

ADMINISTRATIVE PANEL DECISION

MJPS, LLC (dba “Judiciary Process Servers”) v. Freestate Investigations,
Freestate Investigations, LLC
Case No. D2024-3210

1. The Parties

The Complainant is MJPS, LLC (dba “Judiciary Process Servers”), United States of America (“United States”), represented by Honos Law PLLC, United States.

The Respondent is Freestate Investigations, Freestate Investigations, LLC, United States, represented by GOODELL, DEVRIES, LEECH & DANN, LLP, United States.

2. The Domain Name and Registrar

The disputed domain name <judiciaryprocessserver.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 6, 2024. On August 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 6, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On August 8, 2024, the Respondent sent communications to the Center.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent sent a response on August 28, 2024.

On September 3, 2024, the Complainant sent an unsolicited supplemental filing. The Respondent sent an unsolicited supplemental filing on September 10, 2024. These are discussed further below.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on September 13, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a limited liability company established under the laws of the State of Maryland, United States, with principal offices in Pasadena, Maryland. The Complainant operates a website at “www.judiciaryprocessservers.com”, where it advertises its business of serving legal documents in connection with judicial proceedings (“process serving”), “skip tracing” (locating individuals or businesses who owe debts), and providing investigative services such as “stake outs” (surveillance of individuals or premises).

The Complainant registered “Judiciary Process Servers” as a trade name in the State of Maryland on October 13, 2021, and on July 24, 2024.

The Complainant holds United States Trademark Registration Number 7389838, registered May 14, 2024, for JUDICIARY PROCESS SERVERS as a standard character word mark in International Class 45, legal process serving, notary public services, document filing services, surveillance services, and skip tracing services, claiming first use in commerce in January 2021. However, this mark is registered only on the Supplemental Register of the United States Patent and Trademark Office (“USPTO”). Under United States trademark law, this means that the mark is considered to be descriptive and not yet eligible for registration on the Principal Register but is capable of becoming a distinguishing indicator of source over time. Indeed, the USPTO issued a non-final office action in February 2024 on the Complainant’s application for trademark registration, concluding that “[r]egistration is refused because the applied-for mark merely describes a feature, ingredient, characteristic, purpose, function, intended audience of applicant’s goods and/or services”, following which the Complainant amended its application on February 28, 2024, to seek registration on the Supplemental Register.

The disputed domain name was created on November 12, 2023, and is registered to the Respondent Freestate Investigations, LLC of College Park, Maryland, United States. The disputed domain name resolves to a website headed “Freestate Investigations, LLC” advertising the Respondent’s process serving, document delivery, investigation, and skip tracing services. These services are advertised as “nationwide”, as well as in the region of the District of Columbia, Maryland, and Virginia.

The Panel notes that Maryland’s online database of registered companies shows that the Respondent is registered as a Maryland limited liability company that was established in November 2009, with a principal office in College Park, Maryland.

The record shows that the Complainant and the Respondent are competitors and also that at times the Respondent has contracted with the Complainant to perform investigative services for the Respondent. The Complaint attaches a copy of a letter sent from counsel for the Complainant to the Respondent dated July 19, 2024, seeking payment on several overdue invoices for services that the Complainant rendered to the Respondent and rejecting statements made in an earlier email from the Respondent regarding these evidently disputed sums. The letter also demanded that the Respondent cease and desist from using the disputed domain name and “surrender ownership of that web domain”, which differs from the Complainant’s domain name, trade name, and mark only by omitting the final letter “s”. The parties did not resolve their dispute, and the Complaint in this proceeding was filed soon after.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered trademark and trade name JUDICIARY PROCESS SERVERS, differing only by omitting the plural letter "s", and does not correspond to the Respondent's name. The Respondent is not associated with the Complainant other than as having at times obtained services from the Complainant and has no permission to use the Complainant's mark. The Complainant argues that the Respondent has only used the disputed domain name in bad faith to misdirect customers to the Respondent's competing services.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

The Respondent argues that the Complainant does not have a relevant trademark or service mark, as the UDRP complaint cannot be grounded on a trade name or a mark registered only on the USPTO Supplemental Register, and the Complainant has not adduced sufficient evidence of secondary meaning for UDRP purposes.

The Respondent contends that it has a legitimate interest in using the disputed domain name for its preexisting business that is relevant to the meaning of those descriptive terms, "without intent to divert consumers of Complainant or tarnish the alleged mark at issue".

The Respondent further asserts that it did not register or use the disputed domain name in bad faith with the intent to sell it to the Complainant or a competitor or to confuse Internet users but rather because it describes the Respondent's own services.

