Decision for dispute CAC-UDRP-103698

Case number	**CAC-UDRP-103698**
Time of filing	**2021-04-06 10:45:20**
Domain names	**PentairPoolPumps.shop, PentairPoolProducts.shop**

Case administrator

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

Complainant

Organization	**Pentair Flow Service AG**

Complainant representative

Organization	**HSS IPM GmbH**

Respondent

Name	**Li Si Heng**

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark registrations of PENTAIR and PENTAIR-formative marks (collectively, the “PENTAIR marks”) including in China, Switzerland and U.S.:

- Registration No. 3504316 registered on December 21, 2005 in China;

- Registration No. 3504312 registered on December 28, 2004 in China;

- Registration No. 3504313 registered on May 14, 2011 in China;

- Registration No. 3941324 registered on September 14, 2006 in China;

- Registration No. 10871905 registered on November 14, 2015 in China;

- Registration No. 11517820 registered on August 28, 2015 in China;

- Registration No. 10871907 registered on August 28, 2015 in China;

- Registration No. 11519174 registered on August 21, 2014 in China;

- Registration No. 675144 registered on July 2, 2015 in Switzerland; and

- Registration No. 5003584 registered on July 19, 2016 in U.S.

The Complainant also holds the domain name registrations which contain the PENTAIR marks, <www.pentair.com> and <https://www.pentair.com>.

FACTUAL BACKGROUND

The Complainant, Pentair Flow Services AG, is part of the Pentair Group which comprises of many subsidiaries worldwide, including the Complainant, Pentair Plc, Pentair Filtration, Inc, Pentair Inc and so forth. Pentair Group is a water treatment organization with its parent company, Pentair Plc, incorporation in Ireland and its main U.S. office in Minneapolis, Minnesota which was founded in the U.S. in 1966. Currently, then Pentair Group operates from approximately 120 locations in 25 countries with 10,000 employees. Its revenue in 2019 was over USD 3 billion.

The disputed domain names, <PENTAIRPOOLPUMPS.SHOP> and <PENTAIRPOOLPRODUCTS.SHOP>, were registered on January 31, 2021 and December 27, 2020 respectively which resolve to inactive websites.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to the PENTAIR marks on the basis that the disputed domain names wholly incorporate the Complainant’s trademark and the addition of associated words “pool”, “products” and “pool”, “pumps” respectively and generic top-level domain name suffix (“gTLD”) “.shop” are insufficient to avoid the finding that the disputed domain names are confusingly similar to its PENTAIR marks.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain names. The Respondent is not commonly known by the disputed domain names. In addition, the Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the PENTAIR marks.

The Complainant further asserts that the disputed domain names have been registered and are being used in bad faith as the Respondent should have known of the Complainant’s PENTAIR marks at the time of registration of the disputed domain names. The Complainant also asserts that the Respondent is attempting to attract, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites or of a product or service on the Respondent’s websites.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names 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.

Preliminary Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

The language of the Registration Agreement for the disputed domain names <PENTAIRPOOLPUMPS.SHOP> and <PENTAIRPOOLPRODUCTS.SHOP> are Chinese.

The Complainant requested that the language of the proceeding be English for the following reasons:

(i) the disputed domain names are in English;

(ii) the disputed domain names’ websites were in English; and

(iii) the proceeding will be put through unnecessary trouble and delay if Chinese were made the language of the proceeding.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval: “Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (See Groupe Auchan v. xmxzl, WIPO Case No. DCC2006 0004).

Having considered the above factors, the Panel determines that English be the language of the proceeding. The Panel agrees that the Respondent appear to be familiar with the English language, taking into account their selection of the English-language trademark and the domain names in dispute. In the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint and evidence into Chinese.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the PENTAIR marks.

The differences between the disputed domain names and the Complainant's PENTAIR marks are the addition of the addition of associated descriptive words "pool", "products" and "pool", "pumps" respectively and a gTLD ".shop".

It is established that gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see Accor v. Noldc Inc. WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; L'Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877).

The disputed domain names consist of the Complainant's PENTAIR marks and the addition of associated descriptive words "pool", "products" and "pool", "pumps" respectively and a gTLD ".com" which in the Panel's view does not avoid confusing similarity with the Complainant's trademark (see Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd., WIPO Case No. D2015-2333; WIPO Overview 3.0, sections 1.8 and 1.9).

Therefore, the Panel finds that the disputed domain names are confusingly similar to the PENTAIR marks and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondent to use the PENTAIR marks (See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, WIPO Case No. D2015-1149; Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain names.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names which is sufficient to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the disputed domain names resolve to inactive webpages. It is well established 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 (see WIPO Overview 3.0, paragraph 3.3). The test to apply is that of the totality of circumstances. In doing so we must look to: (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 this case, the evidence shows that the Complainant's mark is distinctive and has attained significant reputation. The strong reputation and distinctive character of the Complainant's mark is evidence that the Respondent is unlikely to have registered the disputed domain names without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the disputed domain names may be put to. It is also the Complainant's evidence that the Respondent could not have registered the disputed domain names without prior knowledge of the Complainant's mark as before the disputed domain names' websites were taken down, they used to resolve to active websites displaying the Complainant's PENTAIR marks, reviews about the Complainant's "best pool products" and pumps and several product links to Amazon. Respondent's name has no connection with the Complainant's PENTAIR marks which were registered long before the disputed domain names. This is another indicator of bad faith on the part of the Respondent (see Boursorama SA v. Estrade Nicolas, WIPO Case No. D2017-1463).

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

The Complainant submitted evidence that it had issued cease-and-desist letters to the Registrar prior to the proceedings as the Respondent's contact information were hidden behind a privacy shield. Even though the Complainant never received a response from the Respondent, the Respondent deactivated the websites which contained reviews of the Complainant's products and links to third party websites. It is notable that the Complainant's PENTAIR marks and products were displayed on this website. Based on the particular circumstances of the present case, the Panel draws an adverse inference from the Respondent's failure to submit a response and cease-and-desist letters and that the Respondent was indeed aware of the Complainant prior to the proceedings and specifically targeted the Complainant to disrupt its business and create confusion among unsuspecting Internet users.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain names and the Complainant's mark, the Respondent's hidden identity behind privacy shields, the fact that the disputed domain names are being passively held and the fact that no Response was submitted by the Respondent in response to the Complainant's cease-and-desist letters and the Complaint, and that any good faith use of the disputed domain names is implausible, the Panel draws the inference that the disputed domain names were registered and are being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PENTAIRPOOLPUMPS.SHOP**: Transferred
2. **PENTAIRPOOLPRODUCTS.SHOP**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2021-05-12

Publish the Decision