

ADMINISTRATIVE PANEL DECISION

Dewberry Engineers Inc. v. Dewberry IT, Dewberry Group
Case No. D2022-5016

1. The Parties

Complainant is Dewberry Engineers Inc., United States of America (“United States”), represented by McCandlish Lillard, P.C., United States.

Respondent is Dewberry IT, Dewberry Group, United States, represented by Wellborn, Wallace & Mullman, LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <jkdewberry.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 December 28, 2022. On December 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 30, 2022, 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) and contact information in the Complaint. The Center sent an email communication to Complainant on January 3, 2023, 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 January 5, 2023.

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 January 6, 2023. In accordance with the Rules, paragraph 5, the due date for the Response was January 26, 2023. On January 23, 2023, Respondent requested a four days’ automatic extension, in accordance with paragraph 5(b) of the Rules, to submit a Response, which was granted by the Center. The Response was filed with the Center on January 30, 2023.

On February 6, 2023, Complainant submitted a request to the Center to terminate the proceedings. On February 7, 2023, the Center invited Respondent to provide its comments on Complainant's request for termination of the proceeding by February 12, 2023. On February 8, 2023, Complainant sent an email to the Center requesting the immediate termination of the proceeding. On February 10, 2023, Respondent filed its objections to Complainant's termination request. On February 13, 2023, the Center informed the Parties that it will proceed to panel appointment.

On February 15, 2023, Complainant filed a supplemental filing withdrawing its request to terminate the proceedings. On February 16, 2023, Respondent sent an email to the Center objecting to the supplemental filing.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on February 17, 2023. 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 an engineering, architecture, real estate services, and emergency management firm with numerous locations across the United States. It is the proprietor of the following trademark registrations:

- United States Trademark No. 2991043 for DEWBERRY (word mark), registered on September 6, 2005 for services in classes 35, 37, 40, and 42;
- United States Trademark No. 2991044 for DEWBERRY (device mark), registered on September 6, 2005 for services in classes 35, 37, 40, and 42.

Complainant operates its primary business website at the domain name <dewberry.com>.

Respondent is a corporation owned by a person named John K. Dewberry operating in various fields including philanthropy, horse racing, hospitality, and aircraft operation. Respondent states that it or related entities are the proprietors of the following trademark registrations:

- United States Trademark No. 3374452 for DEWBERRY CAPITAL (device mark), registered on January 22, 2008 for services in class 36;
- United States Trademark No. 4892004 for THE DEWBERRY (word mark), registered on January 26, 2016 for services in class 43;
- United States Trademark No. 5801536 for D DEWBERRY FOUNDATION (device mark), registered on July 9, 2019 for services in class 36;
- United States Trademark No. 6059279 for D DEWBERRY HOSPITALITY (device mark), registered on May 19, 2020 for services in class 35.

The record reflects that trademark litigation in connection with the DEWBERRY mark has been ongoing between the Parties.

The disputed domain name was registered on October 5, 2022. It resolves to a parking page featuring pay-per-click ("PPC") links unrelated to Complainant's business. The record reflects evidence that an e-mail address associated with the disputed domain name has been enabled and is being used by John K. Dewberry.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it is an engineering, architecture, real estate services, and emergency management firm which offers a wide variety of additional services and has more than fifty locations in the United States. The disputed domain name differs from Complainant's registered DEWBERRY mark only by the letters "jk."

Under the second element, Complainant states that "Jkdewberry" is not a registered trademark, and it appears to have no associated registered company. Complainant has received information that Respondent has "Dewberry" as part of its name, but Complainant has not seen any evidence of Respondent's use of, or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods and services. In fact, Respondent does not appear to offer any goods or services in connection with "jkdewberry" whatsoever.

