

## **ADMINISTRATIVE PANEL DECISION**

International Business Machines Corporation v. Annapurna Das / Xudong ZHAO

Case No. D2023-1537

### **1. The Parties**

The Complainant is International Business Machines Corporation, United States of America, represented internally.

The Respondent for the disputed domain name <locationibm.com> is Annapurna Das, India (hereinafter the "First Respondent").

The Respondent for the disputed domain name <ibmcobol.com> is Xudong ZHAO, France (hereinafter referred to as the "Second Respondent").

The First Respondent and the Second Respondent are collectively referred to as the "Respondent".

### **2. The Domain Names and Registrars**

The disputed domain names <ibmcobol.com> and <locationibm.com> (the "Domain Names") are registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 6, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On April 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed, as far as the First Respondent is concerned, from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 18, 2023 providing the registrant and contact information disclosed by the Registrar in relation to the First Respondent, and inviting the Complainant to submit an amendment to the Complaint. Due to an administrative oversight, the Center did not inform the Complainant of the name and contact information disclosed by the Registrar in relation to the Second Respondent. Therefore, the Complainant filed an amendment to the Complaint on April 25, 2023 citing only the First Respondent.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the First Respondent of the

Complaint, and the proceedings commenced on April 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2023. The First Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 19, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on May 25, 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.

On June 15, 2023, the Panel, noting that according to the Registrar verification, the disputed domain names were registered by different Registrants and that the Complaint had only been notified to the First Respondent, issued Administrative Panel Order No. 1, instructing the Center to notify the Complaint to the Second Respondent and inviting the Complainant to submit any further information it may wish regarding the Second Respondent and/or the consolidation of the two disputed domain names in a single proceeding. The Panel granted the Second Respondent a 20 calendar day term from the notification of the Complaint to submit its Response.

On July 4, 2023, the Second Respondent sent an email to the Center, which shortly explained the reasons behind the registration of the disputed domain name <ibmcobal.com>, and expressed its availability to cancel the disputed domain name <ibmcobal.com>, or transfer it to the Complainant.

#### **4. Factual Background**

The Complainant was incorporated in 1911 in the United States and officially adopted its current name in 1924. The Complainant has been offering products under the trademark IBM ever since. In the early days, these products included office and research equipment. In 1952, the Complainant introduced its first large vacuum tube computer under the name IBM 710, and since then has continuously used the trademark IBM in association with computers and computer hardware, software and accessories. In 1961, the Complainant introduced the IBM Selectric typewriter, which was extremely successful as it was a significant innovation in the business sector.

The Complainant owns IBM trademark registrations in 131 countries worldwide, for a wide range of goods and services. Among these trademarks are the following:

- IBM, United States registration No. 4181289, filed on December 21, 2010 and registered on July 31, 2012, for goods in classes 9, 16, 18, 20, 21, 22, 25 and 28, and services in classes 35 and 41;
- IBM, United States registration No. 3002164, filed on December 14, 1999 and registered on September 27, 2005, for goods in class 9, claiming a first use in commerce since July 31, 1992;
- IBM, United States registration No. 1696454, filed on August 30, 1990 and registered on June 23, 1992, for services in class 36, claiming a first use in commerce since March 1981;
- IBM, United States registration No. 1694814, filed on August 31, 1990 and registered on June 16, 1992, claiming a first use in commerce of February 1, 1989, for services in class 36;
- IBM, United States registration No. 1243930, filed on May 10, 1982 and registered on June 28, 1983, claiming a first use in commerce of February 2, 1982, for services in class 42;
- IBM, United States registration No. 1205090, filed on April 30, 1980 and registered on August 17, 1982, for goods in classes 1, 9 and 16, and services in classes 37 and 41, claiming a first use in commerce since 1971 and 1976;

- IBM, United States registration No. 1058803, filed on October 29, 1974 and registered on February 15, 1977, for goods in classes 1, 9, and 16, and services in classes 37, 41 and 42, claiming a first use in commerce since 1950;
- IBM, United States registration No. 640606, filed on March 12, 1956 and registered on January 29, 1957, for goods in class 9, claiming a first use in commerce since August 5, 1955.

