

ADMINISTRATIVE PANEL DECISION

IBI Group Professional Services (Canada) Inc. v. Rebekah Murnion Case No. D2022-3577

1. The Parties

The Complainant is IBI Group Professional Services (Canada) Inc., Canada, represented by Dentons Canada LLP, Canada.

The Respondent is Rebekah Murnion, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dowa-ibigroup.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2022. On September 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 29, 2022, 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 information for the disputed domain name.

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 October 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 26, 2022.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on November 3, 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 Canadian publicly traded company in the Toronto Stock Exchange that provides architectural, engineering, and smart city goods and services under the IBI trademark.

The Complainant is the owner of several trademark registrations around the world, among others, the following:

Trademark	No. Registration	Jurisdiction	Date of Registration
 IBI	UK00003287377	United Kingdom	July 6, 2018
 IBI	6420834	United States	July 13, 2021
IBI	6384100	United States	June 15, 2021
IBI GROUP	UK00003287381	United Kingdom	June 29, 2018
IBI GROUP	6598447	United States	December 21, 2021

The disputed domain name was registered by the Complainant on November 18, 2011. However, the Respondent acquired the disputed domain name on September 28, 2021. At the time of the filing of the Complaint, the disputed domain name resolved to a website that displayed the Complainant's trademarks and pictures. Currently, the disputed domain name redirects to another website that apparently provides architectural services in competition with those of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant argued the following:

I. Identical or Confusingly Similar

That the disputed domain name is confusingly similar to the Complainant's trademarks.

That the Complainant is the owner of several trademark registrations for IBI and IBI GROUP.

That the Complainant has been offering goods and services under the IBI and IBI GROUP trademarks since, at least 1974.

That the Complainant has established significant goodwill and reputation in connection to its trademarks in several countries like Canada, the United States, Australia, and the United Kingdom.

That the only difference between the disputed domain name and the Complainant's trademarks is the addition of the term "dowa". That, therefore, the disputed domain name is confusingly similar to the Complainant's trademark since it incorporates it entirely.

That the website to which the disputed domain name resolved (the "Website") is misleading since it extensively uses the Complainant's trademarks and images which have been taken from the Complainant's website without authorization.

That the Respondent's registration and improper use of the disputed domain name are intended to confuse Internet users as to whether it is owned by or affiliated with the Complainant.

II. Rights or Legitimate Interests

That the Respondent has no rights to or legitimate interests in the disputed domain name.

That the Website features designs and projects carried out by the Complainant.

That the Website substantially reproduces all of the Complainant's content, images, photographs, as well as trademarks related to the Complainant's business.

That the Complainant has no relationship with the Respondent and has not authorized the Respondent to use its trademark in the disputed domain name.

That there is no evidence the Respondent has used the disputed domain name to offer any legitimate goods or services.

That the Website is used only to display content that has been taken from the Complainant's website to create the misimpression that the disputed domain name is owned by, affiliated to, or otherwise associated with the Complainant.

That the Respondent has not acquired any rights or legitimate interests in the disputed domain name under the Policy.

III. Registered and Used in Bad Faith

That the Respondent acquired the disputed domain name and is using it to create a misimpression that the Respondent is associated to or affiliated with the Complainant's DOWA-IBI business.

That the Respondent knew that the disputed domain name was previously owned by the Complainant, and that it was used to operate the DOWA-IBI business.

That the Website displays content and photographs taken from the Complainant's official website, which falsely suggests the Respondent is associated to or affiliated with the Complainant's projects.

That each of the activities and services listed on the website to which the disputed domain name resolves is identical to or directly related with the services associated with the Complainant's trademark. That, therefore, the Respondent has been aware of the Complainant, and its business, and is intentionally attempting to attract, for financial gain, Internet users to the disputed domain name by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the disputed domain name.

That the Respondent is attempting to create confusion and trade off the Complainant's goodwill and reputation.

That in July 2022, the Complainant sent a communication to the Respondent to resolve the matter, but that the Respondent did not reply and continued to use similar content on the Website, which amounts to bad faith.

That the Respondent has attempted to attract for commercial gain Internet users to the Website by creating a likelihood of confusion with the Complainant's trademarks.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant is required to prove that each of the three following elements is satisfied:

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

Given the Respondent's failure to submit a response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations under paragraphs 5(f), 14(a), and 15(a) of the Rules, and shall draw such inferences it considers appropriate under paragraph 14(b) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#), and *Encyclopaedia Britannica, Inc. v. null John Zuccarini, Country Walk*, WIPO Case No. [D2002-0487](#)).

A. Identical or Confusingly Similar

The Complainant has filed evidence showing that it owns registrations for the IBI and IBI GROUP trademarks, among other places, in the United States, where the Respondent has declared to reside.

The disputed domain name is confusingly similar to the Complainant's trademarks, as it incorporates said trademarks entirely, with the addition of the term "dowa".

Generally, panels appointed under the Policy have found that the inclusion of additional terms in a disputed domain name does not prevent a finding of confusing similarity under the first element (see sections 1.7, and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). This is so in the present case because the term "dowa" does not prevent the trademarks from being recognizable in the disputed domain name.

The addition of the generic Top-Level Domain ("gTLD") ".com" to the disputed domain name is immaterial for purposes of assessing confusing similarity because it is a technical requirement of the Domain Name System (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#); *International Business Machines Corporation v. chenaibin*, WIPO Case No. [D2021-0339](#); and *Société Air France v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues*, WIPO Case No. [D2019-0578](#)).

Therefore, the first element of the Policy has been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in the disputed domain name:

- (i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it did not acquire trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant has proven to be the owner of several registrations for the IBI and IBI GROUP trademarks in different jurisdictions, including the United States, where the Respondent has declared to reside.

