

Decision for dispute CAC-UDRP-104030

Case number	CAC-UDRP-104030
Time of filing	2021-10-04 10:10:13
Domain names	hitachi-powergrids.org, hitachi--powergrids.com, hitachi-power-grids.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Hitachi, Ltd
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Complainant representative

Organization	RODENBAUGH LAW
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Respondent

Name	Saint Tommy
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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 owns a portfolio of trade marks consisting of the name HITACHI in multiple classes and numerous countries around the world, including the US trade mark HITACHI, registration number 0701266, first registered on 19 July 1960; the Japanese trade mark HITACHI, registration number 1492488, first registered on 25 December 1981; the EU trade marks HITACHI, registration number 000208645, first registered on 21 December 1999; registration number 001070192, first registered on 19 September 2000; registration number 002364313, first registered on 27 November 2002; and registration number 002809903, first registered on 3 October 2003; and the UK trade mark HITACHI, registration number UK00000811836, first registered on 11 October 1960. The Complainant's trade mark registrations all predate the registration of the disputed domain names.

Furthermore, the Complainant owns multiple domain names consisting of and incorporating the name HITACHI, including <hitachiabb-powergrids.com> and <hitachi-powergrids.com>, which are all connected to the Complainant's official website at <hitachienergy.com> through which it informs Internet users and customers about its products and services in the energy sector.

FACTUAL BACKGROUND

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

The Complainant, Hitachi Ltd, is a Japanese multinational company that offers innovative, world class consumer, business, and government products and services. The Complainant was founded in 1910. Hitachi Group's products range from telecommunications and infrastructure solutions to construction machinery and electronic systems and equipment. The Complainant's group is commonly referenced as the "Hitachi Group", comprised of Hitachi Ltd, and subsidiaries present on a global scale. The Hitachi Group currently employs about 300,000 people worldwide and provides products and services around the globe. Among its commercial activities, the Complainant owns a company called Hitachi ABB Power Grids which provides services to power grid operators worldwide in the areas of grid connectivity, operational efficiency, quality control, security, sustainability, and digital transformation.

The disputed domain names were all registered in a time window between 10 February and 16 June 2021. The disputed domain names all currently resolve to error pages. There is no evidence before the Panel that any of the disputed domain names has ever been used for an active website since they were registered. However, the Complainant adduced evidence to show that some of the disputed domain names were used to send phishing e-mails to the Complainant's customers, seeking to impersonate employees of the Complainant's subsidiary Hitachi ABB Power Grids.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trade mark 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

The Complainant has pointed out that the present proceedings are linked to earlier proceedings in CAC case number 103663 (Hitachi Ltd -v- St Jude <hitachi-powergrlds.com> and <Hitachi-powergrids.com>) insofar as that earlier case also related, in virtually identical circumstances, (i) to the registration of domain names where each of the disputed domain names either inverts a letter, substitutes a similar letter, or adds a dash to the core domain name structure <hitachi-powergrids.com>; (ii) the disputed domain names were all registered in a narrow time window; (iii) none of the disputed domain names resolves to an active website; and (iv) the WHOIS information for each domain name is either patently fictional or obfuscated by a privacy service.

As in the cited earlier case, the Whois records for the disputed domain names in the present proceedings identify different registrant names, and these proceedings therefore in principle concern multiple Respondents and a request by the Complainant that the domain names and the named Respondents be consolidated in a single UDRP proceeding. In determining this issue, the Panel respectfully acknowledges the decision in CAC case number 103663 and adopts the reasoning of the Panel in that case:

