

**Asian Domain Name Dispute Resolution Centre  
(Kuala Lumpur Office)**

**ADMINISTRATIVE PANEL DECISION**

**Case No. AIAC/ADNDRC-797-2019**

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<b>Complainant:</b>	<b>Hitachi, Ltd</b>
<b>Respondent:</b>	<b>Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN</b>
<b>Disputed Domain Name:</b>	<b>&lt;www.hitachi-idi-holding.com&gt;</b>

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**1. The Parties and Contested Domain Name**

The Complainant is Hitachi, Ltd., of 6-6, Marunouchi 1-chome, Chiyoda-ku, Tokyo, Japan.

The Respondent is Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN, of Chuo-ku Minamisenba 3-1-8, Osaka, Japan, of contact email at [info1@hitachi-idi-holding.com](mailto:info1@hitachi-idi-holding.com).

The domain name at issue is <www.hitachi-idi-holding.com>, registered by the Respondent with Key-Systems GmbH, of contact email at: abuse@key-system.net.

**2. Procedural History**

On 11 November, 2019, the Complainant's authorized representative, Mike Rodenbaugh of Rodenbaugh Law, 548 Market Street, Box No. 55819 San Francisco, CA 94014, email: [mike@rodenbaugh.com](mailto:mike@rodenbaugh.com), submitted the Complaint with Annexures, in English, against the Respondent's registration of the disputed domain name <www.hitachi-idi-holding.com> to the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) (the Kuala Lumpur Office), in accordance with the Uniform Domain Name Dispute Resolution Policy (UDRP) adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October, 1999, the Rules for UDRP (the Rules) approved by the ICANN Board of Directors on 28 September, 2013, and ADNDRC's Supplemental Rules for UDRP (Supplemental Rules) effective from 31 July, 2015. The Complainant requested a single person panel.

On 17 January, 2020, the Kuala Lumpur Office sent to the Respondent a written notice in English, informing the Respondent, among others, about the commencement of the proceedings and that the Respondent had to submit a Response within 20 days i.e. on or before 6 February, 2020, in accordance with para. 5 (The Response) of the Rules and the Supplemental Rules.

The Kuala Lumpur Office did not receive a Response from the Respondent in respect of the Complaint by the due date.

On 7 February, 2020, the Kuala Lumpur Office appointed Mr. Peter Cheung Kam Fai as the Sole Panelist in the present dispute, who had confirmed that he was available to act impartially and independently between the Parties in this matter. The Panel finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules.

### 3. Factual background

#### A. The Complainant

Hitachi, Ltd. (“Hitachi” or “Complainant”) is a Japanese multinational company that offers innovative, world class consumer, business, government products, and services. Hitachi’s products range from telecommunications and infrastructure solutions to construction machinery and electronic systems and equipment. Hitachi currently employs about 300,000 people worldwide (consolidated data) and provides products and services around the globe, including in Japan, Germany, and the United States. Information about Complainant can be found at the website <hitachi.com> (“Complainant’s Website”). True and correct copies of screenshots of the <hitachi.com> website are attached as Annex 3.

Hitachi was founded in 1910, and has continuously used the HITACHI mark in global commerce since then - for well over 100 years. Hitachi has also registered the HITACHI mark in numerous jurisdictions throughout the world, including but not limited to the United States, Germany, the EU, and Japan, where Respondent is allegedly located:

Trademark	Jurisdiction	Registration No.	Registration Date
HITACHI	USA	0701266	1960-07-19
HITACHI	Japan	433710	1953-10-29
HITACHI	Japan	1492488	1981-12-25
HITACHI	EUTM	000208645	1999-12-21
HITACHI	EUTM	001070192	2000-09-19
HITACHI	EUTM	002364313	2002-11-27
HITACHI	EUTM	002809903	2003-10-03
HITACHI	United Kingdom	UK00000811836	1960-10-11
HITACHI	Germany	772224	1963-04-03
HITACHI	Germany	2079719	1994-10-07

True and correct copies of Hitachi’s trademark registration certificates and/or printouts from the corresponding trademark office websites are attached as Annex 4. Hitachi has invested copious

amounts of time and money to promote the ubiquitous HITACHI brand. As such, consumers around the world have come to associate Hitachi with the HITACHI marks and brand. Through such longstanding and exclusive use by Hitachi, the HITACHI mark is famous in Japan, the United States, Germany, and throughout the world.

