

Decision for dispute CAC-UDRP-103935

Case number CAC-UDRP-103935

Time of filing 2021-07-19 09:37:18

Domain names swinertonus.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 Fargo Electrical

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

Swinerton owns 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 SWINERTON (& Design). Swinerton 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:

Swinerton Incorporated traces its roots back to 1888, when a young Swedish immigrant formed a brick masonry and contracting business in Los Angeles to serve the growing city in its post-Gold Rush building boom. Since its earliest days the company has been building along the Western frontier. It is celebrated for exceptional craftsmanship in creating landmark projects throughout the West and beyond.

Complainant states that the disputed domain name <swinertonus.com> includes the entirety of the SWINERTON mark, with a geographical abbreviation for the United States, appended to the mark, which is merely descriptive of where Swinerton is headquartered, and does nothing to negate the confusing similarity of the registration to the SWINERTON mark.

Given Complainant's prominence in the construction market it is well-known, and in its niche it is famous. Since "Swinerton" is a corporate name that is both distinctive as a mark and distinctive in the marketplace, it is inconceivable that Respondent was unaware of it and registered the domain name for its brand value. The disputed domain name has no independent value except for its association with Complainant.

Complainant also points out that Respondent has engineered code changes to the MX code such that will confuse consumers to believe that <swinertonus.com> is or has been authorized by Complainant, a fact which is confirmed in that the domain name presently resolves to Complainant's official website. Complainant states that Respondent configured Mail server (MX) records on the disputed domain name, thusly: <swinertonus.com>. 3600 IN MX 0 swinertonus-com.mail.protection.outlook.com. These preparatory steps (configuring 'MX' or mail exchange records) have been considered in relation to 'use' for the purposes of the Policy by other Panels. This Panel concurs that such reconfiguration supports an inference directly concerning infringing use of the disputed domain name.

Respondent can have no legitimate interest in sending or receiving email from the disputed domain name because it will likely lead recipients of the email to mistakenly believe that the mail originates with permission or approval of the trademark owner. Worse, senders might mistakenly send sensitive data to the Respondent under the mistaken assumption that the mail account is under Swinerton's control or management, as would be expected given the disputed domain name likely suggests it is an account authorized or originating with Complainant given it incorporates the entirety of the <swinerton.com> domain and appends a geographical abbreviation for Complainant's headquarters, thereby only falsely reinforcing the connection between the disputed domain name and Complainant.

This certainly does not constitute making use, or demonstrable preparations for use, of 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.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that <swinertonus.com.com> is confusingly similar to its trademark in that it contains in whole the term together with the geographic acronym for the United States. The addition does not create a distinctive name independent of Complainant's mark and is clearly registered to be used to confuse visitors into believing that it belongs to, is associated with, or sponsored by Complainant.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been authorized by the Complainant to use the SWINERTON trademark, and the disputed domain name does not correspond to the name of the Respondent. The Complainant adds that the Respondent does not carry out a fair or non-commercial use of the disputed domain name as it currently resolves to Complainant's official website.

The Complainant contends further that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the SWINERTON trademark is distinctive and well-known, and that it is evident that the Respondent registered the disputed domain name with knowledge of Complainant's trademark. The addition of the geographic term does not create a separate and independent distinctive term. The disputed domain name is not used for any bona fide purpose and was registered and is being used in bad faith.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defence. In such event, UDRP Rule 14 provides (a) that the "Panel shall proceed to a decision on the complaint" and (b) that "the Panel shall draw such inferences therefrom as it considers appropriate." In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at Para. 4.3.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

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

In this case, the Czech Arbitration Court has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case and defend its registration of <swinertonus.com.com> the subject domain name.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ..."

Notwithstanding Respondent's default Complainant is not relieved from the burden of establishing its claim.

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0, § 4.3: "Noting the burden of proof on the complainant, a respondent's default (i.e., failure to submit a formal response) 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." However, if a complainant's adduced evidence supports any element of the Policy, a respondent has an opportunity to contest the contention that its registration of the challenged domain name was unlawful.

A. Identical or confusingly similar, §4(a)(i).

This first limb of the Policy requires Complainant to prove that it has a trademark right and that the disputed domain name is identical or confusingly similar to that mark. The Panel finds that Complainant has demonstrated that it has a registered trademark right to the term SWINERTON. Having established that element of the Policy the next question is whether the disputed domain name is identical or confusingly similar to Complainant's mark.

A side-by-side comparison of the domain name and the SWINERTON trademark indicates that <swinertonus.com.com> is confusingly similar to the mark in that it incorporates Complainant's trademark. At the threshold it is necessary only to consider "whether a domain name is similar enough in light of the purpose of the Policy to justify moving on to the other elements of a claim for cancellation or transfer of a domain name." The Panel in *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, D2000-1415 (WIPO January 23, 2001) notes that "numerous prior panels have held [the purposes of the Policy are satisfied] when a domain name wholly incorporates a complainant's registered mark." Similarly, *Magnum Piering, Inc. v The Mudjacks and Garwood S. Wilson, Sr.*, D2000-1525 (WIPO January 21, 2001). Panelists generally disregard the top-level suffixes as functional necessities, thus the top-level extension is irrelevant in determining the issue under the first requirement of the Policy. Having demonstrated that <swinertonus.com> is confusingly similar to Complainant's SWINERTON trademark the Panel finds Complainant has satisfied Para. 4(a)(i) of the Policy.

B. Rights and legitimate interests, Para. 4(a)(ii)

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for Complainant to allege a prima facie case, and if the evidence presented is conclusive or yields a positive inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations. This concept of shifting burdens is clearly explained in *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, D2003-0455 (WIPO August 21, 2003) in which the Panel held that "[s]ince it is difficult to prove a negative ... especially where the Respondent, rather than complainant, would be best placed to have specific knowledge of such rights or interests—and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light."

