



## DECISION

Spectrum Brands, Inc. v. Liu Yun Yun

Claim Number: FA2011001921890

### PARTIES

Complainant is **Spectrum Brands, Inc.** (“Complainant”), represented by **William Schultz of Merchant & Gould, P.C.**, Minnesota, US. Respondent is **Liu Yun Yun** (“Respondent”), China.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<pfister.design>**, registered with **Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn)**.

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider, Chartered Arbitrator (UK), as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on November 24, 2020; the FORUM received payment on November 24, 2020.

On November 26, 2020, Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) confirmed by e-mail to the FORUM that the **<pfister.design>** domain name is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina

(www.net.cn) and that Respondent is the current registrant of the name. Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) has verified that Respondent is bound by the Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On November 30, 2020, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 21, 2020 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@pfister.design. Also on November 30, 2020, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on December 21, 2020.

On December 23, 2020, Complainant submitted Additional Written Submissions, which the Panel has considered in its discretion under Rule 7 of the Supplemental Rules. Respondent made no additional submissions.

On December 28, 2020, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider, Chartered Arbitrator (UK), as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph

2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

## **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

## **PRELIMINARY ISSUE – LANGUAGE OF THE PROCEEDINGS**

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive evidence has been adduced by Complainant to suggest the likely possibility that the Respondent is conversant and proficient in the English language. After considering the circumstances of the present case, the Panel decides that these proceedings should be conducted in English.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

Spectrum Brands, Inc. (hereafter "Spectrum" or "Complainant") is the owner of the PFISTER family of trademarks used in connection with a variety of products and services. Complainant and its predecessors in interest have used the PRICE PFISTER and PFISTER mark in commerce continuously since at least as early as 1935. Spectrum has also extensively used its PFISTER brand since at least as early as 2010. Complainant claims rights in the PFISTER mark through its registration of the mark with the USPTO (e.g., Reg. No. 4,180,949, registered Jul. 24, 2012). Respondent registered the domain name <pfister.design> (the "Disputed Domain Name") on August 11, 2016.

The Disputed Domain Name incorporates Complainant's entire PFISTER mark and is confusingly similar to the PFISTER Marks pursuant to Policy ¶ 4(a)(i). The

addition of a top level domain to a mark is not a distinguishing feature. *See Isleworth Land Co. v. Lost in Space*, SA, FA 117330 (Nat. Arb.Forum Sept. 27, 2002) (“[I]t is a well established principle that generic top-level domains are irrelevant when conducting a Policy ¶ 4(a)(i) analysis.”) Moreover, the top-level domain “.design” adds to the confusion because Complainant uses the term “design” in connection with its own marketing. Complainant avers that the evidence shows the Disputed Domain Name was registered to trade upon the goodwill associated with Complainant’s PFISTER Marks and to divert traffic away from Complainant’s own websites. There is no other reason to register a domain name that is identical to such a unique term other than to trade on the rights of Complainant.

Complainant has used the phrase “Design Made Right” in connection with its Pfister brand. Indeed, by combining the Pfister brand with the term “design,” Respondent incorporated a portion of a marketing phrase Complainant uses to market its brand based on the unique design of the faucets Complainant manufactures and sells. Moreover, Respondent has never placed any information on a website associated with the Disputed Domain Name. Respondent’s lack of associating the Disputed Domain Name with any website reflects that Respondent does not have a legitimate right to the name. Respondent’s registration of the name trades on Complainant’s goodwill associated with its PFISTER Marks and disrupts Complainant’s business in diverting traffic away from Complainant’s legitimate sites.

Respondent has no statutory or common law trademark rights or any other right or legitimate interest to Complainant’s PFISTER Marks, or in the Disputed Domain Name. Complainant has not authorized or licensed Respondent to use the PFISTER Marks or any derivative mark for any purpose, nor is Respondent commonly known by the mark.