## B. The Respondent

The Respondent is Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN. The Respondent in this administrative proceeding is unknown as the registrant's information on the Whois record for the disputed domain is redacted.

The Whois information for the <hitachi-idi-holding.com> domain name (the "Disputed Domain") does not reveal any personal or contact information about Respondent. See Annex 1. Nor can Complainant confirm via the Whois record for the Disputed Domain where registrant is located because the relevant contact information has been redacted. *Id.* However, based on the information provided on the website associated with the Disputed Domain (the "Infringing Website"), the registrant is believed to be located in Japan. True and correct copies of screenshots of the website found at <hitachi-idi-holding.com> and their English Google translated versions are attached as Annex 5.

The Infringing Website is a Japanese language website. The Infringing Website contains the text "Hitachi IDI Holding" in the top banner throughout the website, including the 'home', 'about us'/'information' and 'contact' pages. *Id.* Respondent markets itself as a "Financial Services Agency" that offers "asset management and asset formation" services. *Id.* Respondent states in the "Company Profile" that it is registered to do business in the Kanto region in Japan ("Registered as a Second-class Financial Instruments Business Operator, Director of Kanto Local Finance Bureau", "Investment Advisory/ Agent Registration Director of Kanto Local Finance Bureau", "Registered as an investment advisor, Director of Kanto Local Finance Bureau", "Special business for qualified institutional investors (Jupiter Jupiter H21.9.2) Kanto Local Finance Bureau"). *Id.* Users looking for more information and/or to contact Respondent, are directed to a third-party website and prompted to enter their contact information. *Id.*

Despite Respondent's assertions that it is registered to do business as a financial services agency, on July 15, 2015, the Kanto Local Finance Bureau issued a warning concerning Respondent (the "Warning"). The Warning stated: Under the Financial Instruments and Exchange Act, unregistered traders are prohibited from displaying information indicating that they are engaged in the financial instruments business without obtaining registration under the Financial Instruments and Exchange Act. A true and correct copy of a screenshot of the warning issued by the Kanto Local Finance Bureau and English Google translated version of the same is attached as Annex 6. The Warning further stated: **Beware of unregistered suppliers!** There are many troubles with unregistered companies, especially elderly people, regarding transactions of stocks, bonds, funds, etc.

## 4 Parties' Contentions

### A. The Complainant

#### **No Business Relationship Exists Between The Parties**

Respondent does not have, and never has had, permission to use the HITACHI trademark.

**i) THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS: Complainant Hitachi Has Prior, Valid Trademark Rights In The HITACHI Mark**

A complainant may satisfy the threshold requirement for standing under Paragraph 4(a)(i) of the Policy by demonstrating ownership of a valid trademark. *See F. Hoffmann-La Roche AG v. Relish Enterprises*, Case No. D2007-1629 (WIPO December 17, 2007) (quoting “WIPO Decision Overview” at §1.1). Here, Complainant’s United States, Japanese, European, and German trademark registrations for the HITACHI mark establish Hitachi’s prior rights pursuant to paragraph 4(a)(i) of the Policy. Complainant’s trademark rights in the HITACHI mark date back to at least 1953, when the mark registered in Japan, where Respondent is allegedly located; whereas, the <hitachi-idi-holding.com> Disputed Domain was not even created until May 2009, over 55 years after Complainant registered its HITACHI mark in and Japan.

**The Disputed Domain Is Confusingly Similar To Complainant’s Trademark**

The burden to establish confusing similarity is low, but in this case is extremely obvious. Research in *Motion Limited v. One Star Global LLC*, Case No. D2009-0227 (WIPO Apr, 9, 2009). A showing of confusing similarity only requires a “simple comparison of the mark relied upon with the domain name in issue.” *Id.* Here, a simple comparison of the HITACHI mark and the Disputed Domain demonstrates that the Disputed Domain is not only confusingly similar, but nearly identical to the HITACHI mark. The Disputed Domain <hitachi-idi-holding.com> is comprised of the HITACHI trademark (in its entirety) merely adding the generic term ‘holding’ and acronym ‘idi’.

