

ADMINISTRATIVE PANEL DECISION

Playboy Enterprises International, Inc. v. ahmad Akram, Aamir Ali,
Muhammad Adnan
Case No. D2023-0140

1. The Parties

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

The Respondents are ahmad Akram, Pakistan, Aamir Ali, Pakistan, Muhammad Adnan, Pakistan.

2. The Domain Names and Registrar

The disputed domain names, <playboyclothing.co> (the “first disputed domain name”), <playboyclothing.net>, (the “second disputed domain name”), <playboyhoodie.com> (the “third disputed domain name”) and <playboyhoodie.net> (the “fourth disputed domain name”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 11, 2023. On January 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 12, 2023, 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 Respondents and contact information in the Complaint. The Center sent an email communication to the Complainant on January 13, 2023, providing the registrant and contact information for the multiple underlying registrants disclosed by the Registrar and inviting the Complainant to amend the Complaint by adding the Registrar-disclosed registrants as formal Respondents and providing relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all the disputed domain names are under common control. The Complainant filed an amendment to the Complaint on January 13, 2023, stating that it relied on its arguments for consolidation as set out in the Complaint.

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 Respondents of the Complaint and the proceedings commenced on January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on February 9, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on February 16, 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 a long-established international entertainment, lifestyle, and multimedia licensing company, its predecessor entity having been established over 60 years ago. Its principal brand is PLAYBOY and it says it has been using this mark in the United States since 1953. The Complainant owns and operates a website at "www.playboy.com", which features articles, photographs, and videos on numerous topics and also links to a separate website on which PLAYBOY-branded merchandise is available for purchase. The Complainant has obtained trade mark registrations in multiple countries to protect its PLAYBOY mark which include, by way, of example, only, United States trade mark, registration number 2,921,658, in class 28, registered on January 25, 2005. In addition to its PLAYBOY mark, the Complainant has made longstanding and extensive use, on its apparel, merchandise and elsewhere, of a distinctive rabbit's head device. It also owns many other domain names, which comprise or include its PLAYBOY mark and, additionally, is also active on social media.

The disputed domain names were registered between October 5, 2021, and July 9, 2022. The first and fourth disputed domain name each were registered on July 9, 2022. As evidenced by the Complainant, all disputed domain names resolved to a corresponding website headed with the Complainant's PLAYBOY mark and featuring its rabbit's head device, offering a variety of garments for sale, including some which are branded as those of the Complainant and/or feature its rabbit's head device.

When the decision was being drafted, the first disputed domain name resolves to a website, headed with the Complainant's PLAYBOY mark and featuring its rabbit's head device, which offers a variety of garments for sale, including some which are branded as those of the Complainant and/or feature its rabbit's head device. The second disputed domain redirects to a website at <pbclothing.com> which is also headed with the Complainant's PLAYBOY mark and sells a range of PLAYBOY branded, clothing and/or which features the Complainant's mark and/or its rabbit's head device. The third disputed domain name redirects to a website at <pbclothing.net> which is similarly branded and features similar content. The fourth disputed domain name redirects to a section of a website at <hoodiemerch.com/playboy>, which sells clothing, some of which is branded as either PLAYBOY or PLAYBOI.

5. Procedural issue - Complaint filed against multiple Respondents

The Complainant seeks consolidation of its complaints against the Respondents in the light of the fact that the disputed domain names all resolve to websites, which sell identical and overlapping products and which use identical images and identical models. None of the products offered for sale are authentic products of the Complainant. The similarities between all the Respondents' websites are evident notwithstanding that the Respondent has attempted to introduce changes to the website to which the fourth disputed domain name resolves in an attempt to distinguish it from the websites to which the other three disputed domain names resolve. In addition, the Panel notes that all the disputed domain names are registered with the same Registrar and that the contact addresses for each of the Respondents are in the same country, namely Pakistan.

The principles applied by UDRP panels considering requests for consolidation are set out at section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition

(“[WIPO Overview 3.0](#)”). This explains that: “Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.” See also *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

The circumstances to which the Complainant has drawn attention, coupled with the fact that the disputed domain names have been registered with the same Registrar and the Respondents’ contact addresses are all in Pakistan, indicate that the Respondents are either the same person or are acting in concert in order to fulfil a common design. In either eventuality, the disputed domain names are plainly under common control, and indeed, the same individual is the underlying registrant of the first and fourth disputed domain names. Moreover, the Panel notes that none of the Respondents has challenged the Complainant’s assertions as to why consolidation is appropriate.

In these circumstances, it is procedurally efficient, as well as fair and equitable to all Parties, for the Complainant’s case in respect of all four of the disputed domain names to be dealt with in a single Complaint. The Panel therefore grants the Complainant’s request for consolidation and the named Respondents are accordingly referred to below collectively as “the Respondent”.

5. Parties’ Contentions

A. Complainant

The Complainant says that the disputed domain names are confusingly similar to a trade mark in which it has rights. Each of the disputed domain names incorporates the Complainant’s PLAYBOY mark and adds generic words, namely either “clothing” or “hoodie”. The addition of these terms does not prevent the disputed domain names from being considered confusingly similar to the Complainant’s mark.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain names. There is no evidence that the Respondent is using the disputed domain names in connection with a *bona fide* offering of goods and services. Each of them resolves, directly or indirectly, to a website purportedly offering apparel for sale which is described as that of the Complainant and/or bears the Complainant’s PLAYBOY mark and/or its rabbit’s head device. The Respondent has not received any express or implied license or consent to use the Complainant’s mark nor its rabbit’s head device. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain names.

Lastly, the Complainant says that the disputed domain names were registered and are being used in bad faith. The Respondent registered the disputed domain names at a time when he knew, or should have known, of the Complainant’s PLAYBOY mark, given the strength and fame of that mark.

