

Decision for dispute CAC-UDRP-104276

Case number	CAC-UDRP-104276
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Time of filing	2022-01-25 09:31:40
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Domain names	hitachi-metals-jp.com
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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	Wilso Ogbie
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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 was founded in 1910, and has continuously used the HITACHI mark in commerce since then -- 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.

Such registrations include but are not limited to:

HITACHI USA, 0701266 19, July 1960;
HITACHI Japan, 1492488, 25 December 1981;
HITACHI EUTM, 000208645, 21 December 1999;
HITACHI EUTM, 001070192, 19 September 2000;
HITACHI EUTM, 002364313, 27 November 2002;
HITACHI EUTM, 002809903, 3 March 2003;

HITACHI United Kingdom, UK00000811836, 11 October 1960.

Information about the Hitachi Group in general, including details on their respective products can be found at the website www.hitachi.com.

Among its many various commercial activities, the Complainant owns a company called Hitachi Metals, Ltd. which is specialized in areas such as the manufacture and marketing of advanced metals products, and advanced components and materials etc.

Hitachi Metals, Ltd. uses the domain name <hitachi-metals.co.jp> for its business e-mail and the screenshots are to be found on the website <http://www.hitachi-metals.co.jp/>.

The Respondent registered the disputed domain name <HITACHI-METALS-JP.COM> on 22 October 2021.

FACTUAL BACKGROUND

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

Hitachi, Ltd. is a Japanese multinational company that offers innovative, world class consumer, business, 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.

Among its many various commercial activities, Complainant owns a company called Hitachi Metals, Ltd. which is specialized in areas such as the manufacture and marketing of advanced metals products, and advanced components and materials etc.

The Complainant invested many and only financial resources to promote the ubiquitous HITACHI brand, worldwide. As such, consumers around the world have come to associate Hitachi Group with the HITACHI marks and brand. Through such longstanding and exclusive use by Hitachi Group, the HITACHI mark is famous in Japan, the United States, and throughout the world.

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

The Complainant alleged that the disputed domain name is extremely confusingly similar to the name of Complainant's subsidiary company Hitachi Metals, Ltd., and the Complainant's trademark for its services and its domain name <hitachi-metals.co.jp> used for its business e-mail address. It makes this disputed domain name highly likely to be used for phishing or other fraud. The only difference is that the disputed domain name adds the geographic element "jp" within the disputed domain name instead of just being the TLD. Anyone would reasonably suspect such disputed domain name could only be used for nefarious purposes.

The Complainant contended that the disputed domain name already has been used in an unsuccessful attempt to defraud Internet users for pecuniary gain. It is true that an e-mail was sent to an unsuspecting user on 4 November 2021, mimicking an e-mail address of the Complainant's group company, and signed by "Shuichi Yoshito, International Sales Consultant Manager, Hitachi Metals, Ltd Japan." Obviously, the Respondent does not have, and never has had, Complainant's permission to use the HITACHI trademark in such manner, or at all.

The Complainant has a prior valid trademark rights in the HITACHI trademark and may satisfy the threshold requirement for standing by demonstrating ownership of a valid trademark. A simple comparison of the HITACHI mark, trade name and the disputed domain name demonstrates that they are confusingly similar, and any addition of a generic term or top-level domain

are negligible. The burden to establish confusing similarity is low, but in this case is extremely obvious.

The Complainant recalled:

- WIPO Case No. D2007-1629 in F. Hoffmann-La Roche AG v. Relish Enterprises, (17 December 2007);
- WIPO Case No. D2009-0227 in Motion Limited v. One Star Global LLC, (9 April 2009);
- CAC Case No. 101592 in Fujitsu Ltd. v. Thomas Ruben, (18 July 2017);
- CAC Case No. 102323 in Apollo Education Group, Inc. v. gaurav negi, (7 March 2019);
- WIPO Case No. D2008-0792 in SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L., (8 July 2008);
- WIPO Case No. D2000-1525 in Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., (29 January 2001);
- WIPO Case No. D2004-0935 in Sharman License Holdings, Limited v. Mario Dolzer, (31 January 2006);
- CAC Case No. 101592 in Fujitsu Ltd. v. Thomas Ruben, (18 July 2017);
- WIPO Case No. D2018-2450 in Alibaba Group Holding Limited v. Huang Guofeng, (26 December 2018);
- WIPO Case No. D2018-0816 in Open Society Institute v. Admin Contact, PrivateName Services Inc. / Axel Feldt, (13 June 2018).

