Decision for dispute CAC-UDRP-106110

Case number	CAC-UDRP-106110
Time of filing	2023-12-29 09:39:02
Domain names	pentair.store

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Pentair Flow Services AG

Complainant representative

Organization	HSS IPM GmbH

Respondent

Name	Lance Jones

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

Complainant owns the registered trademark PENTAIR in numerous territories, including the US, where the Respondent is located, covering, among other countries, the following:

COUNTRY	TM	REG. NO.	REG. DATE	OWNER
USA	Pentair	2573714	.2002.05.28	Pentair Flow Services AG (last listed owner)
USA	Pentair (& logo)	50003584	2012.07.01	Pentair Flow Services AG
USA	Pentair	4348967	2012.04.20	Previously owned by Pentair Inc and transferred to Pentair Flow Services AG

CANADA	Pentair (& logo)	TMA1025371	2019.06.13	Pentair Flow Services AG
CHINA	Pentair (& logo)	11517821	2014.08.21	Pentair Flow Services AG
CHINA	Pentair (& logo)	3504734	2006.04. 28	Pentair Flow Services AG
EUIPO	Pentair (& logo)	011008414	2013.01.23	Pentair Flow Services AG
SWITZERLAND	Pentair (& logo)	675144	2015.07.02	Pentair Flow Services AG

FACTUAL BACKGROUND

Pentair Flow Services AG (hereinafter, the "Complainant"), represented by HSS IPM GmbH is a business within the Pentair Group of companies ("Pentair Group").

Founded in 1966, the Pentair Group is a leader in the water industry, composed of companies around the world, including Pentair Plc, Pentair Filtration Solutions LLC, Pentair Filtration, Inc, Pentair Inc, and the Complainant, among others. The official website of Pentair's Group is found at www.pentair.com.

PARTIES CONTENTIONS

The Complainant´s contentions are summarised below.

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).

The Complainant contends and supports by evidence the following arguments accepted by this Panel:

The Disputed Domain Name directly and entirely incorporates Complainant's registered trademark PENTAIR. Numerous prior UDRP panels have recognized that the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See WIPO Case No. D2021-1790 Kasznar, Leonardos Advogados and Kasznar Leonardos Barbosa Colonna Rosman Vianna Agentes da Propriedade Industrial Ltda v. Jose Claudio de Amorim where the Panel stated:

''As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.7. The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainants, i.e., the disputed domain name is confusingly similar to the Complainants' trademark.''

The addition of the generic Top-Level Domains (gTLD) ".store" does not add any distinctiveness to the Disputed Domain Name. See as an example paragraph 1.11 of the WIPO Overview 3.0 as well as the Bayerische Motoren Werke AG v. Amrit Singh, Il mio negozio WIPO Case No. D2023-3831 where the Panel stated the following: "The gTLD ".store" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11)".

Complainant's PENTAIR trademark in the Disputed Domian Name exaggerates the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business using Complainant's trademarks. For the reasons highlighted above and because the Disputed Domain Name contains Complainant's distinctive trademark reproduced identically, the Disputed Domain Name should be considered as identical to Complainant's trademark PENTAIR.

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).

The Complainant contends and supports by evidence the following arguments accepted by this Panel:

NO BONA FIDE OFFERING

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 does not resolve to an active website. Thus, the use of the Disputed Domain Name is not in connection with a bona fide offering of goods or services as required by the Policy.

Following Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, the use of a trademark as a domain name by an authorized or non-authorized third party is only to be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy if the following conditions are satisfied:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods or services;
- the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- the respondent must not try to ''corner the market'' in domain names that reflect the trademark.

As for Condition a), Respondent is not offering the goods at issue. This inference arises from the website's absence of content, and any attempt to actively use the Domain Name would lead to confusion as to the source, sponsorship of the Respondent´s website among the internet users who might believe that the web site is owned or in somehow associated with the Complainant. Therefore, the Respondent is not actively offering the actual goods and for these reasons, Condition a) is not satisfied.

