

ADMINISTRATIVE PANEL DECISION

Arm Limited v. Privacy service provided by Withheld for Privacy ehf / Joseph Collins

Case No. D2022-1125

1. The Parties

The Complainant is Arm Limited, United Kingdom, represented by Quinn IP Law, United States of America (“United States”).

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Joseph Collins, United States.

2. The Domain Name and Registrar

The disputed domain name <armcore.online> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 1, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 1, 2022, 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 and contact information in the Complaint.

On April 2 and 4, 2022, the Center received emails from the Respondent querying the process under the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”). This email used a different account to that provided by the Registrar in the Verification Response but did confirm that the email address provided by the Registrar was the appropriate email address for the disputed domain name.

In addition to responding to the Respondent’s emails, the Center sent an email communication to the Complainant on April 4, 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 April 10, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Policy, 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 April 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2022. The Respondent did not submit a formal Response. On May 25, 2022, due to a discrepancy in the electronic transmission of the Notification of Complaint and associated documents, the Center retransmitted the Notification of Complaint and associated documents by email. In light of the successful delivery of the Notification of Complaint and associated documents to the Respondent by courier and the email address verified by the Registrar as the email address for the registrant, admin, tech and billing contacts of the Respondent, the Center extended the due date for any Response to June 4, 2022. No formal Response was received by June 4, 2022. Accordingly, the Center notified the Parties with the notification on Commencement of Panel Appointment Process on June 10, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on June 17, 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.

On July 6, 2022, the Panel issued Administrative Panel Procedural Order No. 1 inviting the Respondent to make a supplemental filing pursuant to paragraph 12 of the Rules addressing the date of incorporation of his company, the nature of its business, and the derivation of its name. However, no further response was received from the Respondent.

4. Factual Background

The Complainant has been providing technology related goods and services since at least 1990 under and by reference to the sign ARM (both in plain text and figurative versions). Its main line of products are "computer chips" or central processing units. Since 1990, it has sold over 200 billion Arm brand processors. Its products are used as the main central processing unit for most mobile telephones including, according to the Complaint, Apple, HTC, Nokia, Sony Ericsson, and Samsung. The Complainant's Arm brand central processing units are also widely used in many other devices such as laptops, tablets, televisions, and other electronic products.

The Complainant has registered and uses many domain names based on "ARM", with its main website being found at "www.arm.com".

The Complaint includes evidence that the Complainant is the owner of numerous registered trademarks around the world for, or based on, ARM. For present purposes, it is sufficient to note only details of:

- (a) United Kingdom Registered Trademark No. UK00002000006, ARM, which was registered on January 29, 1999, in respect of semi-conduct chips, microprocessors, integrated circuits and the like, brochures and instruction manuals and related consultancy services in International Classes 9, 16 and 42 with a filing date of October 31, 1994;
- (b) United States Registered Trademark No. 2,332,930, ARM, which was registered in the Principal Register on March 21, 2000, in respect of integrated circuits, microprocessors and related products in International Class 9 with a filing date of May 24, 1999;
- (c) United States Registered Trademark Nos 2,397,339 and 2,397,340, ARM which were registered in the Principal Register on October 24, 2000, in respect of a range of goods and services in, respectively, International Classes 16 and 42, with filing dates of May 24, 1999, for both trademarks;
- (d) United States Registered Trademark No. 4,980,650, ARM, which was registered in the Principal Register on June 21, 2016, in respect of an extensive list of goods and services in International Classes 9, 16, 35, 37, 38, 41, 42 and 45 with a filing date of September 10, 2014;

(e) European Union Registered Trademark No. 001112986, ARM, which was registered on June 8, 2000 in respect of a range of goods and services in International Classes 9 and 42 with a filing date of March 22, 1999.

The Complaint includes evidence of many other registrations in many other countries. In addition, a number of these are for the word ARM in combination with another term such as “powered”, “connected”, “7”.

The disputed domain name was registered on August 7, 2020 or, possibly, May 17, 2019. The first email communication from the Respondent claims the 2019 date; the Registrar’s verification response provides the August 2020 date and the Respondent’s April 4, 2022, email states that the disputed domain name has been registered for “a year and a half”.

So far as the record in this proceeding shows, the disputed domain name has not resolved to a website of any kind since it has been registered.

