

## **ADMINISTRATIVE PANEL DECISION**

Kimley-Horn and Associates, Inc. v. Shonta Casson  
Case No. D2023-3848

### **1. The Parties**

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

Respondent is Shonta Casson, U.S.

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

The disputed domain name <kimleyhornassociates.com> (the “Domain Name”) is registered with Network Solutions, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 14, 2023. On September 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to Complainant on September 18, 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 September 19, 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 September 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 12, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 13, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on October 25, 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 and design consulting firm. Founded in 1967, Complainant has used the KIMLEY-HORN trademark in connection with the marketing, advertising, promotion, and provision of Complainant's planning, engineering, and design consulting firm services.

Complainant owns registered federal trademark registrations, for the KIMLEY-HORN trademark in the U.S., including:

- Registered U.S. trademark number 2,788,474 for the KIMLEY-HORN word mark, registered on December 2, 2003; and
- Registered U.S. trademark number 4,685,771 for the KIMLEY-HORN design and word mark, registered on February 10, 2015.

The Domain Name was registered on August 24, 2023 and reverts to a third party website featuring sponsored pay-per-click ("PPC") advertisements and links, some of which are advertisements for third parties offering services competitive to Complainant's services.

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

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

Complainant contends that (i) the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for KIMLEY-HORN and that Respondent registered and is using the Domain Name with the intention to confuse Internet users looking for *bona fide* and well-known KIMLEY-HORN products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademark, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in registering and setting up the Domain Name, when Respondent clearly knew of Complainant's rights.

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

Respondent did not formally reply to Complainant's contentions.

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

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) states that failure to respond to the complainant’s contentions “would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true”.

Thus, although in this case Respondent has failed to formally respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

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

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the KIMLEY-HORN trademarks, as noted above. Complainant has also submitted evidence, which supports that the KIMLEY-HORN trademarks are known and a source identifier of Complainant’s products and services. Complainant has therefore proven that it has the requisite rights in the KIMLEY-HORN trademarks.

With Complainant’s rights in the KIMLEY-HORN trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain (“TLD”) in which it is registered (in this case, “.com”), is identical or confusingly similar to Complainant’s trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant’s KIMLEY-HORN trademarks. The use of Complainant’s trademark in this entirety, with the hyphen “-” between “kimley” and “horn” and the addition of the term “associates”, does not prevent a finding of confusing similarity between the Domain Name and the KIMLEY-HORN trademark as it is recognizable in the Domain Name.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

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

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its KIMLEY-HORN trademarks, and does not have any rights or legitimate interests in the Domain Name. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the KIMLEY-HORN trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the KIMLEY-HORN trademarks, and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, it reverts to a webpage with PPC links to third party websites with products and services, some of which are competitive to Complainant's business. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

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

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have 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) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your web site or location."

The Panel finds that Complainant has provided ample evidence to show that registration and use of the KIMLEY-HORN trademarks predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's KIMLEY-HORN trademarks and related products and services are widely known and recognized. Moreover, the addition of the term "associates" to Complainant's trademark in the Domain Name suggests activities potentially related to engaging in Complainant's industry and activities. Therefore, Respondent was likely aware of the KIMLEY-HORN trademarks when he registered the Domain Name, or knew or should have known that the Domain Name was identical to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's KIMLEY-HORN trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the KIMLEY-HORN trademarks at the time of registration of the Domain Name and its effort to opportunistically capitalize on the registration and use of the Domain Name. Further, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#). Here, the addition of the term "associates" to Complainant's trademark in the Domain Name suggests activities potentially related to engaging in Complainant's industry and activities.

Respondent registered and is using the Domain Name to confuse and mislead consumers looking for well-known KIMLEY-HORN products and services of Complainant or authorized partners of Complainant. The use of the KIMLEY-HORN trademarks in the Domain Name is intended to capture Internet traffic from Internet users who are looking for Complainant's products and services. The use of the Domain Name to divert users to the webpage with PPC links to third party websites, for commercial gain, by creating a likelihood of confusion with Complainant's mark is in bad faith. In addition, Respondent's association of an email server with the Domain Name may potentially result in Internet users receiving emails and phishing activity perceived to have originated from Complainant. Such activities may result in tarnishing Complainant's reputation.

Finally, the Panel also notes the reputation of the KIMLEY-HORN trademarks, and the failure of Respondent to submit a response to the Complaint or to provide any evidence of actual or contemplated good-faith use, and the implausibility of any good-faith use to which the Domain Name may be put.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Name, <kimleyhornassociates.com> be transferred to Complainant.

*/Kimberley Chen Nobles/*

**Kimberley Chen Nobles**

Sole Panelist

Date: November 8, 2023