

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. 丁洁 (ding jie), 上海赛行信息科技有限公司 (shang hai qian xing xin xi ke ji you xian gong si)
Case No. D2024-3396

1. The Parties

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

The Respondent is 丁洁 (ding jie), 上海赛行信息科技有限公司 (shang hai qian xing xin xi ke ji you xian gong si), China.

2. The Domain Name and Registrar

The disputed domain name <ibm-soft.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 19, 2024. On August 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 21, 2024, 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 August 21, 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 in English on August 22, 2024.

On August 21, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On August 22, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on August 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 19, 2024.

The Center appointed Jacob Changjie Chen as the sole panelist in this matter on September 26, 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 a wide array of products that record, process, communicate, store, and retrieve information, including computers and computer hardware, software, and accessories. The Complainant was officially founded in 1924 and has been offering products under the trademark IBM ever since.

The Complainant holds numerous registrations of IBM trademark, including No. 1058803 United States trademark, registered on February 15, 1977; No. 1243930 United States trademark, registered on June 28, 1983; No. 5744986 Chinese trademark, registered on September 14, 2009; and No. 5744985 Chinese trademark, registered on October 7, 2009.

According to the information disclosed by the Registrar, the Respondent is 丁洁 (ding jie), 上海零行信息科技有限公司 (shang hai qian xing xin xi ke ji you xian gong si), located in China.

The disputed domain name was registered on November 24, 2014. The disputed domain name currently resolves to an inactive webpage.

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 contends that the disputed domain name is confusingly similar to its IBM trademark. The disputed domain name consists of “ibm”, hyphen “-”, the term “soft”, and the generic Top-Level Domain (“gTLD”) “.com”. The term “ibm” is same to the Complainant’s IBM trademark, and other elements such as hyphen “-”, the term “soft”, and the gTLD “.com” do not obviate the confusing similarity between the disputed domain name and the Complainant’s IBM trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no relationship with the Complainant, and the Complainant has not licensed or otherwise permitted the Respondent to use the IBM trademark or to register a domain name incorporating this trademark. The disputed domain name resolves to an inactive webpage, which cannot be deemed as using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use.

The Complainant finally contends that the disputed domain name was registered and is being used in bad faith. The Complainant's IBM trademark was registered far predating the registration date of the disputed domain name. The IBM trademark has gained a certain degree of reputation and recognition worldwide. Internet search engine results indicate a close connection between keywords "ibm", "ibm soft" and the Complainant and its IBM trademark. Therefore, the Respondent has awareness of the Complainant and the IBM trademark at the time of registering the disputed domain name. Given the reputation of the Complainant and the IBM trademark, the Respondent's passive holding of the disputed domain name does not prevent a finding of bad faith. In addition, the Respondent has configured email servers for the disputed domain name, indicating its intention to potentially construct an email composition containing the disputed domain name for deceiving purpose.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that 1) the disputed domain name is an English language domain name registered in Latin script. The word "soft" is an English term; 2) the Complainant is unable to communicate in Chinese, and using Chinese as language of the proceeding would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter; 3) the IP location of the disputed domain name is in Shanghai, China where people have high-level skills of English.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 3.0](#), section 1.7.

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

The entirety of the IBM trademark is reproduced within the disputed domain name. 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.

Although the addition of hyphen “-” and the term “soft” may bear on assessment of the second and third elements, the Panel finds the addition of them does not prevent a finding of confusing similarity between the disputed domain name 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 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 disputed domain name resolves to an inactive webpage, which cannot be deemed as using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. Furthermore, the Complainant and its IBM trademark have gained a certain degree of reputation and recognition worldwide and built up a close connection with each other. Without any evidence from the Respondent, the Panel finds nothing on record could infer the Respondent’s rights or legitimate interests in the disputed domain name.

In addition, the nature of the disputed domain name, comprising the IBM trademark and the additional term “soft”, which may be seen as an abbreviation for “software” when being used together with the IBM trademark, may mislead Internet users into believing that the disputed domain name is associated with the Complainant. This is not the case here.

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 registration date of the Complainant’s IBM trademark significantly predates the registration date of the disputed domain name. According to the Complainant’s evidence, the Panel views that the Complainant and its IBM trademark have gained a certain degree of reputation and recognition worldwide before the Respondent registered the disputed domain name. Given the reputation and recognition of the Complainant and its IBM trademark, noting the composition of the disputed domain name as discussed above, the Respondent knew or should have known of the Complainant and its IBM trademark when registering the disputed domain name.

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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant and its IBM trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of 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-soft.com> be transferred to the Complainant.

/Jacob Changjie Chen/

Jacob Changjie Chen

Sole Panelist

Date: October 10, 2024