

Decision for dispute CAC-UDRP-103786

Case number **CAC-UDRP-103786**

Time of filing **2021-05-12 10:12:36**

Domain names **SWINTERTON.COM**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Swinerton Incorporated**

Complainant representative

Organization **RiskIQ, Inc. - Incident Investigation and Intelligence (i3), Jonathan Matkowsky**

Respondent

Organization **Catch All Investments LLC**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the US trademark SWINERTON (registration n°2,284,825) dated October 12, 1999;
- the US trademark SWINERTON (registration n°2,282,855) dated October 05, 1999;
- the US trademark SWINERTON (registration n°5,756,816) dated May 21, 2019.

Moreover, the Complainant is also the owner of common law right in the United States going far back to 1923 based on the certified first-use dates in '825 and '855 registrations.

FACTUAL BACKGROUND

The Complainant was founded on 1888 and nowadays is one of the largest private companies across all industries providing commercial construction and construction management services through the U.S.

The Complainant holds several trademark registrations for “SWINERTON”.

The Respondent registered the disputed domain name <swinterton.com>. The domain name is currently inactive.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The disputed domain name is confusingly similar to the Complainant's well-known and distinctive trademark "SWINERTON" as it bears the Complainant's "SWINERTON" trademark as a whole with the addition of the letter "T".

The Complainant states that the disputed domain name contains an obvious misspelling of the Complainant's trademark and the present case is a clear example of typosquatting where the disputed domain name is a slight alphabetical variation of the Complainant's trademark.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent has no rights on the disputed domain name as the Respondent is not known as the disputed domain name and as the Respondent does not hold any trademark for "SWINERTON".

The Complainant also states that the Respondent is neither affiliated nor authorized by the Complainant in any way and they do not carry out any business activity together.

The Complainant also alleges that neither license nor authorization has been granted to the Respondent to use the Complainant's trademark "SWINERTON".

The Complainant argues that the Respondent is not using the domain name in connection with bona fide offering of goods or services or a legitimate non-commercial or fair use.

The Complainant indicates that it has made a prima facie case that the Respondent lacks legitimate rights or interests in the disputed domain name and the burden of proof has shifted to the Respondent.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant indicates that the Respondent intentionally used a misspelled version of the Complainant's trademark in order to create a confusing similarity.

The Complainant asserts that considering the well-known status of the Complainant's trademark, the Respondent knew about the Complainant and its rights before the registration of the disputed domain name. Accordingly, the disputed domain name was registered and is being used in bad faith.

The Complainant also states that the disputed domain name is not being used for any bona fide offering and this fact, not being used of the disputed domain name, alone is sufficient to prove the bad faith of the Respondent according to many WIPO UDRP decisions.

Accordingly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith.

RESPONDENT:

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- B. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- C. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of the “SWINERTON” trademarks.

The Panel finds that the disputed domain name is nearly identical with the Complainant’s “SWINERTON” trademark and the addition of the letter ‘T’ is not sufficient to vanish the similarity.

In particular, this case represents a clear example of typo-squatting, where the disputed domain name is one letter less or more than the Complainant’s mark.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant’s rights and concludes that the disputed domain name is confusingly similar with the Complainant’s trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademark "SWINERTON" has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's SWINERTON trademark is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the SWINERTON trademarks, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the link <swinterton.com> is currently inactive.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element 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. SWINTERTON.COM: Transferred

PANELLISTS

Name	Mrs Selma Ünlü
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DATE OF PANEL DECISION	2021-06-23
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Publish the Decision	
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