

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Privacy service provided by Withheld for Privacy ehf / Webviously, Inc.

Case No. D2022-1717

1. The Parties

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Webviously, Inc., United States, represented by Hovland, Rasmus, Brendtro, and Trzynka, PLLC, United States.

2. The Domain Names and Registrar

The disputed domain names <ibmpc.art>, <ibmpc.cloud>, <ibmpc.club>, <ibmpc.co>, <ibmpc.online>, and <ibmpc.org> (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 May 11, 2022. On May 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On May 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 16, 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 the same day.

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 May 23, 2022. In accordance with the Rules, paragraph 5, and extensions of time requested by the Respondent, the due date for Response was July 14, 2022. The Response was filed with the Center on July 14, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on August 10, 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 a corporation organized under the law of the State of New York, United States, and headquartered in that state. It is a publicly traded technology company listed on the New York Stock Exchange with the stock symbol "IBM". Established in 1911, the Complainant has done business under its current name since 1924 and has grown to become one of the largest technology companies in the world, with over 282,000 employees and operations in more than 170 countries.

The Complainant reports that it spends more than USD one billion annually advertising under the IBM mark. The brand also receives considerable media attention beyond the Complainant's advertising efforts. As noted in the Wikipedia article on the Complainant, the Complainant's researchers have garnered five Nobel Prizes, six Turing Awards, ten National Medals of Technology, and five National Medals of Science. The Complainant is also a sponsor of the Olympic Games and several professional sports events. The IBM mark has been ranked among the most valuable brands in the world by Interbrand, BrandZ, and Forbes. The Complainant operates many websites with domain names incorporating the IBM mark, including a principal website at "www.ibm.com".

The Complainant holds numerous IBM trademark registrations, including the following registered by the United States Patent and Trademark Office ("USPTO"):

MARK	REGISTRATION NUMBER	REGISTRATION DATE
IBM (standard characters)	640606	January 29, 1957
IBM (standard characters)	1058803	February 15, 1977
IBM (standard characters)	1243930	June 28, 1983
IBM (standard characters)	1694814	June 16, 1992

The Domain Names were all registered in the name of a domain privacy service on the same date, February 22, 2022. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as "Domain Manager" with an email address in the <webviciously.net> domain and a postal address in Sioux Falls, South Dakota, United States. Webviciously, Inc. ("Webviciously") is a South Dakota corporation that offers website development and mobile application services, according to its website. Webviciously filed the Response in this proceeding and is referred to hereafter as the "Respondent".

Screenshots attached to the Complaint, and a search for archived screenshots using the Internet Archive's Wayback Machine, show that the Domain Names have not been used to date for websites developed by the Respondent. Instead, they have been parked by the Registrar at landing pages that display pay-per-click ("PPC") advertising links to third-parties, chiefly those offering technology goods and services.

The Complainant sent cease-and-desist letters concerning each of the Domain Names to the address listed on the Registrar's Whois database in February and March 2022, with no reply from the Respondent. The Respondent states that it never received these communications.

At the time of this Decision, the Domain Names do not resolve to active websites but instead produce error messages.

The Respondent states that it registered the Domain Names for use in connection with its creation and sale of digital artwork in the form of non-fungible tokens (NFTs)¹ representing the IBM PC, "celebrating the 40th anniversary of the launch of the first personal computer". The Respondent points to the digital collector-art project called "The IBM PC NFT Experience," found at "<https://ibm.theipc.io>" and "<https://nftbackers.io/explorer/collection/earlyibmfans>". The first of these sites (the "Respondent's IBM PC NFT Experience site") is evidently operated by the Respondent, as it displays the following copyright notice and disclaimer:

"© Copyright 2022 Webviciously Inc. and The IBM PC NFT Experience, a Fan-Art Project | Not affiliated with International Business Machines Corp., we're just really huge fans."

The second site does not identify the site operator but is a portal for a large number of NFT collections, including the Respondent's collection entitled "The IBM PC NFT Experience". It links to the Respondent's IBM PC NFT Experience site, which in turn links to four social media sites that are also evidently operated by the Respondent to promote the same NFT collection, with posts dating from May 2021.