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. *See, e.g., Hitachi, Ltd. v. Zlatan Irving*, Case No. 102466 (CAC May 29, 2019) (finding <hitachi-hihgtech.com> confusingly similar to HITACHI); *Hitachi, Ltd. v. William Cooper*, Case No. 102603 (CAC July 26, 2019) (finding <hitachifoundation.org> confusingly similar to HITACHI); *Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Jul. 18, 2017) (finding the <fujitsu-global.com> domain name confusingly similar to complainant’s FUJITSU mark); *SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L.*, Case No. D2008-0792 (WIPO Jul. 8, 2008) (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 mere addition of a generic term to a trademark, in this case ‘holding’, does not avoid a finding of confusion. *Sharman License Holdings, Limited v. Mario Dolzer*, Case No. D2004-0935 (WIPO Jan. 31, 2006); *see also, e.g. Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Jul. 18, 2017) (“It is well established that the addition of a generic term to a trademark does not avoid a finding of confusion.”); *Hitachi, Ltd. v. Zlatan Irving*, Case No. 102466; *Hitachi, Ltd. v. William Cooper*, Case No. 102603. Nor does the addition of an acronym allow a Registrant to escape a finding of confusing similarity. The panel in *Pima Federal Credit Union v. Whois Privacy Corp.* stated: The Panel considers

the disputed domain name <pimafcu.com> to be confusingly similar to the PIMA FEDERAL CREDIT UNION trademarks. .... [T]he disputed domain name contains the most distinctive element of the Complainant's trademark and adds the letters 'fcu', which can be seen as an acronym for 'federal credit union'. Case No. 100979 (CAC July 16, 2015) (finding confusing similarity). Similarly here, the addition of the acronym 'idi' does not create a new mark, as the acronym only abbreviated three similarly generic terms - industrial, development, and international. See Annex 5. Further, the addition of the generic top-level domain ".com" does nothing to distinguish the Disputed Domain from Complainant's mark. See *InfoSpace.com, Inc. v. Ofer*, D2000-0075 (WIPO Apr. 27, 2000) (finding that "[t]he domain name 'info-space.com' is identical to Complainant's INFOSPACE trademark. The addition of a hyphen and .com are not distinguishing features"); *Hitachi, Ltd. v. Zlatan Irving*, Case No. 102466. A simple comparison of the HITACHI mark and the Disputed Domain demonstrates that the two are confusingly similar, and any additions of generic terms, acronyms, and/or top-level domains are negligible. Therefore, Complainant has established the first element of the Policy under paragraph 4(a).

**ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME:**

The second element of a UDRP claim only requires that the complainant make a prima facie showing that respondent lacks a right or legitimate interest in the disputed domain name. *Accor v. Eren Atesmen*, Case No. D2009-0701 (WIPO Jul. 10, 2009). Once a 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. See, e.g., *Mile, Inc. v. Michael Burg*, Case No. D2010-2011 (WIPO Feb. 7, 2011). In this case, it is clear that Respondent has no rights or legitimate interest in the Disputed Domain. See Paragraph 4(c). Respondent not only registered the Disputed Domain many decades after Complainant's rights in the HITACHI mark were registered, but is using the Disputed Domain as a front for an unregistered "financial services agency" and to confuse consumers as to the source of the website, prompting users to potentially reveal sensitive personal information for Respondent's own gain. See Annex 5.

**Respondent Does Not Use, And Has Not Used, The Disputed Domains In Connection With A Bona Fide Offering Of Goods Or Services**

The use of a domain name that is confusingly similar to a complainant's mark to pose as a "financial services agency" (one that is unregistered and has been publicly warned about its conduct by the local Japanese finance bureau) and/or for the purposes of "phishing" is not a bona fide offering of goods and services. *Blackstone TM L.L.C. v. Mita Ireland Limited c/o Michael Buotenko*, Claim No. FA1003001314998 (Nat. Arb. Forum April 30, 2010). Here, Respondent has created a deliberate false association with Complainant by using Complainant's HITACHI mark, copied in its entirety, within the Disputed Domain to operate a website that is posing as a registered financial services company. Such a deliberate, false association with Complainant's trusted HITACHI mark, means users are likely to reveal highly sensitive and personal, financial information to Respondent, solely for Respondent's own gain, which does not constitute a bona fide offering of goods or services. See, e.g., *Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Aug. 16, 2017) "the use of a domain name to "phish for" or to deceptively gather consumer information, is not a legitimate or noncommercial fair use."); *Blackstone TM L.L.C.*, Claim No. FA1003001314998 (finding no bona fide use when the disputed domain resolved

to the website of a “purported” financial company); *Allianz of America Corporation v. Lane Bond d/b/a Allianzcorp*, Claim No. FA0604000690796 (Nat. Arb. Forum June 12, 2006) (finding that respondent’s use of the disputed domain “to fraudulently acquire the personal and financial information of Internet users” was not a bona fide use.).