Respondent does not have a *bona fide* interest in the Domain Name pursuant to Policy ¶¶ 4(c)(i) and 4(c)(iii) in that it failed to place any content on the website associated with the Disputed Domain Name. There is no evidence Respondent ever listed content on the site since the Disputed Domain Name was registered. That inactive use of the Disputed Domain Name shows a lack of *bona fide* offering of goods or services and a lack of legitimate use. Respondent cannot escape the lack of legitimate rights in the site. Indeed, by registering the Disputed Domain Name, Respondent took away Complainant's ability to register the Disputed Domain Name and bring consumers to a website directly associated with Complainant's design products, thereby disrupting Complainant's business. The Disputed Domain Name is not connected to a *bona fide* offering of goods or services and is not a legitimate use. Complainant's evidence includes a screenshot of a notice that no website can be found at the IP address to which the Dispute Domain Name resolves.

Respondent had actual knowledge of Complainant's trademark rights in its PFISTER Marks prior to the registration of the Domain Name. Unlike the registration of a common name that may have more than one meaning in connection with design services, the PFISTER mark is a term that only relates to Complainant in connection with design. These facts demonstrate that Respondent registered a domain name that had no meaning other than Spectrum's PFISTER trademark – showing it had knowledge of Complainant.

Respondent's registration of the Disputed Domain Name with the actual knowledge of Complainant's trademark rights in that name shows bad faith pursuant to Policy ¶ 4(b)(ii). Respondent has also acted in bad faith pursuant to Policy ¶ 4(b)(iii) because it has failed to make active use of the Disputed Domain Name and does not have any right to use the Disputed Domain Name in view of Complainant's prior registered and common law rights.

## B. Respondent

The unsigned Response dated December 20, 2020 is written in simplified Chinese in the name of 青岛拓必德机械有限公司 (which Complainant translates into English as “Qingdao Topbide Machinery Co., Ltd.”) (hereafter “Topbide”).

The Response avers that the Respondent, Liu Yun Yun, a founding shareholder of Topbide, established on April 13, 2015, was engaged in August of 2016 and registered the Disputed Domain Name in connection with a plan to manufacture parts and accessories for industrial grinders for use in mining operations. The Response incorporates a number of photographs and a schematic of grinding machinery.

The Response alleges a plan to use the Disputed Domain Name in connection with the manufacture and sale of heavy industrial grinders for use in mining operations. As research and development work is still underway and is yet to be completed, however, the venture has yet to be “formally commenced”. The Response alleges that prior to receiving the Complaint in these administrative proceedings, Respondent had no knowledge of Complainant or its PFISTER Marks.

## C. Additional Submissions

Complainant’s Additional Submissions alleges that although the Response relates to the alleged activities of Topbide, that entity is not the Respondent. The Respondent is Liu Yun Yun. As such, there is no evidence that the Respondent, Liu Yun Yun, has any right or legitimate interest in the Disputed Domain Name.

Further, a respondent is required to show that it has made demonstrable preparations to offer goods and services using the disputed domain name before it had notice of the Complaint. *The Elizabeth Taylor Trust, Interplanet*

*Productions Limited and The Elizabeth Taylor Cosmetics Company v. Patrick Fitzgerald*, FA1465340 (FORUM, Nov. 20, 2012) (holding mere claims of plans to prepare a website insufficient to show demonstrable preparations). Respondent has adduced no evidence that Respondent planned to use the name PFISTER in connection with the offer or sale of any product or service. The lack of evidence of demonstrable preparations is sufficient to combat any claims of right or interest in a domain name. *See Christian Dior Couture & Chloe v. Zourmas*, D2008-1440 (WIPO December 22, 2008).

## FINDINGS

Complainant is the owner of the PFISTER family of trademarks used in connection with a variety of products and services. Complainant and its predecessors in interest have used the PRICE PFISTER and PFISTER mark in commerce continuously since at least as early as 1935. Complainant has also extensively used its PFISTER brand in connection with, *inter alia*, plumbing and electrical fixtures, valves and faucets since at least as early as 2010. Complainant claims rights in the PFISTER mark through its registration of the mark with the USPTO (e.g., Reg. No. 4,180,949, registered Jul. 24, 2012).

