Decision for dispute CAC-UDRP-103134

Case number	CAC-UDRP-103134
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Domain names	Penltair.com, Peentair.com, Pertair.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Pentair Flow Services AG

Complainant representative

Organization	HSS IPM GmbH

Respondent

Name	pm pm

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the well-known, distinctive trademark PENTAIR as a word and figure mark in several classes in numerous of countries all over the world including in the USA, the state of the respondent. Selected PENTAIR trademark registrations are: SWISS TM: PENTAIR (& LOGO) Reg. no. 675144 Date of Application: 26.10.2012 Date of Registration: 02.07.2015 Owner: Pentair Flow Services AG; CTM: PENTAIR (& LOGO) Reg. no. 010829117 Date of Application: 23.04.2012 Date of Registration: 12.12.2012 Owner: Pentair Flow Services AG; US: PENTAIR (& LOGO) Reg. no. 50003584 Date of Application: 01.07.2012 Date of Registration: 19.07.2016 Owner: Pentair Flow Services AG. These trademark registrations predate the registration of the Disputed Domain Names. The PENTAIR trademarks are valid and registered. Further is the Complainant owner of PENTAIR Domains, e.g. Pentair.com.

FACTUAL BACKGROUND

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

ABOUT COMPLAINANT AND THE BRAND PENTAIR
The Pentair Group (“Pentair Group”) is a water treatment organization with its parent company Pentair plc incorporated in Ireland, and its main U.S. office located in Minneapolis, Minnesota. Pentair plc was founded in the US in 1966, with 65% of

company's revenue coming from the US and Canada as of 2017.

Pentair Flow Services AG (hereinafter, the “Complainant”) represented by HSS IPM GmbH is a subsidiary of Pentair Plc.

The Pentair Group is composed of a number of subsidiaries worldwide, including Pentair Plc, Pentair Filtration, Inc, Pentair Inc, and the Complainant, among other companies. For more information about Pentair Group, see: https://www.pentair.com/.

From approximately 110 locations in 30 countries, the Pentair Group’s 10,000 employees are united in the unwavering belief that the future of water depends on Pentair’s Group. Pentair Group’s 2018 revenue was in excess of USD $3.0 billion. For more information about Complainant and its corporate relationship with respect to Pentair Plc.

Pentair Flow Services AG is the owner of the well-known registered trademark PENTAIR in numerous countries all over the world. Selected trademark registrations PENTAIR:

The above trademark registrations predate the registration of the disputed domain names Penltair.com_Peentair.com_Pertair.com (hereinafter, “the Disputed Domain Names”) registered on the 21.08.2020. Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainants enjoys a high degree of renown worldwide; including the United States of America where Respondent is located.

Pentair Inc, an affiliated company of Complainant, owns also the registration of the domain names pentair.com (registered on 17.10.1996), pentair.net (registered on 05.12.2003), pentair.org (registered on 03.11.2010).
Pentair has been successful in previous UDRP cases before this Arbitration Center, such as Case Numbers 102845, 102894 & 102917.

Complainant uses the domain names to connect to websites through which it informs potential customers about the PENTAIR mark, related brands, and its products and services.

LEGAL GROUNDS, contested by the Compainant:

i) CONSOLIDATION
Complainant assumes that the Disputed Domain Names were registered by the same Respondent since both were registered on the same day; i.e. August 21, 2020 and before the same Registrar; i.e. Public Domain Registry.
Therefore, Complainant respectfully asks the Panel to consolidate the three Disputed Domain Names in only one Complaint.

ii) THE DISPUTED DOMAIN NAMES ARE CONSUFINGLY SIMILAR WITH COMPLAINANT’S PENTAIR TRADEMARKS

The Disputed Domain Names directly and entirely incorporates Complainants’ registered trademark PENTAIR with the following additions or changes: i) One additional “L” in the Disputed Domain Name Penltair.com; ii) One “E” in the Disputed Domain Name Peentair.com and iii) One “R” in the Disputed Domain Name Pertair.com. If not studied carefully, the Disputed Domain Names appear to be the Complainant’s mark. Minor misspellings (“typosquatting”) are not material to a finding of confusing similarity in this respect (see sections 1.8 and 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

The addition of the generic Top-Level Domains (gTLD) “.com” does not add any distinctiveness to the Disputed Domain Names. The use of the Complainant’s mark gives the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business using Complainants’ trademarks. As an example paragraph 1.11 of the WIPO Overview 3.0 as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following “In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”.

The following should apply in the current case and the Disputed Domain Names should be considered as confusingly similar to the trademark PENTAIR.

iii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAMES
Complainant has not found that Respondent is commonly known by the Disputed Domain Name or that it has interest over the Disputed Domain Names or the major part of it. The WHOIS information provided in the Registrar's confirmation dated 17.02.2020 is the only document which relates Respondent to theDisputed Domain Names . When entering the terms "PENTAIR" in the Google search engine, the returned results point to Pentair's Group and its business activity.