The IBM trademark enjoys strong reputation as confirmed by the high rankings awarded by both Interbrand and Fortune, two of the world largest branding companies, and the high amount of yearly expenditures on product development and marketing.

The disputed domain name <locationibm.com> was registered on September 7, 2022, while the disputed domain name <ibmcobol.com> was registered on September 20, 2022. At the time of the filing of the Complaint, the disputed domain names resolved to an index webpage displaying a “cgi-bin” folder. Moreover, the disputed domain names had mail exchange (“MX”) records activated, and the IP address for the disputed domain name <locationibm.com> was linked to a botnet command and control server. The Complainant sent cease and desist letters to the Respondent through the Registrar of the disputed domain names, and several reminders. The Respondent only replied in relation to the disputed domain name <ibmcobol.com> stating that it was willing to transfer it to the Complainant but was not able to proceed. The Complainant sent follow-up communications to the Respondent but the Respondent never finalized the transfer of the disputed domain name <ibmcobol.com> to the Complainant.

## **5. Parties’ Contentions**

### **A. Complainant**

#### **1. Request for Consolidation**

The Complainant requests that the consolidation of the two disputed domain names in a single proceeding as the disputed domain names are subject to a common control. In particular, the Complainant stresses the fact that the disputed domain names were both registered in September 2022, through the same Registrar and have a similar name server history. Moreover, the disputed domain names share a similar naming pattern as they both contain the Complainant’s mark IBM coupled with an additional term (“location” and “cobol”, respectively). The two disputed domain names share a similar content, including general design/layout that displays folder and privacy warnings. Furthermore, the Respondent has used the same online privacy protection company to disclose its identity. Lastly, the Respondent has configured mail exchange (MX) records for both the disputed domain names.

#### **2. Merits**

The Complainant maintains that the disputed domain names are confusingly similar to the Complainant’s IBM mark as they fully include this mark with the addition of the terms “location” and “cobol”. These variations to the Complainant’s mark do not obviate the confusing similarity between the disputed domain names and the IBM mark.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain names.

The Complainant did not license, contract, or otherwise permit anyone to apply to register the disputed domain names. The disputed domain names consist of the well-known trademark IBM coupled with a descriptive term, which is either “location” or “cobol”. The latter is a term generally recognizable as a compiler program to improve application performance. The Complainant also offers an IBM cobol program for compiler application. Therefore, the Respondent’s unauthorized use of the IBM trademark is likely to

cause consumers into erroneously believe that the Complainant is affiliated with the Respondent or endorses its activities.

Furthermore, there is no evidence that “ibm” is the name of the Respondent, or evidence of fair use of the disputed domain names, or use in connection with a *bona fide* offering of goods or services. The Respondent has configured an email server on the disputed domain names and linked the IP address of the disputed domain name <locationibm.com> to botnet command and control servers. A “botnet” is a network of compromised computers infected by a program that communicates with its command-and-control infrastructure in order to attack websites, send unsolicited emails, etc. These botnets are often used to gather sensitive information from the infected hosts, such as financial data.

Lastly, the Complainant maintains that the disputed domain names were registered and have been used in bad faith.

The registration of a domain name that is identical or confusingly similar to a famous or widely known trademark creates by itself a presumption of bad faith. The IBM trademark enjoys substantial reputation worldwide. The Respondent registered the disputed domain names at least 65 years after the Complainant established registered trademark rights in the IBM mark. Internet search engines using the keyword “IBM” show that this trademark is exclusively associated with the Complainant. Additionally, Internet search engines on the keyword “ibm cobol” lead to the Complainant’s website. Therefore, the Respondent knew or should have known the Complainant’s IBM mark when it registered the disputed domain names.

In consideration of the high reputation of the IBM mark, no plausible good faith use of the disputed domain names is possible. The Respondent is likely to retain a commercial gain from high Internet user traffic. Accordingly, by using the IBM mark in the disputed domain names, the Respondent has intentionally attempted to attract for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of its websites.

Furthermore, the registration of a domain name that is confusingly similar to a trademark by an entity that has no relation with that mark, may be sufficient evidence of opportunistic bad faith.

