# Decision for dispute CAC-UDRP-106450

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| Case number | CAC-UDRP-106450 |
| Time of filing | 2024-04-26 10:00:59 |
| Domain names | pentaireu.com |

## Case administrator

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

## Complainant

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| Organization | Pentair Flow Services AG |

## Complainant representative

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| Organization | HSS IPM GmbH |

## Respondent

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| Name | Nguyen Thi Lan |

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 owns the registered trademark PENTAIR in numerous territories, including in Vietnam, where the Respondent is located.

| Country/Region | Trademark | Registration Number | Registration Date | Owner |
|---|---|---|---|---|
| IR WIPO (Canada, European Union, UK, Georgia, Thailand, Tunisia, Trinidad and Tobago, USA, Albania, Belarus, Algeria, Serbia, Ukraine, Viet Nam) | Pentair | 1620503 | 2021.08.09 | Pentair Flow Services AG |
| China | Pentair (& logo) | 11517821 | 2014.08.21 | Pentair Flow Services AG |

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| China | Pentair (& logo) | 3504734 | 2006.04.28 | Pentair Flow Services AG |
| USA | Pentair | 2573714 | 2002.05.28 | Pentair Flow Services AG |
| USA | Pentair (& logo) | 50003584 | 2012.07.01 | Pentair Flow Services AG |
| USA | Pentair | 4348967 | 2012.04.20 | 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 |

The Complainant's affiliated company owns the domain names <pentair.com> (registered on October 17, 1996), <pentair.net> (registered on December 25, 2003), <pentair.org> (registered on November 3, 2010, and <pentair.eu> (registered on May 25, 2005).

## FACTUAL BACKGROUND

The Complainant was founded in 1966. It is a leader in the water industry, part of the Pentair Group, with a significant presence worldwide, including ownership of the registered trademark PENTAIR in numerous countries.

The Complainant and its affiliates use the domain names <pentair.com>, <pentair.net>, <pentair.org>, and <pentair.eu> to connect to websites informing potential customers about the PENTAIR brand and related products and services.

The Pentair Group operates from approximately 139 locations in 27 countries and conducts business in 150 countries. The Group employs over 10,578 individuals who share a commitment to the belief that the future of water relies on the innovative solutions provided by the Pentair Group. In 2023, the Pentair Group reported net sales of approximately $4.1 billion.

The brand name PENTAIR is unique and distinctive, originating from the company's founders in 1966. Initially established in suburban St. Paul, Minnesota, the name "Pentair" was derived from the Greek word "penta," representing the five founders, and "air," reflecting their original intent to manufacture high-altitude balloons.

Over time, the company rapidly diversified into various industries and evolved into the leading provider of water-related products and services that it is recognised as today.

The Respondent registered the disputed domain name on April 12, 2023.

## PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
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 asserts rights in the PENTAIR trademark, which is registered in multiple jurisdictions worldwide. The Panel finds the Complainant has established rights in the PENTAIR trademark through its trademark registrations as demonstrated by the evidence adduced. Its trademark registrations also predate the registration date of the disputed domain name.

The question is whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. See F. Hoffmann-La Roche AG v. P Martin, WIPO Case No. D2009-0323.

A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

Here, the disputed domain name incorporates the Complainant's PENTAIR trademark in its entirety, with the addition of the term "eu", which is commonly recognised as a geographic term for Europe.

The Panel considers such an inclusion does not sufficiently distinguish the disputed domain name from the Complainant's trademark. Instead, it can be seen as enhancing the confusion by suggesting a connection to the Complainant's operations in Europe. This is further strengthened by the fact that the Complainant owns the domain name <pentair.eu>.

Accordingly, the Panel accepts the Complainant's contention that the disputed domain name is confusingly similar to its trademark. The primary element of the domain name, "pentair", is identical to the Complainant's well-known trademark. The addition of "eu" does not mitigate the risk of confusion.

