

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Gabriel Haney
Case No. D2023-2772

1. The Parties

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

Respondent is Gabriel Haney, U.S.

2. The Domain Names and Registrar

The disputed domain names <ibm-as400hostingservices.com>, <ibmcloudmigrator.com>, <ibm-cloudservices.com>, <ibmcloudservices.net>, <ibmcloudservices.pro> and <ibmmanagedhosting.com> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 29, 2023. On June 29, 2023, the Center sent by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names that differed from the named Respondent (John Doe/ Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint.

The Center sent an email communication to Complainant on July 7, 2023, providing the registrant and contact information disclosed by the Registrar and noting that the registrant information for <ibmi.social>, included in the initial Complaint, differed from the registrant information for the other disputed domain names in the Complaint. In light of this, the Center invited Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on July 10, 2023, which, among other things, removed the <ibmi.social> domain name from the Complaint.

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 Respondent of the Amended Complaint and the proceedings commenced on July 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2023. Respondent did not submit a Response. Accordingly, the Center notified Respondent's default on August 22, 2023.

The Center appointed Jeffrey D. Steinhardt as sole panelist in this matter on August 21, 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

Complainant is one of the world's oldest and leading information technology companies, known worldwide for its computers, server, data storage and hosting technologies.

Complainant owns trademark registrations for its famous IBM trademarks in well over one-hundred countries, including, for example United States Trademark Registration No. 640,606 in International Class 9, with a first use in commerce date of August 5, 1955, and United States Trademark Registration No. 4,181,289 in International Classes 9, 16, 18, 20, 21, 22, 24, 25, 28, 35 and 41.

Complainant also owns trademark registrations for its IBM CLOUD trademark, for example, United States Trademark Registration No. 6,031,360 in International Classes 9, 35, 38 and 42 (see Annex 4.9 to Complaint), registered April 14, 2020.

The disputed domain names were registered December 1, 2022. None of the disputed domain names currently resolve to active webpages. However, as discussed below, Complainant provides evidence that shows Respondent's use at times of each of the disputed domain names to route to active webpages displaying pay-per-click (PPC) links to technology products and services similar to, and in some instances in competition with, Complainant's products and services.

5. Parties' Contentions

A. Complainant

Complainant avers that IBM is one of the world's most prominent and valuable brands. Complainant also avers that the IBM trademark is a world-famous trademark that traces its roots to the 1880s and that Complainant has been a leading innovator in the design and manufacture of a wide array of products and services to record, process, communicate, store and retrieve information, including computers, and computer hardware and software.

Complainant avers that the disputed domain names, all of which incorporate the IBM trademark, are confusing to consumers since each disputed domain name combines the IBM trademark with terms that directly relate to areas of IBM's technology business. For example, each of the disputed domain names <ibmcloudmigrator.com>, <ibm-cloudservices.com>, <ibmcloudservices.net>, and <ibmcloudservices.pro> incorporate the term "cloud," which is closely associated with Complainant's business offerings; and the disputed domain names <ibm-as400hostingservices.com> and <ibmmanagedhosting.com> also incorporate terms closely associated with Complainant's business, including "as400", "hosting services", and "hosting".

Complainant avers that all of the disputed domain names are used to display similar content, consisting of advertisements and PPC links related to technology products and services.¹ Complainant also submits

¹ Complainant's annexed screen captures are all dated December 5, 2022, except for the screen capture displaying the webpage to which <ibmcloudservices.pro> resolves, the date of which is not shown.

evidence that each of the disputed domain names is configured to establish MX (mail exchange) records to support their usage for email services.

Summarizing its legal contentions, Complainant alleges that (1) the disputed domain names are identical or confusingly similar to Complainant's trademarks, (2) Respondent has no rights or legitimate interests in the disputed domain names, and (3) the disputed domain names were registered and are being used in bad faith, all in violation of the Policy.

Complainant avers that in December 2022, it sent cease and desist letters for each disputed domain name to Respondent via the privacy registration service and the Registrar, to which no response has been received.²

On this basis, Complainant seeks transfer of the disputed domain names.

B. Respondent

Respondent did not reply to Complainant's contentions and submitted no Response to the Complaint. The Center, however, received two brief email communications from Respondent more than a week after the August 1, 2023, deadline for responding to the Complaint had passed. Respondent's first August 9, 2023 email simply stated, "No clue what this is or what you are talking about?" Respondent's second August 9, 2023 email to the Center added only "I also live the United States of America us".

6. Discussion and Findings

To prevail under the Policy, Complainant must establish that (1) the disputed domain names are identical or confusingly similar to Complainant's IBM trademarks, (2) Respondent has no rights or legitimate interests in the disputed domain names, and (3) the disputed domain names were registered and are being used in bad faith. Policy, paragraph 4(a).

The fact that Respondent has not provided any Response does not, by itself, mean that Complainant prevails. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3. In the absence of a Response, however, the Panel may also accept as true reasonable factual allegations in the Complaint. See, e.g., *ThyssenKrupp USA, Inc. v. Richard Giardini*, WIPO Case No. [D2001-1425](#) (citing *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#)).

A. Identical or Confusingly Similar

The Panel agrees with Complainant's allegations that the disputed domain names are confusingly similar to Complainant's IBM marks.

UDRP panels commonly disregard Top-Level Domains ("TLDs") in determining whether a disputed domain name is identical or similar to a complainant's marks. [WIPO Overview 3.0](#), section 1.11.1.

Omitting the ".net" TLD from the disputed domain name <ibmcloudservices.net> and the ".pro" TLD from the disputed domain name <ibmcloudservices.pro>, the Panel notes that the entire IBM mark is included, in both cases adding only "cloudservices". Omitting the ".com" TLD from the four <.com> disputed domain names, the Panel notes that Complainant's entire IBM mark is included in the disputed domain names, respectively adding only "-as400hosting services", "cloudmigrator", "-cloudservices", and "managedhosting".

