

ADMINISTRATIVE PANEL DECISION

Zurn Water Solutions Corporation, Zurco, Inc., and Elkay Manufacturing Company v. Registrant of the Domain Name <zurnelkay.com> / Marksmen, Inc.

Case No. D2022-1963

1. The Parties

Complainants are Zurn Water Solutions Corporation, Zurco, Inc., and Elkay Manufacturing Company, United States of America, represented by Quarles & Brady LLP, United States of America (“United States”)

Respondent is Registrant of the Domain Name <zurnelkay.com>, United States / Marksmen, Inc., United States¹.

2. The Domain Name and Registrar

The disputed domain name <zurnelkay.com> is registered with Amazon Registrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 30, 2022. On May 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 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 Complainant on June 3, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant chose not to file any amendment to the Complaint on June 13, 2022.

The Center verified that 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”).

¹ The Panel notes that the Complaint identified the Respondent as “Registrant of the Domain Name <zurnelkay.com>”, while the publicly available Whois reflected the registrant name and organization as, “On behalf of zurnelkay.com owner, Whois Privacy Service”. While the Registrar has disclosed the underlying registrant as, “Marksmen, Inc.”, the Complainant has chosen not to amend the Complaint to reflect the information disclosed by the Registrar. In response to the disclosed information, Complainant stated, “We contacted Marksmen (the listed registrant below) but were informed that the domain is no longer in their control”.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on June 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 12, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on July 22, 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

Complainants Zurn Water Solutions Corporation, Zurco, Inc., and Elkay Manufacturing Company ("Complainants", "Zurn", "Zurco", or "Elkay") are plumbing manufacturing companies. Zurn began manufacturing plumbing products in 1900 and has grown to become an industry leader for a wide variety of plumbing parts and fixtures. Zurco is a subsidiary of Zurn. Elkay was founded as a family company in 1920 and is now an industry leader focused on drinking water products and sinks. Zurn and Zurco began using the ZURN name at least as early as 1902. Elkay began using the ELKAY name at least as early as 1957. For decades, Complainants have continuously maintained their respective ZURN and ELKAY brand and trademarks through extensive use and protection. Complainants' brand, trade names, and other intellectual property are the result of significant investment. On February 14, 2022, Zurn and Elkay publicly announced that they would be combining their respective companies and that the combined company's new name would be "Zurn Elkay Water Solutions Corporation."

Complainants own incontestable trademark registrations for their ZURN and ELKAY marks (the "Marks"), with registration details as follows:

- ZURN, United States Trademark Reg. No. 534,984, registered on December 19, 1950;
- ELKAY, United States Trademark Reg. No. 685,393, registered on September 22, 1959.

Complainants have continuously used the Marks in connection with plumbing products for over 60 years. Complainants also own and operate the <zurnwatersolutions.com>, <zurn.com>, and <elkay.com> domain names, which they have continuously used in commerce since at least as early as 2021, 1995, and 1995, respectively.

The disputed domain name was registered on February 14, 2022. Currently, <zurnelkay.com> returns an effort message indicating that the site cannot be reached, and that the domain's server IP address could not be found. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

According to Complainants, the disputed domain name is identical or confusingly similar to Complainants' ZURN and ELKAY trademarks in which Complainants have rights as demonstrated through their cited registrations. The Marks were adopted and have been continuously used since at least as early as 1902 and 1957, respectively, in connection with plumbing products. Complainants maintain their online presence through their websites hosted at their domain names <zurnwatersolutions.com>, <zurn.com>, and <elkay.com>.

Complainants argue that the disputed domain name fully incorporates the Marks. Complainants argue that, due to the complete reproduction of Complainants' company names and prior established registered and incontestable trademarks, Internet users will obviously and wrongly think that the disputed domain name

belongs to Complainants or has been registered in their name. Complainants argue that a likelihood of confusion is therefore undeniable and is reinforced by the public announcement of the merger of Complainants' companies.

Complainants assert that Respondent lacks any rights or legitimate interests in the disputed domain name. According to Complainants, Respondent does not have any trademark rights to the Marks. Complainants allege that Respondent is using the disputed domain name to either profit from the sale of the domain name to Complainants, to prevent Complainants from obtaining the domain, to disrupt the Complainants' business, and/or to attract Internet users to Registrant's site for commercial gain and create a likelihood of confusion with Complainants' business. Complainants also assert that they have not granted Respondent, by license or otherwise, permission to use the Marks in any way. Complainants argue that the disputed domain name was registered by Respondent without Complainants' consent.

Complainants argue that Respondent both registered and is using the disputed domain name in bad faith. According to Complainants, Respondent registered and used the disputed domain name intentionally in an attempt to attract Internet users to its website for financial gain by creating a likelihood of confusion with Complainants' Marks. Complainants argue that Respondent intends to attract Internet users and consumers looking for Complainants' goods and/or authorized partners to Respondent's own website for Respondent's illicit commercial gain. Complainants argue that Respondent could not have been unaware of the existence of Complainants' established trademarks when registering the disputed domain name. Complainants argue that the mere fact that Respondent has registered the disputed domain name which incorporates the entirety of the established and prevalent ZURN and ELKAY Marks is alone sufficient to give rise to an inference of bad faith. Complainants argue that Respondent knowingly selected and maintained the domain name – not to use it to render any *bona fide* goods or services in commerce – but to unfairly capitalize on Complainants' trademark rights. Complainants argue that such actions clearly show the domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainants have rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainants' contentions, the burden remains with Complainants to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainants have provided evidence that they own incontestable trademark registrations for the ZURN and ELKAY trademarks as referenced above. Therefore, Complainants have established that they have rights in the Marks.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainants’ mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name incorporates the entirety of each of the Marks, only combining them together. A side-by-side comparison of the Marks and the disputed domain name reveals that the Marks are easily identifiable within the disputed domain name.

Therefore, the Panel finds that Complainants have satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing their trademark rights and showing that the disputed domain name is confusingly similar to their ZURN and ELKAY marks.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainants must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainants make such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainants. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainants will have sustained their burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainants have alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainants’ contention that Respondent is not an assignee or licensee of Complainants and that Respondent has no other business relationship with Complainants. Complainants have contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to

demonstrate that it has such rights.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 respondent's documented out-of-pocket costs directly related to the domain name; or

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

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Here, Respondent's actions do not necessarily align with any of the above-referenced examples, though these are considered to be non-exhaustive. The disputed domain name does not resolve to an active website and thus is passively held. As found in the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), the passive holding of a domain name does not necessarily prevent a finding of confusing similarity under certain circumstances.

The disputed domain name contains the entirety of the ZURN and ELKAY Marks. Due to the established and storied nature of Complainants' brands, evidenced by their incontestable, decades-old trademark registrations for the Marks, along with the unauthorized use of the Marks in the disputed domain name, Respondent was undoubtedly aware of Complainants and the Marks when it registered the disputed domain name. Respondent's use of the Marks in the disputed domain name, fully incorporating Complainants' Marks, and registration of the disputed domain name mere minutes after the public announcement of a merger of Complainants' companies, clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name. Moreover, Respondent has not participate in this proceeding, failing to offer any plausible good-faith explanation for its registration of the disputed domain name.

This Panel therefore finds that Respondent's passive holding of the disputed domain name does not prevent a finding of 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, <zurnelkay.com> be transferred to the Complainants.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: August 5, 2022