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COMPLAINANT:

eBaum's World, Inc.
2590 Brighton Henrietta Townline Rd.
Rochester, NY 14623

Telephone: 585-292-0069
Fax: 585-292-0722
E-mail: legal@ebaumsworld.com

CPR Case Number: CPR-06-12

Date of Commencement: March 20, 2006

Domain Name: "ebaum.com"

Registrar: Enom, Inc.

Representatives:

William S. Levinson, Esq.
Culley, Marks, Tannenbaum &
Pezzulo, LLP
Rochester, NY

vs.

RESPONDENTS:

Marketpoints.com – New Media
Branding Svcs.
1800 Bryant Street
San Francisco, CA 94110
and
NewMarks.com LLC
341 West 11th Street
New York, NY 10014

Telephone: c/o 646-265-5307
Fax: c/o 212-966-1359
E-mail: c/o legal@dynamo.com

Representative:

B. Rose Yasuda
Dynamo.com

Before Sandra J. Franklin, Deborah A. Coleman, and John Fleming Kelly, Arbitrators

PROCEDURAL HISTORY

The Complaint was filed with CPR on March 20, 2006 and, after review for administrative compliance, served on Respondent Marketpoints.com on March 20, 2006 via email. On May 2, 2006, Complainant called to the attention of CPR that as of April 19, 2006, the WHOIS record of the registrant for eBaum.com had been changed from Marketpoints.com to NewMarks.com LLC. As of July 13, 2006, NewMarks.com LLC remained the registrant for eBaum.com, as evidenced by the WHOIS record dated July 13, 2006 that CPR provided to the panel. On behalf of Respondent NewMarks.com, a Response was filed on July 12, 2006. Arbitrators Sandra J. Franklin, Deborah A. Coleman and John Fleming Kelly were appointed pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record including the Complaint and its seven annexes, and the Response and its 17 attachments, we find as follows:

FINDINGS

The WHOIS record when Complainant began its pursuit of eBaum stated that the registrant was Marketpoints.com, as reflected in a WHOIS record that was Annex 2 to the Complaint. Thereafter, the name of the registrant was changed to NewMarks.com. LLC, The Response alleges that Respondent Marketpoints.com and Respondent NewMarks.com LLC are one and the same, and the Panel so finds.

Respondent's domain name <eBaum.com> was registered with Enom on March 7, 2000. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

IDENTITY/CONFUSING SIMILARITY

Complainant alleges that Respondent's <eBaum.com> domain name is identical or confusingly similar to Complainant's trademark eBaum's World, which applies to entertainment services.

Because Complainant holds a trademark registration for eBaum's World with the USPTO, Complainant has established rights in the mark pursuant to Policy ¶ 4(a)(i). See *Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark.”.)

Respondent's <eBaum.com> domain name is confusingly similar to Complainant's eBaum's World mark pursuant to Policy ¶ 4(a)(i), because it contains Complainant's entire mark and merely omits the descriptive term “world”. See *Arthur Guinness Son & Co. (Dublin) Ltd. v. Healy/BOSTH*, WIPO Case No. D2001-0026, finding confusing similarity where the domain name in dispute contains the identical mark of the complainant combined with a generic word or term.

We therefore conclude that the registered domain name is identical or confusingly similar to Complainant's mark.

RIGHTS AND LEGITIMATE INTERESTS

Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue, primarily by stating that Respondent is not licensed or otherwise authorized to use its trademark. Respondent, however, states that it is in the branding or naming business and, in this case, eBaum (eTree in English) was targeted for a German company selling herbal supplements, as part of a campaign devised by Respondent. According to Respondent, that company did not end up using the name eBaum, but Respondent asserts that he has every right to maintain it in his cache of prospective names for businesses that he works with. It is noted that Respondent registered <eBaum.com> before Complainant commercially used or registered the mark eBaum's World.

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel finds Respondent's explanation of the registration of <eBaum.com> reasonable, constituting preparation to use the domain name legitimately. Where there is no intent to trade off a well-established trademark, common words and descriptive terms are legitimately subject to registration as domain names on a "first come, first served" basis. See *Allocation Network GmbH v. Steve Gregory* WIPO Case No. [D2000-0016](#) denying the transfer of <allocation.com>; see also *Zero International Holding GmbH &*

Co. Kommanditgesellschaft v. Beyonet Services and Stephen Urich, WIPO Case No. D2000-0161; see also *EAuto, L.L.C. v. EAuto Parts*, WIPO Case No. D2000-0096.

We therefore conclude that Respondent does have rights or legitimate interests with respect to the domain name at issue.

BAD FAITH

In support of the contention of Respondent's bad faith registration and use, Complainant alleges that Respondent registered the domain name <eBaum.com> for the purpose of selling it to Complainant or Complainant's competitor, which Respondent vigorously denies.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) an intentional attempt to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location, or of a product or service on Respondent's web site or location.

This Panel cannot find bad faith registration when there is no dispute that Respondent registered the domain name <eBaum.com> *before* Complainant commercially used or registered its trademark eBaum's World. See *John Ode dba ODE and ODE-Optimum Digital Enterprises v. Intership Limited*, WIPO [D2001-0074](#), denying the transfer of <ode.com>, *Digital Vision, Ltd. v. Advanced Chemill Systems*, WIPO [D2001-0827](#), denying the transfer of <digitalvision.com>, and *PrintForBusiness B.V v. LBS Horticulture*, WIPO [D2001-1182](#) denying the transfer of <print4business.com>.

We therefore conclude that Respondent did not register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of our findings above that (a) the registered domain name is identical or confusingly similar to Complainant's mark; (b) Respondent does have rights or legitimate interests with respect to the domain name at issue; and (c) Respondent did not register and use the domain name in bad faith, as that term is defined in the ICANN Policy, we find in favor of the Respondent.

REMEDY

Complainant's request to transfer the domain name <eBaum.com> is hereby DENIED.

Signature of Chairperson, Arbitrator Sandra J. Franklin

Date

Signature of Arbitrator Deborah A. Coleman

Date

Signature of Arbitrator John Fleming Kelly

Date