### **Respondent Is Not Commonly Known By The Disputed Domain**

There is no evidence that Respondent is commonly known by the Disputed Domain. *See Braun Corp. v. Loney*, Claim No. 699652 (NAF July 7, 2006) (finding respondent was not commonly known by the disputed domain names where neither the Whois record or any other evidence of record indicated such). Respondent’s use of a privacy service to mask its identity only further supports the notion that Respondent is not commonly known by the Disputed Domain. *See LK International AG v. Fundacion Private Whois*, Case No. D2013-0135 (WIPO Mar. 4, 2013) (finding that the respondent was not commonly known by the disputed domain where respondent employed a privacy service and the Whois record gave no indication that respondent was commonly known by the disputed domain); *Pima Fed. Credit Union v. Whois Privacy Corp.*, Case No. 100979 (CAC Aug. 20, 2015) (same).

### **Respondent Does Not Use The Disputed Domains For Any Legitimate Or Noncommercial Fair Use**

The use of a domain name to “phish for” or to deceptively gather consumer information is not a legitimate or noncommercial fair use. *See, e.g., Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592; *Blackstone TM L.L.C.*, Claim No. FA1003001314998; *Allianz of America Corporation v. Lane Bond d/b/a Allianzcorp*, Claim No. FA0604000690796 (Nat. Arb. Forum June 12, 2006) (finding that respondent’s use of the disputed domain “to fraudulently acquire the personal and financial information of Internet users” was not a legitimate noncommercial or fair use.). Here, Respondent is merely using the Disputed Domain to direct Internet users to a “phishing” website, i.e. the Infringing Website, where Respondent seeks (via a third party website contact form) to gather user information, which can, upon information and belief, be used to solicit highly sensitive user information due to the purported nature of Respondent’s business (a “financial services agency”), including highly confidential financial information. Such use of the Disputed Domain cannot, therefore, constitute any legitimate noncommercial or fair use. Hitachi has met its burden to make a prima facie showing that the Respondent has no rights or legitimate interest in the Disputed Domain. As such, the burden shifts to the Respondent to rebut Complainant’s showing. However, the evidence strongly demonstrates that Respondent lacks any rights or legitimate interest in the Disputed Domain and will be unable to meet this burden.

### **iii) THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH:**

#### **Respondent Intentionally Attempted To Divert Internet Users By Creating Likelihood Of Confusion**

A respondent has registered and/or used a domain name in bad faith where the purpose of the registration is to confuse consumers as to the source of the website. *See Paragraph 4(b)(iv)*. Here, Respondent is clearly attempting to create a likelihood of confusion as to the source, sponsorship,

affiliation and/or endorsement of the websites associated with the Disputed Domain. Not only does Respondent use Complainant's HITACHI mark without authorization, but Respondent also employs language to lead consumers to believe that the Infringing Website was created by Hitachi. For example, Respondent prominently displays the HITACHI mark at the top of the home page of the Infringing Website. *See* Annex 5; *see also H-D Michigan, Inc. v. Petersons Automobile a/k/a Larry Petersons*, FA 135608 (Nat'l Arb. Forum Jan. 8, 2003) (finding the disputed domain was registered and used in bad faith where "Respondent [] intentionally attempt[ed] to attract Internet users to its fraudulent website by using Complainant's famous marks and likeness"). Moreover, Respondent engages in such activities in connection with the HITACHI mark, and in spite of the Warning it received in 2015. *See* Annexes 5, 6.

