.hk Domain Name Dispute Resolution
AWARD BY ARBITRATION PANEL

Complainant: 1. Pentair plc;
               2. Pentair Filtration Services, LLC

Respondent: Mr Kelvin So

Case Number: DHK-1700147

Disputed Domain Name: <everpurewater.hk>

Panel Member: Mr. FONG Ho Yin

1. Parties and Disputed Domain Name

The First Complainant is Pentair plc of 10 Earlsfort Terrace, Dublin 2, D02 T380, Ireland and the Second Complainant is Pentair Filtration Services, LLC of 1040 Muirfield Drive, Hanover Park, IL 60133, United States of America. The First Complainant and the Second Complainant are collectively referred to as (the Complainant).

The Respondent is Mr Kelvin So Email: domapp@imsbiz.com

The Disputed Domain Name <everpurewater.hk> is registered with Hong Kong Telecommunications (HKT) Limited (the Registrar).

2. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Centre (the HKIAC) on 23 July 2017 pursuant to the Domain Name Dispute Resolution Policy, adopted by the Hong Kong Domain Name Internet Registration Corporation Limited (HKIRC) on 22 February 2011 (the Policy), the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure, approved by HKIRC on 22 February 2011 (the Rules of Procedure) and the HKIAC Supplemental Rules (the Supplemental Rules) effective from 1 March 2011. On 24 July 2017, the HKIAC transmitted by email to the Registrar a request for verification. On 1 August 2017, the Registrar transmitted by email to the HKIAC its verification.

On 2 August 2017, the HKIAC sent to the Complainant by email a Notification of Deficiencies of the Complaint.

On 9 August 2017, the Complainant filed the Complaint duly rectified. On the same day, the HKIAC sent a Notification of Commencement of Proceedings ("the Notification") to
the Respondent. The Notification gave the Respondent 15 business days to submit a Response (i.e. on or before 30 August 2017).

No formal Response was submitted to the HKIAC by the Respondent.

On 31 August 2017, the HKIAC advised both parties of the failure of the Respondent to submit a Response to the Complaint within the stipulated time period and that a Panelist for the case would shortly be appointed by the HKIAC.

On 4 September 2017, the HKIAC sent an email to Mr. FONG Ho Yin enquiring from him whether he could act and if so whether he could act independently and impartially in the matter in question.

On 6 September 2017, Mr. FONG Ho Yin confirmed that he was willing to act and if appointed would act independently and impartially.

On 7 September 2017, the HKIAC notified the parties that Mr. FONG Ho Yin had been appointed as a Sole Panelist by the HKIAC.

By an Arbitration Panel Order No. 1 issued on 21 September 2017, it is ordered that:

"1. The Complainant shall file documentary evidence in support of Paragraph 5(1) of the Complaint on or before 25 September 2017;
2. The Respondent may file submission in reply on or before 28 September 2017;
3. The Arbitration Panel shall render the Decision on or before 12 October 2017."

On 22 September 2017, the Complainant filed an affidavit of Angela D. Jilek pursuant to the Arbitration Panel Order No. 1.

The Respondent did not file any submission in reply by the due date on 28 September 2017.

Paragraph 11(a) of the Rules of Procedure provides that unless otherwise agreed by the Parties, the language of the arbitration proceedings shall be in English for English.hk domain name, subject always to the authority of the Arbitration Panel to determine otherwise, having regard to all the circumstances of the arbitration proceeding. The Arbitration Panel determines that the language of the present arbitration proceedings shall be in English.

3. Factual Background

For the Complainant

1. Complainant 1 herein, Pentair PLC, is the parent company and ultimate beneficial owner of (inter alia) Complainant 2, Pentair Filtration Services, LLC, who is the lawful trade mark owner of EVERPURE in Hong Kong. Due to Complainant 1’s internal policy, the EVERPURE trade marks and domain names may from time to time be legally owned by different entities within Complainant 1’s Pentair Group, but all rights and interests therein enure to the sole and ultimate benefit of Complainant 1.
2. As said, Complainant 2, Complainant 1’s wholly owned subsidiary, is the lawful owner of the trade mark EVERPURE (inter alia) in Hong Kong.