5. Discussion and Findings

No formal Response has been filed. The Complaint and Written Notice and Administrative Panel Procedural Order No. 1 have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules and also provided by the Respondent in the emails received by the Center on April 2 and 4, 2022. Therefore, the Panel finds that the Respondent has been given a fair opportunity to present his case.

In these circumstances, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous trademarks for ARM (either in plain text or figurative representations). The Panel also finds that trademark is well known.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant,

may fall for consideration under the other elements of the Policy. See *e.g.*, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".online" gTLD, the disputed domain name consists of the Complainant's registered trademark and the term "core". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See *e.g.*, [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] 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] (as an individual, business, or other organization) 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 noncommercial 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See *e.g.*, [WIPO Overview 3.0](#), section 2.1.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The Respondent's email of April 4, 2022, does state that the disputed domain name has not been connected to a hosting service for "almost a year" but does not disclose what use, if any, was made before then. The Respondent has also not taken the opportunity to address these matters in response to Administrative Panel Procedural Order No. 1. There is therefore no evidence to suggest that the disputed domain name is in use, whether in connection with a good faith offering of goods or services or for some legitimate noncommercial or fair use. Bearing in mind that almost two and possibly three years have passed since the Respondent

became the registrant of the disputed domain name, there is also no evidence to suggest that any demonstrable preparations for such use were or are underway.

The disputed domain name is not derived from the Respondent's personal name. Nor is there any suggestion of some other name by which the Respondent himself is commonly known from which the disputed domain name could be derived.

On the other hand, it does appear that the Respondent is the president of a company incorporated in Florida in the United States under the name Armcore Inc. Publicly available records online confirm that there is indeed a company incorporated in Florida under that name. It also appears that this company was incorporated on October 20, 2020.¹

That is, the Respondent's company appears to have been incorporated under the name "Armcore" between two and seventeen months after the Respondent became the registrant of the disputed domain name. The disputed domain name, therefore, was not derived from the Respondent's pre-existing company name.

Moreover, mere incorporation of a company under a name confusingly similar to a trademark which has already been registered before the company was incorporated does not necessarily confer a right or legitimate interest in the name or the disputed domain name. That will depend very much on the circumstances surrounding the adoption of the name, including in particular how the name was chosen, and the nature of any business or other activity that the company may engage in. It may also be affected by the extent, if any, that the company registration authority takes into account the existence of trademark rights. In that respect, it appears that the Florida Department of State requires only that a new company name be "distinguishable" from names in the records of the Department of State and does not test for conflicts with trademarks.²

The disputed domain name can be seen as a combination of two ordinary English words, "arm" and "core".

However, whether the Respondent became the registrant of the disputed domain name in 2019 or 2020, the Respondent registered the disputed domain name long after the Complainant had registered its trademarks and also long after the Complainant began using its trademark.

By that stage, as the Complainant contends, the Complainant's trademark had become very well-known indeed. In competition with "Intel" and "AMD", "Arm" brand computer chips and processors are amongst the most widely used and known computer processor products. In that connection, the Complaint claims more than 200 billion of the Complainant's ARM products have been sold. The Complainant's trademark has also been held to be well-known within the meaning of article 6*bis* of the Paris Convention by Courts in the European Union³ and Turkey⁴ and by the European Union Intellectual Property Office.⁵ While these decisions do not relate to the status of the Complainant's trademark in the United States, the Panel considers a similar conclusion would apply in the United States having regard to the volume of the Complainant's sales and the significance of the Complainant's products under the ARM trademark in the market place.

Further, the word "core" is not devoid of significance in this context. In the context of computer chips and similar products, it is a term used to describe the processor or, in case of multiple processors, the processors performing the computational tasks in a computer's central processing unit or graphics processing unit.

¹ https://opencorporates.com/companies/us_fl/P20000084213.

² <https://dos.myflorida.com/sunbiz/start-business/efile/fl-profit-corporation/instructions/>.

³ Decision No. 000134/2016 of the Commercial Court No 2 at Alicante Spain (sitting in Civil Case Proceeding No 000902/2015T and on appeal Case No. 486-U37/16, Judgment No. 15/17 of the Court of Appeal of Alicante – Eighth District, sitting as the Trademark Court of the European Union, 1 February 2017.

⁴ Decision No. 2018/474 of the First Civil Court of Intellectual and Industrial Property Rights, Istanbul, Turkey, December 6, 2018.