### **Respondent Registered the Disputed Domain Primarily For The Purpose Of Disrupting Complainant's Business**

Respondent is using the Disputed Domain for no other reason than to disrupt Complainant's business by using the associated Infringing Website to "phish" for individuals to target and obtain their personal information under the guise of providing purported financial services. *See* Annex 5. Many Panels have ruled that "phishing" activity disrupts business within the provisions of paragraph 4(b)(iii) of the Policy. *See, e.g., Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 ("The Panel also notes that the Respondent is using the disputed domain name for no other reason than to disrupt Complainant's business by using the associated Infringing Website to "phish" for highly sensitive personal information under the guise of providing purported financial services ..."); *Blackstone TM L.L.C.*, Claim No. FA1003001314998 (finding that respondent had disrupted complainant's business by "using the disputed domain to 'phish' for users' personal information", and that, "[r]espondent presumably profits" from the action). Clearly Respondent is not operating a legitimate business, else it would not need to rely on duping consumers into believing that it was associated with Complainant. Moreover, the fact that Respondent has received a public Warning, yet continues to engage in such activities in connection with the HITACHI mark is further evidence of Respondent's bad faith and intent to trade off the Hitachi name and goodwill therein.

### **Respondent Was Or Should Have Been Aware Of Complainant's Rights In The HITACHI Mark and Registered The Disputed Domain In Bad Faith**

Complainant's trademark rights date back to at least as early as 1953. Since that time Complainant has expended substantial amounts of money and effort to ensure that consumers associate the HITACHI trademark with Hitachi and its services, discussed supra. The Disputed Domain was not created until well over fifty five years after Complainant's trademark rights were first registered, and is confusingly similar to the HITACHI trademark, discussed supra. The fact that Respondent displays the identical HITACHI trademark on the Infringing Website indisputably demonstrates that the Registrant was aware of the HITACHI trademark, and that Respondent registered the Disputed Domain with the bad faith intent to confuse consumers as to the source and/or sponsorship of the Disputed Domain. Even if Respondent did not have actual knowledge of the HITACHI mark (which it clearly did), Respondent had a duty to ensure that the registration of the Disputed Domain would not infringe a third party's rights. *See, e.g., Collegetown Relocation, L.L.C. v. John Mamminga*, FA 95003 (Nat'l 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"). Had Respondent performed a

simple Google search, it would have been presented with numerous search results relating and/or referring to Complainant and the existence of Complainant's rights in the HITACHI mark. A true and correct copy of screenshots of the Google search results (in the U.S. and Japan (with English translation)) for the term "hitachi" performed on September 30, 2019, is attached as Annex 7. It is clear that Respondent knowingly registered and has used the Disputed Domain to not only confuse customers as to the source of the Infringing Website, but also to disrupt Complainant's business, evidencing Respondent's bad faith use and registration of the Disputed Domain.

#### B. The Respondent

The Respondent is Privacy Proxy/Privacy Protection Service by VALUE-DOMAIN. The respondent in this administrative proceeding is unknown as the registrant's information on the Whois record for the disputed domain is redacted.

The Respondent did not file any Response in reply to the Complainant's contentions.

### 5. Findings

#### **Applicable principles and rules**

Under para. 14 (Default) of the Rules, in the event that a Party does not comply with any of the time periods established by the Rules, the Panel shall proceed to a decision on the complaint and the Panel shall draw such inferences as it considers appropriate. According to para. 15 (Panel Decisions) of the Rules, a Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the Rules, and any principles and rules of law that it deems applicable.

#### **Language of the Proceedings**

Under para. 11 (Language of Proceedings) of the Rules, the Panel has the authority to determine the language of the proceedings having regard to the circumstances. Para. 10(b) (General Powers of the Panel) of the Rules provides that the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

The general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her ability to articulate the arguments for the case.

Where a respondent does not respond to the complainant's communications (and thus it was not possible for the complainant to come to an agreement on the issue of the language of the proceeding), and the material facts of the proceeding are generally in English (eg, disputed domain name, the language of the respondent's and the complainant's websites, the services provided in the

websites, etc), the proceedings should be in English. This is so even if the respondent is on record not a native English speaker, if persuasive evidence has been adduced to suggest that the respondent is conversant and proficient in the English language. The objective is to ensure the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

Upon weighing all the relevant and special circumstances of the Parties, the Panel determines that it is appropriate for the Panel to exercise its discretion to conduct the proceeding in English.