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

(i) The Complainant makes a prima facie showing that Respondent lacks a right or legitimate interest in the disputed domain name

Once the Complainant has made such a showing, the burden shifts to the Respondent to demonstrate that it has rights or legitimate interest in the disputed domain name. The Respondent has not only registered the disputed domain many decades after the Complainant's rights in the famous and distinctive HITACHI mark were registered, but is also using the disputed domain name to perpetrate attempted fraud. The Complainant uses the HITACHI trademark exclusive by 60 years at least so that the Complainant's rights predate any registration or use of the disputed domain name by the Respondent. 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. A passive holding of a domain name does not constitute a bona fide offering of goods or services.

The Complainant recalled:

- WIPO Case No. D2009-0701 in Accor v. Eren Atesmen, (10 July 2009);
- WIPO Case No. D2010-2011 in Mile, Inc. v. Michael Burg, (7 February 2011);
- Forum Claim No. FA1704001725364 in The Lincoln Electric Company v. David Vargo, (10 May 2017);
- Forum Claim No. FA 1661076 in ForumChevron Intellectual Property LLC v. Thomas Webber / Chev Ronoil Recreational Sport Limited, (15 March 2016);
- Forum Claim No. FA1588430 in Chevron Intellectual Property LLC v. Richard Bailey / Jacobs, Claim, (9 December 2014);

- WIPO Case No. D2000-1195 in Euromarket Designs, Inc. v. Domain For Sale VMI, (26 October 2000);
- WIPO Case No. D2006-0483 in Teachers Insurance and Annuity Association of America v. Wreaks Communications Group, (15 June, 2006);
- WIPO Case No. DNL2012-0074 in Prada S.A. v. Y.B. el Bakkali, (27 March 2013).

(ii) Respondent is Not Commonly Known by the Disputed Domain Name.

There is no evidence that Respondent is commonly known by the disputed domain name. Here, the WHOIS indicates that the disputed domain name has been registered by an individual named "Wilso Ogbie" from Nigeria. No other information on the WHOIS indicates any relation with the Complainant or any information indicating that the Respondent is known in any way by the disputed domain name. The fact that the disputed domain name is extremely confusingly similar to the Complainant's HITACHI mark and its group company trade name indicates that the Respondent is attempting to use the disputed domain name to profit from the Complainant's goodwill in that famous mark.

The Claimant recalled:

- Forum Claim No. 699652 in Braun Corp. v. Loney (7 July 2006).

(iii) Respondent Does Not Use The Disputed Domain For Any Legitimate Or Noncommercial Fair Use

The use of a disputed domain name to commit fraud is not a legitimate or non-commercial fair use. In this case, the Respondent is clearly attempting to commit a fraud as evidenced by the e-mail sent to an unsuspecting individual, and use of a confusingly similar disputed domain name. There is not fair use of the disputed domain name when the Respondent was using the disputed domain to commit a fraud, while "[t]he essence of the fraud is that the Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives." When the disputed domain name is being used by the Respondent in order to cause the recipients of these e-mails to mistakenly believe that the Respondent has a connection with Complainant, it cannot create "a legitimate non-commercial or fair use" of the disputed domain name.

The Claimant recalled:

- WIPO Case No. D2009-1017 in Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence, (2 October 2009);
- WIPO Case No. D2009-1017 in Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence, (2 October 2009);
- WIPO Case No. D2015-0285 in Haas Food Equipment GmbH v. Usman ABD, Usmandel, (7 April 2015);
- Forum Claim No. FA1661076 in Chevron Intellectual Property LLC v. Thomas Webber / Chev Ronoil Recreational Sport Limited, (15 March 2016).