2.1. Complainant 2 (and its predecessors in title) together with its affiliated companies has/have continuously and extensively used the EVERPURE trademark in Hong Kong and numerous other countries worldwide, since at least as early as 1978.

2.2. Further, Complainant 2 (or its predecessors in title) has registered the EVERPURE trademark worldwide including in Hong Kong including those set out in the table below.

<table>
<thead>
<tr>
<th>No.</th>
<th>Trade Mark</th>
<th>Reg. No. / Reg. Date</th>
<th>Class</th>
<th>Goods / Services</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>EVERPURE</td>
<td>300051722 23 Jul 2003</td>
<td>11</td>
<td>water purification devices containing filter means which remove solids, color bodies and taste and odor imparting substances from water.</td>
</tr>
<tr>
<td>2</td>
<td>EVERPURE</td>
<td>300051731 23 Jul 2003</td>
<td></td>
<td>water purification devices containing filter means which remove solids, color bodies and taste and odor imparting substances from water.</td>
</tr>
</tbody>
</table>

For the Respondent

On 30 July 2007, the Respondent through the Registrar registered the Disputed Domain Name.

The Respondent has not filed any formal Response to these proceedings.

4. Parties' Contentions

The Complainant

1. The Disputed DN is identical or confusingly similar to the Complainants’ prior trade/service mark(s), which have been registered by the Complainant 2/ Affiliated Entities in Hong Kong and elsewhere. Additionally, the Disputed DN is also identical or confusingly similar to the trade names / domain names in and to which Complainants have prior legitimate rights through Affiliated Entities.

2. The Respondent has no rights or legitimate interests in respect of the Disputed DN; and none of the conditions set out in Art. 4(d) of the Domain Name Dispute
Resolution Policy are met. Nor does the Respondent have any rights or legitimate interests in EVERPURE, whether as a trade mark or trade name.

3. For <pentair.com.hk>, even after its registration by RLTL, it has not been directed to any actual website. In other words, no use has been made of <pentair.com.hk> except to block the Complainants’ legitimate use and registration thereof. On the other hand, RLTL is using the Disputed DN, registered by the Respondent who was RLTL’s company secretary, director and shareholder at the time, without the Complainants’ authorisation, to pass off as the Complainants’ authorised agent.

4. The Respondent has either registered the Disputed DN as nominee for RLTL, or he has used the Disputed DN through the corporate veil of RLTL. In either way, it is clear that the registration of the Disputed DN by the Respondent who allowed or directed RLTL to use the same as its official website, has deceived the public and constituted passing off.

5. As such, the Respondent had registered the Disputed DN in bad faith. With full knowledge of the Complainants’, and Affiliated Entities’, rights in and to the trade marks and trade names (inter alia) EVERPURE, the Respondent’s inclusion thereof as the only distinctive part of the respective Disputed DN undoubtedly misleads the trade and the public to think that RLTL / the Respondent is/are the Complainants, or Complainants’ appointed agents, which is untrue.

6. The Respondent is fully aware of his lack of intellectual property rights, his unlawful infringement thereof, as well as the Complainants’ objections thereto. Yet he persists and continues to breach the law and the Complainants’ legal rights.

The Respondent

The Respondent has not submitted any formal Response within the stipulated timeframe. Therefore, the Respondent is in default.

5. Findings by the Arbitration Panel

According to Paragraph 4(a) of the Policy which is applicable hereto, the Complainant has the burden of proving that:

(i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and

(iii) the Disputed Domain has been registered and is being used in bad faith; and

(iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.
(1) Identical/confusing similarity

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights.

Based on the "EVERPURE" registered trademarks of the Complainant, the Arbitration Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant’s registered trademarks in Hong Kong.

As noted, the Disputed Domain Name “everpurewater.hk”, composes of “everpurewater” and “.hk”.

The only difference between the Disputed Domain Name and the Complainant’s registered trademarks is the inclusion of the word “water” as a suffix at the end of “everpure”. The Arbitration Panel is of the view that the word “water” is a generic word which adds no distinctive element.