The Response cites a Digital Journal article published in August 2021, "What Goes Around Comes Around: Storied IBM PC Will Be NFT", found online at <https://www.digitaljournal.com/pr/what-goes-around-comes-around-storied-ibm-pc-will-be-nft>. The article identifies Stephen Brendtro of Webviciously, Inc. as the creator and principal artist of the IBM PC NFT Experience, reporting that he previously launched "an asset-backed cryptocurrency business".

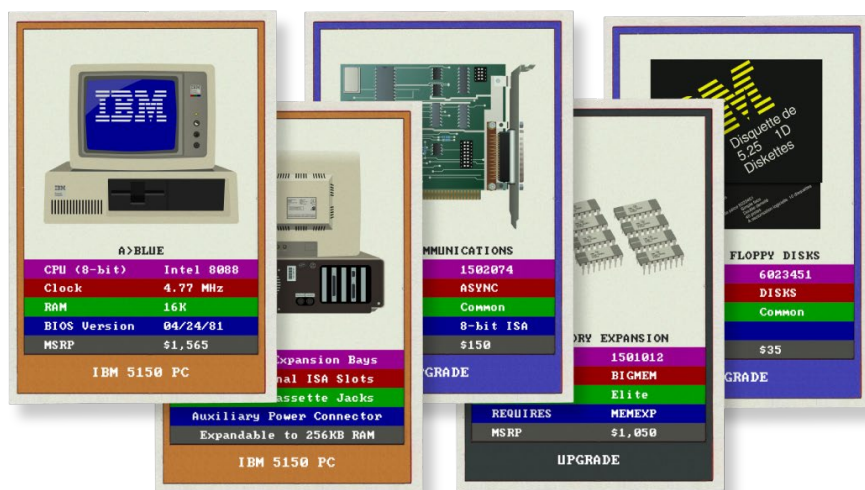
The introduction to the Respondent's collection at "<https://nftbackers.io/explorer/collection/earlyibmfans>" explains the motive and appeal of the NFT collection as follows:

"Forty years ago, on August 12, 1981, IBM released one of the all-time greats in personal computing: the 5150 personal computer. With an Intel 8088 processor clocked at 16MHz, and 16KB of RAM standard, and a 16-color graphics card, for the first time, users could experience raw computing power in the comfort of their own home. The price was right at \$1565, making the 5150 IBM's most affordable computer at the time, albeit without an included disk drive!

The limited-edition, 40th Anniversary IBM 5150 NFT Experience celebrates the venerable IBM 5150 personal computer in all its glory. The collection features the 5150 computer, the color palette, and upgrades available for this timeless personal computer that helped jump-start the personal computing era 40 years ago. You can own a collectible NFT version of this technological wonder that became the ubiquitous PC."

The Respondent's IBM PC NFTs are available in various sets of limited-edition "cards" and packs, as well as in posters and stickers. At the time of this Decision, the collection consists of more than 130 templates and almost 10,000 items. Nearly all of them display the Complainant's IBM mark in one form or another, as in the following examples:

¹ A non-fungible token (NFT) is "a financial security consisting of digital data stored in a blockchain, a form of distributed ledger. The ownership of an NFT is recorded in the blockchain, and can be transferred by the owner, allowing NFTs to be sold and traded." (Wikipedia, "Non-fungible token".)



The Respondent's artwork is accompanied by a disclaimer of affiliation with the Complainant.

The Panel notes that the Respondent also registered another, similar domain name, <ibmpc.io>, in May 2021, at the time it was preparing to launch sales of IBM PC NFTs. This domain name was the subject of a previous [UDRP-based] dispute resolution proceeding, *International Business Machines Corporation v. Domain Manager, Webviously Inc*, WIPO Case No. [DIO2022-0004](#) ("*Webviously I*"), which was decided by a three-person panel shortly after the Complaint was filed in the current proceeding. Neither party in the current proceeding specifically mentions this decision. The Complaint in the current proceeding states, possibly by mistake, that the Respondent redirected <ibmpc.io> from PPC advertising to an inactive website after receiving a demand from the Complainant in March 2022. However, according to the decision in *Webviously I*, the domain name <ibmpc.io> was linked to a website selling the Respondent's IBM PC NFTs, with a disclaimer of affiliation with IBM exactly in the form found on the Respondent's IBM PC NFT Experience website described above. *Webviously I* resulted in an order to transfer the domain name <ibmpc.io> to the Complainant, and that domain name now redirects to a web page at "www.ibm.com".

