

ADMINISTRATIVE PANEL DECISION

Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. rams ram
Case No. D2024-4089

1. The Parties

The Complainant is Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation, Japan, represented by Hogan Lovells (Paris) LLP, France.

The Respondent is rams ram, India.

2. The Domain Name and Registrar

The disputed domain name <toshibaindia.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2024. On October 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 7, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 9, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 11, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 13, 2024.

The Center appointed James Bridgeman as the sole panelist in this matter on November 18, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a manufacturer of electronic and electrical products and provider of related services which are marketed under the TOSHIBA mark, for which the Complainant has furnished evidence in the English language of the registrations including the following:

- Indian TradeMark TOSHIBA, registration number 273761, registered on July 26, 1971 for goods in international class 16;
- New Zealand TradeMark TOSHIBA, registration number 181906, TOSHIBA, registered on February 25, 1992 for goods and services in classes 4 and 42;
- European Union TradeMark TOSHIBA, registration number 000961482, registered on June 5, 2000 for goods in classes 1, 7, 9, and 16;
- United States of America registered trademark TOSHIBA, registration number 2550266, registered on the Principal Register on March 19, 2002 for goods in international classes 1, 6, 7, and 9.

The Complainant has an established Internet presence and maintains its principal website at "www.toshiba.com".

The disputed domain name was registered on May 18, 2024. It has been used to create an email account from which emails purporting to impersonate the Complainant offering employment to unsuspecting third parties, and at the time of filing of the Complaint it resolved to an inactive web page.

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

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant claims rights in the TOSHIBA trademark and service mark established by its ownership of the portfolio of registrations described below and use of the mark on a broad range of electronic and electrical products and systems for the consumer, commercial, and industrial sectors.

Referring to supporting evidence, which is exhibited in annexes to the Complaint, the Complainant submits that since it was founded following a merger of two established corporations in 1939, it has grown to develop a considerable global reputation in the TOSHIBA brand. As of December 31, 2023, the Complainant had an annual turnover of JPY 3285.8 billion. As of March 31, 2023, the Complainant had over 106,000 employees across a global network of offices in addition to its headquarters in Tokyo, Japan, including in the United States of America, Germany, Viet Nam, China, Singapore, and the Republic of Korea.

Relevantly the Complainant has six subsidiaries in India.

The Complainant adds that it has an established Internet presence including on the major social media platforms. In addition to being the owner of the branded new generic Top-Level Domain (“gTLD”) “.toshiba”, the Complainant owns a large portfolio of Internet domain names consisting of or containing “TOSHIBA”, including <toshiba.com>, registered in 1992, from which it operates its main corporate website. Its other domain names include <toshiba.biz>, <toshiba.net>, <toshiba.org>, <toshiba.ca>, <toshiba.es>, <toshiba.eu>, <toshiba.fr>, <toshiba.jp>, <toshiba.in>, and <toshiba.us>.

The Complainant firstly alleges that the disputed domain name is identical or confusingly similar to the Complainant’s TOSHIBA mark because it comprises the mark in its entirety followed by the geographic term “India”. In this regard the Complainant cites the decision in *Amgen, Inc. v. Amgen India, AMGEN India Inc.*, WIPO Case No. [D2019-1217](#) (where the panel noted that the AMGEN mark in which the complainant relied was incorporated in its entirety in the domain name at issue, <amgenindia.com>, and the panel found that the addition of the term “India” did not prevent a finding of confusing similarity).

Furthermore, referring to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.11.1, the Complainant submits that the gTLD extension “.com” may be ignored for the purposes of comparison of the mark and the disputed domain name, because it should be viewed as a standard registration requirement.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name arguing that:

