Decision for dispute CAC-UDRP-103663

Case number	CAC-UDRP-103663
Time of filing	2021-03-25 09:02:27
Domain names	hitachi-powergrlds.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Hitachi, Ltd.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	St Jude

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant was founded in 1910 and has continuously used the HITACHI mark in commerce since then. The Complainant further claims ownership of many active trademark registrations for the HITACHI mark including the following:

HITACHI, USA Reg No. 0701266 dated 1960-07-19;
HITACHI, Japan Reg. No. 1492488 dated 1981-12-25;
HITACHI, EUTM Reg. No. 000208645 dated 1999-12-21;
HITACHI, EUTM Reg. No. 001070192 dated 2000-09-19;
HITACHI, EUTM Reg. No. 002364313 dated 2002-11-27;
HITACHI, EUTM Reg. No. 002809903 dated 2003-10-03;
HITACHI, United Kingdom Reg. No. UK00000811836 dated 1960-10-11.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, a Japanese multinational company, was founded in 1919 and offers innovative, world class consumer, business, and government products and services. Hitachi Group's products range from telecommunications and infrastructure solutions to construction machinery and electronic systems and equipment. Among its many various commercial activities, the Complainant owns a company called Hitachi ABB Power Grids which provides services to power grid operators worldwide in the following broad areas; grid connectivity, operational efficiency, quality control, security, sustainability, and digital transformation.

The disputed domain names were created on October 12-13, 2020, respectively. These disputed domain names do not resolve to any website content. However, a phishing email has been sent to one of the Complainant's customers using an address that incorporates the <hitachi-powergrlds.com> domain name and which mimicks the personal email address of an employee of the Complainant's subsidiary company, Hitachi ABB Power Grids.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names 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).

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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

Multiple Respondents

The Whois records for the two disputed domain names identify different registrant names. However, the Complainant names these two registrants as the Respondents in this proceeding and requests that the domain names and the named Respondents be consolidated in a single UDRP proceeding.

Paragraph 4(f) of the Policy provides that "[i]n the event of multiple disputes between [a respondent] and a complainant, either [the respondent] or the complainant may petition to consolidate the disputes before a single Administrative Panel…." This is allowed where it "promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, reduces the potential for conflicting or inconsistent results arising from multiple proceedings, and generally furthers the fundamental objectives of the Policy." See, e.g., MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc., D2009-0985 (WIPO Sep. 28, 2009). Further, paragraph 3(c) of the Rules provides that "[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder." UDRP panels have looked to a variety of factors in determining whether multiple domain names are, in fact, of common ownership. WIPO Overview 3.0 at par. 4.11.2. Such factors as similarities in the Whois information, similar naming conventions in the disputed domain names, similar website resolution, etc. may lead to the conclusion that domain names with different registrant names are, nevertheless, owned by a single entity. See, e.g., Delta Dental Plans Association v. ICS INC., et al., D2014-0474 (WIPO June 16, 2014) (Consolidation of 31 domains allowed where "[t]he Panel notes that each of the disputed domain names follows an identical naming convention, namely (DELTA DENTAL marks + of + state name or two-letter state abbreviation); Cephalon Inc v. Whois Privacy Protection Foundation / Grigorij Minin, Whois Privacy Protection Foundation / Artem Bogdanov, and Alex Ivanov, Evgeny Shaposhniko, D2021-0497 (WIPO Apr. 22, 2021) (while the names of the registrants of the disputed domain names are different, one factor to consider in allowing consolidation "the Domain Names

were registered on two days, November 13, 2020 and November 20, 2020, with only seven days difference").

In the present case, the Registrant names for the disputed domain names differ. However, the naming pattern (i.e., the Complainant's trademark followed by a hyphen and a misspelling of the phrase "power grid)" is used. Further, both of the disputed domain names were registered just one day apart and neither resolves to any website. The Complainant also points out that some of the address and phone information in the relevant Whois records is false or non-functional. In view of these similarities between the disputed domain names the Panel finds it more likely than not that both of them are owned by the same person and the Respondent has not participated in this case to dispute the claim of common ownership. Thus, by a preponderance of the evidence presented, the Panel finds sufficient grounds to conclude that it would be equitable and procedurally efficient to permit the consolidation of the two disputed domain names into this single case.

The Panel is otherwise satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A. Each of the disputed domain names is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrates its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, 103255 (CAC Sep. 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).")

