

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Robert Bell, Pacific
Development Foundation
Case No. D2023-1710

1. The Parties

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

The Respondent is Robert Bell, Pacific Development Foundation, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names <ibm-world-wire.com> and <worldwire-ibm.com> are registered with Wild West Domains, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 18, 2023. On April 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 19, 2023, 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 / Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 2023 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 on April 24, 2023.

On April 25, 2023, the Center received an email communication from the Respondent stating that the disputed domain names were part of an IBM program starting in 2017 and that "I'm happy to cancel or surrender or whatever". Following this email communication, the Complainant requested a 30-day suspension of the proceedings on April 27, 2023. The Center granted a suspension on April 27, 2023 with a deadline of May 27, 2023. On May 8, 2023, the Center received another email communication from the Respondent indicating that he would transfer the disputed domain name to the Complainant, and would get it sorted in the same week. On May 23, 2023, the Center received another email communication from the Respondent seeking information about transfer. On May 27, 2023, the Complainant requested a 10-day extension of the suspension. On May 30, 2023, the Center granted the 10-day extension and provided a

new deadline of June 6, 2023. On June 16, 2023, the Complainant requested the reinstatement of the proceeding. On June 19, 2023, the Center reinstituted the proceeding.

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 of the Complaint, and the proceedings commenced on June 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2023. On June 20, 2023, the Respondent sent an email communication indicating that he thought the issue was resolved, and he did not expect any further responses required from him. The Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on July 11, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on July 17, 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

Incorporated in 1911 as amalgamation of three previously existing companies and officially becoming International Business Machines (“IBM”) in 1924, the Complainant is one of the leading manufacturers of computers, computer software and related goods and provider of related services throughout the world.

In 2022, the Complainant was ranked the 18th most valuable global brand by BrandZ, the 18th best global brand by Interbrand, the 49th largest company on the Fortune U.S. 500 list and the 168th largest company on the Fortune Global 500 list.

The Complainant owns numerous trademark registrations for IBM in over 100 countries of the world, including the United States Trademark Registration No. 1058803, registered since February 15, 1977 for, among others, data processing devices and systems, computer software and accessories.

The Complainant among others owns the domain name <ibm.com>, which was registered on March 19, 1986 and resolves to its corporate website.

The disputed domain names were registered on October 15, 2021, and have been used to redirect Internet users to a website owned by the Complainant, which displays an article dated October 18, 2017 from the Complainant’s newsroom webpage.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain names, which incorporate its IBM trademark, are confusingly similar to it because the addition of the terms “world” and “wire” to the trademark, separated by hyphens in the disputed domain names does not prevent a finding of confusing similarity.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain names and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant contends that the Respondent has registered and is using the disputed domain names in bad faith. The Respondent has been redirecting the disputed domain names to a webpage owned by the Complainant in order to attract Internet users and generate traffic to its network.

The Complainant requests that the disputed domain names be transferred from the Respondent to the Complainant.

B. Respondent

As set out above, the Respondent sent email communications to the Center stating its willingness to settle with the Complainant. The proceedings were suspended for the Parties to seek resolution, but as the Respondent never signed the Standard Settlement Form, the proceedings were reinstituted.

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

6. Discussion and Findings

6.1 Preliminary Matter – Multiple Domain Names

The Panel notes that paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. Since the disputed domain names were registered by the same Respondent, the Panel finds that this requirement is fulfilled.

6.2 Substantive Matters – Three Elements

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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 complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

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

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain names are identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the IBM trademark and for the purpose of this proceeding the Panel establishes that the Complainant's trademark registrations mentioned above satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain names are identical or confusingly similar to the Complainant's trademark. According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name.

The Complainant's IBM trademark is clearly recognizable in the disputed domain names.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the 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.

The Panel finds that the addition of the terms "world" and "wire" to the Complainant's IBM trademark, separated by hyphens in the disputed domain names does not prevent a finding of confusing similarity.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Panel finds that the disputed domain names are therefore confusingly similar to the Complainant's trademark and that the first ground of the Policy is established.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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 the relevant evidence demonstrating its rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in the IBM trademark.

The Complainant has never authorized the Respondent to use its trademark, in a domain name, or otherwise.

There is no evidence that the Respondent is commonly known by the disputed domain name.

The Respondent has been using the disputed domain names to redirect Internet users to a website owned by the Complainant, which displays an article from the Complainant's newsroom webpage. Use of a complainant's mark to redirect users to the complainant's website cannot confer rights or legitimate interests on a respondent (see section 2.5.3 of the [WIPO Overview 3.0](#)).

The Respondent failed to respond to the Complainant's contentions, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter to the Complainant's *prima facie* case and the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names in accordance with paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

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

It has been well established in prior decisions under the UDRP, with which the Panel agrees, that the Complainant's IBM trademark is globally well known (see, *e.g.*, *International Business Machines Corporation v. Timothy Hayden-Clark, Accountable Sourcing*, WIPO Case No. [D2017-1283](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP "panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith".

The Respondent's replication of the Complainant's well-known trademark in the disputed domain names and the Respondent's redirection of the disputed domain names to a website owned by the Complainant convinces the Panel that the Respondent clearly had the trademark in mind at the time of registration and that he registered the disputed domain names in order to target the Complainant and its trademark.

Further, in light of section 3.1.4 of the [WIPO Overview 3.0](#), the Respondent's redirection of the disputed domain names to the Complainant's website is evidence that the Respondent has registered the disputed domain names to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark within the meaning of paragraph 4(b)(iv) of the Policy.

Last but not least, despite his initial intention to transfer the disputed domain names to the Complainant, the Respondent has repeatedly failed to sign the Standard Settlement Form and has continued to redirect the disputed domain names consisting of the Complainant's well-known IBM trademark to the Complainant's

website even after being notified of the Complaint and the respective proceeding. The Panel regards these facts as the Respondent's attempts to prolong and frustrate the proceeding and as a further evidence of the Respondent's bad faith.

Considering the above, the Panel finds that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) 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 <ibm-world-wire.com> and <worldwire-ibm.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: July 31, 2023