

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Muhammad Samiullah
Case No. D2024-1358

1. The Parties

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

The Respondent is Muhammad Samiullah, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <ibmcoin.store> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 29, 2024. On April 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 4, 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 the same day.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 8, 2024. In accordance with paragraph 5 of the Rules, the due date for Response was April 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 30, 2024.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on May 3, 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 paragraph 7 of the Rules.

4. Factual Background

Incorporated on June 16, 1911, as an amalgamation of three previously existing companies, the Complainant officially renamed to the current corporate name on February 14, 1924. The Complainant has been offering products under the trademark IBM (the “IBM Trademark”) ever since. In the early days, these products included office and research equipment such as punch machines, calculating machines, clocks, and scales. The Complainant introduced its first large vacuum tube computer under the name IBM 710 in 1952, and since then has continuously used the IBM Trademark in association with computers and computer hardware, software, and accessories. The Complainant is and has been a leading 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.

The Complainant owns and has owned the IBM Trademarks registered in 131 countries all around the world for several decades, and for a broad range of goods and services, including, although not limited to, information technology related goods and services, particularly, including United States trademarks No. 640,606 (registered on January 29, 1957), No. 1,058,803 (registered on February 15, 1977), No. 1,205,090 (registered on August 17, 1982), No. 1,243,930 (registered on June 28, 1983), No. 1,694,814 (registered on June 16, 1992), No. 1,696,454 (registered on June 23, 1992), No. 3,002,164 (registered on September 27, 2005), and No. 4,181,289 (registered on July 31, 2012).

The disputed domain name was registered on September 10, 2023. The disputed domain name resolves to a website that provides pay-per-click (“PPC”) links.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. The Complainant’s contentions may be summarized as follows:

First, the minor variation which add the word “coin” to the IBM Trademark does not obviate the confusing similarity between the disputed domain name and the IBM Trademark.

Second, the unauthorized use of the IBM Trademark by the Respondent is likely to cause consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorses the Respondent’s activities, while in fact no such relationship exists.

Third, the Respondent’s misuse of the disputed domain name is clear evidence of bad faith because the use of the Complainant’s famous IBM Trademark as part of the domain name will generate more traffic to the disputed domain name and will result in more revenue for the Respondent. It also creates a likelihood of confusion as to the relationship between the Complainant and the Respondent, as well as the source, sponsorship, or endorsement of the Respondent’s websites and/or goods and services.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant maintains the worldwide registrations of the IBM Trademarks for more than a half century. Thus, the Complainant has shown the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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 name. See section 1.7 of the [WIPO Overview 3.0](#).

The disputed domain name consists of the letters "ibm" (not case sensitive), the descriptive term "coin" and the generic Top-Level Domain ("gTLD") ".store." The letters "ibm" contained in the disputed domain name are exactly the same as the IBM Trademark. The only difference is the addition of the descriptive term "coin". Thus, the Panel finds that the IBM Trademark is recognizable within the disputed domain name, and the mere addition of the descriptive term "coin" would not prevent a finding of confusing similarity under the first element in paragraph 4(a) of the Policy. See section 1.8 of the [WIPO Overview 3.0](#); see also *AXA SA v. Ong Tran Van Minh*, WIPO Case No. [D2017-0697](#); *Philip Morris USA Inc. v. Serkan Kapu*, WIPO Case No. [D2018-0236](#); *Facebook, Inc. v. Tien Nguyen*, WIPO Case No. [D2021-1501](#); *Meta Platforms, Inc. v. Host Master, 1337 Services LLC*, WIPO Case No. [D2022-4279](#); *Meta Platforms, Inc. v. Александр Саратов*, WIPO Case No. [D2022-4691](#).

Furthermore, the gTLD ".store" in the disputed domain name is viewed as a standard registration requirement and as such may be disregarded while conducting the similarity test comparing the disputed domain name to the Complainant's IBM Trademark. Therefore, the gTLD ".store" does not obviate the confusing similarity between the disputed domain name and the IBM Trademark. See section 1.11.1 of the [WIPO Overview 3.0](#).

Accordingly, the disputed domain name is confusingly similar to the IBM Trademark for the purposes of the Policy..

The Panel concludes that the first element in paragraph 4(a) 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.

According to the Complainant's assertion, the Complainant has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain name. Furthermore, there is no evidence that the Respondent is using the disputed domain name incorporating the Complainant's IBM Trademark for a bona fide offering of goods or services, nor is there any evidence of either the Respondent being known by the "ibmcoin.store" name or having used the disputed domain name in a manner consistent with fair use.

The evidence shows that the Respondent has been attempting to create a likelihood of confusion by pointing the disputed domain name to a PPC parking page with advertisement links containing references to technology-related products and services. The Respondent has also configured an email server on the disputed domain name to use for deceptive purposes. As a result, the Respondent is considered to have been misusing the IBM Trademark in the disputed domain name to derive illegitimate commercial gains.

Although the overall burden of proof in UDRP proceedings is on the complainant, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on the second element in paragraph 4(a) of the Policy 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 in paragraph 4(a) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

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 name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element in paragraph 4(a) of the Policy has been established.

C. Registered and Used in Bad Faith

The Complainant's IBM Trademarks are extremely famous or widely known around the world for more than a half century. The Respondent must have been well aware of the Complainant's IBM Trademarks at the time of the registration of the disputed domain name.

A presumption of bad faith may be created solely through the mere registration of a domain name that is identical or confusingly similar (particularly a domain name incorporating the mark plus a descriptive term) to a famous or widely known trademark by unaffiliated entity. See section 3.1.4 of the [WIPO Overview 3.0](#); see also *International Business Machines Corporation v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Xie Gege*, WIPO Case No. [D2021-0245](#); *International Business Machines Corporation v. Jian Liu*, WIPO Case No. [D2021-0248](#). Hence, a presumption of bad faith against the Respondent can be found in this case.

Moreover, the Complainant sent a cease-and-desist letter to the Respondent through the Registrar at the email address listed in the WhoIs records on September 20, 2023, asking the Respondent to disable and transfer the disputed domain name to the Complainant. Subsequently, the Complainant sent follow-up cease-and-desist letters to the Respondent through the Registrar on November 3, 2023, March 8, 2024 and March 25, 2024. However, the Respondent did not reply to any letters from the Complainant.

As explained above, the Respondent points the disputed domain name to a PPC parking page with advertisement links containing references to technology-related products and services. A respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links *ipso facto* vest the respondent with rights or legitimate interests) regardless of whether such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that respondent itself may not have directly profited. See section 3.5 of the [WIPO Overview 3.0](#).

For all the foregoing reasons, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

The Panel concludes that the third element in paragraph 4(a) of the Policy has been established.

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 <ibmcoin.store> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: May 17, 2024