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

(i) Respondent Intentionally Attempted To Divert Internet Users By Creating Likelihood Of Confusion

The Complainant contends that "a respondent has registered and/or used a disputed domain name in bad faith where the

purpose of the registration is to cause confusion as to the source of the website or other service offered via the disputed domain name" and "The registrant has registered and used a disputed domain name in bad faith where "by using the domain name, [the registrant has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [registrant's] web site or location or of a product or service on [registrant's] web site or location." Here it is obvious that the Respondent has made active use of a disputed domain name in effort to defraud Internet users i.e. clearly as a "bad faith use" of the disputed domain name. A failure to actively use a disputed domain name is evidence of bad faith registration and use.

The Complainant recalled:

- Forum Claim No. FA1704001725364 in The Lincoln Electric Company v. David Vargo, (10 May 2017);
- Forum Claim No. FA1503001608735 in VideoLink, Inc. v. Xantech Corporation, (12 May 2015).

(ii) Respondent Registered the Disputed Domain Name Primarily For The Purpose Of Disrupting Complainant's Business

The Complainant alleged that the Respondent is using the disputed domain name for no other reason than to disrupt Complainant's business by defrauding Internet users, by sending e-mails from a mimicking e-mail address of the Complainant's group company for pecuniary gain. 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 e-mails.

The Complainant recalled:

- WIPO Case No. D2015-0285. See, e.g., Haas Food Equipment GmbH v. Usman ABD, Usmandel, (7 April 2015).

(iii) Respondent Was Or Should Have Been Aware Of Complainant's Rights In The HITACHI Mark and Registered The Disputed Domain Name In Bad Faith

The Complainant argues that it can reasonably be inferred that the Respondent was aware of the Complainant's rights given the similarities with the disputed domain name as compared to the Complainant's own domains, and the misrepresentation of being an employee of the Complainant's group company. Alternatively, even if the Respondent did not have actual knowledge of Complainant's Marks (which it likely did), the Respondent had a duty to ensure that the registration of the disputed domain name would not infringe a third party's rights and "[w]hen registering domain names, the respondent has a duty to investigate and refrain from using a disputed domain name that infringes on 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, and the registration of the disputed domain name was in bad faith. Additionally, the Respondent's failure to make any other active use of the disputed domain name is further evidence of bad faith.

The Complainant recalled:

- Forum Claim No. FA 95003 in Collegetown Relocation, L.L.C. v. John Mamminga, (20 July 2000).

(iv) Respondent Is Perpetuating A Common Fraud And Phishing Scam In An Attempt To Con An Internet User For Respondent's Own Profit

The bad faith factors are in view of the Complainant by no means exhaustive while the Respondent has registered the similar

disputed domain name to create confusion, then made no attempt to develop the disputed domain name. Moreover, the Respondent sent emails by pretending to be an employee of the Complainant's group company Hitachi Metals, Ltd., in a deliberate attempt to defraud Internet users for pecuniary gain and that attempted fraud is evidence of bad faith and the disputed domain name's resolving website is inactive.

The Complainant recalled:

- WIPO Case No. D2017-0138 in Florida National University, Inc. v. Registration Private, Domains By Proxy, LLC / Toby Schwarzkopf, (14 March 2017);
 - Forum Claim No. FA1575951 in National Oilwell Varco, L.P. v. Craig Wood/NOV, (22 September 2014);
 - Forum Claim No. FA1529565 in Coldwell Banker Real Estate LLC v. piperleffler piperleffler, (27 December 2013);
 - WIPO Case No. D2015-0285 in Haas Food Equipment GmbH v. Usman ABD, Usmandel, (7 April 2015);
 - WIPO Case No. D2009-1017 in Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence, (2 October 2009);
 - Forum Claim No. FA1704001725364 in The Lincoln Electric Company v. David Vargo, (10 May 2017);
 - Forum Claim No. FA1503001608735 in VideoLink, Inc. v. Xantech Corporation, (12 May 2015).
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PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed allegations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules because of the Respondent's failure to submit a response.

Therefore, in the absence of a response, it is appropriate to accept as true all allegations of the Complainant.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs the Panel to "decide a complaint on the basis of the

statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

(ii) respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations because of the Respondent's failure to submit a response. Therefore, it accepted as true all allegations of the Complainant.

