



# CPR Institute for Dispute Resolution

**STAFF USA, INC.**  
P.O. Box 2699  
Granite Bay, CA 95746  
Tel. (916) 772-3333  
Fax (916) 772-2233  
E-mail: jobs@staffusa.org

File Number: CPR00 0229

Date of Commencement: November 27, 2002

Domain Name(s): staffusa.net

Registrar: Network Solutions, Inc.

Arbitrator: Roderick M. Thompson

vs.

**STAFF USA, INC.**  
2929 E. Commercial Blvd.  
Fort Lauderdale, FL 33308  
Tel. (800) 793-5500  
Fax (954) 938-3789  
E-mail: theexplorer@msn.com

Before Roderick M. Thompson, Arbitrator

## PROCEDURAL HISTORY

The Complaint was filed with CPR on November 25, 2002 and, after review for administrative compliance, served on the Respondent on November 27, 2002. The Respondent served a Response on or before December 10, 2002. I was appointed Arbitrator 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 (dated November 25, 2002), the Response (dated December 10, 2002) and email correspondence regarding whois information from the registrar (dated November 27-December 6, 2002), I find as follows:

## FINDINGS

Respondent's registered domain name, staffusa.net, was registered with Network Solutions, Inc. on May 27, 1999. 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 staffusa.net is identical or confusingly similar to Complainant's trademark, STAFF USA, INC AND DESIGN, which applies to Temporary Employment Agency services.

Complainant limits its claim to rights under the Federal Trademark Registration. No claim to common law trademark rights is made. The Trademark Registration states a first use in commerce date of February 8, 1999, which is before the registration of staffusa.net, but the trademark registered on October 10, 2000, which is after the date of domain name registration.

The word portion of the composite mark STAFF USA, INC AND DESIGN is identical to the words used (without spaces or the period) in the domain name. However, the Trademark Registration contains a disclaimer of those very words: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STAFF USA, INC." APART FROM THE MARK AS SHOWN." The mark as shown includes a prominent design—a large star with two rainbow-like beams shooting out from its left side. Thus only the composite mark, the words and the design taken as a whole, is protected by the Federal Trademark Registration. No right is claimed to use of the words apart from the star design.

Complainant could still have claimed common law trademark rights to the disclaimed words.<sup>1</sup> However, as noted, Complainant has made no such allegation in the Complaint, and is therefore relying only on the rights arising from its Federal Trademark Registration.

I therefore conclude that the registered domain name is not identical or confusingly similar to a trademark or service mark in which Complainant has asserted rights.

As I have determined that Complainant has failed to satisfy the first required finding of UDRP Paragraph 4, there is no need to consider whether the requirements of paragraph 4(b) and (c) have been met.

## **CONCLUSION**

In light of my finding that the registered domain name is not identical or confusingly similar to a trademark or service mark in which Complainant has rights, I find in favor of the Respondent.

## **REMEDY**

Complainant's request to transfer the domain name staffusa.net is hereby DENIED.

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Signature of Arbitrator

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Date

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<sup>1</sup> The pertinent statute, 15 U.S.C. §1056, reads:

(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.

An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer, including those made under subsection (e) of section 7 of this Act, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.