

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Domain Manager, Webviously, Inc.

Case No. DIO2022-0056

1. The Parties

The Complainant is International Business Machines Corporation, United States of America (“United States”), represented by IBM UK Limited, United Kingdom.

The Respondent is Domain Manager, Webviously, Inc., United States, represented by Hovland, Rasmus, Brendtro, and Trzynka, PLLC, United States.

2. The Domain Name and Registrar

The disputed domain name <notibm.io> (the “Domain Name”) 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 November 23, 2022. On November 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. That day, the Registrar sent an email to the Center confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 November 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response initially was December 20, 2022, however it was extended to January 3, 2023 as per paragraph 5(e) of the Rules, upon the request of Respondent. The Response was filed with the Center on January 4, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on January 13, 2023. 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

Complainant has been in existence for more than a century. Since 1924, Complainant has used the trademark IBM for a variety of machines, including punch machines, calculators, clocks, typewriters, mainframe computers, personal computers, laptops, computer hardware and software, and so forth. Complainant holds innumerable trademark registrations throughout the world (in 170 countries), including United States Patent and Trademark Office Reg. No. 640,606 (registered on January 29, 1957).

There is ample evidence in the record that IBM is one of the most valuable brands in the world, and that IBM is a famous trademark.

The Domain Name was registered on July 10, 2022. The Domain Name is redirected to a website at <ibm.thepc.io>. At that website, Respondent sells NFT (non-fungible token¹) stickers commemorating the IBM PC (personal computer), which computer had been in widespread use in the 1980s. Complainant alleges that the NFTs in this case “are virtual stickers created by the Respondent, purportedly to celebrate the 40th anniversary of the IBM PC 5150, without the consent of the Complainant”.

Respondent readily admits that it is aware of the IBM mark, but maintains that it is entitled to use IBM PC mark because that trademark has become generic (and hence no longer legally protected). Respondent asserts that it is the owner and creator of digital artwork that celebrates the 40th anniversary of the launch of the first personal computer, known broadly as the “IBM PC”.

The website bears a small-font line of text, stating as follows:

“© Copyright 2023 Webviously, Inc. and The IBM PC NET Experience, a Fan Art Project. Not affiliated with International Business Machines Corp., we’re just really huge fans.”

Respondent’s website liberally uses the IBM trademark, including its stylized version, and does not always attach “PC” to these IBM references. In other words, Respondent’s website uses the famous stylized or word mark IBM, unenhanced by a “PC” reference, several times on the site. Respondent’s NFT stickers are sold in packs at the website. For example, one offering, called the “three-finger salute pack”, is offered for sale at USD 256.

The Parties have been engaged in two prior disputes over IBM-formative domain names, namely, *International Business Machines Corporation v. Webviously, Inc.*, WIPO Case No. [DIO2022-0004](#) (“*Webviously I*”), and *International Business Machines Corporation v. Privacy service provided by Withheld for Privacy ehf / Webviously, Inc.*, WIPO Case No. [D2022-1717](#) (“*Webviously II*”). The main arguments asserted by Respondent in the present case were also made, and rejected, in *Webviously I* and *Webviously II*.

In *Webviously I*, decided on May 31, 2022 (prior to Respondent’s registration of the Domain Name here), the panel transferred the domain name <ibmpc.io> to Complainant. In *Webviously II*, decided on August 26, 2022, the panel transferred several domain names, including <ibmpc.art>, <ibmpc.club>, <ibmpc.co>, and <ibmpc.org>.

¹ According to Complainant, non-fungible tokens “are cryptographically unique tokens that are linked to digital (and sometimes physical) content, providing proof of ownership. They are recorded on a blockchain that is used to certify authenticity and ownership”.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent's pertinent arguments are reflected above in the "Factual Background" section or are summarized in context below in the "Discussion and Findings" section.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark IBM through longstanding and widespread registration and use demonstrated in the record.

Respondent spends a great deal of time arguing that IBM PC is not a trademark, since it allegedly became generic decades ago. The Panel need not address that assertion, given that Complainant owns the mark IBM and the Domain Name here includes the mark IBM, not IBM PC.