As to the main substantive issue of this matter, the UDRP provides, at Paragraph 4(a) (Applicable Disputes), that each of three findings must be made in order for a Complainant to prevail:

- i. the Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. the Respondent's domain name has been registered and is being used in bad faith.

#### **A) Identical / Confusingly Similar**

The disputed domain name <www.hitachi-idi-holding.com> (Disputed Domain Name) is comprised of five elements: (1) "www." ie the World Wide Web, (2) "hitachi", (3) "-idi-", (4) "holding" and (5) the generic top-level domain ".com". As to "www.", the subdomain is a non-distinguishing feature. There is no actual need to include "www." in one's website address as it is a Uniform Resource Locator (URL) prefix caught on by old practice. As to ".com", it is trite rule that the generic top-level domain name suffix ".com" is technical in nature, does not have any proprietary significance, cannot confer any distinctiveness and is incapable of differentiating the Disputed Domain Name from others' proprietary rights. Thus both "www." and ".com", are disregarded under the confusing similarity test.

The potential distinctive elements of the Disputed Domain Name are: "hitachi", or "hitachi-idi-", or "hitachi-idi-holding". The Panel accepts that the generic term "holding" is a non-distinguishing feature. As to "idi", the Panel considers that the letters may be associated with an acronym standing for "industrial developments international", and, the hyphens between "hitachi" and "idi", and between "idi" and "holding", are also non-distinctive in the proprietary sense. The Panel takes the view that the dominant part of the Disputed Domain Name are the letters "hitachi" which are identical to the Complainant's trade mark. The addition of "-idi-holding" to the distinctive portion of the Disputed Domain Name does not create any proprietary significance. They do not draw a reasonable Internet user's attention away from the fact that the principal element of the Disputed Domain Name is identical to the Complainant's HITACHI mark, as it only indicates that the Disputed Domain Name is related to "-idi-holding".

It is trite rule that the evidential burden to establish confusing similarity requires a simple comparison of the mark relied upon with the disputed domain name in issue. The incorporation of a well-known trademark within a domain name is alone enough to sustain a finding of confusing similarity ie the

similarity is established whenever a mark is incorporated in its entirety, regardless of other terms added to the domain name. Thus, the Panel accepts that the mere additions of hyphenations, an acronym “idi” and a generic term “holding” to the HITACHI trademark does not avoid a finding of confusion.

The Panel agrees that the Complainant enjoys prior rights in its HITACHI Mark. Trademarks are not case sensitive. The Panel takes the view that considering the Disputed Domain Name as a whole, the addition of the non-distinctive letters “-idi-holding” at the end of “hitachi”, is identical or confusingly similar to the Complainant’s “hitachi” trade mark, does not confer to the whole a new meaning and does not dispel confusing similarity between the Disputed Domain Name as a whole and the Complainant’s proprietary trade mark.

The addition of “-idi-holding” in this case further increases the likelihood of confusion due to the Complainant’s notable presence in Japan, as the general public are likely to believe that the Disputed Domain Name relates to the Complainant’s official website in Japan and would further divert Internet users away from the Complainant’s official website at <hitachi.com>.

The Complainant has demonstrated that it owns the trademark registrations for its HITACHI mark in various jurisdictions, long before the Respondent applied to register the Disputed Domain Name on 17 May, 2009. When a registrant chooses to apply for the registration of a domain name, the registrant must represent and warrant, among other things, neither the registration of the domain name nor the manner in which it is directly or indirectly used infringes the legal rights of a third party. In this case, the Disputed Domain Name is confusingly similar to the Complainant’s registered HITACHI mark.

Given the worldwide renown, long-term use and established registered rights in the HITACHI Mark, and the above facts, the Panel finds that the Disputed Domain Name is confusingly similar to a trade mark in which the Complainant has rights, satisfying Paragraph 4(a) (i) of UDRP.

## **B) Rights and Legitimate Interests**

The most distinctive element in the Disputed Domain Name is “HITACHI”, which is a widely known indicia of the Complainant. The Panel takes notice that the Respondent only registered the Disputed Domain Name over five decades after the Complainant’s rights in the HITACHI mark were registered, is using the Disputed Domain Name as a front for an unregistered “financial services agency” to confuse consumers as to the source of the website, prompting users to potentially reveal sensitive personal information for the Respondent’s own gain.

