

ADMINISTRATIVE PANEL DECISION

Kimley-Horn and Associates, Inc. v. Michele Fenner

Case No. D2022-3510

1. The Parties

Complainant is Kimley-Horn and Associates, Inc., United States of America (“U.S.”), represented by Nelson Mullins Riley & Scarborough, LLP, U.S.

Respondent is Michele Fenner, U.S.

2. The Domain Name and Registrar

The disputed domain name <kimley-horn.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On September 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (Registration Private, Domains by Proxy, LLC, U.S.) and contact information in the Complaint. The Center sent an email communication to Complainant on September 23, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 26, 2022.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 18, 2022.

The Center appointed Timothy D. Casey as the sole panelist in this matter on October 26, 2022. 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

Complainant is a planning, engineering, and design consulting firm that operates in a wide range of disciplines. Complainant has used KIMLEY-HORN as a trademark in connection with its services since 1967 and registered the domain name <kimley-horn.com> in 1996. Complainant has received a number of awards and recognitions as a top company to work for. Complainant owns trademark registrations that comprise KIMLEY-HORN, including U.S. Registration No. 2,788,474, registered December 2, 2003 in International Classes 36 and 42, and U.S. Registration No. 4,685,771, registered February 10, 2015 in International Classes 36 and 42 (the “KIMLEY-HORN Marks”).

Complainant owns and has used the domain name <kimley-horn.com> as the location of its main website and to host email addresses for its employees.

The disputed domain name was registered on September 8, 2022. According to the evidence submitted with the Complaint, on the same day, the disputed domain name was registered, it was used for sending an email impersonating one of Complainant’s employees, in which their signature block was altered to include the disputed domain name, in an attempt to get one of Complainant’s clients to alter banking information for processing a payment of an invoice for services rendered by Complainant. Complainant’s client made Complainant aware of the attempt. Complainant filed abuse complaints with the Registrar to get the disputed domain name suspended.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has been subject to multiple phishing/business email compromise (“BEC”) attacks over the past two years.

Complainant further contends that, well prior to the registration of the disputed domain name, it had obtained common law rights and U.S. federal registrations for the KIMLEY-HORN Marks, and that such registrations are uncontestable. Complainant contends that this proves its ownership and exclusive right to use the KIMLEY-HORN Marks for the services identified in the registrations.

Complainant contends that as a common, obvious, or intentional misspelling of the KIMLEY-HORN Marks, the disputed domain name is confusing similar to the KIMLEY-HORN Marks. In particular, Complainant notes that the disputed domain name merely replaced the letters “rn” in “horn” with the letter “m” and that when the disputed domain name appears in lower case letters the letter “m” looks strikingly similar to the combination of the letters “rn” together. Complainant further contends that the disputed domain name wholly incorporates a misspelling of the KIMLEY-HORN Marks and that is sufficient evidence that the disputed domain name is identical or confusingly similar to its trademarks.

Complainant contends that Respondent has no prior rights or legitimate interest in the disputed domain name nor is Respondent commonly known by the disputed domain name. Complainant further contends that Respondent has not authorized Respondent to use the KIMLEY-HORN Marks or licensed Respondent to the KIMLEY-HORN Marks.

Complainant further contends that Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or used or a legitimate noncommercial or fair use of the disputed domain name. Complainant notes the evidence of Respondent's illegal use of the disputed domain name as supporting these contentions.

Complainant contends that Respondent's use of the disputed domain name in furtherance of a phishing/BEC attack is evidence of both bad faith registration and use. Complainant contends that Respondent registered the disputed domain name for the sole purpose of conducting a BEC attack. Complainant notes that there can be no question that Respondent knew of the KIMLEY-HORN Marks at the time of registration of the disputed domain name based on Respondent's actual use of the same.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant's use of the KIMLEY-HORN Marks as early as 1967 and Complainant's registration of the KIMLEY-HORN Marks is sufficient to establish that Complainant has trademark rights in the KIMLEY-HORN Marks.

Complainant contends that the disputed domain name is confusingly similar to the KIMLEY-HORN Marks. Complainant contends that the incorporation of the KIMLEY-HORN Marks with the mere substitution of the letter "m" for the letters "rn" results in the disputed domain name being confusingly similar to the KIMLEY-HORN Marks.

The Panel agrees and finds that the disputed domain name is confusingly similar to the KIMLEY-HORN Marks.

B. Rights or Legitimate Interests

The Panel finds that Respondent has no rights or legitimate interests in the disputed domain name. Respondent does not appear to be commonly known by the disputed domain name. Complainant has not licensed or authorized Respondent to use the disputed domain name. Use of the disputed domain name to impersonate one of Complainant's employees alone is sufficient to support the Panel's conclusion that Respondent's use was not a legitimate noncommercial or fair use, and does not constitute a *bona fide* offering of goods or services. Rather, such fraudulent use can never confer rights or legitimate interests on Respondent. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 2.13. Respondent has not rebutted Complainant's *prima facie* case and has provided no arguments or evidence showing potential rights or legitimate interests in the disputed domain name.

For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Given i) the nature of the disputed domain name in combination with a fraudulent email that appears designed to trick third parties into believing some affiliation with Complainant, ii) the timing of the registration of the disputed domain name and such fraudulent use, and iii) Complainant's prior trademark rights in the U.S., the Panel finds that Respondent clearly knew of the KIMLEY-HORN Marks at the time of registration of the disputed domain name. Respondent's registration of the disputed domain name was therefore in bad

faith.

In addition, the Panel finds the subsequent fraudulent usage of the disputed domain name for the sending of an email communication impersonating an employee of Complainant as part of an attempted BEC attack, to constitute use in bad faith consistent with paragraph 4(b)(iv) of the Policy.

The Panel concludes that the disputed domain name was registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <kimley-hom.com>, be transferred to Complainant.

/Timothy D. Casey/

Timothy D. Casey

Sole Panelist

Date: November 10, 2022