

ADMINISTRATIVE PANEL DECISION

Kimley-Horn and Associates, Inc. v. DAVID SOFER
Case No. D2022-3561

1. The Parties

The Complainant is Kimley-Horn and Associates, Inc., United States of America, represented by Nelson Mullins Riley & Scarborough, L.L.P., United States of America.

The Respondent is DAVID SOFER, United States of America.

2. The Domain Name and Registrar

The disputed domain name <kimley-horn.info> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2022. On September 27, 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 (Privacy Service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 14, 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 the Respondent of the Complaint, and the proceedings commenced on October 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 11, 2022.

The Center appointed Colin T. O’Brien as the sole panelist in this matter on November 18, 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

The Complainant is a planning, engineering, and design consulting firm. Since 1967, the Complainant has extensively and continuously used the KIMLEY-HORN trademark in connection with the marketing, advertising, promotion, and provision of the Complainant's services.

The Complainant applied for and owns the following federal trademark registrations:

KIMLEY-HORN Registration Number 2,788,474, Registered December 2, 2003, for "financial analysis and consultation services" in Class 36, "engineering consultation; design for others in the field of engineering; computer software design for others; environmental consultation services, namely, reviewing standards and practices to assure compliance with environmental laws and regulations" in Class 42.

Kimley»Horn

Registered Number 4,685,771 Registered February 10, 2005, for "financial analysis and consultation services" in Class 36, "engineering consultation; design for others in the field of engineering; computer software design for others; environmental consultation services, namely, reviewing standards and practices to assure compliance with environmental laws and regulations" in Class 42.

The Complainant owns and has continually used the <kimley-horn.com> domain name since at least as early as April 12, 1996.

The Respondent registered the disputed domain name on May 31, 2022.

The Respondent has also associated two mail services to the disputed domain name. At the time of filing the Complaint, the disputed domain name resolved to a website featuring pay-per-click links.

5. Parties' Contentions

A. Complainant

Long prior to the Respondent's registration of the disputed domain name on May 31, 2022, the Complainant obtained common law rights in the KIMLEY-HORN Mark, dating back as early as 1967 when the Complainant was founded and first began using the KIMLEY-HORN trademark. Subsequently, yet still long prior to registration of the Domain Name, the Complainant obtained United States federal trademark registrations for the KIMLEY-HORN Mark, specifically, obtaining a registration for the KIMLEY-HORN (word) trademark on December 2, 2003, and the KIMLEY-HORN (stylized) trademark on February 10, 2015. The disputed domain name is comprised solely of the KIMLEY-HORN Mark and is therefore identical/confusingly similar to the Complainant's KIMLEY-HORN Mark.

The Respondent has no prior rights or legitimate interest in the disputed domain name. To the best of the Complainant's knowledge, the Respondent is not commonly known by the distinctive KIMLEY-HORN Mark. Based on the publicly available information contained in the WhoIs record, Respondent has never been commonly known by the disputed domain name, and thus, lacks rights and legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use the KIMLEY-HORN Mark. The Respondent is not a licensee of the KIMLEY-HORN Mark.

The Respondent has used the disputed domain name to resolve to the Website featuring pay-per-click sponsored advertisements for third-party products and services, some of which are directly related to the Complainant's services and some not related. The fact that the Respondent is using the disputed domain

name to host the Website which contains sponsored advertisements is, by its very nature, commercial and thus the Respondent cannot claim to be using the Domain Name in connection with a legitimate noncommercial or fair use.

The Respondent knew of, or should have known, of the Complainant and the Complainant's rights in the KIMLEY-HORN Mark when the Respondent registered the disputed domain name and the fact that the Respondent registered the Domain Name in spite of this actual or constructive knowledge further supports the inference that the Respondent did so in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns long-standing registered and common law trademark rights in the KIMLEY-HORN mark, and has shown that no other entity has rights in or uses the Complainant's Marks. The Top Level Domain ("TLD") ".info" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11. Accordingly, the relevant portion of the disputed domain name reflects the KIMLEY-HORN mark identically.

Accordingly, the disputed domain name is identical to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name and has not been commonly known by the disputed domain name. The fact that the Respondent obtained the Disputed domain name decades after the Complainant had begun using its unique KIMLEY-HORN mark indicates the Respondent sought to piggyback on the mark for illegitimate reasons, namely to receive pay-per-click revenue to users clicking through to third party sites. Moreover, the nature of the disputed domain name being identical to the Complainant's distinctive mark carries a high risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was registered many years after the Complainant first registered and used its unique KIMLEY-HORN trademark. The evidence on the record provided by the Complainant with respect to the extent of use and fame of KIMLEY-HORN trademark, combined with the absence of any evidence provided by the Respondent to the contrary, is sufficient to satisfy the Panel that, at the time the disputed

domain name was registered, the Respondent undoubtedly knew of the Complainant's KIMLEY-HORN trademark, and knew that it had no rights or legitimate interests in the disputed domain name.

There is *prima facie* no reason for the Respondent to have registered the disputed domain name containing the entirety of the KIMLEY-HORN trademark with the TLD “.info” other than to target and unfairly benefit from the reputation and goodwill associated with the Complainant's mark.

Further, the use of the disputed domain name by the Respondent is clearly in bad faith. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location. The Complainant has submitted evidence that the Respondent has used the Disputed domain name in order to direct users to a parked website which includes links to both the Complainant's website and that of its competitors. Given the notoriety of the Complainant's KIMLEY-HORN mark, the obvious inference is that the Respondent hoped to mislead customers of the Complainant to visit the website at the disputed domain name trading on the Complainant's trademark and reputation in order to obtain pay-per-click revenue. In addition, the disputed domain name has been configured for email servers, which may indicate the disputed domain name could be used for possible phishing attempts or some other illegitimate use especially given that the disputed domain name incorporates the “.info” TLD. As such, if the disputed domain name is used as the sender's domain in email addresses, sent emails would likely appear to recipients as originating from Complainant. As found in *Carrefour SA. v. Withheld for Privacy Purposes, Privacy Service Provided by Withheld for Privacy ehf / Renato Siqueira*, WIPO Case No. [D2021-2911](#), “[i]n light of the proliferation of schemes using confusingly similar email addresses to perpetrate fraudulent activities, the Panel does not consider it necessary or advisable to address such conduct only after the fact. The harm to the defrauded party(ies) may well be irreversible”. Accordingly, and in light of the pay-per-click use of the identical disputed domain name, this is a textbook example of bad faith use on the part of the Respondent.

In the absence of any evidence or explanation from the Respondent, the Panel finds that the only plausible basis for registering and using the disputed domain name has been for illegitimate and bad faith purposes.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

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-horn.info>, be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: December 2, 2022