

Decision for dispute CAC-UDRP-103979

Case number	CAC-UDRP-103979
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Time of filing	2021-08-12 11:13:04
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Domain names	swinerton-us.com
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Swinerton Incorporated
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Complainant representative

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

Organization	Nestle Nig Plc
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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. trade mark registrations:

- Reg. No. 2,284,825, issued October 12, 1999, in Int'l Cl. 35, first use October 11, 1923, for SWINERTON (Standard Characters);
- U.S. Reg. No. 2,282,855, issued October 5, 1999, in Int'l Cl. 37, first use 1923, for SWINERTON (Standard Characters); and
- 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 registrations no 2,284,825 and 2,284,855.

FACTUAL BACKGROUND

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

Recognized nationally in the U.S. since its founding in 1888, through its predecessors-in-interest and subsidiaries, Swinerton is one of the largest private companies across all industries--providing commercial construction and construction management services throughout the U.S.

The disputed domain name was registered recently in 2021.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

To succeed on its claim, Complainant ("Swinerton") must demonstrate that the three elements enumerated in 4(a) of the Policy have been satisfied, specifically: (i) the Domain is identical or confusingly similar to a trademark or service mark in which complainant has rights; (ii) Respondent has no rights to or legitimate interests in respect of the Domain; and (iii) Respondent has registered and is using the Domain in bad faith. The relevant standard of proof is the "balance of probabilities".

[I.] The Domain is Confusingly Similar to a Mark in which Swinerton has Rights (Policy 4(a)(i)).

The Domain incorporates the entirety of the SWINERTON mark, appending only a geographical indicator for where Swinerton is headquartered, which does not negate the confusing similarity of the registration to the SWINERTON mark.

Therefore, the Domain is confusingly similar to a mark in which Complainant has established rights within the meaning of the Policy.

[II.] The Respondent has no Rights or Legitimate Interests Within the Meaning of Policy 4(a)(ii)).

The Respondent is not affiliated with, nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license, nor authorization has been granted by the Complainant to the Respondent to make any use of the Complainant's trademark, or apply for registration of the Domain or any other domain name. The Whois contact information also supports that Respondent is not commonly known by the Domain.

The Respondent configured Mail server (MX) records on the Domain.

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. Respondent has no legitimate interest in sending or receiving e-mail from the Domain because it will likely lead recipients of the e-mail 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 Domain is confusingly similar to the Swinerton name and mark. This certainly does not constitute making use, or demonstrable preparations for use, of the Domain in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the Domain.

Worse, Complainant has already received complaints that fraudulent e-mails spoofing Swinerton employees are being sent from the Domain with a signature block containing Swinerton's official logo spoofing Swinerton to commit fraud.

[III.] The Domain was Registered and is Being Used in Bad Faith (Par. 4 (a)(iii) of the Policy).

The Complainant's evidence shows that the SWINERTON mark has been registered since 1995 whereas the Domain was only created this month. Proof that Respondent knew of Swinerton's rights in the SWINERTON mark when it registered the Domain

is in the use made of it to send e-mails spoofing and masquerading as Swinerton. This re-enforces that Respondent was well-aware of the well-known SWINERTON mark when it was registered, and did so for Respondent's own commercial gain to profit from the confusion that inevitably results when users believe that the mail server on the Domain belongs to Complainant, when that is not the case.

By connecting the mail server to the Domain and creating the false impression that it is Swinerton's server, it is implausible that there is any good faith use to which the Domain is being used. The fraudulent message appearing to come from this Domain masquerading as Swinerton shows that configuring email on this Domain is intended to confuse people into thinking the Domain belongs to Swinerton as part of a fraudulent scheme, such as fraudulent invoicing and purchasing orders. The Domain is under Respondent's control, and the MX (mail server) records were specifically configured through Zoho. Respondent is responsible for these Mail records.

Per Paragraph 4(b)(iv) of the Policy, Respondent likely registered and is using the Domain to intentionally attempt to attract, for commercial gain, Internet users to an online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of a location of a mail server sending and receiving emails likely intended for Complainant. This is evidenced by the mail server (MX) records on the Domain indicating the confusingly similar Domain was registered to receive e-mail through the Domain that would likely be intended for the Complainant. It is also further evidenced by the complaints received of e-mails sent from the Domain masquerading as Swinerton and spoofing Swinerton employees.

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

The disputed domain name registered in 2021 is confusingly similar to the Complainant's SWINERTON mark (registered in the USA with first use recorded as 1923) adding only a hyphen, the geographically descriptive designation 'us' and the gTLD .com none of which prevent said confusing similarity.

The Respondent is not commonly known by the disputed domain name and is not authorised by the Complainant. The disputed domain name has been used to send fraudulent e-mails pretending to be an employee of the Complainant and using the Complainant's official logo. This is deceptive and confusing and cannot be conduct evidencing rights or a legitimate interest in the disputed domain name. It is registration and use in bad faith designed to disrupt the Complainant's business. Fraud is bad faith registration and use per se. The use of the Complainant's official logo in the fraudulent e-mails sent from the disputed domain name shows that the Respondent had actual knowledge of the Complainant, its rights, business and services.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SWINERTON-US.COM**: Transferred
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PANELLISTS

Name	Dawn Osborne
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DATE OF PANEL DECISION	2021-09-06
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Publish the Decision
