Decision for dispute CAC-UDRP-106228

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Domain names	hitachiae.com, TEAM-HITACHI.ASIA, TEAM-GLOBALHITACHI.COM, TEAMS-HITACHI.COM, GLOBALHITACHI.LIVE, HRHITACHI-TEAM.COM, HRHITACHIGROUP.COM

Case administrator

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

Complainant

Organization	Hitachi, Ltd.

Complainant representative

Organization	RODENBAUGH LAW

Respondents

Organization	Gg
Organization	j
Organization	r
Name	raj taj
Organization	Gropel
Name	Aditya Chopra
Name	Sumit das

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

In this proceeding the Complainant relies on the following “HITACHI” trademark registrations:

- US trademark registration No.0701266 “HITACHI” (word), registered on July 19, 1960;
- Japanese trademark registration No.1492488 “HITACHI” (word), registered on December 25, 1981;

- EU trademark registration No.000208645 “HITACHI” (word), registered on December 21, 1999;
- UK trademark registration No. UK00000811836 “HITACHI” (word), registered on October 11,1960; and
- Indian trademark registration No.155314 “HITACHI” (word), registered on August 27, 1952.

FACTUAL BACKGROUND

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

Consolidation: The Complainant requests to consolidate this dispute in respect of all seven (7) disputed domain names and multiple registrants since, in its opinion:

- All of the disputed domain names are registered via the same registrar – “GoDaddy”, using the same nameservers, the same e-mail provider and the same MX records;
- All of the disputed domain names include similar keywords such as “team”, “global” or “hr” in addition to Complainant’s “HITACHI” mark, and/or are using a similar e-mail address such as “hr@” or “hr.team@” the infringing domain name;
- The Complainant submits that at least four of the disputed domain names already have been used to perpetrate a highly similar fraud involving fake employment offers purportedly from the Complainant;
- All of the disputed domain names have been registered within a ten-month period and this indicates that they have been used one after the other; and
- According to the Registrar verification all of the disputed domain names are allegedly registered by person(s) in India and each utilizes a gmail.com administrative email address. The Complainant alleges that all of the identifying WHOIS information is false.

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it is a Japanese multinational company that offers innovative consumer, business, government products, and services. The Complainant’s group of companies is commonly referenced as the “Hitachi Group”, comprised of Hitachi, Ltd. and hundreds of subsidiaries present on a global scale. “Hitachi Group” provides a wide range of products and services such as information and telecommunication systems, railway systems, energy solutions, building systems, and electronic systems and equipment. The Complainant alleges that “Hitachi Group” currently employs about 300,000 people worldwide. The Complainant refers to information from its official website and claims that it was founded in 1910 and has used the "HITACHI" mark in global commerce for 100 years.

The Complainant refers to its “HITACH” registered trademarks provided above and claims that it has invested copious amounts of time and money to promote the “HITACHI” brand worldwide.

Through such longstanding and exclusive use by the Complainant, the "HITACHI" mark is famous in Japan, India and throughout the world.

The Complainant submits that the disputed domain names are confusingly similar to its trademarks since they fully incorporate the Complainant’s “HITACHI” mark with the addition of generic terms such as “team”, “teams”, “global”, “HR”, etc.

The mere addition of a generic term to a trademark does not avoid a finding of confusion. The gTLDs do not affect confusing similarity analysis.

Thus, the Complainant contends the disputed domain names are confusingly similar to the Complainant’s trademarks.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain names. The Respondent not only registered the disputed domain names many decades after Complainant’s rights in the famous and distinctive “HITACHI” marks were registered, but is also using the disputed domain names to perpetrate attempted fraud.

The Complainant alleges that none of the circumstances provided in paragraph 4 (c) of the UDRP are present in this dispute, in particular:

- the use of domain names that are confusingly similar to a complainant’s mark for perpetration of fraud, is not a bona fide use of the disputed domain names. The Complainant claims that the Respondent is therefore not providing any product or service, but is merely attempting to defraud Internet users for pecuniary gain. The Complainant refers to previous UDRP decisions that found that fraudulent and/or criminal activity constitutes bad faith under the Policy. The Complainant alleges that at least four out of seven disputed domain names have been used in an attempted fraud on Complainant’s potential employees;
- There is no evidence that the Respondent is commonly known by the disputed domain names as nothing in the “Whois” record indicates any connection between the Respondent and the disputed domain names;

- The use of some of the disputed domain names to commit fraud is not a legitimate or non-commercial fair use.