It is also trite to state that the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that this ground is made out.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. See Document Technologies, Inc. v. International Electronic Communications Inc, WIPO Case No. D20000270.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name on the following basis:

1. No Bona Fide Offering

The Respondent has no relationship with the Complainant and was not authorised to use the Complainant's trademark. The disputed domain name resolves to a site mimicking the Complainant's legitimate site, using identical trademarks and content, and appears to be part of a phishing scheme to collect personal information. This use does not constitute a bona fide offering of goods or services.

2. Not Commonly Known by the Domain Name

There is no evidence that the Respondent is commonly known by the disputed domain name. The WHOIS information and Google search results indicate that the term "Pentair" is associated with the Complainant, and the Respondent has no legitimate connection or authorisation to use the name.

3. No Legitimate Non-Commercial or Fair Use

The Respondent has not demonstrated any legitimate, non-commercial use of the disputed domain name. The website associated with the disputed domain name is not used for informational or fair purposes but instead aims to deceive users and engage in phishing activities.

The Panel accepts the uncontradicted assertions put forward by the Complainant that the Respondent is not affiliated with the Complainant, nor has the Complainant authorised the Respondent to use the PENTAIR trademark. Further, there is no evidence that the Respondent is commonly known by the disputed domain name.

The Respondent has clearly not seized on the opportunity in this proceeding to provide any evidence of legitimate non-commercial or fair use of the disputed domain name.

On the other hand, the Complainant has submitted evidence showing that the Respondent's website, accessible via the disputed domain name, mimics the Complainant's official website. The Panel infer that this imitation suggests an intent to mislead users into believing that the site is associated with the Complainant.

The Panel considers that such conduct does not constitute a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name.

The Panel notes that the disputed domain name was registered on April 12, 2023. The Complaint was filed on April 25, 2024. This is just over 12 months after the disputed domain name was registered. The Complainant has led no evidence as to the delay in bringing its case nor explained the delay in its Amended Complainant.

The Respondent on the other hand has not challenged the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Despite the unexplained delay in bringing its case promptly, the Panel is prepared to consider the following matters in favour of the Complainant:

- The long-standing rights of the Complainant to its trademark PENTAIR and its famous reputation worldwide.
- The lack of any administratively compliant response from the Respondent.
- The lack of evidence of any legitimate use of the disputed domain name.

Given the evidence adduced by the Complainant of its portfolio of trademarks and wide reputation which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain name.

Accordingly, the Panel considers that this ground is made out.

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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 must demonstrate that the disputed domain name was registered and is being used in bad faith.

Paragraph 4(b) of the UDRP provides a non-exhaustive list of circumstances that indicate bad faith registration and use of domain names:

1. Circumstances indicating that the Respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
2. The Respondent 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
3. The Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's 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 relies on paragraph 4(b)(iv) to support its contention that the Respondent registered and is using the disputed domain name in bad faith for the following reasons:

1. The Complainant's PENTAIR trademark significantly predates the registration of the disputed domain name which was registered on April 12, 2023. The Respondent was never authorised by the Complainant to register the disputed domain name, and no relationship exists between the two parties.

2. The PENTAIR trademark, registered in numerous territories and used by the Complainant for decades, is distinctive and widely recognised within its sector. The Complainant asserts that this is evidenced by accolades such as being named one of America's best employers for women in 2022 by Forbes, receiving the 2022 ENERGY STAR® Partner of the Year – Sustained Excellence Award, and being voted the Brand Most Used by industry professionals across the U.S.A.
3. A Google search for "PENTAIR" and "PENTAIR EU" returns results related to the Complainant's business, indicating the Respondent's likely knowledge of the Complainant's trademark.
4. The Respondent has used the disputed domain name in bad faith by creating a website that mimics the Complainant's legitimate site, www.pentair.eu, including the unauthorised use of the PENTAIR trademark and similar content. Despite efforts by the Complainant to resolve the matter amicably through a Cease-and-Desist letter sent on January 7, 2024, the Respondent has ignored such communications.
5. The disputed domain name resolves to a site designed to create confusion among internet users, making them believe it is associated with the Complainant. The site features identical trademarks, logos, and imagery from the Complainant's official website.
6. Additionally, the significant time gap between the Complainant's trademark registrations, first filed in 2002, and the Respondent's registration of the disputed domain name in 2023, further supports a finding of bad faith. The Complainant relies on Natixis v. Felix Anderson, WIPO Case No. D2021-1934 to support the contention that such a time gap can indicate bad faith, especially when the complainant's rights predate the respondent's registration by many years.

