

ADMINISTRATIVE PANEL DECISION

Dewberry Engineers Inc. v. Michael Dunn
Case No. D2023-0781

1. The Parties

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

Respondent is Michael Dunn, United States.

2. The Domain Name and Registrar

The disputed domain name <dewberry-us.com> (“Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2023. On February 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 23, 2023, 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 (Withheld for Privacy Purposes) and contact information in the Complaint. The Center sent an email communication to Complainant on February 23, 2023, 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 1, 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 Respondent of the Complaint, and the proceedings commenced on March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 28, 2023.

The Center appointed Richard W. Page as the sole panelist in this matter on April 6, 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 is an engineering, architecture, real estate services, and emergency management firm, which offers a wide variety of additional services and has more than fifty locations in the United States. Complainant is also the owner of the <dewberry.com> domain name, which was registered on October 4, 1998.

Complainant is the owner of numerous registered service marks, including without limitation: DEWBERRY U.S. Registration No. 2,991,043 registered September 6, 2003 and DEWBERRY and Berry Design U.S. Registration No. 2,991,044 registered September 6, 2003 (collectively the "DEWBERRY Mark") covering a wide variety of services. The DEWBERRY Mark is used by Complainant in connection with all of its services listed above.

The Disputed Domain Name was registered on January 13, 2023, and it resolves to an inactive website.

5. Parties' Contentions

A. Complainant

Complainant contends that the Disputed Domain Name is, on its face, confusingly similar to the DEWBERRY Mark. Complainant further contends that, in a side-by-side comparison of the Disputed Domain Name and the textual component of the DEWBERRY Mark, the Disputed Domain Name incorporates the entirety of the DEWBERRY Mark, adding only a dash and the two letters "us" to the name. Complainant further contends that this does not sufficiently alter the overall commercial impression of the two terms and therefore renders them to be confusingly similar in appearance.

Complaint alleges that Respondent has no rights or legitimate interests with respect of the Disputed Domain Name, because Respondent has no registered trademark of service mark. Complainant further alleges that there is no evidence that Respondent is commonly known by the Disputed Domain Name or that Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name

Complainant further alleges that a Google search of the Disputed Domain Name does not return any results that connect to Respondent. In fact, the search directs the user to the homepage at Complainant's <dewberry.com> domain name. Complainant further alleges that Respondent has not created a website offering goods or services in connection with the Disputed Domain Name.

Complainant asserts that the Disputed Domain Name is confusingly similar to the DEWBERRY Marks and was registered by people who neither do business with Complainant nor have Complainant as part of their name. Complainant further asserts that Respondent registered the Disputed Domain Name on January 13, 2023, and there is a high likelihood of confusion between the website to which the Disputed Domain Name resolves and Complainant's official website. Complainant further asserts that, based on the nearly identical nature of the Disputed Domain Name to the DEWBERRY Mark, Respondent's registration and use of the Disputed Domain Name indicates that such registration and use has been done for the specific purpose of trading on the name and reputation to Complainant and its DEWBERRY Mark.

Complainant further asserts that the use of the characters "-us" in the Disputed Domain Name incorporates a commonly known and used abbreviation for the United States. Complainant further asserts that Respondent's addition of "-us" to Complainant's well-known name constitutes an attempt to signify to

potential customers of Complainant that the Disputed Domain Name is associated with a United States branch of Complainant's business.

Complainant further asserts that it is not aware of any use of the Disputed Domain Name. Complainant further asserts that inactive or passive holding of the Disputed Domain Name by Respondent still demonstrates bad faith registration and use.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Even though Respondent has failed to file a Response or to contest Complainant's assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to a the DEWBERRY Mark in which Complainant has rights; and
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant contends that it owns registrations for the DEWBERRY Mark. Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the DEWBERRY Mark.

For purposes of this proceeding, the Panel finds that Complainant has enforceable rights in the DEWBERRY Mark.

Complainant further contends that the Disputed Domain Name is confusingly similar to the DEWBERRY Mark.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that generic Top-Level Domains ("gTLDs") such as ".com" may be disregarded for purposes of assessing confusing similarity.

The Panel determines that the entirety of the DEWBERRY Mark is included in the Disputed Domain Name and that the additional phrase "-us" does not prevent confusing similarity. The gTLD ".com" may be disregarded.

Therefore, the Panel finds that Complainant has satisfied the necessary elements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant alleges that Respondent has no rights or legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating it has rights or legitimate interests in the Disputed Domain Name. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the DEWBERRY Mark.

Complainant further alleges that Respondent has no rights or legitimate interests with respect of the Disputed Domain Name, because Respondent has no registered trademark or service mark. Complainant further alleges that there is no evidence that Respondent is commonly known by the Disputed Domain Name or that Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name

Complainant further alleges that a Google search of the Disputed Domain Name does not return any results that connect to Respondent. In fact, the search directs the user to the homepage at Complainant's <dewberry.com> domain. Complainant further alleges that Respondent has not created a website offering goods or services in connection with the Disputed Domain Name.

The Panel finds that Complainant has made a *prima facie* case that Respondent has not rights or legitimate interests in the Disputed Domain Name. Respondent has not contested Complainant's allegations.

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

C. Registered and Used in Bad Faith

Complainant asserts that Respondent registered and is using the Domain Name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

(i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the DEWBERRY Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or

(ii) you [Respondent] have registered the Disputed Domain Name in order to prevent Complainant from reflecting the DEWBERRY Mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the DEWBERRY Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

The four criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In addition to these criteria, other factors alone or in combination can support a finding of bad faith. Section 3.2.2 of [WIPO Overview 3.0](#) states that an additional factor is the Respondent should have known about Complainant's rights in the DEWBERRY Mark. Section 3.4 of [WIPO Overview 3.0](#) states that passive holding of the Disputed Domain Name is an additional element to be considered in a determination of bad faith.

Complainant asserts that registration of the DEWBERRY Mark and of the <dewberry.com> domain name and resultant website predate the registration of the Disputed Domain Name, and that Respondent should have been aware of Complainant's rights in the DEWBERRY Mark.

Complainant further asserts that it is not aware of any use of the Disputed Domain Name. Complainant further asserts that inactive or passive holding of the Disputed Domain Name by Respondent demonstrates bad faith registration and use.

The Panel finds that Respondent should have been aware of Complainant's rights in the DEWBERRY Mark when he registered the Disputed Domain Name and that Respondent has engaged in passive holding of the Disputed Domain Name.

Therefore, the Panel finds that Complainant has satisfied the requirements of 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, <dewberry-us.com> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: April 20, 2023