

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Milen Radumilo Case No. D2022-4783

1. The Parties

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

The Respondent is Milen Radumilo, Romania.

2. The Domain Name and Registrar

The disputed domain name <pc-ibm.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 13, 2022. On December 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 14, 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 (Contact Privacy Inc. Customer 0164710010) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 15, 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 December 22, 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 December 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 17, 2023.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on January 23, 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 is a multinational technology corporation headquartered in Armonk, New York, United States. It specializes in computer hardware, middleware, and software, and provides hosting and consulting services in areas ranging from mainframe computers to nanotechnology. As of December 31, 2021, the Complainant has over 282,100 employees worldwide and operates in over 175 countries. The Complainant's brand IBM has consistently been ranked among the most valuable global brands in the recent years.

The Complainant owns and has owned trademark registrations for IBM in 131 countries around the world for several decades, as well as for a broad range of goods and services, including, but not limited to, information technology related goods and services. More particularly, the Complainant owns the following trademarks consisting of or containing IBM in the United States:

- United States trademark no. 4,181,289 "IBM" (figurative mark) in International Classes 9, 16, 18, 20, 21, 22, 24, 25, 28, 35, and 41, registered on July 31, 2012.
- United States trademark no. 3,002,164 "IBM" (figurative mark) in International Class 9, registered on September 27, 2005.
- United States trademark no. 1,696,454 "IBM" (figurative mark) in International Class 36, registered on June 23, 1992.
- United States trademark no. 1,694,814 "IBM" (word mark) in International Class 36, registered on June 16, 1992.
- United States trademark no. 1,243,930 "IBM" (word mark) in International Class 42, registered on June 28, 1983.
- United States trademark no. 1,205,090 "IBM" (figurative mark) in International Classes 1, 7, 9, 16, 37, and 41, registered on August 17, 1982.
- United States trademark no. 1,058,803 "IBM" (word mark) in International Classes 1, 9, 16, 37, 41 and 42, registered on February 15, 1977.
- United States trademark no. 640,606 "IBM" (word mark) in International Class 9, registered on January 29, 1957.

The Complainant owns numerous domain names that consist of or include the word "ibm", including the domain name <ibm.com>.

The disputed domain name <pc-ibm.com> was registered on June 30, 2022 and at one point resolved to a website with pop-up messages urging visitors to download alleged Microsoft programs presumably infected with malware, and later resolved to a website with pay-per-click links related to the products offered by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three requirements stated in paragraph 4(a) of the Policy is established in the present case:

The Complainant claims that IBM is a world-famous trademark. Tracing its roots to the 1880s, the Complainant states that it has been a leading innovator in the design and manufacture of a wide array of products that record, process, communicate, store and retrieve information, including personal computers and computer hardware, software and accessories. It points to numerous rankings for IBM as a valuable global brand, such as in 2021, when IBM was ranked 15th most valuable global brand by BrandZ. In addition, the Complainant refers to various UDRP decisions having accepted IBM as a well-known trademark.

The Complainant submits that the disputed domain name is confusingly similar to the registered trademarks, namely IBM, in which the Complainant has rights. The relevant comparison to be made is with the second-level portion of the disputed domain name only (*i.e.*, "pc-ibm"), as it is well established that the generic Top-Level Domain ("gTLD") (*i.e.*, ".com") may be disregarded for this purpose. The disputed domain name contains the Complainant's IBM trademark in its entirety, the only difference being the addition of a hyphen "-" and the letters "pc" in front of the letters "ibm".

According to the Complainant, the addition of the term "pc" connected with a hyphen in the disputed domain name does not prevent a finding of confusing similarity. On the contrary, the addition of the term "pc" is descriptive and an abbreviation for "personal computer" which directly refers to the product line the Complainant claims to be most known for, given that the Complainant was a pioneer in manufacturing personal computers. Therefore, it creates among the Internet users a likelihood of confusion so that they will believe that the disputed domain name is related to the Complainant.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the IBM trademark in any way. By using the disputed domain name in connection with – as the Complainant presumes – selling software infected with malware and services impersonating the Complainant, the Respondent clearly has not used the disputed domain name in connection with a *bona fide* offering of goods or services. This, according to the Complainant, is underlined by the use of the disputed domain name for a pay-per-click page that includes links for goods and services as they may be offered under the IBM trademark. To the Complainant's knowledge, the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith by the Respondent. It claims that the IBM trademark is famous and/or widely known, given that it is protected by trademark registrations in many countries all around the world, some of which were registered many decades ago, and considering the global reach and popularity of the Complainant's services. Therefore, it is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name. Furthermore, the Complainant contends that using the disputed domain name as part of a malware distributing scam impersonating the Complainant and others and in connection with a monetized parking page constitutes the use of the disputed domain name in bad faith. In addition, the disputed domain name is being offered for sale for a compensation largely exceeding the registration cost.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademarks; 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.

In the following, the Panel will discuss in consecutive order whether each of these requirements is met.