The Panel finds that these additions to Complainant's trademarks do not prevent findings in each instance of confusing similarity. See, e.g., [WIPO Overview 3.0](#), section 1.7 (where a domain name incorporates the entirety of a trademark, the domain name will normally be considered by UDRP panels to be confusingly

² Complainant also avers that it sent follow-up letters without response. Complainant's cease and desist letters to Respondent are annexed to the Complaint.

similar); [WIPO Overview 3.0](#), section 1.8 (“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 concludes that the first element of paragraph 4(a) of the Policy is satisfied with respect to each of the disputed domain names.

B. Rights or Legitimate Interests

The Panel also concludes that Respondent has no rights or legitimate interests in the disputed domain names.

The Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes: (1) using the domain name in connection with a *bona fide* offering of goods and services; (2) being commonly known by the domain name; or (3) making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers. Policy, paragraphs 4(c)(i) – (iii).

A complainant must show a *prima facie* case that a respondent lacks rights or legitimate interests in a disputed domain name, after which the burden of production of evidence passes to the respondent. See, e.g., [WIPO Overview 3.0](#), section 2.1. The absence of rights or legitimate interests is established if a complainant makes out a *prima facie* case and the respondent enters no response. See *id.*

Complainant avers that Respondent is not affiliated with Complainant, has no authorization to use Complainant’s trademarks, and that Respondent is not commonly known by the disputed domain names. The Panel accepts these undisputed allegations.

Complainant has submitted credible evidence that the disputed domain names have at times routed users to webpages that create the misleading impression that they are Complainant’s official websites. At other times, the disputed domain names have routed to inactive webpages.

Complainant also submits evidence showing that the PPC advertising links displayed on the webpages to which the disputed domain names pointed have directed Internet users to third-party commercial products in competition with products and services offered by Complainant under its marks. The Panel agrees with Complainant that it is reasonable to conclude that Respondent is receiving revenue from the use of the advertising links, and the Panel therefore finds that there is no *bona fide* use.

In the circumstances of this case (including the use of domain names which incorporate and are confusingly similar to Complainant’s trademarks), the display of PPC advertising links on the websites to which the disputed domain names route also precludes the possibility that Respondent is making a legitimate noncommercial or fair use. E.g., [WIPO Overview 3.0](#), section 2.9.

The Panel rules that Complainant has established a *prima facie* case. Refraining from submitting a response, Respondent has brought to the Panel’s attention no circumstances from which the Panel could infer that Respondent has rights or legitimate interests in respect of the disputed domain names.³

Therefore, the Panel concludes that the second element of paragraph 4(a) of the Policy is established.

³The Panel also finds that Respondent lacks rights or legitimate interests in the disputed domain names on the grounds that Respondent’s use of the disputed domain names falsely suggests that Respondent is affiliated with Complainant, the trademark owner. [WIPO Overview 3.0](#), section 2.5 (a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner).

C. Registered and Used in Bad Faith

The Panel finds that the third element of paragraph 4(a) of the Policy, bad faith registration and bad faith use, is also established.

Complainant has made hundreds of trademark registrations and longstanding and widespread worldwide use of its famous IBM trademark. The record shows that Respondent registered multiple disputed domain names incorporating Complainant's IBM trademarks more than 67 years after Complainant first registered its trademark rights in the U.S. The Panel finds that a presumption of bad faith is created by Respondent's mere registration of the disputed domain names, which are confusingly similar to Complainant's famous IBM trademarks. [WIPO Overview 3.0](#), section 3.1.4. Respondent has submitted no evidence to contradict this presumption.

Respondent's choice of the disputed domain names, all of which completely incorporate Complainant's famous IBM marks, makes clear that Respondent knew of Complainant and targeted Complainant's trademarks and business. This renders beyond dispute that Respondent sought to exploit Complainant's trademark through registration of the confusingly similar disputed domain names, and the Panel so finds. The Panel holds therefore that Respondent registered the disputed domain names in bad faith. Policy, paragraph 4(b)(iv); [WIPO Overview 3.0](#), section 3.2.1.

The Panel also agrees with Complainant that Respondent has engaged in a pattern of domain name registration aimed at preventing the owner of the trademark from reflecting the mark in corresponding domain names. Given the ample other indications of Respondent's bad faith, the Panel does not hesitate to conclude that this also evidences bad faith. Policy, paragraph 4(b)(ii); see [WIPO Overview 3.0](#), section 3.1.2 ("A pattern of abuse has also been found where the respondent registers . . . multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.").

The Panel finds that the following circumstances further evidence Respondent's use in bad faith: (1) Respondent's DNS configuration of the disputed domain names for use with email; (2) the use of PPC links to areas that correspond to Complainant's business activities and also to direct traffic to Complainant's competitors; (3) Respondent's later passive holding of the disputed domain names; and (4) Respondent's failure to reply both to Complainant's cease and desist letters and to the Complaint in this proceeding. *E.g.*, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), sections 3.3, 3.4 and 3.2.1.

The Panel holds therefore that Respondent registered and used the disputed domain names in bad faith, thus establishing the third element under Paragraph 4(a) 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 <ibm-as400hostingservices.com>, <ibmcloudmigrator.com>, <ibm-cloudservices.com>, <ibmcloudservices.net>, <ibmcloudservices.pro>, and <ibmmanagedhosting.com> be transferred to Complainant.

/Jeffrey D. Steinhardt/

Jeffrey D. Steinhardt

Sole Panelist

Date: September 2, 2023