

ADMINISTRATIVE PANEL DECISION

**Kyndryl, Inc. and Kyndryl Australia Pty Ltd v. Mohamedzakwan
Mohamedsharif Mansuri
Case No. DAU2022-0007**

1. The Parties

The Complainant is is Kyndryl, Inc., United States of America (United States), and Kyndryl Australia Pty Ltd, Australia, represented by Demys Limited, United Kingdom.

The Respondent is Mohamedzakwan Mohamedsharif Mansuri, Australia.

2. The Domain Name and Registrar

The disputed domain name <kyndrylsolutions.com.au> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2022. On April 11, 2022, the Center transmitted by email to GoDaddy.com, LLC a request for registrar verification in connection with the disputed domain name. On April 11, 2022, GoDaddy.com, LLC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details and clarifications that the language of the registration agreement is English and the disputed domain name had been placed on Registrar lock.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 28, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was May 18, 2022. The Respondent sent an email to the Center on April 28, 2022, but, notwithstanding the Center’s request for clarification on May 20, 2022, made no further response.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on June 3, 2022. 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 Complainants are part of the Kyndryl group of companies. The Kyndryl group was formed by the divestiture of IBM's Global Technology Services infrastructure services business.

According to the Complaint, this business comprised one quarter of IBM's then employees and more than 4,000 clients including some 75 per cent of Fortune 100 companies. In 2020, the business generated USD 19.35 billion in revenues.

The first-named Complainant is the headquarters and, as discussed below, holds the group's registered trade marks. The second-named Complainant is the group's Australian operating entity.

The plan for the demerger was initially announced in October 2020. The merger formally took place in November 2021 when the parent of the group, Kyndryl Holdings Inc. was listed on the New York Stock Exchange.

On April 12, 2021, IBM announced that Kyndryl would be the name of the newly separated managed infrastructure services business. This announcement was reported globally in services including Bloomberg, the Financial Post, IT World Canada, Nasdaq, Reuters, RSY Digital World / Nixdrafts, and CIO United Kingdom.

The first-named Complainant owns two registered trade marks in Australia. For present purposes, it is sufficient to note Australian Registered Trade Mark No. 2231241, KYNDRYL, in respect of a wide range of goods and services in International Classes 9, 35, 37, 38, 41, and 42. Many of these goods and services are computer or IT related but also include advertising, business management and consultancy, construction, telecommunications, and education services. The other registration is a stylised version of this trade mark.

Both trade marks are registered with effect from June 14, 2021; the date the applications were filed.

According to auDA, the disputed domain name was registered on July 14, 2021.

In October 2021 when the Complainants discovered the Respondent's registration of the disputed domain name, the disputed domain name resolved to the Registrar's website page stating that "This domain name may be for sale".

In subsequent correspondence between the Respondent and the Complainants' agent, the Respondent confirmed the disputed domain name was for sale.

In response to an offer of USD 500, in November 2021, the Respondent claimed a third party had offered him USD 87,000 and he was negotiating for a price of USD 100,000. In December 2021, the Respondent re-initiated negotiations, this time seeking 25 Ethereum to transfer the disputed domain name – approximately USD 110,000 at the time.

There were further communications in January and February 2022. In the course of these, the Respondent noted "We totally understand the importance this domain for your client, that's why we are here.", described the Complainants' agent's offer of USD 500 as "silly" and then offered to rent the disputed domain name for USD 658 per week or, to buy it outright, for USD 54,678 stating "If you're interested then amount is very little for Billion Dollar MNC company".

Two weeks later the Respondent emailed the Complainants' agent with what he described as his "last offer" to sell for USD 19,500, which was valid until March 1, 2022.

When the Complaint was filed the disputed domain name resolved to a website under the name 'K Solutions' which appeared to be largely under construction. The website included text "Begin the Search For Your Perfect Domain Name" and appeared to offer, or be intending to offer, various types of hosting services including Dedicated Hosting, Shared Hosting, Managed Hosting, Cloud Hosting, VPS Hosting and Colocation. The website displayed numerous placeholders for images yet to be uploaded and much of the text was "lorem ipsum" placeholder text such as the text for the explanations of Asshured [sic] Speed, MySQL Database and 24/7 Support as well as the proposed Testimonials. However, monthly plans were listed: Bronze shared hosting for USD 40 per month, Silver cloud VPS for USD 60 per month and Gold dedicated servers for USD 100 per month. The text also declared under the heading "Let The Number [sic] Speak" "500+ Hostings Done, 150+ Dedicated Servers, 200+ Satisfied Clients and 2000+ Websites Created". The map on the "Contact Us" page shows New York City and surrounds in the United States.

The Complainants note that the disputed domain name's zonefile has been configured with Mail eXchanger ("MX") and Sender Policy Framework records "which means it can be used for email communication".

At the time this decision is being prepared, the disputed domain name resolves to a webpage "HostGator Let's set up your website!" with two links to "Log in to Hostgator" and "Get Support". There is also a copyright notice "Copyright 2022 © Hostgator".

