



CPR Institute for Dispute Resolution

COMPLAINANT

Name Source Marketing LLC
Address 15 Ketchum Street
Address Westport, CT 06880
Telephone 203.291.4000
Fax 203.291.4010
E-mail Riordan@Source-Marketing.com

File Number: CPR0405

Date of Commencement: June 15, 2004

Domain Name(s):
“sourcemarketing.com”

Registrar: Network Solutions, Inc.

vs.

Arbitrator: Louise E. Dembeck, Esq.

RESPONDENT

Name: Strata Graphics, Inc.
Address: 2000 Butler Pike
Address Conshohocken, PA 19428-1203
Telephone 610.941.6100
Fax 999.999.9999
E-mail jeff@stratagraphics.com

Before Louise E. Dembeck, Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on June 11, 2004 and, after review for administrative compliance, served on the Respondent on June 15, 2004. The Respondent filed a timely Response on or before July 9, 2004. I was appointed Arbitrator on July 15, 2004 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 all attachments and the Response and all attachments, I find as follows:

FINDINGS

Respondent's registered domain name, "sourcemarketing.com", was registered with Network Solutions, Inc. on February 5, 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 in "January of 1989, Pepsi marketer Howard Steinberg conducted an exhaustive trademark search on the name Source Marketing in contemplation of investing in the creation of a national marketing services business called Source Marketing." Complainant further alleges that, "with no other regional or national company identified with the name Source Marketing providing any kind of reasonably similar services, Source Marketing Inc. was officially established with the Secretary of the State of Connecticut in July 1989" and, "[s]ince then, it has used and promoted itself nationally, exclusively and only under the Source Marketing name, as it built a national reputation within the promotional marketing and marketing services industry, performing services" for a wide range of Fortune 500 companies.

The Complainant states that in 1997, when it first created its website, the URL "sourcemarketing.com" was not available. Accordingly, it registered, instead, the URL "sourcemkt.com." The Complainant does not indicate who owned the domain name "sourcemarketing" at that time, if it knew; but states that, in 1999, when it was updating its website, it investigated the then ownership of the domain name "sourcemarketing" and subsequently, a dialogue ensued between the Complainant and the Respondent, Strata Graphics Inc.

The Complainant alleges that after negotiations to purchase the domain name "sourcemarketing.com" from the Respondent broke down, the Respondent renewed its registration through 2008 and the Complainant settled on using a hyphenated version of the domain name: 'source-marketing.com.'

The Respondent maintains that the Complainant has no special protection for the name “Source Marketing” because, as the Respondent claims to have discovered when it looked into protecting the name in 1999, “there are too many forms already in use by others to get trademark status.” As support for this position, the Respondent has attached a copy of a trademark search report prepared for the Respondent in January, 1999 which revealed, among other things, an exact match for the mark SOURCE MARKETING as a State of Minnesota registration dating back to December 1, 1989, registered by a Sharon Barlass of Plymouth, Minnesota.

The Respondent alleges that it “registered the name with the State of Pennsylvania in 1999 and has the right to use it” although the evidence attached to the Response suggests that the Respondent’s April 1999 application to register “Source Marketing Services” as a fictitious name with the Pennsylvania Department of State was returned because the proposed name was not available due to a conflict with a prior registration issued to a third party, Source Marketing, Inc., in Malvern, Pennsylvania. The Respondent submitted a photocopy of a 4-page brochure with graphic design as evidence of its own use of the term “source marketing” as a service mark or trade name use, although no information is provided regarding dates of use or extent of circulation of this brochure.

DISCUSSION

The evidence in the record of negotiations between the two companies appears in the attachment to the Complaint as an exchange of emails between October 2000 and early November 2000 which suggest, *inter alia*, that the Complainant offered to purchase the domain name from the Respondent, a price was agreed but negotiations broke down over the timing of the proposed transfer – the Complainant apparently wanted the transfer to take place no later than December 1, 2000; the Respondent maintained it could not vacate the site and notify all its clients until January 1, 2001. These negotiations conclude with the Complainant’s email to the Respondent stating: “Sorry Jeff: Our timing doesn’t align. If we can’t have it sooner, it’s not worth it. We’ll take a pass. Thanks.”

Although at the time of the exchange of emails between the parties, the Complainant was still using a “sourcemkt.com” email address, in one email communication, dated October 31, 2000, the Complainant advises the Respondent that the Complainant has the hyphenated domain name ‘source-marketing.com.’ There is no explanation in the record regarding the Complainant’s registration of the hyphenated URL “source-marketing.com,” but according to a WHOIS search, the hyphenated version of the domain name was created by the Complainant on January 25, 2000.

