

## **ADMINISTRATIVE PANEL DECISION**

Hitachi, Ltd. (Kabushiki Kaisha Hitachi Seisakusho) v. David J. Perkins,  
Worldwide Domains  
Case No. DPH2022-0002

### **1. The Parties**

The Complainant is Hitachi, Ltd. (Kabushiki Kaisha Hitachi Seisakusho), Japan represented by Rodenbaugh Law, United States of America (“United States”).

The Respondent is David J. Perkins, Worldwide Domains, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <hitachi.ph> (the “Disputed Domain Name”) is registered with DotPH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2022. On October 4, 2022, the Center transmitted by email to DotPH a request for registrar verification in connection with the Disputed Domain Name. On October 5, 2022, DotPH 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 (Privacy Protected by Registry) and contact information in the original Complaint. The Center sent an email communication to the Complainant on October 5, 2022, 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 10, 2022.

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

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 11, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 1, 2022.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on November 10, 2022. 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**

Founded in 1910, the Complainant is a Japanese transnational company offering a variety of products to consumers, businesses and governments, such as telecommunications and infrastructure solutions, electronic systems and equipment. The Complainant operates its business through its hundreds of subsidiaries worldwide under the HITACHI mark. The Complainant and its subsidiaries are commonly referred to as the “Hitachi Group”. The Hitachi Group currently employs about 300,000 people worldwide and provides products and services around the world under the HITACHI mark. Through extensive use by the Complainant and its subsidiaries, the HITACHI mark is well-known in Japan, the United States, the Philippines and throughout the world.

The Complainant is the owner of a number of trade mark registrations for the HITACHI mark in the world, including, *inter alia*, Philippines Trademark Registration No. 419602598 in Class 9 registered on December 1, 1960, United States Trademark Registration No. 701266 in Classes 7, 9 and 11 registered on July 19, 1960, Japan Trademark Registration No. 1492488 in Class 11 registered on December 25, 1981, European Union Trademark Registration No. 000208645 in Classes 1 to 42 registered on December 21, 1999, European Union Trademark Registration No. 001070192 in Classes 1 and 5 registered on September 19, 2000, European Union Trademark Registration No. 002364313 in Class 40 registered on November 27, 2002, European Union Trademark Registration No. 002809903 in Classes 42 to 45 registered on October 3, 2003, and United Kingdom Trademark Registration No. UK00000811836 in Class 9 registered on October 11, 1960 (together, the “Complainant’s Trademark”). The Complainant’s Trademark is also fully incorporated in various domain names, including, *inter alia*, <hitachi.com.ph>, which is registered by Hitachi Asia Ltd. – Philippine Branch Office (the “Complainant’s Domain Name”).

The Disputed Domain Name was registered on January 11, 2022, which is more than 60 years after the Complainant’s Trademark was first registered. The Disputed Domain Name resolves to a website displaying a security warning and inviting Internet users to download anti-virus security software, and displaying the logo “Microsoft”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant’s primary contentions can be summarized as follows:

- (a) The Disputed Domain Name is identical to the Complainant’s Trademark. The Complainant’s Trademark is reproduced in its entirety in the Disputed Domain Name. The only element which differentiates the Disputed Domain Name from the Complainant’s Trademark is the addition of the country code Top-Level Domain (“ccTLD”) “.ph”.
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not received any licence or other authorization of any kind to make use of the Complainant’s Trademark as part of a domain name or otherwise. Moreover, the Disputed Domain Name resolves to a fake “Microsoft” website, which the Respondent is using for commercial gain. Hence the Respondent does not use and has not used the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

(c) Both the Respondent's registration of and its use of the Disputed Domain Name establish the Respondent's bad faith. The Respondent's registration of the Disputed Domain Name, which is identical or confusingly similar to the Complainant's Trademark, is in itself an act of bad faith by someone with no legal connection with the Complainant's business. Moreover, the Respondent must have been fully aware of the existence of the Complainant's rights in the Complainant's Trademark when it registered the Disputed Domain Name and used the Complainant's Trademark because of the widespread reputation acquired by the Complainant in the Complainant's Trademark. The Disputed Domain Name is also offered for sale at USD5,000, which is substantially in excess of the out-of-pocket costs to register the Disputed Domain Name. Furthermore, through the likelihood of confusion arising from the confusing similarity between the Disputed Domain Name and the Complainant's Trademark, the Respondent has attempted to illegitimately profit by directing Internet users to a fake "Microsoft" website. Notably, the Respondent also has a pattern of bad faith conduct a history of bad faith registrations which were the subject of other UDRP cases. Given these factors, it is clear the Respondent has registered and is using the Disputed Domain Name in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) The Disputed Domain Name has been registered and is being used by the Respondent in bad faith.

