

CPR International Institute for Conflict Prevention and Resolution

575 Lexington Avenue □ New York, NY 10022 □ Tel. (212) 949-6490 □ Fax (212) 949-8859 □ www.cpradr.org

COMPLAINANT

Insurance Services Office, Inc.
545 Washington Blvd.
Jersey City, New Jersey 07310-1686
Tel: (201) 469-2979
Fax: (201) 748-1441
E-mail: csamay@mccarter.com
aschwartz@mccarter.com

File Number: CPR-06-01

Date of Commencement: January 4, 2006

Domain Names: claimsearch.com;
claim-search.com

Registrar: Moniker Online Services, Inc.

vs.

Arbitrators: Peter L. Michaelson, Esq. (Presiding)
Hon. Daniel Banks
M. Kelley Tillery, Esq.

RESPONDENTS

Nat Collicot and SolidDomains.com, Inc.
P. O. Box 2202
Fort Bragg, California 95437
Tel: (707) 964-7464
Fax: (707) 964-7464
E-mail: john@johnberryhill.com
jberryhill@gmail.com

Before Peter L. Michaelson, Esq., Hon, Daniel Banks and M. Kelley Tillery, Esq., Arbitrators

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved on October 24, 1999 and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") as approved on October 24, 1999 and the CPR International Institute for Conflict Prevention and Resolution ("CPR") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect ("the Supplemental Rules").

The Complaint, including accompanying Exhibits A-E, was filed with CPR on December 23, 2005 and, after review for administrative compliance, served on the Respondents. This proceeding commenced on January 4, 2006. On January 25, 2006, the Respondents filed their Response, together with Exhibits A-E, with CPR. Shortly thereafter, on January 31, 2006, the

Complainant filed a Reply with CPR followed on February 1, 2006 with the Respondents having filed their Reply with CPR. Then on February 13, 2006, the Complainant filed a Supplemental Submission with CPR. The Respondents followed by filing their Supplemental Submission with CPR on February 15, 2006.

Meanwhile, on February 3, 2006 and pursuant to the Policy and the Rules, CPR appointed Mr. Peter L. Michaelson, Esq. as the presiding panelist and Hon. Daniel E. Banks and Mr. M. Kelly Tillery, Esq., as co-panelists.

CONTESTED DOMAIN NAMES

The contested domain names, <CLAIMSEARCH.COM> and <CLAIM-SEARCH.COM>, were registered by the Respondents with the Registrar on April 17, 2002 and October 18, 2004, respectively. In registering these names, the Respondents agreed to submit to this forum to resolve any dispute concerning the domain names, pursuant to the Policy, and are now so bound.

FINDINGS

Paragraph 4(a) of the Policy provides 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.

Upon the written submitted record including the Complaint and the Response and their corresponding Exhibits, the replies and the supplemental submissions -- all of which were fully considered, we find as follows.

A. BACKGROUND

The Complainant alleges that the contested domain names, <CLAIMSEARCH.COM> and <CLAIM-SEARCH.COM> are identical or confusingly similar to Complainant's federally registered service marks, ISO CLAIMSEARCH and CLAIMSEARCH, which the Complainant uses in conjunction with the services of "providing information about insurance claims, via a global computer network".

In particular, the Complainant owns two United States service mark registrations, on which this dispute is based, for marks that either constitute or include the term "CLAIMSEARCH". One such registration is on the Supplemental Register. The Complainant has provided, in Exhibit C a copy of each of the corresponding registration certificates. The pertinent details of these registrations are as follows:

- 1) ISO CLAIMSEARCH (block letters)
Registered on the Principal Register
US registration 2,368,227; registered July 18, 2000
Disclaimer reads: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE
'CLAIM SEARCH' APART FROM THE MARK AS SHOWN."
This mark was registered for use in connection with: "Providing information about insurance claims via a global computer network" in international class 36. The registration states that first use and first use in commerce of the mark in conjunction with this service commenced as of November 30, 1998.
- 2) CLAIMSEARCH (block letters)
Registered on the Supplemental Register
US registration 2,346,231; registered April 25, 2000
This mark was registered for use in connection with: "Providing information about insurance claims via a global computer network" in international class 36.

ISO ClaimSearch is a large database of insurance claims information which specifically contains information on over 412,000,000 claims. This database is a relational database which uses Complainant's proprietary technology to predict a likelihood that fraud has occurred in the submission of an insurance claim. According to the Complainant, this database is the "only source of property and casualty insurance claims to be used for claims adjudication and fraud detection".