Once the 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 evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP," *Malayan Banking Berhad v. Beauty, Success & Truth International*, D2008-1393 (December 8, 2008). Finally, "in the absence of direct evidence, complainant and the panel must resort to reasonable inferences from whatever evidence is in the record," *Euromarket Designs, Inc. v. Domain For Sale VMI*, D2000-1195 (WIPO October 26, 2000).

In this case, Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent has no permission to use the SWINERTON trademark. The evidence in the record is conclusive that Respondent Fargo Electrical is not commonly known under the disputed domain name. See *Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group*, FA1804001781783 (Forum May 11, 2018) ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii)"); *Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy*, FA 1741129 (FORUM August 16, 2017) (finding that respondent had no rights or legitimate interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same).

Once the burden shifts, Respondent has the opportunity of demonstrating its right or legitimate interest by showing the existence of any of the following nonexclusive circumstances:

- (i) before any notice to you [respondent] of the dispute, your use of, or 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial

gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

If a respondent proves any of these circumstances or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the respondent must succeed. However, where respondent fails to respond, the panel must assess the record before it.

Here, the choice of the domain name corresponds to the trademark. The geographic addition is Complainant's location and does not create a distinctive term separate from the mark, but in fact reinforces the identity of domain name and mark. Therefore, Respondent's default and its failure to rebut Complainant's evidence is particularly telling. Since there is no proof otherwise, the record supports the conclusion that Respondent lacks any right or legitimate interest as measured by the three circumstances of paragraph 4(c). See *Deutsche Telekom AG v. Britt Cordon*, D2004-0487 (WIPO September 13, 2004) (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP). Similarly in *Malayan Banking Berhad*, supra. (holding that "[i]f the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.").

Accordingly, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith, §4(a)(iii)

Having determined that Respondent lacks rights or legitimate interests, the Complainant must then prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The consensus expressed in WIPO Overview 3.0, section 3.1.4. is that "the mere registration of a domain name that is identical or confusingly similar . . . to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Particularly probative in this case is that Complainant holds the domain name <swinerton.com> and the only difference with the disputed domain name is the addition of the geographic location. Absent a cogent explanation from Respondent justifying its choice of domain name, this supports the conclusion that it registered <swinertonus.com.com> with the purpose of taking advantage of its goodwill and reputation.

The Panel finds that the present case is one in which the presumption of bad faith is satisfied. The presumption is further strengthened by the strong inference of Respondent's actual knowledge of Complainant's and its SWINERTON trademark and of its intention to take advantage of its attractive value on the Internet solely for the reason of its goodwill flowing from its widely known or famous brand.

Paragraph 4(b) of the Policy sets out four nonexclusive circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 the respondent's website or location or of a product or service on the site or location.

Of the four circumstances, the fourth most readily applies as the domain name is clearly intended to attract Internet users seeking to reach Complainant's website or purchase its products and services. The domain name in this case is passively held, but for no conceivably lawful use. *Telstra, supra.*; also *National Football League v. Thomas Trainer*, D2006-1440 (WIPO December 29, 2006) <nflnetwork.com> (holding that "when a registrant, such as respondent here, obtains a domain name that is [identical and] to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted."

The Complainant also points out that the disputed domain name resolves to its official website, which in no sense, absent permission to do so, can be considered good faith. Added to this the reconfiguration of email service indicated above supports a conclusion that the purpose for registering <swinertonus.com> is to take advantage of Complainant's goodwill with the likelihood that it is intended to also take advantage of consumers whose emails it is likely to harvest or use in some harmful fashion.

The Respondent has specifically used the disputed domain name to receive email messages sent to _platform/form_show.php?dispute_id=103935&item_id=71848 10 of 12 8/13/2021, 5:42 AM the disputed domain name by directing it to G Suite mail servers."). See *Pepsico, Inc. v. Allen Othman*, CAC Case No. 102380 (ADR.eu April 25, 2019) ("In light of the evidence presented by the Complainant, the Panel finds that the disputed domain name was registered and is being used in bad faith, including through its use in association with the configuration of email accounts (MX records). The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met.").

Where the facts demonstrate an intent to capitalize on an owner's mark in the manner in which Complainant describes and which is supported by proof in the record, the registration is prima facie abusive. *Royal Bank of Canada - Banque Royale Du Canada v. Registration Private, Domains By Proxy, LLC / Randy Cass*, D2019-2803 (WIPO February 23, 2020) (<investease.com>. "It is clear that where the facts of the case establish that the respondent's intent in registering or acquiring a domain name was to unfairly capitalize on the complainant's nascent . . . trademark, panels have been prepared to find the respondent acted in bad faith."). See WIPO Overview 3.0, section 3.8.2.

The Panel finds that the Complainant has shown that the Respondent registered and is using the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iv) as well as within the larger notion of abusive conduct. The Panel finds that Complainant has adduced more than sufficient evidence to prove Respondent's bad faith based on the foregoing considerations.

Accordingly, the Respondent has registered and used the disputed domain name in bad faith and that its conduct firmly supports the conclusion that the registration of <swinertonus.com.com> was abusive. Having thus demonstrated that Respondent registered and is using the disputed domain name in bad faith, Complainant has also satisfied 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. SWINERTONUS.COM: Transferred

PANELLISTS

Name	Gerald M. Levine, Ph.D, Esq.
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DATE OF PANEL DECISION 2021-08-16

Publish the Decision
