9, 2006, a copy of which is provided as an exhibit to the Complaint. Complainant states that Respondent did not respond to the demand letter and, therefore, Complainant sent a second demand letter to Respondent, via FedEx (to the address for Respondent listed in the Whois database), regarding the Domain Name on February 28, 2006, a copy of which is provided as an exhibit to the Complaint. A FedEx label provided by Complainant indicates either that the Respondent moved and left no forwarding address information or that Respondent was not in and that FedEx was not authorized to leave the letter without a signature.<sup>3</sup>

## **5. Parties’ Contentions**

### **A. Complainant**

Complainant contends that the Domain Name is confusingly similar to its PLAYBOY trademark and that the addition of the words “atthepalms” “does nothing to reduce the confusing similarity” between the Domain Name and the PLAYBOY trademark (citing *Telstra Corporation Limited v. Ozurls*, WIPO Case No. D2001-0046).

Complainant contends, as provided in more detail below, that “Respondent should be considered as having no legitimate rights in playboyatthepalms.com because Respondent is not known by that name, has never made any bona fide use of the domain name, nor made any noncommercial or fair use.”

Complainant contends that the Domain Name was registered and is being used in bad faith because (1) the PLAYBOY trademark “falls within a select class of internationally strong marks that have become so famous that it is impossible for any respondent to claim that he was unaware of Playboy’s prior rights in PLAYBOY or had a legitimate interest in a domain name that incorporated the marks” and “[g]iven that Respondent has no connection with Complainant and has never been authorized by Complainant to use the [Playboy Marks], the very fact that Respondent has registered [playboyatthepalms.com] establishes bad faith use and registration” (citing *Ford Motor Company and Land Rover Ltd. v. Kevin Knuhtsen*, WIPO Case No. DBIZ2002-00183); and (2) in light of Complainant’s unanswered demand letter sent via e-mail and its undeliverable demand letter sent via FedEx, there is an inference that Respondent has provided false or inaccurate contact information, which is evidence of bad faith.

### **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

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<sup>3</sup> The FedEx label is unclear as to which of these two reasons was the cause for the letter not being delivered, but Complainant states that FedEx informed Complainant that “Respondent did not reside at that address and that [FedEx] was unable to find any alternative address.”

## 6. Discussion and Findings

Pursuant to the Policy, Complainant is required to prove the presence of each of the following three elements to obtain the relief it has requested: (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

- (ii) the Respondent 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. Policy, Paragraph 4(a).

### A. Identical or Confusingly Similar

Based upon the U.S. trademark registrations cited by Complainant, it is obvious that Complainant has rights in the PLAYBOY mark.

As to whether the Domain Name is identical or confusingly similar to Complainant's PLAYBOY mark, the relevant comparison to be made is with the second-level portion of the Domain Name only (i.e., <playboyatthepalms.com>), as it is well-established that the top-level domain name (i.e., ".com") should be disregarded for this purpose. See, e.g., *The Forward Association, Inc., v. Enterprises Unlimited*, NAF Case No. FA0008000095491 ("[N]either the beginning of the URL (http://www.), nor the TLD (.com) have any source indicating significance. Those designations are merely devices that every Internet site provider must use as part of its address").

Although PLAYBOY and "playboyatthepalms" are not identical, they are obviously similar. The similarity is particularly relevant given Complainant's announcement that it planned to open a venture at The Palms and the Domain Name contains the phrase "atthepalms". See *Yellow Corporation v. MIC*, WIPO Case No. D2003-0748 ("when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity"). See also *Six Continents Hotels, Inc. v. Sdf fdgg*, WIPO Case No. D2004-0384.

In this case, the "disputed domain name incorporates the whole of the Complainant's trademark PLAYBOY, together with [a] descriptive [phrase]... associated with the Complainant and its renowned activities [at The Palms]." *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745; see also *Playboy Enterprises International, Inc v. Federico Concas*, WIPO Case No. D2002-0074. As a result, the Domain Name is confusingly similar to the Complainant's PLAYBOY trademark and the Panel is convinced that Complainant has proven the first element of the Policy.

### B. Rights or Legitimate Interests

Complainant alleges that "Respondent should be considered as having no legitimate rights in playboyatthepalms.com because Respondent is not known by that name, has never made any bona fide use of the domain name, nor made any noncommercial or fair use." Complainant further alleges: "Nor has Complainant uncovered any evidence that Respondent has ever been known by the Disputed Domain Name. He has not applied for and does not hold any trademark registration for PLAYBOY or PLAYBOY AT THE PALMS or any trademark registration incorporating PLAYBOY in the United States. Nor does he have any connection or affiliation with Complainant or has he been

authorized by Complainant to register <playboyatthepalms.com> or to make any use of Complainant's Playboy Marks."

Under the Policy, "a complainant is required to make out an initial *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP." "WIPO Overview of WIPO Panel Views on Selected UDRP Questions," paragraph 2.1, <<http://arbiter.wipo.int/domains/search/overview/index.html>> (visited July 14, 2006).

Accordingly, as a result of Complainants' allegations and without any evidence of Respondent's rights or legitimate interests in the Domain Name, the Panel is satisfied that the Complainant has proven the second element of the Policy.

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

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by, among other things, evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

In this case, Complainant has not alleged with specificity in its Complaint which, if any, of these four factors may exist and evidence bad faith, although it implies that Respondent has acted in bad faith as set forth in paragraph 4(b)(iii) or 4(b)(iv) of the Policy. Given the well-established rights Complainant has obtained in its PLAYBOY trademarks and its announcement of a venture at "The Palms" that generated "substantial publicity," Respondent surely must have registered the Domain Name to take advantage of these trademarks and venture, to the Complainant's detriment.

Indeed, "the Respondent most likely had ample prior knowledge of the Complainant's activities conducted under its [PLAYBOY trademarks] at the time the Respondent registered the disputed domain name. Hence, if the Respondent had no intention of benefiting from opportunistically exploiting any of those marks[,] let alone to the detriment of the Complainant, then why did it register a name that so resembles those marks? The Panel can think of no credible reason. Moreover, since the Respondent failed to file a response, the Panel simply infers that no such reason exists." *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411.

Therefore, the Panel is satisfied that the Complainant has proven the third element required by the Policy.

**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 <playboyatthepalms.com> be transferred to the Complainant.

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Douglas M. Isenberg  
Presiding Panelist

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Peter L. Michaelson  
Panelist

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Justin Hughes  
Panelist

Dated: July 19, 2006