

## **ADMINISTRATIVE PANEL DECISION**

Itron, Inc. v. The Senior Junior Holding B.V., Senior Holdig  
Case No. D2022-1914

### **1. The Parties**

The Complainant is Itron, Inc., United States of America (United States or U.S.), represented by Lee & Hayes, PC, United States.

The Respondent is The Senior Junior Holding B.V., Senior Holdig, Netherlands.

### **2. The Domain Name and Registrar**

The disputed domain name <actaris-meters.com> (the “Disputed Domain Name”) is registered with Mijn InternetOplossing B.V. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 26, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 30, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 30, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on May 31, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”). Informal communications were received on May 30 and May 31, 2022 from a company called ITT Controls B.V. It would appear that this company had been copied in on various emails from the Complainant’s representatives to the Center (see further below).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 6, 2022.

The Center appointed Nick J. Gardner as the sole panelist in this matter on July 21, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a U.S. corporation which offers products and services involving energy and water resource management. It operates via subsidiary companies throughout the world. In 2007 the Complainant acquired Actaris SAS (“Actaris”), a French corporation which produces metering products. Actaris was active in the design and manufacture of metering technology for electricity, gas, and water metering, was established in 2001 and has been active since. The Complainant registered a Trademark ACTARIS on December 13, 2022 in International Classes 9, 35, 38, and 42. The Complainant has a pending U.S. trademark application for the word “actaris”. Various subsidiary companies within the Complainant’s group own registered trademarks for the word “actaris” – see for example South African Registration No 2001/20354 registered in Class 9 by Itron France. These registered trademarks are referred to in this decision as the “ACTARIS trademark”.

The Disputed Domain Name was registered on October 22, 2018. It is linked to a website (the “Respondent’s Website”) which appears to promote the sale of metering equipment made by the Complainant and also competing equipment made by third parties. The Respondent’s Website appears to be operated by a Dutch company called ITT Controls B.V.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant’s case can be summarized as follows.

- a) The Disputed Domain Name is confusingly similar to the ACTARIS trademark.
- b) The Respondent does not have any rights or legitimate interests in the Disputed Domain Name.
- c) The Respondent has registered and used the Disputed Domain Name in bad faith. The Complainant says the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by use of domain name confusingly similar to the Complainant’s ACTARIS trademark. It says the Respondent has unfairly tried to take advantage of the ACTARIS trademark.

##### **B. Respondent**

No formal Response has been filed. It would seem likely that the Respondent represents or is connected with ITT Controls B.V. given that company appears to operate the Respondent’s Website. The informal communications received from ITT Controls B.V. (see above) indicate it was aware of the present proceeding but did not appear to consider it needed their attention – for example one of two emails received on May 31, 2022 stated “DONT waste our time With your nonsense. You dont have better things to do ? People got Paid for this ? GET LOST IDIOTS. Please feel free to contact us if you have any questions”.

#### **6. Discussion and Findings**

##### **Preliminary Matters**

The Panel notes that no formal Response has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel

considers that this satisfies the requirement in paragraph 2(a) of the Rules to “employ reasonably available means calculated to achieve actual notice”. It is also the case that ITT Controls B.V. is aware of this proceeding (see above). Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any formal Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

### **Substantive Matters**

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements in respect of the Disputed Domain Name:

- (i) the Disputed Domain Name is identical to or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Disputed Domain Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has rights in the ACTARIS trademark. The Complainant’s U.S. trademark application does not suffice for these purposes (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)” section 1.1.4). The Panel is however satisfied that other companies within the Complainant’s group hold registered trademarks in respect of the ACTARIS trademark and that the Complainant’s position as parent company provides it with standing to bring the Complaint (see [WIPO Overview 3.0](#) at section 1.4).

The Panel finds the Disputed Domain Name is confusingly similar to the ACTARIS trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (*DHL Operations B.V. v. DHL Packers*, WIPO Case No. [D2008-1694](#)).

It is also established that the addition of a term (such as here “meters”) to a disputed domain name has little, if any, effect on a determination of confusing similarity between the domain name and the mark (*Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO Case No. [D2000-0253](#)); furthermore, the mere addition of such term – the relevant mark still being readily recognizable – does not prevent a finding of confusing similarity under the first element (*PRL USA Holdings, Inc. v. Spiral Matrix*, WIPO Case No. [D2006-0189](#)).

It is also well established that the generic Top-Level Domain (“gTLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that demonstrate a right or legitimate interest in a domain name:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a 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 Complainant has not authorized, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the ACTARIS trademark. The Complainant has rights in the ACTARIS name and mark which (owing to its 2007 acquisition of Actaris, itself founded in and trading since 2001) precede the Respondent’s registration of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce relevant evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see for example *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish any rights or legitimate interests in the Disputed Domain Name. The Panel has considered the fact that the Respondent’s Website appears to involve the resale of the Complainant’s products as well as third party products. Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to promote or undertake sales related to the complainant’s services may be making a *bona fide* offering of services and thus have a legitimate interest in such domain name. This principle is outlined in the well-known “Okidata test” – see *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) which establishes the following cumulative requirements will be applied if a legitimate interest is to be shown in such circumstances:

(i) The respondent must actually be offering the goods or services at issue.

(ii) The respondent must use the site to sell only the trademarked goods or services.

(iii) The site must accurately and prominently disclose the registrant’s relationship with the trademark holder. In this case, the website to which the disputed domain name points do not make it clear that the websites are operated by a company other than the Complainant.

(iv) The respondent must not try to “corner the market” in domain names that reflect the trademark. In this case, the Respondent has registered multiple domain names, containing the ACTARIS trademark.

In the present case criteria (ii) and (iii) are not met and hence the case does not meet the requirements established in the “Okidata test”.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

### **C. Registered and Used in Bad Faith**

In the present circumstances the Panel concludes that the Respondent chose to register a name confusingly similar to the Complainant’s trademark in order to facilitate a business where the Respondent’s Website could offer for sale not only goods provided by the Complainant but also goods from third parties directly competing with those offered by the Complainant. Manifestly the choice of name was not coincidental.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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.”

In the present circumstances the Panel agrees with the Complainant that factor (iv) applies as the Respondent was seeking to attract customers by creating a likelihood of confusion with the Complainant’s ACTARIS trademark. The Disputed Domain name clearly gives the impression that the Respondent’s Website is likely to be a website operated by or with the permission of the Complainant when that is not the case. The Panel also notes that the Respondent has not filed a formal Response and hence has not availed itself of the opportunity to present any case of good faith that it might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4 of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <actaris-meters.com>, be transferred to the Complainant.

*/Nick J. Gardner/*

**Nick J. Gardner**

Sole Panelist

Date: August 4, 2022