The Complainant has submitted screenshots from the European Union Intellectual Property Office website, the UK Intellectual Property Office, and a search page for Japanese trademark registrations as evidence that it owns rights to its asserted trademark. Such evidence has been held sufficient to satisfy the paragraph 4(a)(i) requirement that a Complainant demonstrate its ownership of trademark rights. See Margaritaville Enterprises, LLC v. Neil Wein, FA 1916531 (FORUM Nov. 9, 2020) ("It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights"). The disputed domain names, which were registered long subsequent to the existence of the Complainant's trademark rights, reproduce Complainant's trademark in its entirety and adding a hyphen plus a misspelling of the of the phrase "power grid" (either substituting a 'q' for the letter 'g' or an 'l' for the letter 'I'), as well as the ".com" TLD. Thus, the Complainant asserts that the second level of each of the disputed domain names is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain names are endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. See, e.g., Fujitsu Ltd. v. Thomas Ruben, 101592 (CAC Jul. 18, 2017) (finding the <fujitsu-global.com> domain name confusingly similar to complainant's FUJITSU mark).

Also, the extension ".com" typically adds no meaning to the second level of a disputed domain name and may be disregarded in the paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC Dec. 9, 2020) ("it is generally accepted that the addition of the top-level suffix in the domain name (e.g., '.com') is to be disregarded under the confusing similarity test").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the additions made thereto in the disputed domain names are insufficient to avoid a finding that each of them is identical or confusingly similar to the Complainant's trademark. Thus, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain names

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in a domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC Sept. 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests

in the domain name.

Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests to the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that “Respondent does not have, and never has had, Complainant’s permission to use the HITACHI trademark”. The Respondent has not participated in this case and so it does not contest this. As such, the Panel concludes that the Respondent is not affiliated with the Complainant, nor is it authorized or licensed to use the Complainant’s trademark or to seek registration of any domain name incorporating the aforementioned trademarks. Furthermore, the Whois records for the disputed domain names identify the Registrant as “St Jude” and “Greg Munoz”, respectively. There is no evidence that the Respondent is known otherwise. Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain names or that it has any rights to the Complainant’s trademark.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain names to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain names. Attempting to pass oneself off as a Complainant in phishing emails illegitimately seeking payment of certain customer invoices is not a bona fide offering of goods or services under paragraph 4(c)(i) or (iii) of the Policy. See Emerson Electric Co. v. Adilcon Rocha, FA 1735949 (FORUM July 11, 2017) (finding that the Respondent’s attempt to pass itself off as the Complainant through emails does not constitute a bona fide offering of goods or services and, as such, the Respondent lacked rights or legitimate interests in the disputed domain names). The Complainant claims that the Respondent has engaged in “an unsuccessful attempt to defraud the customer of Hitachi ABB Power Grids for pecuniary gain”. In support, it has provided a copy of an email, sent from an address using the format [name]@hitachi-powergrlds.com, that mimics the personal email address of one of the Complainant’s employees and seeks to have one of the Complainant’s customers make payment on certain outstanding invoices. The Complainant also notes that “the domain registrars and/or hosting companies have taken appropriate action to deactivate any further use of the Disputed Domains for nefarious purposes.” For its part, Respondent has filed no Response or made any other submission in this case to explain its actions or otherwise refute the Complainant’s claims. Therefore, the Panel finds that the Complainant has made out a prima facie case, which has not been rebutted, that the Respondent does not use the disputed domain names for any bona fide offering of goods or services under Policy paragraphs 4(c)(i) or (iii).

Further, the Complainant points out that the disputed domain names have never resolved to any website content. Resolving a disputed domain name to an error page or to no content at all is also not a bona fide use thereof. See Kohler Co. v xi long chen, FA 1737910 (FORUM Aug. 4, 2017) (where the disputed domain name resolves to an inactive webpage displaying the message “website coming soon!” the Panel held that the ”Respondent has not made a bona fide offering of goods or services, or a legitimate non-commercial or fair use of the domain.”) In light of the other circumstances of this case, the non-resolution of the confusingly similar disputed domain names leads the Panel to find further support for the conclusion that the Respondent does not have any rights or legitimate interests therein under Policy paragraphs 4(c)(i) or (iii).

For all of the above-stated reasons, this Panel finds, by a preponderance of the evidence, that the Respondent does not have any rights or legitimate interests in the disputed domain names under Paragraph 4(a)(ii) of the Policy.

