

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. 黄俊翰 (huang jun han), 黄氏资本控股集团有限公司 (WONG'S CAPITAL HOLDING GROUP LIMITED)

Case No. D2022-3380

1. The Parties

The Complainant is Playboy Enterprises International, Inc., United States of America ("United States"), represented by Venable, LLP, United States.

The Respondent is 黄俊翰 (huang jun han), 黄氏资本控股集团有限公司 (WONG'S CAPITAL HOLDING GROUP LIMITED), Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <playboyplesure.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on September 9, 2022. On September 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 15, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. The Complainant filed an amendment to the Complaint in English on September 16, 2022, including its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), 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 and 4, the Center formally notified the Respondent in Chinese and English of the Complaint, and the proceedings commenced on September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 18, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on October 27, 2022. The Panel finds that it was properly constituted. 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

The Complainant is a multinational company active in the media and entertainment industry and is the successor-in-interest to all trademarks and related goodwill formally owned by Playboy Enterprises, Inc., including the PLAYBOY trademarks referred to below. The Complainant is particularly the publisher of the Playboy magazine, which is one of the world's best-selling men's lifestyle magazines. Furthermore the Complainant markets and licenses the PLAYBOY marks for a wide range of consumer products, which are sold in more than 100 countries, as well as retail stores and entertainment venues. Asia, and China in particular, are very important markets to the Complainant.

The Complainant provides evidence that it owns a large international trademark portfolio for a series of PLAYBOY marks (comprising both word and logo marks), including, but not limited to, United States trademark registration number 5301904 for PLAYBOY (logo mark), registered on October 3, 2017; and United States trademark registration number 4560637 for PLAYBOY (word mark), registered on July 1, 2014. The Complainant also provides evidence that it maintains a strong online presence through its publications on various social media channels as well as on its main website hosted at the domain name <playboy.com> (registered on February 14, 1994) where the Complainant publishes articles, photos and videos and also hosts its online merchandising products shop.

The disputed domain name was registered on October 10, 2020, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name directs to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademarks for PLAYBOY, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its PLAYBOY trademarks are distinctive and internationally famous, and submits a number of prior UDRP cases in which the respective panels have concluded that the Complainant's PLAYBOY trademarks are internationally famous, including *Playboy Enters. Int'l, Inc. v. Banning*, WIPO Case No. [D2006-1542](#) and *Playboy Enterprises International, Inc. v. junhan huang*, WIPO Case No. [D2021-1886](#). The Complainant particularly claims that the Respondent has registered the disputed domain name with no intent to use it in connection with a *bona fide* offering of goods or services, as the disputed domain name is a parked webpage with no activity. The Complainant argues that such absence of use amounts to passive holding of the disputed domain name, which, it claims, does not confer any rights or legitimate interests in respect of the disputed domain name. Furthermore, the Complainant claims that given the international fame and prior registration and intensive use of its PLAYBOY trademarks, the Respondent has consciously targeted the Complainant's trademarks and registered and is using the disputed domain name in bad faith. The Complainant finally also refers to legal court proceedings currently

pending in the United States, in which three preliminary injunction orders were issued on August 9, 2021 by the United States District Court for the Southern District of New York against a number of defendants, including the Respondent in an action to protect the Complainant's PLAYBOY marks from being used in counterfeited products, and in which the Respondent is ordered to, *inter alia*, refrain from operating any website containing any portion of the PLAYBOY marks within its name.

The Complainant requests that the disputed domain name be transferred to it.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint and its amendment to the Complaint in English, and requested that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

The Panel has carefully considered all elements of this case, and considers the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comments on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited in a timely manner by the Center to present its comments and response in either English or Chinese, but chose not to do so); the fact that the disputed domain name contains the Complainant's trademark in its entirety with an English word "pleasure" and that the disputed domain name is written in Latin letters and not in Chinese characters; and, finally, the fact that making Chinese as the language of this proceeding could lead to unwarranted delays and costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this proceeding shall be English.

6.2. Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has shown that it has valid rights in the mark PLAYBOY, based on its portfolio of registered trademarks for PLAYBOY and based on its longstanding and intensive use thereof.

As to whether the disputed domain name is identical to, or confusingly similar with the Complainant's trademarks, the Panel considers that the disputed domain name consists of two elements, namely the Complainant's mark PLAYBOY, followed by the descriptive term "pleasure". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)"), section 1.8, "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." The Panel concludes that the disputed domain name contains the entirety of the Complainant's trademark PLAYBOY, as its sole distinctive and dominant feature, and that the addition of the descriptive term "pleasure" does not prevent a finding of confusing similarity. The Panel also finds that the applicable generic Top-Level Domain ("gTLD") (".com" in this proceeding) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

The Panel concludes that the disputed domain name is confusingly similar to the Complainant's registered trademarks, and decides that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee, or distributor of the Complainant, is not a *bona fide* provider of goods or services under the disputed domain name, and is not making legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Upon review of the facts and evidence provided by the Complainant, the Panel notes that the disputed domain name directs to an inactive webpage and is not being used. In this regard, the Panel finds that merely registering a domain name and holding it passively, without making any use of it, does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)). Furthermore, the Panel considers that the nature of the disputed domain name, containing the entirety of the Complainant's trademarks for PLAYBOY with the descriptive term "pleasure", carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain name, which contains the entirety of the Complainant's internationally well-known trademark, by the Respondent, which is an unaffiliated entity, creates a presumption of bad faith of the Respondent (see in this regard the [WIPO Overview 3.0](#), section 3.1.4). Furthermore, the Panel notes that the Complainant's prior rights in the PLAYBOY marks would have been readily discovered by the Respondent, if it had conducted a basic domain name or trademark search

before registering the disputed domain name. The Panel also considers the disputed domain name, fully incorporating the Complainant's trademarks, to be so closely linked and obviously connected to the Complainant and its trademarks that the Respondent's registration of this disputed domain name points towards the Respondent's bad faith. In the Panel's view, the preceding elements establish the bad faith of the Respondent in registering the disputed domain name.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name links to an inactive website. In this regard, the [WIPO Overview 3.0](#), section 3.3 provides: "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." The Panel has reviewed all elements of this case, and attributes particular relevance to the following elements: the fact that the disputed domain name contains the entirety of the Complainant's PLAYBOY trademarks; the high degree of distinctiveness and the international fame of the Complainant's trademarks, including in the Respondent's jurisdiction Hong Kong, China; the fact that the Written Notice could not be delivered to the Respondent's postal address by courier service; the fact that the Respondent was involved in a prior UDRP proceeding against the Complainant (*Playboy Enterprises International, Inc. v. junhan huang*, WIPO Case No. [D2021-1886](#)) in which the panel found that the Respondent had registered the domain name in bad faith; and that the Respondent is also involved in prior trademark litigation filed by the Complainant in the United States, in which the Respondent is ordered, in three preliminary injunctions of August 9, 2021 issued by the United States District Court for the Southern District of New York, *inter alia* to refrain from operating any website containing any portion of the PLAYBOY marks within its name, from which the Panel concludes that the Respondent has engaged in a pattern of trademark-abusive domain name conduct; and finally, the unlikelihood of any good-faith use to which the disputed domain name may be put by the Respondent. In these circumstances, the Panel considers that the passive holding of the disputed domain name constitutes use of the disputed domain name in bad faith. On the basis of the foregoing elements, the Panel finds that it has been demonstrated that the Respondent has used the disputed domain name in bad faith.

Finally, the Respondent failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore decides that the Complainant has satisfied the requirements of the third element under the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <playboypleasure.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: November 14, 2022