

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. Maya Lal
Case No. D2024-0028

1. The Parties

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

The Respondent is Maya Lal, India.

2. The Domain Name and Registrar

The disputed domain names <ibm-apache.com> and <ibm-hadoop.com> are registered with Dynadot Inc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 4, 2024, against two disputed domain names.

On January 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 7, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain names which differed from the named Respondent (John Doe, REDACTED FOR PRIVACY (DT), Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 10, 2024, 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 January 10, 2024.

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 February 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 3, 2024.

The Respondent sent email communications to the Center on January 10, 2024, and February 8, 2024. On January 10, 2024, the Respondent stated that it wished “to resolve the complaint but through appropriate compensation”. On February 8, 2024, the Respondent stated that it “would still request for a compensation and was “ready for a settlement”. The Complainant did not entertain this request.

Pursuant to paragraph 6 of the Rules, on March 11, 2024, the Center informed the Parties that it would proceed with the panel appointment process.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on March 14, 2024. 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 leading innovator in the design and manufacture of technology products since the 1880s. The Complainant is the 38th largest company on the Fortune U.S. 500 and has been offering products under the trademark IBM since 1924.

The Complainant owns numerous trademark registrations for the mark IBM in several countries around the world for a broad range of goods and services, including information technology-related goods and services, ranging in International Classes 1, 7, 9, 16, 18, 20, 21, 22, 24, 25, 28, 35, 36, 37, 41 and 42. The Complainant owns the following trademarks in the United States of America: trademark registration no. 4,181,289; trademark registration no. 3,002,164; and trademark registration no. 1,696,454.

The disputed domain name <ibm-hadoop.com> was registered on August 22, 2023, and the disputed domain name <ibm-apache.com> was registered on October 21, 2023.

Both disputed domain names resolve to websites that replicate the Complainant’s legitimate web presence, and that have the capacity to gather web users’ private information.

5. Parties’ Contentions

A. Complainant

The Complainant sought consolidation in relation to the two disputed domain names concerned here. This is because both disputed domain names have the same contact information, registrar, hosting provider, IP location and ASN, name and email servers. They also have the same compositional pattern and analogous content in the websites to which each resolve, the Complainant points out. When making these submissions the Complainant was unaware that both disputed domain names have the same underlying registrant.

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that within the meaning of paragraph 4 of the Policy, <ibm-hadoop.com> and <ibm-apache.com> are identical or confusingly similar to the Complainant’s registered trademarks. The only differences between <ibm-hadoop.com>, <ibm-apache.com>, and the Complainant’s trademarks is the addition of the words “hadoop” or “apache” and a dash “-.” According to the Complainant, these minor variations do not obviate the confusing similarity between <ibm-hadoop.com>, <ibm-apache.com>, and the IBM trademark.

The Complainant points to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") where it says 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." The Complainant also asserts that it has never licensed, contracted, or otherwise permitted anyone to apply to register the domain names in dispute. Furthermore, the Complainant says that there is no evidence that the Respondent is using the disputed domain names for a bona fide offering of goods or services, nor is there any evidence of fair use.

The Complainant emphasizes that the Respondent used both disputed domain names to direct Internet users to a website that deceptively replicates the look and feel of the Complainant's website through use of its trademark, logo, and passages of copied text. This amounts to use for illegal activity and can therefore never confer rights or legitimate interests. The Respondent has been actively using the IBM trademark in the disputed domain names to derive illegitimate commercial gains by gathering personal and sensitive information from unsuspecting Internet users. The Complainant contends that it could thus reasonably be inferred that the Respondent is either selling the gathered personal information or using it to perpetuate other phishing schemes.

The Complainant further points out that section 3.1.4 of the [WIPO Overview 3.0](#) states that a presumption of bad faith may be created solely through the "registration of a domain name that is identical or confusingly similar (particularly domain names comprising of typos or incorporating the mark plus a descriptive term) to a famous or widely-known trade mark..." In this case, both disputed domain names include what the Complainant refers to as the world-famous IBM mark. The Complainant contends that the Respondent was aware of the Complainant's IBM trademark at the time the Respondent registered the disputed domain names, and that Internet search engines yield results for the Complainant and its products and services when using "IBM," "IBM Hadoop," and "IBM Apache" as keywords.

Further, the Complainant points out that the Respondent used a privacy shield to mask its identity, which makes it difficult for a Complainant to contact the Respondent and amicably settle a domain dispute. Furthermore, the Complainant asserts that the Respondent is using the Complainant's mark to attract users and generate more traffic to its network, which poses a security threat by gathering personal and sensitive information. The Respondent has also connected the disputed domain names to a mail server responsible for sending and accepting email messages on behalf of the disputed domain names to the Complainant. This suggests, the Complainant contends, that the Respondent may have intended to use the disputed domain names for phishing or other fraudulent purposes. The Complainant also says the Respondent did not reply to any of its cease and desist letters, a fact that should also be held against it.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Respondent indicated in communications with the Center that it wished "to resolve the complaint but through appropriate compensation" and was "ready for a settlement".

6. Discussion and Findings

Consolidation

Upon verification by the Center, it has become apparent that both disputed domain names are registered in the name of Maya Lal with all other registrant information also being identical. Given that fact and the arguments advanced by the Complainant and referenced above, it is fair, efficient and appropriate for both disputed domain names to be dealt with in this single proceeding.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names ([WIPO Overview 3.0](#), section 1.7).

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced and recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the IBM mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.7).

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's prima facie showing and has not advanced any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise. The Complainant did not authorize the Respondent's use of its IBM trademark, is not known by either disputed domain name, and has no legitimate claim to prior use of the mark IBM.

Panels have held that the use of a domain name for illegal activity such as here impersonation/passing off of the Complainant's web presence, and attempting to obtain private information from Internet users, can never confer rights or legitimate interests on a respondent ([WIPO Overview 3.0](#), section 2.13.1).

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Accordingly, the Panel notes that the Respondent has "intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant's mark".

Panels have held that the use of a domain name for illegal activity, here claimed impersonation and associated surreptitious capturing of personal information, constitutes bad faith ([WIPO Overview 3.0](#), section 3.4). The Respondent chose to register domain names that incorporate a very long established and widely reputed trademark to which that same Respondent has no prior rights. The composition of the disputed domain names indicates that the Respondent at the time of registration was fully aware of the Complainant and the exclusivity of its rights over the IBM mark.

The Panel finds that the Complainant has established the third element 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-apache.com> and <ibm-hadoop.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: March 28, 2024