The Complainant is the parent company of the ISO family of companies. The Complainant's wholly-owned subsidiaries, ISO Properties, Inc. and ISO Services Properties, Inc., are the owners of record of the registrations for the ISO CLAIMSEARCH and the CLAIMSEARCH marks. The Complainant uses these marks through exclusive worldwide licenses. The Complainant claims it has common law trademark rights in these marks as well, based on its use of these marks commencing in November 1998 in conjunction with its ISO ClaimSearch database. The Complainant has invested a substantial sum of money promoting these marks and therethrough establishing goodwill and secondary meaning in these marks, as particularly identifiers of the Complainant's products and their source.

Presently, each of the contested domain names resolves to a "parked page" maintained by a service that places sponsored links on that page and, through that page, provides access to a search engine. When an Internet user enters a term into the search engine, the engine generates and displays, on that page, a list of sponsored links tailored to the search then conducted. Search terms that users have recently entered into the search engine are subsequently displayed on the website as lists of "Popular Links" and "Popular Categories." The Complainant provided, in Exhibit D a copy of this page, as it appeared on August 5, 2005 and which included the terms "Claim Search Iso", "Iso Forms", "Iso" and "Insurance Claims".

B. CONFUSING SIMILARITY/IDENTICALITY

The Complainant contends that each of the contested domain names is confusingly similar, if not

identical or virtually so, to its marks. In that regard, the Complainant notes that the only difference between its mark CLAIMSEARCH and the contested domain name <CLAIMSEARCH.COM> is the addition of the generic top level domain (gTLD) ".com" to the name, and with respect to the contested domain name <CLAIM-SEARCH.COM> is, apart from the gTLD, the addition of the hyphen between the terms "CLAIM" and "SEARCH". Further, the Complainant contends that, as to its mark ISO CLAIMSEARCH, the contested domain names are confusingly similar to that particular mark owing to their mere omission of the term "ISO" -- which is a term with which the Complainant's customers are quite familiar and hence its omission does not negate consumer confusion. Specifically, the Complainant believes that its consumers, being familiar with the term "ISO" and the Complainant's ISO CLAIMSEARCH product, may easily infer that ISO CLAIMSEARCH is the conjunction of two individual marks and seek out the ISO ClaimSearch database at the Respondents' web site resolvable through either of the contested domain names <CLAIMSEARCH.COM> or <CLAIM-SEARCH.COM>.

The Respondents essentially contend that, as to the mark ISO CLAIMSEARCH, the Complainant, through its disclaimer, expressly renounced any exclusive trademark rights it might otherwise have in the term "CLAIMSEARCH", apart from that entire mark, and is now effectively, through its arguments here, trying to recapture those rights and assert them against the Respondents.

Furthermore, the Respondents contend that, as to any common law trademark rights which the Complainant is asserting, the Complainant has simply not provided any evidence of the reputation and distinctiveness which its marks have attained in the marketplace and thus has not proved that it has any viable common law rights in either of those marks.

Inasmuch as both the Complainant and Respondents amplify, in their respective replies, their arguments concerning the effect of the disclaimer, and whether the Complainant has shown any acquired distinctiveness in the term "CLAIM SEARCH" and thus has any federal or common law rights in its marks, the Panel sees no need to summarize those portions of the replies. Further, the additional submissions submitted by both parties raise an issue as to whether the Respondents' recent conduct in changing its use of the <CLAIMSEARCH.COM> name to re-direct Internet users to its web site resolvable by the name <CLAIM-SEARCH.COM> constitutes bad faith. Inasmuch as any consideration of bad faith is unnecessary to the Panel's disposition of this proceeding, these additional submissions will not be addressed any further.

This dispute involves two contested domain names that are each to be assessed against two separate trademarks. As a threshold matter, under paragraph 4(a)(i) of the Policy, the Panel has considered whether the Complainant actually has trademark rights in either of its two CLAIMSEARCH-based marks so as to invoke paragraph 4(a)(i). The Panel has separately considered each of these marks and, for reasons given below, has concluded that the Complainant has no such rights in either mark.

1. US registration 2,368,227 -- "ISO CLAIMSEARCH"

It is well established that trademark disclaimers only apply to a specific registration in which the disclaimer was made.

Hence, through disclaiming the term "CLAIM SEARCH", the Complainant has voluntarily relinquished all trademark rights whatsoever to the term "CLAIM SEARCH" but only in conjunction with this particular mark. Hence, for purposes of this registration, the Complainant's only trademark rights are to the entire phrase "ISO CLAIMSEARCH".

