

## ADMINISTRATIVE PANEL DECISION

### International Business Machines Corporation (IBM) v. Name Redacted Case No. D2022-4292

#### 1. The Parties

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

The Respondent is Name Redacted.<sup>1</sup>

#### 2. The Domain Names and Registrar

The disputed domain names <ibmnfts.com> and <nftsibm.com> are registered with GoDaddy.com, LLC (the “Registrar”).

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 11, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 14, 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 November 23, 2022.

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<sup>1</sup> It seems to the Panel that the Respondent appears to have used the name and contact details of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. References to the Respondent shall be construed as to refer to the registrant in control of the disputed domain names. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

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 November 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2022. The Response was filed with the Center on December 15, 2022. The Respondent provided a Supplemental Filing to the Center on December 22, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on January 13, 2023. 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 provides a broad range of goods and services, including information technology related goods and services. It owns trademark registrations around the world for the mark IBM, including United States Reg. No. 640,606, registered on January 29, 1957. According to the Whois records, both of the disputed domain names were registered on February 3, 2022. The disputed domain names are not associated with active web pages but instead have pointed to Registrar-provided pages, including parking pages that appear to have featured paid advertisements. The Complainant sent cease and desist communications via the Registrar to the Respondent concerning the disputed domain names, but these communications remained unanswered.

#### **5. Parties’ Contentions**

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

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and that the disputed domain names were registered and are being used in bad faith.

##### **B. Respondent**

The Respondent principally claims in her Response and Supplemental filing that she “is unaware of any of this”, that she has “been locked out of [H]otmail since at least Jan/[F]eb”, and denies that either she or her children have “been mining cryptocurrency, making bots or malware” and further states that “[c]omplete compliance [is] intended.” In addition, the Panel notes that a Hotmail email address was provided to the Registrar as the registrant’s email address for the disputed domain names, which were registered on February 3, 2022.

#### **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are 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 names, and (iii) the disputed domain names have been registered and are being used in bad faith. The Panel finds that all three of these elements have been met in this case.

## A. Identical or Confusingly Similar

This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain names are identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.7

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the IBM mark by providing evidence of its trademark registrations. The disputed domain names incorporate the IBM mark in its entirety. This is sufficient for showing confusing similarity under the Policy. The presence of the term “nfts” in each of the disputed domain names does not prevent a finding of confusing similarity – the IBM mark remains identifiable within the disputed domain names.

The Panel finds that the Complainant has established this first element under the Policy.

## B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain names.

On this point, the Complainant asserts, among other things, that: (1) the Complainant has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain names, (2) the Respondent has not been commonly known by the disputed domain names, (3) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, and (4) there is no evidence that the Respondent is using the disputed domain names for a *bona fide* offering of goods or services. The Complainant asserts that instead, the Respondent has been intentionally attempting to create a likelihood of confusion by pointing the disputed domain names to pay-per-click pages. The Complainant has also submitted evidence (in support of the third Policy element) that the disputed domain names are associated with an IP address linked to dissemination of malware and botnet command and control servers and that the IP address is linked to activities related to cryptocurrency mining.

These assertions establish, *prima facie*, that the Respondent lacks rights or legitimate interests in the disputed domain names. As such, where the Complainant has made 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 disputed domain names. [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

Paragraph 4(c) of the Policy instructs respondents on a number of ways they could demonstrate rights or legitimate interests (“you” and “your” in the following refers to the particular respondent):

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 Panel takes note of the Respondent's communications, which serve the Panel to consider more likely than not that the named Respondent may have been a victim of identity theft. In any case, the Panel does not find that any of the Respondent's assertions address any of the ways in which she could establish rights or legitimate interests in the disputed domain names. Accordingly, the Panel finds that the Respondent has failed to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names that would overcome the Complainant's *prima facie* showing.

The Complainant has established this second element under the Policy.

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

Section 3.1.4 of the [WIPO Overview 3.0](#) states that a presumption of bad faith may be created solely through the "registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity". See *International Business Machines Corporation v. Jian Liu*, WIPO Case No. [D2021-0248](#) (finding a presumption of bad faith where the respondent had registered <ibmdns.com>, which incorporated the IBM mark followed by a descriptive term). Because the Complainant's IBM mark is so well-known, it is implausible to believe that the Respondent was not aware of that mark when it registered the disputed domain names. In the circumstances of this case, these facts are sufficient to establish bad faith registration of the disputed domain names.

Bad faith use is clear from the Respondent's activities of using the disputed domain names to engage in purported malware and botnet activity relating to cryptocurrency mining. See *International Business Machines Corporation v. John Lovvorn*, WIPO Case No. [D2022-1932](#), (bad faith use found based on the illegal and illegitimate conduct involving phishing and the distribution of malware in which the respondent was engaged).

The lack of response by the Respondent to the cease-and-desist communications sent by the Complainant further supports a finding of bad faith. Past UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a factor in finding bad faith registration and use of a domain name. See *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party*, WIPO Case No. [D2000-0330](#).

For these reasons, the Panel finds that the Complainant has established this third element 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 names <ibmnfts.com> and <nftsibm.com> be transferred to the Complainant.

*/Evan D. Brown/*

**Evan D. Brown**

Sole Panelist

Date: January 28, 2023