

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. rui yuan and rui network inc Case No. D2023-1640

1. The Parties

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

The Respondent is rui yuan, China, and rui network inc, United States.

2. The Domain Name and Registrar

The disputed domain name <ibm52.com> is registered with NameSilo, LLC.

The disputed domain name <ibm52inc.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com

The disputed domain name <ibm52.net> is registered with NameSilo, LLC.

The disputed domain name <ibm52.org> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com.

All the disputed domain names listed above are collectively referred to as the “Domain Names”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2023. On April 14, 2023, the Center transmitted by email to the Registrars the requests for registrar verification in connection with the Domain Names. On April 14 and April 15, 2023, the Registrars transmitted by emails to the Center their verification responses disclosing registrants and contact information for the Domain Names, which differed from the named Respondent (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) and PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 25, 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 April 28, 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 May 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 31, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on June 8, 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 manufacturer of computers and computer-related goods and services. It was incorporated on June 16, 1911. In 2022, the Complainant was ranked the 168th largest company on the Fortune Global 500 list.

The Complainant is the owner of numerous IBM trademark registrations, including:

- the United States Trademark Registration for IBM, No. 4181289 registered on July 31, 2012;
- the United States Trademark Registration for IBM, No. 1696454 registered on June 23, 1992;
- the Chinese Trademark Registration for IBM, No. 1914464 registered on August 7, 2002; and
- the Chinese Trademark Registration for IBM, No. 5744856 registered on April 7, 2012.

The disputed domain name <ibm52.com> was registered on September 28, 2022.

The disputed domain name <ibm52inc.com> was registered on October 27, 2022.

The disputed domain name <ibm52.net> was registered on September 28, 2022.

The disputed domain name <ibm52.org> was registered on October 27, 2022.

On October 26, 28 and 31, 2022, and on November 11 and 29, 2022, the Complainant sent the cease-and-desist letters to the Respondent through the Registrars requesting the transfer of the Domain Names to the Complainant. However, no reply was received by the Complainant.

The Complainant presented evidence that while the Domain Names were active, they directed to similar websites hosting a fake IBM employee portal in Spanish. As of the date of this Decision, the Domain Names resolve to inactive webpages.

5. Parties' Contentions

A. Complainant

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Names are identical or confusingly similar to the IBM trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Names.

Third, the Complainant contends that the Domain Names were registered and are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Matters – Consolidation of the multiple Domain Names

Paragraph 3(c) of the Rules provides that the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. Moreover, pursuant to section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

In the present case, the Panel finds that various commonalities between the Domain Names provide sufficient evidence that they are owned and/or controlled by a common individual/entity.

Firstly, the Panel notes the proximity in the dates of registration of the Domain Names. The disputed domain names <ibm52.com> and <ibm52.net> were registered on September 28, 2022, while the disputed domain names <ibm52inc.com> and <ibm52.org> were registered on October 27, 2022.

Secondly, the Panel observes that for all the Domain Names, the registrant information was hidden by the privacy protection services. The Respondent has used the same online privacy protection company, PrivacyGuardian.org LLC, to hide its identity for the disputed domain names <ibm52.com> and <ibm52.net>. Further, the Respondent has used the same online privacy protection company, Privacy Protect, LLC, to hide its identity for the disputed domain names <ibm52.org> and <ibm52inc.com>.

Thirdly, the Panel notes the similarities in the names of the registrants of the Domain Names, as both names include “rui”.

Fourthly, all the Domain Names follow similar naming patterns. They all include the term “ibm” and the number “52”. The only difference between the Domain Names are the generic Top-Level Domains (“gTLDs”), as well as the addition of the term “inc” in the disputed domain name <ibm52inc.com>.

Fifthly, the Complainant presented evidence that while the Domain Names were active, they all directed to similar websites hosting a fake IBM employee portal in Spanish.

Lastly, the Panel takes into consideration that the Respondent has not denied in this proceeding that the Domain Names are owned and/or controlled by a common individual/entity.

Accordingly, the Panel finds that the Domain Names are subject to a common control for the purposes of these proceedings. Thus, the Panel permits the consolidation of the proceedings and refers to all the registrants of the Domain Names as the “Respondent”.

6.2. Substantive Matters – Three Elements

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the 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 the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

Under the first requirement, the Complainant must establish that the Domain Names are identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid IBM trademark registrations, which precede the registration of the Domain Names. The Domain Names incorporate this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the number “52” in the Domain Names, as well as the term “inc” in the disputed domain name <ibm52inc.com> does not prevent a finding of confusing similarity between the Domain Name and the Complainant’s IBM trademark. UDRP panels have consistently held 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. See section 1.8, [WIPO Overview 3.0](#).

The gTLD “.com”, “.net” and “.org” in the Domain Names are viewed as a standard registration requirement and as such are disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Names are confusingly similar to the IBM trademark in which the Complainant has rights. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second requirement, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Names.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it is 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant’s IBM trademark registrations predate the Respondent’s registration of the Domain Names. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the IBM trademark or to register the Domain Names incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Names.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Names in connection with a *bona fide* offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Names. On the contrary, the Complainant presented evidence that the Domain Names were used to attract Internet users and the Complainant's employees to fake employee login portals. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Names have been registered and are being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) "circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location."

As indicated above, the Complainant's rights in the IBM trademark predate the registration of the Domain Names. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration. This finding is supported by the content of the websites connected to the Domain Names and the activity carried through the Domain Names impersonating the Complainant. Moreover, it has been proven to the Panel's satisfaction that the Complainant's IBM trademark is well-known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products under this trademark. In sum, the Respondent in all likelihood registered the Domain Names with the expectation of taking advantage of the reputation of the Complainant's IBM trademark.

Furthermore, the Domain Names were used in bad faith as part of a scheme of marketing fraudulent employment opportunities to falsely appear as an entity affiliated with, or endorsed by the Complainant. Such activity was continued even after sending cease and desist letters by the Complainant.

In addition, by attracting unsuspecting Complainant's employees to fake employee login portals, the Domain Names risked these employees using their work login credentials, which compromises their privacy as well as the Complainant's cybersecurity interests. This constitutes further evidence of bad faith.

Moreover, as of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Names have resolved to inactive websites. Considering the overall circumstances of this case, the Panel

finds that the Respondent's passive holding of the Domain Names does not prevent a finding of bad faith. As numerous UDRP panels have held, passive holding, under the totality of circumstances of the case, would not prevent a finding of bad faith under the Policy. See section 3.3 of the [WIPO Overview 3.0](#). Here, given the well-known nature of the Complainant's trademark, the Respondent's failure to participate in the proceeding, and the implausible good faith use to which the Domain Names may be put, the Panel agrees with the above.

Furthermore, the Domain Names have been configured with MX records to enable sending and receiving emails from the Domain Name. In the circumstances of this case, there appear to be no conceivable benefit to the Respondent to be gained by registration and use of the Domain Name in this way other than through bad faith activity such as phishing (*W.W. Grainger, Inc. v. WhoisGuard Protected, WhoisGuard, Inc. / Daniel Thomas*, WIPO Case No. [D2020-1740](#)).

Finally, the Respondent's use of privacy services that concealed registrant information, as well as lack of response to the Complainant's cease-and-desist letters are further evidence of bad faith.

For the reasons discussed above, the Panel finds that the Complainants have proved the requirements under 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 Domain Names <ibm52.com>, <ibm52inc.com>, <ibm52.net> and <ibm52.org> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: June 22, 2023