

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Mingxiang Zhou, Jan Everno,
and Web.com Holding Account
Case No. D2023-0632

1. The Parties

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

The Respondents are Mingxiang Zhou, China; Jan Everno, United States; and Web.com Holding Account, United States.

2. The Domain Names and Registrars

The disputed domain name <ibmcollectable.com> is registered with Top Pick Names LLC (the “Registrar 1”).

The disputed domain name <ibm-collectables.com> is registered with Hong Kong Juming Network Technology Co., Ltd (the “Registrar 2”).

The disputed domain name <ibmcollectables.com> is registered with Rally Cry Domains, LLC (the “Registrar 3”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2023. On February 10, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On February 13, 2023, the Registrar 2 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) and contact information in the Complaint. On February 14, 2023, the Registrar 3 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 (Perfect Privacy, LLC) and contact information in the Complaint. On February 18, 2023, the Registrar 1 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 (Perfect Privacy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 2023, providing the registrants 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 February 24, 2023.

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 Respondents of the Complaint, and the proceedings commenced on March 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on March 30, 2023.

The Center appointed Gareth Dickson as the sole panelist in this matter on April 6, 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.

The Complainant has sought consolidation of disputes in relation to the three disputed domain names, under paragraph 4(f) of the Policy and paragraph 10(e) of the Rules. The Panel’s findings in respect of this request are set out in section 6 below.

4. Factual Background

The Complainant is an international business operating in the field of computers, software and accessories. It was incorporated over 100 years ago, in 1911, and is the owner of a large number of trade marks around the world for IBM (the “Mark”), including:

- United States trade mark registration number 1058803, registered on February 15, 1977; and
- United States trade mark registration number 1243930, registered on June 28, 1983.

The disputed domain names were registered as follows:

- <ibm-collectables.com> - July 2, 2022;
- <ibmcollectables.com> - July 2, 2022;
- <ibmcollectable.com> - July 18, 2022.

The disputed domain names are being used, respectively, to provide access to:

- A webpage featuring gambling content, with several elements using Chinese script;
- A parked page featuring sponsored links; and
- A page which appears to be linked to malware and/or the distribution of viruses.

5. Parties’ Contentions

A. Complainant

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark around the world. It contends that each of the disputed domain names is confusingly similar to the Mark since each such domain name incorporates the Mark (which is recognisable within the disputed domain name) with the addition of “collectable”, “collectables” or “-collectables”, under the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant confirms that it has not given any of the Respondents permission to use the Mark in a domain name. It alleges that the Respondents have been using the disputed domain names for commercial purposes and/or in association with the malware and the distribution of viruses and that none of these purposes amounts to a right or legitimate interest in the relevant disputed domain names.

The Complainant submits that there is no evidence that any of the Respondents: has been commonly known by any of the disputed domain names; is making, or intends to make, a legitimate noncommercial or fair use of any of the disputed domain names; or has ever used or demonstrated preparations to use any of the disputed domain names in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondents must have known of the Complainant and the Mark when registering the disputed domain names. It argues that the disputed domain names are being used to attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Mark, contrary to the Policy.

Together, the Complainant submits that the Respondents have registered and are using the disputed domain names in bad faith.

B. Respondents

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

6. Discussion and Findings

Prior to determining the Complaint on the merits, the Panel must determine whether or not to accede to the Complainant's request that its Complaints against the three disputed domain names be consolidated into a single proceeding.

The Panel is empowered to consolidate disputes into a single proceeding under paragraph 4(f) of the Policy, provided that it is satisfied that paragraph 3(c) of the Rules is met (see paragraph 10(e) of the Rules), namely that in addition to considering the procedural efficiency and fairness of consolidation, the Panel must be convinced that the domain names "are registered by the same domain-name holder". It is up to the Complainant to demonstrate that common control.

Notwithstanding that efficiency and procedural fairness permit the requested consolidation, the Panel is not persuaded by the evidence in the Complaint that all three of the disputed domain names are under common control. To the extent that the Complainant's arguments rely: on registrants having the same physical address while making use of the same privacy protection service; or on registrar or IP address history prior to the registration dates, the Panel finds these of limited assistance without any further explanation of their relevance. In any event, those details are superseded by the provision of current registrant information by the registrars concerned, following their receipt of notice of the Complaints.

The essential elements of the disputed domain names are set out below:

- <ibm-collectables>: registered with Hong Kong Juming Network Technology Co., Ltd, on July 2, 2022 and only two seconds apart from the second disputed domain name listed below. It directs users to a webpage featuring gambling content, with several elements using Chinese script. The registrant is recorded on the Whois as Mingxiang Zhou and their address is listed in Hunan Province, China. An email address and a phone number are given, and do not match the email address of either of the other registrants. The phone number is said to have been used to register other domain names under different registrant names, although the Panel hesitates to draw many conclusions from that in light of the fact that some of the differences in registrant names could be differences in the script being used rather than any difference in meaning. Furthermore, there is no allegation that any of the other domain names registered with this phone number are making any unauthorised use of any third party trade mark rights or are otherwise illegitimate.
- <ibmcollectables.com>: registered with Rally Cry Domains, LLC, also on July 2, 2022, and only two seconds apart from the first disputed domain name listed above. It directs users to a parked webpage featuring sponsored links. The registrant on the Whois is a proxy service, namely Web.com Holding

Account and their address is listed in United States of America. An email address and a phone number are given, and do not match the email address of either of the other registrants.

- <ibmcollectable.com>: registered with Top Pick Names LLC, on July 18, 2022. It directed users to a parked webpage featuring sponsored links but has subsequently been updated to provide access to a webpage which appears to be linked to malware and/or the distribution of viruses. The registrant is recorded on the Whois as Jan Everno. Their address is listed in, United States of America, and may or may not be a genuine business address. An email address and a phone number are given, and do not match the email address of either of the other registrants.

