

## **ADMINISTRATIVE PANEL DECISION**

Dewberry Engineers Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico

Case No. D2022-5002

### **1. The Parties**

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

### **2. The Domain Name and Registrar**

The disputed domain name <hqaddressdewberry.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 27, 2022. On December 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 29, 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 January 16, 2023, 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 January 17, 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 the Respondent of the Complaint, and the proceedings commenced on January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 9, 2023.

The Center appointed Kaya Köklü as the sole panelist in this matter on February 16, 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**

The Complainant is an engineering, architecture, real estate services, and emergency management firm which offers various additional services and has more than fifty locations in the United States.

The Complainant is the owner of the United States Trademark No. 2,991,043 for DEWBERRY, and No. 2,991,044 for DEWBERRY in combination with a figurative element, both registered on September 6, 2005, for services in Classes 35, 37, 40, 42 and 45.

The Complainant further operates its main website at "dewberry.com".

The Respondent is reportedly located in Panama.

The disputed domain name was registered on October 6, 2022.

Apparently, the disputed domain name has yet not been associated to an active website.

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

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

The Complainant requests the transfer of the disputed domain name.

The Complainant is of the opinion that the disputed domain name confusingly similar to its DEWBERRY trademark.

It further argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In addition, the Complainant is convinced that the Respondent has registered and is using the disputed domain name in bad faith.

##### **B. Respondent**

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

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

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

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

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

For the evaluation of this case, the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views stated therein.

#### **A. Identical or Confusingly Similar**

To begin with, the Panel confirms that the Complainant has satisfied the threshold requirement of having relevant trademark rights. As evidenced in the Complaint, the Complainant is the owner of the DEWBERRY trademark (Annexes 5a and 5b to the Complaint).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's DEWBERRY trademark. The disputed domain name fully comprises the DEWBERRY trademark. As stated at section 1.8 of the [WIPO Overview 3.0](#), where a trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity. In the present case, the mere addition of the abbreviation "hq" (probably standing for "headquarter") and the term "address", does, in view of the Panel, not serve to avoid a finding of confusing similarity between the disputed domain name and the Complainant's DEWBERRY trademark.

In view of the above, the Panel is satisfied that the Complainant has met the requirements under paragraph 4(a)(i) of the Policy.

#### **B. Rights or Legitimate Interests**

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of proving a negative, in particular as the evidence needed to show the Respondent's rights or legitimate interests is primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy. *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

With its Complaint, the Complainant has provided *prima facie* evidence that the Respondent has no rights or legitimate interests, particularly no license or alike to use the Complainant's DEWBERRY trademark in a confusingly similar way within the disputed domain name.

In the absence of a Response, the Respondent has failed to demonstrate any of the nonexclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or provide any other evidence of a right or legitimate interest in the disputed domain name.

The Panel has no doubt that the Respondent was aware of the Complainant and its DEWBERRY trademark before registering the disputed domain name, particularly noting the nature of the disputed domain name. The Panel notes that the disputed domain name uses the terms "hq" and "address" in combination with the use of the Complainant's DEWBERRY trademark, which results in "DEWBERRY" being used here as a reference to an entity (*i.e.* to the Complainant), and not in a dictionary sense of the term "dewberry".

Bearing all this in mind, the Panel does also not see any basis for assessing a *bona fide* offering of goods or services by the Respondent.

Consequently, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

The Panel is convinced that the Respondent was aware of the Complainant's DEWBERRY trademark when registering the disputed domain name in October 2022. At the date of registration, the Complainant's DEWBERRY trademark was already registered and used for many years. Bearing in mind the inherently misleading nature of the disputed domain name, it is obvious to the Panel, that the Respondent has deliberately chosen the disputed domain name to target and mislead Internet users who particularly are searching for information on the Complainant and its contact details and/or services. Consequently, the Panel has no doubt that the Respondent has registered the disputed domain name in bad faith.

With respect to the use of the disputed domain name in bad faith, as already indicated before, the disputed domain name has apparently yet not been linked to an active website. Nonetheless, and in line with the previous UDRP decisions (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)) and section 3.3 of the [WIPO Overview 3.0](#), the Panel believes that the non-use of a domain name does not prevent a finding of bad faith use.

Applying the passive holding doctrine as summarized in section 3.3 of the [WIPO Overview 3.0](#), the Panel assesses that the composition of the disputed domain name is inherently misleading.

Also, the Panel accepts the failure of the Respondent to submit a response to the Complainant's contentions as an additional affirmation of the Panel's finding of bad faith.

Taking the facts of the case into consideration, the Panel believes that this is a typical cybersquatting case, which the UDRP was designed to stop. The Panel therefore concludes that the disputed domain name was registered and is being used in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, 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 disputed domain name <hqaddressdewberry.com> be transferred to the Complainant.

*/Kaya Köklü/*

**Kaya Köklü**

Sole Panelist

Date: March 2, 2023