### **A. Identical or Confusingly Similar**

The Panel accepts that the Complainant has rights in the Complainant's Trademark based on the various trademark registrations listed above in Section 4.

It is well established that in making an enquiry as to whether a trademark is identical or confusingly similar to a domain name, the ccTLD extension, ".ph" in this case, may be disregarded. See section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")<sup>1</sup>.

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety. UDRP panels have consistently found that a domain name that wholly and only incorporates a complainant's trademark is identical or confusingly similar to the complainant's trademark (see *Société Air France v Indra Armansyah*, WIPO Case No. [D2016-2027](#); and *Icebug AB v. Domain Administrator*, WIPO Case No. [D2013-1823](#)).

As such, the Panel finds that the Disputed Domain Name is identical to the Complainant's Trademark and accordingly paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has

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<sup>1</sup> In view of the similarities between the .PH Policy and the Uniform Domain Name Dispute Resolution Policy (UDRP), the Panel will refer to previous UDRP decisions and the [WIPO Overview 3.0](#) when relevant.

rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondent which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

The Respondent did not submit a formal Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a formal Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(b) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) Before any notice to him of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) The Respondent has been commonly known by the Disputed Domain Name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name. The Panel also notes the nature of the Disputed Domain Name, being identical to the Complainant's Trademark, carries a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Disputed Domain Name resolves to a webpage impersonating a Microsoft webpage. It contains a security warning and invites Internet user to download anti-virus security software. The Panel agrees with the Complainant that the Respondent's use of the Disputed Domain Name to impersonate a Microsoft webpage cannot be regarded as legitimate noncommercial or fair use. In fact, an illegal use can never confer rights or legitimate interests in the Disputed Domain Name on the Respondent. See section 2.13.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

UDPR panels have consistently found that the mere registration of a domain name that is confusingly similar or identical to a widely-known trademark by an unaffiliated entity can already by itself creates a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

After reviewing the supporting evidence submitted by the Complainant, the Panel agrees with the Complainant that the Complainant's Trademark appears to be well known globally. A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "hitachi" are the

Complainant's websites and third party websites providing information relating to the Complainant's goods and services. Therefore, the Panel agrees that the Respondent must have been aware of the Complainant and the Complainant's Trademark when registering and using the Disputed Domain Name.

The Panel also agrees with the Complainant that the following factors support a finding that the Disputed Domain Name was registered and has been used by the Respondent in bad faith:

(i) The Respondent registered the Disputed Domain Name using a privacy shield to conceal its identity (see *Primonial v. Domain Administrator, PrivacyGuardian.org / Parla Turkmenoglu*, WIPO Case No. [D2019-0193](#)).

(ii) It is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name is identical to the Complainant's Trademark.

(iii) The Respondent failed to provide evidence of any actual or contemplated good faith use by it of the Disputed Domain Name.

UDPR panels have held that two or more instances of abusive domain name registrations are sufficient evidence to establish a pattern of bad faith conduct. See section 3.1.2 of the [WIPO Overview 3.0](#). In this regard, the Panel notes that the Respondent was named in four previous UDRP proceedings concerning four different trademarks where the domain names were ordered to be transferred to the respective complainants. The Panel therefore finds that the Respondent has been engaging in a pattern of bad faith conduct through its bad faith registration of multiple domain names reflecting third party trademarks.

In the circumstances, the Panel finds that the Respondent registered and has been using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

## 7. Decision

For all 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 <hitachi.ph> be transferred to the Complainant.

*/Gabriela Kennedy/*

**Gabriela Kennedy**

Sole Panelist

Date: November 28, 2022