In that regard, see, *Salem Five Cents Savings Bank v. Direct Federal Credit Union* FA103058 (Nat. Arb. Forum, February 15, 2002), in which the panel in the context of evaluating a complainant's disclaimer of the term "directbanking.com" in its federal registration for a stylized mark that included that term, commented on the effect of a disclaimer -- comments that are of equal import here:

"However, for federal purposes, the Complainant has expressly disclaimed any rights in the words "directbanking.com" themselves. Regardless of the Complainant's reason behind the disclaimer, i.e., as it suggests 'solely for the purpose of obtaining approval of this application' (see the Complainant's Response filed January 5, 2001 in the US PTO appearing in Annex H to the Response), the fact is that the Complainant acquiesced to the Examiner's request. While doing so clearly did expedite approval of the application -- by resolving an issue raised by the Examiner, nevertheless, this acquiescence was willingly made and manifested acceptance of a 'bargain' offered by the Examiner: disclaim the term and the application will be approved. If the Complainant felt that the term was not merely descriptive, then it should have rejected the Examiner's offer and filed argumentation, supplemented by appropriate and adequate evidentiary proof, to the effect that the term 'directbanking.com' was not descriptive. It simply did not do so and will be held to the consequences of its bargain.

In viewing the effect of disclaimers, the US Circuit Court of Appeals for the Eleventh Circuit in *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 41 U.S.P.Q.2d 1896 (CA11 1997) stated at page 1902, quoting from *McCarthy on Trademarks and Unfair Competition* (3d ed. 1992) at § 19.20 [1]:

'The disclaimer does not have the effect of removing from the registered mark the matter disclaimed. It disclaims only a claim that the federal registration gives an exclusive right in those disclaimed words or symbols per se. That is, *the applicant is merely stating that he is claiming only the whole composite mark as his property*, and makes no claim to those particular portions disclaimed'. "
(emphasis in original).

Hence, given that each of the contested domain names <CLAIMSEARCH.COM> and <CLAIM-SEARCH.COM> solely consists of the portion of the mark which the Complainant willingly disclaimed, the mark ISO CLAIMSEARCH is of no avail to the Complainant as it provides no rights which the Complainant can now assert against either of those names. Therefore, the Panel will ignore the mark ISO CLAIMSEARCH going forward.

2. US registration 2,346,231 -- "CLAIMSEARCH"

The Supplemental Register is one which the PTO maintains for those marks, while being

descriptive, might through sufficient use over time acquire requisite distinctiveness and thus function as trademarks. There is no presumption attached to marks on the Supplemental Register that they are distinctive (which is the case on the Principal Register) or that they are not.

Once a mark has been registered on the Supplemental Register, its owner may transfer that mark to the Principal Register by filing, with the US Patent and Trademark Office (PTO), an affidavit/declaration of continued use (under Section 8 of the Lanham Act), based on five years or prior exclusive and continuous use, along with an amendment which changes the register from the Supplemental to the Principal Register. Specifically, 15 USC 1052(f) (Section 2(f) of the Lanham Act) states:

"The Director [of the PTO] may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the Applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made."

Now, with that in mind, in order for the Complainant to have rights of exclusivity in its mark CLAIMSEARCH, that mark must have acquired distinctiveness through sufficient prior use. If the Complainant can not show, in its Complaint, that its mark CLAIMSEARCH has yet to acquire requisite distinctiveness, then the Complainant has no trademark rights in that mark (both federally as well as at common law, since, as to the latter, common law marks derive their rights of exclusivity from distinctiveness arising solely out of prior use).

The record before the Panel is totally remiss of any evidence indicating that the Complainant made such a showing in its Complaint. Specifically, no evidence has been adduced by the Complainant as to how the mark was used; the expenses which the Complainant incurred in advertising, marketing and related activities associated with promoting the mark; and the resulting distinctiveness which the mark gained in the marketplace (given that distinctiveness is itself very hard to measure, its existence is usually presumed from sufficient activities that can be directly measured, such as marketing expenses, advertising efforts and channels used, etc.). In that regard, all the Complainant states in the record is:

"The trademarks have been used in commerce in connection with the above described product since at least as early as November 1998. Annual sales related to ISO ClaimSearch are approximately \$ 75 Million. Complainant has invested a substantial sum of money promoting and establishing the Trademarks in the minds of customers as the source of a unique, industry-leading database product. Through ISO's marketing and continuous, extensive and prolonged use, ISO CLAIMSEARCH and CLAIMSEARCH hold very substantial goodwill, value and recognition as identifiers of the ISO ClaimSearch product and its source."

The Panel finds that all these statements are simply unfounded and unsubstantiated allegations which fail to prove that, as of December 23, 2005 when the Complaint was filed, the mark CLAIMSEARCH has acquired any distinctiveness in the marketplace. The burden is squarely on the Complainant to prove that its mark CLAIMSEARCH has acquired the requisite

distinctiveness at a sufficiently early date. The Complainant's mere allegation in its Complaint that its mark has acquired distinctiveness simply does not make it so. Far more is needed. The Complainant simply failed to meet its burden.

Consequently, the Complainant has not proved that it possessed any rights of exclusivity in the mark CLAIMSEARCH, whether through its supplemental service mark registration and correlatively at common law.

