

## **ADMINISTRATIVE PANEL DECISION**

### **International Business Machines Corporation v. John Lovvorn Case No. D2022-1932**

#### **1. The Parties**

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

The Respondent is John Lovvorn, United States.

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

The disputed domain names <ph-ibm.com> and <sg-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 May 27, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 1, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 2, 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 June 7, 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 June 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 4, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on July 12, 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**

Without contest by the Respondent, the Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Tracing its roots to the 1880s and incorporated on June 16, 1911, as an amalgamation of three previously existing companies, the Complainant officially became International Business Machines on February 14, 1924 ("IBM"). 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 under the INTERNATIONAL BUSINESS MACHINES trademark and its abbreviation trademark IBM (the "IBM Mark").

Complainant introduced its first large vacuum tube computer under the IBM Mark as the IBM 710 in 1952, and since then has continuously used the IBM Mark in association with computers and computer hardware, software, and accessories. 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 spent more than USD 6 Billion on advanced research in 2021 and spent more than USD 6 Billion on advanced research in 2020. As a result of the high quality of goods and services IBM has provided to its customers for over 100 years, the Complainant's IBM Mark is synonymous with innovation and high quality in the field of information technology throughout the world, and the IBM Mark has been recognized by prior UDRP panels as famous and well-known worldwide a valuable asset of the Complainant.

The Complainant holds numerous trademark registrations for the IBM Mark around the world for information technology related goods and services, including the following registrations in the United States, where the Respondent is located:

1. United States Trademark Registration No. 0640,606, IBM, registered on January 29, 1957, for "magnetic recording tape" in international class 9, and claiming a first use date of August 5, 1955.
2. United States Trademark Registration No. 1,058,803, IBM, registered on February 15, 1977, for a range of information technology goods and services in International Classes 1, 9, 16, 37, 41, and 42 and claiming a first use date as early as January 1, 1950; and
3. United States Trademark Registration No. 1,243,930, IBM, registered on June 28, 1983, for "Computer Time Sharing Services" in International Class 42 and claiming a first use date of February 2, 1982.

The Complainant has also registered numerous domain names that incorporate the IBM Mark, including <ibm.com> registered on March 19, 1986, used to access the Official IBM Website where it promotes its information technology goods and services in connection with the IBM Mark.

Both disputed domain names were registered on October 26, 2021, and neither resolves to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademark, that the Respondent has no rights or legitimate interests in respect of the disputed

domain names, and that the disputed domain names were registered and are being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

Where no substantive Response is filed, however, the Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these requirements in more detail below.

The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

### **6.1. Consolidation**

Paragraph 4(f) of the Policy allows a panel to consolidate multiple disputes between parties at its sole discretion, and paragraph 10(e) of the Rules empowers a panel to consolidate multiple domain name disputes in accordance with the Policy and the Rules. (UDRP Rules, paragraph 10(e)). Where multiple respondents are named, the consensus of prior UDRP panels is to look at the following key considerations: i) whether the domain names or corresponding websites appear to be under common control; ii) whether consolidation would be fair and equitable to all parties; and iii) whether consolidation would promote procedural efficiency. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2; see also *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

In support of its consolidation request, the Complainant provides the following evidence in the annexes to its Complaint showing common control over the disputed domain names: (i) both disputed domain names were registered on the same date, October 26, 2021, with the same Registrar, Wild West Domains, LLC, using the same online privacy protection company, Domains by Proxy, LLC, to hide their respective identity on the Whois records; (ii) both disputed domain names have been configured in an identical pattern of terms and punctuation: a two-letter country abbreviation as provided in ISO-3166 Alpha-2, which letters are also used for that country's "country code" TLD ("ph" for Philippines and "sg" for Singapore), followed by a hyphen, followed by the IBM Mark, and ending with the generic suffix ".com" gTLD; (iii) neither of the disputed domain names leads to an active website; (iv) on October 29, 2021, approximately one week after both were registered, the name servers connected to each disputed domain name were updated to use Microsoftonline.com; and (v) the Complainant's technical analysis evidence shows that both disputed domain names are associated with IP addresses linked to malware, cryptocurrency mining, and botnet command and control servers.

The Complainant contends these similarities clearly reflect the same underlying controller of the disputed domain names in this case. The Panel finds based on the factors listed above that it is most likely that the disputed domain names are or were under the common control of the same person or persons named as the

Respondent and there is sufficient evidence of common control here to grant the Complainant's request for consolidation. The Respondent has not challenged the Complainant's request for consolidation, and it is clearly most procedurally efficient, and considering all the circumstances, fair and equitable for the disputed domain names to be included together in this one case to determine the Complainant's UDRP claims in the same proceeding.