The Panel also concludes that the Domain Name is confusingly similar to the IBM mark. Under section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element".

Here, the Domain Name entirely incorporates the IBM trademark, which mark is clearly recognizable within the Domain Name, notwithstanding the additional word "not". See *Fenix International Limited v. Privacy Service Provided by Withheld for Privacy ehf / Julio Medina*, WIPO Case No. [D2022-0337](#) (finding <notyouronlyfan.com> to be confusingly similar to ONLY FANS mark).

Respondent argues that the *Fenix* decision is of limited value because the respondent in that case filed no response (and hence made no arguments to counter the complaint). This Panel disagrees with Respondent's argument, because the issue at stake here is the "confusing similarity" issue. The first element of the UDRP is generally viewed as a "standing" requirement with a fairly low threshold to clear. Once a complainant's rights in a trademark are established (and that issue can be contested in some instances), the "confusing similarity"

analysis is undertaken. As such, the fact that the respondent defaulter in *Fenix* does not help Respondent here. The panel in that case undertook a full “confusing similarity” analysis in that case, and it does not appear from the decision that the panelist was influenced by either party’s arguments.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

As noted above, two prior panels have concluded that Respondent had no legitimate interest in domain names containing the Second-Level Domain (“SLD”) “IBMPC”, regardless of the Top-Level Domain (“TLD”) at issue. These panels reached this conclusion, notwithstanding the fact that Respondent was arguing that it was entitled to use IBM PC because it had become generic and Respondent was making fair use of that (former) mark.

Here, Respondent is using the Domain Name <notibm.io>, which contains the IBM mark, not the IBM PC mark (generic or not). Respondent’s use of the Domain Name here – redirecting it to another site where Respondent sells its “digital artwork” – is essentially the same as it was in the two prior cases. If Respondent had no legitimate interest in domain names containing the disputed trademark IBM PC, then it is difficult to see how Respondent can be said to have a legitimate interest in this Domain Name, which includes the undisputed and famous mark IBM. Seemingly Respondent has here tried to “distance itself” from the prior decisions by adding the term “not” to the Domain Name; this is of course entirely pretextual and does not in the Panel’s view cut it.

As discussed above, the Domain Name redirects the user to Respondent’s website at <ibm.theipc.io>, where Respondent sells NFT stickers. The Panel pays no heed to the fact that the subdomain of this site is “IBM”, since that fact need not be considered in order to resolve this dispute under the UDRP. Nor does the Panel need to address the argument that IBM PC is generic, and hence no longer a protected trademark. This is because the Domain Name at issue contains the mark IBM, not IBM PC.

Put another way, Respondent is using the famous IBM trademark in the Domain Name (as the dominant element of the SLD), and is redirecting that Domain Name to a website (the name of which is irrelevant for these purposes) where Respondent sells digital merchandise.

Put still more succinctly, Respondent is trading off the fame of the IBM mark to enhance the sale of its products. This is not a *bona fide* offering of goods or services within the meaning of the UDRP, since Respondent is trading off the fame of another party’s mark – and not, *e.g.*, selling its products under its own name.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration or use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered or used the Domain Name in bad faith. The Panel incorporates its discussion above in the “Legitimate Interests” section.

It is undisputed that Respondent was aware of the famous IBM mark when he registered the Domain Name on July 10, 2022. As was discussed above, this case boils down to the fact that Respondent incorporated the famous mark IBM in the Domain Name, and then redirected the Domain Name to a website where Respondent sells its digital wares, and is engaging in a commercial use of it. That is a fairly straightforward description of bad faith registration and use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

In addition, the mere existence of the disclaimer on the webpage (mentioned in the “Factual Background” section) cannot cure such bad faith, considering the overall circumstances of this case.

The Panel takes note of Complainant’s alternative argument that Respondent is in bad faith as a serial cybersquatter under Policy paragraph 4(b)(ii).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name, <notibm.io>, be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: January 27, 2023