Decision for dispute CAC-UDRP-103385

Case number	CAC-UDRP-103385
Time of filing	2020-11-18 10:01:58
Domain names	pentairpartners.co

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Pentair Flow Services AG

Complainant representative

Organization	HSS IPM GmbH

Respondent

Name	Yabani Eze

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 the owner of the trademark registrations PENTAIR:

SWISS TM: PENTAIR (& LOGO)
Reg. no. 675144
Date of Application: 26.10.2012
Date of Registration: 02.07.2015

CTM: PENTAIR (& LOGO)
Reg. no. 010829117
Date of Application: 23.04.2012
Date of Registration: 12.12.2012

US: PENTAIR (& LOGO)
Reg. no. 50003584

Date of Application: 01.07.2012
Date of Registration: 19.07.2016

Pentair Inc, an affiliated company of Complainant, owns the trademark

MORROCAN TM: PENTAIR
Reg. no. 147673
Date of Application: 22.10.2012
Date of Registration: 24.10.2022

and 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) & <pentairpartners.co> (registered on 18.01.2021).

The 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.

FACTUAL BACKGROUND

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

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. The Complainant 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.

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.

Pentair Flow Services AG is the owner of the registered trademark PENTAIR in numerous countries all over the world.

Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainants states that it enjoys a high degree of renown worldwide; including in the African Continent where Respondent is located.

Pentair Inc, an affiliated company of Complainant, owns also the registration of the domain names <pentair.com>, <pentair.net>, <pentair.org> and others.

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.

The disputed domain name directly and entirely incorporates Complainants’ registered trademark’s PENTAIR plus the inclusion of the word PARTNERS. The addition of the country code Top-Level Domain (gTLD’s) “.co” does not in the view of the Complainant add any distinctiveness to the disputed domain name. These references exaggerate in the view of Complainant the impression that the Respondent is somehow affiliated with the Complainant, and Respondent is somehow doing business using Complainant´s trademarks.

The Complainant states, that the WHOIS information “Yabani Eze” within the WHOIS record is the only evidence, which relates the Respondent to the disputed domain name. When entering the terms “PENTAIR” and “Africa” in the Google search engine, the returned results point to Pentair’s Group and its business activity

The Respondent could easily perform in the view of Complainant a similar search before registering the disputed domain

name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks.

The Respondent has not by virtue of the content of the website, nor by its use of the disputed domain name shown that it 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 name in connection with a bona fide offering of goods and services. It is clear for the Complainant that Complainant has become a distinctive identifier associated with the term “PENTAIR” and that the intention of the disputed domain name is to take advantage of an association with the business of Complainants’ Group.

This disputed domain name currently host a pay per click website with Third Party Links such as “Sauna Bausatz Outdoor”, etc.

The Complainant has not authorized, licensed or permitted the Respondent to use the trademark PENTAIR and there is no evidence that the Respondent has been or is commonly known by the disputed domain name.

Furthermore, the Respondent is in the view of the Complainant not using the disputed domain name in connection with a bona fide offering of goods or services and it is not making a legitimate non-commercial or fair use of the trademark.

The use of the trademark “PENTAIR & “PARTNERS” was in the view of the Complainant calculated by the Respondent to take advantage of Complainant’s reputation, its employees plus countless prospective employees and other interested stakeholders, who would be likely to undertake internet searches based on variants of the term “PENTAIR”.

Complainant’s trademarks predate the registration of the disputed domain name, moreover, the active business presence of the Complainant in different Markets, including the African Continent and on a significant scale around the world, makes it apparent thar that the Respondent was aware that the registration of the disputed domain name was unauthorized and improper. As mentioned before, the Complainant is the owner of the domain name <pentairpartners.com> and this is an additional indication of bad faith on the Respondent’s side, in particular with the potential confusion that internet consumers might face.

Further, the disputed domain name currently has active MX records, meaning that emails can be sent from an address which would be likely to make a recipient believe that it is a legitimate communication from the Complainant. This is highly concerning to the Complainant, as there can be no ‘good’ reason for a party to be able to impersonate the Complainant in regards to the relevant topic of “Pentair Partners”.

Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an email address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under paragraph 4(a)(iii) of the Policy.

It is important to mention that before filing the Complaint, the disputed domain name was hidden through an identity protection service provider.

The Complainant contacted the Respondent on November 4th, 2020 through a cease and desist letter (“C&D letter”). The C&D letter was sent to the only email address listed in the whois record associated with the disputed domain name; i.e.. abuse@godaddy.com as well as to the email service@afternic.com due to the fact that the disputed domain name is also for sale for the price of 925USD at Afternic – a Go Daddy’s company. The Respondent has simply disregarded such communications. It has been mentioned in earlier cases that the failure of a respondent to respond to a cease and desist letter, or a similar attempt at contact, has been considered relevant in a finding of bad faith.

Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process.

According to the WIPO Overview 3.0, “the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users”.

The disputed domain name includes links which capitalize on products related to third parties such as a link purporting to go to ”Sauna Bausatz Outdoor” which takes to different links such as “Hochwertige Outdoor Aussensauna – Beste Qualität & faire Preise www.butenas.de”. It is important to note that the Complainant sells “Pool & Spa Solutions” and, therefore, the use of third party’s links from competitors are an additional element of bad faith; in this case the use of Sauna competitors.

As in these cases, the Respondent has the final say over what content appears at the <claro.video> website and cannot avoid responsibility therefor simply because it voluntarily allowed a third-party to select pay-per-click links on its behalf.

Last but not least, the disputed domain name is listed for sale at Afternic for a price of 925 USD. This conduct has been considered in previous cases as an additional evidence of an abusive registration due to the Respondent´s intention to unduly profit from the Complainant´s rights.

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, Yabani Eze, has been involved in at least in 6 UDRP Disputes involving well-known domain names. In addition, Respondent using the email address sugarcane@mm.st has registered more than 5967 domain names including well-known brands such as <applebee.cm>, <appledepot.com>, <applemarket.com>.

Such pattern of abusive conduct constitutes evidence of bad faith according to paragraph (6) (ii) of the Policy.
From the Complainant’s point of view, the Respondent intentionally chose the disputed domain name based on a registered and well-known trademark in order to only use it for non-legitimate purposes. In the view of the Complainant the conduct of the Respondent in registering domains incorporating other well-known trademarks demonstrates systematic bad faith behavior.

The Complainant summarizes its arguments as follows: The trademarks PENTAIR is a known mark in water treatment worldwide. The Respondent bears no relationship to the trademarks and the disputed domain name has no other meaning except for referring to Complainant's business name and trademarks. There is no way in which the disputed domain name could be used legitimately by the Respondent. Additionally, the disputed domain name hosts a pay per click website with Third Party Links such as “Sauna Bausatz Outdoor”, etc. Further; the disputed domain name has active MX records, which makes it highly suspect for involvement in potential phishing attacks. The Complainant submits there is the potential for the disputed domain name to do harm through a phishing scam or other fraudulent misconduct. The current use of the disputed domain name cannot be considered as legitimate use. Inference of bad faith registration and use of the disputed domain name is also given by the fact that the Respondent did not reply to C&D letter and the fact that the disputed domain names is for sale. Last but not least, the Respondent has been involved in different UDRP proceedings as Respondent.
Consequently, the Respondent should be considered to have registered and to be using the disputed domain name 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 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

A. Identical or Confusingly Similar

The Complainant has rights in the mark by virtue of its registered trademark Pentair.
The disputed domain name incorporates the whole of the Complainant’s Pentair trademark, and adds the generic word “partners" as a suffix and the gTLD suffix “.co". Whilst the addition of the term “Pentair” is enough to preclude the disputed domain name from being identical to the Complainant’s registered trademark, it does not help to escape the conclusion that the disputed domain name is confusingly similar to the "Pentair" mark, and the Panel accepts the Complainant’s submissions in so finding.

The Panel agrees with the Complainant that the addition of the generic term "partner" without a hyphen name and the gTLD “.co” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark and does not change the overall impression of the designation as being connected to the trademark "Pentair", as the Pentair trademark at the beginning of the disputed domain name is the distinctive part of the disputed domain name.

B. Rights or Legitimate Interests
When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the disputed domain name and the Panel so finds.

C. Bad Faith

The Panel believes that the Respondent registered the disputed domain name with knowledge of Complainant's rights. The disputed domain name was registered years after the registration of several trademarks of the Complainant and the Complainant used it widely since then. Furthermore, the combination in the disputed domain name of the Pentair mark with the Complainant´s business related not distinctive term "partners" shows that Respondent could not be ignorant to the Complainant´s trademark.

Additionally, the disputed domain name hosts a pay per click website with third party links such as “Sauna Bausatz Outdoor”, etc. Furthermore, the Respondent did not reply to C&D letter and the disputed domain names is for sale.

On these grounds, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PENTAIRPARTNERS.CO**: Transferred

PANELLISTS

Name	Jan Christian Schnedler, LL.M.

DATE OF PANEL DECISION 2020-12-16

Publish the Decision