

ADMINISTRATIVE PANEL DECISION

Kimley-Horn and Associates, Inc. v. Rachel Zona

Case No. D2023-1465

1. The Parties

Complainant is Kimley-Horn and Associates, Inc., United States of America ("USA" or "U.S."), represented by Nelson Mullins Riley & Scarborough, L.L.P., USA.

Respondent is Rachel Zona, USA.

2. The Domain Name and Registrar

The disputed domain name <kimleyhorncorp.com> (the "Domain Name") is registered with Squarespace Domains, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 4, 2023. On April 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent ("Redacted for Privacy") and contact information in the Complaint. The Center sent an email communication to Complainant on April 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on April 10, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on May 9, 2023.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on May 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, founded in 1967, is a planning, engineering, and design consulting firm. Since that time, Complainant has used the KIMLEY-HORN mark in connection with its marketing, advertising, promotion, and providing of its services. Complainant also owns the following incontestable U.S. Trademark Registrations: 2,788,474 for KIMLEY-HORN (registered on December 2, 2003) and 4,685,771 for KIMLEY HORN & design (registered on February 10, 2015) (the “KIMLEY-HORN Mark” or the “Mark”).

Complainant and its employees have also been recognized by awards and recognitions over the years, including being ranked in Fortune Magazine’s “100 Best Companies to Work For” and “100 Best Workplaces for Millennials” rankings as well as being the top ranked firm in “Civil Engineering News”, “Best Civil Engineering Companies to Work For” ranking.

The Domain Name was registered on March 26, 2023, and does not resolve to any active website. Upon registering the Domain Name (apparently a day later), Respondent used it in connection with an attempted business email compromise (BEC) attack wherein Respondent, impersonating Complainant’s chief financial officer, contacted one of Complainant’s clients and inquired about any existing open invoices. The email to Complainant’s client impersonating Complainant’s Chief Financial Officer (CFO) bears the message: “Be Careful With This Message | The sender’s email domain has been active for a short period of time and could be unsafe.”

5. Parties’ Contentions

A. Complainant

Long before Respondent registered the Domain Name on March 26, 2023, Complainant established common law rights in the Mark, dating back to at least 1967, because of its extensive, continuous, and substantial investment in and use of the KIMLEY-HORN Mark in commerce. The KIMLEY-HORN Mark is wholly incorporated and identifiable in the Domain Name with the only differences between the Domain Name and the Mark being (i) the exclusion of the hyphen between “Kimley” and “Horn” and (ii) the addition of the “corp” (corporation) abbreviation to the end of “Kimleyhorn”. Adding the “corp” abbreviation and the omission of the hyphen from the KIMLEY-HORN Mark do not prevent a finding of confusing similarity between the Domain Name and the Mark.

To the best of Complainant’s knowledge, Respondent is not commonly known by and will not be revealed to be commonly known by the name Kimley Horn or Kimley Horn Corp, or any variation thereof. Moreover, Complainant has not authorized Respondent to use the KIMLEY-HORN Mark and Respondent is not a licensee of the Mark. Furthermore, Respondent has used the Domain Name to impersonate Complainant’s CFO in furtherance of Respondent’s attempted BEC attack. This illegal activity cannot be a *bona fide* use of the Domain Name nor can such use of the Domain Name ever qualify as a legitimate noncommercial or fair use of the Domain Name.

Registration of domain names which are used in furtherance of BEC attacks are evidence of bad faith registration and use of the domain names. Because Respondent registered the Domain Name and immediately used it in an attempted BEC attack, there can be no question that Respondent registered and has used the Domain name in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the KIMLEY-HORN Mark by virtue of its U.S. trademark registrations cited above.

The Domain Name is confusingly similar to Complainant's KIMLEY-HORN Mark because: Complainant's Mark is clearly recognizable within the Domain Name; the Top-Level Domain is generally not determinative in establishing whether the Domain Name is confusingly similar to a complainant's mark; and excluding the hyphen between "Kimley" and "Horn" and adding "corp" to the end of the Mark do not prevent a finding of confusing similarity with Complainant's Mark. See, *Hi-Tec Sports International Holdings B.V. v. Domain Administrator, PrivacyGuardian.org / Frank Jaeger*, WIPO Case No. [D2022-2956](#) ("The Panel notes that the disputed domain name incorporates the HI-TEC trademark in its entirety. The omission of the hyphen and the addition of the term 'Australia' do not prevent a finding of confusing similarity under Policy, Paragraph 4(a)(i)."); See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8 ("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.").

For the foregoing reasons, the Panel concludes that Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant argues that it has no information that Respondent is commonly known by a name corresponding to the Domain Name, and notes that Respondent's name according to the Whois record is Rachel Zona, not Kimley-Horn. Accordingly, it claims absent a showing by Respondent otherwise, it is reasonable to infer based on the publicly available information contained in the Whois record that Respondent has never been commonly known by the Domain Name, and thus, lacks rights and legitimate interest in the Domain Name. See [WIPO Overview 3.0](#), section 2.3. Also, Complainant has neither authorized nor licensed Respondent to use the Mark for any purpose.

Furthermore, Complainant submits that Respondent's use of the Domain Name to impersonate its CFO in furtherance of an attempted BEC attack can never constitute a *bona fide*, legitimate noncommercial or fair use of the Domain Name under the Policy. See [WIPO Overview 3.0](#), Section 2.13.1; see also *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) (finding that the respondent had no rights or legitimate interests in the disputed domain name holding, "such phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name").

Where, as here, Complainant has raised a *prima facie* presumption of Respondent's lack of any rights or legitimate interests in the Domain Name, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondent has no rights or legitimate interests in the Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

At the time Respondent registered the Domain Name on March 26, 2023, Complainant had been using the KIMLEY-HORN Mark since 1967 to promote its planning and design consulting services. Having no rights or legitimate interests in the Domain Name, Respondent registered a Domain Name that is confusingly similar to Complainant's registered Mark (merely removing a hyphen between "Kimley" and "Horn" and adding "corp" to the end of the Mark, which term the public could assume is a business designator for Complainant. Given these facts it is highly unlikely Respondent was unaware of Complainant or its KIMLEY-HORN Mark when registering the Domain Name. Moreover, in using the Domain Name to impersonate Complainant's

CFO in furtherance of an attempted BEC attack this is further evidence of Respondent's bad faith registration of the Domain Name.

The registration of domain names which are used in furtherance of BEC attacks are also evidence of bad faith use of the domain name. See, e.g., *BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#) (“[T]he use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.”); *Kimley-Horn and Associates, Inc. v. Abraham Hashim*, WIPO Case No. [DCO2019-0017](#) (“registration of a domain name in furtherance of phishing scams supports a finding of bad faith registration and use”); See also *Kimley-Horn and Associates, Inc. v. Contact Privacy Inc., Customer 1246614033 / Larry William*, WIPO Case No. [D2020-0661](#); *Kimley-Horn and Associates, Inc. v. Michele Fenner*, WIPO Case No. [D2022-3510](#); *Kimley-Horn and Associates, Inc. v. Abraham Hashim*, WIPO Case No. [DCO2019-0017](#). Insofar as Respondent registered the Domain Name and immediately used it in an attempted BEC attack, there can be no question that Respondent has used the Domain Name in bad faith.

For the foregoing reasons, the Panel concludes that 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 Domain Name <kimleyhorncorp.com> be transferred to Complainant.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: May 26, 2023