

ADMINISTRATIVE PANEL DECISION

Kyndryl, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-3868

1. The Parties

The Complainant is Kyndryl, Inc., United States of America, represented by Demys Limited, United Kingdom.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <narayanankyndryl.com> 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 October 14, 2022. On October 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 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 (Domains By Proxy, LLC, United States of America) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 19, 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 amended Complaint on October 19, 2022.

The Center verified that the Complaint together with the amended 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 October 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2022.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on November 21, 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 IT company that designs, builds, manages and modernizes complex, mission-critical information systems. The Complainant was IBM's former Global Technology Services infrastructure services business comprising more than a quarter of IBM's employees as well as over 4,000 clients. 75 percent of Fortune 100 companies are the Complainant's clients. Currently, the Complainant is one of the largest IT service providers in the world. The Complainant employs more than 88,000 people and operates in 63 countries.

On April 12, 2021, the media broadcasted that IBM was to name its infrastructure services business as "Kyndryl", which is derived from the words "kin" and "tendrill" to represent the symbol of growing collaboration to foster human progress.

On November 4, 2021, the Complainant's group company, Kyndryl Holdings, Inc., began trading shares on the New York Stock Exchange.

The Complainant owns an international trademark KYNDRYL with registration number 1628208 registered on June 14, 2021.

The Complainant operates an official website at "www.kyndryl.com".

The disputed domain name was registered on July 5, 2022 and redirects randomly to a variety of unrelated third-party websites apparently selected at random.

The Respondent has been part to more than 550 previous disputes under the UDRP, the majority of which found against the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to registered trademarks in which the Complainant has rights in terms of the Policy. The disputed domain name incorporates the Complainant's KYNDRYL mark in its entirety, with the addition of the personal name "Narayanan". The Complainant affirms that its KYNDRYL name and mark is the most dominant and recognizable element of the disputed domain name. The Complainant further contends that the adornment does nothing to distinguish the disputed domain name from the Complainant's name and mark.

The Complainant alleges that Kyndryl is a made-up term and provides a Google search for the term "Narayanan Kyndryl" where the results relate to the Complainant or individuals employed by the Complainant who have the personal name "Narayanan". The Complainant further notes that none of the individual are named "Kyndryl".

The Complainant avers that the Top-Level Domain ("TLD") ".com" is required only for technical reasons and, as is common in dispute proceedings, can be ignored for the purposes of comparison of the disputed domain name to the Complainant's mark.

With regard to the second element, the Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant refers to section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant has found no evidence that the Respondent has been commonly known as Kyndryl or Narayanan Kyndryl prior to or after the registration of the disputed domain name. The Complainant observes that the Respondent's personal name, "Carolina Rodrigues", nor the Respondent's organization name, "Fundacion Comercio Electronico" are reflected in the disputed domain name.

Furthermore, the Respondent is not a licensee of the Complainant and has not received any permission, consent or acquiescence from the Complainant to use its name or marks in association with the registration of the disputed domain name or, indeed, any domain name, service or product. Neither has the Complainant found evidence that the Respondent has ever traded legitimately under the business names Kyndryl or Narayanan Kyndryl. Indeed, the Complainant has found no evidence that the Respondent owns any trademarks incorporating the terms Kyndryl or Narayanan Kyndryl.

The Complainant also contends that the incorporation of its highly distinctive KYNDRYL name and mark, which is the most recognizable and dominant element of the disputed domain name, falsely suggests affiliation between the Respondent and the Complainant.

The Complainant notes that the disputed domain name resolves to a variety of unrelated third-party websites apparently selected at random. In some cases, the disputed domain name redirects to websites that attempt to mislead Internet users into downloading malware. However, on other occasions, it resolves to an unrelated third-party shop or pay-per-click advertising webpage. To sum up, the Complainant is of the opinion that there is "bait and switch" use of the trademark in clear detriment of the Complainant's rights.

Moreover, the Complainant notes that the disputed domain name is listed for sale with the asking price of USD 999. However, the offering for sale of a disputed domain name that incorporates a highly distinctive mark, cannot confer a right or legitimate interest on the Respondent.

For the purposes of the third element, the Complainant asserts that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark and this is sufficient to find that the disputed domain name was registered and is being used in bad faith. Such a finding is based on the following claims:

The disputed domain name is, at first glance, confusing to the average Internet user.

The distribution of malware on any domain name cannot be construed as *bona fide* use for the purposes of the Policy.

The display of pay-per-click advertising in association with a domain name that is confusingly similar to a complainant's trademark is sufficient on its own for a finding of registration and use in bad faith, regardless of whether it was directly placed by the registrant or its registrar of record.

The Complainant contends that the Respondent's offer to sell the disputed domain name, which incorporates the Complainant's highly distinctive name and mark, for valuable consideration in excess of the Respondent's reasonable out-of-pocket costs directly related to the disputed domain name is evidence of abusive registration and use as per the Policy.

