

## **ADMINISTRATIVE PANEL DECISION**

Kimley-Horn and Associates, Inc. v. Privacy service provided by Withheld for Privacy ehf / Contact Privacy Inc. Customer 7151571251 / Allen Lu, Allengroup / COW COW, Cow / James Kennington, [...]@kimley-horn.com  
Case No. D2022-1885

### **1. The Parties**

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

The Respondents are Privacy service provided by Withheld for Privacy ehf, Iceland / Contact Privacy Inc. Customer 7151571251, United States / Allen Lu, Allengroup, United States / COW COW, Cow, United States / James Kennington, [...]@kimley-horn.com, United States.

### **2. The Domain Names and Registrars**

The disputed domain names <kimley-horn.com>, <kimley-h0rn.com> and <kimleys-horn.com> are registered with NameCheap, Inc. (the “Registrar”).

The disputed domain name <kimleyhorn.org> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2022. On May 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 25, 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 the Complainant on May 26, 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 May 31, 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 Respondents of the Complaint, and the proceedings commenced on June 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on June 23, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on July 8, 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 and design consulting firm. It owns the trademark KIMLEY-HORN, for which it has obtained registration in the United States (Reg. No. 2,788,474, registered on December 2, 2003).

According to the Whois records, the disputed domain names were registered on the following dates:

|                    |                |
|--------------------|----------------|
| <kimleys-horn.com> | April 26, 2022 |
| <kimleyhorn.org>   | May 2, 2022    |
| <kimley-horm.com>  | May 9, 2022    |
| <kimley-h0rn.com>  | May 9, 2022    |

The Complainant asserts that the Respondents have used three of the disputed domain names to establish websites showing pay-per-click advertisements. As for the remaining disputed domain name, the Complainant has submitted evidence showing the Respondents could be using such disputed domain name to send fraudulent email messages.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademark; that the Respondents have no rights or legitimate interests in respect of the disputed domain names; and that the disputed domain names were registered and are being used in bad faith.

##### **B. Respondents**

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

#### **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names, and (iii) the disputed domain names have been registered and are being used in bad faith. The Panel finds that all three of these elements have been met in this case.

##### **A. Procedural Issue: Consolidation**

There are three named Respondents (three underlying registrants for four disputed domain names disclosed by the Registrars). The Complainant requests that all of these Respondents be consolidated into this matter. Consolidation is proper, so the Complainant's request for consolidation is granted.

Paragraph 10(e) of the Rules states that a “[p]anel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules”. Paragraph 10(c) of the Rules provides, in relevant part, that “the [p]anel shall ensure that the administrative proceeding takes place with due expedition”. Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) summarizes the consensus view of UDRP panels on the consolidation of multiple respondents and provides that where a complaint is filed against multiple respondents, panels consider whether the domain names or corresponding websites are subject to common control, and whether the consolidation would be fair and equitable to all parties.

The record indicates the disputed domain names are under common control. The following facts support this conclusion:

- all of the disputed domain names were registered within a thirteen-day period between April 26, 2022, and May 9, 2022;
- three of the four disputed domain names were registered via the same registrar and were associated with the same nameserver;
- a different configuration of three of the disputed domain names were associated with the same email MX servers; and
- the disputed domain names all utilize essentially the same naming convention, specifically, the disputed domain names are comprised solely of confusingly similar variations of the KIMLEY-HORN mark.

The Respondents have not presented any arguments as to why consolidation would be unfair or inequitable. Accordingly, conditions for proper consolidation of the disputed domain names into one matter are present here.

## **B. Identical or Confusingly Similar**

This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and, second, whether the disputed domain names are identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. [WIPO Overview 3.0](#), section 1.7.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the KIMLEY-HORN mark by providing evidence of its trademark registrations.

The disputed domain names are confusingly similar to the KIMLEY-HORN mark. One of the disputed domain names incorporates the mark in its entirety (missing only the dash between the two words). As for the other three disputed domain names, the only difference between the disputed domain names and the mark results from minor misspellings. Such insignificant modifications to trademarks are commonly referred to as “typosquatting”, as such conduct seeks to wrongfully take advantage of errors by Internet users. See, *Six Continents Hotels, Inc. v. null John Zuccarini d/b/a Country Walk*, WIPO Case No. [D2003-0161](#). “Domain names which constitute typo-squatting are confusingly similar by definition; it is this similarity which makes them attractive.” *Dell Computer Corp. v. Clinical Evaluations*, WIPO Case No. [D2002-0423](#); see also *American Home Products Corporation v. Privateer Ltd.*, WIPO Case No. [D2000-0455](#) (<advil.com> held confusingly similar to ADVIL).

For the foregoing reasons, the Panel finds that this first element of the Policy has been satisfied.

## **C. Rights or Legitimate Interests**

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondents lack rights or legitimate interests in respect of the disputed domain names. If the Complainant makes that showing, the burden of production of demonstrating rights or

legitimate interests shifts to the Respondents (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts, among other things, that: (1) the Respondents are not commonly known by the disputed domain names, (2) the Complainant has not authorized the Respondents to use the KIMLEY-HORN mark, and (3) the Respondents are not using the disputed domain names in connection with a *bona fide* offering of goods or services. Instead, the Respondents have used three of the disputed domain names to display sponsored advertisements. Additionally, the Complainant has presented evidence that MX records have been established for the other disputed domain name, suggesting that the disputed domain name may be used for fraudulent purposes.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondents have not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondents' favor. Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

#### **D. Registered and Used in Bad Faith**

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [the respondent's] website or location".

Because the KIMLEY-HORN mark is so well known, it is implausible to believe that the Respondents were not aware of it when they registered the disputed domain names. In the circumstances of this case, the mere registration of a domain name that is confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith registration of the disputed domain name. *Government Employees Insurance Company v. Joel Rosenzweig, RegC*, WIPO Case No. [D2021-1221](#). Bad faith use is shown from the Respondents' activities of using certain of the disputed domain names to present pay-per-click links for commercial gain. Passive holding (which seems to be the case at present for all the disputed domain names) moreover does not prevent a finding of bad faith. Furthermore, bad faith would be shown were the disputed domain names used to send fraudulent email messages. For these reasons, the Panel finds that the Complainant has successfully met this third element.

#### **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 names <kimley-horn.com>, <kimleyhorn.org>, <kimley-h0rn.com> and <kimleys-horn.com> be transferred to the Complainant.

/Evan D. Brown/

**Evan D. Brown**

Sole Panelist

Date: July 22, 2022