

Decision for dispute CAC-UDRP-105193

CASE NUMBER: CAC-UDRP-105193

DISPUTED DOMAIN NAME: PentairShop.com

COMPLAINANT: Pentair Flow Services AG

COMPLAINANT'S REPRESENTATIVE: HSS IPM GmbH

RESPONDENT: mi mi

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 has adduced evidence of a portfolio of nearly a hundred trademarks that it holds in different parts of the world. The majority protect the company's brand name PENTAIR itself in word or figurative form while the rest combine this brand name with specific product or service descriptors. The portfolio includes in particular:

- China PENTAIR word and figurative trademark No. 11517821, registered on 21 August 2014 in Nice Classification List class 35 (categorized as a "general mark");
- US PENTAIR word trademark No. 85604154, registered on 11 June 2013 in Nice Classification List classes 7, 9, 11 and 20;
- EU PENTAIR word trademark No. 011008414, registered on 23 January 2013 in Nice Classification List classes 6, 7, 9, 11 and 42.

The Complainant has further adduced evidence that it has been the registrant of the domain name <pentair.com> since 1996, among other longstanding registrations of the same brand name.

The Registrar Verification data confirm that the Respondent registered the disputed domain name <pentairshop.com> on 7 April 2022.

FACTUAL BACKGROUND

The Complainant, Pentair, is a multinational group of companies active in the water industry since 1966. It has a presence in twenty-six countries and a turnover in 2022 of over \$4 billion. The brand name PENTAIR was devised by the five founders of the original US Pentair company as a combination of the Greek word for "five" and the word "air", air products being their business focus at the outset. The brand is thus distinctive and the Complainant's brand development in the water industry has been the subject of considerable investment as the group has grown and expanded internationally and into new media including the internet. This expansion has included China, where Pentair has a country office in Shanghai.

The Complainant has shown that the disputed domain name <pentairshop.com> is used by the Respondent to display advertisements on its website that include pornographic images and links to gambling websites. The site's written content is in Chinese.

Preliminary investigations made by the Panel under its general powers pursuant to Paragraph 10 of the Policy in respect of the issue of the language for this proceeding (see Procedural Factors) have shown that the disputed domain name's character string was listed on a Chinese website along with several hundred other candidates for domain names, all in European languages but mostly English. Several are variants upon the descriptors of known commercial entities. Other names include slight typographical errors in generic terms. There

is no common content-related theme to this collection of prospective domain names; it has the appearance of a resource to guide intending registrants towards registering foreign-language domain names to which they have no connection. The website concerned is ranked at medium level for internet traffic, meaning that it is quite popular. According to its own date on the site's page concerned, inclusion of <pentairshop.com> was made some years before the Respondent registered it.

The Panel observes that publishing the details of the Chinese website referred to in the previous paragraph might serve to publicize it and thereby promote domain name abuse; therefore, the Panel has exercised its power under Paragraph 16(b) of the Rules to redact the site's domain name and hyperlink out of the present Decision. These details have been made available to the Case Administrator with the authorization, for good procedural order, to disclose them to the Respondent upon request.

Lastly, the Panel's regular scrutiny of the Case File has revealed that the Respondent's email address does not appear to be a functional one, since the CAC's communication to it was undeliverable. Furthermore, the Panel's further investigations, under its general powers pursuant to Paragraph 10 of the Policy in respect of the issue of the language for this proceeding, have also revealed the postal address details to be inaccurate. The city name given is Fujian; this is a basic error, since Fujian is a province. No postal code is given. For the street address, a city name is recognizable, but inaccurately rendered, and only vague district and area indications are given. In short, no real address was given at registration. As to the Respondent's first and second names given to the registrar -- "mi mi" -- this appears to form an improbable name and is more akin in Chinese usage to a nickname or pseudonym. Its use by the Respondent in this proceeding recalls similar and equally improbable registrants' names having the same form and country of origin that surfaced in proceedings before previous Panels and which involved other well-known brands; like this case, none were contested proceedings.

