



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Kabushiki Kaisha Hitachi Seisakusho v. Jorge Borborema

Case No. DTV2001– 0030

1. The Parties

The Complainant is Kabushiki Kaisha Hitachi, Seisakusho (Japan Corporation), 6.Lamda-Surugadai 4-chome, Chiyoda-ku, Tokyo, 101-8010, Japan.

The Respondent is Jorge Borborema, Icoaraci, Belem, para, 67800 Brazil.

2. The Domain Name and Registrar

The Domain Name is <日立.tv> (ACE Encoding:ra--3bs6k6wl.tv).

The Registrar is The .tv Corporation International, 1100 Gkendon Ave., 8th floor, Los Angeles, California 90024, United States of America.

3. Procedural History

The Complaint was filed by e-mail on December 14, 2001, and sent in hard copy on December 21, 2001. On January 14, 2002, an amendment to the Complaint was made by e-mail, and followed in hard copy on January 15, 2002 and by the signed original on January 23, 2002. The payment was properly made.

It was filed in accordance with the Uniform Policy for Domain Name Dispute Resolution, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 (“the Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999 (“the Rules”) and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the Supplemental Rules”).

On January 17, 2002, the Complaint was properly notified to the Respondent in accordance with Paragraph 2(a) of the Rules. But, no response was timely filed by the Respondent. On February 26, 2002, namely after his default, the Respondent sent a submission by e-mail.

On February 26, 2002, the Administrative Panel was properly constituted and notified to the parties.

The date scheduled for the issuance of the Panel's decision is March 12, 2002.

4. Factual Background

The Complainant, Hitachi, Ltd. [hereinafter "Hitachi"] has used the trade-mark HITACHI in both Roman and Kanji characters [hereinafter the "MARK", meaning both Roman and Kanji-character versions]. HITACHI (Roman characters) is the transliteration of the phonetic sound of the Kanji characters for "HITACHI" (日立) in the Japanese language.

The MARK was first registered at the Japanese Patent Office in Kanji characters in 1923, and in Roman characters in 1953. The Roman character MARK is licensed to approximately 600 Hitachi subsidiaries in over 35 countries. The Kanji character MARK is licensed to Hitachi subsidiaries in countries or areas of Chinese character inheritance, i.e. Japan, China, Taiwan, Hong Kong and Macau.

The Japanese Patent Office has recognized the MARK as well-known and has granted to Hitachi the defensive mark registrations.

The Complainant and its subsidiaries also own an extensive domain name portfolio incorporating the MARK, which comprise hundreds of .com registrations, over 200 registrations in the 99 unrestricted ccTLDs and over 60 multilingual registrations in Kanji characters and Chinese characters.

On November 10, 2000, the Complainant discovered that the domain name <日立.tv> was registered on September 27, 2000, by the registrant identified as Roberio Rocoda Ramos (hereinafter referred to as "R.Ramos"), of Hamamatsu City, Shizuoka Prefecture, Japan.

The Complainant contacted R.Ramos by e-mail on January 23, 2001, requesting disclosure of any legitimate interest he may have in the Kanji MARK, the reason for his registration and that <日立.tv> be transferred to it in exchange for reimbursement of registrant's out-of-pocket registration costs.

The Complainant received an e-mail response from R.Ramos on January 29, 2001, in which he claimed to have registered <日立.tv> not for himself but for his anonymous "customer" in Brazil, who was prepared to transfer it to Hitachi for a total of USD9,140, which allegedly comprised (1) the actual registration [USD90] and transfer fees [USD50] payable to the Registrar; (2) R.Ramos' USD1,500 "fee" for his services as "agent" and (3) part of the alleged cost of a homepage that was supposedly under construction.

In a further e-mail exchange with R.Ramos, the Complainant again offered to reimburse his out-of-pocket registration costs, but sought further particulars of the USD9,140. Further information was also requested regarding R.Ramos' relationship with his "customer", as well as the purpose of the homepage. R.Ramos confirmed the Registrar's registration fee and his own USD1,500 "agent's" charges, but he did not know his "customer" personally, nor was he aware of the actual purpose of the registration.

While preparing for this Complaint after unsuccessful negotiations with R.Ramos, the Complainant discovered on August 1, 2001, that R.Ramos transferred the domain name <日立.tv> to the Respondent, a Brazilian resident.

On August 3, 2001, the Complainant wrote to the Respondent by e-mail/registered mail to ensure that the Respondent had adequate notice of Hitachi's trade-mark/trade-name rights in the MARK and was able to personally consider the Complainant's request for the transfer of <日立.tv> in exchange for reimbursement of the Respondent's out-of-pocket registration expenses. The Complainant also summarized in this letter the communications with R.Ramos to date and requested disclosure of any rights Respondent believed he had in <日立.tv>.

