Decision for dispute CAC-UDRP-102894

Case number	**CAC-UDRP-102894**
Time of filing	**2020-02-13 11:44:59**
Domain names	**pentairr.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Pentair Flow Service AG**

Complainant representative

Organization	**HSS IPM GmbH**

Respondent

Name	**Frank Peters**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

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

FACTUAL BACKGROUND

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

i) 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 (Power of Attorney) 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, please see: 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.

Pentair Flow Services AG is the owner of the well-known registered trademark PENTAIR in numerous countries all over the world. In China, for instance, Pentair Flow Services AG is the owner of the following trademarks: PENTAIR with registration number 3504316 (filing date 28.03.2003 and registration date 28.12.2007), PENTAIR with registration number 3504312 (filing date 28.03.2003 and registration date 28.12.2004).

The links below connect customers to the official local sales and service locator and to the official website of the Pentair's Group:
- Global Website www.pentair.com
- Chinese contact: www.pentair.com

Trademark registrations extracts and a list with some PENTAIR trademark registrations around the world were presented as evidence in the dispute..

The above trademark registrations predate the registration of the Disputed Domain Name. Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainants enjoys a high degree of renown worldwide.

Pentair Inc, an affiliated company of Complainant, owns also the registration of the domain names www.pentair.com (registered on 17.10.1996), www.pentair.net (registered on 25.12.2003), www.pentair.org (registered on 03.11.2010).

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:

i) THE DISPUTED DOMAIN NAME IS CONSUFINGLY SIMILAR WITH COMPLAINANT'S PENTAIR TRADEMARKS

The Disputed Domain Name directly and entirely incorporates Complainants' registered trademark PENTAIR with only the addition of an extra "R". If not studied carefully, the domain name appears to be the Complainant's mark. Minor misspellings ("typosquatting") and the addition of dictionary or descriptive term to a complainant's mark 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 Name. 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. See 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 Name should be considered as confusingly similar to the trademark PENTAIR.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

Complainant has not found that Respondent is commonly known by the Disputed Domain Name or that it has interest over the Domain Name or the major part of it. The WHOIS information within the WHOIS record is the only evidence, which relates Respondent to the Domain Name (see ANNEX 5 who is extract). 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 Name 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 Name 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 Name does not resolve to an active websites, as presented by evidence with a print screen of the Disputed Domain Name from February 12, 2020. There is no evidence that Respondent is known by the Disputed Domain Name, nor has the Respondent made any known legitimate, non-commercial use of the Domain Name. 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 Name cannot be considered as legitimate use.

iii) THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

Complainant's PENTAIR trademarks predate the registration of the Disputed Domain Name and Respondent has never been authorized by Complainants to register the Disputed Domain Name. It is inconceivable that the unique combinations of the mark "PENTAIR" along with merely the addition of an extra "R" in the Disputed Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainants' rights.

Further, it must be noted that the Disputed Domain Name has active MX records, meaning that emails could be sent from addresses which would be likely to make a recipient believe that it was a legitimate communication from 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 a domain called "Pentairr". In the recent WIPO Case No. D2019-2371, Marklinck SA v. Obabko Nikolay Vladimirovich, the panel held,

"The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that there are several active MX records connected to the disputed domain name, which enables the Respondent to send emails using an email address that contains the disputed domain name.

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. See section 3.3 of WIPO Overview 3.0 and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003."

According to section 3.4 of the WIPO Overview 3.0, UDRP panels have held that the use of a domain name other than to host a website may constitute bad faith. Such purposes include sending email, phishing, or identity theft. Many of such cases involve the respondent's use of the disputed domain name to send deceptive emails to obtain sensitive or confidential information from complainant's actual or prospective clients.

THE DISPUTED DOMAIN NAME ARE BEING USED IN BAD FAITH

Complainant initially contacted Respondent on January 24, 2020 via a Cease and Desist letter ("C&D") In the C&D , Complainant advised Respondent that the unauthorized use of its trademark within the Disputed Domain Name violated its trademark rights and Complainant requested a voluntary transfer of the Disputed Domain Name.
A first reminder to the Cease and Desist letter was sent on Friday 31 January, 2020.

A second and final reminder was sent on Tuesday February 4, 2020. No response was received from anyone claiming to be the registrant. 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, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623; Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598; and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460.

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

a) THE WEBSITE

The Disputed Domain Name currently does 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 Name 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).

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 Name has no other meaning except for referring to Complainants' name and trademarks, along with an additional "R" which is difficult to spot. Further; the Disputed Domain Name has active MX records, which makes it highly suspect for involvement in potential phishing attacks. Complainant submits there is the potential for the Disputed Domain Name to do harm through a phishing scam or other fraudulent misconduct. The Disputed Domain Name is not being used for any legitimate purpose, but rather is merely being passively held. Respondent did not respond to multiple attempts to contact it which is an additional element of bad faith in accordance with the applicable cases described in this Complaint. 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

FIRST CONDITION

The test for confusing similarity involves a relatively straightforward comparison (usually a side-by-side comparison).

The Disputed Domain Name directly and entirely incorporates Complainants' registered trademark PENTAIR with only the addition of an extra "R".

This slight difference is not enough to exclude confusing similarity.

This is even more the case for the Domain Name and the Complainant's trademark are phonetically identical.

First condition is satisfied.

SECOND CONDITION

Complainant claims (without being challenged) that :
• Respondent is not commonly known by the Disputed Domain Name or that it has interest over the Domain Name or the major part of it.
• 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.

Both the Complainant and the Respondent originate from North America. Complainants claims that 65% of company's revenue are coming from US and Canada (2017). It is very unlikely that the Respondent was not aware of the existence of the Complainant's trademark when he registered the Domain Name. The Respondent could have easily performed a 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. As a consequence, the legitimacy of the interest (if any) would also be questionable.

The second condition is satisfied.

THIRD CONDITION

The Panel notes that it has been registered recently (January, 21, 2020).

Such a short period of time is not enough to conclude to bad faith registration and use.
However, this case is remarkable in the fact that the whois shows that MX records are active, meaning that emails could be sent from addresses which would be likely to make a recipient believe that it was a legitimate communication from Complainant.

In WIPO Case No. D2019-2371, Marklinck SA v. Obabko Nikolay Vladimirovich, the panel held that “The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that there are several active MX records connected to the disputed domain name, which enables the Respondent to send emails using an email address that contains the disputed domain name.
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. See section 3.3 of WIPO Overview 3.0 and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003." This Panel is of the same opinion.

This MX records specificity, together with the fact that the Domain Name is inactive, the absence of answer from the Respondent in this procedure, the absence of reaction to the cease and desist letters, lead the Panel to conclude that the third condition is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PENTAIRR.COM**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2020-03-10

Publish the Decision