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainants must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainants have rights;
- (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 or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Consolidation of Complaints

The Complainants have requested that their respective complaints against the Respondent be consolidated into the one dispute.

Paragraph 4(f) of the Policy provides that either party may apply to consolidate multiple disputes between them into the one proceeding. However, panels have exercised their powers under paragraph 10 of the Rules to permit consolidation in other circumstances subject to the overriding obligation to ensure the parties are treated with equality and each is given a fair opportunity to present its case.

In the present case, the Panel considers consolidation is appropriate given the shared interests of both Complainants in the trade mark on which the Complaint is based: the first-named Complainant being the owner of the registered trade mark and the second-named Complainant being the operating entity using the trade mark in Australia and, in effect, its licensee. See *e.g.*, auDA Overview of Panel Views on Selected auDRP Questions First Edition ("auDA auDRP Overview 1.0"), paragraph 4.16(i).

B. Identical or Confusingly Similar

The first element that the Complainants must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainants' name, trade mark or service mark.

There are two parts to this inquiry: the Complainants must demonstrate that they rights in a name or trade mark at the date the Complaint was filed and, if so, the disputed domain name must be identical or confusingly similar to the name or trade mark.

The first-named Complainant has proven that it owns the registered trade mark KYNDRYL.

As the Australian operating entity of the corporate group it is also likely that the second-named Complainant is the or an authorised user of the trade mark. An authorised user is a person who uses the trade mark under the control of the trade mark owner: Trade Marks Act 1995 (cth) s 8. Furthermore, footnote 1 to the Policy defines "name" for the purposes of this requirement under the Policy as the complainant's company, business or other legal or trading name registered with the relevant Australian government authority, or the complainant's personal name. The second-named Complainant's name is the name under which it is registered with the Australian Companies and Securities Commission and so qualifies as a name for this purpose.

On the question of identity or confusing similarity, what is required is a visual and/or aural comparison and assessment of the disputed domain name itself to the Complainants' trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of "likelihood of confusion" under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically and as is appropriate in this case, it is permissible to disregard the Top-Level Domain, ".com.au", as a functional component of the domain naming system. See for example auDA auDRP Overview 1.0, section 1.2.

The disputed domain name, therefore, consists of the Complainants' trade mark with the addition of the word "solutions". The addition of such a term to the Complainants' trade mark does not avoid a finding of confusing similarity as the trade mark remains plainly recognizable, both visually and aurally, in the disputed domain name. See *e.g.*, auDA auDRP Overview 1.0, section 1.9.

If necessary, the Panel would also disregard the inclusion of the geographical term, "Australia", in the second-named Complainant's name and find the disputed domain name confusingly similar to the second-named Complainant's name as well as the term "Kyndryl" is the distinguishing element of both names.

Accordingly, the Complainants have established the first requirement under the Policy.

C. Rights or Legitimate Interests

The second requirement the Complainants must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or

- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainants. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainants. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#) and auDA auDRP Overview 1.0, section 2.1.

In the present case, the Complainants contend and it is not in dispute that the Respondent is not licensed by or in any way associated with the Complainants or their corporate group.

The disputed domain name is not derived from the Respondent's personal name. Nor is there any suggestion of some other name from which "Kyndryl" could plausibly be derived. Indeed, it is far from clear on what basis the Respondent could establish entitlement to the disputed domain name under the eligibility and allocation rules set out for the .com.au namespace in the .au Domain Administration Rules: Licensing policy.

In that connection, the Complainants plausibly contend that "kyndryl" is a made up word (according to them being contrived from a combination of modifications of "kin" and "tendrill"). However that may be, the trade mark does not appear to be an ordinary dictionary word or geographical term but rather an invented and distinctive term. Assuming for present purposes the Respondent were conducting, or proposing to conduct, a business under the name "K Solutions", that name would not by itself support the adoption of "kyndryl" in the disputed domain name and there has been no explanation supported by credible evidence how the Respondent came to adopt the name. In any event, there is no suggestion that the Respondent adopted "K Solution" until well after he had become aware of the Complainants' corporate group and the plans for it to trade under the Kyndryl name and trade mark.

Putting to one side for the moment the question of whether the website purporting to be for a hosting business was a genuine business or not, the use of the disputed domain name which is confusingly similar to the Complainants' trade mark would appear to be in direct conflict with the Complainant's registered trade mark. It has long been established that adoption and use of a domain name in competition with a complainant's trade mark does not constitute a good faith offering of goods or services under the Policy. As the Complainants' trade mark pre-dates the Respondent's adoption of the disputed domain name, therefore, the website (even if genuine) would not constitute a good faith offering of goods or services or demonstrable preparations for such use.

In any event and as the Complainants contend, the Panel considers it likely that the website was not indicative of a genuine business. First, the disputed domain name did not begin resolving to a website (other than a parking page declaring the disputed domain name may be for sale) until many months after the Respondent registered the disputed domain name. The Respondent has not sought to explain that delay by reference to preparations being undertaken to launch the business or its website.