It is well-established that in cases where the distinctive and prominent element of a Disputed Domain Name is the Complainant’s mark and the only addition is a generic term that adds no distinctive element, such an addition does not negate the confusing similarity between the Disputed Domain Name and the mark: see LEGO Juris A/S v. huangderong, WIPO Case No. D2009-1325.

No doubt, “.hk” is a generic top-level domain name (gTLD) suffix. It is non-distinctive and is incapable of differentiating the Disputed Domain Name from the Complainant’s registered trademark: see Pomellato S.p.A v. Tonetti, WIPO Case No. D2000-0493. Hence, the gTLD “.hk” is without legal significance as the use of a gTLD is technically required to operate domain names and it does not serve to identify the source of the goods or services provided by the registrant of a domain name.

Accordingly, the Arbitration Panel is satisfied that the Complainant has complied with Paragraph 4(a)(i) of the Policy.

(2) Rights or Legitimate Interests of Respondent

The fact that the Complainant’s adoption and first use of the registered trademarks predates the Respondent’s Disputed Domain Name has the practical effect of shifting the burden of proof to the Respondent in establishing that it has legitimate rights and/or interests in the Disputed Domain Name: see PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor, WIPO Case No. D2003-0174.

As the Respondent is in default and has not filed any Response, in particular, the Respondent has not discharged the burden of proof under Paragraph 4(c) of the Policy.
Accordingly, the Arbitration Panel is satisfied that the Complainant has complied with Paragraph 4(a)(ii) of the Policy.

(3) **Bad faith**

Paragraph 4 (b) of the Policy provides:

"**Evidence of Registration and Use in Bad Faith.** For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

(i) circumstances indicating that the Registrant has registered or has 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 Registrant’s documented out-of-pocket costs directly related to the Domain Name; or

(ii) the Registrant 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 Registrant has engaged in a pattern of such conduct; or

(iii) the Registrant has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s 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 the Registrant’s web site or location or of a product or service on the Registrant’s web site or location."

On the information before the Arbitration Panel, the Arbitration Panel finds that the Respondent registered the Disputed Domain Name in bad faith.

In reaching this conclusion, the Arbitration Panel takes into account of a number of facts into consideration:

1. The Complainant has registered the “EVERPURE” trademarks in Hong Kong long before the Disputed Domain Name was registered.

2. The Complainant’s “EVERPURE” trademarks have been registered, advertised and used widely, and have become well-known amongst the Internet users globally and in Hong Kong. It has been held that registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith: see The Caravan Club v. Mrgsale, Case No. NAF/FA95314.
3. It is well established that the Respondent's registration and use of the Disputed Domain Name must involve malafides where the registration and use of it was and continues to be made in the full knowledge of the Complainant's prior rights in the “EVERPURE” trademarks, and in circumstances where the Respondent did not seek permission from the Complainant, as the owner of the trademarks, for such registration and use: see Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163.

4. The Arbitration Panel accepts that by registering the Disputed Domain Name, the Respondent has prevented the Complainant from registering a corresponding domain name reflecting its trademarks.

5. The Respondent registered the Disputed Domain Name to create a likelihood of confusion to and/or intentional mislead Internet users into believing that it is connected to, endorsed by and/or otherwise associated with the Complainant, and thereby disrupting the Complainant's business and directing legitimate traffic away from the Complainant.

Accordingly, the Arbitration Panel is satisfied that the Complainant has complied with Paragraph 4(a)(iii) of the Policy.

(4) **If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name**

The Disputed Domain Name is not the Respondent's legal name for .idv.hk. So, he does not meet the registration requirements for that individual category of domain name.

6. **Award**

For the foregoing reasons, the Arbitration Panel is satisfied that the Complainant has proved its case against the Respondent under Paragraph 4(a) of the Policy.

The Arbitration Panel hereby orders that the Disputed Domain Name be transferred to the Second Complainant.

Date of Issue: 9 October 2017

Place of arbitration: Hong Kong

FONG Ho Yin
Sole Panelist of the Arbitral Tribunal