



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Playboy Enterprises International, Inc. v. Cantrell Inc.**

**Case No. D2006-0823**

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

The Complainant is Playboy Enterprises, Inc., of Illinois, United States of America.

The Respondent is Cantrell Inc., of Florida, United States of America.

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

The disputed domain name <playboyphonesex.com> is registered with Go Daddy Software, Inc.

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2006. On June 29, 2006, the Center transmitted by email to Go Daddy Software, Inc. a request for registrar verification in connection with the domain name at issue. On June 29, 2006, the registrar transmitted by email to the Center its verification response. 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 July 5, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was July 25, 2006. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 26, 2006.

The Center appointed Peter L. Michaelson, Jeffrey M. Samuels and Mark V. B. Partridge as the Panelists in this matter on August 18, 2006. The Panel finds that it was properly constituted.

#### 4. Factual Background

The Complainant, Playboy Enterprises International, Inc. (“Playboy”), is an international multimedia entertainment company, perhaps best known as the publisher of Playboy magazine. Playboy develops and distributes multimedia lifestyle entertainment for adult audiences. Playboy also operates Playboy television and cable networks worldwide; distributes programming via home video, DVD, and wireless networks worldwide; licenses its PLAYBOY trademarks internationally for a wide range of consumer goods and services; and operates several leading men’s lifestyle and entertainment websites, including <playboy.com>, <playboystore.com>, and <playboytv.com>.

Playboy owns many trademark registrations and active applications for PLAYBOY in the United States of America and worldwide. Playboy first obtained a United States Trademark Registration for PLAYBOY in 1954 and has acquired many additional registrations covering entertainment and, specifically, adult entertainment online, including PLAYBOY (Reg. Nos. 2,631,654, and 2,482,255, covering entertainment services, namely casino services and sporting events), PLAYBOYPLUS (Reg. No. 2,802,036, covering a subscription website featuring female models), PLAYBOY.COMVERSATION (Reg. No. 2,538,068, covering entertainment services offered over a global computer network), PLAYBOY TV JUKEBOX (Reg. Nos. 2,822,730 and 2,906,287, covering a website featuring adult-content video clips), PLAYBOYTV CLUB (Reg. No. 2,894,179, covering a subscription website featuring adult photographs, videos, and film clips), PLAYBOY BACHELOR PARTY (Reg. No. 2,537,924, covering a website featuring female models and adult-themed topics), and PLAYBOY’S CYBER GIRLS (Reg. No. 2,504,457, covering an online subscription service featuring adult themes). Playboy also owns trademark rights in PLAYBOY outside of the United States of America, including over 1,716 registrations for PLAYBOY in 163 countries.

The PLAYBOY brand has been recognized in other proceedings as famous and well-known. See *Playboy Enters. v. Baccarat Clothing Co., Inc.*, 692 F.2d 1272, 1274 (9th Cir. 1982) (finding “PLAYBOY and RABBIT HEAD design trademarks are strong and distinctive and have acquired great fame”); *Playboy Enters., Inc. v. Chuckleberry Pub., Inc.*, 687 F.2d 563, 566-67 (2d Cir. 1982) (upholding “district court’s finding that the PLAYBOY mark was distinctive and enjoyed wide recognition” as indisputable and finding “PLAYBOY is a mark of great value, due in large part to the long standing success of PLAYBOY magazine”); *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1560 (M.D. Fla. 1993) (finding that Playboy’s marks “are well known marks” and “have acquired great distinctiveness among consumers, and are therefore entitled to a high degree of protection”), *superseded by statute in part*; *Playboy Enters., Inc. v. P. K. Sorren Export Co. Inc.*, 546 F. Supp. 987, 994 (D.C. Fla. 1982) (finding that Playboy’s “marks are well-known and widely associated with [Playboy’s] products” and “that these marks are strong marks, entitled to broad protection”).

The Respondent registered <playboyphonesex.com> on August 2, 2002 - long after the PLAYBOY mark had become famous and distinctive.

Playboy discovered the Respondent’s infringing registration and use of the domain name in October 2005. At that time, <playboyphonesex.com> was registered to Jumpline 2000. On October 18, 2005, Playboy’s legal department sent a cease and desist letter to Jumpline 2000. When Jumpline 2000 did not respond, on

November 7, 2005, Playboy sent a subsequent letter. On November 8, 2005, Jumpline 2000 responded by email, representing that Cantrell Inc. was the beneficial owner.

At that time, the Whois record was changed to identify the Respondent - "Cantrell Inc." located in Green Cove Springs, Florida – as the registrant. The Respondent did not respond to a cease and desist letter emailed from Playboy's law office on November 14, 2005. A subsequent letter addressed to the Respondent at the mailing address provided in the Whois record that was sent via Federal Express on December 27, 2005, was returned to Playboy.

