

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. Carolina Rodrigues,
Fundacion Comercio Electronico
Case No. D2023-2572

1. The Parties

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Names and Registrar

The disputed domain name <americasibm.com>, and <emailibm.com> are registered with GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2023. On June 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 23, 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 June 27, 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 July 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 23, 2023.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on September 5, 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 was incorporated in 1911, as an amalgamation of three previously existing companies, the Complainant is a multinational manufacturer of computer and computer-related goods and services throughout the world and produces a wide variety of products that process, communicate, store, and retrieve information. It has been an 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 since the 1880s. It officially became International Business Machines on February 14, 1924, and has been offering products under the IBM trade mark ever since.

In 2022, the Complainant was ranked the 18th most valuable global brand by BrandZ, the 18th best global brand by Interbrand, the 49th largest company on the Fortune U.S. 500 list, and the 168st largest company on the Fortune Global 500 list. In 2021, the Complainant was ranked the 15th most valuable global brand by BrandZ, the 18th best global brand by Interbrand, the 42nd largest company on the Fortune U.S. 500 list, and the 121st largest company on the Fortune Global 500 list.

The Complainant is the owner of a range of trademark registrations that incorporate the element IBM in 131 countries, including the United States and China. For example, United States Registration No. 4,181,289 registered on July 31, 2012 in classes 6, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 30, 35, and 41, and United States Registration No. 3,002,164 registered on September 27, 2005, in class 9.

It is a fact, recognized in many judicial cases in various jurisdictions and also in a previous WIPO UDRP decision that the Complainant's trademark has a strong reputation and is widely known throughout the world.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

The disputed domain names were registered on October 4, 2022, and October 11, 2022, and redirect (prior to the Complaint) Internet users to a website that shows elements consistent with malware or virus distribution. After the filing of the Complaint the contents of the disputed domain name <americasibm.com>, changed and resolved to a pay-per-click ("PPC") site offering links to third-party relating to rims and wheels.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

(a) The IBM trademark is a world-famous trademark and the Complainant presents proof and evidence to support this statement.

(b)The disputed domain names are confusingly similar to its trademark IBM.

(c) The disputed domain names consist of the letters "ibm", preceded by the word "email" or "americas", and the generic Top-Level Domain suffix ".com" and argues that this minor variation does not obviate the confusing similarity between the two disputed domain names and the IBM trademark.

(d) The letters "ibm" contained in the disputed domain names are exactly the same as the IBM trademark. The only difference is the addition of the word "email" a descriptive term and "americas" a geographic term.

(e) The Respondent has no rights or legitimate interests in the disputed domain names since the Complainant has never licensed, contracted, or otherwise permitted it to register the disputed domain names. There is no evidence that “IBM” is the name of the Respondent’s corporate entity nor is there any evidence of fair use. The Respondent has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names.

(f) The disputed domain names were registered and are being used in bad faith. The Respondent has been actively using the disputed domain names, to redirect Internet users to websites that show elements consistent with malware or virus distribution. The Respondent has also connected the disputed domain names to mail servers responsible for sending and accepting email message on behalf of the disputed domain names. Such misuse of the disputed domain names containing the IBM trademark is clear evidence of bad faith.

The Complainant requests the transfer of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) the disputed 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 respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith

A. Identical or Confusingly Similar

The Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademark. The disputed domain names incorporate the Complainant’s IBM trademark in full preceded by the word “email” or “americas”, that does not prevent a finding of confusing similarity. See section 1.8 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The gTLD” suffix “.com” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, which has not been rebutted by the Respondent.

As highlighted in several previous UDRP decisions, and stated in the [WIPO Overview 3.0](#), section 2.1, that a complainant makes out 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 name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has asserted that the Respondent has no business with, and is not affiliated with the Complainant. The Respondent is not authorized nor licensed to use the Complainant's IBM trademark. There is no evidence that "emailibm" or "americasibm" is the name of the Respondent's corporate entity. Furthermore, there is no evidence that the Respondent has used or is planning to use the IBM trademark or the disputed domain names for a *bona fide* offering of goods and services. In addition, the Respondent has used the disputed domain names, to redirect Internet users to a website that shows elements consistent with malware or virus distribution.

The Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel, based on the evidence presented, accepts and agrees with the Complainant's contentions that the disputed domain names were registered in bad faith. Moreover, the disputed domain names, reproduce on its entirety the Complainant trademark IBM and have been used to redirect Internet users to websites that shows elements consistent with malware or virus distribution. The dissemination of malware through a domain name that is confusingly similar to a complainant's trademark is often done to steal consumer information for commercial gain, and this is evidence of bad faith. *Wikimedia Foundation, Inc. v. Yangmin Fang, Huli Jing Internet Holdings Ltd.*, WIPO Case No. [D2015-2140](#).

Moreover, the Respondent has also connected the disputed domain names to a mail server responsible for sending and accepting email message on behalf of the disputed domain names.

Therefore, 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 names <americasibm.com> and <emailibm.com> be transferred to the Complainant.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: September 18, 2023