The Panel accepts the uncontradicted evidence of the Complainant's well-known brand, its international trademark registration, its global presence and reputation. Accordingly, the Panel is prepared to infer that the Respondent has been fully aware of the Complainant, its PENTAIR trademarks when registering the disputed domain name.

The Panel is also prepared to draw the adverse inference that the Respondent registered the disputed domain name incorporating in its entirety the Complainant's trademark intentionally to take advantage of the Complainant's reputation and business goodwill.

The Panel also accepts the Complainant's uncontradicted assertion that the Respondent cannot claim any rights or legitimate interests in the disputed domain name.

The Panel notes that the Complainant sent a Cease-and-Desist letter to the Respondent on January 7, 2024. The Panel considers that the failure by a respondent to respond to a Cease-and-Desist letter or a similar attempt to make contact is a factor to take into account in favour of the Complainant. See 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.

Here, the Respondent for its own reasons has not responded by filing an administrative compliant response. The irrefragable inference is that the Respondent has chosen to ignore this, and accordingly the Panel is prepared to accept this conduct as indicating bad faith by the Respondent.

The Panel finds that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, but on the evidence the Panel is prepared to infer that the Respondent's conduct shows its intent to deceive users for commercial gain.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

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PROCEDURAL FACTORS

**Language of the proceedings request**

Rule 11(a) of the UDRP rules states:

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.

Here, the language of the Registration Agreement for the disputed domain name is Vietnamese.

The Complainant has requested that the language of the proceeding be English. The Complainant contends that the Respondent has sufficient proficiency in English, as evidenced by the content of the website associated with the disputed domain name, which is predominantly in English.

Further, the Complainant asserts that conducting the proceeding in Vietnamese would cause unnecessary delay and additional expense, while the Respondent would not be prejudiced by conducting the proceeding in English.

In conducting the administrative proceeding, the Panel is required to ensure under Rule 10 of the UDRP rules that the Parties are treated with equality and be given a fair opportunity to present its case.

The Respondent has not filed any administratively compliant response to the Complainant's Amended Complaint.

The Panel notes that the Respondent's website is in English, indicating that the Respondent has a sufficient understanding of the English language. Further, the Respondent's failure to participate in this proceeding and thereby object to the Complainant's request for English to be the language of the proceeding suggests that the Respondent would not be unfairly prejudiced by this decision.

Having considered the circumstances, including the interest of fairness and the avoidance of unnecessary delay and expense, the Panel determines that the language of the proceeding shall be English.

**Notification of proceedings to the Respondent**

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On May 30, 2024 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

Written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not.

CAC received a confirmation that the e-mail sent (in both English and Vietnamese) to postmaster@pentaireu.com was delayed.

The e-mail notice sent (in both English and Vietnamese) to email@smartviet.vn was returned back as undelivered. The e-mail notice was also sent to hvt.smartviet@gmail.com and to info@smartviet.vn, but CAC never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site.

The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Complainant owns the trademark PENTAIR, and several domain names with the PENTAIR trademarks, including <pentair.eu> which are used in connection with its goods or services.

The Respondent registered the disputed domain name <pentaireu.com> on April 12, 2023.

The disputed domain name was registered after the Complainant's trademark PENTAIR and after the various domain names own by the Complainant.

The Complainant commenced this dispute on April 25, 2024, just over 12 months after the disputed domain name was registered.

The Complainant challenges the registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Complainant also seeks to have the proceedings to be determined in the English language rather than the Vietnamese language.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

(a) The disputed domain name is identical to the Complainant's widely known trademark.

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

(c) The disputed domain name has been registered and is 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. **pentaireu.com**: Transferred

## PANELLISTS

| Name | **William Lye OAM KC** |
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DATE OF PANEL DECISION 2024-06-02

Publish the Decision