

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Domain Admin Tucows.com Co.

Case No. D2023-1473

1. The Parties

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

The Respondent is Domain Admin Tucows.com Co., Canada.

2. The Domain Name and Registrar

The disputed domain name <ibmcloudpack.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 April 4, 2023. On April 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 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 (Contact Privacy Inc. Customer 0165145759), and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 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 25, 2023.

The Center verified that the Complaint together with the amended 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 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 26, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on June 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.

4. Factual Background

The Complainant is a leader in the field of computers and its trademark IBM is world-famous. The Complainant has registered its trademark IBM in 131 countries. The Complainant owns many trademark registrations for IBM such as United States trademark registration No. 1,243,930, registered on June 28, 1983;

The Complainant has registered the United States trademark registration for IBM CLOUD PAK, No. 6,004,612 registered on March 10, 2020. The Panel notes the registration of the trademark IBM CLOUD PAK by the Complainant, is subsequent to the registration of the disputed domain name.

The disputed domain name was registered on July 24, 2019, and resolves to a website which contains sponsored Pay-Per-Click ("PPC") links.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name incorporates the Complainant's trademark IBM in its entirety and the words "cloud pack", which are a typo of an offering of the Complainant "Cloud Pak". Neither the typo nor the generic Top-Level -Domain ("gTLD") ".com" eliminate confusing similarity. In any case, the gTLD ".com" should be disregarded.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not licensed by the Complainant to use its trademark. The Respondent is not commonly known by the disputed domain name. The use of the disputed domain name cannot be considered a *bona fide* offering of goods or services. The Respondent is not making a noncommercial/fair use of the disputed domain name. The disputed domain name is being used to derive commercial gain as it points to a PPC page with links for technology related products and services.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The registration of a domain name that is identical or confusingly similar to a famous trademark creates a presumption of bad faith. IBM is a famous trademark and is incorporated in the disputed domain name. Also, the registration of a domain name that is confusingly similar to a trademark by an entity that has no relationship to that mark may be sufficient evidence of opportunistic bad faith. The Respondent in this case has no relationship with the Complainant. The registration of the disputed domain name was in 2019, while the Complainant has used the trademark IBM 63 years before that date. A privacy shield has been used. The Respondent knew or should have known of the Complainant's trademark. The Respondent did not respond to the Complainant's cease and desist letter and continued using the disputed domain name for PPC links. The Respondent is attempting to attract Internet users by creating a likelihood of confusion as to the relationship between the Respondent and the Complainant. Bad faith exists in case of passive holding.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the trademark IBM. The Panel is satisfied that the Complainant has established its ownership of the trademark IBM.

The disputed domain name incorporates the Complainant's trademarks IBM in its entirety. It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other terms are added as part of the disputed domain name. *E.g., Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"). Consequently, the addition of the terms "cloud" and "pack" does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark IBM.

The gTLD ".com" should typically be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* case that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent.

In the instant case, the Complainant asserts, *inter alia*, that the Respondent is not licensed by the Complainant to use its trademark. It is then for the Respondent to prove that it has rights or legitimate interests.

Prior UDRP 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 capitalize on the reputation and goodwill of the complainant's mark. The website to which the disputed domain name resolves contains a variety of PPC links which offer software, which is related to the Complainant's field of business. Therefore, it is the Panel's view that the Respondent is trying to capitalize on the reputation and goodwill of the Complainant's trademarks. In *Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#), it was found that the respondent had no rights or legitimate interests as "the sole purpose of the disputed domain name is to resolve to pay-per-click advertising websites and collect click-through revenue from advertising links. Such use demonstrates that the Respondent has used the disputed domain name to derive a commercial benefit. There is no indication on the website that the Respondent has made a *bona fide* use of the disputed domain name".

The absence of a Response by the Respondent allows the Panel to draw inferences, and under the circumstances, the absence of a response leaves the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name un rebutted.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent must have been aware of the Complainant's IBM trademark as it is a well-known trademark and has been registered since the 1980s. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's IBM trademark in its entirety with the additional terms "cloud" and "pack", which relate to the Complainant's sector of business. Additionally, the website contains PPC links for software products, which is within the Complainant's field. Given the above, the Panel believes

that the Respondent has registered and used the disputed domain name in order to trade off the reputation of the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 <ibmcloudpack.com> be transferred to the Complainant.

/Nayiri Boghossian/
Nayiri Boghossian
Sole Panelist
Date: June 20, 2023