Decision for dispute CAC-UDRP-106728

Case number	CAC-UDRP-106728
Time of filing	2024-07-24 13:36:20
Domain names	pentair.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Pentair Flow Services AG

Complainant representative

Organization	HSS IPM GmbH

Respondent

Name	MEI WANG

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 a portfolio of word and combined trade marks consisting of or incorporating the name PENTAIR, including the US national trade mark PENTAIR, registration number 257714, first registered on 28 May 2002 in international class 7; the US national trade mark PENTAIR, registration number 50003584, first registered on 1 July 2012 in international class 35; the US national trade mark PENTAIR, registration number 4348967, first registered on 20 April 2012 in international classes 7, 9, 11 and 20; the Chinese national trade mark PENTAIR, registration number 11517821, first registered on 21 August 2014 in international class 35; the Chinese national trade mark PENTAIR, registration number 3504734, first registered on 28 April 2006 in international class 21; the European Union trade mark PENTAIR, registration number 011008414, first registered on 23 January 2013 in international classes 6, 7, 9, 11 and 42; and the Swiss national trade mark PENTAIR, registration number 675144, first registered on 2 July 2015 in international classes 6, 7, 9, 11, 17, 35-37 and 40-42. The aforementioned trade mark registrations of the Complainant all predate the registration of the disputed domain name.

Furthermore, Pentair Inc, an affiliated company of the Complainant, owns a portfolio of domain names consisting of the name PENTAIR, including the domain names <pentair.com>, registered on 17 October 1996; <pentair.net>, registered on 25 December 2003; and <pentair.org>, registered on 3 November 2010, which the Complainant and its affiliates use to connect to official websites through which they inform Internet users and potential customers about the PENTAIR mark, related brands, and products and services.

FACTUAL BACKGROUND

The Complainant is a business within the Pentair Group of companies ("Pentair Group"). Founded in 1966, the Pentair Group is a leader in the provision of products and services for 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. Pentair Group works from approximately 135 locations in 26 countries and has more than 11,000 employees. Pentair Group's 2022 net sales were approximately US$4.1 billion.

The brand name PENTAIR was created by the company founders. In 1966, five founders intent on manufacturing high-altitude balloons founded a company in suburban St. Paul, Minnesota, which 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 new ventures in a number of different industries, before ultimately becoming a leader in water-related products and services.

The disputed domain name <pentair.shop> was registered on 14 December 2023 and resolves to a commercial third-party website on which the disputed domain name is offered for sale to the general public for US$950.

PARTIES CONTENTIONS

The Complainant contends that all three elements of the UDRP have been fulfilled and it therefore requests the transfer of the disputed domain name to the Complainant. 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 trade mark 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

With regard to the first UDRP element, the Panel finds that the disputed domain name is identical with the Complainant's trade mark PENTAIR. Indeed, the disputed domain name incorporates the Complainant's trade mark in its entirety without any alteration. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a Complainant's registered trade mark is sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin <porsche-autoparts.com>).

With regard to the second UDRP element, the Panel observes that the disputed domain name resolves to a commercial third-party website at www.dan.com (a Go Daddy brand) where the disputed domain name is offered for sale to the general public at a price of US$950. It is commonly accepted that aggregating and holding domain names (including for resale) consisting of acronyms, dictionary words, or common phrases can be bona fide and is not per se illegitimate under the Policy. However, the name PENTAIR is fanciful, protected as a trade mark, and does not fall under any of these categories. Furthermore, in the circumstances, the disputed domain name (falsely) suggests and implies an affiliation with the Complainant. The Panel accepts the Complainant's submission that there is no evidence to suggest that the Respondent has made any use of, or demonstrable preparations to use, the

disputed domain names in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy because the Respondent failed to satisfy the "OKI Data" test (see WIPO Case No. D2001-0903, OKI Data Americas, Inc v. ASD, Inc <okidataparts.com>). In particular, the third-party website at www.dan.com offering the disputed domain name for sale does not offer the goods or services at issue; the site does not only sell the trade marked goods and services; and the site does not accurately and prominently disclose the registrant's relationship with the trade mark holder. The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade marks or to apply for or use the disputed domain names. Additionally, the Whois information for the disputed domain names does not suggest that the Respondent is commonly known by the disputed domain names. Past panels have held that a respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name, as is equally not the case here (see, for example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).")). Finally, there is no indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain names. Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

