

## **ADMINISTRATIVE PANEL DECISION**

International Business Machines Corporation (IBM) v. Karim Toumi,  
SPOTWORK

Case No. DAI2024-0069

### **1. The Parties**

The Complainant is International Business Machines Corporation (IBM), United States of America (“United States”), internally represented.

The Respondent is Karim Toumi, SPOTWORK, France.

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

The disputed domain name <ibmtechnology.ai> is registered with INTERNETX GMBH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2024. On September 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 1, 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 (John Doe; Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 2, 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 amendment to the Complaint on October 4, 2024.

The Center verified that the Complaint together with the amendment to the 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 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 1, 2024. The Respondent sent email communications to the Center on October 5, 2024, October 8, 2024, October 9, 2024, October 27, 2024, and November 1, 2024. On October, 27, 2024, the Respondent requested a four day extension of the Response due date in

accordance with Paragraphs 5(b) and 5(e) of the Rules. On October 28, 2024, the Center confirmed the extension of the Response due date until November 1, 2024. On November 6, 2024, the Complainant requested the suspension of the proceedings to discuss settlement with the Respondent. On November 6, 2024, the Center confirmed the suspension of the proceedings until December 6, 2024. On December 12, 2024, the Complainant requested the reinstatement of the proceedings. On December 12, 2024, the Center notified the reinstatement of the proceedings and the commencement of the panel appointment. The Respondent sent a further email communication to the Center on December 18, 2024.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on December 17, 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 was incorporated on June 16, 1911, as the amalgamation of three previously existing companies, having officially become International Business Machines on February 14, 1924, and offering products under the trademark IBM ever since, initially office and research equipment such as punch machines, calculating machines, clocks and scales, and presently information technology related goods and services.

The Complainant is the owner of trademark registrations for IBM in 131 countries around the world for a broad range of goods and services, amongst which:

- United States trademark registration No. 4,181,289 in classes 9, 16, 18, 20, 21, 22, 24, 25, 28, 35, and 41 registered on July 31, 2012;
- United States trademark registration No. 3,002,164 in class 9 registered on September 27, 2005;
- United States trademark registration No. 1,696,454 in class 36 registered on June 23, 1992;
- United States trademark registration No. 1,694,814 in class 36 registered on June 16, 1992;
- United States trademark registration No. 1,243,930 in class 42 registered on June 28, 1983;
- United States trademark registration No. 1,205,090 in classes 1, 7, 9, 16, 37, and 41 registered on August 17, 1982;
- United States trademark registration No. 1,058,803 in classes 1, 9, 16, 37, 41, and 42 registered on February 15, 1977; and
- United States trademark registration No. 640,606 in class 9 registered on January 29, 1957.

Previous UDRP Panels recognized that “the Complainant’s trademark has a strong reputation and is widely known throughout the world” (*International Business Machines Corporation v. Sadaqat Khan*, WIPO Case No. [D2018-2476](#)).

The disputed domain name was registered on January 21, 2024. Presently it resolves to a registrar parked webpage.

#### **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.

Notably, the Complainant asserts to be a leading innovator in the design and manufacture of a wide array of products that record, process, communicate, store and retrieve information, including computers and computer hardware, software; having its IBM trademark become a world-famous trademark as a result of

extensive efforts to protect the Complainant's name and enforce the IBM trademark, having the Complainant spent over USD 1 billion annually in marketing the Complainant's goods and services using the IBM trademark, which was ranked, in 2024, the 16th most valuable global brand by BrandZ.

Under the Complainant's view, the disputed domain name entirely reproduces the Complainant's well-known IBM trademark followed by the descriptive term "technology" thus being clearly confusingly similar thereof.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- i) the Complainant has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain name;
- ii) there is no evidence that Respondent is using the disputed domain name in connection with a bona fide offering of goods or services;
- iii) there is no evidence of either the Respondent being known by the disputed domain name or having used the disputed domain name in a manner consistent with fair use; and
- iv) the Respondent has configured an email server on the disputed domain name, potentially indicating the intention of using the disputed domain name for purposes other than hosting a website, including potentially constructing an email composition to be used for deceiving or fraudulent purposes.

As to the registration and use of the disputed domain name in bad faith, the Complainant asserts that its IBM trademark is well-known internationally, being the Complainant a company that offers technological products and services, including artificial intelligence solutions, and consumers are likely to believe that the disputed domain name is associated with the Complainant; an association that could be extremely harmful should the email server configured on the disputed domain name be used in connection with fraudulent purposes. Furthermore, bad faith also arises in view of the passive holding of the disputed domain name and in the fact that the Respondent has ignored the Complainant's attempts to resolve this dispute outside of this administrative proceeding.

## **B. Respondent**

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

The Respondent sent email communications to the Center on October 5, 2024 (asking clarifications); October 8, 2024 (requesting a call to discuss the situation), October 9, 2024 (asking for English translation), October 27, 2024 (requesting a four day extension of the Response due date in accordance with Paragraphs 5(b) and 5(e) of the Rules), and November 1, 2024 (stating that they had reserved the disputed domain with the intention of collaborating with the Complainant, in anticipation of a future collaboration, ensuring it would not be taken by others and with a genuine desire to study the opportunity for a collaborative relationship with the Complainant to develop innovative solutions in the field of artificial intelligence and concluding that they were agreeable to the transfer the disputed domain name to the Complainant).

The Respondent sent a further email communication to the Center on December 18, 2024, indicating their willingness to transfer the disputed domain name, proposing the sum of USD 500 in order to cover the registration costs.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

### **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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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 confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Although the addition of other terms ("technology") may bear on assessment of the second and third elements, the Panel finds the addition of such term 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 6(c) of the Policy provides a non-exclusive list of circumstances that may indicate a respondent's rights to or legitimate interests in a domain name. These circumstances include:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if it has not acquired trademark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In that sense, the Complainant indeed states that it has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain name.

Also, the absence of any trademarks or trade names registered by the Respondent corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name, that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate the absence of a right or legitimate interest.

As seen above, the Respondent has indeed stated that they had reserved the disputed domain with the intention of collaborating with the Complainant, in anticipation of a future collaboration, and being agreeable to the transfer the disputed domain name to the Complainant

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

### **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.

The registration and use of the disputed domain name in bad faith can be found in the present case in view of the following circumstances:

- (i) the well-known status of the Complainant's distinctive trademark;
- (ii) the present inactive use of the disputed domain name;
- (iii) the lack of reply to the cease-and-desist letter sent prior to this procedure; and
- (iv) the offer of the disputed domain name for sale for USD 500, an amount likely in excess of out-of-pocket costs incurred in the registration of the disputed domain name.

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 <ibmtechnology.ai> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: December 30, 2024