Decision for dispute CAC-UDRP-102603

Case number	CAC-UDRP-102603
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Domain names	hitachifoundation.org

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Hitachi, Ltd.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	William Cooper

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Trademark: HITACHI
Jurisdiction: USA
Registration No.: 0701266
Registration Date: 1960-07-19

Trademark: HITACHI
Jurisdiction: Japan
Registration No.: 1492488
Registration Date: 1981-12-25

Trademark: HITACHI
Jurisdiction: EUTM
Registration No.: 000208645
Registration Date: 1999-12-21

Trademark: HITACHI
Jurisdiction: EUTM
Registration No.: 001070192
Registration Date: 2000-09-19

Trademark: HITACHI
Jurisdiction: EUTM
Registration No.: 002364313
Registration Date: 2002-11-27

Trademark: HITACHI
Jurisdiction: EUTM
Registration No.: 002809903
Registration Date: 2003-10-03

Trademark: HITACHI
Jurisdiction: United Kingdom
Registration No.: UK00000811836
Registration Date: 1960-10-11

FACTUAL BACKGROUND

The Complainant is a Japanese multinational company that offers innovative, world class consumer, business, government products, and services. Hitachi's products range from telecommunications and infrastructure solutions to construction machinery and electronic systems and equipment. The Complainant is commonly referenced as the "Hitachi Group", comprised of Hitachi, Ltd. and hundreds of subsidiaries present on a global scale. The Hitachi Group currently employs over 300,000 people worldwide and provides products and services around the globe. Information about both Complainant and the Hitachi Group in general, including details on their respective products can be found at the website <hitachi.com> ("Complainant's Website").

Hitachi was founded in 1910, and has continuously used the HITACHI mark in global commerce since then -- for well over 100 years. Hitachi has also registered the HITACHI mark in numerous jurisdictions throughout the world, including but not limited to the United States, European Union, and Japan.

The Complainant held:

The disputed domain name currently resolves to a website that is solely devoted to advertising the "Penimaster Pro" a device that purports to increase a man's penis size. The website describes the device as "an extender device that you wear on your man parts to try an increase it's size." The website also displays a grainy photo of the device at the top of the page, and contains sections explaining what it purportedly is and does, compares it to purportedly competing products, contains an embedded video on how to use the device, and answers "frequently asked questions." Id. The website serves no purpose other than to advertise and promote this purported device. By connecting the proud Hitachi and Hitachi Foundation names to this website, the Respondent has obviously tarnished those famous and beneficent brands, solely for Respondent's own prurient and/or petulant interests.

PARTIES CONTENTIONS

The Respondent held that that his intentions with the disputed domain name were not malicious or meant to diminish the Hitachi name so he apologize if it appears that way. Secondly, he stated that he is complying with the request for the return of the disputed domain name.

RIGHTS

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The burden to establish confusing similarity is low, but in this case is extremely obvious. Research in Motion Limited v. One Star Global LLC, Case No. D2009-0227 (WIPO Apr, 9, 2009). A showing of confusing similarity only requires a "simple comparison of the mark relied upon with the domain name in issue." Id. Here, a simple comparison of the HITACHI mark and the disputed domain name demonstrates that the disputed domain name is not only confusingly similar, but nearly identical to the HITACHI mark. The disputed domain name is comprised of the HITACHI trademark (in its entirety) merely adding the generic term 'foundation'.

It is well established that the incorporation of a well-known trademark within a domain name (as is the case here) is alone enough to sustain a finding of confusing similarity. See, e.g., Fujitsu Ltd. v. Thomas Ruben, Case No. 101592 (CAC Jul. 18, 2017) (finding the <fujitsu-global.com> domain name confusingly similar to complainant's FUJITSU mark); Apollo Education Group, Inc. v. gaurav negi, Case No. 102323 (CAC Mar. 7, 2019) (finding <universityofphoenixlogins.com> confusingly similar to UNIVERSITY OF PHOENIX and THE UNIVERSITY OF PHOENIX); SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L., Case No. D2008-0792 (WIPO Jul. 8, 2008) (finding the domain name <myhostingfree.com> to be confusingly similar to complainant's MYHOSTING mark, stating, "This similarity is established whenever a mark is incorporated in its entirety, regardless of other terms added to the domain name."); Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., Case No. D2000-1525 (WIPO Jan. 29, 2001) (finding confusing similarity between numerous "magnum"-formative domains and complainant's MAGNUM trademark).

Moreover, the mere addition of a generic term to a trademark does not avoid a finding of confusion. Sharman License Holdings, Limited v. Mario Dolzer, Case No. D2004-0935 (WIPO Jan. 31, 2006); see also, e.g. Fujitsu Ltd. v. Thomas Ruben, Case No. 101592 (CAC Jul. 18, 2017) (stating, "It is well established that the addition of a generic term to a trademark does not avoid a finding of confusion."). In fact, recent UDRP decisions have specifically found that the addition of the term 'foundation' does not avoid a finding of confusingly similarity. See e.g. Alibaba Group Holding Limited v. Huang Guofeng, Case No. D2018-2450 (WIPO Dec. 28, 2018) (finding <jackmafoundation.com> and <jackmafoundation.org> confusingly similar to complainant's rights in JACK MA); Virgin Enterprises Limited and Virgin Limited Edition v. Moore Williams, Case No. D2018-2210 (WIPO Nov. 22, 2018) ("Similarly, the Domain Name <virginunitefoundation.com> is confusingly similar to the VIRGIN UNITE trademark. The mark is incorporated in its entirety in the Domain Name, adding the generic term "foundation", which does not avoid confusing similarity.").

