

Decision for dispute CAC-UDRP-105339

Case number	CAC-UDRP-105339
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Time of filing	2023-04-05 10:38:45
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Domain names	hitachi-global.com
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Case administrator

Name	Olga Dvořáková (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	Dev Kurmi
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant has rights in the HITACHI trademark and service mark established by its ownership of a portfolio of trademark and service mark registrations that include the following:

United States registered trademark HITACHI, registration number 0701266, registered on the Principal Register on July 19, 2007, for goods in international classes 7, 9 and 11;

Japanese registered trademark HITACHI, registration number 1492488, registered on December 25, 1981 for goods in international class 7;

EUTM HITACHI, registration number 000208645, registered on December 21, 1999 for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42;

United Kingdom registered Trade Mark, HITACHI, registration number UK00000811836, registered on October 11, 1960 for goods in class 9.

Additionally, the Complainant has rights in the HITACHI mark established by the extensive use of the mark by itself and its group of companies across the world.

FACTUAL BACKGROUND

The Complainant is a member of a Japanese multinational group of companies comprised of the Complainant and hundreds of subsidiaries across the world that use the HITACHI mark.

The Complainant has an established Internet presence and maintains its principal website at <www.hitachi.com>.

The disputed domain name <hitachi-global.com> was registered on November 5, 2022 and has been used to create an email account from which the Respondent, purporting to impersonate the Complainant, has sent emails to an unsuspecting victim who was given to believe that she was being considered for a position in the employment of the Complainant, in an attempt to phish for her personal data.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar in response to the request by the Center for details of the registration of the disputed domain name.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant claims rights in the HITACHI mark established by its ownership of the portfolio of trademark and service mark registrations described herein and extensive use of the mark by itself and other members of its group of companies which together currently employ about 300,000 people worldwide providing products that range from information and telecommunication systems and infrastructure solutions to automotive systems business and electronic systems and equipment.

The Complainant alleges that the disputed domain name is confusingly similar to the HITACHI trademark and service mark in which it has rights, arguing that the disputed domain name is composed of the Complainant's globally famous HITACHI mark followed only by the generic terms "-global".

It is submitted that it is well established that the incorporation of a well-known trademark within a domain name at issue (as is the case here) is alone enough to sustain a finding of confusing similarity. See, e.g., *SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L.*, WIPO Case No. D2008-0792 (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.").

Moreover, the Complainant argues that the mere addition of the generic term "global" to the trademark does not avoid a finding of confusion. See e.g., *Fujitsu Ltd. v. Thomas Ruben*, CAC 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.").

Furthermore, the Complainant argues that the addition of the generic Top-Level Domain ("gTLD") extension <.com> does nothing to distinguish the disputed domain name from the Complainant's mark. See, e.g., *Alibaba Group Holding Limited v. Huang Guofeng*, WIPO 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 . . .").

The Complainant next alleges that the Respondent has no rights or legitimate interest in the disputed domain name, arguing that the Complainant's rights in the HITACHI mark predate any registration or use of the disputed domain name by the Respondent by 60 years at least.

There is no evidence that Respondent is commonly known by the disputed domain name. See, e.g., *Braun Corp. v. Loney*, FORUM Claim No. 699652 (finding respondent was not commonly known by the disputed domain names where neither the WHOIS record nor any other evidence of record indicated such). Here, the identity of the Complainant is concealed on the published WHOIS by a privacy service.

The Complainant asserts that no business relationship exists between the Parties.

Referring to a copy of email correspondence with is exhibited in an annex to the Complaint, the Complainant argues that the exhibited messages illustrate that the Respondent is using the disputed domain name, that is confusingly similar to the Complainant's mark, to perpetrate a fraud on Internet users for pecuniary gain.

The Complainant argues that the exhibited email correspondence illustrates that the Respondent has used the disputed domain name as an email address to impersonate the Complainant, which the Complainant submits is clearly not a *bona fide* offering of goods and services. See, *Hitachi, Ltd. v. Wilso Ogbie*, CAC Case No. 104276 (Feb. 15, 2022) ("The Respondent is not providing any product or service, but is merely attempting to defraud Internet users for pecuniary gain and its use of a disputed domain name which is confusingly similar to a complainant's mark for perpetration of fraud is not a bona fide use of the disputed domain name.").

