

Decision for dispute CAC-UDRP-107271

Case number CAC-UDRP-107271

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Domain names PentairDealer.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 wen xiao

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 the "PENTAIR" trademarks

- USA word trademark registration number 2573714, with the registration day on May 28, 2002;
- USA combined trademark registration number 5003584, with the registration day on July 01, 2012;
- USA word trademark registration number 4348967, with the registration day on April 20, 2012;
- China combined trademark registration number 11517821, with the registration day on August 21, 2014;
- China combined trademark registration number 3504734, with the registration day on April 28, 2006;
- EU combined trademark registration number 011008414, with the registration day on January 23, 2013;
- Switzerland combined trademark registration number 675144, with the registration day on July 02, 2015.

The disputed domain name has been registered on November 07, 2024.

PARTIES CONTENTIONS

The Complainant 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. 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 brand 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 Complainant owns the registered trademark PENTAIR in numerous territories, covering among other countries, USA, China, EU and Switzerland. These trademark registrations, as well as other PENTAIR marks owned by the Complainant, long predate the registration of the disputed domain name. Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown worldwide.

Pentair Inc, an affiliated company of the Complainant, owns the domain names <pentair.com> (Registered on 17.10.1996), <pentair.net> (registered on 25.12.2003) and <pentair.org> (registered on 03.11.2010).

The trademark PENTAIR has been subject of past disputes under the UDRP Policy, such as:

- CAC Case No. 102845 (<pentairbenefit.com>, <mypentairbenifits.com>, <mypentairbenefit.com>)
- CAC Case No. 102894 (<pentairr.com>)
- CAC Case No. 102705 (<PentairEverPure.com>)
- CAC Case No. 104955 (<pentairulantikon.com>)
- CAC Case No. 105279 (<wwwpentairbenefits.com>, <pentairbenifits.com>, <pentairbenefits.com> and <wwwmypentairbenefits.com>)
- CAC Case No. 105193 (<pentairshop.com>)
- CAC Case No. 105848 (<pentaireurope.blog>)
- CAC Case No. 106110 (<Pentair.store>)
- CAC Case No. 106728 (<pentair.shop>)

The disputed domain name is confusingly similar to Complainant's PENTAIR trademarks

The disputed domain name directly and entirely incorporates Complainant's registered trademark PENTAIR along with the generic term "dealer", a term that can be considered related to Complainant's business. Complainant's PENTAIR mark is the initial, dominant and only distinctive element in the disputed domain name. The generic term "dealer" adds no distinguishing character, is relevant to Complainant's business because many of Complainant's products are sold through authorized dealers, and does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

Further, 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.

The addition of the generic Top-Level Domains (gTLD) ".com" does not add any distinctiveness to the disputed domain name.

The disputed domain name should be considered as confusingly similar to the Complainant's trademark PENTAIR, as it contains the trademark in full and dominant part.

The Respondent has no rights or legitimate interest in respect of the disputed domain name

The Complainant has not authorized the Respondent to use any of its trademarks, and the Complainant does not have any other relationship or association, or connection with the Respondent.

a) No bona fide offering

At the time of preparing the Complaint, the disputed domain name resolved to a web browser warning alert regarding malicious activity. The Complainant's investigation found that, the disputed domain name previously displayed a gambling website in Chinese language.

Several panelists have confirmed that the distribution of malware is not a bona fide offering of goods or services. Therefore, the use of these disputed domain name, which is identified by the web browser as being used for malicious activity, cannot be considered as legitimate use.

As addressed in more detail below, the Complainant is also concerned that there may be a more malicious intent behind the disputed domain name, under the bad faith third element due to the potential to generate phishing activity and attacks. Such malicious use of the disputed domain name for phishing purposes would also be considered to be not in connection with a bona fide offering of goods or services as required by the Policy.

There is no other 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. The identified earlier use of the disputed domain name in connection

with a gambling site also does not appear to be legitimate, in so far as there was no apparent connection to the Complainant's trademark PENTAIR and the browser alerts disabled access to the site. It is clear that Complainant has become a distinctive identifier associated with the term "PENTAIR" and that the intention of the disputed domain name is to take advantage of an association with the business of Complainant's Group.

b) Not commonly known by the domain name

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has any interest in it. When entering the term "PENTAIR" and "PENTAIR DEALER" in the Google search engine, the returned results point to the 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 the Complainant owns the trademark and that the Complainant has been using its trademarks extensively. As mentioned above, the Complainant has not authorized the Respondent to use any of its trademarks, and the Complainant does not have any other relationship or association, or connection with the Respondent.

c) No legitimate non-commercial or 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. The use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

Accordingly, the Respondent fails in all three of the above-mentioned conditions. In conclusion, according to the evidence available to the Complainant, there is no indication that Respondent has any rights or legitimate interests in the disputed domain name.