The Respondent could easily perform a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by Complainants and that the Complainants have been using its trademarks.

Respondent has not by virtue of the content of the website, nor by its use of the Disputed Domain Name shown that they will be used in connection with a bona fide offering of goods or services.

There is no evidence that Respondent has a history of using, or preparing to use, the Disputed Domain Names in connection with a bona fide offering of goods and services. It is clear that Complainants have become a distinctive identifier associated with the term "PENTAIR" and that the intention of the Disputed Domain Names is to take advantage of an association with the business of Complainants' Group.

a) THE WEBSITE

At the time of the filing of this Complaint, the Disputed Domain Names do not resolve to active websites with a print screen of the Disputed Domain Names from September 24, 2020. There is no evidence that Respondent is known by the Disputed Domain Names, nor has the Respondent made any known legitimate, non-commercial use of the Disputed Domain Names. Moreover, as mentioned previously, Complainant has never authorized the Respondent to use its trademarks in any form.

As indicated at the WIPO case No. D2016-0253 Aldi GmbH & Co. KG Aldi Store Limited v. Greg Saunderson, the use of a domain name parking service is "per se" not illegitimate, however, when such service is linked with the trademark owner's name in mind the situation changes. Here the relevant Panel finding:

"While there is nothing per se illegitimate in using a domain name parking service, linking a domain name to such a service with a trademark owner's name in mind in the hope and expectation that Internet users searching for information about the business activities of the trademark owner will be directed to the parking page is a different matter. Such activity does not provide a legitimate interest in that domain name under the Policy."

Therefore, the non - use of the Disputed Domain Names cannot be considered as legitimate use.

FRAUDULENT ACTIVITY

It is important to mention that the domain name www.penltair.com has been used with the purpose to fraudulently acquire financial information from the Complainant. In his regard, on August 24, 2020 the Respondent, impersonating Complainant's Credit Manager of Pentair, sent an email to Complainant's Provider in Brazil Mr. Gustavo Binotti asking for assistance with an urgent international wire transfer due to an overdue. Respondent sent further emails on August 25, 2020 & August 26, 2020. Interestingly, Respondent also CC in the fraudulent emails the following email addresses: christy.ross@pertair.com, sam.andersen@pertair.com, angela.craig@peentair.com & rowena.powell@penltair.com; which are related to the other Disputed Domain Names.

As a consequence, on September 24th 2020 Complainant's representatives filed a takedown request before Respondent's Registrar Public Domain Registry asking them to immediately disable the MX records and suspend the DNS and Registrar confirmed said requested and proceed accordingly.

This behaviour is a clear confirmation that Respondent does not have rights or legitimate interest to use the Disputed Domain Names.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

THE DISPUTED DOMAIN NAMES WERE REGISTERED IN BAD FAITH

Complainant's PENTAIR trademarks predate the registration of the Disputed Domain Names and Respondent has never been authorized by Complainants to register the Disputed Domain Names. It is inconceivable that the unique combinations of the mark "PENTAIR" along with: i) One additional "L" in the Disputed Domain Name Penltair.com; ii) One "E" in the Disputed Domain Name Peentair.com and iii) One "R" in the Disputed Domain Name Pertair.com; in the Disputed Domain Names are not a deliberate and calculated attempt to improperly benefit from the Complainants' rights.

THE DISPUTED DOMAIN NAMES ARE BEING USED IN BAD FAITH

Given the international reputation and the distinctive nature of PENTAIR® trademarks, it is in all likelihood that Respondent should have been aware of the Complainant's well-known trademarks at the time it registered the Disputed Domain Names; see for instance the following UDRP Cases: Vertu Corporation Limited v. David Szn and Jun Luo, WIPO Case No. D2015-0185; Revlon Consumer Product Corp. v. Easy Weight Loss Info, WIPO Case No. D2010-0936; Hermes International SCA v. Cui ZhenHua,WIPO Case No. D2010-1743.

In addition, the disputed domain name www.penltair.com was used for an attempted fraud against the Complainant. According to several UDRP decisions, this is further evidence of bad faith, please see for instance the following UDRP cases: Haas Food Equipment GmbH v. Usman ABD, Usmandel, WIPO Case No. D2015-0285; Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrenge, WIPO Case No. D2009-1017.
As indicated, the other Disputed Domain Names have been also used as part of this fraudulent phishing scheme by being CC in the main phishing email with the only reason to confuse the receptor.

a) THE WEBSITE

As noted previously, the Disputed Domain Names currently do not resolve to an active website. Some Panels have found that the concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" by a third party of a domain name. See as an example WIPO Overview 3.0. question 3.3. indicating the following:
"…
From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the Complainant's mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the Respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows the Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly references Complainants' trademark may constitute registration and use in bad faith. In the current case it is clear that Respondent has registered the Disputed Domain Name in bad faith by intentionally adopting Complainants' widely known marks in violation of Complainants' rights.