The Respondent set up MX records for the disputed domain names. This indicates the Respondent’s intention to potentially use the disputed domain names for purposes other than hosting a website, including, potentially, for constructing an email composition containing the Complainant’s IBM mark.

The disputed domain name <locationibm.com> is associated with an IP address linked to botnet command and control servers. The dissemination of botnets through a domain name that is confusingly similar to a complainant’s trademark has often the purpose of stealing consumer information for commercial gain, which amounts to bad faith.

Before filing the Complaint, the Complainant sent cease and desist letters to the Respondent and subsequent reminders. The Respondent replied in relation to the disputed domain name <ibmcobol.com> stating that it was willing to transfer this disputed domain name, but was unable to proceed in the absence of the Registrar’s collaboration. The Complainant informed the Respondent on what was needed to finalize the transfer, but received no further communications from the Respondent.

Additional evidence of bad faith lies in the fact that the Respondent registered the disputed domain names through a privacy shield service in order to conceal its identity.

## **B. Respondent**

The First Respondent did not reply to the Complainant’s contentions in relation to the disputed domain name <locationibm.com>. On the contrary, upon receiving a copy of the Complaint, the Second Respondent sent an email to the Center reading as follows: *“Hello, I am Xudong ZHAO, and I have purchased the domain name ibmcobol.com. I am a programming enthusiast, and I bought this domain solely for my hobby. I have*

*never written anything on it.*

*I am willing to cancel this domain or transfer it to IBM. However, I have opened several tickets with Namecheap, my domain service provider, but they have not replied to my requests.*

*Please help me resolve this issue. Could you please contact Namecheap on my behalf to cancel this domain?*

*Thank you.*

*Best regards,*

*Xudong ZHAO."*

## **6. Discussion and Findings**

### **A. Procedural Issue - Consolidation of multiple Respondents**

According to Paragraph 10(e) of the Rules a "[p]anel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules". Paragraph 10(c) of the Rules provides that "the [p]anel shall ensure that the administrative proceeding takes place with due expedition".

According to section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where a complaint is filed against multiple respondents, panels shall consider whether the domain names or corresponding websites are subject to common control, and whether the consolidation would be fair and equitable to all parties.

In evaluating whether the disputed domain names are subject to a common control, the Panel took in consideration all such circumstances mentioned in the Complaint, namely that:

- (i) the disputed domain names were both registered in September 2022, within a short span of time;
- (ii) the Registrar and the servers of the disputed domain names are the same;
- (iii) the disputed domain names share a similar naming pattern;
- (iv) MX records were configured for both disputed domain names;
- (v) the disputed domain names have a similar content, including general design/layout that displays a cgi-bin folder;
- (vi) the Respondent has used the same online privacy protection company to disclose its identity for both disputed domain names.

In the absence of any contrary statement from the Respondent, and considering all circumstances listed above, the Panel finds that it is more likely than not, that the disputed domain names are subject to a common control. Moreover, the Panel is of the view that the consolidation of multiple domain name disputes in a single proceeding would be fair and equitable to all parties in this case.

### **B. Identical or Confusingly Similar**

The Panel is of the opinion that the disputed domain names are confusingly similar to the Complainant's trademark. The Complainant has shown that it owns rights over the IBM registered trademark, which date back many years before the date of registration of the disputed domain names. The Complainant's trademark is fully recognizable within the disputed domain names. As to the addition of the words "cobol" and "location" in the disputed domain names, in accordance with the [WIPO Overview 3.0](#), the Panel finds that "[w]here 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".

Therefore, the Panel is satisfied that the first condition under the Policy is met.

### C. Rights or Legitimate Interests

While the overall burden of proof rests with the complainant, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge 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 shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Complainant states that the Respondent is not a licensee of the Complainant and that it does not have any contractual relationship with the Respondent. The Complainant never consented to the use of its IBM trademark in the disputed domain names. Furthermore, there is no evidence in the file that the Respondent is commonly known by the names “locationibm” and “ibmcobol”.