PARTIES CONTENTIONS

COMPLAINANT:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The disputed domain name entirely incorporates the Complainant's registered trademark PENTAIR along with the generic term "shop", a term that can be considered related to the Complainant's business. The Complainant's PENTAIR mark is the initial, dominant and only distinctive element in the disputed domain name. The generic term "shop" adds no distinguishing character, is irrelevant and does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The disputed domain name is not being used in connection with a bona fide offering of goods or services. At the time of preparing this Complaint, the disputed domain name resolves to an active website displaying Chinese-language gambling links as well as pornographic advertising content.

The Complainant contends that the Respondent is not commonly known by the disputed domain name, has no legitimate interest in registering the disputed domain name, and has no basis upon which the Respondent might be using the disputed domain name fairly. There is furthermore no question that the Respondent is in any way known to the Complainant or that the Complainant has authorized the Respondent to use its protected brand name.

3. The disputed domain name was registered and is being used in bad faith

The Complainant's PENTAIR trademarks long predate registration of the disputed domain name. It is inconceivable that the unique and fanciful combination of the seven-letter-string that makes up the Complainant's mark "PENTAIR" along with the generic term "shop" in the disputed domain name is not a deliberate and calculated attempt improperly to benefit from the Complainant's rights.

Rather, the Respondent is using the disputed domain name intentionally to attempt to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

4. The language of the proceeding

It is established practice to take UDRP Rules 10(b) and (c) into consideration for the purpose of determining the language of the proceeding so as to ensure fairness and justice to both parties.

There is evidence that Respondent is familiar with the English language. The disputed domain name incorporates the terms “Pentair” and “shop” which are words in the English language. The disputed domain name employs the Roman script, which is used in the English language. It is important to note that the domain name was registered using the most common gTLD worldwide, i.e., .com. This is relevant because the most suitable domain name for the Chinese market would be the ccTLD applicable for China, i.e., .cn, where Respondent is located.

The Complainant will be put to unnecessary cost, delay and inconvenience if the language of this proceeding is Chinese.

Therefore, the language of this proceeding should be English.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trademarks 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 that 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

1. Language of this proceeding

The preliminary issue faced by the Panel in this case is that of the language of the proceeding. It is clearly stated in Paragraph 11(a) of the Rules that “the language of the administrative proceeding shall be the language of the Registration Agreement”.

There are in Paragraph 11(a) three qualifications. The first two require that another language applies if agreed between the Parties or if a derogation is included in the registrar’s registration agreement with the registrant. Neither of these applies in this proceeding.

That leaves the last qualification, under which it is for each Panel to decide -- if so requested by a Party or of its own volition -- whether to exercise the authority the Rules grant it to impose another language than that of the registration agreement. In making its decision, the Panel must pay regard to the circumstances of the proceeding.

Beyond Paragraph 11(a), a Panel is naturally subject to its general duties of impartiality and efficiency. But no reference to Paragraph 10 or set of balancing criteria is specifically laid down in Paragraph 11.

There is, moreover, no doctrine of binding precedent under the Policy, as is found in the law of several national jurisdictions across the world. A line of cases may hence be persuasive, but not conclusive; rather, each case's circumstances must be considered afresh. And, in this regard, it will be appropriate to keep in mind the global nature of the World Wide Web enabled by the Domain Name System, with the consequence that diverse conditions including local usage of languages and local culture can be pertinent when considering whether to deviate from the default language that the Rules specify.

The bar to displacing the default language is, against this background, necessarily a high one, so as to protect the local interest in a global resource.

A close examination of previous Panels' Decisions is not necessary in this case because of its actual circumstances stated below. It suffices to note that, in them, the circumstances relied upon have often provided demonstration that the Party concerned (generally the Respondent) has a strong connection with the English language (an example being *Credit Suisse Group v. Credit Suisse Group*, Case No. D2005-0213); others (such as *Paris Saint Germain Football v. Ai Si Ai Si, ma guobao, Yin Lin, Mi Ni Mi Ni*, Case No. D2015-1396) seem in the passages of the Decision concerned to overturn the default rule more easily, but, even there, it is necessary to regard not only single passages in a case but that case as a whole. Taken together, the overwhelming impression given from past Decisions is that the circumstances of the case are indeed regarded in the consciousness that deviation from the default rule must be justified substantively and not by way of formality.