With regard to the third UDRP element, the Panel accepts the Complainant's submission 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 who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name. While the WIPO Overview 3.0 states at paragraph 3.1.1 that the practice of registering a domain name for subsequent resale does not by itself establish that a respondent registered the domain name for the purpose of selling in bad faith to the complainant or a competitor, a fact-specific enquiry may lead to such a finding. Against this background, the Panel finds it reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical or confusingly similar to the Complainant's trade mark, and that the Respondent registered the disputed domain name in full knowledge of the Complainant's trade mark. Indeed, if the Respondent had carried out a Google search for the term "Pentair", the search results would have yielded immediate results related to the Complainant, its websites, and its connected business and services. It is likely that the disputed domain name would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673, Ferrari Spa v. American Entertainment Group Inc <ferrariowner.com>). Indeed, the Panel considers it likely that the disputed domain name was intentionally designed to be either identical or confusingly similar with the Complainant's trade mark because the name "Pentair" has no meaning other than to refer to the Complainant (see also: CAC Case No. 106110, Pentair Flows Services AG v. Lance Jones <pentair.store>). Furthermore, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain names by any third party that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law under circumstances where the disputed domain name is identical with the Complainant's trade mark and is similar to the Complainant's genuine domain names currently used by the latter to promote its goods and services. The disputed domain name is therefore primarily (if not exclusively) of interest to the Complainant. In addition, the Panel notes that the Complainant attempted to contact the Respondent via the available contact details on 9 April 2024 by sending a Cease-and-Desist ("C&D") letter. In the C&D letter, the Complainant advised the Respondent that the unauthorized use of its trademark within the Disputed Domain Name violated its trade mark rights and the Complainant requested a voluntary transfer of the disputed domain name. On the same date, the Complainant received the response "" (which commonly means "stop sending"). The Complainant followed up again on 9 April 2024 (in Chinese and English) reiterating the Complainant's assertion of its trade mark rights and requesting the transfer of the disputed domain name but the Complainant received no further response. The Panel follows the view held by other panels that a failure by the respondent to respond (substantively) to a C&D letter constitutes further evidence of bad faith (see, for example, WIPO Case No. D2024-0557, Société Nestle S.A. v. Prairie Web Development <recetanestle.com>; CAC Case No. 105866, Arla Foods Amba v. James Moore <arlfoods.com>; and CAC Case No. 106070, Carsten Johne (Siemens Trademark GmbH & Co KG) v. Leonel Lopez Castillo (Buildpoint Construction Group) <siemensmx.com>). The Panel derives yet further support for a finding of bad faith on the part of the Respondent from the fact that the Complainant's trade mark registrations long predate the Respondent's registration of the disputed domain name because the Complainants' PENTAIR trade mark was filed as early as 2002, whereas the Disputed Domain Name was registered in 2023, constituting a gap of more than 20 years (see, for example, WIPO Case No. D2021-1934, Natixis v. Felix Anderson <natixisbnk.com>, where the Panel found that: "… In addition, a gap of more than ten years between registration of the Complainant's trademark and the Respondent's registration of the disputed domain name (containing the trademark) can, in certain circumstances, be an indicator of bad faith. (See Asian World of Martial Arts Inc. v. Texas International Property Associates, WIPO Case No. D2007-1415). In this case, the Complainant's rights in its trademark predate any rights that could possibly flow from the Respondent's registration by 15 years"). Finally, a purchase price of US$950 of course exceeds the typical out-of-pocket expenses directly related to the registration of a ".shop" domain name. Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **pentair.shop**: Transferred

PANELLISTS

Name	**Gregor Kleinknecht LLM MCIArb**

DATE OF PANEL DECISION 2024-08-27

Publish the Decision