Decision for dispute CAC-UDRP-106129

Case number	CAC-UDRP-106129
Time of filing	2024-01-30 11:09:45
Domain names	pentairdubai.com

Case administrator

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

Complainant

Organization	Pentair Flow Services AG

Complainant representative

Organization	HSS IPM GmbH

Respondent

Name	Aomori Ayaka

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 PENTAIR and PENTAIR & logo marks registered in numerous territories, including Japan, where the Respondent is located:

- JPO (Japan Patent Office) trademark Reg. No. 6238656 registered on March 24, 2020;

- USPTO trademark Reg. No. 2573714 registered on May 28, 2002; and

- EUIPO trademark Reg. No. 011008414 for PENTAIR (& logo) mark registered on January 23, 2013.

FACTUAL BACKGROUND

The Complainant, Pentair Flow Services AG, 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. From approximately 135 locations in 26 countries, the Pentair Group's more than 11,000 employees are united in the unwavering belief that water's future depends on Pentair's Group. Pentair Group’s 2022 net sales were approximately $4.1 billion. The mark PENTAIR is fanciful and distinctive and was coined by the company founders. In 1966, five men intent on manufacturing high-altitude balloons founded a company in

suburban St. Paul, Minnesota, that they called Pentair, the Greek “penta” for the five founders and “air” for the products they planned to produce. The original business diversified quickly, with ventures in many varied industries, before ultimately becoming the leader in water-related products and services the Pentair Group is today.

The disputed domain name was registered on August 2, 2023.

PARTIES CONTENTIONS

COMPLAINANT:

(i) The Complainant has rights in the PENTAIR mark as identified in section “Identification of rights” above. The disputed domain name is confusingly similar to the Complainant's PENTAIR mark because it incorporates the Complainant’s mark PENTAIR merely adding a geographic term “Dubai” and the “.com” generic top-level domain (“gTLD”).

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent does not have any relationships with the Complainant, nor has the Complainant ever granted the Respondent with any rights to use the PENTAIR trademark in any forms, including the disputed domain name; and there is no evidence that the Respondent has acquired any rights in a trademark or trade name corresponding to the disputed domain name. The Respondent does not use the disputed domain name for any bona fide offering of goods or services or legitimate noncommercial or fair use. The disputed domain name is not directed to an active website. The redirected webpage only displays the following sentence: 403 FORBIDDEN.

(iii) The Respondent has registered and is using the disputed domain name in bad faith: The Respondent has registered and used the disputed domain name with actual knowledge of the Complainant's rights in the PENTAIR mark; the mere registration of the disputed domain name that is confusingly similar to the Complainant’s famous trademark can by itself create a presumption of bad faith; and the disputed domain name does not resolve to any active page, and such a passive holding constitutes bad faith registration and use of the disputed domain name given several factual considerations. The Complainant’s trademark registrations long predate the disputed domain name registration because the Complainants’ PENTAIR trademark was filed at least as early as 2002, whereas the disputed domain name was registered in 2023.

RESPONDENT:

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

Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Japanese, thereby making the language of the proceedings in Japanese. The Complainant has requested that the proceeding should be conducted in English. The Panel has the discretion under UDRP Rule 11(a) to determine the appropriate language of the proceedings taking the particular circumstances of the administrative proceeding into consideration. See Section 4.5, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3rd Edition; see also Lovehoney Group Limited v yan zhang, CAC 103917 (CAC August 17, 2021) (finding it appropriate to conduct the proceeding in English under Rule 11, despite Japanese being designated as the required language in the registration agreement). The Complainant contends that (i) the disputed domain name includes the Complainant’s mark "PENTAIR," with the additional geographic term

"Dubai". Both words are in English and utilize the Roman script, which is also employed in the English language; (ii) the use of English script and a relevant geographic term strongly suggests the Respondent's knowledge of English; (iii) the domain name was registered using the most common gTLD worldwide, i.e., .com, which is relevant because if the Respondent was aiming for the Japanese language market, the most relevant TLD would be the ccTLD applicable for Japan, i.e., .jp; (iv) the Respondent has deliberately chosen to use English words and script and the generally applicable gTLD, with both factors indicating the Respondent has command of the English language; (v) it would be unfair and prejudicial to proceed in the Japanese language because to do so would result in considerable delays to the proceedings and unnecessary expenses for the Complainant to prepare translations of the Complaint and all associated annexes; and (vi) the business language of the Complainant and its authorized Representative is English, and it would be burdensome and prejudicial for both to consider this proceeding in Japanese.