On June 16, 2022, shortly after the publication of the *Webviously I* decision, the Respondent filed a civil complaint in federal court, *Webviously, Inc. v. International Business Machines Corporation*, as discussed further below.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Names are confusingly similar to its IBM mark, incorporating the mark in its entirety and adding the letters "pc", the generally recognizable abbreviation for "personal computer".

The Complainant states that it has not licensed the use of the IBM mark for these Domain Names and contends that there is no evidence that the Respondent is known by a corresponding name or is making a *bona fide* commercial use or noncommercial fair use of the Domain Names. Instead, "the Respondent has been intentionally attempting to create a likelihood of confusion by pointing the Disputed Domain Names to pay-per-click pages with advertisement links containing references to technology-related products and services." The Complainant argues that this does not represent a legitimate interest and reflects bad faith in the registration and use of the Domain Names, as the IBM mark is well-known throughout the world. The Complainant infers bad faith from the misdirection of Internet users to other sites for commercial gain through PPC advertising and also from the Respondent's efforts to obscure its identity and its failure to reply to correspondence concerning trademark infringement claims and to this UDRP proceeding.

In addition, the Complainant cites the “passive holding” doctrine as outlined in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 3.3. The Complainant argues that the IBM mark is so distinctive and well-known that there is no plausible reason for the Respondent to register and hold the multiple Domain Names other than for bad-faith exploitation of the Complainant’s mark.

B. Respondent

The Respondent accepts that the Complainant holds “dozens” of IBM trademarks but argues that “the phrase IBM PC reached ‘generic’ status in the 1980’s”, as PCs were cloned by competitors with the same Microsoft operating system and off-the-shelf components used for the IBM PC. As a consequence, the phrase “IBM PC” was never trademarked. The Respondent mentions that the Complainant applied for United States trademark registration of “IBM PC” as a word mark (Serial Number 74520581) in 1994 but abandoned the application in 1995. The Respondent asserts “on information and belief” (without offering evidentiary support) that this was because “the examiner advised IBM that its attempted filing would be rejected because of the genericized nature of the mark”.

The Respondent observes that the Complainant exited the PC business 17 years ago, as reported on the Complainant’s website (“24 years after creating the ‘PC era,’ IBM in 2005 completed the sale of its PC division to Lenovo”). Thus, the term “IBM PC” used in all of the Domain Names is equivalent to a “genericized mark” that has not been associated with a product offered by the Complainant since 2005. The Response attaches evidence that Internet searches on “IBM PC” produce results overwhelmingly referring to the history of IBM PCs and clones in the 1980s and 1990s, not to any current product offerings of the Complainant. The Respondent concludes that the Domain Names are unlikely to create confusion with goods or services offered by the Complainant.

The Respondent argues that it is making fair use of the phrase “IBM PC” in the Domain Names to refer to the generic term for the first generation of IBM personal computers using the term by which they were commonly known, “IBM PC” (the Complainant actually marketed them at first as the “IBM 5150”). “Webviously is also not attempting to tarnish IBM’s trademarks. Instead, it seeks honor a single, narrow, and key aspect of IBM’s historical business.” The Respondent likens its artistic project and following to a fan club celebrating the historic achievements of the Complainant. “[T]he purchasers of this art are a small but energetic community that is proud and excited to celebrate IBM’s accomplishment, which forever changed the face of computing.”

The Respondent’s claim to artistic use is supported by the fact that the images it distributes electronically are “100% original, painstakingly created by us ‘from scratch’.” The images are created as “vector art”, independently mapped from a myriad of sources” over a period of months and modeled from dozens of individual photographs in the public domain. “In much the same way, Andy Warhol’s famous prints portrayed Campbell’s soup as art, and idealized an item of commerce.”