The Complainant alleges that it has met its burden to make prima facie showing that the Respondent has no rights or legitimate interest in the disputed domain names.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

The Complainant's submissions on the bad faith element of the Policy can be summarized as follows:

1. The Respondent intentionally attempted to divert Internet users by creating likelihood of confusion under paragraph 4(b)(iv) of the Policy. The Complainant claims that the Respondent has made active use of at least four of the disputed domain names in an effort to defraud Internet users and such behavior constitutes a bad faith use under the Policy.
2. The Respondent is using the disputed domain names for no other reason than to disrupt Complainant's business by defrauding Internet users and by sending emails from email addresses mimicking the Complainant's group. In the Complainant's view, 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. The fact that the 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.
3. The Respondent was or should have been aware of the Complainant's trademark rights. Even if Respondent did not have actual knowledge of Complainant's marks, the Respondent had a duty to ensure that the registration of the disputed domain names would not infringe a third party's rights.
4. The Respondent is perpetuating a fraud and phishing scam in an attempt to con Internet users. The Complainant states that the bad faith factors outlined under the Policy are by no means exhaustive. The Complainant refers to previous decisions of UDRP panels that found bad faith in case of attempted fraud. The Respondent has registered the confusingly similar disputed domain names 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 Respondent's possible failure to make active public use of three of the disputed domain names does not refute Complainant's allegations of bad faith. The fact that all of the disputed domain names share the exact same MX mail servers, were registered within a ten-month period and share other attributes as stated above, indicates that all of them have been registered and used in bad faith. The setting up of MX records indicates that all of the disputed domain names have been used in bad faith already, as there can be no legitimate purpose for anyone but the Complainant to send email from any of these disputed domain names.

The Complainant claims that this is not the first time when it became a victim of impersonation and refers to earlier UDRP decisions in CAC Case No. 105339 and CAC Case No. 104276.

Therefore, the Complainant claims the disputed domain names were registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

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 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

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.

Preliminary issue: Consolidation against multiple registrants

The Complainant requests consolidation of all seven disputed domain names and multiple registrants into a single dispute for the reasons explained above.

The Panel first notes that under par. 3 (c) of the UDRP Rules, the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. Consolidation is also addressed in "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition" ("WIPO Overview 3.0"), section 4.11, which states that "panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

The Complainant in its submissions suggests that all seven disputed domain names are subject to common control due to their common features described above in the Factual background section.

The Panel having considered Complainant's arguments in favor of consolidation, evidence provided as well as facts of this dispute, and also its limited research conducted under par. 10 (a) of the Rules and its authority under par. 10 (e) of the Rules, decided to accept the consolidation request based on the following:

- All seven disputed domain names are registered through the same Registrar – "GoDaddy";
- According to the Registrar verification the registrants are based in India;
- 6 out of 7 disputed domain names on the date of this decision resolve to similar webpages with PPC links and the domain name <hrhitachigroup.com> redirects to Complainant's own website;
- All of the disputed domain names share the same MX records and the same name servers;
- The Complainant provided evidence that four of the disputed domain names were used for impersonating the Complainant;
- All of the disputed domain names were registered within a ten-month period one after the other at intervals of one or a few months apart. While a ten-month period per se may seem rather long, the Complainant made a plausible argument of "a fraudster buying a new "burner phone" once in a while to avoid being tracked";
- Totality of the circumstances of this dispute indicate that all the named registrants are either different aliases of the same person or they are commonly controlled. The Panel in "Scribd, Inc. v. Robert Brink, Host Master, 1337 Services LLC, Ly Tran, Oscar Enriquez, and Minh Le, Home", WIPO Case No. D2022-3887 noted that "Common control may be indicated where various commonalities are present among the domain names concerned" and among such commonalities the Panel highlighted the following: "as common webserver IP addresses, nameservers, registrars, or web hosting arrangements. Finally, commonalities of use indicating a sufficient unity of interests may be of significance, such as similar activities and designs among the websites associated with the domain names concerned". This Panel finds that such commonalities are present in this dispute as described above; and
- Last, but not least, neither of the identified respondents filed a response and questioned consolidation or otherwise indicated that he or she is not related to the other identified respondents.

Based on the above the Panel finds that all of the disputed domain names are more likely than not under common control. Taking into account evidence available and facts of the case, Panel's own limited research and previous UDRP decisions in similar circumstances (e.g. **CAC Case No. 103663**: "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") consolidation is fair and equitable to both parties.

Based on the above, the Panel accepts the consolidation request of the Complainant and will refer to all named respondents in the complaint as "Respondent".

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar

The Complainant provides evidence of its trademark registrations for the "HITACHI" marks that are protected in various jurisdictions.

As confirmed by WIPO Overview 3.0: “where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case” (see sec. 1.2.1).

The disputed domain names fully incorporate the Complainant’s “HITACHI” trademarks with the addition of either geographical (“ae”) or generic/descriptive terms.

As stated in WIPO Overview 3.0: “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” and “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (see 1.7 and 1.8).

In the present case, the Complainant’s word trademarks are clearly recognizable within all of the disputed domain names and the additional terms do not the change overall perception of the disputed domain names and do not affect confusing similarity under the UDRP.

The gTLDs <.com>, <.asia> and <.live> are to be disregarded under the confusing similarity test as they do nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **“Julian Barnes v. Old Barn Studios”, WIPO Case No. D2001-0121; “Belupo d.d. v. WACHEM d.o.o.”, WIPO Case No. D2004-0110**.

