

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Super Privacy Service LTD
c/o Dynadot / Wu Yu
Case No. D2022-2459

1. The Parties

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

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Wu Yu, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 6, 2022. On July 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 7, 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. The Center sent an email communication to the Complainant on July 12, 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 amendment to the Complaint on July 19, 2022.

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 July 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 16, 2022.

The Center appointed Anna Carabelli as the sole panelist in this matter on August 19, 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.

The Panel found inconsistencies in the Complaint with regard to the domain name under dispute. In this regard, the Panel noticed that Section III (The Domain Name and Registrar) and paragraph A.l and C.j of Section VI (Factual and legal Grounds) of the Complaint refer to the domain name <ibmcgroupe.com>, which also appears on the Complaint's header. Annexes to the Complaint also refer to the domain name <ibmcgroupe.com>. However, in Section VII (Remedies Requested) the Complainant submitted a request for the transfer of <w38.ibmcgroupe.com>, while in Section VI paragraphs A.k and C.l reference is made to <ww38.ibmcgroupe.com> and <w38.ibmcgroupe.com> respectively.

By Procedural Order n° 1 notified to the parties on September 5, 2022, the Panel allowed the Complainant to submit an amendment to the Complaint to correct the above inconsistencies, by September 9, 2022. The due date for decision was postponed to September 16, 2022.

By email sent to the Center on September 15, the Complainant responded to the Panel's Procedural Order as follows:

"Hi Anna,
We apologize for the delay and any confusion the inconsistencies might have caused. In this instance, the 'w38' was a subdomain of the Disputed Domain Name in question: ibmcgroupe.com. We have this clarifies matters (sic)."

4. Procedural Matter: Complainant's late response to the Panel's Procedural Order

The Complainant responded to the Procedural Order on September 15, 2022, after the time limit set by the Panel (*i.e.* September 9, 2022).

It is a matter for the discretion of the Panel under Paragraph 10 of the Rules as to whether or not to accept and consider a late filing. Previous panel decisions emphasize the discretionary nature of a panel's powers in these circumstances, including considerations of fairness and equity and whether there would be prejudice to the other party if late submissions were accepted.

In the present case, there would be no prejudice to the Respondent that would flow from acceptance of the Complainant's late submission, also considering that the Respondent had failed to submit a Response and to take an active part in the proceedings. Obviously, the Complainant's delay causes a delay in the decision of the present case, but this too would not result detrimental to the Respondent.

The Panel therefore deems it appropriate to consider the email communication received from the Complainant on September 15, 2022. The Panel also deems that the above communication, although questionable in form and not particularly accurate in content, may be considered as confirmation that the disputed domain name which is the subject of the transfer request is <ibmcgroupe.com>.

5. Factual Background

The Complainant owns and has owned trademark registrations for the mark IBM in 131 countries all around the world for several decades. In particular, the Complainant owns the following registrations for the IBM mark in the U.S.:

Registration No. 4,181,289 registered on July 31, 2012 in International Classes 6, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 30, 35, and 41;

Registration No. 3,002,164 registered on September 27, 2005 in International Class 9;

Registration No. 1,696,454 registered on June 23, 1992 in International Class 36;

Registration No. 1,694,814 registered on June 16, 1992 in International Class 36;

Registration No. 1,243,930 registered on June 28, 1983 in International Class 42;

Registration No. 1,205,090, registered on August 17, 1982 in International Classes 1,7, 9, 16, 37, and 42;

Registration No. 1,058,803, registered on February 15, 1977 in International Classes 1, 2, 3, 4, 7, 9, 10, 16, 28, 37, 41, and 42; and

Registration No. 640,606 registered on January 29, 1957 in International Class 9.

The Complainant is a designer and manufacturer of a wide array of products that record, process, communicate, store and retrieve information, including computers and computer hardware, software and accessories, and has been offering products under the IBM mark since February 14, 1924.

In 2021, the Complainant was ranked the 15th most valuable global brand by BrandZ, the 18th best global brand by Interbrand, the 42nd largest company on the Fortune U.S. 500 list, and the 121st largest company on the Fortune Global 500 list. The IBM mark was valued by BrandZ as worth over USD 83 billion in 2020, USD 86 billion in 2019, and USD 96 billion in 2018.

The disputed domain name was registered on October 14, 2021. As per the evidence submitted with the Complaint, the disputed domain name resolves to a pay-per-click parking page with advertising links, and has also been used by the Respondent to direct internet users to a website that shows elements consistent with malware or virus distribution.

6. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

- As recognized in previous WIPO decisions, the IBM mark has a strong reputation and is widely known throughout the world (see, among others *International Business Machines v. Sadaquat Khan*, WIPO Case No. [D2018-2476](#));
- The disputed domain name is identical or confusingly similar to the IBM mark. The disputed domain name consists of the letters "ibm", followed by the misspelled word "cgroupe". This minor variation does not obviate the confusing similarity between the disputed domain name and the IBM mark;
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant to use the IBM mark or to apply for any domain name incorporating the IBM mark. Furthermore, there is no evidence that the Respondent is using the disputed domain name for a *bona fide* offering of goods or services;
- The disputed domain name was registered and is being used in bad faith by the Respondent to derive illegitimate commercial gains. Specifically, the Respondent has been intentionally attempting to create a likelihood of confusion by pointing the disputed domain name to a pay-per-click parking page with advertisement links. The Respondent has also been actively using the IBM mark in the disputed domain name to direct Internet users to a website that shows elements consistent with malware or virus distribution. The dissemination of malware through a domain name that is confusingly similar to a complainant's

trademark is often done to steal consumers' information for commercial gain, and this is evidence of bad faith (see *Wikimedia Foundation, Inc. v. Yangmin Fang, Huli Jing Internet Holdings Ltd*, WIPO Case No. [D2015-2140](#));

- The Complainant sent a cease and desist letter to the Respondent at the email address listed in the Whois records on October 21, 2021, asking the Respondent to disable and transfer the disputed domain name to the Complainant. The Complainant also sent a follow up letter to the Respondent on November 4, 2021. The Respondent's failure to respond to the Complainant's emails is further evidence of bad faith.

Encyclopedia Britannica v. Zucarini, WIPO Case No. [D2000-0330](#); and *RRI Financial, Inc., v. Ray Chen*, WIPO Case No. [D2001-1242](#);

- The Respondent's identity and contact information have been redacted for privacy on Whois records, and this is also indication of bad faith.

B. Respondent

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

7. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove 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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the Respondent, shall be evidence of the Respondent's rights to or legitimate interests in the disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns the registered trademark rights in the globally well-known IBM mark in the United States and throughout the world.

As highlighted in section 1.11 of the WIPO Overview of WIPO Panels View on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the addition of the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*; "ibmcgroupe".

The disputed domain name entirely incorporates the Complainant's mark IBM and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v.*

Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)). The addition of the misspelled word “cgroupe” does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#)

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which Complainant has rights. Therefore the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

(i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;

(ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;

(iii) it is making a legitimate noncommercial 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.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) The Complainant holds prior rights in the globally registered and famous IBM mark (b) the Respondent has not been authorized to use the Complainant’s mark in any way (c) the Respondent cannot demonstrate any legitimate noncommercial or fair use of the disputed domain as the disputed domain name resolves to a pay-per-click parking page with advertisement links, and is also being used by the Respondent to direct Internet users to a website that shows elements consistent with malware or virus distribution.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests in the Respondent.

Therefore, the Panel finds that the Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith.

The disputed domain name incorporates the Complainant’s trademark IBM and was registered long after this trademark became well-known. Given the distinctiveness and well-established reputation of the

Complainant's IBM mark, also recognized by previous Panels, it is not conceivable that the Respondent did not have in mind the Complainant's IBM mark when registering the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith (see section 3.2.2 of the [WIPO Overview 3.0](#)) with a deliberate intent to create an impression of an association with the Complainant.

Concerning the use of the disputed domain name, the evidence submitted shows that at the time of filing the Complaint, the disputed domain name pointed to a pay-per-click parking page with advertisement links, which is confusing in that Internet users might reasonably believe that services/products advertised are connected to or approved by the Complainant. Accordingly, the Panel finds that the Respondent has intentionally attempted to attract for commercial gain Internet users by creating a likelihood of confusion with the Complainant's IBM mark. Further, the Complainant has produced evidence that the Respondent's IP address has previously been associated with malware. In addition, it appears that the Respondent has taken steps to conceal its identity and has failed to respond to the Complainant's cease and desist letters. All the above circumstances affirm a finding of bad faith use under the Policy.

For all the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith by the Respondent.

Therefore, the Complainant has established also paragraph 4(a)(iii) of the Policy.

8. 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, <ibmcgroupe.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: October 3, 2022