In the present proceeding, the Panel notes the Complainant's contentions concerning cost, delay and inconvenience, but finds that these are insufficient grounds on their own to overturn the primacy of the determination of language made in the registration agreement. To be clear: the Panel would have denied the Complainant's request for a change of language on those grounds alone, and it notes that the Complainant could have done more to substantiate its contentions without undue difficulty – as by means of devoting more scrutiny to as basic an aspect as the Respondent's contact details.

What, nevertheless, does in this case surpass the high standard set by Paragraph 11(a) is the combination of the following circumstances:

- a self-evidently distinctive foreign-language trademark in Latin characters;
- the global presence of the brand name concerned, including in China;
- the appearance of the disputed domain name's character string, some years before its registration, in a long list to be found on a Chinese website that seems to serve as a resource to aid those wishing to engage in domain name abuse by exclusively using foreign-language names and terms in Latin characters or misspellings of them;
- the absence of any response from the Respondent to notification of the present proceeding in both English and Chinese;
- the defective contact details which the Respondent provided at the time of concluding the registration agreement with the registrar, which rob that agreement of authority.

It is thus safe to conclude in such circumstances that there are sufficiently compelling reasons to regard the language of the registration agreement as no longer serving as a protection to an innocent Party based on respecting the local interest in a global resource. It instead risks becoming here a shield for domain name abuse that itself has a strong connection to English in the context of the disputed domain name's registration and use, including the choice to employ the Complainant's protected brand.

The Panel accordingly determines that the language of this proceeding is English.

2. Résumé of contentions

The Panel notes that, in this uncontested case, its résumé of the Parties' contentions includes only the Complainant's essential arguments. A contestation made as to a prima facie standard of proof regarding absence of a Respondent's rights or legitimate interest is, in particular, immaterial to the present proceeding in view of the Complainant having adduced factors easily surpassing such a threshold. That contention can thus safely be omitted from consideration.

3. Fulfilment of procedural requirements

The Panel is satisfied that all procedural requirements under UDRP are met and that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds for the purposes of the UDRP three-part cumulative test that:

(1) the Complainant has established its own rights through the evidence it has adduced (see Identification of Rights) and has shown the disputed domain name to be confusingly similar to its protected PENTAIR trademark. The addition of the generic term “shop” is not irrelevant, as contended; rather, it reinforces the specifically commercial function of using the Complainant’s trademark in the disputed domain name, as does repetition in the disputed domain name of the same TLD technical suffix <.com> that appears in a domain name registered to the Complainant;

(2) in the facts of this case, the Respondent clearly has no right or legitimate interest in the disputed domain name, and that the disputed domain name instead appears to have been picked by the Respondent from a pool of foreign-language names assembled by another entity and displayed on a website that, in effect, appears to promote domain name abuse;

(3) it is probable, on the basis of (1) and (2), that the Respondent must either have realized that registration and use of the disputed domain name have infringed the rights of the owner of the PENTAIR brand or simply not have cared about any third party’s interest that the registration and use affected. The dense number of items advertised on the Respondent’s website suggests a business case involving both page-view and per-click revenue; there can be no doubt that the project being pursued in the disputed domain name’s registration and use is to attract internet users for commercial gain without respect for the Complainant’s rights. The registration details then suggest that acquisition of the disputed domain name has been made using fake details for the purpose of concealing the Respondent’s identity. No honest intent can be associated with this combination of behaviour. There can thus be no other conclusion than one of bad faith registration and use.

The Panel accordingly finds for the Complainant and orders the transfer of the disputed domain name to it.

DATE: 2023-04-25

PANEL: Kevin Madders