

Decision for dispute CAC-UDRP-103755

Case number **CAC-UDRP-103755**

Time of filing **2021-04-30 09:38:12**

Domain names **pentairpumps.shop, pentairpoolfilters.shop, pentairfilters.shop, pentairfilters.ltd, pentairpumps.ltd , pentairpoolpumps.ltd**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Pentair Flow Services 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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of, inter alia, the following word and figurative PENTAIR trademarks in the China and Switzerland:

- China Trademark Registration No. 3941316 registered on December 21, 2005;
- China Trademark Registration No. 3504313 registered on May 14, 2011;
- China Trademark Registration No. 3941324 registered on September 14, 2006;
- China Trademark Registration No. 10871905 registered on November 14, 2015;
- China Trademark Registration No. 11517820 registered on August 21, 2015;
- China Trademark Registration No. 10871907 registered on August 28, 2015;
- China Trademark Registration No. 11519174 registered on August 21, 2014;
- Swiss Trademark Registration No. 675144 registered on July 2, 2015;
- CTM Trademark Registration No. 010829117 registered on December 12, 2012; and
- U.S. Trademark Registration No. 85666254 registered on July 19, 2016.

An affiliated company of the Complainant, Pentair Inc., owns domain name registrations which contain the PENTAIR trademark, <pentair.com>, <pentair.net> and <pentair.org>.

FACTUAL BACKGROUND

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

The Complainant, Pentair Flow Services AG, is a subsidiary of Pentair Plc established in the United States in 1966. The parent company is part of the Pentair Group which is a water treatment organization and its business includes pool and spa solutions. The Pentair Group comprises of many subsidiaries worldwide, including Pentair Plc, Pentair Filtration, Inc, Pentair Inc, and the Complainant, among other companies. The Pentair Group has offices in over 120 locations in 125 countries with 10,000 employees and its revenue in 2019 was over USD 3 billion. The Complainant uses the above domain names to inform potential customers about its PENTAIR mark, related brands and its products and services.

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 terms "pool", "filters" and "pumps" are descriptive and do not serve to avoid the finding of confusing similarity. The addition of the generic top-level domain name suffixes ("gTLD") ".Ltd", ".shop" and ".ink" are also insufficient to avoid the finding that the disputed domain names are confusingly similar to its PENTAIR mark.

The Complainant also argues that the Respondents do not have any rights or legitimate interests in the disputed domain names. The Respondents are not commonly known by the disputed domain names. In addition, the Respondents are not affiliated with the Complainant nor did the Complainant licensed or authorized the Respondents to use the PENTAIR mark.

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

RESPONDENT:

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 Respondents 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).

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 <pentairpumps.shop>, <pentairpoolfilters.shop>, <pentairfilters.shop>, <pentairfilters.ltd>, <pentairpumps.ltd>, <pentairpoolpumps.ltd> and <pentair.ink> are in 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 language of the disputed domain name are the same as the Complainant’s mark; and
- (iii) the websites in which the disputed domain names resolve to are all in English.

The Respondents 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 Respondents 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 Respondents, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint and evidence into Chinese.

Preliminary Issue: Consolidation of Proceedings

Paragraph 10(e) of the Rules provides that:

“A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.”

The disputed domain names <pentairpumps.shop>, <pentairpoolfilters.shop>, <pentairfilters.shop>, <pentairfilters.ltd>, <pentairpumps.ltd>, <pentairpoolpumps.ltd> and <pentair.ink> were registered during within 3 weeks, from March 18 to April 8, 2021. All of the disputed domain names contain the Complainant’s trademark in its entirety with six out of seven of the domain names also including a product term of “filters”, “pumps”, “pool filters” or “pool pumps”. Six out of seven of the disputed domain names resolve to similar or the same Shopify style template listing pool filters associated with a non-working Amazon link. Six out of seven of the disputed domain names are also registered with the registrar, DNSPod, Inc. Four of the disputed domain names were registered by “li si heng” and the remaining three were registered by “chicui”. Both registrants are located in “hu bei sheng” in China and use the same contact email format comprising a nine digit number followed by “@qq.com”. Further, all of the disputed domain names share the same naming pattern and resolve to inactive pages.

The Panel is guided by section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition

("the WIPO Overview 3.0") and is of the view that given that the disputed domain names were registered around the same period, by registrants which share similar contact information and naming patterns and that the websites in which the disputed domain names resolve to are largely similar, the disputed domain names are subject to common control and that it would be fair and equitable to consolidate the proceedings for procedural efficiency.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similarity

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 trademark.

The differences between the disputed domain names and the Complainant's PENTAIR trademark are the addition of descriptive terms "pool", "filters" and "pumps" which are associated with the Complainant and gTLDs ".ltd", ".shop" and ".ink".

The addition of a descriptive term would not prevent a finding of confusing similarity under the first element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8). In addition, 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 mark and the addition of the descriptive terms "pool", "filters" and "pumps" and gTLDs ".ltd", ".shop" and ".ink" 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, section 1.9).

Therefore, the Panel finds that the disputed domain names are similar to the PENTAIR mark 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 Respondents lack rights or legitimate interests in respect of the disputed domain names and the Respondents have failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondents to use the PENTAIR mark (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 Respondents are not commonly known by the disputed domain names. The Respondents 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 are sufficient to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondents have 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 six out of seven of the disputed domain names resolve to active webpages in a Shopify style template listing pool filters associated with a non-working Amazon link. The last disputed domain name website resolves to an under-construction page with the text “Awesome Site in The Making”.

In relation to the six websites, the Respondents added at the website footers notices that state clearly wordings such as “ © 2021 PENTAIR PUMPS ALL RIGHTS RESERVED” and “© 2021PENTAIR RIGHTS RESERVED” which suggest an affiliation with the Complainant. The Panel also notes that the evidence provided by the Complainant suggests these websites feature fake listings and/or reviews of potentially counterfeit products. Panels have held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent, particularly in the case of counterfeits as is the case here (see WIPO Overview 3.0, section 2.13.1).

In relation to the last website which is passively held, it is also 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. The distinctive character of the Complainant’s mark is evidence that the Respondents are 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 Respondents could not have registered the disputed domain names without prior knowledge of the Complainant’s mark as the Respondents’ names have no connection with the Complainant’s PENTAIR mark which was registered long ago. This is another indicator of bad faith on the part of the Respondents (see Boursorama SA v. Estrade Nicolas, WIPO Case No. D2017-1463).

The Respondents did not submit a Response in this proceeding which is a further indication of the Respondents’ bad faith, which was considered by the Panel. The Panel also notes that the Respondents also did not respond to the Complainant’s cease and desist letters and take-down requests which were filed prior to the commencement of the proceeding.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain names and the Complainant’s mark, the fact that the disputed domain names were used for counterfeit listings and passive holding and the fact that no Response was submitted by the Respondents, 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. **PENTAIRPUMPS.SHOP**: Transferred
2. **PENTAIR.INK**: Transferred
3. **PENTAIRPOOLFILTERS.SHOP**: Transferred
4. **PENTAIRFILTERS.SHOP**: Transferred
5. **PENTAIRFILTERS.LTD**: Transferred
6. **PENTAIRPUMPS.LTD** : Transferred
7. **PENTAIRPOOLPUMPS.LTD**: Transferred

PANELLISTS

Name	Mr. Jonathan Agmon
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DATE OF PANEL DECISION	2021-06-21
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Publish the Decision
