



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. Vileshome

Case No. D2001-1082

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 Julie Brown, Esq. of the Complainant.

The Respondent is Vileshome of Kazim Karabekir Caddesi 8 Sokak No. 43-4, Sirinevler, Istanbul 34510, Turkey.

2. The Domain Names and Registrar

The disputed domain names are <playboymarket.com> and <playboymarket.net>.

The Registrar is Network Solutions, Inc., of Herndon, Virginia, United States of America.

3. Procedural History

This is an administrative proceeding pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999, (“the Rules”) and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the Supplemental Rules”) of the WIPO Arbitration and Mediation Center (“the Center”).

The Complaint was received by the Center by email on August 30, 2001, and in hardcopy on September 4, 2001. The Complaint was acknowledged on September 4, 2001. The next day registration details were sought from the Registrar. On September 7, 2001, the Registrar confirmed that the disputed domain names are registered in the name of the Respondent at the address mentioned above and that

version 5 of the Registrar's Service Agreement (which incorporates the Policy) is in effect.

On September 7, 2001, the Center satisfied itself that the Complaint complied with all formal requirements (including payment of the prescribed fee) and that day formally dispatched copies of the Complaint by post/courier (with enclosures) to the Respondent at its address as recorded with the Registrar and by email (without attachments). The Center also sent copies of the material by the same methods to the Respondent's Administrative, Billing and Technical Contacts at the addresses recorded by the Registrar and included with the material dispatched to the Respondent and to those contacts a letter dated September 7, 2001, containing notification of the commencement of this administrative proceeding, with copies (of the Complaint without attachments) to the Complainant, the Registrar and ICANN.

The emails to the Respondent at "postmaster@playboymarket.com", to its Administrative and Billing Contact at "vileshome@yahoo.com" and to its Technical Contact at "support@domainvalet.com" do not appear to have reached their intended destination. The emails to the Respondent at "postmaster@playboymarket.net", to its Administrative and Billing Contact at "kemalsinmez@superonline.com" and to its Technical Contact at "dnsbilling@infospace.com" do appear to have reached their intended destination. On September 11, 2001, the material that had been sent to the Respondent by post was returned to the Center undelivered.

The last day specified by the Center for a Response was September 27, 2001. No Response was filed. On October 1, 2001, the Center gave formal notice of the Respondent's default.

The Complainant elected to have the case decided by a three-member Administrative Panel ("the Panel") and nominated Peter L. Michaelson, Esq., who was appointed by the Center. In the absence of a Response, the Center appointed Herman Verbist, Esq. as co-panelist. Alan L. Limbury, Esq. was appointed by the Center as presiding panelist. Each panelist submitted a Statement of Acceptance and Declaration of Impartiality and Independence. On October 16, 2001, the Center transmitted the case file to the Panel and notified the parties of the projected decision date of October 30, 2001.

The Panel is satisfied that the Complaint was filed in accordance with the requirements of the Rules and Supplemental Rules; payment was properly made; the Panel agrees with the Center's assessment concerning the Complaint's compliance with the formal requirements; the Center discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint; no Response was filed and the Panel was properly constituted.

The language of the proceedings was English, being the language of the Registration Agreement.

4. Factual Background

The Complainant is an international media entertainment company, providing adult lifestyle entertainment through a wide variety of media, including print, cable television, videotape and the Internet.

First registered in the United States in 1954, (No. 600,018) and in the Respondent's home country, Turkey, in 1977 (No.100402), the Complainant's PLAYBOY trademark is internationally famous. The distinctiveness, strength and fame of the PLAYBOY mark has been acknowledged by a number of courts. Decisions referred to in this respect by the Complainant (Complaint, item 15) include *Playboy Enters, Inc. v. Baccarat Clothing Co, Inc.*, 692 F.2d 1272 (9th Cir. 1982), (PLAYBOY trademark is distinctive, strong and has acquired great fame); and *Playboy Enters, Inc. v. AsiaFocus Int'l, Inc.*, 1998, WL 724000 (E.D.Va. April 10, 1998), (noting that fame of PLAYBOY mark is beyond dispute).