Regarding Condition b), based on the address of the Respondent, which was revealed by the Registrar, Complainant conducted a search on Google Maps. This search revealed that Respondent is located at a commercial premises, with signage for "Aquamaid Pool Services". This signage corresponds with Respondent's email address namely lanceaquamd@gmail.com, which is a combination of Respondent's first name "Lance" and "aquamd" which is apparently an abbreviation of "Aquamaid". Thus the evidence points to Respondent providing swimming pool related services and goods in general. There is no indication that Respondent intends to offer goods and services solely related to Complainant's PENTAIR mark, nor is there any indication that they are authorized to do so. Consequently, due to website inactivity and a potential future activation reflecting the physical presence of Respondent, the Respondent isn't exclusively offering the trademarked goods. Therefore, Condition b) is not satisfied.

Regarding Condition c), due to the inactiveness of the Disputed Domain Name, Respondent is not "accurately and prominently" disclosing the Respondent's relationship with the Complainant. Therefore, Condition c) is not satisfied.

As to Condition d), Respondent tries to corner the market in the Disputed Domain Name because it is using the PENTAIR trademark in its entirety along with an important gTLD which is ''.store'' and which is considered a common, related and important term for Complainant and which is relevant to Complainant's business of selling pool and spa equipment, pumps, filters, valves among other types of equipment. Therefore, Condition d) is not satisfied.

The Panel agrees that the Respondent's use of the Disputed Domain Name did not satisfy the Oki Data requirements.

Further, there is no evidence that Respondent has a history of using or is currently preparing to use the Disputed Domain Name in connection with a bona fide offering of goods and services. Complainant has become distinctively associated with the term and registered trademark "PENTAIR" that the intention of the Disputed Domain Name is to take advantage of an association with the business of Complainant's Group.

The Panel therefore finds that the use of the Disputed Domain Name is not in connection with a bona fide offering of goods or services as required by this element of the Policy.

NOT COMMONLY KNOWN BY THE DOMAIN NAME

Based on the registrar verification, received by the registrar on December 29, 2023, Complainant has not found that Respondent is commonly known by the Disputed Domain Name or that it has any interest in the Domain Name or the major part of it. It appears on the registrar verification that the Registrant of the Disputed Domain Name is Lance Jones, who is located in 4615 Martin St. Fort Worth, Texas 76119 United States and which is the only evidence that relates Respondent to the Disputed Domain Name along with the WHOS information. Besides, when entering the term "PENTAIR" and "PENTAIR STORE" in the Google search engine, the returned results point to Complainant and its business activity. The Respondent could easily perform a similar search before registering the

Disputed Domain Name and would have quickly learned that Complainant owns the trademark and that Complainant has been using its trademarks extensively. As mentioned above, Complainant has not authorized Respondent to use any of its trademarks, and Complainant does not have any other relationship or association, or connection with Respondent.

NO LEGITIMATE NON-COMMERCIAL OF FAIR USE WITHOUT INTENT FOR COMMERCIAL GAIN

Complainant has not found any evidence that Respondent has made any known legitimate, non-commercial use of the Disputed Domain Name. The website associated with the Disputed Domain Name is not being used for the purposes of information or criticism or any other use that could potentially be deemed fair use.

With no response submitted by the Respondent in this proceeding there is no indication that Respondent has any rights or legitimate interests in the Disputed Domain Name.

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).

The Complainant contends and support by evidence the following arguments accepted by this Panel:

THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

Complainant's PENTAIR trademarks long predate the registration of the Disputed Domain Name and Respondent has never been authorized by Complainant to register the Disputed Domain Name, nor does Complainant have any relationship with Respondent. The active business presence of the Complainant in different markets and on a significant scale around the world including the US where the Respondent is located, makes it apparent that the Respondent was aware that the registration of the Disputed Domain Name was unauthorized and improper.

The trademark PENTAIR is registered by the Complainant in numerous territories, including the US and has been used by Complainant's group for several decades since the term was coined by the founders of the original business.

The Complainant's PENTAIR mark is distinctive and widely known in its sector which Complainant supported by evidence.

Further, as mentioned above, when entering the term "PENTAIR" and "PENTAIR STORE" in the Google search engine, the returned results point to Complainant's business activity. That points to an inference of knowledge and, therefore, of bad faith targeting.

