

Decision for dispute CAC-UDRP-104449

Case number	CAC-UDRP-104449
Time of filing	2022-03-28 09:15:05
Domain names	hitachienergy.dev, hitachienergys.com

Case administrator

Name	Iveta Špiclová (Case admin)
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Complainant

Organization	Hitachi, Ltd.
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Complainant representative

Organization	RODENBAUGH LAW
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Respondent

Organization	Redacted for Privacy
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks for "HITACHI", such as:

- US trademark registration no. 0701266 for "HITACHI", registered on July 19, 1960;
- Japanese trademark registration no. 1492488 for "HITACHI" registered on December 25, 1981;
- EUTM registration no. 000208645 for "HITACHI" registered on December 21, 1999;
- EUTM registration no. 001070192 for "HITACHI" registered on September 19, 2000;
- EUTM registration no. 002364313 for "HITACHI" registered on November 27, 2002;
- EUTM registration no. 002809903 for "HITACHI" registered on March 10, 2003; and
- United Kingdom trademark no. UK00000811836 for "HITACHI" registered on October 11, 1960.

FACTUAL BACKGROUND

The Complainant is a Japanese multinational company that 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. The Complainant's group 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 about 300,000 people worldwide and provides products and services around the globe. Information about the Hitachi Group in general, including details on their respective products, can be found at <hitachi.com>.

Among its various commercial activities, the Complainant owns a company called Hitachi Energy 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 Complainant was founded in 1910 and has continuously used the HITACHI mark in commerce for well over 100 years. The Complainant 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 WHOIS records prove that the disputed domain name was registered recently, specifically in November 2021.

PARTIES CONTENTIONS

A. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO A TRADEMARK IN WHICH THE COMPLAINANT HAS RIGHTS

On its face, the disputed domain name is confusingly similar to the name of the Complainant's subsidiary company Hitachi Energy and the Complainant's "HITACHI" trademark for its related services. Furthermore, Hitachi Energy uses the domain name <hitachienergy.com> for its business email address, making the disputed domain name highly likely to be used for phishing or other fraud. There is only a typographical difference of the sort generally used by fraudsters, adding an 's' in the .com domain. Anyone would reasonably suspect the disputed domain name could only be used for nefarious purposes.

Here, the Complainant's United States, Japanese, and European trademark registrations for the "HITACHI" mark establish its prior rights according to paragraph 4(a)(i) of the Policy. The Complainant's trademark rights in the "HITACHI" trademark date back to 1960, when the trademark was registered in the United States and the United Kingdom, whereas the Respondent did not even register the disputed domain name until 2021.

Here, a simple comparison of the "HITACHI" trademark, Hitachi Energy trade name, and the disputed domain name demonstrates that the disputed domain name is not only confusingly similar but nearly identical to the "HITACHI" trademark and/or the Hitachi Energy trade name. The disputed domain name differs from the Complainant's famous trademark, trade name, and website domain name only by a minuscule typographical error such as commonly used by fraudsters.

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.

A simple comparison of the "HITACHI" trademark, Hitachi Energy trade name, and the disputed domain name demonstrates that it is confusingly similar, and any addition of a generic term or the top-level domain is negligible. Therefore, Complainant has established the first element of the Policy under paragraph 4(a).

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

Respondent does not have and never has had, Complainant's permission to use the "HITACHI" trademark in any way.

In this case, the Respondent has no rights or legitimate interest in the disputed domain name. The Respondent not only

registered it many decades after the Complainant's rights in the famous and distinctive "HITACHI" trademarks were registered but is also using the disputed domain name to serve competitive pay-per-click advertising. The 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 the Respondent by 60 years at least.

Therefore, the Respondent is not providing any product or service but is merely attempting to confuse customers or prospective customers of Hitachi Energy solely for the Respondent's financial gain.

The Respondent uses the disputed domain name to display pay-per-click advertising to unsuspecting internet users seeking the Complainant's website. That is neither a legitimate nor a fair use of the disputed domain name.

Nor can it be said that demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods and services have been made. There is no other indication that Respondent has made any steps towards any legitimate use of either of the disputed domain name.

There is no evidence that Respondent is commonly known by the disputed domain name. The publicly available WHOIS records do not provide any information that would suggest that the Respondent is known by the disputed domain name. Instead, the fact that the disputed domain name is confusingly similar to the Complainant's "HITACHI" trademark and Hitachi Energy trade name indicates that the Respondent is attempting to use the disputed domain name to profit from Complainant's goodwill in that famous trademark.

The Respondent uses the disputed domain name to display pay-per-click advertising to unsuspecting internet users seeking the Complainant's website. That is neither a legitimate nor a fair use of the disputed domain name.

The Complainant has met its burden to make prima facie showing that the Respondent has no rights or legitimate interest in the disputed domain name. The burden shifts to the Respondent to rebut Complainant's showing.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Respondent has registered and/or used the disputed domain name in bad faith. The purpose of the registration is to confuse as to the source of the website or other service offered via the disputed domain name.

The Respondent uses the disputed domain name for no other reason than to disrupt Complainant's business by confusing the customers and prospective customers of the Complainant's subsidiary by serving competitive advertising to unsuspecting Internet users. This practice alone is enough to disrupt Complainant's business, as any reasonable person is likely to be confused about the source, recipients, and/or contents of the e-mails.