The Complainant's websites, including <playboy.com>, <playboytv.com>, <playboystore.com>, <playboyauctions.com>, <playboysportsbook.com> and "the playboy cyber club" site, offer to Internet users around the world a range of goods and services at the PLAYBOY STORE and MARKETPLACE.

On December 16, 2000, the Respondent registered the domain name <playboymarket.com> and on December 21, 2000, the domain name <playboymarket.net>.

The Complainant learned of the registration of <playboymarket.com> on January 2, 2001, at which time the site reached through that domain name comprised a blank page with the HTML title "Domain Valet" (Complaint Annex G). On January 31, 2001, the Complainant put the Respondent by email to Mr. Kenan Dagsan (the Respondent's Administrative and Billing Contact), on notice of the Complainant's rights with regard to the PLAYBOY trademark (Complaint Annex H).

On March 9, 2001, a Mr. Kemal Sinmez replied, stating that the domain name <playboymarket.com> had been bought by him in accordance with all legal procedures, that the Complainant could not interfere with it and that Mr. Sinmez would be processing the website as an e-market for his own company, marketing women's underwear, sexual health equipment, gifts, film and music CDs. Mr. Sinmez added: "products with the Playboy trademark will not be sold in this site". He then suggested the Complainant might like to support the site and that, by agreement, part of the site might be devoted to Playboy products. The e-mail ended:

"if any attention has not been paid by you, our site will be activated by May 2001 with the image that has been tride [sic] to be formed by giving the product profile"(Complaint Annex I).

The Complainant replied by e-mail on March 13, 2001, again emphasising its rights in the PLAYBOY trademark and asking that the website be dismantled and that the domain name be deleted or transferred to the Complainant (Complaint Annex J).

On March 19, 2001, the Complainant learned of the registration of the domain name <playboymarket.net> and wrote to the Respondent in terms similar to its January 31, 2001 letter, (Complaint Annex M). Mr. Dagsan replied by email on March 22, 2001, that he held and was planning to sell both the sites <playboymarket.com> and <playboymarket.net> and soliciting "a minimum bid of \$20,000 US" (Complaint Annex N).

Over the next few weeks, the Complainant, through its legal department, continued to assert its rights and to seek an amicable resolution. On behalf of the Respondent, the following statements were made:

- On April 17, 2001, Mr. Kemal Sinmez wrote (relevant extracts only):

... Mr. Kenan Dagan is one of my employees working at my company and I am the owner of the domain name.....I am planing to do a real comercial website on the domain names I own... ... I am still planing about the houndrad tosands of dolars that I would earn by the e-commerce done on my domais.

...I am not using the trademark PLAYBOY; the domain name PLAYBOYMARKET.COM is totaly a different trademark... So... PLAYBOYMARKET.COM is not ... your business.

...I am repeating my commercial offer if you would like to demonstrate PLAYBOY products in the site please get intouch with me.”[sic] (Complaint Annex P)

- On April 19, 2001, Mr. Kenan Dagan wrote (referring to both the disputed domain names):

“I want to sell this domain names to PEII. Yf your take , pls only send me mail offer”. [sic] (Complaint Annex Q)

- On May 6, 2001, Mr. Dagan wrote:

“I want to sale for the domain name. I know the law and † dont to be afraid. there or everyone † sale for the domain name. †f you give the ask † wait for there. this domain not sale now on web but you delay to me † sale for everyone best regards”. [sic] (Complaint Annex Q)

On May 30, 2001, the website reached by means of the domain name <playboymarket.net> had been changed from the “welcome to Playboymarket net!” page it had been on March 19, 2001, to an adult website carrying third party advertising, including links to third party web sites, pop-up advertisements and banner advertisements. This site contained links to hundreds of adult websites, many of which posted unauthorised reproductions of the Complainant's copyrighted images (Complaint Annex R).

The www.playboymarket.net website had changed again by June 13, 2001, but still displayed commercial advertisements, a text link titled “adult” and a link from the homepage to <playboy.com> (Complaint Annex T).

The website at www.playboymarket.com has continually consisted of a single line in Turkish and third party commercial banner advertisement.