On the contrary, before the disputed domain name began resolving to that website, the Respondent had been actively engaged in attempts to sell the disputed domain name at least to the Complainants and claimed he was negotiating with other parties for sale to them.

Following the filing of the Complaint, the disputed domain name has ceased to resolve to that website.

Moreover, the Respondent has not claimed that he registered the disputed domain name for use in a business, or a proposed business, of providing hosting services or any other activity. In his email in response to the filing of the Complaint, the Respondent simply stated:

“We do not have any intention to use the following domain in any kind of bad activity. In the past, we also got two buying offers from third parties but rejected that offer because we don't want to give in bad hands. We totally respect their rights and are happy to cooperate at any stage. From our side we want to settle this matter as soon as possible. We are pleased to transfer all the domain rights in \$4500 AUD, and this money will be used in good faith as well.”

Having regard to these matters, the Respondent's adoption of the Complainants' inherently distinctive trade mark only after the publicising of the Complainants' plans to adopt it and the lack of any prior connection between the Respondent and the invented term “kyndryl”, the Panel considers it likely that the Respondent did not adopt the disputed domain name in connection with a planned hosting business.

In these circumstances, the Complainants have made out a clear *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has not rebutted that case. Accordingly, the Panel finds that the Complainants have established the second requirement under the Policy.

D. Registered or Subsequently Used in Bad Faith

In contrast to the Uniform Domain Name Dispute Resolution Policy, the Complainants must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent under the third requirement of the Policy. Both are in any event present here.

Generally speaking, a finding that a domain name has been registered or is being used in bad faith requires an inference to be drawn that the respondent in question has registered or is using the disputed domain name to take advantage of its significance as a trade mark owned by (usually) the complainant.

As discussed in section 5.C above, it appears that the Complainants' trade mark is an invented and inherently distinctive term. The Respondent had no apparent connection with the term prior to the Complainants' adoption of it. The Respondent adopted the disputed domain name only after there had been extensive publicity of the planned demerger of the relevant part of IBM's business under the name “Kyndryl”.

Those matters lead to a strong inference that the Respondent registered the disputed domain name with knowledge of the Complainants' (then) proposed use. The Respondent has not sought to argue otherwise. It appears likely, therefore, that the Respondent registered the disputed domain name opportunistically to take advantage of the Complainants' trade mark rights. The subsequent offers to sell the disputed domain name to the Complainants for prices far in excess of likely reasonable out-of-pocket costs supports that conclusion.

Those matters are sufficient to find that the Respondent registered the disputed domain name in bad faith.

In reaching that conclusion, the Panel does not disregard the (apparently) temporary resolution of the disputed domain name to a partially completed website in connection with a proposed offering of hosting services. First, as discussed in section 5.C above, the adoption of a domain name confusingly similar to the Complainants' trade mark for use in a business in conflict with the Complainants' trade mark would not constitute use in good faith where the Complainants' rights anticipate the Respondent's adoption.

In any event and as the Complainants contend, the Panel considers it likely that the website was not indicative of a genuine business, either existing or proposed. First, the disputed domain name did not begin

resolving to a website (other than a parking page declaring the disputed domain name may be for sale) until many months after the Respondent registered the disputed domain name.

Secondly, before it did begin resolving to that website and consistently with the parking page declaring that the disputed domain name may be for sale, the Respondent had been actively engaged in attempts to sell the disputed domain name at least to the Complainants and claimed he was negotiating with other parties for sale to them.

Thirdly, following the filing of the Complaint, the disputed domain name has ceased to resolve to that website.

Fourthly, the Respondent has not claimed that he registered the disputed domain name for use in a business, or a proposed business, of providing hosting services or any other activity. In his email in response to the filing of the Complaint, the Respondent simply stated:

"We do not have any intention to use the following domain in any kind of bad activity. In the past, we also got two buying offers from third parties but rejected that offer because we don't want to give in bad hands. We totally respect their rights and are happy to cooperate at any stage. From our side we want to settle this matter as soon as possible. We are pleased to transfer all the domain rights in \$4500 AUD, and this money will be used in good faith as well."

Having regard to these matters and the Respondent's adoption of the Complainants' inherently distinctive trade mark only after the publicizing of the plans for the Complainants to adopt it, the Panel considers it likely that the Respondent did not adopt the disputed domain name in connection with a planned hosting business. On the information before the Panel, the temporary website appears to have been a pretext only.

The use the Respondent subsequently made of the disputed domain name, offering to sell it to the Complainant for sums far in excess of the likely reasonable out-of-pocket costs of registering a domain name in the .com.au namespace, constitutes use in bad faith in circumstances where the Respondent has been found not to have rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has established all three requirements under the Policy.

6. Decision

For all 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, <kyndrylsolutions.com.au>, be transferred to the second-named Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: June 20, 2022