## 6.2. Substantive Issues

### A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. the Complainant claims registered trademark rights in the IBM Mark for its information technology products and services dating back to at least as early as 1950. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting international trademark registration documents in the name of the Complainant and therefore, the Complainant has demonstrated it has rights in the IBM Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

Further, the Complainant has provided a citation to prior UDRP decisions, which support the recognition of the Complainant's trademark rights established in the IBM Mark as famous and well-known worldwide. See *International Business Machines Corporation v. Sadaqat Khan*, WIPO Case No. [D2018-2476](#); and *International Business Machines v. Niculescu Aron Razvan Nicolae*, WIPO Case No. [DRO02010-0003](#).

With the Complainant's rights in the IBM Mark established, the remaining question under the first element of the Policy is whether the disputed domain names are identical or confusingly similar to the Complainant's IBM Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7.

Prior UDRP panels have held the fact that a domain name which wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. [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"); see also *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#).

Each of the disputed domain names encompasses the Complainant's IBM Mark, respectively, starting with the letters "ph" or "sg", respectively, appended to the IBM Mark with a hyphen and followed by the generic suffix ".com" in sequence. The letters "ibm" contained in each disputed domain name are identical to the IBM Mark. The disputed domain names, therefore, incorporates in their entirety the Complainant's registered IBM Mark.

As noted in section 6.1 the letters "ph" and "sg" are generally recognized as the two-letter country abbreviation for Philippines and Singapore as provided in ISO-3166 Alpha-2, as well as each country's "country code" TLD, but neither would prevent the panel from finding confusing similarity as noted in the UDRP precedents cited above. The Complainant also contends the Respondent's selection of these geographic terms for each disputed domain name is to enhance confusion of consumers because the Complainant has a longstanding history of conducting business in these countries, but that issue is more appropriately considered under the second and third elements of the Policy. See *Natixis v. Domain eRegistration/ ID Shield Service, Domain ID Shield Service CO., Limited*, WIPO Case No. [D2016-2289](#).

Prior UDRP panels have found typographic differences, such as the inclusion or omission of hyphens and apostrophes are inadequate to avoid a finding of confusing similarity. See, e.g., *L'Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#). The addition of the Top-Level Domain ("TLD") ".com" is irrelevant in determining whether the disputed domain name is confusingly similar. See, *Research in Motion Limited v*

*thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#); [WIPO Overview 3.0](#), section 1.11.

Based on the above, this Panel finds that the terms appended by a hyphen to the Complainant's mark to form each disputed domain name do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's IBM Mark. The Complainant's well-known IBM Mark remains fully recognizable as incorporated in its entirety into each disputed domain name. Accordingly, the Panel finds the disputed domain names confusingly similar to the IBM Mark in which the Complainant has rights and the Complainant has thus satisfied its burden under Paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, and if successful the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the disputed domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or legitimate interests.

The first example, under paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services".

Here, the annexes to the Complaint show that neither disputed domain name resolves to any website.

The Respondent has not submitted evidence showing its preparations to use either disputed domain name with a *bona fide* offering of goods or services, nor has the Respondent proven that it has been commonly known as either disputed domain name, or that it is making a legitimate, noncommercial or fair use of either disputed domain name.

The Complainant contends, however, that although the Respondent's disputed domain name <ph-ibm.com>, currently appears to lead to an inactive website, the Complainant's technical analysis of the disputed domain name shows the Respondent has connected the disputed domain names to a mail server responsible for sending and accepting email messages on its behalf. Prior UDRP panels have found such behavior suggests the Respondent "may have intended to use the [D]isputed [D]omain [N]ame for phishing or other fraudulent purposes". *Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Thomas Clark*, WIPO Case No. [D2019-1465](#).

The Complainant also contends and shows in its technical analysis of the Whois records that the disputed domain names are both associated with the IP addresses linked to dissemination of malware and botnet command and control servers. Prior UDRP panels have found botnets used to illegally reap financial data from infected host websites and dissemination of malware through a domain name that is confusingly similar to a complainant's trademark is often done to steal consumer information for commercial gain. See, e.g., *Confederation Nationale du Credit Mutuel v. Hardsoft, Inc. / Hilary Kneber*, WIPO Case No. [D2010-1352](#); *Splunk Inc. v. SuperPrivacy Service c/o Dynadot*, WIPO Case No. [D2017-1150](#).

Prior UDRP panels have also held that the use of a domain name for illegal activity involving impersonation and fraud (e.g., 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. See, [WIPO Overview 3.0](#), section 2.13. See also, *Springer Nature Limited v. Registration Private, Domains By Proxy, LLC / Collections Springer Nature*, WIPO Case No. [D2020-0955](#).