Under the third element, Complainant states that the disputed domain name is confusingly similar to <dewberry.com>, a domain name connected to a well-known and profitable entity, but was registered by people who do not do business with Complainant. Respondent registered the disputed domain name on October 5, 2022, and while there was no active website as of January 5, 2023, there would be a high likelihood of confusion if one were activated. The disputed domain name was registered 24 years after Complainant's domain name was registered. It is assumed that Respondent discovered the existence of Complainant's domain name and registered marks, yet still elected to proceed with registration of a domain that differed by just two letters. This implies that consideration of the similarity was made, and Respondent desired to benefit from the well-known nature of Complainant's name. Based on the nearly identical nature of the disputed domain name to <dewberry.com> and the fact that no business website or legitimate use of the disputed domain name has been set up to date, the only plausible conclusion is that the disputed domain name was registered for one or more improper purposes, such as diverting traffic from Complainant's website or seeking to sell the disputed domain name to Complainant.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent's arguments may be summarized as follows:

Respondent states that John K. Dewberry is a well-known athlete, philanthropist, and businessman who, after playing football at Georgia Tech and for the Canadian Football League in the 1980s, founded Dewberry Capital Corporation in 1989. His business interests now include a philanthropic foundation, horse-racing company, a luxury hotel, and a company that operates aircraft, all under names incorporating the term "Dewberry." The disputed domain name was registered by Dewberry IT, an entity providing IT services to the various business, at the personal instruction of Mr. Dewberry for his "[...]@jkdewberry.com" vanity email address.

Complainant professes ignorance of Respondent. However, the Complaint and Amended Complaint fail to state that Complainant has intimate knowledge of John K. Dewberry and his businesses, as there is and has been trademark litigation between the parties. In 2006, Complainant's predecessor-in-interest sued Dewberry Capital for trademark infringement. The case was resolved by a 2007 agreement that defined the parties' permissible uses of the DEWBERRY name and mark. In 2020, Complainant sued Dewberry Capital for breach of that agreement and trademark infringement. The district court granted summary judgment to Complainant and entered a damages award and an injunction, which Dewberry Capital has appealed. Respondent states that, during litigation, Complainant (represented by the same counsel as in this proceeding) conducted exhaustive discovery including searches directed to the term "jkdewberry," which is identical to the disputed domain name.

In response to Complainant's contentions under the first element, Respondent states that it does not contest that the disputed domain name contains the character string "dewberry."

In response to Complainant's contentions under the second element, Respondent states that the disputed domain name reflects the initials and name of John K. Dewberry and has been registered at his personal direction for his vanity email address. In addition, Complainant is aware that numerous entities controlled by Mr. Dewberry are conducting business under a "Dewberry" name or mark.

In response to Complainant's contentions under the third element, Respondent states that Complainant has provided no evidence in support of its allegations. Complainant is aware that "jkdewberry" referred to John K. Dewberry; that various entities controlled by him under names including "Dewberry" are active in unrelated fields and do not infringe Complainant's rights; that Mr. Dewberry holds trademark registrations containing "Dewberry"; and that, pursuant to the 2007 agreement, Complainant authorized Dewberry Capital to engage in certain business activities under that name. The parking page to which the disputed domain name contains no reference to Mr. Dewberry or to Complainant and therefore it cannot be considered to have been registered to divert Internet traffic from Complainant's website. The disputed domain name is not and will not be offered for sale, least of all to Complainant.

Respondent requests a finding of Reverse Domain-Name Hijacking for the following reasons. Complainant should have known it could not prove an essential element of its claim. It provided intentionally incomplete material evidence, attempted to mislead the panel, and brought a complaint on only the barest of allegations without any supporting evidence. The Complaint lacks any reference to the contentious history between the parties and is silent on the fact that the disputed domain name corresponds to the first initial, middle initial and last name of a person associated with Respondent. The disputed domain name is used only for a vanity e-mail address. The Complaint is a wrongful attempt to seize John K. Dewberry's namesake domain name.

6. Discussion and Findings

6.1. Procedural Issues – Complainant's Request for Withdrawal of the Complaint and Admissibility of Supplemental Filing

A. Summary of the Parties' Submissions Related to Withdrawal

The Parties' additional filings are voluminous. The main points are summarized below.