Such use disrupts the Complainant's business and demonstrates the Respondent's bad faith use and registration of the disputed domain name. Moreover, the fact that the Respondent has undertaken such actions long after the Complainant's trademark rights arose is further evidence of a bad faith registration to disrupt the Complainant's business for the Respondent's commercial gain.

It can reasonably be inferred that the Respondent was aware of the Complainant's rights given the minor differences in the disputed domain name as compared to the Complainant's domain and the Complainant's well-known subsidiary Hitachi Energy. Alternatively, even if the Respondent did not have actual knowledge of the Complainant's Marks (which it almost certainly did), the Respondent had a duty to ensure that the disputed domain name registration would not infringe a third party's rights. Accordingly, the Respondent failed to discharge its duty to ensure that his registration of the disputed domain name would not infringe the Complainant's famous trademark. Accordingly, the registration of the disputed domain name was in bad faith.

Further, the Respondent's failure to make any legitimate use of the disputed domain name is further evidence of bad faith.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

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

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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).

BAD FAITH

To the satisfaction of the Panel, the Complainant has 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).

PROCEDURAL FACTORS

On March 24, 2022, the Complainant filed the dispute for two disputed domain names, namely <hitachienergy.dev> and <hitachienergys.com>. However, after the Registrar provided the information related to the Registrants of each disputed domain name, it was noted that two different individuals registered the disputed domain names. After this, the Complainant amended its Complaint on April 1, 2022, to include only one disputed domain name, namely <hitachienergys.com>, and the correct details of the Respondent.

The Panel is satisfied that all procedural requirements under UDRP have been met, and there is no other reason why it would be unsuitable for providing the Decision.

PRINCIPAL REASONS FOR THE DECISION

Under Paragraph 4 of the Policy, the onus is on the Complainant to prove:

1. That the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:
2. That the Registrant has no rights or legitimate interests in the disputed domain name; and
3. That the disputed domain name has been registered and being used in bad faith.

The Panel will consider each of these requirements in turn.

1. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has shown its rights to the "HITACHI" trademark, with the earliest registration dating back to 1960.

Now, the Panel must analyze if there is a confusing similarity between the disputed domain name and the trademark. As contained in the record before the Panel, the disputed domain name reproduces the trademark in its totality, namely, "HITACHI", with two additions. For the purposes of the analysis, we will consider these two additions separately. The first addition is the term "ENERGY". The second addition is the letter "S" following "ENERGY". "ENERGY" is a term associated with

the Complainant through the business of one of its subsidiaries, namely Hitachi Energy. It is noted that the Complainant does not provide evidence of a trademark for "HITACHI ENERGY". The second addition is the letter "S", immediately following "ENERGY". This can be interpreted as a typo.

As per paragraph 1.7 of the WIPO 3.0 Overview, "[w]hile each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." In this case, the disputed domain name incorporates the trademark in its entirety, and the "HITACHI" trademark is arguably the dominant and recognizable element of the disputed domain name. Having considered all of the above, the addition of the term "ENERGY" and the letter "S" is immaterial enough to dispel a finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

The addition of the term "ENERGY", since it appears to refer to a subsidiary of the Complainant, is relevant to further analysis under the second and third elements below. Accordingly, the Panel will refer to this under the relevant elements set out below.

Consequently, the Panel determines that the Complaint has satisfied the first element set under paragraph 4(a)(i) of the Policy.

2. Rights or Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts. These indicate that a) the Respondent is not affiliated with the Complainant; b) the Respondent is not authorized to carry out any activity for the Complainant and has no business dealings with the Complainant; c) the Respondent is not commonly known by the disputed domain name; d) the Respondent has no license or authorization to use the trademarks and e) the Respondent is not using the disputed domain name and has not demonstrable plans to use the disputed domain name legitimately.

In failing to respond to the Complainant's contentions, the Respondent has not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

In addition to this, the Respondent's use of the trademark plus the use of a term that seems to refer to a subsidiary of the Complainant, namely "ENERGY", seems to indicate that the Respondent not only was aware of the Complainant but deliberately targeted the Complainant to benefit from the association to the Complainant and confuse Internet users as to the source of sponsorship. A practice like this can never be considered a bona fide offering under the Policy.

Even putting aside, the question of trademark infringement, the Panel finds for all the reasons set out above (as well as below under the third element analysis) that the Respondent's conduct runs contrary to many of the persuasive principles contained in sections 2.4 and 2.5 (including subsections) of the WIPO 3.0 Overview.

In sum, based on the facts and analysis above, in addition to the Respondent's failure to come forward with evidence showing rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has established that the Respondent lacks any rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

3. Registered and Used in Bad Faith

As per the record and evidence, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This conclusion is reinforced by the fact that

the Respondent seems to evoke a connection to the Complainant's trademark by including the trademark in its entirety, with the addition of a term, namely "ENERGY", which is associated with a subsidiary of the Complainant.

All the preceding analysis leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

4. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HITACHIENERGYS.COM**: Transferred

PANELLISTS

Name	Rodolfo Carlos Rivas Rea
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DATE OF PANEL DECISION 2022-04-28

Publish the Decision