The Panel notes the Complainant's submissions that Rally Cry Domains, LLC and Top Pick Names, LLC, being the registrars for <ibmcollectables.com> and <ibmcollectable.com> respectively, have the same Abuse Contact phone number and Abuse Contact email addresses (no doubt due to both registrars being part of the Network Solutions infrastructure), and that the same privacy service was used for both registrations. Neither of these facts on their own prove common control, but they are relevant factors as part of the Panel's wider consideration of all the facts of the request, as is the fact that they were registered more than two weeks apart using different Whois information, and have been put to different uses.

The Panel also notes that all three disputed domain names may have been under some common control prior to the registration dates listed above, in light of the similar IP addresses and registrars previously associated with those names. Other than as noted in the immediately preceding paragraph, however, there has been no commonality of registrars and IP addresses since the registration dates mentioned above. Although the first two of the disputed domain names were registered at the same time, the third was registered much later. Such evidence counts against a finding of common control.

The Panel also notes that the Whois information for each of the disputed domain names has nothing in common beyond the use of the same (widely used) privacy service by two of the names, which were registered on different dates and have different underlying registrant information: one of them includes a further corporate proxy holding service, whereas the other purports to use an individual name and personal contact details. The disputed domain names are all being put to different uses.

Taking all of the above into account, the Panel is not persuaded that the three disputed domain names are registered by the same domain name holder or are under common control, and therefore the Panel has no power under the Rules or the Policy to consolidate these three disputed domain name into a single Complaint.

On the basis that they were registered virtually simultaneously, however, the Panel is prepared to accept that the first and second disputed domain names are under common control. The Panel is aware that there could be other explanations for the near synchronicity of these registrations, and that common ownership is not the only reasonable explanation for it; but considers it inappropriate to give speculation any greater weight than the evidence before it, which includes the Respondent's failure to submit a Response to the Complaint. The totality of the evidence favours the Complainant's request for consolidation of the first and second disputed domain names, albeit by the slimmest of margins. The Complainant is at liberty to file a new complaint in relation to the third disputed domain name.

Given the finding above, the Panel has considered the remainder of the Complaint as it pertains to the first and second disputed domain names only, and refers to the Respondent in the singular.

Under paragraph 4(a) of the Policy, the Complainant bears the burden of proving that:

- a) the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- b) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- c) the disputed domain names have been registered and are being used in bad faith.

These criteria are cumulative. The failure of the Complainant to prove any one of these elements means the Complaint must be denied.

A. Identical or Confusingly Similar

The first limb under paragraph 4(a) of the Policy is essentially a standing requirement. While evidence of the nature and extent of a complainant's rights may be necessary to support submissions made under the second and third limbs, the first limb does not ordinarily require a complainant to submit voluminous, repetitive materials merely to prove their rights in a trade mark or a service mark, especially where those materials have only tangential relevance to the complaint. Such profligacy has a tendency to overcomplicate and overburden what should be a straightforward assessment, particularly for famous and registered marks.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)) provides that: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Section 1.8 of the [WIPO Overview 3.0](#) further provides that: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

The Panel therefore finds that the Complainant has rights in the Mark and that the disputed domain names are confusingly similar to the Mark, since they incorporate the Mark in its entirety and the Mark is distinctly recognisable within each of them.

The use of the gTLD ".com" does not prevent a finding of confusing similarity nor does the addition of the term "collectables", with or without a hyphen.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of a domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes 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 names. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the current proceeding, the Complainant has established its *prima facie* case. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and submits that the Respondent has not been commonly known by the disputed domain names.

There is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the disputed domain names in any descriptive manner or is making any use of the disputed domain names that would establish rights or legitimate interests as a result of a noncommercial or fair use of them.

Although one of the websites to which the disputed domain names directs Internet users contains only pay per click links, that does not constitute a *bona fide* sale of goods or services or a legitimate noncommercial or fair use within the meaning of the Policy. Section 2.9 of the [WIPO Overview 3.0](#) states that: "Panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona*

fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users", as is the case here.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), "a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed". Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

C. Registered and Used in Bad Faith

The Panel notes that the disputed domain names were registered many years after the Mark was registered and accepts that they were chosen by reference to the Mark, which is one of the world's most well known trade marks.

As a result, and in the absence of evidence from the Respondent that the similarity of the disputed domain names to the Mark is coincidental, the Panel must conclude that the Respondent knew of the Complainant's rights in the Mark when it registered the disputed domain names.

The Panel therefore finds that the Respondent's registration of the disputed domain names was in bad faith since it attempted to appropriate for the Respondent, without the consent or authorisation of the Complainant, rights in the Complainant's Mark.

The disputed domain names are also being used in bad faith, in that they are using the Mark for a commercial purpose that involves redirecting Internet users away from the Complainant, without any justification for doing so.

Therefore, and on the basis of the information available to it, the Panel finds that the Respondent's use of the disputed domain names is without justification and is inconsistent with the Complainant's exclusive rights in the Mark. Consideration of these and other factors militates in favour of a finding of bad faith.

The Panel finds that the Respondent has registered and is using the disputed domain names in bad faith.

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:

<ibm-collectables.com>; and
<ibmcollectables.com>,

be transferred to the Complainant.

No finding is made in relation to <ibmcollectable.com> in light of the Panel's finding on consolidation. The Complainant is at liberty to submit a further complaint in respect of that domain name.

/Gareth Dickson/

Gareth Dickson

Sole Panelist

Date: May 15, 2023