The disputed domain names were registered within a ten-month period in 2022 and 2023. 6 out of 7 disputed domain names on the date of this decision resolve to webpages with PPC links and the domain name <hrhitachigroup.com> redirects to Complainant’s own website.

The Complainant has made a prima facie case of Respondent’s lack of rights or legitimate interests in respect of all disputed domain names.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: “A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”.

The Respondent is not known by the disputed domain names and has no connection to the Complainant’s business, the disputed domain names or any name(s) corresponding to the disputed domain names. There is no evidence of any other rights or legitimate interest of the Respondent in respect of the disputed domain names.

The Complainant provided evidence that four of the disputed domain names were used for likely fraudulent purposes and for impersonating the Complainant.

Under WIPO Overview 3.0 “panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent” (see section 2.13.1).

Besides, as reflected in WIPO Overview 3.0 “a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner” (see 2.5), and the Panel finds that this applies to the present dispute since the disputed domain names all incorporate the Complainant’s marks with the addition of terms that may actually indicate some kind of affiliation with the Complainant such as “ae”, “team”, “hr”, “group”, etc.

The very choice of the disputed domain names indicates an intent to create an implied affiliation and impersonate the Complainant taking into account evidence that the Complainant provided.

Impersonation is not fair and as such does not create any rights or legitimate interests.

Current use of the disputed domain names for PPC links (6 out of 7) does not create rights or legitimate interests of the Respondent in the circumstances of this dispute.

There is no other evidence that may indicate any rights or legitimate interest of the Respondent in the present dispute.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of the WIPO Overview 3.0). Targeting is important in establishing bad faith under the UDRP.

As noted by Gerald M. Levine in "**Domain Name Arbitration**", a leading treatise on the subject of the UDRP and domain name disputes: "knowledge and targeting are prerequisites to finding bad faith registration" and "knowledge of a complainant's mark, if not directly evident or denied, can be inferred or rebutted from website's content, strength of the mark and respective timing of a mark's use in commerce and registration of the domain name" (see "**Domain Name Arbitration**", Gerald M. Levine, "Legal Corner Press", Second Edition, 2019, page 235).

The Panel finds that the Complainant established that the disputed domain names were registered and are being used in bad faith based on the following:

1. The nature of the disputed domain names that incorporate the "HITACHI" Complainant's trademarks with the addition of geographical or descriptive terms and the timing of the registration of the disputed domain names, many years after the Complainant obtained protection for its trademarks and started using its trademarks. The nature of the disputed domain names indicates that the Respondent was aware of the Complainant and its trademarks when he/she registered the disputed domain names.
2. The strength of the Complainant's "HITACHI" trademarks registered and used decades before the registration of all of the disputed domain names. The Complainant's marks were previously recognized as "famous" (see e.g. **CAC Case No. 105339**: "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…" and **Hitachi, Ltd. (Kabushiki Kaisha Hitachi Seisakusho) v. Domains By Proxy, LLC / kurmi boys, services, WIPO Case No. D2021-0141**: "Considering also the very substantial degree of renown attaching to the Complainant's HITACHI mark worldwide based on its very substantial and widespread use and the Complainant group's substantial internet presence by 2020…"). It is inconceivable that the Respondent was not aware of the Complainant's marks while registering the disputed domain names.
3. The nature of use of some of the disputed domain names and the evidence of likely fraudulent activity provided by the Complainant. This indicates targeting, namely knowledge of the Complainant's marks and an intent to abuse and take an unfair advantage of the Complainant's marks. The Panel takes note of previous UDRP decisions in similar circumstances where the same Complainant and its "HITACHI" marks were involved, e.g. **CAC Case No. 104030** ("the Complainant adduced evidence to show that some of the disputed domain names have been used for sending phishing e-mails for fraudulent purposes…") and **CAC Case No. 105339** ("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").
4. A clear absence of rights or legitimate interests as discussed above under the second element analysis coupled with no credible explanation for the Respondent's choice of the disputed domain names. The Respondent failed to respond and provide explanations for his/her choice of the disputed domain names confusingly similar with the Complainant's trademarks.
5. By registering all seven (7) disputed domain names the Respondent engaged in a pattern of conduct preventing the Complainant "from reflecting the mark in corresponding domain names". As provided in WIPO Overview 3.0 establishing a pattern of conduct "requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner" (see sec. 3.1.2).

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (ii) and par. 4 b (iv) of the UDRP since the Respondent has engaged in "a pattern of conduct" by registering the disputed domain names "to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name" and the Respondent by using the disputed domain names has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of

confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement. Besides, the evidence of fraudulent use indicates Respondent’s intent to abuse and take an unfair advantage of the Complainant’s marks and this also represents bad faith registration and use.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **hitachiae.com**: Transferred
2. **TEAM-HITACHI.ASIA**: Transferred
3. **TEAM-GLOBALHITACHI.COM**: Transferred
4. **TEAMS-HITACHI.COM**: Transferred
5. **GLOBALHITACHI.LIVE**: Transferred
6. **HRHITACHI-TEAM.COM**: Transferred
7. **HRHITACHIGROUP.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-04-10

Publish the Decision