There is also no explanation, in the evidence before this Arbitrator, illuminating the relationship between the Complainant in this proceeding, Source Marketing LLC, a limited liability company, and Source Marketing, Inc., the corporation established with the Secretary of State of Connecticut in July, 1989,

which the Complainant claims began using the tradename “Source Marketing” in 1989. It may be merely a legal conversion or it may be two (2) separate companies; but, for purposes of this proceeding, it has been assumed that there is a relationship, and a continuity of interest in the name, so that the lack of explanation is not deemed material to the outcome of this proceeding.

It should be noted that, although not mentioned by either party in record before this Arbitrator, on the Home and Contact Pages of the Complainant’s current website, www.source-marketing.com, the Complainant is identified solely by the trade name, Source Marketing.

Although it is patently clear that the disputed domain name is identical to the name registered by the Complainant with the Secretary of State for the State of Connecticut (and to the trade name currently appearing on the Complainant’s website), this does not give the Complainant exclusive rights to the domain name. (See, *Weatherford Int’l, Inc. v. Wells*, FA 153626 (Nat. Arb. Forum May 19, 2003)(holding that simply operating under a business name does not, per se, constitute secondary source identification sufficient to warrant a finding of common law rights in a mark; see also, *Cyberprints.com, Inc. v. Alberga*, FA 100608 (Nat. Arb. Forum Dec. 11, 2001) (finding that the Complainant did not establish rights to CYBERIMPRINTS.COM mark within the meaning of Policy Par. 4(a)(i) merely by registering its company name CYBERIMPRINTS.COM, INC. with the California Secretary of State.)

The Complainant does not assert ownership of any registered trademark or service mark nor does the Complainant allege that it has ever filed a trademark or service mark application for the mark “source marketing.” While the Policy does not require that a trademark be registered (See, *Great Plains Metromall, LLC v. Creach*, FA 97044) (Nat. Arb. Forum May 18, 2001), in the absence of registered rights, it is incumbent upon the Complainant to establish unregistered rights. The Policy requires the Complainant to prove that the disputed domain name is identical or confusingly similar to “a trademark or service mark in which the complainant has rights.” Policy at ¶ 4(a)(i).

Presumably, the Complainant is relying on common law service mark rights. To do so, successfully, however, the Complainant must prove prior use and distinctiveness by alleging, and proving, that the mark in question is used to identify the source or sponsorship of certain services and that there is strong customer identification of the mark with the Complainant as indicating the source of such services.

In this case, the mark in question is comprised of two generic terms which, together, are vulnerable to being considered merely descriptive. Such marks may still be protected if they have acquired distinctiveness or secondary meaning through use. The factors typically considered include (1) length and manner of use; (2) manner and extent of advertising and promotion; (3) sales volume; and (4) survey evidence. (See, *Home Mortgage Corp. v. Platinum Financial Group*, 149 F.3d 722 (7th Cir. 1998); *Investacorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519 (11th Cir. 1991).)

The threshold test, under the Policy, places the burden on the Complainant. Even if Complainant’s assertion that it has used its name since 1989 performing services for a host of Fortune 500 companies is accepted, however, there is no evidence in the record before this Arbitrator, by way of exhibits or affidavits, regarding the other relevant factors for determining secondary meaning, such as the manner in which the name has been used during that period of time, the nature and extent to which the name has been advertised or promoted, the volume of services provided under the name or the reaction of even a particular segment of the

community to the name.

Moreover, the Respondent has drawn attention to other uses, by unrelated third parties, both prior and contemporaneous, of the term “source marketing” and the Complainant admits that its first attempt to register the domain name was blocked by a prior, unidentified, registrant.

Basically, the Complainant has failed to present any evidence of secondary meaning, beyond the bald allegations of its complaint, while Respondent has shown that the mark is comprised of generic and/or descriptive terms, and, in any event, is not exclusively associated with Complainant’s business.

Because Complainant has failed to allege or prove that it holds trademark or service mark rights in the disputed domain name, this Arbitrator concludes that Policy ¶ 4(a)(i) has *not* been satisfied. Since a Complainant must prove all three elements under the Policy, the Complainant’s failure, in this case, to prove one of the elements, the first, makes further inquiry into the remaining elements, under 4(a)(ii) and 4(a)(iii), unnecessary. It is, therefore, not necessary to determine whether Respondent had rights or legitimate interests in respect of the domain name at issue or whether it was registered and is being used in bad faith.

CONCLUSION

In light of my findings above that the Complainant has failed to meet the requirements of Paragraph 4(a)(i) of the Policy, the Complaint against the Respondent is dismissed.

REMEDY

Complainant's request to transfer the domain name "Sourcemarketing.com" is hereby DENIED.

Louise E. Dembeck

Dated: July 28, 2004