The Response indicates that the proposed content for the websites the Respondent plans to associate with the Domain Names is essentially similar to that found on the Respondent’s IBM PC NFT Experience website. These sites would include a similar disclaimer of affiliation with the Complainant. The Respondent denies any intent to compete with the Complainant or exploit its trademark by creating confusion as to source or affiliation. The Respondent explains the interim PPC parking of the Domain Names as follows:

“Webviously intended to park these domains for use with its NFT artwork. The domains were parked automatically by the domain registrar in a format that included apparent pay-per-click pages. Webviously derived no revenue from those pages or clicks. When Webviously recognized that the pay-per-click pages were active, it repointed its domains away from there. They are not currently in use, and will be activated in conjunction with Respondent’s intended content, shown by way of example, at ibm.thepec.io and <https://nftbackers.io/explorer/collection/earlyibmfans>.”

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (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. Under paragraph 15(a) of the Rules, “[a] Panel shall decide a 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”.

6.1 Preliminary Issue: Suspension or Termination Because of Pending Litigation

The Respondent seeks termination or suspension of the current UDRP proceeding based on its filing of a civil lawsuit against the Complainant, *Webviously, Inc. v. International Business Machines Corporation*, 4:22-cv-04079-KES, USDC D. S. Dakota. The complaint in that action argues that IBM wrongfully interfered with Webviously’s business by (a) issuing a “takedown” notice to the entity hosting Webviously’s website associated with the domain name <ibmpc.io> and (b) filing a UDRP complaint seeking the transfer of that domain name. The lawsuit seeks, among other things, a judicial declaration that the phrase “IBM PC” is generic and that the domain name <ibmpc.io> “and any other similar domains are rightfully the [Respondent’s]”.

The Complainant opposes suspension or termination of the current UDRP proceeding “because the lawsuit is not directed towards any of these six domains”. This is not entirely accurate. While the court complaint focusses on the Complainant’s actions regarding the domain name <ibmpc.io>, it also refers in paragraph 132 to the current UDRP proceeding and the Domain Names at issue here:

“Further, Webviously is the registrant of other domain names employing the generic, IBM PC, phrase. See, WIPO Case No. [D2022-1717](#) (ibmpc.art; ibmpc.cloud; ibmpc.club; ibmpc.co; ibmpc.online; and ibmpc.org). Without a declaration of rights, Webviously (and IBM) runs the risk of inconsistent results in other administrative proceedings.”

Moreover, the requested declaration of rights concerning the generic status of “IBM PC” is claimed as “integral” to “the current disputes between these parties, including Webviously’s current domain registrations” as well as planned registrations (paragraphs 115, 116).

However, the fact that there is another proceeding addressing the trademark rights of the Complainant does not mean that the Policy lacks jurisdiction or that this proceeding necessarily should be suspended or terminated. The Center is an ICANN-appointed dispute resolution service provider conducting UDRP mandatory administrative proceedings as contemplated in the registration agreements for each of the Domain Names, and these agreements are contractually binding on the Respondent. The Policy provides a mandatory but non-exclusive form of relief for complainant trademark holders, which does not prevent complainants or respondents from “submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded” (Policy, paragraph 4(k)). “All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of Paragraph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.” (Policy, paragraph 5)

The Panel has broad discretion where there are parallel proceedings:

“In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.” (Rules, paragraph 18(a)).

As noted in the WIPO Overview, sections 4.14.1 and 4.14.2, UDRP proceedings are expeditious and limited in scope. They do not entail all the procedures available and all the issues that can be addressed in civil litigation or proceedings before national trademark offices. UDRP panels are cognizant of the fact that their decisions are not binding on the courts or other decision-making bodies with separate jurisdiction but give the parties prompt resolution of one important operational issue – who controls the disputed domain name, at least until other pertinent legal challenges are finally resolved (assuming they would be). Hence, UDRP panels are typically reluctant to suspend or terminate proceedings in deference to other ongoing proceedings of indeterminate duration.

The Panel observes as well that a court ruling in this instance on the asserted generic nature of the phrase “IBM PC” could indeed be relevant but is not necessarily dispositive in the UDRP context. The three-person panel in *Webviously I* concluded as follows on the first element of the similar UDRP complaint in that proceeding:

“The Panel considers that Respondent’s argument – that the phrase IBM PC became a generic mark regarding personal computers in the 1980s – is irrelevant both because the phrase IBM PC is arguably generic only as to personal computers, which Respondent does not sell, and because Complainant asserts rights in its well-known IBM trademark, not in the mark IBM PC. Moreover, there is absolutely no evidence in the record to indicate that the trademark IBM has become generic. Indeed, to the contrary, Complainant has submitted evidence to demonstrate the strength of its IBM name and mark as one of the most valuable and well-known brands in the world.”

