



NATIONAL ARBITRATION FORUM

DECISION

Marc Gobe v. OP c/o D OConnor
Claim Number: FA0711001106663

PARTIES

Complainant is **Marc Gobe** ("Complainant"), represented by **Vincent A. Balardi**, of **Morgenthau & Greenes, LLP**, 575 Lexington Avenue, 31st Floor, New York, NY 10022. Respondent is **OP c/o D OConnor** ("Respondent"), 91 Fifth Avenue, Floor 7, New York, NY 10003.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**marcgobe.com**>, <**marcgobe.net**> and <**marcgobe.biz**>, registered with **Name.com LLC**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 6, 2007; the National Arbitration Forum received a hard copy of the Complaint on November 7, 2007.

On November 9, 2007, Name.com LLC confirmed by e-mail to the National Arbitration Forum that the <**marcgobe.com**> domain name is registered with Name.com LLC and that Respondent is the current registrant of the name. On November 13, 2007, Name.com LLC confirmed by e-mail to the National Arbitration Forum that the <**marcgobe.net**> and <**marcgobe.biz**> domain names are registered with Name.com LLC and that Respondent is the current registrant of the names. Name.com LLC has verified that Respondent is bound by the Name.com LLC registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On November 21, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of December 11, 2007 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to

postmaster@marcgobe.com, postmaster@marcgobe.net and postmaster@marcgobe.biz by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On December 19, 2007, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

FACTUAL AND LEGAL GROUNDS. This Complaint is based on the following factual and legal grounds:

(a) The domain names are identical to Complainant's personal and unique name, Marc Gobe, in which Complainant has significant and valuable common law rights. Ownership of a trademark registration is not required in order for Complainant to demonstrate its rights in the mark or to satisfy ICANN Policy requirements to maintain this proceeding. See, Vin Diesel v. LMN a/k/a L.M. Nordell, FA 0609000804924 (Nat. Arb. Forum, Nov. 7, 2006). The mere addition of a general top level domain such as ".com," ".net" and ".biz" does not serve to distinguish the domain names from Complainant's name. See, Jerry Damson, Inc. v. Texas International Property Associates, FA 0702000916991 (Nat. Arb. Forum, Apr. 10, 2007).

(b) For over the past twenty years, Complainant has served as President, CEO and Executive Creative Director of Desgrippes Gobe, Inc. ("DGI"), which is one of the world's top brand image creation firms with worldwide offices in New York, Paris, Brussels, Shanghai, Hong Kong, Seoul and Tokyo. Complainant has achieved significant domestic and international notoriety and acclaim in the advertising and brand image creation industry through his stewardship of DGI, and also for his pioneering design and

marketing theories, lectures and best-selling books. As a result, Complainant has established substantial common law rights to, and significant good will in, his name. See, Eric Bischoff v. Kentech, Inc., FA 0512000611723 (Nat. Arb. Forum, Jan. 25, 2006).

(c) Respondent has no rights or legitimate interests in or to the domain names or Complainant's name. Respondent never has been known by the domain names or Complainant's name and never acquired trademark or service mark rights in the domain names or Complainant's name. Rather, Respondent is using the domain names for a portal website containing hyperlinks to various third party websites selling various products and services that are unrelated to Complainant, all for Respondent's commercial gain. Accordingly, Respondent's use of the domain names does not constitute a bona fide offering of goods and services, and does not make any legitimate non-commercial or fair use thereof or of Complainant's name. See, Jerry Damson, Inc., supra, Vin Diesel, supra, Eric Bischoff, supra, and the cases cited therein. See also, Margaritaville Enterprises, LLC v. Whapp Innovations, FA 0702000921853 (Nat. Arb. Forum, Apr. 2, 2007) and Maria Sharapova v. Whois Privacy Protection Service, Inc. c/o Whois Agent, FA 0601000621125 (Nat. Arb. Forum, Feb. 17, 2006).

Respondent has registered and is using the domain names in bad faith. Respondent worked as an independent contractor/freelance creative director for DGI for more than a year from 2003 to 2004, and, as a result, is fully familiar with Complainant. Ostensibly, Respondent is attempting to profit from the notoriety and good will associated with Complainant's name by luring internet users onto Respondent's website using Complainant's name and deriving click through fees, commissions or other revenue as the internet users click onto the website's hyperlinks to various other websites selling the indicated products and services. Respondent's registration of the domain names with full knowledge of Complainant for the purely commercial purpose of generating revenues as set forth above constitutes bad faith. See, Jerry Damson, Inc., supra, Vin Diesel, supra, Eric Bischoff, supra, and Maria Sharapova, supra, and the cases cited therein. Moreover, Respondent's failure to date to heed Complainant's cease and desist demands is further evidence of Respondent's bad faith.

B. Respondent submitted a response that he "does not oppose" the requested domain name transfer.

FINDINGS

Complainant, Marc Gobe, is an individual who is the President, CEO and Executive Creative Director of Desgrippes Gobe, Inc. (DGI), a brand image creation firm with United States and international offices. Complainant has used the MARC GOBE mark through his involvement in DGI, his pioneering design and marketing theories, his lectures and published books, for more than twenty years.

Respondent registered the <marcgobe.com>, <marcgobe.net> and <marcgobe.biz> domain names all on May 29, 2007. Respondent is using the disputed domain names as a

portal website containing hyperlinks to various third party websites selling various products and services unrelated to Complainant.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to contest this Complaint, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical and/or Confusingly Similar

While Complainant does not have a registered trademark for the MARC GOBE mark, such registration is unnecessary under Policy ¶4(a)(i), provided Complainant can establish common law rights in the mark. *See British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy "does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names" and applying the Policy to "unregistered trademarks and service marks"); *see also SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist).