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

The Panel finds that that the disputed domain name is confusingly similar to the name of Complainant's subsidiary company Hitachi Metals, Ltd., and the Complainant's trademark for its services and its domain name <hitachi-metals.co.jp> is used for its business e-mail address. The Complainant has after the finding of the Panel a prior valid trademark rights in the HITACHI trademark and may satisfy the threshold requirement for standing by demonstrating the ownership of a valid trademark. A simple comparison of the HITACHI mark, trade name and the disputed domain name demonstrates that they are confusingly similar, and any addition of a generic term or top-level domain are negligible. The only difference is that the disputed domain name adds the geographic element "jp" within the disputed domain name instead of just being the TLD. The burden to establish non confusing similarity lies on the Respondent. The Panel finds that such disputed domain name could only be used for nefarious purposes and highly likely for phishing or other fraud.

The Panel finds that an email was sent to an unexpected user on 4 November 2021, mimicking an e-mail address of the Complainant's group company, and signed by "Shuichi Yoshito, International Sales Consultant Manager, Hitachi Metals, Ltd Japan." so that the disputed domain name has been used in an unsuccessful attempt to defraud Internet users for pecuniary gain. The Respondent does neither contended nor prove that it has or ever has had, the Complainant's permission to use the HITACHI trademark in such manner, or at all.

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

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

The Panel is satisfied that the Complainant makes a prima facie showing that Respondent lacks a right or legitimate interest in the disputed domain name. Once the Complainant has made such a showing, the burden shifts to the Respondent to demonstrate that it has rights or legitimate interest in the disputed domain name. The Complainant uses the HITACHI trademark exclusive by 60 years at least so that the Complainant's rights predate any registration or use of the disputed domain name by the Respondent. The Respondent has not only registered the disputed domain many decades after the Complainant's rights in the famous and distinctive HITACHI mark were registered, but is also using the disputed domain name to perpetrate attempted fraud.

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. A passive holding of a domain name does not constitute a bona fide offering of goods or services.

There is no evidence that the Respondent is commonly known by the disputed domain name because the disputed domain name has been registered by an individual named "Wilso Ogbie" from Nigeria. It was not proven that the Respondent is known in any way by the disputed domain name. The fact that the disputed domain name is confusingly similar to the Complainant's HITACHI mark and its group company trade name shows that the Respondent attempted to use the disputed domain name to profit from the Complainant's goodwill in that famous mark.

The use of a disputed domain to commit fraud is after finding of the Panel not a legitimate or non-commercial fair use. Given that the disputed domain name was being used by the Respondent in order to cause the recipients of the e-mail to mistakenly believe that the Respondent has a connection with Complainant, it cannot create "a legitimate non-commercial or fair use" of the disputed domain name.

Thus, 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).

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

The Panel finds that the Respondent has made active use of a disputed domain name in effort to defraud Internet users i.e. clearly as a "bad faith use" of the disputed domain name. A failure to actively use a disputed domain name is evidence of bad faith registration and use. This attempt is evidence of bad faith. Moreover, the website of the disputed domain name is inactive. It is obvious that the Respondent is using the disputed domain name for reason to disrupt the Complainant's business by defrauding Internet users, by sending e-mails from a mimicking e-mail address of the Complainant's group company for pecuniary gain so that this practice alone is enough to cause a disruption to the Complainant's business, as any reasonable person is likely to be confused about the source, recipients and/or contents of the e-mails. The Respondent was in conclusion of the Panel aware of the Complainant's rights because of the similarities with the disputed domain name as compared to the Complainant's own domains, and the misrepresentation of being an employee of the Complainant's group company. In any case the Respondent had a duty to ensure that the registration of the disputed domain name would not infringe a third party's rights when registering domain names, otherwise this is an evidence of the infringement made by the Respondent to the Complainant's famous trademark, and the registration of the disputed domain name was in bad faith. Additionally, the Respondent's failure to make any other active use of the disputed domain name, which is inactive, is a further evidence of bad faith. Also the above mentioned e-mails by which the Respondent was pretending to be an employee of the Complainant's group company Hitachi Metals, Ltd., is a deliberate attempt to defraud Internet users for pecuniary gain.

Thus, 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HITACHI-METALS-JP.COM**: Transferred

PANELLISTS

Name	JUDr. Vojtěch Trapl
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DATE OF PANEL DECISION	2022-02-15
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Publish the Decision	
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