A. Identical or Confusingly Similar

On the first element, the Complainant has demonstrated registered trademark rights that consist of or contain the trademark IBM and which predate the registration of the disputed domain name.

The test of identity or confusing similarity under the Policy, paragraph 4(a)(i), is limited in scope to a direct comparison between the Complainant's trademark and the textual string which comprises the disputed domain name.

The disputed domain name contains the Complainant's trademark IBM in its entirety. It consists of the term "pc" plus a hyphen followed by the term "ibm" and the gTLD ".com". Neither the addition of the term "pc" followed by the hyphen nor the gTLD ".com" prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name, see Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition [WIPO Overview 3.0](#).

Thus, the Panel finds that the disputed domain name is confusingly similar to the IBM trademarks, in which the Complainant has rights. The requirements of paragraph 4(a)(i) of the Policy are, therefore, satisfied.

B. Rights or Legitimate Interests

On the second element, under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

It is established case law that it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production onto the Respondent to come forward with relevant evidence to rebut such presumption (see *Credit Agricole S.A. v. Dick Weisz*, WIPO Case No. [D2010-1683](#); see *Champion Innovations, Ltd. v. Udo Dussling*, WIPO Case No. [D2005-1094](#); see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#); see *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#)).

The Panel notes that with respect to paragraph 4(c)(i) of the Policy, there is no evidence in the record that the Respondent, before any notice of the dispute, used or prepared 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.

Further, the Panel notes that, with respect to paragraph 4(c)(ii) of the Policy, there is no evidence that indicates that the Respondent has ever been commonly known by the disputed domain name or has acquired trademark rights in a name corresponding to it.

In addition, with respect to paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent has made, and is making, a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

On the contrary, the Complainant has not authorized, licensed or permitted in any way the Respondent to register or use the disputed domain name. This finding is supported by the fact that the Respondent failed to file a response within the proceedings before the Panel. As far as failure to file a response is concerned, it is for a complainant to prove its case, as there may be good reasons why an honest respondent may decide not to prepare and file such document. But where allegations are made which are as serious as those levied by the present Complainant in its Complaint, one would expect any honest respondent to positively deny those allegations (see *The Commissioners for HM Revenue and Customs v. Tyrone Jackson*, WIPO Case No. [D2018-0298](#)).

Consequently, the Panel finds that the Respondent's default in refuting the *prima facie* case made by the Complainant, as described above, is sufficient to establish a lack of rights or legitimate interests of the Respondent in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

On the third element, under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the disputed domain name has been registered and is being used in bad faith by the Respondent.

Whether a domain name is used in bad faith for the purposes of the Policy may be determined by evaluating the factors set out under paragraph 4(b) of the Policy.

However, the aforementioned provisions are without limitation, and bad faith registration and use may be found otherwise, taking into account all circumstances relevant to the case (see *Cleveland Browns Football Company LLC v. Andrea Denise Dinoia*, WIPO Case No. [D2011-0421](#)).

The Complainant has submitted sufficient evidence to prove that the IBM trademark is widely known in connection with its services worldwide. Considering the Complainant's many different goods and services using the IBM trademark, in addition to the Complainant's global reach and history as a pioneer of personal computing, it is highly unlikely that the Respondent would not have known of the Complainant's rights in the trademark at the time of the disputed domain name's registration. Prior knowledge of the Complainant's trademark rights is another indication for a bad faith registration of the disputed domain name (see *TRS, Quality, Inc v. Privacy Protect*, WIPO Case No. [D2010-0400](#)). The Panel notes that the disputed domain name was registered long after the Complainant's trademarks were registered and accepts that the disputed domain name was chosen by reference to the IBM trademark. Notably, the Complainant obtained the first registration of the IBM trademark more than 60 years ago. The Panel also notes the fact that the disputed domain name consists of the Complainant's IBM trademark entirely, and the additional letters "pc" as an abbreviation of the words "personal computer" referring to the Complainant's product line, separated by a hyphen, is a strong indicator that the Respondent's knowledge of and its intention to target, the Complainant and its business by registering the disputed domain name and causing a likelihood of confusion on the part of Internet users.

The registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith, see section 3.1.4 of the [WIPO Overview 3.0](#). Considering the circumstances of this case, the fact that the disputed domain name at one point was used to resolve to a website with pay-per-click links clearly constitutes use in bad faith (see *Columbia Pictures Industries, Inc. v. North West Enterprise, Inc.*, WIPO Case No. [D2006-0951](#)). According to the Complainant's uncontested statement and the evidence submitted, the Respondent offers the disputed domain name for sale at USD 688, a price that is likely to be largely exceeding the registration costs. In addition, the Respondent uses the disputed domain name as part of a malware distributing scheme. Given that the use of a domain name for *per se* illegitimate activities such as distributing malware can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith,

see sections 2.13 and 3.4 of [WIPO Overview 3.0](#), and *Ferring B.V. v. Domain Administrator, Fundacion Privacy Services LTD.*, WIPO Case No. [D2021-0784](#).

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(b) 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 <pc-ibm.com> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: February 6, 2023