Applying the foregoing decision to these facts this Panel finds the disputed domain names are not being used in connection with a *bona fide* offering of goods or services sufficient to demonstrate the Respondent has any rights or legitimate interests in the disputed domain names under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. The Complainant states that the Respondent is not related in any way with the Complainant, does not carry out any activity for, nor have any business with the Respondent. Neither has the Complainant granted any license or authorization to the Respondent to make any use of the Complainant's IBM Mark or apply for registration of the disputed domain names. The Complainant has never authorized the Respondent to use the IBM Mark, or any marks confusingly similar thereto for any purpose, including as a domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

The Complainant also shows that the Respondent is not commonly known by either disputed domain name because the original Respondent listed in the initial Complaint was "John Doe" as the registrant for each was unknown until the Registrar identified the underlying registrant for each disputed domain name in its verification process as "John Lovvorn" of the United States, as the Respondent. Neither bears any resemblance to either of the disputed domain names whatsoever (the latter may not even be real). Thus, there is no evidence in this case to suggest that the Respondent is commonly known by either disputed domain name, that it is licensed or otherwise authorized to use the Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to the Respondent and the facts presented here support a lack of rights or legitimate interests in both disputed domain names. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

In light of the above, and with no Response or other submission in this case to rebut the Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

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

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, the Complainant contends and prior UDRP Panels have found that the IBM Mark is a famous and well-known trademark worldwide. See *International Business Machines Corporation v. Sadaqat Khan, supra*; *International Business Machines v. Niculescu Aron Razvan Nicolae, supra*.

The Complainant further contends that given its IBM Mark is well-known, and the disputed domain name incorporates the registered IBM Mark in its entirety, shows both the Respondent's actual knowledge of the registered IBM Mark and worldwide recognition, including the United States where the Respondent is located, and the Respondent registered both disputed domain names on the same day over 64 years after the Complainant established registered trademark rights in the IBM Mark. Prior UDRP panels have found that where, as here, it would be implausible to believe that the Respondent selected and was using the disputed domain names encompassing the IBM Mark for any other purpose than to trade on the



Complainant's trademark rights and reputation in its internationally famous trademark, establishes a fact pattern that repeatedly has been held to constitute bad faith registration. See *International Business Machines Corporation v. Domain Administrator*, See *PrivacyGuardian.org / Tan Fei Tan*, WIPO Case No. [D2021-0085](#); see also *Philip Morris Inc. v. Tsytkin*, WIPO Case No. [D2002-0946](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises the complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#). Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

As noted in 6A. above as the Complainant contends, the Respondent has intentionally configured each disputed domain name to enhance confusing similarity to the Complainant's IBM Mark by adding a descriptive geographic term which relates to a location where the Complainant provides its information technology products and services, "ph" for the Philippines and "sg" for Singapore and using the disputed domain name to direct or redirect consumers to the Respondent's inactive site or for phishing email or malware distribution purposes. Prior UDRP Panels have found the additions of country codes as descriptive indications of origin, adding to the confusion to create a false association between the Complainant and the Respondent and a clear indication that the Respondent intentionally attempted to attract, for commercial gain, Internet users to the disputed domain names, by creating a likelihood of confusion with the Complainant's IBM Mark as to the source, sponsorship, affiliation or endorsement of the Respondent, and, therefore, evidence of registration and use of the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy. See, e.g., *Natixis v. Domain eRegistration / ID Shield Service, Domain ID Shield Service CO., Limited*, WIPO Case No. [D2016-2289](#); *Microsoft Corporation v. Zerbo*, WIPO Case No. [D2005-0644](#).

As noted in 6B above the Complainant has shown evidence of bad faith use based on the illegal and illegitimate conduct involving phishing and the distribution of malware the Respondent is engaged in as shown in the technical analyses submitted for each disputed domain name in the annexes to the Complaint. See *Wikimedia Foundation, Inc. v. Yangmin Fang, Huli Jing Internet Holdings Ltd.*, WIPO Case No. [D2015-2140](#).

Finally, the Complainant contends the Respondent has used the disputed domain names in bad faith pursuant to the doctrine of passive holding, as the disputed domain names are not being used in connection with active websites.

It is the consensus of UDRP panels under the doctrine of passive holding that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith. While panelists will look at the totality of the circumstances in each case, factors considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), Section 3.3.

Many of the above factors are applicable here: (i), the IBM Mark is distinctive, widely known, and readily identified with the Complainant's products and services; (ii) the Respondent has failed to respond to the Complainant's multiple cease and desist letters directed to each disputed domain name; (iii) the Respondent provided no evidence of actual or contemplated good-faith use; (iv) the Respondent masked its identity on the Whois records by using a privacy shield service, Domains by Proxy, LLC; and (v) it is implausible that there would be any good faith use to which the disputed domain names may be put. Considering the foregoing factors and the totality of the circumstances present here, the Panel finds the Respondent has registered and is using the disputed domain names in bad faith.

The Panel finds the Complainant's arguments and evidence persuasive and has received no arguments or evidence from the Respondent to the contrary. Considering all the circumstances, the Panel concludes that the Respondent has registered and used the disputed domain names in bad faith and the Complainant has satisfied 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, <ph-ibm.com> and <sg-ibm.com> be transferred to the Complainant.

*/Scott R. Austin/*

**Scott R. Austin**

Sole Panelist

Date: August 9, 2022