

## **ADMINISTRATIVE PANEL DECISION**

Playboy Enterprises International, Inc. v. Web Commerce Communications Limited, Client Care

Case No. D2022-4597

### **1. The Parties**

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

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

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

The disputed domain names <playboyclothingsale.com>, <playboyclothinguk.com>, <playboysalesusa.com>, and <playboysclothinguk.com> are registered with Alibaba.com Singapore E-Commerce Private Limited.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2022, for the disputed domain names <playboyclothinguk.com>, <playboysalesusa.com>, <playboyclothingsale.com>, <playboyhoodie.net>, <playboyhoodie.com>, and <playboyclothing.net>. On December 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 15, 2022, adding the disputed domain name <playboysclothinguk.com> and removing the disputed domain names <playboyhoodie.net>, <playboyhoodie.com>, and <playboyclothing.net> from the original Complaint.

The Center verified that the Complaint together with the amended 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 of the Complaint, and the proceedings commenced on January 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 30, 2023.

The Center appointed Daniel Peña as the sole panelist in this matter on March 1, 2023. 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 an international entertainment, lifestyle, and multi-media licensing company.

The Complainant is the owner of the PLAYBOY trademark.

The Complainant is the successor-in-interest to all trademarks and related goodwill formally owned by Playboy Enterprises, Inc., including the PLAYBOY trademark.

The Complainant owns over 2,000 trademark registrations for the PLAYBOY trademark, worldwide, in all 45 International Classes.

The PLAYBOY trademark has been used in the United States since 1953 and was registered as a United States trademark on December 28, 1954

The Complainant believes the disputed domain names are owned and operated by the same individual or entity.

The Respondent registered the disputed domain names as follows: <playboyclothinguk.com> on July 8, 2022; <playboyclothingsale.com> on July 8, 2022; <playboysalesusa.com> on September 21, 2022; and <playboysclothinguk.com> on June 12, 2022.

#### **5. Parties' Contentions**

##### **A. Complainant**

The PLAYBOY trademark is one of the most well-known and recognized trademarks in history, due to the millions of dollars the Complainant has spent growing and protecting it.

The Complainant is best known as the publisher of Playboy magazine, one of the world's best-selling men's lifestyle magazines.

The disputed domain names are similar in appearance, sound, connotation and commercial impression to the PLAYBOY trademark.

The disputed domain names incorporate the entire PLAYBOY trademark with the addition of one of, or a combination, of the generic words "clothing", "uk", "sale/sales", "usa", and with the addition of the generic Top-Level domain ("gTLD") ".com".

The addition of the term "clothing" to the disputed domains is confusingly similar because the Complainant sells clothing on the Internet using the PLAYBOY Trademark.

The addition of the gTLD“.com” does not remove the likelihood of confusion between the PLAYBOY trademark and the disputed domain names, as it only indicates that the disputed domain names are registered in the “.com” gTLD.

The Respondent has no rights or legitimate interests with respect to the disputed domain names

There is no evidence that the Respondent uses the disputed domain names in connection with the *bona fide* offering of goods or services.

When the Respondent registered the disputed domain names, the Respondent was aware of the Complainant’s trademark rights.

The disputed domain names are used by the Respondent in an attempt to pass itself off as the Complainant. The disputed domain names offer for sale counterfeit PLAYBOY clothing apparel. The offering for sale of counterfeit goods supports a finding of bad faith.

The disputed domain names use the Complainant’s RABBIT HEAD DESIGN trademark in the header to the to the disputed domain name in an attempt to appear as they are authorized by the Complainant when in fact they are not.

The Respondent has not received any license or consent, express or implied, to use the PLAYBOY Trademark in a domain name or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application of the PLAYBOY Trademark by the Respondent.

The Respondent has not received any license or consent, express or implied, to use the RABBIT HEAD DESIGN Trademark on the disputed domain names or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application of the RABBIT HEAD DESIGN trademark by the Respondent.

