

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Maya Lal, IBM HADOOP
Case No. D2024-1614

1. The Parties

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

The Respondent is Maya Lal, IBM HADOOP, India.

2. The Domain Name and Registrar

The disputed domain name <ibm-scala.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2024. On April 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and providing additional details. The Center sent an email communication to the Complainant on April 25, 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 April 29, 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 May 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2024. The Respondent sent an email communication to the Center on May 3, 2024. On May 29, 2024, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Mireille Buydens as the sole panelist in this matter on June 7, 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

Incorporated on June 16, 1911, the Complainant officially became International Business Machines (“IBM”) on February 14, 1924. The Complainant has been offering products under the trademark IBM (“the IBM Trademark”) ever since. The Complainant is a leading company in the field of computers and computer hardware, software, and accessories and has been ranked among the largest companies on the Fortune US list of companies for years.

The Complainant owns trademark registrations for the IBM Trademark in various countries for several decades, and for a broad range of goods and services, including information technology-related goods and services. The Complainant notably owns the following trademark registrations for the IBM Trademark:

- United States trademark registration No. 4,181,289 for IBM (word- and figurative mark) registered on July 31, 2012 in International Classes 9, 16, 18, 20, 21, 22, 24, 25, 28, 35, and 41;
- United States trademark registration No. 3,002,164 for IBM (word and figurative mark) registered on September 27, 2005 in International Class 9;
- India trademark registration No. 903,730, for IBM (combined) registered on February 15, 2000 in Class 9;
- India trademark registration No. 2,120,172 for IBM (word- and figurative mark) registered on March 23, 2011 in Class 9;

The Complainant is also the owner of the domain name <ibm.com>, registered in 1986, which resolves to the Complainant’s primary web portal for the promotion and provision of the IBM products and services.

The disputed domain name was registered on December 5, 2023. According to the Complaint, the Respondent used the disputed domain name to direct Internet users to a webpage that deceptively replicated the look and feel of the Complainant’s website through the use of the Complainant’s IBM Trademark and passages of text lifted from the Complainant’s website. The webpage to which the disputed domain name resolved also presented a registration link under the heading “IBM Training” which redirected to a log-in page titled “IBM – Students Remote Learning Registration”, where personal information was gathered.

At the time of this decision, the disputed domain name resolves to an error page.

The Complainant sent two cease-and-desist letters to the Respondent through the Registrar at the email address listed in the Whois records. The Respondent did not reply. Eventually, the Complainant also sent a cease-and-desist letter directly to the Respondent. The Respondent replied to this last cease-and-desist letter, explaining that it had unknowingly bought the disputed domain name and invested to develop the website. In the same email, the Respondent asked for financial compensation to transfer it to the Complainant.

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.

Notably, the Complainant explains that it owns rights in the IBM Trademark and that the disputed domain name is confusingly similar to the IBM Trademark. The disputed domain name consists of the letters "ibm" followed by a hyphen "-", and the term "scala" (which is the name of an open source programming language). The addition of the term "scala" alongside the IBM Trademark suggests that the disputed domain name is associated with the Complainant, as the Complainant has offerings incorporating the Scala programming language.

Second, the Complainant asserts that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant has never licensed, contracted, or otherwise permitted the Respondent to register the disputed domain name. Respondent has not been commonly known by the disputed domain name. There is no evidence that the Respondent is using disputed domain name for a bona fide offering of goods or services, nor is there any evidence of fair use. On the contrary, the Respondent has used the disputed domain name to direct Internet users to a webpage that deceptively replicates the look and feel of the Complainant's website, thereby diverting traffic intended for the Complainant's website for the Respondent's own commercial gain. The Respondent's use of the Complainant's IBM Trademark to gain reputational advantage does not support a claim of rights or legitimate interests. In addition, the Respondent's webpage displayed a link to "Buy Now" which redirected to another webpage, where visitors could purchase educational courses related to the Scala programming language. When doing so, they entered various personal information. It could reasonably be understood that the Respondent is either selling the gathered personal information or using it to perpetuate other phishing schemes, thus attempting to generate illegitimate commercial gain from using the Complainant's IBM Trademark. Furthermore, such unauthorized use of the IBM Trademark is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while in fact, no such relationship exists.

