

ADMINISTRATIVE PANEL DECISION

Dewberry Engineers Inc. v. Lisa Paschal

Case No. D2022-0909

1. The Parties

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

Respondent is Lisa Paschal, United States.

2. The Domain Name and Registrar

The disputed domain name <dewberrydesignandmarketing.com> 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 March 15, 2022. On March 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on March 17, 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 March 17, 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 March 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 20, 2022.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on May 11, 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 United States company. For well over a decade, Complainant has offered various services under the DEWBERRY mark. Complainant owns trademark registrations for the DEWBERRY mark in the United States, where Respondent lists an address of record, namely, U.S. Registration Nos. 2991043 (registered September 6, 2005) for DEWBERRY as a literal term (typed drawing), and 2991044 (registered September 6, 2005) for DEWBERRY and design. Both registrations identify various services including real estate and land development as well as “interior design and space planning,” among others. Complainant additionally owns the registration for the domain name <dewberry.com> (registered October 5, 1998).

The disputed domain name was registered on February 6, 2022. The disputed domain name is not currently linked to an active website. Respondent nevertheless has no affiliation with Complainant, nor any license to use its marks.

5. Parties’ Contentions

A. Complainant

Complainant contends that (i) the disputed domain name is identical or confusingly similar to Complainant’s trademarks, (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

Specifically, Complainant contends that it owns the DEWBERRY mark, which Complainant uses in connection with various “engineering, architecture, real estate services,” among others. Complainant additionally contends that it “has more than fifty locations in the United States” and that Complainant additionally owns the registration for the domain name <dewberry.com>. Complainant contends that Respondent has incorporated Complainant’s DEWBERRY mark into the disputed domain name, “adding only the descriptive terms “designandmarketing.” Complainant contends that Respondent lacks rights or legitimate interest in the disputed domain name, and rather has registered and is using it in bad faith, having simply acquired the disputed domain name for “one or more improper purposes, such as diverting traffic from Complainant’s website or seeking to sell the disputed domain name to Complainant.”

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel must first determine whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainants has rights in accordance with paragraph 4(a)(i) of the Policy.

The Panel finds that it is. The disputed domain name incorporates in full Complainant’s DEWBERRY mark with the addition of the dictionary words “design”, “and”, “marketing.”

Numerous UDRP panels have agreed that supplementing or modifying a trademark with descriptive words does not make a domain name any less “identical or confusingly similar” for purposes of satisfying this first prong of paragraph 4(a)(i) of the Policy. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8, “[w]here 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”.

The Panel therefore finds that Complainant has satisfied the first UDRP element, in showing that the disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights in accordance with paragraph (4)(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Panel next considers whether Complainant has shown that Respondent has no “rights or legitimate interest,” as must be proven to succeed in a UDRP dispute.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#) section 2.1.

Paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name “in connection with a *bona fide* offering of goods or services”; (ii) demonstration that respondent has been “commonly known by the domain name”; or (iii) “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”.

No evidence has been presented to the Panel that might support a claim of Respondent’s rights or legitimate interests in the disputed domain name, and Respondent has no license from, or other affiliation with, Complainant.

Therefore, the Panel finds that Complainant has provided sufficient evidence to carry its burden under this element of the Policy which Respondent has not rebutted.

D. Registered and Used in Bad Faith

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. As noted in Section 4 of this Panel’s decision, the disputed domain name is not currently linked to an active website. It is well established that having a passive website does not necessarily shield a respondent from a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3, which notes that the “non-use of a domain name” does not necessarily negate a finding of bad faith. Rather, a panel must examine “the totality of the circumstances,” including, for example, whether a complainant has a well-known trademark, and whether a respondent conceals his/her identity and/or replies to the complaint.

Respondent here did not respond to the Complaint. Respondent also utilized a privacy service.

Respondent’s inclusion of Complainant’s registered DEWBERRY trademark in the disputed domain name coupled with addition of the term “designandmarketing” -- which may also be found to be descriptive of some of Complainant’s services -- in the Panel’s view suggests that Respondent was most likely aware of Complainant’s trademark at the time of obtaining the disputed domain name and chose to register it in order to try to exploit the reputation behind it without any authorization or rights to do so.

Respondent's lack of any demonstrated rights or legitimate interests in the disputed domain name, absence of any apparent good faith use of the disputed domain name by Respondent, failure to react and respond to Complainant's arguments in view of this Panel further support an inference of Respondent's targeting of Complainant's trademark rights. This conclusion is consistent with prior UDRP panels, which have found Complainant's DEWBERRY mark to be a distinctive, and a common target of cybersquatters. See *Dewberry Engineers Inc. v. Contact Privacy Inc. Customer 12411923346/ brian bach*, WIPO Case No. [D2022-0305](#); *Dewberry Engineers Inc. v. David Fok*, WIPO Case No. [D2021-4183](#); *Dewberry Engineers Inc. v. Domains by Proxy, LLC/Name Redacted*, WIPO Case No. [D2021-3986](#); *Dewberry Engineers Inc. v. Peggy Cumberledge, Island Service*, WIPO Case No. [D2020-0346](#), among others.

The Panel therefore finds Complainant has met its burden under this element of the Policy.

7. Decision

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

/Lorelei Ritchie/

Lorelei Ritchie

Sole Panelist

Date: June 1, 2022