Moreover, based on Respondent's physical address and email, it can be inferred that Respondent is involved or operates within the swimming pool industry, as indicated by the wording visible on the business's door, which states: "AQUAMAID POOL SERVICES". Furthermore, upon searching for authorized PENTAIR dealers in Texas where Respondent is located, it is evident that Complainant's goods and services are widely promoted, sold and used in the swimming pool industry in that region including the presence of dozens of local PENTAIR dealers. For these reasons, it is reasonable to infer that Respondent knew or should have known of Complainant's mark at the time of registration. This assertion of actual or inferred knowledge of Complainant's marks at the time of registration is clearly supported by the documented use of the Disputed Domain Name, as discussed below.

THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

In an effort to amicably resolve the matter, Complainant attempted to contact the Respondent via the only available contact details pertaining to the Disputed Domain Name on December 21, 2023, 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. However, on December 26, 2023, the only response received was from the Registrar, advising the Complainant to work directly with the content author to address the issue.

As noted previously, the Disputed Domain Name currently does not resolve to an active website. Other 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. 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”.

The Disputed Domain Name fails, at least, in three of the above-mentioned conditions: (i) there is a high-degree of distinctiveness or reputation of the PENTAIR’S mark (ii) based on the WHOIS record, the Respondent has concealed its identity, and (iv) there is no evidence 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 PENTAIR marks in violation of Complainants’ rights.

Thus, it is clear from the evidence that Respondent intentionally chose the Disputed Domain Name based on the Complainant’s trademark PENTAIR in order to try to generate more traffic to its own business.

Even though, the website associated with the Disputed Domain Name is inactive, the Disputed Domain Name conveys the impression of being an official site of the Complainant, in particular, because it contains the Complainant’s PENTAIR word trademark. The foregoing makes it very likely that Internet users will assume that there is an association between the Disputed Domain Name and the Complainant. The addition of the gTLD “store” in the Disputed Domain Name makes it even more likely that the Respondent wishes to give the impression that the website is affiliated with the Complainant. This indicates the Respondent’s intention to attempt to attract Internet users to its website by creating a likelihood of confusion between the Disputed Domain Name and the PENTAIR trademarks. For this reason, Respondent must have had actual knowledge of Complainant’s rights in the PENTAIR mark since the Disputed Domain Name fully incorporates Complainant’s mark.

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 website among the internet users who might believe that the web site is owned or in somehow associated with the Complainant. From the Complainant point of view, Respondent uses the Disputed Domain Name to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Lastly, Complainant’s trademark registrations long predate Respondent’s Disputed Domain Name registration because Complainants’ PENTAIR trademark was file at least as early as 2002, whereas the Disputed Domain Name was registered in 2023. This constitutes bad faith due to the gap of more than 10 years between the registration of the Complainant’s trademarks and the Respondent’s registration of the Disputed Domain Name.

Based on the above, the Panel is convinced that the Disputed Domain Name has been used in bad faith by Respondent.

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.

The Respondent accessed the online platform and reviewed the case file but never tried to contact the CAC in any way neither did he submit any Response.

PRINCIPAL REASONS FOR THE DECISION

The Complainant’s trademark has been used since 1966 and is a well-established mark in water treatment around the world, including the US where Respondent is located. Respondent bears no relationship to the Complainant and its trademarks, and the Disputed Domain Name has no other meaning except for referring to Complainant’s name and trademarks. Respondent does not have rights or legitimate interests in the Disputed Domain Name. Respondent is not commonly known by the Disputed Domain Name, and further has never been authorized by Complainant to register the Disputed Domain Name, nor does Complainant have any relationship with Respondent. The evidence shows that Respondent operates in the swimming pool industry, which strongly indicates they are targeting Complainant and its substantial reputation and presence therein.

The Disputed Domain Name is not being used in connection with a bona fide offer of goods or services and inference of bad faith registration and use is also given by the fact that there is no active content. Finally, Complainant’s distinctive trademark

registrations long predate Respondent's Disputed Domain Name registration. This constitutes bad faith due to the gap of more than ten years between the registration of the Complainant's trademarks and the Respondent's registration of the Disputed Domain Name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **pentair.store**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2024-01-25

Publish the Decision