



NATIONAL ARBITRATION FORUM

DECISION

Ebynum Enterprises, Inc. v. Tag-Board.com Corporation
Claim Number: FA0610000817104

PARTIES

Complainant is **Ebynum Enterprises, Inc.** ("Complainant"), represented by **Nicole Andrighetti**, 104 S. Main St, Greenville, SC 29601. Respondent is **Tag-Board.com Corporation** ("Respondent"), Tag-Board.com Corporation, Surabaya Jawa Timur 60000, ID.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**tag-board.com**>, registered with **Computer Services Langenbach Gmbh d/b/a Joker.com**.

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 October 9, 2006; the National Arbitration Forum received a hard copy of the Complaint on October 12, 2006.

On October 11, 2006, Computer Services Langenbach Gmbh d/b/a Joker.com confirmed by e-mail to the National Arbitration Forum that the <**tag-board.com**> domain name is registered with Computer Services Langenbach Gmbh d/b/a Joker.com and that Respondent is the current registrant of the name. Computer Services Langenbach Gmbh d/b/a Joker.com has verified that Respondent is bound by the Computer Services Langenbach Gmbh d/b/a Joker.com 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 October 16, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of November 6, 2006 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@tag-board.com by e-mail.

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

On November 14, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, 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 name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

This case involves an unusual factual scenario. Complainant's predecessor in interest registered the domain name tag-board.com on April 1, 2002, using GoDaddy.com as the registrar. The e-mail address "g14678@yahoo.com" was listed as the administrative contact for that registration. Some time thereafter, and without Complainant's knowledge, the e-mail account was cancelled by Yahoo.com. It is believed that Respondent attempted to send an e-mail to the administrative contact for tag-board.com. Upon realizing that the e-mail account was no longer active, it is believed that Respondent registered with Yahoo.com and acquired the e-mail account "g14678@yahoo.com". It is further believed that Respondent then contacted GoDaddy.com and asked the registrar to send the password for the tag-board.com domain name account to the e-mail address listed as the administrative contact. Once GoDaddy.com e-mailed the password for tag-board.com to the administrative contact, "g14678@yahoo.com", Respondent had access to the registration information. He then changed all of the registration information, listing himself as owner of the domain name, and changed registrars. Respondent has repeatedly threatened and blackmailed Complainant and refuses to return the domain name registration to Complainant.

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following:

1. The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
2. The Respondent has no legitimate interest in respect of the domain names; and

3. The domain name has been used in bad faith.

Each of these grounds will be fully explained below.

[a.] **The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.**

Complainant or its predecessor in interest has been using the trademark tag-board.com continuously since April 1, 2002 in connection with a hosted webservice. Although Complainant lost ownership of the domain name due to Respondent's unauthorized misappropriation, Complainant continues to own and operate a website entitled tag-board.com. Respondent allows the domain name tag-board.com to point at Complainant's IP address, but refuses to relinquish registration of the domain name. Because Complainant's use of the trademark tag-board.com has been continuous since April 1, 2002, Complainant has developed protectable common law trademark rights in the mark tag-board.com.

In addition to Complainant's common law trademark rights in the mark tag-board.com, it filed an application for federal trademark protection of its mark on September 29, 2006. This application has been given the serial number 77/010,270.

Respondent is the current registrant of the domain name tag-board.com. The domain name is identical to Complainant's protectable trademark tag-board.com. Accordingly, the domain name tag-board.com is identical to a trademark in which the Complainant has rights.

[b.] **The Respondent has no legitimate interest in respect of the domain names.**

Although Respondent has kept the domain name pointed at Complainant's IP address, he has not used the domain name for his own bona fide purposes. Respondent is not currently known by the mark tag-board.com and has not been commonly known in the past by the mark tag-board.com. Respondent is not making a legitimate noncommercial or fair use of the domain name. Additionally, Respondent has no connection or affiliation with Complainant and has not been authorized or otherwise licensed by Complainant to use the domain name or otherwise to use Complainant's trademark.

[c.] **The domain name has been used in bad faith.**

The domain name tag-board.com has been acquired in bad faith and is currently being used in bad faith. Firstly, Respondent misappropriated the registration for tag-board.com in early 2005, which constitutes a bad faith acquisition of the domain name. Secondly, Respondent has repeatedly threatened, blackmailed, and interfered with Complainant's business. The threats and blackmail began on March 7th, 2005 with Respondent's e-mail to Complainant, stating:

TAG-BOARD.COM now is mine. If you are smart you can check it and you will find out that I have already get tag-board.com out from godaddy.com and transferred it to SEVERAL REGISTRARS. . . . prepare \$20,000 in cash in a bag . . . I will call you and let you know how to drive and then throw the money to me. . . . If you try to contact any party included IP provider, FBI or domain registrar will result in an immediate selling action for tag-board.com domain to 3rd traffic speculator. . . . Please note that I'm not negotiate with you at all, prepare \$20,000 in cash within 24 hours. . . or say goodbye to tag-board.com.