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

In the instant case, the Complainant contends that using the disputed domain name, Respondent intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location. Such use establishes bad faith registration and use in addition to generalized bad faith due to likely use of malware and potential phishing risks.

a) The disputed domain name was registered in bad faith

The Complainant's PENTAIR trademarks long predate the registration of the disputed domain name, and the Respondent has never been authorized by the Complainant to register the disputed domain name, nor does the Complainant have any relationship with the Respondent. The active business presence of the Complainant in different markets 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 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.

Previous panels have confirmed the distinctiveness of the Complainant's PENTAIR trademark (CAC Case No. 106110 Pentair Flows Services AG v. Lance Jones concerning the domain name <Pentair.store> where the panel held, "the Disputed Domain Name has no other meaning except for referring to Complainant's name and trademarks").

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

b) The disputed domain name is being used in bad faith

Complainant's numerous relevant trademark registrations long predate Respondent's disputed domain name registration. This constitutes bad faith due to the gap of more than twenty years between the registration of the Complainant's trademark and the Respondent's registration of the disputed domain name (WIPO Case No. D2021-1934)

As noted previously, the disputed domain name currently does not resolve to an active website. Some panels have found that the concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" by a third party of a domain name.

In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows 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 marks in violation of Complainants' rights.

Further the disputed domain name previously resolved to an active website displaying a Chinese language gambling site. Complainant considers such use to be disrupting to Complainant's business while attracting users for commercial gain and causing consumer confusion. Prior panels have held that using a domain name to resolve to a gambling site can bolster the case for a finding of bad faith (WIPO Case No. D2024-1228). Respondent was never granted permission to register the disputed domain name. Respondent took advantage of Complainant's trademark by creating a likelihood of confusion with the Complainant's mark as to the

source, sponsorship, affiliation, or endorsement of Respondent's products, services, website or location.

From the Complainant's point of view, Respondent intentionally chose the disputed domain name based on the registered and widely used trademark PENTAIR, along with the term "DEALER" in order to generate more traffic to its own business. Respondent used 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. This conduct has been considered as bad faith under the Policy.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to a trademark 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- I. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
and
- II. The respondent has no rights or legitimate interests in respect of the domain name; and
- III. The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the trademarks PENTAIR with the registration date on May 28, 2002 (in the case of the oldest US trademark registration No. 2573714).

The disputed domain name has been registered on November 07, 2024, i.e. more than 22 years after the first PENTAIR trademark registration and wholly incorporates the Complainant's trademarks PENTAIR.

The generic term "DEALER" in the disputed domain name does not distinguish the disputed domain name from the Complainant's trademarks. The use of this generic and descriptive term more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark as it could lead to the conclusion, that the disputed domain name points to dealer of the Complainant's products or services. Use of this term, therefore, does not change the overall impression of the designation as being connected to the Complainant or its trademarks. The same applies in the case of the generic top-level domain ".COM".

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant's trademark "PENTAIR" in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

II. Rights or Legitimate Interests

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name. It has been proved, that the Respondent is not commonly known by the disputed domain name and there is no indication that the Respondent is related in any way with the Complainant.

It has not been proved, that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services – the disputed domain name resolves to a web browser warning alert regarding malicious activity and previously displayed a gambling website in Chinese language. Such use cannot be considered as legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel therefore considers that 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).

III. Registered and Used in Bad Faith

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists of the Complainant's trademarks "PENTAIR". There are no doubts that the Complainant's trademarks are distinctive and well-known as confirmed in the previous CAC decisions mentioned by the Complainant. It could be therefore concluded that the disputed domain name has been registered in bad faith as the Respondent had or should have the Complainant and its prior trademark rights in mind when registering the disputed domain name.

Use of such disputed domain name could, therefore, attract the internet users to the corresponding web page by creating a likelihood of confusion with the Complainant's trademarks (paragraph 4(b)(iv) of the Policy).

Moreover, use of disputed domain names in connection with the gambling site be disrupting to Complainant's business and trademarks. Also, any malicious activity as noted by the web browser warning alert while accessing the website resolved by the disputed domain name could harm the Complainant.

Considering the (i) similarity between the Complainant's trademarks and the disputed domain name, (ii) obviously intentional addition of the generic words after the Complainant's trademark, (iii) distinctiveness of the Complainant's trademarks, (iv) use of one of the disputed domain name for the gambling services and malicious activities and (v) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Thus, 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 Panel considers that the Complainant has shown that the disputed domain name <pentairdealer.com>, is confusingly similar to trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. PentairDealer.com: Transferred

PANELLISTS

Name	Petr Hostaš
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DATE OF PANEL DECISION 2025-03-14

Publish the Decision