On September 17, 2001, the Respondent replied by e-mail claiming that he had not registered <日立.tv> in bad faith because "hitati" is the name of a Japanese city. The message contained a link to a webpage containing brief details about Hitachi City in Japan.

On September 19, 2001, the Complainant sent a letter to the Respondent noting that the existence of a city by this name in no way diminishes Hitachi's trade-mark/trade-name rights in the word HITACHI, both in Kanji and Roman characters. Further, the Respondent was again offered reimbursement of its out-of-pocket costs (approximately USD300) associated with registering <日立.tv> in exchange for its transfer.

As of the date of this Complaint, the Complainant received no further communication from the Respondent and <日立.tv> remained inactive.

5. Parties' Contentions

A. Complainant

Based on the factual background (4.), the Complainant contends as follows.

1) The Panel's Jurisdiction

This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The Registration Agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the Policy.

The Registration Agreement that was in effect on this date (updated as of September 15, 2000) provides in paragraph 3 thereof that the registrant agrees to comply with the dotTV policies (which include the Registration Agreement and Dispute Policy), including amendments and modifications thereto that are made by dotTV during the term of the Agreement. Paragraph 13 of the Registration Agreement incorporates, and subjects the domain name in issue to the Policy. This Registration Agreement has since been amended, the most recent update being dated November 6, 2001. The domain name in issue is still subject to the Policy pursuant to Paragraph 9 and Schedule A, Paragraph 16 of the current version of the Agreement.

2) Submission to this Panel Proceeding

In addition, in accordance with the Policy 4(a), the Respondent is required to submit to a mandatory administrative proceeding because:(1) the domain name is identical or

confusingly similar to a trademark or service mark in which the Complainant has rights; and (2) the Respondent has no rights or legitimate interests in respect of the domain name; and (3) the domain name was registered and is being used in bad faith.

3) Domain Name Identical to Complainant's Mark [the Policy 4(a)(1), the Rules 3(b)(ix) (1)]

The Complainant submits that the domain name <日立.tv> is identical to its MARK in its entirety. Given Hitachi's long-standing registrations for and use of the MARK, as well as the MARK's distinctiveness and fame, the MARK is not one which traders would legitimately choose to adopt in either Kanji or Roman characters unless seeking to create an impression of association with Hitachi. Visitors to a website at <日立.tv> would likely consider it to be affiliated with, sponsored or endorsed by Hitachi, or its subsidiaries.

Further, it is inconceivable that the Respondent would be unaware of the HITACHI MARK, both in Kanji and Roman characters, and the Hitachi trade-name, and associated fame, reputation and goodwill that Hitachi has established internationally, including among people of cultures familiar with Kanji or Chinese characters, over the past nine decades.

4) Lack of Rights or Legitimate Interests [the Policy 4(a)(2),4(c)(i)(ii)(iii)]

The Complainant contends that the Respondent cannot demonstrate rights or a legitimate interest in <日立.tv> in accordance with those criteria, nor can it produce any other evidence to justify its unauthorized use of the MARK in the disputed domain name.

The Respondent does not have and has never had any relationship with Hitachi or its subsidiaries, nor have they ever authorized it to use the MARK for any purpose.

The Respondent has not used nor made demonstrable preparations to use <日立.tv> in connection with a bona fide offering of goods or services such that it would have any rights or legitimate interest in this domain name.

The Complainant contends that there is no, nor has there ever been any, evidence or assertion of any facts by the Respondent, R.Ramos, or otherwise to indicate that the Respondent is, or has ever been known by the domain name or any name other than that appearing in the WHOIS record, or that the Respondent has ever acquired any trademark, service-mark or other rights in the domain name.

Since the Complainant first discovered the registration of the MARK as a domain name to the present, <日立.tv> has not linked to an active web site involved in any fair use offer of goods or services by the Respondent, nor has the Respondent established any other presence on the Internet in association with <日立.tv>.

The Respondent is currently making no legitimate non-commercial or fair use whatsoever of <日立.tv>.

5) Bad Faith [the Policy 4(a), 4(b)(i)(ii)(iii)(iv), the Rules 3(b)(ix)]

The Complainant contends that the registration and use of the domain name <日立.tv> by the Respondent is in bad faith for the following reasons.

The Respondent attempted to extract a very substantial amount of money from the Complainant that greatly exceeds its documented out-of-pocket costs related to the registration of <日立.tv>. The Complainant initiated contact both with the original registrant and the Respondent and attempted in good faith to resolve this matter on mutually beneficial terms. Although various representations were made to the Complainant during the course of communications regarding certain "charges" in addition to the registration fee (i.e. "agency" fees, homepage development costs) that were associated with the ultimate acquisition of <日立.tv> by the Respondent, these extra charges of USD 9,140 were never substantiated by R.Ramos or the Respondent despite Hitachi's numerous requests.

