

Decision for dispute CAC-UDRP-103955

Case number **CAC-UDRP-103955**

Time of filing **2021-08-02 09:41:20**

Domain names **swinetrn.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

Name **Rhendi Ledford**

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 is owner of the following registered trademarks:

- U.S. Reg. No. 2,284,825, issued on 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 on October 5, 1999, in Int'l Cl. 37, first use 1923, for SWINERTON (Standard Characters); and
- U.S. Reg. No. 5,756,816, issued on May 21, 2019, Int'l Cl. 35,37, first use in 2018 for SWINERTON (& Design).

The Complainant has also 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.

The Complainant's rights are hereinafter referred to as the Swinerton Trademark.

FACTUAL BACKGROUND

FAC TUAL BACKGROUND

Recognized nationally in the U.S. since its founding in 1888, through its predecessors-in-interest and subsidiaries, the Complainant 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 with privacy or proxy service on July 14, 2021. Upon the CAC's registrar verification request, the Registrar disclosed the underlying registration data, identifying Rhendi Ledford (US) as registrant.

The disputed domain name does not resolve to any active website. However, the domain name has mail server (MX) records configured.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

Complainant:

The Complainant contends that the disputed domain name is confusingly similar to the Swinerton Trademark because it includes a typographical (transposition) error of such mark. Letters adjacent on the keyboard are frequently transposed, which constitutes a form of typosquatting, and does not negate the confusing similarity of the disputed domain name to the Complainant's mark.

The Complainant also contends that the Respondent has no rights or legitimate interests to the disputed domain name. The preparatory steps, i.e., configuring 'MX' or mail exchange records on the disputed domain name confusingly similar to the Swinerton Trademark, are not to be considered 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, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

The Complainant finally contends that the Respondent's bad faith is demonstrated by:

- the registration of the disputed domain name confusingly similar to the well-known Swinerton Trademark through privacy or proxy service and using false registration information;
- the configuration of mail server (MX) records.

The Respondent likely registered and is using the disputed domain name 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 e-mails likely intended for the Complainant.

The Complainant, therefore, requests the transfer of the disputed domain name.

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

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

I. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the Swinerton Trademark since 1923. The disputed domain name, registered on July, 14, 2021, consist of the misspelled version of the Swinerton Trademark, i.e. the transposition of the letters "R" and "T".

A domain name which contains sufficiently recognizable aspects of the relevant mark and uses a common, obvious, or intentional misspelling of such trademark is considered by UDRP panels confusingly similar to the relevant mark for purposes of the first element (see 1.9 WIPO Overview 3.0). Examples of such typos include: (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters), (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersions of other terms or numbers. The practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors is commonly called typosquatting.

UDRP panels also agree that the TLD is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see 1.11.1 WIPO Overview 3.0).

Therefore, in assessing confusing similarity, this Panel finds that the disputed domain name contains sufficiently recognizable aspects of the Swinerton Trademark and that the transposition of two letters ("R" and "T") neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark.

Hence, the Panel is satisfied that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the complainant shall establish a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the respondent (see 2.1 WIPO Overview 3.0: "[...] 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to

have satisfied the second element.")

The disputed domain name was registered with privacy or proxy service on July, 14, 2021. Upon CAC's registrar verification request, the Registrar disclosed the underlying registration data, identifying Rhendi Ledford (US) as registrant.

The Complainant has no relationship with the Respondent whatsoever. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register the disputed domain name.

There is no evidence that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name, which is a typosquatted version of the Complainant's mark, does not resolve to any active website. However, the domain name has mail server (MX) records configured. Thus, the Respondent highly likely uses the disputed domain name in association with fraudulent e-mail activities impersonating the Complainant and, thus, part of a phishing scheme. 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, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests to the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent has registered the disputed domain name which is confusingly similar to Complainant's prior well-known trademark, since it contains sufficiently recognizable aspects of the such mark and uses common, obvious, or intentional typos of such trademark.

Given the good-will and reputation of the Complainant and the Swinerton Trademark, acquired over the years in the construction industry and confirmed by other UDRP decisions (inter alia, CAC Case No. 102751), it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website. Even assuming that the Respondent had no knowledge of the Complainant's prior mark at the time of registration of the disputed domain name (which is quite unlikely), it omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, it verified it and deliberately proceeded with the infringing registration and use. The Complainant has indeed submitted the result of a Google search regarding the term "SWINETRON" and has shown that Google responds "Did you mean SWINERTON?". This re-enforces that the Respondent was well-aware of the well-known Swinerton Trademark when it was registered, and did so for the Respondent's own commercial gain to profit from the confusion that inevitably results when users believe that the mail server on the disputed domain name belongs to the Complainant, when that is not the case.

Although the disputed domain name does not resolve to any active website, the Complainant has shown that the Respondent had configured mail server (MX) records for the disputed domain name. By connecting the mail server to the disputed domain name and creating the false impression that it is the Complainant's server, it is implausible that there is any good faith use to which the disputed domain name is being used. Configuring e-mail on the disputed domain name that confuses people into thinking it belongs to the Complainant is likely part of a fraudulent scheme (phishing), such as to obtain sensitive or confidential personal information, or to solicit payment of fraudulent invoices. The disputed domain name is under Respondent's control, and the MX records were specifically configured through Outlook. Respondent is responsible for these Mail records.

Per paragraph 4(b)(iv) of the Policy, the Respondent likely registered and is using the disputed domain name 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 e-mails likely intended for the Complainant. This is evidenced by the configuration of MX records indicating the confusingly similar disputed domain name was registered to receive e-mails that would likely be intended for the Complainant (see CAC Cases No. 102751 and 102380).

The Respondent has also used a privacy or proxy service when registering the disputed domain name. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel's assessment of bad faith (see 3.6 WIPO Overview 3.0). The Complainant has shown that the Respondent, further to concealing its identity by privacy or proxy registration, it used false contact details. For instance, the phone number used is no longer in service and the address appears to be commercial rather than residential.

The Respondent has failed to submit a Response in the present administrative proceeding or to provide any evidence of actual or contemplated good faith use.

Considered all the afore-mentioned circumstances, the Panel determines that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

The disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SWINETRON.COM**: Transferred

PANELLISTS

Name	Avv. Ivett Paulovics
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DATE OF PANEL DECISION	2021-09-09
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Publish the Decision