

ADMINISTRATIVE PANEL DECISION

Kimley-Horn and Associates, Inc. v. cosby repullt, Cosby LLC
Case No. D2024-1250

1. The Parties

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

Respondent is cosby repullt, Cosby LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <kimley-hon.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2024. On March 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 25, 2024, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on March 26, 2024, 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 28, 2024

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 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 18, 2024.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on April 25, 2024. 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, Kimley-Horn and Associates, Inc., is a United States based engineering, planning, and design consulting firm. Complainant owns and uses the name and mark KIMLEY-HORN in connection with its services. Complainant owns two trademark registration for the KIMLEY-HORN mark in the United States: (i) a word mark registration for KIMLEY-HORN (Registration No. 2,788,474) that issued to registration on December 2, 2003, and (ii) a registration for a logo incorporating KIMLEY HORN (Registration 4,685,771) that issued to registration on February 10, 2015. Complainant also owns and uses the domain name <kimley-horn.com> for a website about Complainant and its services.

Respondent, who is also based in the United States, registered the disputed domain name on February 22, 2024. The Respondent does not appear to have used the disputed domain name for an active and website or page and has simply allowed the disputed domain name to resolves to a page with pay-per-click links (“PPC”). Respondent, however, may have set up the disputed domain name for email purposes.¹

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant maintains that it has used the KIMLEY-HORN mark since 1967 and as a result of Complainant’s marketing, advertising, promotion and use of the KIMLEY-HORN mark has acquired a substantial amount of reputation and goodwill.

Complainant contends that the disputed domain name is confusingly similar to the KIMLEY-HORN mark as it is merely a typo version of the KIMLEY-HORN mark by eliminating the letter “r” in “horn”.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name as Respondent: (i) is not commonly known by the KIMLEY-HORN mark or “kimley-hon”, (ii) has not been authorized or licensed by Complainant to use the KIMLEY-HORN mark or a variant thereof, (iii) can have no rights or legitimate interests in the disputed domain name because on its face it effectively impersonates Complainant or suggests a sponsorship or endorsement by Complainant, (iv) has simply used the disputed domain name to attract web users to a page full of “pay-per-click advertisements which feature ads for third-party products and services”, and (v) has set up the disputed domain name for email purposes which suggests a possible illegal activity such as “a phishing or business email compromise scheme”.

Lastly, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith given that the disputed domain name is merely a typo version of Complainant’s highly distinctive KIMLEY-HORN mark which has been in use for the past 56 years. In that regard, Complainant notes that it “stretches credibility that Respondent would have a legitimate speculative reason for registering the Domain other than specifically targeting Complainant, which amounts to registration of the Domain Name in bad faith.” Complainant further argues that Respondent has acted in bad faith by using the disputed domain name, which is based on Complainant’s KIMLEY-HORN mark, for financial gain either through a PPC page placed at the disputed domain name or through its possible use for email for potentially illegal activities.

B. Respondent

Respondent did not reply to Complainant’s contentions.

¹ Respondent asserts that the disputed domain name has been set up for email, but the evidence provided was not clear. The Panel in its discretion checked for MX records for the disputed domain name through the publicly available website at “www.mxtoolbox.com” and notes that the disputed domain name may be set up for email purposes.

6. Discussion and Findings

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

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

Here, although Respondent has failed to respond to the Complaint, the default does not automatically result in a decision in favor of Complainant, nor is it an admission that Complainant's claims are true. The burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. A panel, however, may draw appropriate inferences from a respondent's default in light of the particular facts and circumstances of the case, such as regarding factual allegations that are not inherently implausible as being true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"); see also *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#) at section 1.7.

Here, Complainant has shown rights in respect the KIMLEY-HORN mark for purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Panel finds that the disputed domain name is confusingly similar to Complainant's KIMLEY-HORN mark as the disputed domain name is merely a typo version or misspelling of the KIMLEY-HORN mark that drops the letter "r" in "HORN".

The first element of the Policy has thus been established by Complainant.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

Based on the evidence submitted in this proceeding, and Respondent's failure to file a response, the Panel concludes that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent's registration of the disputed domain name that is clearly based on the KIMLEY-HORN mark does not seem coincidental. The disputed domain is visually similar to the KIMLEY-HORN mark in overall appearance and is likely to be mistakenly seen by consumers as related to Complainant and its services. Simply put, because the disputed domain name effectively impersonates Complainant it carries a high risk of implied affiliation to Complainant. As such, it is hard to see how Respondent could have any rights or legitimate interests in the disputed domain name. [WIPO Overview 3.0](#) at section 2.5.1.

The fact that Respondent has made no use of the disputed domain name for an active website or page and has merely allowed it to be used with a PPC page does not detract from a finding that Respondent lacks rights or legitimate interests in the disputed domain name. [WIPO Overview 3.0](#), section 2.9. Apart from impersonating Complainant, the disputed domain name may be set up for email purposes. While this could possibly be innocuous, there is a risk that the disputed domain name may be in use for fraudulent email purposes. This simply reinforces the likelihood that the underlying intent is to impersonate Complainant in some way, and/or perhaps to further a nefarious purpose. Such use is simply not legitimate. *Id.* at sections 2.5.1 and 2.13.1.

Given that Complainant has established with sufficient evidence that it owns rights in the KIMLEY-HORN mark, and given Respondent's above noted actions and failure to file a response, the Panel concludes that Respondent does not have a right or legitimate interest in the disputed domain name and that none of the circumstances of paragraph 4(c) of the Policy are evident in this case.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In view of Respondent's actions, and failure to appear in this proceeding, the Panel finds that Respondent's registration and use of the disputed domain name, which is merely a typo version of Complainant's KIMLEY-HORN mark, has been done opportunistically and in bad faith for benefit or profit of Respondent. The disputed domain name essentially impersonates Complainant's KIMLEY-HORN mark and the <kimley-horn.com> domain name and was registered well after Complainant had established rights in its KIMLEY-HORN mark. Respondent, as already noted, has used the disputed domain name for an active website or page, but merely allowed its use with a PPC page. Respondent may have also set up the disputed domain name for email purposes, which suggests a possible fraudulent purpose. All of these circumstances, at the very least, indicate that Respondent has registered and uses the disputed domain name with the intent to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's mark. In all, Respondent's actions make it more probable than not that Respondent was fully aware of Complainant and its KIMLEY-HORN name when it registered the disputed domain name and specifically chose to target Complainant in bad faith.

The Panel thus finds that Complainant has established the third element 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 <kimley-hon.com> be transferred to Complainant.

/Georges Nahitchevansky/

Georges Nahitchevansky

Sole Panelist

Date: May 9, 2024