The Respondent requests a finding of Reverse Domain Name Hijacking, as the Complainant brought the Complaint without standing, failed to mention that it relied only on a registration on the USPTO Secondary Register, and failed to adduce evidence of secondary meaning.

6. Discussion and Findings

6.1 Preliminary Matter: Supplemental Filings

The Rules do not expressly allow for the submission of unsolicited filings. Paragraph 12 of the Rules notes that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case. Paragraph 10(c) of the Rules *inter alia* requires the Panel to ensure that the administrative proceeding takes place with due expedition.

Section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") advises that "Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel.... [P]anels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response. Depending on the content of any admitted supplemental filing, the panel may issue further instructions to the parties, including a rebuttal/reply opportunity to the non-initiating party."

Here, the Complainant replied to the Response by submitting a very brief reply on the issue of “secondary meaning in the trademarked name of Complainant”, asserting that registration on the USPTO Supplemental Register “fully allows a registrant to assert its rights to its trade name in commerce” and attaching two new documents to provide evidence of secondary meaning. The documents are respectively a Google Analytics report showing how much money the Complainant spent advertising its website since March 2021, for 255,000 ad impressions, and a Stripe report showing that consumers spent over USD 1 million on services purchased through the Complainant’s website from January 2021 through August 2024.

The Respondent replied with a supplemental filing arguing, as it had in the Response, that the Complainant’s claimed mark is merely descriptive and citing WIPO UDRP decisions to the effect that registrations on the USPTO Supplemental Register is not evidence of secondary meaning under either United States trademark law or for purposes of the UDRP. The Respondent also cited United States judicial precedents and UDRP decisions to the effect that advertising expenditures and sales over a relatively short period of time did not conclusively establish secondary meaning.

The Panel declines to accept the parties’ supplemental filings.

The Complainant is represented by counsel, and the first element of the Complaint is a requirement to demonstrate standing with evidence of a relevant trademark or service mark (not a trade name). This is not a new issue, or a new set of facts raised by the Response. The [WIPO Overview 3.0](#), paragraph 1.2.2, clearly states that WIPO panels require complainants to furnish sufficient evidence to establish acquired distinctiveness or “secondary meaning” if their trademark registration is listed solely on the USPTO Supplemental Register. Paragraph 1.3 indicates that such evidence “includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.” Thus, the standing requirement was there from the outset, and the Complainant simply failed to furnish the necessary evidence to support a Complaint based on a mark that was registered only on the Supplemental Register.

Having rejected the Complainant’s supplemental filing, the Panel finds no need to accept the Respondent’s.

6.2. Substantive issues

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) and the respondent has no rights or legitimate interests in respect of the disputed domain name;
- (iii) and the disputed domain name has been registered and is being used in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the first element of the Policy has not been established. The Complaint cites two state trade name registrations, but the Policy protects only “trademarks” or “service marks” in which the Complainant has an interest. The Complainant relies on a United States trademark registration on the USPTO Supplemental Register, which cannot of itself ground a UDRP complaint but requires proof that the mark has acquired secondary meaning, as in the case of unregistered or “common law” marks.

[WIPO Overview 3.0](#), paragraph 1.2.2. Barely five months before the disputed domain name was registered and the Complainant launched the current UDRP proceeding, the USPTO found that the Complainant's claimed mark was merely descriptive and had not acquired secondary meaning. The Complainant accepted that finding by amending its application to seek registration on the USPTO's Supplemental Register. The Panel is unwilling to conclude that within five months the Complainant's mark suddenly became so distinctive and well-known that it now should be deemed to have acquired secondary meaning.

The Panel concludes that the Complaint fails on first Policy element.

B. Rights or Legitimate Interests

Given the Panel's finding in the first Policy element, it is unnecessary to reach a conclusion on the second.

C. Registered and Used in Bad Faith

Given the Panel's finding in the first Policy element, it is unnecessary to reach a conclusion on the third.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

Here, the Respondent has requested a finding of Reverse Domain Name Hijacking, which the Panel finds appropriate under the circumstances. While the Respondent appears to be taking advantage of a disputed domain name clearly emulating the Complainant's trade name and domain name (and the Complainant may choose to seek legal recourse for such conduct in another forum), the Policy Complaint was ill-advised. It was expressly grounded on trade names rather than a trademark, as well as a very recent trademark registration that was only on the USPTO Supplemental Register. This meant that the Complainant itself had recently acknowledged that the mark was descriptive and would require time to acquire secondary meaning. The Complainant is represented by counsel and cannot be excused for overlooking such obvious flaws in the Complaint.

7. Decision

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: September 27, 2024