C. The disputed domain names were registered and are being used in bad faith

The Complainant argues that the Respondent registered the disputed domain names in bad faith, as it had actual knowledge of the Complainant’s rights in its asserted trademarks at that time. Actual knowledge of rights in a trademark at the time of registering a disputed domain name is generally sufficient as a foundation upon which to build a case for bad faith under Policy paragraph 4(a)(iii), and can be demonstrated through such actions as a respondent’s use of a well-known mark in its disputed domain name or use of such domain name to send phishing emails to business partners of a Complainant. See AutoZone Parts, Inc. v. Ken Belden, FA 1815011 (FORUM Dec. 24, 2018) (the “Complainant contends that Respondent’s knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of

Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii).") See also Spectrum Brands, Inc. v. Guo Li Bo, FA 1760233 (FORUM Jan. 5, 2018) ("[T]he fact Respondent registered a domain name that looked identical to the SPECTRUM BRANDS mark and used that as an email address to pass itself off as Complainant shows that Respondent knew of Complainant and its trademark rights at the time of registration."). The Complainant claims that "the HITACHI mark is famous in Japan, the United States, and throughout the world" and then asserts that, in light of the widespread notoriety of its trademarks, along with the Respondent's use of one of the disputed domain names to send a fraudulent email to the Complainant's own customer, "[i]t can reasonably be inferred that Respondent was aware of Complainant's rights" in the asserted trademark. The Complainant submits into evidence screenshots of its own <hitachi.com> and <hitachiabb-powergrids.com> websites at which its products and services are promoted, as well as a copy of a July 1, 2020 press release announcing the Complainant's acquisition of the company ABB Ltd. It also submits a copy of the Respondent's phishing email which mimics the email address of one of the Complainant's employees and was sent to one of the Complainant's customers. Although the Panel does not feel that the Complainant's evidence, alone, supports the claim of widespread trademark fame (i.e., the effect of the Complainant's promotional efforts and their impact on consumers), the Panel does find that the Respondent's use of one of the disputed domain names to send a phishing email to the Complaint's customer does make it a near certainty that it registered the disputed domain names with actual knowledge of the Complainant's trademarks.

Next, the Complainant argues that the Respondent registered and uses the disputed domain names in bad faith under paragraphs 4(b)(iii) and (iv) of the Policy by engaging in a phishing scheme that disrupts the Complainant's business and is in pursuit of commercial gain based upon a likelihood of confusion with its trademarks. Using a disputed domain name to pass oneself off as a Complainant in emails attempting to further a phishing scheme is evinces bad faith disruption as well as the seeking of commercial gain based on trademark confusion under paragraphs 4(b)(iii) and (iv) of the Policy. See K. HOV IP, II, Inc. v. Jack Riley / pleasant travels and tours, FA 1929446 (FORUM Feb. 22, 2021) ("Impersonating a complainant by use of a complainant's mark in a fraudulent phishing attempt is disruptive and evinces bad faith registration and use.") See also, Qatalyst Partners LP v. Devimore, FA 1393436 (FORUM July 13, 2011) (finding that using the disputed domain name as an e-mail address to pass itself off as the Complainant in a phishing scheme is evidence of bad faith registration and use under paragraph 4(b)(iv) of the Policy). As noted above, the Complainant provides a copy of an email sent from an address that uses one of the disputed domain names to impersonate an employee of the Complainant's and attempts to have one of the Complainant's customers pay certain outstanding invoices. Further, the disputed domain names have been deactivated by the Respondent's registrars and/or hosting provider. The Respondent does not contest any of these assertions or evidence and, therefore, the Panel finds that the Respondent has both disrupted the Complainant's business and also sought commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source of its phishing email under paragraphs 4(b)(iii) and (iv) of the Policy.

Finally, the Complainant notes that the disputed domain names have never resolved to any websites and asserts that the failure to actively use a disputed domain name in this manner can be evidence of bad faith registration and use pursuant to paragraph 4(a)(iii) of the Policy. See Dermtek Pharmaceuticals Ltd. v. Sang Im / Private Registration, FA 1522801 (FORUM Nov. 19, 2013) (holding that because the respondent's website contained no content related to the domain name and instead generated the error message "Error 400- Bad Request," the respondent had registered and used the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy). As there is no evidence that the disputed domain name has resolved to any website content, the Panel finds further support for its holding that the Respondent registered and uses this disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HITACHI-POWERGRLDS.COM**: Transferred
2. **HITACHI-POWERQRIDS.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2021-04-30

Publish the Decision