Third, the Complainant asserts that the disputed domain name was registered and is being used in bad faith. In particular, the Respondent was well aware of the Complainant's well-known IBM Trademark at the time it registered the disputed domain name, as the IBM Trademark predates the disputed domain name for several decades. Further, Internet search engines yield numerous results for the Complainant and its products and services when using "IBM" or "IBM Scala" as keywords. Hence, the Respondent knew or should have known of the Complainant's IBM Trademark when registering the disputed domain name. Furthermore, the Respondent intentionally used the Complainant's IBM Trademark to create a fraudulent misrepresentation to potential consumers by impersonating the Complainant. Such misuse 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 website and/or goods and services. Besides, the Respondent established an email address using the disputed domain name to send deceptive emails and pass itself off as a representative within the Complainant's organization. Finally, the Complainant sent cease-and-desist letters to the Respondent. The Respondent eventually replied to the Complainant's cease-and-desist letter requesting financial compensation (with no amount mentioned) in exchange for transfer of the disputed domain name to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions. After having received notification of the Complaint, the Respondent wrote a short email to explain that he was willing to transfer the disputed domain name for a compensation of USD 1,000.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements to succeed in its Complaint:

- (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

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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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 Panel finds the IBM Trademark is recognizable within the disputed domain name. The disputed domain name consists of the IBM Trademark followed by a hyphen "-" and the term "scala", which is a term designating a programming language. The generic Top-Level Domain ("gTLD") extension (".com"), as a standard requirement of domain name registration, may be disregarded in the assessment of identity or confusing similarity. Accordingly, the disputed domain name is confusingly similar to the IBM Trademark 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 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 Respondent is not licensed by or affiliated with the Complainant in any way. There is no evidence that the Respondent is commonly known by the disputed domain name, nor is there any evidence of use or demonstrable preparations to use the disputed domain name for a bona fide offering of goods or services. In this regard, the Panel notes that the registrant organization identified in the registration details of the

disputed domain name is “IBM HADOOP”, however, there is no evidence before the Panel that the Respondent is actually commonly known by “IBM HADOOP”. Rather, it appears most likely that such details were specifically chosen to falsely suggest an affiliation with the Complainant, possibly in connection to a planned impersonating or fraudulent use of the disputed domain name. There is no evidence of legitimate noncommercial or fair use of the disputed domain name, either. The fact that the disputed domain name originally resolved to a website impersonating the Complainant’s official website, confirms that the Respondent was not intending to use the disputed domain name in the framework of a bona fide offering of goods or services. In addition, the Respondent’s webpage contained a link to a form which proposed Internet users to enter personal information, which can reasonably be understood, in the circumstances of the case, as an attempt to either sell the gathered personal information or use it to perpetuate other phishing schemes. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off and gathering of personal data, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Furthermore, the disputed domain name, consisting of the IBM Trademark and the descriptive term “scala” (which refers to a programming language used by the Complainant), carries a high risk of implied affiliation and affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant’s IBM trademark. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the disputed domain name consists of the IBM Trademark and the descriptive term “Scala” (which refers to a programming language used by the Complainant), separated by a hyphen. The IBM Trademark predates the registration of the disputed domain name for decades and is well known. It is inter alia registered in India, where the Respondent is located. As a result, the Panel finds that the Respondent was more likely than not aware of the Complainant’s IBM Trademark at the time of the registration of the disputed domain names ([WIPO Overview 3.0](#) section 3.1.4). The Respondent’s actual knowledge of the Complainant and its IBM Trademark is clearly demonstrated by the fact that the disputed domain name resolved to a website impersonating the Complainant’s official website (the website under the disputed domain name reproduced the IBM Trademark, was structured like the official IBM website and erroneously presented itself as being an official IBM website proposing IBM educational courses).

Paragraph 4(b) of the Policy considers that the domain name is used in bad faith when, by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location. In the present case, the Panel notes that the disputed domain name which reproduces the IBM Trademark with the descriptive term “scala” separated by a hyphen, combined with the gTLD “.com”, falsely suggests that Internet users will find a website affiliated with the Complainant and proposing Scala programming courses. The Respondent has sought to create a misleading impression of association with the Complainant, which is a famous company in the field of computer hardware, software, and accessories. The Panel concludes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s IBM Trademark.

Panels have held that the use of a domain name for illegal activity constitutes bad faith ([WIPO Overview 3.0](#), section 3.4.) In the present case, the disputed domain name resolved to a website impersonating the Complainant, reproducing the Complainant’s IBM Trademark as well as the same lay-out and structure of the Complainant’s official website. The website under the disputed domain name erroneously presented itself as an official IBM website proposing IBM educational courses and tried to fraudulently collect personal data.

Furthermore, the Respondent established an email address using the disputed domain name to send deceptive emails and pass itself off as a representative within the Complainant's organization. Finally, the Panel also notes that, after having received the Complainant's cease and desist letter, the Respondent offered to transfer the disputed domain name for a financial compensation, without mentioning any amount, probably in order to initiate price negotiations.

Lastly, the Panel finds that the Respondent has already registered IBM-related domain names for which a panel decision has admitted bad faith registration (see *International Business Machines Corporation (IBM) v. Maya Lal*, WIPO Case No. [D2024-0028](#)). This further reinforces the overall impression of bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 name <ibm-scala.com> be transferred to the Complainant.

/Mireille Buydens/

Mireille Buydens

Sole Panelist

Date: June 21, 2024