The Complainant submits that the Respondent registered <日立.tv> in order to prevent Hitachi from reflecting its MARK in this corresponding domain name, particularly in view of (a) the Respondent's lack of any relationship whatsoever with Hitachi, including authorization to use the MARK as part of a domain name or otherwise, (b) the fact that the Respondent cannot demonstrate any rights to or legitimate interests in <日立.tv> as previously described, and (c) the Respondent's refusal to negotiate with the Complainant in good faith and/or provide credible grounds for its entitlement to a domain name comprised entirely of the Complainant's MARK, even after being made aware of the Complainant's prior rights to the MARK.

The Complainant submits that the Respondent's conduct prior to the filing of this Complaint has demonstrated (1) its intention to use <日立.tv> primarily for the purpose of disrupting the business of the Complainant and (2) that there is the possibility that the Respondent is planning to use <日立.tv> to intentionally attract, for commercial gain, Internet users to a website by creating a likelihood of confusion with the Complainant's MARK as to the source, sponsorship, affiliation or endorsement of the Respondent's website or of products on such website.

The Complainant has repeatedly asked the Respondent about any possibility that the Respondent may believe he is entitled in some way to a domain name comprised solely of the Complainant's MARK in its entirety, but the Respondent ignored the Complainant's requests for cooperation and has maintained the registration.

As to the use and non-use of the domain name in issue, the Complainant contends that UDRP cases have clearly established that in given factual situations, the concept of bad faith use of a domain name includes non-use or inaction on the part of the Respondent. This principle, originally enunciated in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 has been adopted by numerous UDRP Panels to date, for e.g. *The NASDAQ Stock Market, Inc. v Steve Grewal*, WIPO Case No. DTV2001-0001.

With respect to the Respondent's claim that the MARK in Kanji means the name of a city in Japan, thus implying that the Complainant is prevented from claiming exclusive rights (trade-mark or otherwise) to the word HITACHI in Kanji (日立), the Complainant contends that this issue is irrelevant, because the right of private entities which incorporate a geographical or city name in their domain name may be challenged by such government or administrative authorities, unless they have established rights or a legitimate interest in such name and in the instant case, the Respondent has not demonstrated any such legitimate rights or interest beyond asserting that HITACHI is the name of a city in Japan.

Summing up, the Complainant contends that all of the Respondent's actions or inactions mentioned above are indicative of the registration and use of the domain name in bad faith.

- 6) In conclusion, the Complainant contends that it has shown all three elements required to be proved under the Policy 4(a) and claims that the domain name <日立.tv> owned by the Respondent be transferred to the Complainant.

B. Respondent

This is a default case. There are no contentions on the part of the Respondent. However, the Respondent sent a submission by e-mail afterwards. The following is a part of this submission, which is reproduced for the sake of discretionary considerations of the Complaint.

“There are two names called Hitachi in Japan. One is an electric relation and the one is the name of a city, ...Hitachi think that something like I'm going to sell hitachi electrical products.but I am thinking to make a homepage of Hitachi city.There are no relationship of between Hitachi electric relation to Hatachi city... When you register Domein, you're going to register miami, not miami city.am I right? When you register Domein, you're going to register Japan, not Japan country.am I right? ...That is why the name of China is on sale for \$100,000.But the name of China country on sale for \$ 50...If this name is very important to Hitachi electric relation.why they don't buy it before I baught,i have registred this name day 27 sept 2000 hitachi eletric have first contact to mr ramos day 23 jan 2001 (four mounts after),dot tv had started to domein register few month before.my homepage still not open ,so there is no prove that I have bad faith.”(sic)

6. Discussion and Findings

1) Jurisdiction and Authority

The Registration Agreement, pursuant to which the domain name <日立.tv> that is the subject of this Complaint is registered, incorporates the Policy. Therefore, this dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute.

2) The Submission of the Respondent to this Panel Administrative Proceeding

In accordance with Paragraph 4(a) of the Policy, the Respondent is required to submit to a mandatory administrative proceeding because (1) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and (2) the Respondent has no rights or legitimate interests in respect of the domain name; and (3) the domain name was registered and is being used in bad faith.

3) Identical or Confusingly Similar [Paragraph 4(a)(i) of the Policy and Paragraph 3(b)(ix) of the Rules]

The domain name <日立.tv> is the Kanji characters of HITACHI which is identical to the Mark in its entirety.

As the Complainant contends, the Mark is not one which traders would legitimately choose to adopt in either Kanji or Roman characters unless seeking to create an impression of association with Hitachi. Further, it is inconceivable that the Respondent would be unaware of the HITACHI MARK, both in Kanji and Roman characters, and the Hitachi trade-name, and associated fame, reputation and goodwill that Hitachi has established internationally, including among people of cultures familiar with Kanji or Chinese characters, over the past nine decades.