Specifically, the disputed domain names are being used by the Respondent in order to pass itself off as the Complainant, namely, by offering for sale clothing apparel under the false guise that they are authentic products of the Complainant. Moreover, the Complainant’s private investigator has attempted to purchase products from the website to which the second and third disputed domain names resolve, but was unable to do so because the investigator’s payment methods failed. This suggests that the disputed domain names are phishing websites intended to trick consumers into providing the Respondent with their personal identifying information.

B. Respondent

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

6. Discussion and Findings

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (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.

A. Identical or Confusingly Similar

The Complainant has produced evidence of its registered marks for PLAYBOY, including the mark full details of which have been set out above. It has thereby established its rights in this mark.

When considering whether the disputed domain names are identical or confusingly similar to the Complainant's mark the generic Top-Level Domains ".com" and "net" and the country code Top-Level Domain ".co" are disregarded as technical requirements of registration. Each of the disputed domain names accordingly comprises the Complainant's PLAYBOY trade mark, in full and without alteration, followed by the words "clothing" or "hoodie". The addition of these words does not prevent them from being found confusingly similar to the Complainant's mark. As explained at section 1.8 of the [WIPO Overview 3.0](#); "Where the relevant trade mark 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". See also *LinkedIn Corporation v. Daphne Reynolds*, WIPO Case No. [D2015-1679](#).

The Complainant's PLAYBOY mark is clearly recognizable within each of the disputed domain names and the Panel therefore finds that they are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, in summary, that a respondent may demonstrate that it may have rights or legitimate interests in a domain name by demonstrating either that, before any notice to it of the dispute, it has been using or has made demonstrable preparations to use, the domain name in connection with a *bona fide* offering of goods or services, or that it has been commonly known by the domain name or that it has been making a legitimate noncommercial or fair use of the domain name.

The use of the Respondent's websites in order to sell, or purport to sell, apparel which is either described as that of the Complainant and/or which features the Complainant's mark and/or its rabbit's head device, either to describe the garments and/or as a motif on the garments themselves, as well as the lack of any disclaimer on any of the websites, to which the disputed domain names resolve is plainly intended to mislead Internet users into believing that the Respondent's websites are operated by, or with the license or permission of, the Complainant. Use of the disputed domain names for these purposes does not amount to use in connection with a *bona fide* offering of goods and services. See the decision of the panel in *Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilipplein*, WIPO Case No. [D2015-1050](#); "The Respondent's use of a domain name that is confusingly similar to the Complainant's trade marks in order to attract Internet users looking for genuine products of the Complainant's company and

to offer them unauthorized copies instead is a 'bait and switch' strategy that lacks *bona fides* and does not give rise to rights or a legitimate interests under the Policy". See also section 2.13.1 of the [WIPO Overview 3.0](#) which explains that "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent".

The Panel notes the Complainant's contention (not challenged by the Respondent) that the apparel advertised for sale on the Respondent's websites is not authentic merchandise of the Complainant. In fact, the Complainant asserts that the Respondent is not actually selling any clothing, and that its websites are simply dummy websites which are being used for phishing purposes, that is to capture confidential information of Internet users who attempt to purchase clothing from them. Whilst this may well be the case, it is sufficient for the Complainant to establish (as it has) that the Respondent's websites purport to be operated by, or authorized by, the Complainant and to offer for sale unauthorized apparel which features its PLAYBOY mark.

There is no evidence to indicate that the Respondent has been commonly known by any of the disputed domain names and the second circumstance set out at paragraph 4(c) of the Policy is therefore inapplicable. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain names.

Once a complainant has made out a *prima facie* case that a respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it does have such rights or legitimate interests. In the absence of any response from the Respondent to the Complaint, it has failed to satisfy that burden. The Panel accordingly finds that the Respondent has no rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

The fact that, following registration of the disputed domain names, the Respondent has used them in order to resolve, directly or indirectly, to websites that purport either to be authorized by the Complainant or, at least, to sell its apparel, establishes, that the Respondent was aware of the Complainant's PLAYBOY mark as at the date of their registration and that they were registered in order to target the Complainant and take advantage of its repute in its marks. This is affirmed by the fact that the added terms within the disputed domain names, namely "hoodie" and "clothing" will also be associated with the Complainant. As explained at section 3.1.4 of the [WIPO Overview 3.0](#): "[p]anels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trade mark by an unaffiliated entity (particularly domain names comprising typos or incorporating the mark plus a descriptive term) can by itself create a presumption of bad faith". The Panel therefore finds the registration of the disputed domain names to have been in bad faith.

Turning to bad faith use, paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy, in summary, is if a 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. The use the Respondent is making of the disputed domain names, as described above, is plainly intended to confuse Internet users into believing that its websites are those of the Complainant, or are authorized by it, and therefore comprises bad faith use within the meaning of paragraph 4(b)(iv) of the Policy; see, for example *Clarins v. Privacy Service Provided by Withheld for Privacy ehf / Do Thanh Luan, Lilla Group*, WIPO Case No. [D2022-1178](#) and *Sneakersnstuff AB v. Sneaker Games LLC / DONG LI*, WIPO Case No. [D2021-3237](#). To the extent that the Respondent's websites are simply vehicles for engaging in phishing as asserted by the Complainant, see section 3.1.4 of the [WIPO Overview 3.0](#): "Given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith".

The Panel accordingly finds that the disputed domain names have been registered and are being used in bad faith.

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, <playboyclothing.co>, <playboyclothing.net>, <playboyhoodie.com>, and <playboyhoodie.net>, be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: March 2, 2023