Decision for dispute CAC-UDRP-102751

Case number	CAC-UDRP-102751
Time of filing	2019-11-07 11:33:02
Domain names	swinerton-builders.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Swinerton Incorporated

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	Jose Zafra

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings concerning the disputed domain name which are pending or decided.

IDENTIFICATION OF RIGHTS

The Complainant is the registered proprietor of the following registered trademarks:

U.S. Reg. No. 2,284,825, issued Oct. 12, 1999, in Int'l Cl. 35, first use Oct. 11, 1923, for SWINERTON (Standard Characters);
U.S. Reg. No. 2,282,855, issued Oct. 5, 1999, in Int'l Cl. 37, first use 1923, for SWINERTON (Standard Characters);
U.S. Reg. No. 5,756,816, issued May 21, 2019, Int'l Cl. 35,37, first use in 2018 for a SWINTERTON (& Design).

The Complainant also has common law rights in the United States going as far back as 1923 based on the certified first-use dates in the '825 and '855 registrations.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

[I] The disputed domain name is Identical or Confusingly Similar to a Mark in which Complainant has Rights (Policy paragraph 4(a)(ii)).

[I.A] The Complainant's Background and the SWINERTON Mark

Recognized nationally in the U.S. since its founding in 1888, through its predecessors-in-interest and subsidiaries, the Complainant provides commercial construction and construction management services throughout the U.S. It has helped build communities from the peaks of the Rocky Mountains to the Hawaiian Islands, from the Gulf of Alaska to the jungles of Colombia. The company obtained its state license in California in 1927 when the State of California first began issuing licenses. Many structures built by the Complainant now claim a spot on the National Register of Historic Places and other architectural preservation lists. In 2018, Swinerton was ranked as the 117th largest private company across all industries, according to Forbes.

TThe Complainant owns several Swinerton registered and Common Law trademarks SWINERTON.

[I.B]. The disputed domain name is Confusingly Similar to a Mark in Which Swinerton Has Rights (paragraph 4(a)(i) of the Policy).

The Respondent wholly incorporates the mark into the disputed domain name. Adding a generic term ("builders") related to the services covered by the Complainant's registrations reinforces confusing similarity. There is also a stronger likelihood of confusion, considering the Complainant naturally uses the generic word that was appended to its mark in the disputed domain name. One of the Complainant's subsidiaries even goes by "Swinerton Builders". Generic words, with or without a hyphen, do not negate confusing similarity.

[II] Respondent has no Rights or Legitimate Interests in the disputed domain name (Policy, paragraph 4(a)(ii)).

Not only is the Respondent not commonly known by the disputed domain name, as evidenced by the registrar verification response, but the Complainant has not authorized, licensed, or otherwise permitted Respondent to use the trademark.

The Respondent configured the Web server on the disputed domain name in a way that a browser will connect to it, but not be able to find the requested URL and instead returns a 404 error message. There is no plausible future active use of the disputed domain name name by the Respondent that would be legitimate without permission from the Complainant.

The following answer from DNS shows the priority of mail servers connected in the DNS via the MX records to the disputed domain name so that the Respondent can use the disputed domain name to direct email to his G Suite account:

ANSWER SECTION:
swinerton-builders.com. 3600 IN MX 1 aspmx.l.google.com.
swinerton-builders.com. 3600 IN MX 5 alt1.aspmx.l.google.com.
swinerton-builders.com. 3600 IN MX 5 alt2.aspmx.l.google.com.
swinerton-builders.com. 3600 IN MX 10 aspmx2.googlemail.com.
swinerton-builders.com. 3600 IN MX 10 aspmx3.googlemail.com.

[III]. The disputed domain name Was Registered and Used in Bad Faith (Policy paragraph 4(a)(iii)).

The Respondent knew of the Complainant's mark before registering and using the disputed domain name, and he likely has used, and if not stopped, will continue to use, the disputed domain name to scam and deceive people using Gmail. He combined the Complainant's mark with a generic word describing the services covered by the registered trademark in which the Complainant has established rights well before the creation of the disputed domain name. Setting up a custom email address knowing it is likely to deceive recipients into thinking it belongs to the Complainant and then connecting it to the DNS by configuring Mail (MX) records to collect mail on the disputed domain name is bad-faith registration and use. Creating Mail records on the disputed domain name exploits the trademark significance as emails obtained through the server are likely being sent mistakenly believing the email accounts are under the Complainant's management. Deceitful email communication for financial gain is neither bona fide, not is it fair use.

Also, in this case, the Respondent's concealing of its identity and contact information for the disputed domain name reinforces the independent finding of bad-faith registration and use.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

According to Paragraph 4(a) of the Policy, a complainant is required to prove each of the following three elements to obtain an order that a domain name should be transferred or cancelled:

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

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The disputed domain name is confusingly similar to the Complainant’s trademarks. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:
a) disregarding the top-level suffix in the domain name (i.e. “.com”), and
b) not finding that the addition of a generic word or words or a combination thereof (such as “BUILDERS”), clearly indicating the activity carried out by the proprietor of the mark, would be sufficient to distinguish a domain name from a trademark.
Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet

Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

The Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations for use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name.

On the contrary, the Respondent has signed into his GoDaddy host account, has gone into his DNS records, and has added the G Suite MX records to direct email to his G Suite account. He has used the disputed domain name to set up the values of G Suite mail servers. In the DNS, he has pointed the Mail record to Google. The Respondent has specifically used the disputed domain name to receive email messages sent to the disputed domain name by directing it to G Suite mail servers. Publicly available information online suggests that some people have complained or reported that they have received fraudulent emails from the disputed domain name.

The Respondent uses the Complainant´s trademark solely for the commercial gain to misleadingly divert the Complainant´s consumers and to tarnish the trademarks at issue by creating the likelihood of confusion with the Complainant´s marks. The circumstances indicate that the Respondent is using the disputed domain name in a way which has confused or is likely to confuse people or businesses into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

There is no indication that the disputed domain name was registered and is being used in a bona fide manner.

Given the reputation of the Complainant and its trademarks, the Panel must conclude that the Respondent was fully aware of the Complainant's trademarks "SWINERTON" at the time of registering the disputed domain name <SWINERTON-BUILDERS.COM >. Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SWINERTON-BUILDERS.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2019-12-23

Publish the Decision