And finally, there is potential for misleading emails. It means according to the Complainant that since the disputed domain name incorporates Complainant's highly distinctive name and mark, anyone receiving an email from the disputed domain name would reasonably assume that it was sent from the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a “default” the Panel is still required “to proceed with a decision on the complaint”, whilst under paragraph 14(b) it “shall draw such inferences there from as it considers appropriate”. This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

A. Identical or Confusingly Similar

The Complainant has demonstrated trademarks rights over KYNDRYL for purposes of the Policy, paragraph 4(a)(i).

The Panel looks at section 1.8 of [WIPO Overview 3.0](#): “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” and section 1.11: “The applicable Top Level Domain (‘TLD’) in a domain name [...] is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”.

Accordingly, the identity or confusing similarity under the first element rests on the comparison between the disputed domain name and the mark KYNDRYL which results in a more than obvious reproduction of the latter. The Panel notes that the trademark KYNDRYL is clearly recognizable in the disputed domain name, and the addition of the term “Narayanan” does not prevent a finding of confusing similarity between the disputed domain name and that the trademark KINDRYL.

Therefore, the first requirement is met under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out non-exclusive examples in which the Respondent may establish rights or legitimate interests in the 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) 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.

After reviewing the websites randomly resulting from the disputed domain name, the Panel agrees that there is no legitimate noncommercial or fair use of the disputed domain name. Indeed, pay-per-click website constitutes commercial use of the disputed domain name without the Complainant’s authorization. Similarly,

there is no *bona fide* offering in the Respondent's attempt to mislead Internet users into downloading malware since such use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent.

The reproduction of the trademark KYNDRYL in the disputed domain name suggests an implied affiliation between the Respondent and the Complainant while it does not exist.

Nothing in the record allows the Panel to consider the Respondent to have been commonly known as "Kyndryl" or "Narayanan Kyndryl", according to the Whois information.

Neither is there evidence of any trademark registration in favor to the Respondent in relation to "Kyndryl" or "Narayanan Kyndryl".

The Respondent is not a licensee of the Complainant and no evidence has been induced to show that the Respondent was given authorization to use the Complainant's trademark in a corresponding domain name.

Under these circumstances the Panel looks at [WIPO Overview 3.0](#), section 2.1: "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 relevant evidence demonstrating 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."

Accordingly, the Panel concludes that the Respondent intentionally registered a domain name which contains the KYNDRYL trademark, namely, in the Panel's view, the Respondent targeted the Complainant and its trademarks.

The Complainant has presented a *prima facie* case which demonstrates that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Panel notes that the Respondent has not submit a Response.

Accordingly, the Complainant has met the second element under paragraph 4(a)(ii) of the Policy to the satisfaction of the Panel.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent has registered and used the disputed domain name in bad faith.

In the present circumstances the Panel finds that the Respondent knew or should have known about the Complainant. Indeed, the Panel notes that the announcement of the Complainant's name Kyndryl received important media attention (Reuters, Nasdaq, Bloomberg, etc.) at the moment IBM decided to announce the spinoff of the Complainant back to April 2021. Additionally, by registering the disputed domain name that includes the Complainant's coined trademark is evidence of the Respondent's bad faith registration. Moreover, the Complainant has provided a Google search for the term "Narayanan Kyndryl" where the results relate to the Complainant or individuals employed by the Complainant who have the personal name "Narayanan". Accordingly, the requirement of bad faith registration is met by the Complainant.

With regard to the use of the disputed domain name, it has been proven that it randomly redirects to various third-party websites, including the website with pay-per-click links. The Respondent has attempted to divert consumers to third parties unrelated to the Complainant, and purportedly obtaining revenues for this activity. This is deemed to be in bad faith. See *AECI Limited v. Rick Matthews*, WIPO Case No. [D2022-1250](#).

Additionally, the Respondent's use of the disputed domain name, in certain cases, for misleading Internet users to download and install malware cannot be considered as *bona fide*.

The Panel further notes that the Respondent has been the respondent in more than 500 UDRP cases, the majority of which found against the Respondent. Therefore, the Panel finds that the Respondent has been engaged in a pattern of bad faith conduct within the meaning of paragraph 4(b)(ii) of the Policy. See *Reckitt Benckiser Group Plc, Reckitt & Colman (Overseas) Health Limited, and Reckitt Benckiser SARL v. Privacy Service Provided by Withheld for Privacy ehf / Rick Matthews*, WIPO Case No. [D2022-0815](#).

Likewise, the attempt to sell the disputed domain name for valuable consideration in excess of the Respondent's reasonable out-of-pocket costs directly related to it is further evidence of bad faith.

Therefore, the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy after producing a strong case to the satisfaction of the Panel.

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 <narayanankyndryl.com> be transferred to the Complainant.

/Manuel Moreno-Torres/

Manuel Moreno-Torres

Sole Panelist

Date: December 5, 2022