The Complainant has asserted that there is no relationship or affiliation between the Complainant and the Respondent and that it has not granted any license or authorization to the Respondent to use its IBI and IBI GROUP trademarks (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#), and *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#)). The Respondent did not contest these allegations.

According to the evidence filed by the Complainant, the Website portrayed to be one of the Complainant's official websites. Considering that the disputed domain name fully incorporates the Complainant's trademark IBI, the Panel notes that the composition of the disputed domain name carries a risk of implied affiliation since Internet users may think that the website to which this disputed domain name resolved was the Complainant's official website or was otherwise affiliated to or sponsored by the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#), see also *Euro Sko Norge AS v. Whoisguard Inc. / Shier Dede, Shier Dede*, WIPO Case No. [D2020-0194](#); *Bechtel Group, Inc. v. Raman Shuk*, WIPO Case No. [D2020-1469](#); and *Biofarma v. Dawn Mason*, WIPO Case No. [D2019-1952](#)).

Furthermore, the Website predominantly displayed the Complainant's trademark. As well, it reproduced images of the Complainant's projects. This shows that the Respondent attempted to impersonate the Complainant. In addition, the Panel notes that the composition of the disputed domain name (with added term "dowa") carries a risk of implied affiliation since Internet users may think that the Website belonged to the Complainant (see sections 2.5.1, and 2.13.1 of the [WIPO Overview 3.0](#); see also *Self-Portrait IP Limited v. Franklin Kelly*; WIPO Case No. [D2019-0283](#)).

The addition of the term "dowa", affirms the confusing similarity and indeed likelihood of confusing, since said term corresponds to the name of a United States company acquired by the Complainant. This fanciful term is an acronym from Dull, Olson, Weekes, and Architects "dowa". Therefore, Internet users might be confused by thinking that the disputed domain name is related to the Complainant.

Finally, until the date of issuance of this decision, the disputed domain name resolves to a website that apparently provides architectural services that compete with the ones provided by the Complainant. Thus, previous UDRP panels have found that using a complainant's mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests. See section 2.5.3 of the [WIPO Overview 3.0](#), see also *Roberto Federico Wille Buschmann and Industrial Esco-will, S.A. de C.V. v. STX – Dominios, STX* WIPO Case No. [D2017-2581](#) ("Further, in the Panel's view, the redirecting of the disputed domain name to a website offering similar and competing products to those marketed by the Complainant, is neither a *bona fide* offering of goods nor a legitimate noncommercial or fair use of the disputed domain name under subparagraphs (i) and (iii) of Policy paragraph 4(c).")

The Complainant has made a *prima facie* case asserting that there is no evidence of the Respondent's use of the disputed domain name in connection with a *bona fide* offering of goods or services and that the Respondent has not been commonly known by the disputed domain name. The Respondent has not submitted evidence to prove otherwise. The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

In light of the above, the second element of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Bad faith under the Policy is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the 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 its website or location.

As previously stated, the Complainant has proven that it owns registrations for the trademarks, IBI and IBI GROUP in several different jurisdictions, among others, in the United States, where the Respondent has declared to reside.

The fact that the Respondent chose to register the disputed domain name, which has resolved to a website that displayed the Complainant's trademarks, and made available reproductions of images which copyrights apparently belong to the Complainant, suggests that the Respondent knew the Complainant, its trademarks, and its business when registering the disputed domain name. Therefore, the Panel finds that the Respondent has targeted the Complainant, which constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); and *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#)).

These facts also show that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the Website by creating the impression among Internet users that said website was related to, associated with, or endorsed by the Complainant, which conduct constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

According to the evidence submitted by the Complainant and not contested by the Respondent, the said Respondent has used the disputed domain name in an attempt to impersonate the Complainant for commercial gain, which also constitutes bad faith under the Policy (see also *SwissCare Europe v. michael click, Active OutDoors LLC*, WIPO Case No. [D2022-1496](#): ("This Panel considers that, in appropriate circumstances, a failure to pass the impersonation test may properly lead to a finding of registration and use in bad faith because of the fact that, at its heart, such a domain name has been selected and used with the intention of unfairly deceiving Internet users, notably those who are (actual or potential) consumers of the trademark owner."); *Philip Morris Products S.A. v. Domain Administrator, Registrant of iqosatismaganiz.com (apiname com) / Anl Girgin, Teknoloji Sarayi*, WIPO Case No. [D2019-0466](#); *Self-Portrait IP Limited v. Franklin Kelly, supra*; and *Friedman and Soliman Enterprises, LLC v. Gary Selesko, M&B Relocation and Referral, LLC*, WIPO Case No. [D2016-0800](#)).

Moreover, to date, the disputed domain name redirects to a website that apparently offers architectural services in competition with those of the Complainant, which amounts to bad faith under paragraph 4(b)(iv) of the Policy. Section 3.1.4 of the [WIPO Overview 3.0](#), states that Panels have found that “redirecting the disputed domain name to the [C]omplainant’s (or a competitor’s) website” is evidence to support that the Respondent registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks (see also *AllianceBernstein LP v. Texas International Property Associates*, WIPO Case No. [D2008-1230](#) (“It is well-established that use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy.”), and *Carvana, LLC v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2020-1533](#) (“(ii) By using the Disputed Domain Name to divert Internet users away from the Complainant’s website towards the Respondent’s website or third-party websites in competition with the Complainant, the Panel finds the Respondent is likely to be improperly reaping commercial profit through diverted sales, and is likely to derive a benefit from the suspicious malware offerings.”).

Therefore, the third element of the Policy has been met.

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 <dowa-ibigroup.com> be transferred to the Complainant.

/Kiyoshi Tsuru/

Kiyoshi Tsuru

Sole Panelist

Date: November 17, 2022