5. Parties' Contentions

A. Complainant

The Complainant requests the Panel to issue a decision that <playboymarket.com> and <playboymarket.net> be transferred to the Complainant and it invokes the following legal grounds as a basis for the relief sought:

Identity or confusing similarity

The disputed domain names are identical or confusingly similar to the Complainant's trademark PLAYBOY.

Legitimacy

The Respondent has no legitimate interests in the disputed domain names.

Bad faith

The disputed domain names were registered and are being used in bad faith.

B. The Respondent

No Response was filed.

6. Discussion and Findings

Under paragraph 15(a) of the Rules, the Panel must decide this Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

To qualify for cancellation or transfer, a Complainant must prove each element of paragraph 4(a) of the Policy, namely:

- (i) the disputed 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 disputed domain name has been registered and is being used in bad faith.

Failure to file a Response, in the absence of exceptional circumstances, permits the Panel to infer that the Respondent does not deny the facts which the Complainant asserts nor the conclusions which the Complainant asserts can be drawn from those facts: Rule 14(b) and see *Reuters Limited v. Global Net 2000, Inc.* (WIPO Case No. D2000-0441); *Hewlett-Packard Company v. Full System S.a.S.* (NAF Case No. FA0094637); *David G. Cook v. This Domain is For Sale* (NAF Case No. FA0094957) and *Gorstew Jamaica and Unique Vacations, Inc. v. Travel Concierge* (NAF Case No. FA0094925).

Identity or confusing similarity

Essential or virtual identity is sufficient for the purposes of the Policy: 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).

The test of confusing similarity under the Policy, unlike trademark infringement or unfair competition cases, is usually confined to a consideration of the disputed domain name and the trademark: *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).

Here, each disputed domain name incorporates, as its most prominent feature, the whole of the Complainant's famous trademark PLAYBOY, together with the descriptive word MARKET, which does nothing to detract from the immediate association with the Complainant aroused in the public mind by the word PLAYBOY.

The content of the Respondent's website at www.playboymarket.net at all relevant times would strengthen the misrepresentation conveyed by that domain name that it is associated with the Complainant, having regard to the fame of the PLAYBOY mark and the Complainant's activities. For the same reason, the content of the Respondent's website at www.playboymarket.com would do nothing to detract from the misrepresentation inherent in that domain name.

The Panel finds the disputed domain names are confusingly similar to the Complainant's famous registered trademark PLAYBOY. The Complainant has established this element.

Illegitimacy

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

It is thus apparent that the Respondent's site has been designed to attract Internet users because of the renown of the PLAYBOY mark. The Respondent is trading off the Complainant's goodwill in so doing and is not offering *bona fide* services: *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and <madonna.com>* (WIPO case No.D2000-0847).

The Panel finds the Complainant has established this element. The Respondent has no rights or legitimate interest in the disputed domain names.

Bad faith registration and use

A finding of bad faith may be made where the Respondent "knew or should have known" of the registration and use of the trademark prior to registering the domain name: *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).

Given the international renown of the PLAYBOY trademark, the Panel finds that the Respondent must have known of the PLAYBOY mark before it registered the domain names.

It is clear from the Respondent's initial communications that the primary purpose of the Respondent in registering the disputed domain names was to sell them to the Complainant for a price greatly exceeding the direct costs of their registration. This is evidence of both bad faith registration and bad faith use under paragraph 4(b)(i) of the Policy. The Respondent's threats to establish active commercial websites and its conduct in doing so in relation to the domain names <playboymarket.com> and <playboymarket.net> were an attempt to drive up the price which the Complainant might be induced to pay.

As to the domain name <playboymarket.net>, by intentionally diverting Internet users, for commercial gain, from what they expect to be the Complainant's site to the Respondent's competing site at www.playboymarket.net, the Respondent has allowed those users to infer a relationship between the Complainant and the Respondent that does not exist. This is evidence of both bad faith registration and bad faith use under paragraph 4(b)(iv) of the Policy.

The Complainant has established this element.

7. Decision

Pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the domain names <playboymarket.com> and <playboymarket.net> be transferred from the Respondent to the Complainant.

Alan L. Limbury
Presiding Panelist

Peter L. Michaelson
Panelist

Herman Verbist
Panelist

Dated: October 30, 2001