The Respondent has no authorization from the Complainant to register the disputed domain names. The Respondent has no legitimate right or interest in the disputed domain names. The Respondent has registered and used the disputed domain names in bad faith.

The disputed domain names are used by the Respondent in an attempt to pass itself off as the Complainant. All of the disputed domain names offer for sale clothing apparel under the false guise that they are authentic PLAYBOY products when they are not. The fact that some of the disputed domain names use the ® symbol and have statements at the bottom of the homepage, demonstrates the Respondent’s attempts to deceive consumers into believing the Respondent is authorized by the Complainant when it is not.

It is a concern for the Complainant that the Respondent is merely trying to collect consumers’ personal information—including payment information.

In view of the forgoing, the Respondent has registered and is using the disputed domain names in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are 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 names; and (iii) the disputed domain names have been registered and are

being used in bad faith.

Considering these requirements, the Panel rules as follows:

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademarks PLAYBOY on the basis of its multiple trademark registrations in the United States. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.1). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#).

The Panel finds that the disputed domain names are confusingly similar to the Complainant’s marks. The Respondent’s incorporation of the Complainant’s mark in full in the disputed domain names is evidence that the disputed domain names are confusingly similar to the Complainant’s marks. Mere fact of the addition of the words “clothing”, and “sale/sales” and the geographic acronyms “usa” and “uk” to the Complainant’s trademark PLAYBOY do not prevent a finding of confusing similarity with the Complainant’s marks.

Furthermore, the addition of the gTLD “.com” is not sufficient to prevent a finding of confusing similarity either. The Panel is satisfied that the disputed domain names are identical or confusingly similar to the Complainant’s mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

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

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth. Refraining from submitting any Response, the Respondent has brought to the Panel’s attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests the disputed domain names.

The Panel will now examine the Complainant’s arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain names. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant’s trademarks in a domain name or in any other manner.

Furthermore, the disputed domain names direct to commercial websites that allegedly offer the Complainant’s goods including in its content the Complainant’s trademarks and logos, without any disclaimer as to the relationship with or authorization of the Complainant, exacerbating the user confusion as to the websites’ affiliation to the Complainant. Such use for deliberately attracting Internet users to these websites in the mistaken belief that such are websites of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain names.

Moreover, the Complainant contends that the Respondent likely uses the websites to collect personal and payment information from confused Internet users, which constitutes an illegal use that can never confer rights or legitimate interests upon a respondent. The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse

inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain names and that paragraph 4(a)(ii) of the Policy is satisfied.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (ii) the respondent 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 respondent has engaged in a pattern of such conduct; (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the Complainant submits that at the date of registration of the disputed domain names the Respondent would have had constructive, if not actual knowledge of the Complainant's mark PLAYBOY. The Panel's finding is reinforced given the construction of the disputed domain name, which combines the PLAYBOY mark with the terms "clothing", and "sale/sales" and the geographic acronyms "usa" and "uk", as well as the fact that some of the disputed domain names directed to the same website that allegedly offers the Complainant's trademarked goods. The Panel is satisfied that by redirecting the disputed domain names to a commercial website allegedly offering the Complainant's goods, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith. In addition, the use of the disputed domain names for phishing, supported by the Complainant's claims and evidence, affirms a finding of bad faith (see [WIPO Overview 3.0](#), section 3.4). The Complainant points out that the Respondent is hiding its identity behind a Whois privacy wall. It is well-established that this, too, can be further *prima facie* evidence of bad faith in certain circumstances. Having considered the Complainant's submissions and in the absence of a Response, the Panel accepts the Complainant's submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register or use the disputed domain names. Consequently, the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith within paragraph 4(a)(iii) of 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 names, <playboyclothingsale.com>, <playboyclothinguk.com>, <playboysalesusa.com>, and <playboysclothinguk.com> be transferred to the Complainant.

*/Daniel Peña/*

**Daniel Peña**

Sole Panelist

Date: March 15, 2023