Playboy's outside law firm then sent a cease and desist letter to Racine Cantrell, the apparent website operator. The Respondent called in response and denied any involvement with the website. Playboy's outside law firm then sent a cease and desist letter to Brian Shadis, who was at that time identified on the website as the website designer, asking for the website owner's contact information. Mr. Shadis never responded.

The Respondent has used the domain name to operate a commercial website purveying phone sex. The mark PLAYBOY is prominently featured on the website homepage and on each pages within. The mark PLAYBOY appears in a font type and size that is different, and much larger, than any other text or any other graphic. The Respondent's website displays the sentence "I am not affiliated with Playboy in any way" in small, 9 point font at the bottom of the homepage.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant claims that the disputed domain name is confusingly similar to its famous PLAYBOY mark; that the Respondent has no rights or legitimate interests in the domain name because the name is used in an infringing manner; and that the Respondent has registered and used the domain name in bad faith by using it to offer related services with knowledge of the Complainant's famous mark. The Complainant also claims bad faith is demonstrated by the Respondent's provision of fraudulent or incorrect registration information.

### **B. Respondent**

The Respondent has made no response.

## **6. Discussion and Findings**

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

The Panel finds that the domain name is confusingly similar to the PLAYBOY mark. The domain name <playboyphonesex.com> incorporates Playboy's PLAYBOY trademark, adding only the descriptive phrase "phone sex" to describe services that are likely to be associated with the Complainant. The addition of an apt descriptive term or phrase to a well-known trademark "does nothing to reduce the confusing similarity present in the domain names." *Telstra Corporation Limited v. Ozurls*, WIPO Case No. D2001-0046. This principle has been specifically found to apply to PLAYBOY in circumstances that are similar to the present circumstances. See *Playboy Enterprises*

*International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745 (holding playboy-photographer.com “is confusingly similar to the Complainant’s registered trademark PLAYBOY, being a combination of the well-known trademark PLAYBOY with a generic term which makes explicit reference to a field of activity (photography) in which the Complainant has gained renown”); see also *Playboy Enterprises International, Inc. v. Asia Sun*, WIPO Case No. D2005-0767 (finding dominant impression of <playboymobile.com> “arises from the Complainant’s mark – a mark which is distinctive and famous”). The Panel agrees that this principal applies to the disputed domain name.

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

The Panel also finds that the Respondent lacks any right or legitimate interests in the disputed domain name. It appears that the Respondent is not known by the disputed domain name and has not been authorized by Playboy to use the PLAYBOY mark in any connection. Further, the Respondent’s use appears to be a deliberate attempt to trade on the PLAYBOY mark. Such use is not viewed as creating a right or legitimate interests in the disputed domain name. See *The Chase Manhattan Corporation et al. v. John Whitely*, WIPO Case No. D2000-0346 (June 12, 2000); see also *AutoNation, Inc. v. Paul Schaefer*, WIPO Case No. D2001-0289 (April 24, 2001) (“Because Mr. Schaefer’s use of the domain name <auto-nation-direct.com> is an infringing use of AutoNation’s service marks, Mr. Schaefer cannot have established any legitimate right or interest in this Domain Name.”); *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. D2005-0556 (“Bad faith use of domain names does not establish rights or legitimate interests in the names in the sense of paragraph 4(a)(ii) of the Policy.”).

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

Finally, the Panel finds that the disputed domain name was registered and used in bad faith. The PLAYBOY mark is famous and well-known. The Respondent’s small disclaimer confirms that it had actual knowledge of the Complainant’s use of the PLAYBOY mark. The Respondent’s bad faith is therefore demonstrated by its registration and use of the disputed domain name for related services with obvious knowledge of the Complainant’s prior rights. The Respondent’s conduct appears to be a deliberate attempt to attract Internet users for commercial gain by using a domain name that is confusingly similar to the Complainant’s mark.

The small disclaimer used by the Respondent is insufficient to avoid a finding of bad faith. First, the disclaimer is small and unlikely to be noticed by Internet users. Second, disclaimers, even when likely to be noticed, do little to rectify trademark infringement. See J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 2:14 (4<sup>th</sup> ed. 2004).

Bad faith is further suggested by the Respondent’s effort to conceal its identity. See, e.g., *Oxygen Media, LLC v. Oana Marinescu*, WIPO Case No. D2000-0582 (finding bad faith when original registrant transferred disputed domain names to her sister and inferring “she and the Respondent have sought at the very least to complicate the process for the Complainant, perhaps believing that the Respondent was not tainted by the complaints which have been leveled at Ms. Maren”); *Spice Entertainment, Inc. v. AWOS and Steve Fleming*, WIPO Case No. D2006-0114 (holding “those who incorporate the marks of others in domain names must be prepared to address inferences that arise from using methods to hide their identities from complainants who seek to protect their interests in such marks”).

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

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Mark V.B. Partridge  
Presiding Panelist

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Peter L. Michaelson  
Panelist

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Jeffrey M. Samuels  
Panelist

Dated: September 8, 2006