Complainant replied to Respondent, refusing to pay the \$20,000. Respondent, however, continued to threaten Complainant, in full knowledge that his actions were “illegal”. In fact, Respondent stated on March 11, 2005:

I doubt that FBI can get your domain back with no complete proof from your side. But you guys should be careful with FBI. If I got caught and get investigated by them, I can easily do chargeback for the latest domain transfer transaction so the current registrar for this domain will angry and delete your domain without wait the expire date (yes, all registrars will delete the domain if they get any chargeback issue) and this way you put yourself into the big risk losing the domain because there's tons of 'traffic speculators' . . . willing to spend ALOT of money to grab it once available on the market through several real-time back-order services. . . . I know it's illegal but I SHOULD give you some lesson to respect your FREE members.

Threatening e-mails continued in July and August of 2006. On August 2, 2006, Respondent e-mailed Complainant and threatened to redirect the domain name tag-board.com to another IP address permanently unless Complainant put advertising links for Respondent on the tag-board.com website:

OK, it's time to pay [for] what Greg did to me . . . NO questions asked! You have 24 hours to do it or I will close it permanently. Don't believe it? Try it. . . . Please note that even attempting to contact any 3rd party will result in an immediate removal of your site.

To avoid having the domain name redirected and losing necessary revenue, Complainant placed the requested advertising on its website. Since that time Complainant has not heard from Respondent.

From the above e-mails, it is clear that Respondent has misappropriated the domain name tag-board.com primarily for the purpose of harassing and blackmailing the Complainant. He has offered to sell the domain name registration to the Complainant, who is the owner of the trademark, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name. Respondent has also blackmailed

Complainant into placing advertising for Respondent on Complainant's website. It is clear that Respondent has acquired the domain name primarily for the purpose of disrupting Complainant's business.

In summary, the Complainant has shown that (1) the domain name "tag-board.com" is identical to a trademark or service mark in which the Complainant has rights; (2) the Respondent does not have rights or legitimate interests in respect to the domain name "tag-board.com"; and (3) the domain name is being used in bad faith.

B. Respondent failed to submit a Response in this proceeding.

C. Additional submission.

At the Panel's direction, Complainant timely submitted the following additional material, which was duly considered:

Under the mark Tag-Board.com, Complainant provides a hosted webservice which allows web site owners to easily create a way for their visitors to communicate with one another. By registering a username with Tag-Board.com and adding a small segment of code to a location of their choice on their website, Tag-Board.com customers can create a highly customizable box on their website which allows visitors to leave messages for each other. Currently, Tag-Board.com has over 500,000 customers. About 5,000 of these customers pay a monthly or yearly renewable registration fee in order to use the services of Complainant. Nearly 500,000 of Complainant's customers utilize the services of Complainant for free but accept advertising with their contract.

The domain name Tag-Board.com was registered in April of 2002. The hosted webservice has been in continuous operation since the site went live in April 2002. Because Complainant has been continuously using the mark Tag-Board.com in commerce in connection with a hosted webservice for nearly five years, he has developed significant common law trademark rights in the mark. Complainant's use of the mark is a *bona fide* use in commerce, in that he generates significant revenue through the sale of his hosted webservices under the trademark Tag-Board.com. Complainant also advertises his services under the trademark Tag-Board.com, primarily on his website.

When Respondent learned of the present arbitration proceeding, he intentionally redirected the domain name Tag-Board.com toward an unrelated site, seriously interfering with Complainant's business. Complainant is currently operating his hosted webservice under the domain name Tag-Board.biz until this arbitration is resolved. If the Arbitrator would like more information about Complainant's services, he may be interested in visiting www.tag-board.biz. The Arbitrator will see that the advertising on www.tag-board.biz continues to use the trademark Tag-Board.com in connection with Complainant's services.

Based on the foregoing, Complainant believes that it has a protectable right in the trademark Tag-Board.com.

FINDINGS

Complainant, Ebynum Enterprises, Inc., and its predecessor in interest previously registered and owned the <tag-board.com> domain name on April 1, 2002. Respondent, however, misappropriated the disputed domain name sometime in early 2005. From April 1, 2002 until early 2005, Complainant used the disputed domain name in connection with a "hosted webservice" to provide a messaging service for its members. Currently, the <tag-board.com> domain name resolves to a website that features links to various commercial web pages.

Complainant recently applied for a trademark registration with the United States Patent and Trademark Office ("USPTO") (Serial No. 77/010,270 filed September 29, 2006). Complainant's application is still pending.

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 submit a response, 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

Respondent's <**tag-board.com**> domain name is identical to Complainant's mark (which is Complainant's trade name).