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive argument has been adduced by the Complainant. After considering the circumstance of the present case, in the absence of the Response and no objection to the Complainant's request for the language of proceeding, the Panel decides that the proceeding should be in English.

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

Rights

The Complainant contends that it is the owner of the registered trademark PENTAIR as identified in section "Identification of rights" above. The Panel notes that a trademark registration with a national trademark agency and an international trademark organization such as the USPTO, the EUIPO, the JPO, etc. is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark PENTAIR.

The Complainant further contends that the disputed domain name is confusingly similar to its mark PENTAIR on the grounds that the disputed domain name **<pentairdubai.com>** incorporates the Complainant's mark PENTAIR merely adding a geographic term "Dubai" and the ".com" generic top-level domain ("gTLD"). The Panel agrees and finds that the disputed domain name is confusingly similar to the Complainant's PENTAIR mark under Policy paragraph 4(a)(i).

No rights or legitimate interests

A complainant must first make a prima facie case that a respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to the respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not been licensed by the Complainant to register a domain name featuring the PENTAIR mark, nor any confusingly similar variant thereof. There are no indications that the Respondent has been commonly known by the domain name. The Panel finds that nothing in the records suggests that the Respondent is commonly known by the disputed domain name or authorized to use the Complainant's mark.

The Complainant contends that at the time of preparing this Complaint, the disputed domain name does not resolve to an active website and it only displays the following sentence: 403 FORBIDDEN. 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. The Panel is of the view that failure to make an active use of a website does not represent a bona fide offering of goods and services or a legitimate or fair use per Policy paragraph 4(c)(i) and (iii). See CrossFirst Bankshares, Inc. v Yu-Hsien Huang, FA 1785415 (Forum June 6, 2018) ("Complainant demonstrates that Respondent fails to actively use the disputed domain name as it resolves to an inactive website. Therefore, the Panel finds that Respondent fails to actively use the disputed domain name for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii)."). The Complainant provides screenshot evidence of the resolving website. The Panel therefore finds the Respondent fails to use the disputed domain name in connection with a bona fide offering of goods and services or a legitimate or fair use per Policy paragraph 4(c)(i) and (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Respondent, based in Japan, registered the disputed domain name on August 2, 2023. The Complainant, via its agent, reached out to the Registrar, expressing a willingness to reimburse the Respondent's registration fee in exchange for the transfer of the disputed domain name. However, since this effort to resolve the matter amicably was not successful, the Complainant opted to initiate this Complaint through the UDRP process. As noted previously, the disputed domain name currently does not resolve to an active website. 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.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.)

The particular circumstances of this case that the Panel has considered are:

(i) The Complainant 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. From approximately 135 locations in 26 countries, the Pentair Group's more than 11,000 employees are united in the unwavering belief that water's future depends on Pentair's Group. Pentair Group's 2022 net sales were approximately $4.1 billion. As such, the Complainant's mark 'PENTAIR' is considered as being a well-known and reputable trademark; and

(ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith under Policy, paragraph 4(a)(iii) and that the Respondent is using the disputed domain name in bad faith.

The Complainant further contends that the Complainant's trademark registrations long predate disputed domain name registration because the Complainants' PENTAIR trademark was filed 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 ten years between the registration of the Complainant's trademarks and the Respondent's registration of the disputed domain name. While constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of a disputed domain name with actual knowledge of another's trademark rights is sufficient to establish bad faith, and can be shown by the notoriety of the mark and the use the Respondent makes of the disputed domain name. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy paragraph 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); see also AutoZone Parts, Inc. v. Ken Belden, FA 1815011 (Forum December 24, 2018) ("Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii)."). The Panel agrees and infers, due to the notoriety of the Complainant's mark around the world that the Respondent had actual knowledge of the Complainant's rights in its mark PENTAIR at the time of registering the disputed domain name, and thus the Panel finds the bad faith 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. **pentairdubai.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-03-01

Publish the Decision