Respondent, Liu Yun Yun, registered the domain name <pfister.design> (the “Disputed Domain Name”) on August 11, 2016.

The Disputed Domain Name incorporates Complainant’s entire PFISTER mark and is identical or confusingly similar to the PFISTER Marks pursuant to Policy ¶ 4(a)(i). Although the Response references the alleged activities of Qingdao Topbide Machinery Co., Ltd., that entity is not the respondent in these administrative proceedings. The respondent is Liu Yun Yun. The Respondent has adduced no evidence to show any right or legitimate interest in the Disputed Domain Name.

The Response does not meet the mandatory requirements of Rule 5(c), in that it does not, *inter alia*, conclude with the signature of the Respondent and a certification that the information contained in the Response is, to the best of Respondent's knowledge, complete and accurate and is not being presented for any improper purpose.

## DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### Identical and/or Confusingly Similar

A domain name which fully incorporates a complainant's mark, with the only addition being a top-level domain relevant to the complainant's business, may be found to be identical to the mark under Policy ¶ 4(a)(i). *See Avaya Inc. v. Robert Bird*, FA 1603045 (FORUM Mar. 12, 2015) ("The Panel agrees that the disputed domain names are confusingly similar to the AVAYA mark pursuant to Policy ¶ 4(a)(i) as the added terms are descriptive of and related to Complainant's offerings, and in the cases of <avaya.help>, and <avayaphone.systems>, the



added gTLD adds to the confusion . . .”). Here, Complainant notes that the “.design” mark is relevant to Complainant’s business. For the foregoing reasons, the Panel finds that the Disputed Domain Name is identical or confusingly similar to Complainant’s mark.

Complainant has satisfied the first element under Policy ¶ 4(a)(i).

### Rights or Legitimate Interests

The Complaint alleges that Respondent does not have any rights or legitimate interests in the Disputed Domain Name and that Respondent’s failure to make any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services shows a lack of legitimate rights to the Disputed Domain Name pursuant to Policy ¶ 4(c)(i). Moreover, Respondent has no legitimate right to the Disputed Domain Name in that it has not used or received permission to use the mark and is not commonly known by the mark pursuant to Policy ¶ 4(c)(ii). Furthermore, Respondent is not using the Disputed Domain Name for a legitimate non-commercial or fair use pursuant to Policy ¶ 4(c)(iii), because Respondent registered an identical version of the PFISTER Marks and has not placed any content on the website.

It is well established under UDRP jurisprudence that a complainant must first make out a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), then the burden shifts to the respondent to show it does have rights or legitimate interests. *See 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 ¶ 4(a)(ii)); *see also Neal & Massey Holdings Limited v. Gregory Ricks*, FA 1549327 (FORUM Apr. 12, 2014) (“Under Policy ¶ 4(a)(ii), Complainant must first make out a *prima facie* case showing that

respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to respondent to come forward with evidence of its rights or legitimate interests”).

The Panel finds that Complainant has made out a *prima facie* case that Respondent lacks rights and legitimate interests in the Disputed Domain Name under Policy ¶ 4(a)(ii), and that Respondent has failed to meet its burden to show it does have rights or legitimate interests thereto.

The Panel finds that Respondent’s Response does not meet the mandatory requirements of Rule 5(c), in that it does not, *inter alia*, conclude with the certification and signature of the Respondent that the information contained in the Response is, to the best of Respondent’s knowledge, complete and accurate and is not being presented for any improper purpose. In fact, it is unclear whether the Response was submitted by the Respondent in these proceedings, Liu Yun Yun, or by Topbide, a supposed Chinese business entity whose relationship to these proceedings, if any, is not specified in the Response.

Even assuming, *arguendo*, that the Response was submitted in the form required by Rule 5, Respondent has adduced no evidence whatsoever to show it does have rights or legitimate interests in the Disputed Domain Name. Rather, the unsigned and uncertified Response sets forth mere unsubstantiated assertions about how the Respondent, Topbide, or both, plan to use the Disputed Domain Name at some unspecified future time.