The Complainant contends that unsurprisingly, numerous panels have found that fraudulent and/or criminal activity constitutes bad faith under the Policy. See *The Lincoln Electric Company v. David Vargo*, Forum Claim No. FA1704001725364 (Nat. Arb. Forum May 10, 2017) (finding inactive use of a domain name is not a bona fide offering of goods or services, and further, that using the disputed domain

as part of a phishing scheme “is not a bona fide offering of goods or services”).

The Complainant adds that it cannot be argued that the Respondent has made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods and services.

The Complainant submits that the exhibited email correspondence illustrates that the disputed domain name already has been used in an attempted fraud on a person interested in becoming an employee of the Complainant, and there is no other indication that the Respondent has made any steps towards any legitimate use of the disputed domain name. See, e.g., *Euromarket Designs, Inc. v. Domain For Sale VMI*, WIPO Case No. D2000-1195 (Oct. 26, 2000) (noting that respondent was a passive holder of the disputed domain name <crateandbarrel.org> in that “the domain name does not resolve to a site” and ruling that “the Respondent has not made, nor taken any preparatory steps to make,” any legitimate use of the domain name).

The Complainant next alleges that the disputed domain was registered and is being used in bad faith arguing that the Respondent registered the disputed domain name primarily for the purpose of disrupting the Complainant’s business and has intentionally attempted to divert internet users by creating likelihood of confusion.

The Complainant further argues that the Respondent was, or should have been aware of the Complainant’s rights in the HITACHI mark, and it can reasonably be inferred that the Respondent was aware of the Complainant’s rights given the similarity of the disputed domain name and the Complainant’s own domain names, and the impersonation of the company within the Complainant’s group.

Alternatively, the Complainant argues that even if the Respondent did not have actual knowledge of the Complainant’s marks, which is improbable, the Respondent nonetheless had a duty to ensure that the registration of the disputed domain name would not infringe a third party’s rights. See *Collegetown Relocation, L.L.C. v. John Mamminga*, FA 95003 (Nat. Arb. Forum Jul. 20, 2000) (stating that “[w]hen registering domain names, the respondent has a duty to investigate and refrain from using a domain name that infringes on a third-party’s rights”).

The Complainant alleges that therefore, because the Respondent failed to discharge its duty to ensure that registration of the disputed domain name would not infringe the Complainant’s famous trademark, the registration of the disputed domain was made in bad faith.

The Complainant specifically argues that the Respondent is using the disputed domain name for no other reason than to disrupt the Complainant’s business by defrauding Internet users, by sending emails from an email address mimicking the Complainant’s group -- solely for Respondent’s pecuniary gain. It is submitted that this practice alone is enough to cause a disruption to Complainant’s business, as any reasonable person is likely to be confused about the source, recipients and/or contents of the emails. See, e.g., *Haas Food Equipment GmbH v. Usman ABD, Usmandel*, WIPO Case No. D2015-0285 (Apr. 7, 2015) (finding bad faith because the respondent had used the domain to “perpetrate fraud” by using “the Domain Name to pose as senior executive of the Complainant and to send false emails on behalf of that executive making the emails look like genuine emails coming from that executive”).

Such use results in a disruption to Complainant’s business and demonstrates Respondent’s bad faith use and registration of the disputed domain name. Moreover, the fact that Respondent has undertaken such actions long after Complainant’s trademark rights arose is further evidence of bad faith registration for the sole purpose of disrupting Complainant’s business for Respondent’s own commercial gain.

The Complainant next argues that the Respondent is perpetuating a common fraud and phishing scam in an attempt to con internet users for the Respondent’s own profit. The bad faith factors outlined under the Policy are by no means exhaustive. *Florida National University, Inc. v. Registration Private, Domains By Proxy, LLC / Toby Schwarzkopf*, WIPO Case No. D2017-0138 (“The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another.”)

Here, the Respondent is attempting to commit fraud. The Respondent has registered the confusingly similar disputed domain name to create confusion, then sent emails pretending to be an employee of a Hitachi Group HR department, in a deliberate attempt to defraud Internet users for pecuniary gain.

The Complainant submits that unsurprisingly, panels have consistently ruled that attempted fraud is evidence of bad faith. See, e.g., *Hitachi, Ltd. v. Wilso Ogbie*, CAC Case No. 104276 (Feb. 15, 2022) (“The Respondent is not providing any product or service, but is merely attempting to defraud Internet users for pecuniary gain and its use of a disputed domain name which is confusingly similar to a complainant’s mark for perpetration of fraud is not a bona fide use of the disputed domain name.”).