Further, the inaction in relation to a domain name registration can also constitute a domain name being used in bad faith and any attempt to actively use the Domain Name would lead to confusion as to the source, sponsorship of the Respondent´s web site among the internet users who might believe that the web site is owned or in somehow associated with

Complainants.

Finally, Complainants' trademark registrations predate Respondent's Disputed Domain Names registration. These cumulative factors clearly demonstrate that Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith as stated at the WIPO case No. D2016-0456 Amis Paris v. Amiparis, Amipa, where the Panel found out the following:

"Based on the evidence presented to the Panel, including the late registration of the disputed domain name which includes to the Complainant's marks, the confusing similarity between the Complainant's trademark and the disputed domain name, the Respondent's failure to reply to the cease-and-desist letter, the failure of the Respondent to respond to the Complaint and the Respondent's passive holding of the disputed domain name, the Panel draws the inference that on balance the disputed domain name has been registered and is being used in bad faith."

It is an established principle that the lack of active use of a domain name does not as such prevent a finding of bad faith as indicated in the following WIPO Cases: Vertu Corporation Limited v. David Szn and Jun Luo, WIPO Case No. D2015-0185; Accor, So Luxury HMC v. Youness Itsmail, WIPO Case No. D2015-0287; McGrigors LLP v. Fraser Coutts, WIPO Case No. DCO2011-0022).

PATTERN OF CONDUCT

A pattern of conduct can involve multiple UDRP cases with similar fact situations or a single case where the respondent has registered multiple domain names, which are similar to trademarks. Here, it has to be highlighted that the Respondent, has registered using the email address pmkemi@yandex.com several typo variant domain names related to different companies such as the domain names tetarlon-br.com, tetralon-br.com & tetralons-br.com which try to impersonate Complainant's Brazil Provider TETRALON.

Such pattern of abusive conduct constitutes evidence of bad faith according to Paragraph (6) (ii) of the Policy and this behavior was declared as bad faith registration according to WIPO case No. D2015-1932 Bayer AG of Leverkusen v. huang cheng of Shanghai where the Panel stated that "The Respondent is engaged in registering disputed domain names containing famous marks… This is evidence of a pattern in the misappropriation of well-known marks which cannot be regarded as registration and use in good faith.".

From the Complainant's point of view, the Respondent intentionally chose the Disputed Domain Names based on a registered and well-known trademark in order to only use it for non-legitimate purposes. The conduct of the Respondent in registering domains incorporating other well-known trademarks demonstrates systematic bad faith behavior.

SUMMARY

To summarize, the trademark PENTAIR was established more than 50 years ago and is a well-known mark in water treatment worldwide with 110 locations in 30 countries. Respondent bears no relationship to the trademarks and the Disputed Domain Names has no other meaning except for referring to Complainants' name and trademarks. There is no way in which the Disputed Domain Names could be used legitimately by the Respondent; in particular taking into consideration the fraudulent activity by Respondent against Complainant. Further, the Disputed Domain Names are being hosted on passive holding, an additional element of bad faith in accordance with the applicable cases described at this Complaint. Consequently, the Respondent should be considered to have registered and to be using the Disputed Domain Names in bad faith.

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 have been registered and are 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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

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

The Panel finds that the Disputed Domain Names Penltair.com, Peentair.com, Pertair.com are confusingly similar to the trademarks of the Complainant.

The Disputed Domain Names directly and entirely incorporates Complainants' registered trademark PENTAIR with the following additions or changes: i) One additional "L" in the Disputed Domain Name Penltair.com; ii) One "E" in the Disputed Domain Name Peentair.com and iii) One "R" in the Disputed Domain Name Pertair.com. If not studied carefully, the Disputed Domain Names appear to be the Complainant's mark.
This is a clear case of "typosquatting", i.e. the disputed domain names contain an obvious misspelling of the Complainant's trademark. Previous panels have found that the slight spelling variations do not prevent a disputed domain name from being confusing similar to the Complainant's trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant has not granted the Respondent any right to use the PENTAIR trademark within the Disputed Domain Names, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Disputed Domain Names. The Complainant contends that the Respondent was seeking to use the disputed domain names only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the three Disputed Domain Names.
In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Complainant also asserted and proved that the Respondent tried to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademarks. The Complainant rightfully contended that the four Disputed Domain Names are confusingly similar to the prior trademark PENTAIR of the Complainant. The Complainant also

referred to the distinctiveness and reputation of its PENTAIR trademarks.

This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the Disputed Domain Names. The Complainant rightfully contended that the Respondent has used the three Disputed Domain Names intentionally to attract visitors for commercial gain by creating confusion with the Complainant's trademarks, and that the Respondent has used the Disputed Domain Names with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: "The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant".

Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

Furthermore, the Respondent is using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the Disputed Domain Names Penltair.com, Peentair.com, Pertair.com were both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PENLTAIR.COM**: Transferred
2. **PEENTAIR.COM**: Transferred
3. **PERTAIR.COM**: Transferred

PANELLISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2020-11-10

Publish the Decision