While Complainant has filed an application for a trademark registration with the USPTO on September 29, 2006, mere application for rights neither creates nor establishes Complainant's rights pursuant to Policy ¶4(a)(i). *See ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 14, 2003) ("Complainant's mere application to the USPTO to register the ECG mark is insufficient to establish rights to the mark."); *see also Razorbox, Inc. v. Skjodt*, FA 150795 (Nat. Arb. Forum May 9, 2003) ("Complainant's pending trademark application does not in and of itself demonstrate trademark rights in the mark applied for.").

However, Complainant has established common law rights to the <**tag-board.com**> name by its continuous use of the mark since April 1, 2002, *LD Products v. Brassring Taxation Company*, FA0607000758792 (9/13/2006). These common law rights are adequate under the UDRP policy

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

Rights or Legitimate Interests

Complainant has alleged Respondent lacks rights and legitimate interests in the <**tag-board.com**> domain name. Complainant has the initial burden of proof in establishing Respondent lacks rights or legitimate interests in the disputed domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden then shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent"); *see also Woolworths plc. v. Anderson*, D2000-1113 (WIPO Oct. 10, 2000) (finding that, absent evidence of preparation to use the domain name for a legitimate purpose, the burden of proof lies with the respondent to demonstrate that it has rights or legitimate interests).

Respondent's failure to answer the Complaint raises a presumption Respondent lacks rights and legitimate interests in the <**tag-board.com**> domain name. *See Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("[Rule 14(b)] expressly provide[s] that the Panel 'shall draw such inferences' from the Respondent's failure to comply with the rules 'as it considers appropriate.'"); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding it appropriate for the panel to draw adverse inferences from the respondent's failure to reply to the complaint). The Panel will now examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Respondent has registered the disputed domain name under the name “Tag-Board.com Corp.” which apparently does not exist as a corporation. Respondent is not commonly known by the <tag-board.com> domain name. Complainant asserts Respondent is not authorized to use Complainant’s tag-board.com mark, and Respondent is not associated with Complainant in any way. In *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000), the panel found no rights or legitimate interest where the respondent was not commonly known by the mark and had never applied for a license or permission from the complainant to use the trademarked name. See *Brown v. Sarrault*, FA 99584 (Nat. Arb. Forum Oct. 16, 2001) (finding that the respondent was not commonly known by the <mobilitytrans.com> domain name because it was doing business as “Mobility Connections”).

Respondent’s has not engaged in any *bona fide* use of the <tag-board.com> domain name since acquiring it.

This is also not a legitimate non-commercial or fair use under Policy ¶4(c)(iii). See *Coryn Group, Inc. v. Media Insight*, FA 198959 (Nat. Arb. Forum Dec. 5, 2003) (finding that the respondent was not using the domain names for a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use because the respondent used the names to divert Internet users to a website that offered services that competed with those offered by the complainant under its marks); see also *Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) (“Respondent’s appropriation of [Complainant’s] SAFLOK mark to market products that compete with Complainant’s goods does not constitute a bona fide offering of goods and services.”).

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

Registration and Use in Bad Faith

Respondent has registered and is using the <tag-board.com> domain name in bad faith pursuant to Policy ¶4(b)(iii). The ransom emails Respondent sent make it very clear Respondent was not acting in good faith either at the time it acquired the domain name and at the present time.

Respondent has also provided false *whois* information, which also allows the Panel to infer Respondent’s bad faith.

Respondent is using the disputed domain name to intentionally disrupt Internet users attempting to locate Complainant’s site. In *S. Exposure v. S. Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000), the panel found the respondent registered the domain name in question to disrupt the business of the complainant, a competitor of the respondent. See *Surface Prot. Indus., Inc. v. Webposters*, D2000-1613 (WIPO Feb. 5, 2001) (finding that, given the competitive relationship between the complainant and the respondent, the respondent likely registered the contested domain name with the intent to

disrupt the complainant's business and create user confusion). As such, the Panel finds Respondent's use of the <tag-board.com> domain name constitutes disruption and is evidence of bad faith registration and use under Policy ¶4(b)(iii).

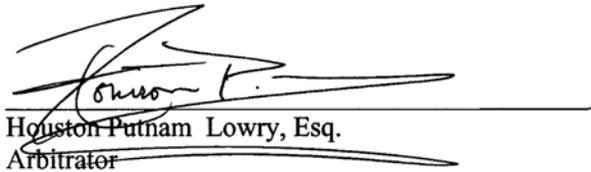
The Panel further finds Respondent has registered and is using the disputed domain name to profit commercially from the goodwill associated with Complainant's tag-board.com mark (even though the mark was unregistered at the time Respondent began its activities). Seeking to ransom a domain name makes this so obvious that this conclusion does not require any significant elaboration.

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 <tag-board.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: December 15, 2006

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