

## **ADMINISTRATIVE PANEL DECISION**

Itron, Inc. v. Super Privacy Service LTD c/o Dynadot / Nanci Nette, Name Management Group  
Case No. D2022-1920

### **1. The Parties**

The Complainant is Itron, Inc., United States of America (“United States”), represented by Lee & Hayes, PC, United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Nanci Nette, Name Management Group, United States.

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

The disputed domain name <actaris.com> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 27, 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 June 1, 2022.

The Center verified that the Complaint together with the amendment to the 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 30, 2022.

The Center appointed David H. Bernstein as the sole panelist in this matter on July 12, 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.

After initial review of the case file including the Registrar's verification response, the Panel was unable to determine the date on which the Respondent registered the disputed domain name (a fact critical to the assessment of bad faith registration). Accordingly, the Panel issued an Administrative Panel Procedural Order on July 13, 2022, requesting that the parties specifically address the ownership and use history of the disputed domain name, and identify when the Respondent registered the disputed domain name. The Complainant submitted a declaration as well as supplemental exhibits on the evening of July 18, 2022. The Respondent did not submit any additional declarations or evidence by the requested deadline of July 21, 2022.

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

The following facts alleged in the Amended Complaint and Supplemental Submission and evidenced by the record are accepted as true for purposes of this proceeding because the Respondent has not filed a Response, and because the assertions of fact are specific and supported. Rules, paragraph 14(b); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

The Complainant owns and operates a technology company that focuses on energy and water resource management. In 2007, it acquired Actaris, a company that has specialized in metering technology in the water, gas, and electricity space since its establishment in 2001. Since its acquisition by the Complainant, Actaris has continued to operate under its original "Actaris" name.

The Complainant owns a number of trademark registrations, including in France (Reg. No. 999634), Germany (Reg. No. 302021117283), Chile (Reg. No.999634), and South Africa (Reg. Nos. 2001/20354, 2001/20355, 2001/20356, and 2001/20357), and an allowed intent-to-use application in the United States (serial number 97/099,684). The Panel's review of the United States Patent and Trademark Office database also shows that the Complainant had a United States registration that was issued in 2003 (Reg. No. 2,699,744), but that registration expired in 2013 when the registration was not renewed at the ten-years-deadline for renewal. The Complainant also owned a registration for ACTARIS EASY that was issued in 2008 (Reg. No. 3,480,952); that registration was cancelled in 2017 when the international registration on which it was based was not renewed.

The disputed domain name <actaris.com> was created on May 1, 2000. The Complainant asserts that the domain name was originally registered and owned by Actaris (and later owned and used by the Complainant once the Complainant acquired Actaris in 2007), and used in association with its metering technology, continuing use of the domain name through at least February 2, 2012. The Complainant further asserts that in or about 2014, the Respondent acquired the disputed domain name.

At the time the Complaint was filed, the disputed domain name allegedly resolved to malware download websites, as well as a website linking to websites selling products and services in direct competition with the Complainant. As of July 12, 2022, the disputed domain name resolved in the United States to a website containing pornographic images.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant alleges that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant alleges that the ACTARIS mark has been in use since 2001 when Actaris was established, and has been used by the Complainant since the Actaris company was acquired by the Complainant in 2007. The Complainant alleges that it has consistently and continuously used its ACTARIS marks and advertises and sells its goods and services worldwide under its ACTARIS marks. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark because it incorporates the mark in which the Complainant has trademark rights in its entirety without any deletions, additions, or other modifications.

The Complainant further alleges that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Complainant states that the Respondent does not hold any trademarks for the term "Actaris," was never previously known by the name "Actaris," and does not have a license or any sort of permission from the Complainant to use the Complainant's ACTARIS marks in a domain name. The Complainant additionally alleges that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, but instead is using the disputed domain name to redirect users to a malware download website, as well as a website containing links to websites in direct competition with the Complainant.

Finally, the Complainant submits that the disputed domain name was registered and is being used by the Respondent in bad faith. The Complainant alleges that the Respondent registered the disputed domain name in or around 2014, long after the Complainant adopted its trademark in 2001, and that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's site or other on-line location by creating a likelihood of confusion with the Complainant's ACTARIS marks. The Complainant further alleges that it can be reasonably inferred that the Respondent knew of the Complainant's ACTARIS marks since the disputed domain name redirects users to a website containing links to websites in direct competition with the Complainant.

For these reasons, the Complainant asks the Panel to transfer the disputed domain name to the Complainant.

### **B. Respondent**

The Respondent did not reply to the Complainant's contentions and also did not respond to the Panel's request for information concerning the ownership and use history of the disputed domain name.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that, in order to succeed in its claim, the Complainant must prove each of the following three elements:

- first, the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- second, the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- third, the disputed domain name has been registered and is being used in bad faith.

In the absence of a response, the Complainant must still prove each of these elements by a preponderance of the evidence. [WIPO Overview 3.0](#), section 4.3.

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

The Complainant owns trademark registrations for the word mark ACTARIS. Those registrations *prima facie* satisfy the threshold requirement of having trademark rights for purposes of the first element of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name is identical to the Complainant's registered trademarks as it incorporates the Complainant's mark in its entirety with no modification whatsoever.

Accordingly, the Panel finds that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

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

In this instance, the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has registered a domain name that is identical to the Complainant's mark and used it to offer goods and services that directly compete with the Complainant's business. That is not a *bona fide* offering of goods or services. There is no indication in the record that the Respondent is commonly known by the name "Actaris," and neither the disputed domain name nor the website it hosts suggest any possible fair use of the Complainant's mark.

Because the Respondent elected to not reply to Complainant's contentions, the Respondent has not rebutted this *prima facie* showing. Therefore, the Complainant has satisfied its burden of proving that the Respondent lacks rights or legitimate interests in the disputed domain name.

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

In assessing bad faith registration, a critical fact is when the Respondent registered the disputed domain name. The record on that was not clear. Although the Registrar's verification indicates that the disputed domain name was created in 2000, it appears to have initially been registered and used by the Complainant. In or around 2014, it appears that the Respondent acquired the disputed domain name, though the Complainant has not explained how it lost the disputed domain name.

The evidence submitted by the Complainant is sufficient to support an inference that the Complainant probably allowed the disputed domain name to lapse in or about 2014, and that the Respondent thereafter registered the name. Since that was more than a decade after the Complainant's adoption of the ACTARIS mark, and since the disputed domain name had previously been used for a website that promoted the Complainant's ACTARIS business, and since the ACTARIS mark is distinctive and was protected by trademark registrations at that time, the Respondent's registration of the disputed domain name and its subsequent use of the disputed domain name for advertising links that offer services that compete with the Complainant, for malware, and for pornography, is paradigmatic bad faith.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <actaris.com> be transferred to the Complainant.

*/David H. Bernstein/*

**David H. Bernstein**

Sole Panelist

Date: July 26, 2022