Complainant has established common law rights in the MARC GOBE mark pursuant to Policy ¶4(a)(i) through his history of use of MARC GOBE in his business capacity and through his academic theories, lectures and publications for at least twenty years. *See Keppel TatLee Bank v. Taylor*, D2001-0168 (WIPO Mar. 28, 2001) ("[O]n account of

long and substantial use of [KEPPEL BANK] in connection with its banking business, it has acquired rights under the common law.”); *see also Fishtech, Inc. v. Rossiter*, FA 92976 (Nat. Arb. Forum Mar. 10, 2000) (finding that the complainant has common law rights in the mark FISHTECH that it has used since 1982).

Respondent’s <marcobe.com>, <marcobe.net> and <marcobe.biz> domain names are identical to Complainant’s MARC GOBE mark pursuant to Policy ¶4(a)(i) because Respondent’s domain name uses the mark exactly in the domain name and the generic top-level domains after the names are irrelevant. *See Isleworth Land Co. v. Lost in Space, SA, FA 117330* (Nat. Arb. Forum Sept. 27, 2002) (“[I]t is a well established principle that generic top-level domains are irrelevant when conducting a Policy ¶4(a)(i) analysis.”); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Respondent does not have rights or legitimate interests in the <marcobe.com>, <marcobe.net> and <marcobe.biz> domain names. Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to prove that it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). The Panel finds that Complainant has established a *prima facie* case. Due to Respondent’s failure to contest the Complaint, the Panel assumes that Respondent does not have rights or legitimate interests in the disputed domain names. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶4(a)(ii).”); *see also Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide “concrete evidence that it has rights to or legitimate interests in the domain name at issue”). However, the Panel will examine the record to determine whether Respondent has rights or legitimate interests under Policy ¶4(c).

Respondent is using the <marcobe.com>, <marcobe.net> and <marcobe.biz> domain names to resolve to websites that contain links and advertisements for goods and services unrelated to Complainant. Respondent’s use of domain names that are identical to Complainant’s mark to direct users interested in Complainant’s products to websites that offer unrelated goods and services is not a use in connection with a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i), or a legitimate noncommercial or fair use of the disputed domain name pursuant to Policy ¶4(c)(iii). *See*

WeddingChannel.com Inc. v. Vasiliev, FA 156716 (Nat. Arb. Forum June 12, 2003) (finding that the respondent's use of the disputed domain name to redirect Internet users to websites unrelated to the complainant's mark, websites where the respondent presumably receives a referral fee for each misdirected Internet user, was not a *bona fide* offering of goods or services as contemplated by the Policy); *see also Am. Online, Inc. v. Advanced Membership Servs., Inc.*, FA 180703 (Nat. Arb. Forum Sept. 26, 2003) ("Respondent's registration and use of the <gayaol.com> domain name with the intent to divert Internet users to Respondent's website suggests that Respondent has no rights to or legitimate interests in the disputed domain name pursuant to Policy Paragraph 4(a)(ii).").

Additionally, the record and WHOIS information indicates no evidence suggesting Respondent is commonly known by the <marcgobe.com>, <marcgobe.net> and <marcgobe.biz> domain names. There is no evidence in the record that Respondent is authorized to use Complainant's mark. Thus, Respondent has not established rights or legitimate interests in the <marcgobe.com>, <marcgobe.net> and <marcgobe.biz> domain names pursuant to Policy ¶4(c)(ii). *See Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); *see also Ian Schrager Hotels, L.L.C. v. Taylor*, FA 173369 (Nat. Arb. Forum Sept. 25, 2003) (finding that without demonstrable evidence to support the assertion that a respondent is commonly known by a domain name, the assertion must be rejected).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

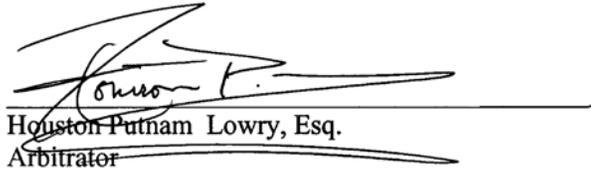
Respondent is using the <marcgobe.com>, <marcgobe.net> and <marcgobe.biz> domain names in bad faith pursuant to Policy ¶4(b)(iv) because Respondent is using Complainant's mark to attract Internet users to a website that advertises for goods and services unrelated to Complainant's, for which Respondent presumably receives click-through fees. This conduct is evidence that the Respondent is attempting to profit by attracting Internet users looking for Complainant's website to Respondent's commercial website which offers unrelated goods and services. *See Bank of Am. Corp. v. Out Island Props., Inc.*, FA 154531 (Nat. Arb. Forum June 3, 2003) (stating that "[s]ince the disputed domain names contain entire versions of Complainant's marks and are used for something completely unrelated to their descriptive quality, a consumer searching for Complainant would become confused as to Complainant's affiliation with the resulting search engine website" in holding that the domain names were registered and used in bad faith pursuant to Policy ¶4(b)(iv)); *see also G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that the respondent registered and used the domain name in bad faith pursuant to Policy ¶4(b)(iv) because the respondent was using the confusingly similar domain name to attract Internet users to its commercial website).

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <marcgobe.com>, <marcgobe.net> and <marcgobe.biz> domain names be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: January 2, 2008

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