On February 6, 2023, Complainant filed a request to withdraw the Complaint in reliance upon Respondent's statements that the disputed domain name will be used solely for John K. Dewberry's personal vanity email address. Complainant states that it reserves the right to proceed against Respondent if Respondent's representations prove to be untrue. Complainant summarizes recent trademark litigation in the United States District Court for the Eastern District of Virginia in which Respondent was found liable to Complainant for damages and enjoined from certain uses of the DEWBERRY mark. In support of these statements, Complainant appended court orders related to the trademark litigation between the Parties.

On February 7, 2023, Respondent was invited to comment on Complainant's request. On February 8, 2023, Complainant objected to Respondent's being asked to provide comments and requested that the proceeding be terminated immediately based upon its voluntary withdrawal of the Complaint, with no opportunity for Respondent to comment. On the same date, Respondent objected to this objection.

On February 10, 2023, Respondent filed its objections to Complainant's termination request. Respondent states that, due to the ongoing litigation between the Parties, Complainant was aware of John K. Dewberry "JKDewberry" at the time that it filed its Complaint and Amended Complaint. Respondent states that it is entitled to a UDRP decision on the merits and to a Panel decision on whether Complainant has attempted to deprive it of a domain name. The litigation referred to by Complainant is pending appeal in the Fourth Circuit Court of Appeals, and the court orders do not enjoin Respondent from all uses of the DEWBERRY mark. John K. Dewberry has been known by that name his entire life. He controls a number of enterprises

containing the name “Dewberry” and marks containing the element DEWBERRY. Respondent requests a finding of Reverse Domain Name Hijacking for reasons that will be discussed below.

On February 15, 2023, Complainant submitted a supplemental filing responding to Respondent’s objection to the withdrawal. It states that it first learned of Respondent’s intended use of the disputed domain name only upon receiving Respondent’s Response. In light of Respondent’s reversal of position, Complainant requests that its withdrawal request be withdrawn, and requests a decision on the merits. Complainant restates the arguments in its Complaint, calls into question the veracity of evidence supplied by Respondent, and disputes a finding of Reverse Domain Name Hijacking for reasons that will be discussed below.

On February 16, 2023, Respondent sent an email to the Center requesting the Panel not to consider the supplemental filing filed by Complainant and stating that it will not be submitting additional filings.

B. Discussion and Findings

1. Termination of the Proceeding

Paragraph 17(b) of the Rules provides that if, before the Panel’s decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel. The request for withdrawal of the Complaint can be interpreted as if Complainant no longer wished to receive a decision on the merits, which raises the question of whether it has now become unnecessary to continue the administrative proceeding.

In this case, Complainant, after twice requesting the Complaint to be withdrawn, has withdrawn its request to terminate the proceeding. Respondent insists on the continuation of the proceeding and the issuance of a decision on the merits that addresses the arguments contained in the Response, and the Parties have not reached a settlement of their dispute.

In these circumstances, it appears to the Panel that it has not become unnecessary to continue the administrative proceeding. Therefore, a termination of the proceeding would not be appropriate, and the Panel will proceed to a decision on the merits. See, for example, *Türkiye’nin Otomobili Girişim Grubu Sanayi Ve Ticaret Anonim Şirketi v. The Office of George Gould*, WIPO Case No. [D2021-1949](#). Further, the Panel finds that, despite the existence of litigation between the Parties, this dispute may be properly resolved under the UDRP. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.14.2.

2. Admissibility of Complainant’s Supplemental Filing

Paragraph 10 of the UDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition.

Paragraph 12 of the UDRP Rules expressly provides 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.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. See [WIPO Overview 3.0](#), section 4.6.