Although paragraph 4(a)(i) provides no express point in time as to when trademark rights must have arisen to invoke this paragraph, by implication, this paragraph requires that a complainant have "prior" trademark rights, meaning that actual rights of exclusivity must exist in the complainant at least as early as the date it files its complaint, if not sooner.

Any contrary interpretation would allow a complainant to file its complaint predicated solely on an aspiration or expectation: basically illusory trademark rights which, at some unknown time later, might spring into existence. This, in turn, would allow the complainant, who could be viewed as a junior user, to simply "reserve its rights" and, through so doing, successfully challenge a respondent's prior domain name registration at a time when that complainant had no actual trademark rights on which to do so, thus completely frustrating any legitimate justification a respondent might otherwise have to register and use its domain name. Such an outcome clearly contravenes the intent of the Policy, and one which will not be sanctioned here. Either a complainant has valid trademark rights at the time it files its complaint, or it does not. Here, the Complainant did not.

Various ICANN Panels have considered the issue of when must a complainant first have rights of trademark exclusivity, i.e., how far back in time must those rights exist, to constitute "prior rights" sufficient to satisfy paragraph 4(a)(i). One view espoused by various panels is that such rights must arise no later than the dates a contested domain name was both registered and used; while another, consensus, view (see "WIPO Overview of WIPO Panel Views on Selected UDRP Questions", questions 1.4) holds that such rights need not predate the domain name registration. As reflective of the first view, consider, e.g., *Phoenix Mortgage Corporation v. Tom Toggas*, WIPO Case No. D2001-0101 (March 30, 2001), which held that the complainant's trademark rights must have been in existence as of the date the domain name was registered and used. Also, see, *John Ode d/b/a ODE and ODE - Optimum Digital Enterprises v. Intership Limited*, WIPO Case No. D2001-0074 (May 1, 2001), where the Panel held:

"If paragraph 4a(i) of the Policy means that a Complainant must have rights in a trademark which antedates the date when the domain name in issue was registered, then the Complainant does not meet the requirements of this paragraph. If so he cannot succeed. ... The Panel is of the view that this is arguably an essential requirement of paragraph 4a(i) of the Policy."

An exception exists and bad faith registration can still be found -- though totally unsupported by the present record before this Panel -- where a respondent had prior knowledge of a complainant but nevertheless intentionally proceeded to register its domain name, which included the complainant's mark -- even before the complainant established trademark rights, to exploit, to the respondent's own benefit, inevitable user confusion between the name and the mark. See WIPO

Overview, question 3.1

As to the consensus view, consider *AB Svenska Spel v. Andrey Zacharov*, WIPO Case No. 2003-0527 (October 2, 2003) where the panel stated:

"The Domain Name was registered on August 9, 1998. However, as stated in *Digital Vision, Ltd v. Advanced Chemill Systems*, WIPO Case No. D2001-0827 and other cases, Paragraph 4(a) (i) of the Policy does not require that the trademark be registered prior to the domain name. The fact that the disputed Domain Name predates Complainant's trademark registration may only be relevant to the assessment of bad faith pursuant to Paragraph 4(a) (iii)"

Under either view, prior rights were found only where trademark rights actually existed prior to the date on which a complaint was filed, regardless of whether those rights existed as early as prior to dates of registration and use of a contested domain name or arose later.

Consequently, since no prior trademark rights existed here as of the date the Complaint was filed, then the Complainant has no cognizable rights under paragraph 4(a)(i) of the Policy. Therefore, the Complainant has failed to meet its burden under this paragraph.

B. RIGHTS AND LEGITIMATE INTERESTS; BAD FAITH REGISTRATION AND USE

In view of the Panel's finding that the Complainant did not have trademark rights, when it filed the Complaint, in the term "CLAIM SEARCH", whether through either of its federal registrations or at common law, sufficient to accord it rights under paragraph 4(a)(i) of the Policy and thus failed to meet its burden under that paragraph, then any issues relating to paragraphs 4(a)(ii) and (iii) of the Policy, namely as to whether the Respondents have any valid rights and legitimate interests in either of the contested domain names or has registered and used either of those names in bad faith, are now moot. Thus, the Panel sees no need to either summarize any of the contentions raised by the parties raised under either of these latter paragraphs or rule on any of those issues, and hence declines to do so.

CONCLUSION

Since the Panel concludes that the Complainant has not provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy, the Panel finds in favor of the Respondents.

REMEDY

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the relief requested by the Complainant is DENIED.

Peter L. Michaelson, Esq., Presiding Panelist

March 2, 2006

Hon. Daniel E. Banks, Panelist

March 2, 2006

M. Kelley Tillery, Esq., Panelist

March 2, 2006