The Panel finds on Complainant’s evidence that Respondent has failed to make any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services from the time the Disputed Domain Name was registered more than four (4) years ago, and that Respondent has

failed to meet its burden to show it does has rights or legitimate interests in the Disputed Domain Name.

Complainant has satisfied the second element under Policy ¶ 4(a)(ii).

### **Registration and Use in Bad Faith**

Respondent contends in its unsigned and uncertified Response that it did not know of the PFISTER brand when it registered the Disputed Domain Name. Complainant contends, and the Panel agrees, that Respondent's allegation of ignorance defies logic, given the uniqueness and worldwide notoriety of the PFISTER brand. *Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000) (finding bad faith where the domain name in question is obviously connected with the complainant's well known marks, thus creating a likelihood of confusion strictly for commercial gain). Complainant correctly observes that the plausibility of a respondent's denial of knowledge of a complainant's business or trade name when it registered the domain name diminishes as the fame or notoriety of the complainant increases. *Betco Corporation, Ltd. v. R. Zimmerman / envirozymes*, FA1787028 (FORUM, June 25, 2018).

Complainant's PFISTER mark is not a common term, but heralds back to William Pfister, who along with Emil Price, founded the Price Pfister business in 1910. The Panel considers that Pfister is a unique and rare family name. There is no definition for the term in the dictionary. Complainant observes that a simple Google™ search would bring up Complainant's Pfister product line as the first result.

Complainant alleges that Respondent's registration of the Disputed Domain Name was in bad faith pursuant to Policy ¶ 4(b)(ii) because at the time the name was registered, Respondent knew of Spectrum's rights and "engaged in a pattern

of such registration” to prevent Spectrum from using the Domain Name. The Panel rejects this assertion, as Complainant has adduced no evidence of other infringing domain name registrations by Respondent which might reflect a pattern of bad faith registrations.

Notwithstanding the absence of proof the Respondent has engaged in a pattern of infringing registrations, the Panel finds nonetheless that Respondent registered and used the Disputed Domain Name in bad faith, for the following reasons:-

- 1) Complainant’s PFISTER mark has a strong reputation and is widely known, as evidenced by its substantial use;
- 2) Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the Disputed Domain Name;
- 3) Respondent has taken active steps to conceal its true identity, by seeking to interpose “Topbide” into these proceedings and failing to sign or certify its Response or to confirm Respondent’s correct identity and contact details, as required by Rule 5; and,
- 4) Under all the circumstances, it is not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain Name by Respondent that would not be illegitimate. *See Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO February 18, 2000).

The Panel sees no relevance or connection to these proceedings in Respondent’s “evidence”, which includes, *inter alia*, a number of photographs and a design schematic of heavy, sophisticated grinding machines strewn across vast factory floors. The text of the Response appears above the printed Topbide name, and not the name of Respondent, but is not affixed with the corporate seal or “chop” of Topbide (or any other entity, legal representative or person), as

would be typical, in the Tribunal's experience, for a business letter or other corporate document under Chinese law and procedure. Further, the Response includes the allegation that the Respondent, Liu Yun Yun, is a founding shareholder of Topbide, however, there are no exhibits, no references to websites, and no declaratory evidence to establish the connection.

The Panel finds that the Respondent has failed to adduce any evidence whatsoever of any demonstrable preparations by the Respondent to utilize the Disputed Domain Name and that, under all the circumstances, it is not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain Name by Respondent that would not be illegitimate.

For the reasons recited above, the Panel finds that Respondent registered and is using the Disputed Domain Name in bad faith.

Complainant has satisfied the third element under Policy ¶ 4(a)(iii).

## **DECISION**

Complainant having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <pfister.design> domain name be **TRANSFERRED** from Respondent to Complainant.

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David L. Kreider, Panelist  
Dated: December 31, 2020