In conclusion, the Complainant argues that the Respondent’s failure to make active public use of the disputed domain name is further evidence of bad faith. See, *The Lincoln Electric Company v. David Vargo*, FORUM Claim No. FA1704001725364 (Nat. Arb. Forum May 10, 2017) (finding that “[r]espondent has acted in bad faith because the disputed domain name’s resolving website is inactive. Failure to make an active use of a domain name is evidence of bad faith.”).

RESPONDENT:

No administratively compliant Response has been filed.

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).

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).

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).

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.

PRINCIPAL REASONS FOR THE DECISION

The Complainant's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the HITACHI mark, established by the ownership of the portfolio of trademark registrations described above and extensive use of the mark in its global technology business.

Confusing Similarity

The disputed domain name consists of the Complainant's HITACHI mark in its entirety in combination with composed of only the HITACHI mark in combination with the word "global", a hyphen and the TLD extension <.com>

The Complainant's HITACHI mark is the initial, dominant and only distinctive element in the disputed domain name. The word "global" has no distinguishing character when used in combination with the HITACHI mark as it would be understood to refer to the global reach of the Complainant's company.

Additionally the hyphen adds no distinguishing character to the disputed domain name, but merely separates the other elements and thereby add emphasis to the Complainant's mark.

Similarly, the gTLD extension <.com> does not prevent a finding of confusing similarity as the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration,

This Panel finds therefore that the disputed domain name is confusingly similar to the HITACHI mark, and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

Rights or Legitimate Interests

The Complainant has made out a *prima facie* case that the Respondent has no rights legitimate interests in the disputed domain name arguing that

- the Complainant's rights in the HITACHI mark predate any registration or use of the disputed domain name by the Respondent by at least 60 years;
- there is no evidence that the Respondent is commonly known by the disputed domain name;
- no business relationship exists between the Parties;
- the email correspondence, a copy of which is exhibited in an annex to the Complaint, illustrates that the Respondent has used the disputed domain name to create an email account from which it has sent an email message intending to perpetrate a fraud, by impersonating the Complainant and falsely creating the impression that the victim is being considered for a position in the employment of the Complainant;
- it cannot be said that the Respondent has made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods and services and there is no other indication that Respondent has made any steps towards any legitimate use of the disputed domain name.

It is well established that once a complainant makes out a *prima facie* case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Registration in Bad Faith

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights in the HITACHI mark which long predate the registration and first use of the disputed domain name <hitachi-global.com> on November 5, 2022.

HITACHI is a famous mark and it is most improbable that the disputed domain name which is composed of only the HITACHI mark in combination with the word “global”, a hyphen and the gTLD extension <.com> was chosen and registered by coincidence, without any knowledge of the Complainant and its famous HITACHI mark.

This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with the Complainant in mind, with the intention of taking predatory advantage of the global fame and reputation of the Complainant and its HITACHI mark.

The manner in which the disputed domain name has been used supports this finding.

Use in Bad Faith

The evidence adduced shows that the disputed domain name does not resolve to an active webpage but instead has been used to create an email account from which at least one unsuspecting person has been targeted to become a victim of a phishing scheme. The Complainant's allegation that the email message sent by the Respondent to the unsuspecting victim was an attempt at phishing by Respondent is entirely credible.

This is a particularly mean and abhorrent scheme and, as illustrated in the following quotation from the email exchange, the victim was put at the risk of divulging extensive details of her personal information if she had fallen for the ruse:

“So you have to send a scan copy of some documents as per the requirement of the client. All these documents are mandatory for the Technical Interview (Final Round). So arrange the following documents as soon as possible.

Documents Required :

Passport.

Passport size photograph.

Highest qualification certificate.

Current companies offer letters or salary slips.

Previous Company experience certificate.

Profile verification certificate (Mandatory).

You have to submit all the documents by the date 9th March 2023 as per the result of the interview declared to you otherwise your candidature may also be cancelled. So we inform you that you have to submit all your documents along with a profile verification certificate. It is mandatory for the Technical Interview (Final Round). Please share all your required documents as soon as possible.

You will have to get all your documents such as your Identity, Educational certificate and Experience certificate verified by an ISO certified agency. After verification they will provide you a certificate with an ISO stamp in which all responsibility of originality of characters of all your documents will be by ISO certified agency/company.

Final Interview Date: 9th March 2023.

This Panel finds that the above information provided by the Respondent is untrue and the Respondent is using the disputed domain name in bad faith in an attempt to perpetrate a phishing scheme.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **hitachi-global.com:** Transferred

PANELLISTS

Name **James Bridgeman**

DATE OF PANEL DECISION 2023-05-08

Publish the Decision