The Panel has reviewed Complainant’s unsolicited Supplemental Filing of February 15, 2023. The record already reflects Complainant’s Complaint and Amended Complaint, its requested Withdrawal of Complaint and various emails in connection with the above. The Panel finds that the Supplemental Filing does not contain any new evidence or information necessary to the consideration of this matter, but consists of challenges to Respondent’s arguments. Accordingly, the Panel takes into consideration Complainant’s request to continue the proceeding and its explanation for why it has changed course but does not find it necessary to consider any other argument of this Supplemental Filing nor refer it to Respondent for comment.

6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed 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 disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name 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

Complainant has provided evidence establishing that it has trademark rights in the DEWBERRY mark through registrations in the United States. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See [WIPO Overview 3.0](#), section 1.2.1.

In comparing Complainant’s marks with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to Complainant’s mark, as it contains Complainant’s DEWBERRY mark, preceded by the letters “jk”. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8. Respondent does not contest Complainant’s standing under the first element.

It is the well-established view of UDRP panels that a generic Top-Level Domain such as “.com” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel would be prepared to find that Complainant has established the first element under paragraph 4(a) of the Policy for standing purposes, but such a finding is not necessary here in light of the third element discussion.

B. Rights or Legitimate Interests

Based on the finding under the third element below, the Panel need not come to a determination on whether Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b) provides that for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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. (Policy, paragraph 4(b)).

There is no dispute that Complainant has trademark rights in the DEWBERRY mark, and that the disputed domain name differs from this mark only by two letters.

Complainant bases its Complaint on allegations that there would be a high likelihood of confusion if a website were established using the disputed domain name, and that Respondent desired to benefit from the well-known nature of Complainant's name. Complainant states that the only plausible conclusion is that the disputed domain name was registered for one or more improper purposes, such as diverting traffic from Complainant's website or seeking to sell the disputed domain name to Complainant.

Surprisingly, the Complaint is completely silent on Complainant's detailed knowledge of Respondent and the lengthy history of litigation between the Parties. The Complaint is likewise silent on any other possible justification for the selection of the disputed domain name, such as Respondent's own DEWBERRY marks or the name of Respondent's founder.

There is no evidence that Respondent seeks to sell the disputed domain name to Complainant or to a competitor of Complainant. The Panel accepts that using a domain name for PPC links directed at a complainant can support a finding of bad faith under certain circumstances. See [WIPO Overview 3.0](#), section 3.5. Noting the use of the disputed domain name for the email address connected to Respondent, however, the Panel finds that the use of the disputed domain name in connection with PPC links unrelated to Complainant does not support a finding of bad faith in these circumstances. See, for example, *Radiola Consumer AG v. Registration Private - Domains By Proxy, LLC / Marisol Cortes*, WIPO Case No. [D2019-1545](#); *COLAS v. Domain Administrator, Daruna, LLC*, WIPO Case No. [D2020-0560](#).

The Panel does not find that, by registering the disputed domain name, Respondent has prevented Complainant from registering its own trademark as a domain name or has attempted to attract Internet users to its website by creating a likelihood of confusion with Complainant's mark. See [WIPO Overview 3.0](#), sections 3.1.2 and 3.1.4.

Complainant has not provided evidence in support of its contention that attractiveness of the disputed domain name derives from Complainant's trademark rather than from other factors. Respondent has brought forth credible evidence that it registered and used the disputed domain name for its identity with the name of Respondent's founder. See [WIPO Overview 3.0](#), section 3.2.1.

While a relatively short time elapsed between the registration of the disputed domain name and the filing of the Complaint, Respondent has provided evidence of use of the disputed domain name for an email address for John K. Dewberry. See [WIPO Overview 3.0](#), section 3.3.

UDRP panels have recognized the right to register domain names corresponding to personal names of registrants. See, for example, *Dewberry Engineers Inc. v. Elizabeth Dewberry, Dewberry Designs*, WIPO Case No. [D2021-1791](#); *G. A. Modefine S.A. v. A.R. Mani*, WIPO Case No. [D2001-0537](#); *CKL Holdings N.V. v. Paul Flammea*, WIPO Case No. [D2016-1340](#).