The Panel accepts that the use of the Disputed Domain Name that is confusingly similar to a Complainant’s mark to pose as a “financial services agency” (one that is unregistered and has been publicly warned about its conduct by the local Japanese finance bureau) and/or for the purposes of “phishing” is not a bona fide offering of goods and services. The Panel takes notice that the Respondent has created a deliberate false association with the Complainant by using the

Complainant's HITACHI mark, copied in its entirety, within the Disputed Domain Name to operate a website that is posing as a registered financial services company. Such a deliberate, false association with the Complainant's trusted HITACHI mark, means users are likely to reveal highly sensitive and personal, financial information to the Respondent, solely for the Respondent's own gain, which does not constitute a bona fide offering of goods or services. It is trite rule that such use of a Disputed Domain Name to "phish for" or to deceptively gather consumer information, is not a legitimate or noncommercial fair use, and is not a bona fide use.

The Panel notes that neither the Whois record nor any other evidence of record indicated the Respondent is commonly known by the Disputed Domain Name. The Panel agrees that the Respondent's use of a privacy service to mask its identity only further supports the notion that the Respondent is not commonly known by the Disputed Domain Name.

It is trite rule that the use of a domain name to "phish for" or to deceptively gather consumer information is not a legitimate or noncommercial fair use. The Panel accepts that the Respondent is merely using the Disputed Domain Name to direct Internet users to a "phishing" website, i.e. the Infringing Website, where the Respondent seeks (via a third party website contact form) to gather user information, which can, upon information and belief, be used to solicit highly sensitive user information due to the purported nature of the Respondent's business (a "financial services agency"), including highly confidential financial information. Such use of the Disputed Domain Name cannot, therefore, constitute any legitimate noncommercial or fair use.

As proving a negative is always difficult, it is a well-established rule that a complainant's burden of proof on this element is light. The Panel rules that there is *prima facie* evidence to prove that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Since the Complainant satisfies the second requirement stipulated under Paragraph 4(a) of UDRP, it is up to the Respondent to discharge the evidential burden in demonstrating it has rights or legitimate interests in respect of the Disputed Domain Name.

The Respondent did not file any Response in reply to the Complainant's contentions.

It is trite rule that the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns rights and legitimate interests. The Panel takes the view that passing off the goodwill and reputation of others, which is contrary to the object and purpose of UDRP, cannot derive any rights or legitimate interests.

The Panel takes notice that after decades of commercial use, the "HITACHI" trade mark has acquired the recognition of the relevant sector of the public. The Complainant and the Respondent have no prior connection. The HITACHI mark is not a term commonly used in the English language. Further, the Respondent has submitted no evidence to demonstrate it has been commonly known by the Disputed Domain Name.

Nobody has any right to represent his or her goods or services as the goods or services of somebody else. The Complainant has not licensed or otherwise permitted the Respondent to use the Disputed

Domain Name or use any domain name incorporating the dominant part of the Complainant's registered trade mark.

The Panel considers that there is no evidence that would tend to establish that the Respondent has rights to or legitimate interests in respect of the Disputed Domain Name. The Panel draws the irresistible inference that the Respondent is not using the Disputed Domain Name on a non-commercial or fair use basis without intent to misleadingly divert the relevant sector of the public to its operation. On the contrary, the Respondent is using the Disputed Domain Name to tarnish the goodwill and reputation of the Complainant's trade mark.

The Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name, satisfying Paragraph 4 (a) (ii) of UDRP.

### **C) Bad Faith**

Paragraph 4 (b) (Evidence of Registration and Use in Bad Faith) of UDRP provides that for the purposes of Paragraph 4 (a) (iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or*
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or*
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor, or*
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.*

The Panel takes notice that the Complainant's trademark rights date back to at least as early as 1953. Since that time the Complainant has expended substantial amounts of money and effort to ensure that consumers associate the HITACHI trademark with Hitachi and its goods and services. The Panel takes the view that the Complainant's HITACHI Mark has become well-known due to its long term and extensive use. The Disputed Domain Name was created on 17 May 2009 and updated on 18 May 2009 containing the HITACHI Mark in its entirety, and is confusingly similar to the HITACHI trademark. As the Respondent displays the Disputed Domain Name on the Infringing Website, the Panel takes the

view that it demonstrates that the Respondent's intent to confuse consumers as to its source and/or sponsorship. Given the goodwill and reputation of the Complainant and the HITACHI Mark globally including Japan, the Panel considers that it is virtually impossible for the Respondent to have selected the Disputed Domain Name without knowing it. The Respondent should have been well aware of the Complainant and the HITACHI Mark prior to registration, and the Panel accepts that the Disputed Domain Name has clearly been registered and is being used in bad faith.

