

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. Jeff Schneider,
BrandOps

Case No. D2024-1746

1. The Parties

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

Respondent is Jeff Schneider, BrandOps, United States.

2. The Domain Names and Registrar

The disputed domain names <watsonx-orchestrate.com> and <watsonxorchestrate.com> are registered with Amazon Registrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2024. On April 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 1, 2024, 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 (John Doe / On behalf of watsonxorchestrate.com owner, Identity Protection Service) and contact information in the Complaint. The Center sent an email communication to Complainant on May 6, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 7, 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 Respondent of the Complaint, and the proceedings commenced on May 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2024. Respondent sent e-mail communications to the Center on May 31, 2024.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on June 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.

Respondent's e-mail correspondence to the Center of May 31, 2024 consisted solely of objection to the formatting of the e-mail from the Center notifying Respondent of the Complaint.

4. Factual Background

Complainant is a large multinational enterprise organized in the State of New York and with headquarters in Armonk, New York, United States. Complainant has a presence in over 175 countries through its wholly owned subsidiaries with over 288,300 employees worldwide. Complainant has long provided information technology related goods and services under its IBM trademark, and since about 2010 has used the trademark WATSON in connection with artificial intelligence (AI)-related goods and services, and more recently since 2023 has used WATSONX for generative AI and data-related services. Complainant publicly announced the launch of its WATSONX AI and data platform on May 9, 2023. Complainant maintains a commercial website devoted to WATSONX at domain name <ibm.com/watsonx>. Complainant has recently showcased WATSONX in connection with the 66th Annual GRAMMY Awards and the 2024 Masters Golf Tournament.

Complainant is the owner of registration for WATSON-formative trademarks on the Principal Register of the United States Patent and Trademark Office (USPTO), including for IBM WATSON, word trademark registration number 5082512, registration dated November 15, 2016, in international classes (ICs) 9, 35 and 42, covering, inter alia, computer software, and programming and computer support services. Complainant is the owner of registrations for the trademark WATSONX on the register of the Australian intellectual property office (IP Australia), registration number 2418331, registration dated March 19, 2024, in ICs 9, 35 and 42; on the register of the New Zealand Intellectual Property Office, registration number 1254849, registration dated April 30, 2024, in ICs 9, 35 and 42, and; on the register of the French National Institute for Industrial Property (INPI), registration number 4959354, registration dated November 3, 2023, filed on May 4, 2023, in ICs 9, 35 and 42.

According to the Registrar's verification, Respondent is registrant of the disputed domain names. According to the Whois database report, the disputed domain names were registered on September 14, 2023. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain names since their creation date.

There is no evidence on the record of this proceeding of the use by Respondent of the disputed domain names in connection with active websites or otherwise. Entry of the disputed domain names into a browser returns server connection errors.

There is no evidence on the record of this proceeding of any commercial or other association between Respondent and 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 names.

Complainant alleges that it owns rights in the trademarks WATSON, WATSONX and other WATSON-formative trademarks, and that the disputed domain names are confusingly similar to those trademarks. Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain names because: (1) Complainant did not authorize Respondent to register the disputed domain names; (2) Respondent is not using the disputed domain names for a bona fide offering of goods or services, nor is there any evidence of legitimate noncommercial or fair use; (3) Respondent has not been commonly known by either of the disputed domain names, and; (4) use by Respondent of the disputed domain names would mislead consumers.

Complainant contends that Respondent registered and is using the disputed domain names in bad faith because: (1) Respondent's registration of the disputed domain names corresponding to Complainant's widely known trademarks creates a presumption of bad faith; (2) registration of domain names confusingly similar to Complainant's trademarks is evidence of opportunistic bad faith; (3) Respondent was well aware of Complainant's WATSON trademark when it registered the disputed domain names at least 12 years after Complainant registered its WATSON trademark; (4) Internet search results for Complainant's trademarks and the disputed domain names yield multiple results associated with Complainant and its trademarks such that Respondent must have been aware of Complainant's trademarks when it registered the disputed domain names; (5) Respondent's use of a privacy shield is evidence of bad faith; (6) Complainant need not wait for direct harm from Respondent's registration of the disputed domain names before seeking redress, and; (7) Respondent's registration and lack of use of the disputed domain names in connection with active websites constitutes bad faith under passive holding doctrine.

Complainant argues that it is appropriate to address two disputed domain names registered by the same person in this proceeding.

Respondent requests the Panel to direct the Registrar to transfer the disputed domain names to Complainant.

B. Respondent

Respondent did not substantively reply to Complainant's contentions.

6. Discussion and Findings

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration. Courier delivery of the Complaint to Respondent was successful. There is no indication of difficulty in transmission of email notification to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. There is a common identity as to the registrant of the two disputed domain names in this proceeding. The Panel determines that it was appropriate for Complainant to proceed against both disputed domain names in its Complaint, and the Panel renders its decision accordingly as to both.

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 Complainant's trademark and the disputed domain names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of the trademarks WATSON and WATSONX for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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

Although the addition of other terms, here "orchestrate" and "-orchestrate" respectively, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on 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 respondent. As such, where a complainant makes out a prima facie case that respondent lacks rights or legitimate interests, the burden of production on this element shifts to 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 respondent fails to come forward with such relevant evidence, complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Respondent has made no active use of the disputed domain names. Respondent has not provided any evidence of preparations for bona fide use. In the absence of any reply from Respondent, and considering the distinctive character of Complainant's WATSON trademark, the Panel declines to speculate regarding the potential for legitimate noncommercial or fair use.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain names.

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 Respondent registered the disputed domain names long after Complainant had established rights in its WATSON trademark, and not long after Complainant publicly announced and made use of its WATSONX trademark. Given the publicity surrounding Complainant's WATSON trademark including its use in a widely advertised television game show contest, and the distinctive character of the WATSONX trademark, it is highly implausible that Respondent was unaware of Complainant's trademarks when it registered the disputed domain names. As Complainant argued, a routine Internet search of the trademark terms yields results dominated by Complainant and its trademarks.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of Complainant's WATSON and WATSONX trademarks, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

In particular in this case, the WATSONX trademark that is incorporated in the disputed domain names is highly distinctive. The disputed domain names were registered shortly following Complainant's announcement of its WATSONX platform. It is difficult to foresee the circumstances in which Respondent independently and without reference to Complainant and its product and service decided to register the same term in the disputed domain names. Absent some explanation from Respondent, the Panel finds it implausible that Respondent registered the disputed domain names without intending to take unfair advantage of Complainant's goodwill in its trademarks.

In these circumstances, the Panel does not consider it necessary for Complainant to have waited for Respondent to take further action with the disputed domain names before seeking a remedy.

The Panel determines that Respondent registered and is using the disputed domain names in bad faith within the meaning of paragraph 4(b) of the Policy taking into account the totality of the circumstances.

The Panel finds that 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 <watsonx-orchestrate.com> and <watsonxorchestrate.com> be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: June 28, 2024