The panel in *Webviously I* found that the Respondent lacked rights or legitimate interests in the domain name <ibmpc.io> because it was not using it in connection with a noncommercial “fan site” with content about IBM PCs. The panel found instead that the Respondent unfairly exploited the IBM mark with a domain name that engendered confusion among Internet users for commercial gain. The panel rejected the Respondent’s contention that the arguably generic nature of “IBM PC” gave the Respondent freedom to use that phrase incorporating the recognizable IBM mark in a domain name:

“As discussed above, even if the phrase IBM PC arguably reflects a generic mark in the US (an issue the Panel does not decide), it would only be generic in relation to personal computers, which Respondent does not sell. Further, as discussed above, there is no evidence that Complainant’s IBM mark fails to provide coverage for the technical goods and services related to NFTs. Respondent could be selling NFTs on its commercial website associated with any variety of items (e.g., sports or music memorabilia), not just the IBM 5550 [sic] computer. If Respondent registered a domain name corresponding to the trademarked brand for any of those items, it would require the trademark owner’s consent.

Complainant also benefits from the international renown of its IBM trademark. The Panel concludes that Respondent has registered the Domain Name to capitalize on the IBM mark for financial gain. [...] On this point, it is important to note by way of analogy that a commercial art gallery cannot justify using the name of a famous third-party trademark for its own gallery name, merely because one or more of the paintings it sells makes artistic reference to that trademark. Similarly on the Internet, trademarks are entitled to protection.”

This Panel declines, therefore, to suspend or terminate the present proceeding.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. The Domain Names all incorporate the Complainant’s registered IBM mark in its entirety and add the letters “pc”, commonly used as an abbreviation for “personal computer”, which does not avoid a finding of confusing similarity for purposes of the first Policy element. See *id.*, section 1.8. The IBM mark is recognizable in this string, even though the entire string may have a

generic meaning as alleged by the Respondent. That may be relevant in assessing the second and third elements of the Complaint, as discussed below, but it does not eliminate the fact that Internet users will likely recognize the IBM mark in the Domain Names, which is sufficient to afford the Complainant standing. (As usual, the Top-Level Domains “.art”, “.cloud”, “.club”, “.co”, “.online”, and “.org” are disregarded as a standard registration requirement. See *id.* section 1.11.1.)

The Panel finds, therefore, that the Domain Names are all confusingly similar to the Complainant’s IBM mark for purposes of the first Policy element and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

(i) before any notice to it 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 a *bona fide* offering of goods or services; or

(ii) that the respondent has been commonly known by the domain name, even if it has acquired no trademark 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 trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent’s use of the Domain Names to date only for PPC advertising. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent.

The Respondent claims a legitimate interest in using Domain Names based on the term “IBM PC” referentially in connection with NFTs comprised of original digital artwork created to celebrate the fortieth anniversary of a product line formerly sold by the Complainant and commonly called the “IBM PC”. The Respondent points to similar examples of artistic representations of commercial icons, such as Andy Warhol’s pop art paintings of Campbell’s Soup cans in the early 1960s and a painting of a university football team replete with its trademarked logos, which was the subject of a United States federal lawsuit. The United States Eleventh Circuit Court of Appeals held in that case that trademark protection must be construed “narrowly when deciding whether an artistically expressive work infringes a trademark.” *University of Alabama Board of Trustees v. New Life Art*, 683 F.3d 1266, 1278 (USCA 11th Cir. 2012).

