

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. Shanmugam M Case No. D2022-0900

1. The Parties

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

The Respondent is Shanmugam M, India.

2. The Domain Name and Registrar

The disputed domain name <ibmindia.org> (the “Disputed 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 March 15, 2022. On March 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 17, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 18, 2022, 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 March 25, 2022.

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 March 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 19, 2022.

The Center appointed Mariya Koval as the sole panelist in this matter on April 26, 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 Complainant is an American multinational technology corporation with operations in over 171 countries. The company began in 1911 and was renamed “International Business Machines” (“IBM”) in 1924. The Complainant produces and sells computer hardware, middleware, and software, and provides hosting and consulting services in areas ranging from mainframe computers to nanotechnology. In addition to its expenditures on product development, the Complainant spent more than USD 6 billion on advanced research in 2020 and 2021. Moreover, the Complainant spends over USD 1 billion annually marketing its goods and services globally, using the IBM trademark (the “IBM Trademark”), and has undertaken extensive efforts to protect its name and enforce its Trademark. In 2021, the Complainant was ranked the 15th most valuable global brand by BrandZ, the 18th best global brand by Interbrand, the 42nd largest company on the Fortune U.S. 500 list, and the 121st largest company on the Fortune Global 500 list.

The Complainant is the owner of a large IBM Trademark registrations portfolio throughout the world, among which are:

- United States Trademark Registration No. 640,606 registered on January 29, 1957, in respect of goods in class 9;
- United States Trademark Registration No. 1,243,930 registered on June 28, 1983, in respect of services in class 42;
- United States Trademark Registration No. 1,696,454 registered on June 23, 1992, in respect of services in class 36;
- United States Trademark Registration No. 3,002,164 registered on September 27, 2005, in respect of goods in class 9;
- United States Trademark Registration No. 4,181,289 registered on July 31, 2012, in respect of goods and services in classes 6, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 30, 35, and 41.

The Complainant has a significant online presence, it operates different domain names reflecting its IBM Trademark for sale and promotion of its goods and services, *inter alia*: <ibm.com> (registered on March 19, 1986), <ibmindia.com> (registered on December 7, 2003), <ibm.us> (registered on April 19, 2002), <ibm.net> (registered on August 12, 1994), and others.

The Disputed Domain Name was registered on December 21, 2021. At the date of this Decision, the Disputed Domain Name redirects to the Complainant’s official website, to a mail server responsible for sending and accepting email messages on behalf of the Disputed Domain Name. According to the evidence presented by the Complainant (Annexes 14 and 15) the IP addresses associated with the Disputed Domain Name are linked to dissemination of malware and botnet command and control servers.

On January 5, 2022, the Complainant sent a cease and desist letter to the Respondent, asking Respondent to disable and transfer the Disputed Domain Name back to the Complainant. The Complainant also sent a follow up letter to the Respondent on January 28, 2022. The Respondent did not reply to the Complainant’s cease and desist letter.

5. Parties’ Contentions

A. Complainant

The Complainant contends that its IBM Trademark is a world-famous trademark. Tracing its roots to the 1880s, the Complainant is and has been 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 IBM Trademark was valued by BrandZ as worth over USD 91 billion in 2021, USD 83 billion in 2020, and USD 86 billion in 2019. As a result of the high quality of goods and services the Complainant has provided to its customers for over 100 years, and its reputation as one of the premier manufacturers of computer and computer related goods and services throughout the world, the Complainant's company name and the IBM Trademark are famous and valuable assets.

The Complainant claims that the Disputed Domain Name is confusingly similar to its IBM Trademark in view of the fact that the Disputed Domain Name contains the IBM Trademark in its entirety followed by the geographical term "india," and the generic Top-Level Domain ("gTLD") ".org". The presence of term "india" in the Disputed Domain Name does not obviate the confusing similarity between the Disputed Domain Name and the IBM Trademark.

The Complainant further asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following:

- the Complainant has never licensed, contracted, or otherwise permitted anyone to apply to register the Disputed Domain Name;
- there is no evidence that the Respondent is using the Disputed Domain Name incorporating the IBM Trademark for a *bona fide* offering of goods or services. On the contrary, the Respondent has configured an email server on the Disputed Domain Name;
- the Respondent's use of the IBM Trademark is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while in fact, no such relationship exists;
- the Respondent has not been commonly known by the Disputed Domain Name;
- the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name.

The Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith since the Disputed Domain Name is confusingly similar to the Complainant's IBM Trademark and the Respondent has no relationship to the Complainant or the Trademark. The Complainant has a longstanding history of conducting business in India and owns the domain name <ibmindia.com> which redirects to the Complainant's official website under the domain name <ibm.com>. The only difference between the Complainant's domain name <ibmindia.com> and the Disputed Domain Name is in the gTLD: the Complainant's being ".com" and the Disputed Domain Name's being ".org".

The Respondent was well aware of the Complainant's Trademark at the time when the Respondent registered the Disputed Domain Name since the Complainant's IBM Trademark is well-known around the world due to the extensive range of the IBM Trademark registrations. The Respondent registered the Disputed Domain Name at least 64 years after the Complainant established registered rights in the IBM Trademark.