Further, the addition of the generic top-level domain ".org" does nothing to distinguish the disputed domain name from Complainants mark. See Alibaba Group Holding Limited v. Huang Guofeng, Case No. D2018-2450 ("The addition of the gTLD extension ".com" and ".org" in domain names may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark . . ."); Open Society Institute v. Admin Contact, PrivateName Services Inc. / Axel Feldt, Case No. D2018-0816 (WIPO Jun. 13, 2018).

A simple comparison of the HITACHI mark and the disputed domain name demonstrates that the two are confusingly similar, and any addition of a generic term or top-level domain are negligible. Therefore, Complainant has established the first element of the Policy under paragraph 4(a).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

The second element of a UDRP claim only requires that a complainant make a prima facie showing that respondent lacks a right or legitimate interest in a domain name. Accor v. Eren Atesmen, Case No. D2009-0701 (WIPO Jul. 10, 2009). Once a complainant has made such a showing, the burden shifts to the respondent to demonstrate that it has rights or legitimate interest in the disputed domain name. See, e.g., Mile, Inc. v. Michael Burg, Case No. D2010-2011 (WIPO Feb. 7, 2011).

In this case, it is clear that Respondent has no rights or legitimate interest in the disputed domain name. Respondent not only registered the disputed domain name many decades after Complainant's rights in the HITACHI mark were registered, but is using the disputed domain name to associate and disparage Hitachi and HGF. Conversely, Complainant has demonstrated longstanding, exclusive use of the HITACHI trademark, and Complainant's rights predate any registration or use of the disputed domain name by Respondent by almost 60 years.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

A respondent has registered and/or used a domain name in bad faith where the purpose of the registration is to cause confusion as to the source of a website or other service associated with the domain for respondent's pecuniary gain. Under Paragraph 4(b)(iv) of the Policy the panel may make a finding that the registrant has registered and used a domain name in bad faith where "by using the domain name, [the registrant has] intentionally attempted to attract, for commercial gain, Internet users to [its] 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 [registrant's] web site or location or of a product or service on [registrant's] web site or location." Respondent's use of the disputed domain name is confusing because it incorporates Complainant's HITACHI mark in its entirety (and is also similar to the HGF name), giving the impression that Respondent is somehow affiliated with Complainant, and is being used to advertise penis enhancing products, purportedly for Respondent's own commercial gain.

In Educational Testing Service v. Mohamed Ahmed Aljarwan the "disputed domain names resolved to identical websites which promoted and offered online sales of penis enlargement products and featured explicit photographs of nude men." Case No. D2008-1073 (WIPO Sept. 10, 2008). Similarly, "[t]here was no reference to the [complainant's] mark in the content of the websites and the websites offered no discernible reasons as to the Respondent's choice of the disputed domain names." Id. The panel found the domains were registered in bad faith, stating:

The offer of penis enlargement products on the website resolved by the disputed domain names appears calculated to generate financial gain for the Respondent. The deliberate use of various trade marks of the Complainant to attract traffic to the Respondent's websites created a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website (eg, Dell Computer Corp. v. Logo Excellence, WIPO Case No. D2001-0361).

Id.; see also Fibox Oy Ab v. Ville Muilu, Case No. D2007-1429 (WIPO Nov. 13, 2007) (finding a likelihood of confusion where "[t]he website contains links to another website that contains a web shop where visitors can buy pornographic videos, sex toys, and clothing accessories related to adult entertainment. Such usage is also apt to tarnish the Complainant's trademark and is evidence of bad faith usage."); see also e.g. Statoil ASA. v. Evgeny Pavlov, Case No. D2015-1582 (WIPO Oct. 30, 2015) ("The Complaint also submits evidence that the disputed domain name resolved to a site selling penis enlargement cream, which suggests an impermissible bad faith use for commercial profit.").

Respondent is using the disputed domain name to disrupt Complainant's business, for Respondent's benefit. Such use of the disputed domain name has the potential to result in media and consumer inquiries, which requires Complainant to devote valuable resources thereto and results in a disruption to Complainant's business and demonstrates Respondents bad faith use and registration of the disputed domain name. Moreover, the fact that Respondent has undertaken such actions well after Complainant's trademark rights arose in further evidence of a bad faith registration for the sole purpose of disrupting Complainant's business for Respondents own commercial gain.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision. The complaint cannot be dismissed regarding the apology of the Respondent as the parties have not settled the case.

PRINCIPAL REASONS FOR THE DECISION

The Respondent clearly registered and used a domain name similar to the well-known trademark of the Complainant. The offer of penis enlargement products on the website resolved by the disputed domain name appears calculated to generate financial gain for the Respondent and amounts to bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **HITACHIFOUNDATION.ORG**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2019-08-26

Publish the Decision