But the issue here is not whether the Respondent has a right to create and sell digital artwork representing the former IBM PC, and neither party actually sells IBM PCs or claims IBM PC as a mark. Rather, the Complainant has a well-established IBM mark included in all of the Domain Names. Thus, the Respondent’s arguments concerning a genericized “IBM PC” mark are off point. The Respondent appears to suggest that it has a “fair use” interest in using the IBM mark in the Domain Names in connection with websites that “celebrate” the IBM PC, similar to a fan club. However, the “fair use” decisions concerning the referential use of trademarks in domain names associated with fan sites typically require that such sites are “active, genuinely noncommercial, and clearly distinct from any official complainant site”. See [WIPO Overview 3.0](#), section 2.7.1. The Respondent does not pass these tests. As the panel in *Webviciously I* found, the sites associated with the Respondent’s IBM PC NFT Experience are clearly commercial. Moreover, in the current

proceeding, there is no evidence that the Domain Names have actually resolved to anything but PPC parking pages or error messages.

The Respondent might have made an argument instead that it was preparing to use the Domain Names for commercial NFT offerings related solely to the IBM PC, to meet the example of the Policy, paragraph 4(c)(i): “before any notice to it 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 a *bona fide* offering of goods or services”. The Respondent did not redirect these Domain Names to sites where the Respondent was selling the IBM PC NFTs, however, and the Respondent has not articulated plans or offered evidence of preparations for websites to be associated with the Domain Names. Instead, the Respondent simply allowed them to be used for months for unrelated PPC advertising. Thus, there is no predicate on this record for a claim of rights or legitimate interests under paragraph 4(c)(i). Even the Respondent’s artwork at the “nftbackers” site does not convey a message that the works are not affiliated with Complainant; to the contrary they could easily be mistaken as originating from the Complainant.²

The Panel finds, therefore, that the Respondent has not met its burden of production and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following (in which “you” refers to the registrant of the domain name):

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

This example is apposite in the circumstances of this proceeding, because the Respondent was admittedly aware of the Complainant’s IBM well-known trademark and allowed the Domain Names to be used for months for third-party PPC advertising. A registrant may not be viewed as acting in bad faith simply because a registrar automatically parks a domain name initially by default at a landing page with an advertisement for its own services and software-generated PPC advertising for third parties, often sharing no advertising revenues with the registrant (as the Respondent states in this case). But under the ICANN-approved terms of the registration agreement, the registrant remains responsible for the use of the domain name in a manner that complies with the registration agreement and that does not infringe the rights of others. Allowing default PPC parking for a short time may not be enough to infer bad faith in the registration and use of a domain name, but allowing others over an extended period of time to commercially exploit a domain name that is identical or confusingly similar to a trademark known to the registrant reflects a disregard for the rights of others that must be considered bad faith within the meaning of the Policy. The Panel notes that the example of bad faith cited in paragraph 4(b)(iv) does not require that the Respondent itself profits from misdirecting Internet users to other commercial sites. It appears on this record that the Respondent did not redirect the Domain Names away from PPC advertising pages until notified of the Complaint in this proceeding.

The Complainant considers this also a “passive holding” case, where the Respondent could never make a legitimate use of the Domain Names. In fact, the Respondent has allowed the Domain Names to be used for commercial advertising. As described in the previous section, the Respondent has not made a case for

² If the Respondent had provided evidence of such demonstrable preparations, it would still have been obliged to justify the referential fair use of the Complainant’s trademark in the Domain Names as used for such commercial sites. See [WIPO Overview 3.0](#), sections 2.4, 2.5 (“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.”), and *Everytown for Gun Safety Action Fund, Inc. v. Contact Privacy Inc. Customer 1249561463 / Steve Coffman*, WIPO Case No. [D2022-0473](#) (endorsing a holistic assessment of factors in claimed fair use fan or criticism cases).

planned referential fair use of the Complainant's trademark in Domain Names that inherently suggest association with the Complainant. Whether that could conceivably be done in a legitimate manner with these Domain Names (versus one which does not use Complainant's mark) is arguable. As the panel in *Webviously* I remarked, there is a difference between selling art that pictures a company's trademark and using the trademark in the name of the gallery. But in this case, the Respondent has only allowed others to exploit the Complainant's trademark commercially for months, which must be considered bad faith under the Policy.

The Panel concludes that the Complainant has established the third element of the Complaint.

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, <ibmpc.art>, <ibmpc.cloud>, <ibmpc.club>, <ibmpc.co>, <ibmpc.online>, and <ibmpc.org>, be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: August 26, 2022