The Disputed Domain Name currently redirects to the Complainant's website, to a mail server responsible for sending and accepting email messages on behalf of the Disputed Domain Name. This creates a real or implied ongoing threat to the Complainant. The Whois records indicate that the Disputed Domain Name is associated with IP addresses which are linked to dissemination of malware and botnet command and control servers. The consequence of such illegitimate activities can be detrimental not only to the Complainant, but to third parties who may entrust what appears to be the Complainant with sensitive information.

The Respondent was undoubtedly familiar with the Complainant's world-famous IBM Trademark at the time of registering the Disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, in order for the complainant to succeed it must satisfy the panel that:

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

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the IBM Trademark due to the long use and number of registrations globally. The Panel notes that the registration of the Complainant's Trademark significantly predates the registration of the Disputed Domain Name. The Panel finds that the Complainant has established that the IBM Trademark is well-recognized and world-famous.

The Disputed Domain Name completely reproduces the Complainant's IBM Trademark in combination with the geographical term "india" and the gTLD ".org". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, 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. In this case, the addition of the geographical term "india" to the IBM Trademark does not prevent a finding of confusing similarity.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant contends that the Respondent has no relationship with or permission from the Complainant to use the IBM Trademark, the Respondent has neither been commonly known by the Disputed Domain Name.

According to section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is always on the Complainant, once the Complainant makes out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, the burden of production of evidence shifts to the Respondent.

The Panel finds that the Complainant has made a *prima facie* case. The Respondent registered the Disputed Domain Name more than sixty years after the IBM Trademark had been registered. The Complainant's Trademark is well-known throughout the world.

The Complainant submits that the Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. Namely,

according to the evidence presented by the Complainant (Annexes 9, 14, and 15 to the Complaint) the Respondent is using the Disputed Domain Name to redirect to the Complainant's official website, to a mail server responsible for sending and accepting email messages on behalf of the Disputed Domain Name. Moreover, IP addresses associated with the Disputed Domain Name are linked to dissemination of malware and botnet command and control servers. Such use of the Disputed Domain Name cannot obviously be considered as *bona fide* offering of goods or services, or a legitimate noncommercial or fair use. In accordance with section 2.13.1 of the [WIPO Overview 3.0](#) panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

The Panel also considers it is more than likely that the Respondent was well aware of the Complainant's IBM Trademark when registering the Disputed Domain Name, taking into account the long use and reputation of the Complainant's Trademark.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Therefore, the addition of the geographical term "india", which is the name of country where the Complainant has a longstanding history of conducting business, to the Complainant's Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant's Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant's Trademark.

The Respondent did not respond neither to the Complainant's cease and desist letter nor to the Complaint and did not participate in this proceeding, accordingly, the Respondent has failed to present any evidence to support any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Taking into consideration that the IBM Trademark has been in use more than 60 years and that the Complainant has spent huge amounts and efforts for promotion of its Trademark, which is undoubtedly globally known, the Panel considers it is clear that the Respondent was well aware of the Complainant and its Trademark at the time of registration of the Disputed Domain Name. Moreover, the Disputed Domain Name, incorporating the Complainant's IBM Trademark in its entirety, is clearly deceptive for the Internet users with respect to the person producing the goods and rendering the services.

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety that creates a strong likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name.

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 Panel is of opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the well-known Complainant's Trademark, primarily intended to disrupt the Complainant's business. In view of the absence of any evidence to the contrary and that the Respondent did not file any statement, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Panel also concludes that addition of the geographical term “india” to the IBM Trademark does not change an impression of strong association of the Disputed Domain Name with the Complainant’s Trademark, but on the contrary, taking into consideration that the Complainant has a longstanding history of conducting business in India, even strengthens such association. Previous UDRP panels have concluded that in appropriate circumstances, bad faith is established where the Complainant’s trademark has been well-known or in wide use at the time of registering a domain name, see, e.g., *Chanel, Inc. v. EstcoEnterprises Ltd., Estco Technology Group*, WIPO Case No. [D2000-0413](#).

In accordance with the [WIPO Overview 3.0](#), section 3.4. UDRP panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution (in some such cases, the respondent may host a copycat version of the complainant’s website). The Panel finds that the Disputed Domain Name redirects to the Complainant’s official website and that the Respondent is likely using the Disputed Domain Name for fraudulent scheme, namely IP addresses, associated with the Disputed Domain Name, are linked to dissemination of malware and botnet command and control servers. Such Respondent’s behavior cannot be in any way considered as good faith.

Furthermore, the Respondent did not respond to the Complainant’s cease and desist letter in which the Complainant requested to transfer the Disputed Domain Name, accordingly the Respondent ignored the Complainant’s attempts to settle this dispute without initiation of this proceeding. Such Respondent behavior also supports the Panel’s finding that the Respondent has registered and is using the Disputed Domain Name in bad faith. Previous UDRP panels have considered that a respondent’s failure to respond to the complaint supports an inference of bad faith, see e.g., *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show the good faith registration and use of the Disputed Domain Name.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being used in bad faith.

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 <ibmindia.org> be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: May 10, 2022