

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. sun dekun
Case No. D2023-1411

1. The Parties

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

The Respondent is sun dekun, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <ibm-trade.org> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2023. On April 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 3, 2023, 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 (See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 3, 2023, 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 April 4, 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 Respondent of the Complaint, and the proceedings commenced on April 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 2, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on May 19, 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

According to information in the Complaint, the Complainant is a leading innovator in the design and manufacture of a wide array of products that record, process, communicate, store, and retrieve information, including computers and computer hardware, software, and accessories. The Complainant has been offering products under the trademark IBM ever since 1924. In 2022, the Complainant was ranked the 18th most valuable global brand by BrandZ. As per the Complainant, as a result of the high quality of goods and services it has provided to its customers for over 100 years, and its reputation as one of the premier manufacturers of computers and computer related goods and services throughout the world, the Complainant's name and its IBM trademark are famous and valuable assets.

The Complainant has registered various trademarks consisting of or including IBM, such as the United States trademark registration for IBM (word), registered under No. 4,181,289 as of July 31, 2012, or the United States trademark registration for IBM (word), registered under No. 3,002,164 as of September 27, 2005.

The disputed domain name was registered on September 18, 2022, and redirected to a third-party website. Currently, it does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is identical or confusingly similar to the Complainant's registered trademarks, as the disputed domain name consists of the letters "ibm" followed by a dash "-", the term "trade," and the generic Top-Level Domain ("gTLD") ".org". The presence of the descriptive term "trade" in the disputed domain name does not obviate the confusing similarity between the disputed domain name and the IBM trademark of the Complainant.

As regards the second element, the Complainant argues that the Complainant has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain name. Furthermore, there is no evidence that the Respondent is using the disputed domain name for a *bona fide* offering of goods or services. Rather, the Respondent has used the disputed domain name to redirect users to a third-party website. As per the Complainant, such unauthorized use of the IBM trademark is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while in fact, no such relationship exists.

With respect to the third element, the Complainant argues that the Respondent was well aware of the Complainant's trademark at the time the Respondent registered the disputed domain name, as the Complainant's trademarks are well-known around the world. The Respondent registered the disputed domain name at least 65 years after the Complainant established registered trademark rights in the IBM trademark. Furthermore, the Complainant submits that the Respondent is acting in bad faith by redirecting the disputed domain name to a website that attempts to install a tracking cookie on the Internet user's computer. In addition, the website to which the disputed domain name redirects is associated with malware and botnets as evidenced by the IP address reports. This demonstrates the Respondent's bad faith, which is detrimental to the Complainant's reputation. Moreover, the Respondent has registered the disputed domain name through a privacy shield service and did not reply to the Complainant's cease and desist letters.

B. Respondent

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

6. Discussion and Findings

No response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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 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.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to that trademark. This first element under the Policy functions primarily as a standing requirement. [WIPO Overview 3.0](#), section 1.7.

The Complainant has provided evidence of its rights in the IBM trademarks by providing evidence of its trademark registrations.

As regards the second limb of the first element, the test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name. It is well-established that the gTLD, in this case ".org" may be ignored when assessing the confusing similarity between the disputed domain name and the Complainant's trademarks. Only the second-level portion of the disputed domain name is taken into consideration. See section 1.11.1 of the [WIPO Overview 3.0](#).

The disputed domain name consists of the IBM trademark, in addition to the term "trade", a hyphen and the gTLD ".org". The addition of "trade" and of a hyphen does not prevent a finding of confusing similarity with the Complainant's trademarks. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of another term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

The Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

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 contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)). In the present case the Complainant has established a *prima facie* case that it holds rights over the trademark IBM, and that the Respondent has no legitimate reason to acquire the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because he did not formally respond to the Complainant's contentions.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

According to the unrebutted assertions of the Complainant, its IBM trademarks were widely used in commerce well before the registration of the disputed domain name in September 2022 and are reputed. The disputed domain name is confusingly similar to the Complainant's trademark. Under these circumstances, it is most likely that the Respondent was aware of the Complainant's trademark at the registration date of the disputed domain name.

As regards the use of the disputed domain name, the Panel accepts the Complainant's evidence, which the Respondent has not disputed, that the Respondent used the disputed domain name to redirect to a third-party website, without authorization. Such use is likely to mislead Internet users looking for the Complainant's products or services. Accordingly, the Panel finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

According to the unrebutted evidence in the case file, the website to which the disputed domain name redirects is associated with malware and botnets, which is further indications of bad faith registration and use. Furthermore, the Respondent availed of a privacy shield service to protect its identity. While the use of a privacy shield is not in any way objectionable in itself, in the present case it contributes to the accumulation of elements pointing to bad faith registration and use.

The fact that the website at which the disputed domain name resolves is currently inactive does not preclude a finding of bad faith, nor does it detract from the Respondent's bad faith. "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." (Section 3.3 of the [WIPO Overview 3.0](#).)

The following factors were considered by the Panel as indicative of bad faith registration and use of the disputed domain name: (i) the Respondent's failure to respond to the Complaint, even though awarded a possibility to do so; (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name as per paragraph 4(b) of the Policy; (iii) the well-known character of the IBM trademarks. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or 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](#). Also, as noted above, the Panel has concluded that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. The Respondent provided no explanations for which it registered the disputed domain name.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

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, <ibm-trade.org>, be transferred to the Complainant.

/Mihaela Maravela/
Mihaela Maravela
Sole Panelist
Date: June 2, 2023