The Panel notes that technically Respondent is not John K. Dewberry as the registrant as confirmed by the Registrar is Dewberry IT, Dewberry Group (and the Amended Complaint was addressed against these). However, the Panel notes that there seems to be a connection between the Respondent and John K. Dewberry, as Dewberry IT seems to be a division of Dewberry Hospitality Group, the address for Dewberry IT is the same as that of "the Dewberry Hotel", and on the sworn statement submitted by J.K. Dewberry it

appears that it was his personal account that was charged for the disputed domain name. The Panel notes that some questions about the degree and nature of Mr. Dewberry's control or current ownership of Respondent remain unanswered. Nevertheless, on the balance of probabilities, the Panel finds that Respondent has provided credible evidence that the disputed domain name was registered by entities acting at the direction of John K. Dewberry and for his benefit. The composition and use of the disputed domain name are consistent with this intention. For that reason, the Panel finds that the record supports a finding that it was entirely reasonable for entities controlled by John K. Dewberry to register the disputed domain name at his direction for the reasons substantiated by the record.

The Panel notes that Respondent does not provide any explanation for why, having engaged in business under various "Dewberry" marks since 1989, Respondent elected to create a domain name corresponding to the initials and surname of John K. Dewberry only in 2022. The record clearly shows that Respondent has been aware of Complainant and its DEWBERRY mark since at least 2007. For all the reasons described above, however, the Panel finds that Complainant has not proved that Respondent has registered and is using the disputed domain to take unfair advantage of or otherwise abuse Complainant's mark. See [WIPO Overview 3.0](#), section 3.1.

Accordingly, the Panel finds that Complainant has not established the third element under paragraph 4(a) of the Policy.

7. Reverse Domain Name Hijacking ("RDNH")

Paragraph 15(e) of the Rules provides that, "[i]f after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at RDNH or was brought primarily 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". It is the Panel obligation to consider whether a finding of RDNH should be made even in the absence of a request from Respondent. Further, mere lack of success of a complaint is not in itself sufficient for a finding of RDNH.

Section 4.16 of the [WIPO Overview 3.0](#) sets forth various circumstances under which a panel may find RDNH, including "the provision of intentionally incomplete material evidence – often clarified by the respondent."

The Panel finds that Complainant has provided incomplete material evidence by failing, in its Complaint and Amended Complaint, to mention the litigation between the Parties and remaining silent on its extensive knowledge of Respondent, its trademarks containing the word "Dewberry", Respondent's controlling shareholder John K. Dewberry, and the numerous entities related to Respondent containing the name "Dewberry."

In the Amended Complaint, Complainant states that "Respondent should be considered to have no rights or legitimate interests with respect to "Jkdewberry.com" because Jkdewberry is not a registered trademark or service mark, and it appears to have no associated registered company. A Google search of Jkdewberry, attached hereto as Annex No. 7, does not return any results connected to Respondent."

The Panel notes that the record contradicts Complainant's professed ignorance. To name but one example of evidence presented by Respondent, in a discovery request in the course of civil proceedings that predated this proceeding, Complainant had requested information on Respondent's use of "jkdewberry," a term identical with the disputed domain name. Instead, Complainant proceeded as if Respondent were a party unknown to it. If Respondent has not provided a Response, the Panel would have considered an entirely different case. See, for example, *Rillius Holding Limited v. Yuliia Makovska, Abudantia B.V.*, WIPO Case No. [D2022-2242](#); *Green Globe Limited v. Domains By Proxy, LLC / Green Globe LLC*, WIPO Case No. [D2020-1822](#).

Based on this record, there can be no doubt whatsoever that, by the time that the privacy shield was lifted, Complainant was aware of Respondent's identity and of its possible rights in the disputed domain name.

Only upon receiving the Response did Complainant recall these circumstances. Complainant is represented by counsel that will be aware of the professional representations of Parties and their counsel initiating such proceedings.

As such, the Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: March 13, 2023