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, for example, WIPO Case No D2009-0985, MLB Advanced Media, The Phillies, Padres LP -v- OreNet, Inc.). Furthermore, 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. (see 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, for example, WIPO Case No D2014-0474, Delta Dental Plans Association -v- ICS INC., et al. (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); WIPO Case No D2021-0497, Cephalon Inc -v- Whois Privacy Protection Foundation / Grigorij Minin, Whois Privacy Protection Foundation / Artem Bogdanov, and Alex Ivanov, Evgeny Shaposhniko (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 same naming pattern (i.e., use of the Complainant’s trade mark followed by a hyphen and a misspelling of the phrase “power grid”) is used for each of the disputed domain names. Furthermore, all of the disputed domain names were registered within a narrow time window and none resolves to an active website. The Complainant also points out that some of the address and phone information in the relevant Whois records is fictitious or non-functional. In view of these similarities between the disputed domain names, the Panel finds it likely on balance that they are owned by the same person. The Panel further notes that none of the registrants of the disputed domain names has participated in these proceedings to dispute the Complainant’s assertion of common ownership. The Panel therefore finds that there are sufficient grounds to conclude that it would be equitable and procedurally efficient to permit the consolidation of the disputed domain names into this single case.

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.

PRINCIPAL REASONS FOR THE DECISION

With regard to the first UDRP element, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trade marks HITACHI. Indeed, the disputed domain names all incorporate the Complainant’s trade marks in their entirety, save that the disputed domain names either invert a letter, substitute a similar letter, or add a dash to the core domain name structure <hitachi-powergrids.com>. The Panel considers this case to be a plain case of “typo-squatting”, i.e., the disputed domain names contain an obvious and intentional misspelling of the Complainant’s trade marks, which is not sufficient to alter the overall impression of the designation as being connected to the Complainant’s trade marks. Minor alterations to the Complainant’s trade marks do not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trade marks and associated domain names. The Panel follows in this respect the view established by numerous other decisions that a domain name which consists of a common, obvious, or intentional misspelling of a trade mark is to be considered to be confusingly similar to the relevant trade mark (see, for example, CAC Case No. 103124, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringeringelheimpetrreebates.com>; CAC Case No. 101990, JCDECAUX SA -v- Emma Purnell <jcdeceux.com>; CAC case No. 101892, JCDECAUX SA -v- Lab-Clean Inc <jcdacaux.com>; WIPO Case No. D2005-0941, Bayerische Motoren Werke AG, Sauber Motorsport AG v. Petaluma Auto Works <bmwsauberf1.com>; and WIPO Case No. D2015-1679, LinkedIn Corporation -v- Daphne Reynolds <linkedinjobs.com>).

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain names. Indeed, the disputed domain names are not being used for any active websites but resolve to error pages. A lack of content at the disputed domain has in itself been regarded by other panels as supporting a finding that the Respondent lacked a bona fide offering of goods or services and did not make legitimate non-commercial or fair use of the

disputed domain name (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants). The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade marks or to apply for or use the disputed domain names. In addition, the Whois information does not suggest that the Respondent is commonly known by the disputed domain names.

Finally, the Complainant adduced evidence in its submissions to show that the disputed domain names have been used for phishing/scam purposes by sending e-mails from the disputed domains, seeking to impersonate employees of a subsidiary of the Complainant for fraudulent purposes to the detriment of the recipients of the e-mails. The Panel categorially agrees with the Complainant's submission that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. The Panel follows in this regard an established line of cases: CAC Case No. 101578 <ARLEFOOD.COM> found that "To the contrary, it appears that the Respondent has used the disputed domain name to impersonate the Complainant and fraudulently attempt to obtain payments and sensitive personal information. The use of the disputed domain name in connection with such illegal activities cannot confer rights or legitimate interests on the Respondent". See also CAC Case No. 102290 <PEPSICOGDV.COM> (carrying out phishing attacks spoofing the Complainant's identity to send fraudulent emails for financial gain); and, most recently, CAC Case No. 103393 <SonyCreativeSoftware.Info> ("the use of a domain name for illegal activity (e.g. phishing) can never confer rights or legitimate interests on a respondent").

Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

With regard to the third UDRP element, the Complainant asserts that the Respondent was clearly aware that the HITACHI trade marks were already registered and being used by the Complainant since the disputed domain names were deliberately being used to send phishing e-mails, seeking to impersonate the Complainant's subsidiary. In any event, the Panel surmises that, if the Respondent had carried out a Google search for the name HITACHI, and for the additional term "Power Grids" incorporated in the disputed domain names, the search results would have yielded immediate and obvious references to the Complainant. It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain names would be identical with or confusingly similar to the Complainant's trade marks and that he registered the disputed domain names in full knowledge of the Complainant's trade marks. The Panel notes the Complainant's submissions linking the Respondent to the domain name dispute in the earlier CAC Case No 103663 but does not need to rely on that connection for a finding that the Respondent registered and is using the disputed domain names in bad faith.

Furthermore, the websites related to the disputed domain names are currently inactive and resolve to error pages. The Respondent has not demonstrated any activity in respect of the disputed domain names. First, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law in circumstances where that disputed domain name corresponds to the Complainant's trade marks and is similar to the Complainant's domain names currently used by the latter to promote its goods and services. Secondly, numerous other UDRP decisions have taken the view, which this Panel shares in this case, that the passive holding of a domain name with knowledge that the domain name infringes another party's trade mark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; and WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

Indeed, in its submissions, the Complainant adduced evidence to show that some of the disputed domain names have been used for sending phishing e-mails for fraudulent purposes. The Panel again follows an established line of cases in finding that registration and use of a domain name for such purposes constitutes bad faith. See, for example: WIPO Case No. D2018-1815 <hidQlobal.com>: "Respondent registered the disputed domain name which is nearly identical in appearance to Complainant's distinctive trademark. As the disputed domain name effectively impersonates Complainant, there is no evident ground for Respondent to have selected it, other than for using it to induce Internet users, including email recipients, to confuse the owner/sponsor of a website or the sender of an email with Complainant and its products. Regrettably, it is not

uncommon for domain names which closely approximate distinctive trademarks to be used as instruments of fraud or other abuse. Respondent has failed to provide any explanation for its decision to register the disputed domain name, and the Panel is unable to discern or infer any plausible legitimate reason for Respondent to have registered the disputed domain name. These circumstances are sufficient to establish Respondent's registration and use of the disputed domain name in bad faith". Further, CAC Case No. 101578 (<ARLEFOOD.COM>) concluded that: "As recognized in previous UDRP decisions, the use of a domain name for purposes other than to host a website may constitute bad faith where, like in the case at hand, the circumstances suggest that the disputed domain name has been used for fraudulent purposes such as the sending of deceptive emails to obtain sensitive or confidential personal information or to solicit payment of fraudulent invoices by the Complainant's actual or prospective customers". In similar circumstances, previous UDRP panels have also stated that "the use of the disputed domain name in connection with a fraudulent email scheme can only lead to the conclusion that the disputed domain name is being used in bad faith" (see, for example, SAP SE v. Anuoluwapo Akobi, WIPO Case No. D2018-0624 <aribacompany.com>). Yet other cases have specifically addressed that using a disputed domain name to pass oneself off as a Complainant in emails attempting to further a phishing scheme is evidence of 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, for example, K. HOV IP, II, Inc. v. Jack Riley / pleasant travels and tours, Forum case No 1929446 ("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, Forum case No1393436 (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)).

Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. HITACHI-POWERGRIDS.ORG: Transferred
2. HITCAHI-POWERGRIDS.COM: Transferred
3. HITACHL-POWERQRIDS.COM: Transferred
4. HITACH-POWERGRIDS.COM: Transferred
5. HITACHI--POWERGRIDS.COM: Transferred
6. HITACHI-POWER-GRIDS.COM: Transferred
7. HITAHCI-POWERGRIDS.COM: Transferred

PANELLISTS

Name	Gregor Kleinknecht
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DATE OF PANEL DECISION 2021-11-18

Publish the Decision