By registering and using the Disputed Domain Name, the Panel accepts that the Respondent has prevented the Complainant from using its marks in a corresponding domain name, and disrupted the business of the Complainant. Worst still, it has also created confusion among the general public in respect of the relationship between the Respondent's Website and the Complainant, increasing the likelihood of confusion.

As no reasonable explanation was offered by the Respondent for its continued registration and use of the Disputed Domain Name, the Panel infers that the Respondent has done so with the intent to pass off the Complainant's goodwill and reputation in its HITACHI Mark, and lead Internet users into believing that the Disputed Domain Name and/or the Respondent's Website or the business and activities referred to therein are associated with, endorsed or sponsored by the Complainant in some way, or that the Respondent's use of the Disputed Domain Name is authorized by the Complainant, or to attract Internet traffic by capitalizing on the association of "HITACHI" with the Complainant's HITACHI Mark, and further keep the Disputed Domain Name from being used by the Complainant. It is well established that use of the Disputed Domain Name merely intended to divert the public to the Respondent's Website cannot be considered as a bona fide offering of goods and services.

The Respondent's use of the Disputed Domain Name might even be attributable to the Complainant, which would tarnish not only the goodwill and reputation accumulated in the HITACHI Mark, but also disrupt the business of HITACHI. The Panel accepts that these are further evidence that the Disputed Domain Name is being used in bad faith.

The Panel notes that the Respondent is using the Disputed Domain Name for no other reason than to disrupt Complainant's business by using the associated Infringing Website to "phish" for users' personal information under the guise of providing purported financial services for gain. The Respondent is not operating a legitimate business, else it would not need to rely on duping consumers into believing that it was associated with the Complainant. The fact that the Respondent has received a public Warning, yet continues to engage in such activities in connection with the HITACHI mark is further evidence of the Respondent's bad faith and intent to pass off the Hitachi's goodwill and reputation.

The Panel takes notice that not only does the Respondent use the Complainant's HITACHI mark without authorization, but the Respondent also employs language to lead consumers to believe that the Infringing Website was created by Hitachi. The Respondent also displays prominently the Disputed Domain Name at the top of the home page of the Infringing Website and continues to engage in such activities in spite of the Warning it received in 2015.

The Panel considers that even if the Respondent did not have actual knowledge of the HITACHI mark, the Respondent had a duty to ensure that the registration of the Disputed Domain Name would not infringe a third party's rights. The Respondent has to investigate and refrain from so doing. A simple Google search would have been presented with numerous search results relating and/or referring to the Complainant and the existence of the Complainant's rights in the HITACHI mark. The Panel agrees that the Respondent's probable breach of the warranty divests it of any and all rights in the Disputed Domain Name.

It is trite rule that use which intentionally passes off the goodwill and reputation of another cannot constitute a "bona fide" offering of goods or services. Further, the Respondent has provided no evidence to demonstrate use of the Disputed Domain Name registered on 17 May, 2009 in good faith. The Panel draws the irresistible inference that the Respondent must have prior knowledge of the Complainant's "HITACHI" trade mark. The Panel takes the view that the Respondent, by registering the Disputed Domain Name, is a dishonest misappropriation of the Complainant's registered trade mark, making the Respondent's cybersquatting an instrument of fraud.

The Panel therefore finds that the Respondent's Disputed Domain Name has been registered and is being used in bad faith, satisfying Paragraph 4 (a) (iii) of UDRP.

## **6. Decision**

For all the foregoing reasons, the Panel concludes that the Complainant has provided sufficient proof of its contentions, has proven each of the three elements of Paragraph 4 of UDRP with respect to the Disputed Domain Name and has established a case upon which the relief sought must be granted. The Panel therefore orders that the registration of the Disputed Domain Name <www.hitachi-idi-holding.com> be transferred to the Complainant.

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Sole Panelist: Peter Cheung Kam Fai

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Date: 19 February, 2020