The Respondent has not shown that before any notice of the dispute, it has used or made demonstrable preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the IBM trademark. The mere composition of the disputed domain names, consisting of the well-known trademark IBM plus a generic term such as “location”, or the term “cobol” that is directly linked to the Complainant’s activity cannot constitute fair use. Indeed, through the disputed domain names, the Respondent effectively impersonates the Complainant, or suggests sponsorship or endorsement by the Complainant (see in this respect, section 2.5.1 of the [WIPO Overview 3.0](#)).

Furthermore, at the time of the filing of the Complaint, the disputed domain names resolved to an index webpage displaying a cgi-bin folder. No further content was available. In addition, the disputed domain name <locationibm.com> was associated with an IP address linked to a botnet command and control servers, which is often used to attack websites, send unsolicited emails, and in relation to other infringing activities. Moreover, MX records were set up for the disputed domain names. Such use of the disputed domain names does not amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use.

In light of the foregoing, the Panel concludes that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent could have come forward with convincing arguments and evidence demonstrating that it owns rights or legitimate interests in the disputed domain names but was unable to do so. As a matter of fact, while in respect of the disputed domain name <locationibm> the Respondent did not file a Response, it did so in relation to the disputed domain name <ibmcobol.com>. However, the fact that the Respondent bought the disputed domain name for its hobby (being a “programming enthusiast”) is a mere unconvincing self-statement. Indeed, this statement is not supported by adequate evidence, which in any case the Panel would have had to carefully evaluate before concluding that it could support a finding of the Respondent’s rights or legitimate interests in the disputed domain name <ibmcobol.com>. Furthermore, the fact that the Respondent “never wrote anything” on the disputed domain name <ibmcobol.com>, cannot confer rights or legitimate interests to the Respondent on this disputed domain name. As mentioned above, the IBM trademark enjoys substantial reputation and MX records were configured for this disputed domain name. Moreover, the disputed domain name <ibmcobol.com> is associated with an IP address linked to botnet command and control servers, which is often used for fraudulent activities. Lastly, the fact that the Respondent is struggling to transfer the disputed domain name <ibmcobol.com> to the Respondent is not convincing, for the reasons mentioned below.

Consequently, the Panel is satisfied that the Complainant has met the second condition under the Policy.

#### **D. Registered and Used in Bad Faith**

The Complainant has duly substantiated and proved that its IBM trademark enjoys substantial reputation and is exclusively associated with the Complainant. The disputed domain names include the Complainant's trademark coupled with a word, which is either generic ("location") or is linked to the Complainant's activity ("cobol"). It is therefore clear that, at the time of the registration of the disputed domain names, the Respondent was aware, or ought to have been aware of the Complainant and of its well-known IBM mark. The registration of a domain name confusingly similar to a third party's well-known trademark without rights or legitimate interests amounts to registration in bad faith.

As far as use is concerned, the Complainant has shown that at the time of the filing of the Complaint, the disputed domain names resolved to an index webpage displaying a cgi-bin folder. In addition, the disputed domain names had their MX records configured and the IP address of the disputed domain name <locationibm.com> was associated to botnet command and control servers, which consent the dissemination of malware or other fraudulent activity. In light of the strong reputation of the Complainant's IBM trademark, and the Respondent's lack of rights or legitimate interests in the disputed domain names, the Panel finds that no plausible good faith use of the disputed domain names by the Respondent is possible, and that the Respondent is using the disputed domain names to take undue advantage from the reputation of the Complainant and of its IBM mark for commercial gain, or in connection with some fraudulent scheme.

With regard to the Response sent for the disputed domain name <ibmcobol.com>, that the Respondent is available to transfer the disputed domain name to the Complainant, but is not able to do so for a lack of cooperation of the Registrar, the Panel notes that this is the same answer that the Respondent already provided when it received the cease and desist letter from the Complainant before the beginning of this UDRP proceeding. Thus, in the Panel's opinion, there is no real intention of the Respondent to cooperate with the Complainant in this dispute. Instead, the Respondent is simply trying to take time to postpone the settlement of the dispute to the maximum possible extent.

Lastly, further evidence of bad faith lies in the fact that the Respondent took deliberate steps to conceal its identity behind a privacy protection shield.

Therefore, the Panel is satisfied that also the third and last condition under the Policy is met.

#### **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 Names, <ibmcobol.com> and <locationibm.com> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: July 13, 2023