There are already some cases regarding the Mark. For examples, *Hitachi, Ltd. v. Fortune International Development Ent. Co. Limited.*, WIPO Case No. D2000-0412; *Hitachi, Ltd. v. Yosi Hasidim*, WIPO Case No. D2000-1542 and *Hitachi, Ltd. v. Ijam, Inc.*, WIPO Case No. D2000-1557, regarding <hitachi2000.net>, <hitachistore.com> and <ehitachi.com> respectively, which were all transferred to Hitachi because they were found to be *prima facie* identical or confusingly similar to its MARK since the dominant portion of each domain name comprised Hitachi's distinctive MARK in its entirety, and the additional elements were all descriptive and generic that were found to add nothing to the domain names as a whole.

The domain name <日立.tv> in this Complaint is comprised solely of the Kanji Mark in its entirety, without any other elements that could possibly distinguish the domain name and negate confusion with Hitachi's MARK. The same reason applies to the instant case where, as the Respondent asserts, the domain name <日立.tv> is for the city of HITACHI, unless he shows that he has any rights or a legitimate interest in it. Additionally, the word HITACHI (Roman and Kanji) has long been a registered trade-mark used extensively by the Complainant, it is now an internationally well-known trade-mark. Moreover, even in Japan the word HITACHI (in both Roman and Kanji characters) is generally identified with Hitachi, Ltd., its goods and services, rather than the city.

4) Lack of Rights or Legitimate Interest [Paragraph 4(a)(ii) and Paragraph 4(c) of the Policy]

The Respondent has not any rights or a legitimate interest in <日立.tv>, because the Respondent does not have and has never had any relationship with Hitachi or its subsidiaries, nor have they ever authorized it to use the MARK for any purpose.

The Respondent has not used nor made demonstrable preparations to use <日立.tv> in connection with a bona fide offering of information such that it would have any rights or a legitimate interest in this domain name. Furthermore, the Respondent is currently making no legitimate non-commercial or fair use whatsoever of <日立.tv>.

Even if, as the Respondent contends, the domain name <日立.tv> means that for the city of Hitachi, the Respondent has not shown any legitimate interest in registering and using such Mark.

5) Bad Faith [Paragraphs 4(a) and(b) of the Policy and Paragraph 3(b)(ix) of the Rules]

As is shown in the Factual Background (4.), when the Complainant first contacted R.Ramos, the registrant of the domain name <日立.tv>, R.Ramos claimed to have registered it not for himself but for his anonymous "customer" in Brazil and told that his customer was prepared to transfer it to Hitachi for a total of USD 9,140, which substantially exceeds (1) the actual registration [USD90] and transfer fees [USD50]

payable to the Registrar; (2) R.Ramos' USD1,500 "fee" for his services as "agent" and (3) part of the alleged cost of a homepage.

In the Respondent's delayed submission, the Respondent contends, *"If this name is very important to Hitachi electric relation.why they don't buy it before I baught,i have registred this name day 27 sept 2000 hitachi eletric have first contact to mr ramos day 23 jan 2001 (four mounts after)(sic) ..."*

Although this part of his submission is not clear, it is highly probable that the Respondent was the anonymous customer of R.Ramos, because the Respondent himself wrote that he registered it on September 27, 2000, which is the date of the registration of the domain name. Then, the Respondent himself attempted through R.Ramos as his agent to transfer the domain name for valuable consideration in excess of the out-of-pocket costs and registered and used the domain name <日立 .tv > in bad faith.

Apart from this reasoning, the Respondent may be held to register and use the domain name in bad faith for the following reasons. The Respondent's submission is here again relevant.

He first contends that the domain name <日立 .tv > means the city of Hitachi, not Hitachi, Ltd. His submission then asserts that the domain name of China only is far more expensive than that of China with the country name and questions why the Complainant did not buy such important domain name, ignoring the fact that the Complainant repeatedly attempted to buy it at a reasonable price. It follows impliedly that the Respondent is aware of the high value of the sole Mark of Hitachi and intended to sell the domain name <日立 .tv >, which is identical to the Complainant's Mark and in which the Respondent has no legitimate interest, at a much higher price than the out-of-pocket costs. These impliedly show the Respondent's bad faith.

Finally, the Respondent contends that he cannot be in bad faith before his homepage is not open. As the Complainant convincingly proves, the concept of bad faith use of a domain name includes non-use or inaction on the part of the Respondent.

7. Decision

In accordance with Paragraph 4(i) of the Policy and Paragraph 15(a) of the Rules, and for all the foregoing reasons, the Panel requires that the registered domain name <日立 .tv> be transferred to the Complainant.

Zentaro Kitagawa
Sole Panelist

Dated: March 12, 2002