⁵ Decision of the Opposition Division in Opposition No B 3 075 510, *ARM Limited v Beigjin Orion Star Technology Co Ltd*, July 6, 2020.

The combination of the two terms in the way they are arranged in the disputed domain name, therefore, is very likely to be taken in the abstract mistakenly to be a direct reference to the Complainant's products and without any explanation whatsoever from the Respondent, despite repeated opportunities.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The basis on which the Respondent has adopted the disputed domain name, therefore, calls for explanation or justification. Apart from reference to his company name, however, the Respondent has not sought to rebut that *prima facie* case or advance any claimed entitlement and, as already discussed, the incorporation of the company under the name alone does not establish a right or legitimate interest in the disputed domain name. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd.*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take unfair advantage of its significance as a trademark owned by (usually) the complainant.

The Complainant alleges that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark and to take advantage of its significance as confusingly similar to the Complainant's trademark. The Respondent has not directly denied either allegation but contends, as the company name is registered with the Florida Department of State, it is not trading on someone else's name. As already discussed, however, the mere fact of incorporation under a particular name does not confer an entitlement to use the name in conflict with prior trademark rights. Accordingly, the mere incorporation of the Respondent's company under its name does not preclude bad faith or confer rights or legitimate interests in the disputed domain name in circumstances where the company was registered long after the Complainant acquired its trademark rights.

On the other hand, a bald, unsupported allegation is not enough in itself to make out a claim of registration and use in bad faith.

As noted in section 5.B above, however, the Panel has found that the Complainant's ARM trademark is very well-known. It is likely that the Respondent, therefore, was aware of the Complainant's trademark when he adopted the disputed domain name in 2019 or 2020, many years after the Complainant began using its trademark. That the Respondent would have been aware of the Complainant's trademark appears all the more likely – again in the absence of any explanation from the Respondent despite several opportunities to provide such information – given its combination in the disputed domain name with the term “core” which is the term commonly used for the processor element of computing devices' central processing units and graphics processing units. This combination is highly likely to be mistaken as a direct reference to the Complainant and its ARM products.

In these circumstances, the Panel considers it likely that the Respondent was aware of the Complainant's trademark when registering the disputed domain name. Moreover, the Respondent's failure to deny such knowledge or to explain how the disputed domain name has been derived or what business or other activity the Respondent registered the disputed domain name for reinforces that conclusion.

Having that knowledge and in the absence of rights or legitimate interests in the disputed domain name, the Panel finds it is likely that the Respondent registered the disputed domain name to take unfair advantage of its confusing similarity to the Complainant's trademark. That is sufficient to constitute registration in bad faith under the Policy.

The Complainant invokes a previous decision in its favour, *Arm Limited v. Domain Admin, Match Domains LLC*, WIPO Case No. [D2021-0971](#), in support of its allegations that the disputed domain name is being used in bad faith. That case is not on all fours with the present case. Moreover, there is a significant difference as in the earlier decision the domain name had resolved to an active website.

The fact that the disputed domain name does not appear to have been in use, however, does not preclude a finding of use in bad faith under the Policy. See e.g., *Telstra Corporation Limited v Nuclear Marshmallows* WIPO Case No [D2000-0003](#). [WIPO Overview 3.0](#), section 3.3 outlines:

“While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

In the present case, factors (i) and (ii) point strongly to a finding of bad faith. Factor (iii) is more equivocal.

As “arm” is an ordinary English word and can also be seen as a three-letter acronym, the possibility of its use for purposes unconnected with the Complainant and its products cannot be excluded. As discussed above, however, its use in combination with the term “core” which is commonly used in connection with the Complainant’s products does lead to a very high risk of misrepresentation of association with the Complainant. Thus, the fourth point weighs in the Complainant’s favour in this case.

Having regard to these matters and in circumstances where the Respondent has not denied knowledge of the Complainant’s trademark but merely claimed not to be “trading on someone else’s name” and has not offered any explanation for his adoption of the disputed domain name or his plans for its use (other than, possibly, somehow a pre-emptive derivation from his later registration of the company Armcore Inc.), therefore, the Panel also finds the disputed domain name is being used it in bad faith.

Accordingly, the Complainant has established all three requirements under 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, <armcore.online>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: July 19, 2022