- because the disputed domain name was registered using a proxy service, and the identity of the underlying registrant is unknown there is no evidence to suggest that the Respondent is commonly known by the disputed domain name, as contemplated by paragraph 4(c)(ii) of the Policy;
- there is no evidence that the Respondent has acquired or applied for any trademark registrations for “toshiba”, “toshiba india” or any variation thereof, as reflected in the disputed domain name;
- the Respondent has not received any license or other authorization of any kind to make use of the Complainant’s trademark in the disputed domain name or otherwise;
- the Respondent cannot assert that prior to any notice of this dispute it was using, or had made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, in accordance with Policy paragraph 4(c)(i);
- the Respondent is not using the disputed domain name in connection with any bona fide offering of goods or services; but rather, the copy email correspondence which is exhibited in an annex to the Complaint shows that the Respondent is using the disputed domain name in the furtherance of a fraudulent employment phishing scheme intended to mislead Internet users into believing that they are dealing with the Complainant;
- specifically, the exhibited copy email correspondence shows that the Respondent is using the disputed domain name as part of a fraudulent employment phishing scheme impersonating one of the Complainant’s Indian subsidiaries, Toshiba India Pvt. Ltd.; the scheme involves sending an email to unsuspecting Internet users from the email address [...]@toshibaindia.com, with related email addresses in copy, purporting to be from the “Sr Director – Human Resources” of “Toshiba India Pvt. Ltd”; the email impersonating the Complainant attaches an offer of employment for the position of “Associate Software Engineer”, a position related to the Complainant’s activities, as well as a detailed breakdown of “Compensation Structure” as well as a detailed list of benefits available under the employment contract; and the employment offer features the Complainant’s red color scheme and TOSHIBA logo and figurative trademark and seeks to induce Internet users to provide extensive documentation, including disclosing personal identifying information;
- such use of the disputed domain name cannot support any legitimate claim of being commonly known by the disputed domain name independently from the Complainant’s rights in the TOSHIBA trademark, nor does it give rise to any bona fide reputation in the disputed domain name itself;
- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name; nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers, within the meaning of paragraph 4(c)(iii) of the Policy;

- neither can the Respondent assert that prior to any notice of this dispute it was using, or had made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy.

The Complainant next argues that the disputed domain name is registered and is being used in bad faith, arguing that the TOSHIBA mark which is incorporated into the disputed domain name is inherently distinctive and well known in connection with the Complainant's electronic and electrical products and is exclusively associated with the Complainant.

The TOSHIBA mark has been continuously used by the Complainant for over 30 years and as a result, had acquired a considerable reputation and goodwill prior to the registration of the disputed domain name in May 2024.

The Complainant submits that the Respondent, having no relationship with the Complainant or authorization to make use of its trademarks in the disputed domain name or otherwise, proceeded to register the disputed domain name, carrying with it a risk of implied affiliation with the Complainant's TOSHIBA trademark, with a view to impersonating the Complainant and engaging in a fraudulent employment phishing scheme, in bad faith.

In light of the above, the Complainant submits that the Respondent could not credibly argue that it did not have knowledge of the Complainant and its rights in the TOSHIBA trademark when registering the disputed domain name.

The Complainant submits that the exhibited email correspondence shows that the Respondent is using the disputed domain name in bad faith to create an email account from which the Respondent is sending fraudulent emails to engage in phishing for personal information while falsely purporting to present itself as the Complainant.

The Complainant adds that the fact that the disputed domain name does not resolve to an active web page does not cure the Respondent's clearly illegitimate use of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, "India" may bear on assessment of the second and third elements, the Panel finds the addition of such term[s] does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, here, claimed as specifically applicable to this case: the Respondent’s use of the disputed domain name to create an email account from which emails are being sent, impersonating the Complainant, falsely purporting to make non-existent offers of employment to unsuspecting third parties for the purposes of collecting their personal data, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain name was registered on May 18, 2024, long after the Complainant relevantly registered its TOSHIBA mark in India on July 26, 1971.

TOSHIBA is a distinctive mark and the disputed domain name consists of the mark in its entirety with the geographical term “India”. It is implausible that the registrant of the disputed domain name was unaware of the Complainant and its TOSHIBA mark when the disputed domain name was chosen and registered.

On the balance of probabilities, the disputed domain name was in fact chosen and registered with the Complainant’s mark in mind intending to create an inference of an association with and take predatory advantage of the Complainant’s goodwill in the Indian market.

Panels have held that the use of a domain name for illegal activity, here, claimed as applicable to this case: phishing, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

In uncontested submissions the Complainant has adduced convincing evidence that the disputed domain name is being used to send email messages in which the sender is purporting to falsely represent itself as the Complainant.

The text in the exhibited messages which are more fully described in the Complainant's submissions above, show that on the balance of probabilities the Respondent is engaged in a phishing scheme to collect personal data from unsuspecting members of the public under the guise of purporting to offer job opportunities.

This is a callous abuse of the Complainant's trademark and goodwill by the Respondent and constitutes use in bad faith for the purposes of the Policy. Also, as the Complainant has submitted the fact that the disputed domain name does not resolve to any active website does not prevent a finding that the disputed domain name was registered and is being used in bad faith.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <toshibaindia.com> be transferred to the Complainant.

/James Bridgeman/

James Bridgeman

Sole Panelist

Date: December 2, 2024