

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. benhe yang, yan hao, Mahmoud Ech-cheikh, Deyuan Du (德元 杜), Jizu Cao (纪祖 曹), day song (日 曲)

Case No. D2024-1939

1. The Parties

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

The Respondents are benhe yang, Hong Kong, China, yan hao, Hong Kong, China, Deyuan Du (德元 杜), Hong Kong, China, Jizu Cao (纪祖 曹), Hong Kong, China, day song (日 曲), Hong Kong, China, and Mahmoud Ech-cheikh, Canada.

2. The Domain Names and Registrars

The disputed domain names <cryptocurrencyibm.xyz>, <ethereumibm.com>, <ethereum-ibm.vip> and <ethereum-ibm.app> are registered with NameSilo, LLC.

The disputed domain names <ethereum-ibm.com>, <ethereum-ibm.info>, <ethereum-ibm.net> <ethereum-ibm.org>, and <ethereum-ibm.xyz> are registered with Dynadot Inc.

The disputed domain name <ibmethereum.com> is registered with GoDaddy.com, LLC (altogether the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 8, 2024. On May 13, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On May 13 and May 14, 2024, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Jose) and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 15, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity

and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on May 20, 2024.

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 Respondents of the Complaint, and the proceedings commenced on May 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on June 26, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on July 8, 2024. 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

It results from the Complainant’s undisputed allegations that it 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. Incorporated on June 16, 1911, as an amalgamation of three previously existing companies, the Complainant officially became “International Business Machines” on February 14, 1924. The Complainant has been offering products under the trademark IBM ever since.

The Complainant is the registered owner of several trademarks worldwide for IBM, such as the United States trademark registration no. 4,181,289, registered on July 31, 2012, in classes 6, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 30, 35, 35, and 41.

The disputed domain names concerned were registered as follows:

<ethereum-ibm.com> on September 8, 2023
<ethereum-ibm.info> on September 8, 2023
<ethereum-ibm.net> on September 8, 2023
<ethereum-ibm.org> on September 8, 2023
<ethereum-ibm.xyz> on September 8, 2023
<ethereum-ibm.app> on February 5, 2024
<ethereum-ibm.vip> on February 5, 2024
<ethereumibm.com> on February 4, 2024
<cryptocurrencyibm.xyz> on February 4, 2024
<ibmethereum.com> on August 19, 2023

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain names (but <ibmethereum.com>) redirect to the website at “www.coinbase.com/wallet”, an e-commerce platform for buying, selling, and trading cryptocurrency. The disputed domain name <ibmethereum.com> resolve to its Registrar’s parked page.

Moreover, the undisputed evidence provided by the Complainant proves that the Complainant sent a cease-and-desist letter to the related Respondent, through the Registrar, at the email address listed on the Whois records on September 15, 2023, for the disputed domain name <ibmethereum.com>, asking the Respondent to disable and transfer the disputed domain name back to the Complainant. On November 1, 2023, the Respondent, acting as “Jose”, replied stating “The domain is up for grabs...grab it or get lost.”

The Complainant also sent cease-and-desist letters to the related Respondent, through the Registrar, at the email address listed on the Whois records on September 22, 2023, for the disputed domain names <ethereum-ibm.com>, <ethereum-ibm.info>, <ethereum-ibm.net> and <ethereum-ibm.xyz>. The Respondent did not reply to it.

In addition, the undisputed evidence provided by the Complainant proves that the Complainant also sent a cease-and-desist letter to the related Respondent, through the Registrar, at the email address listed on the Whois records on February 12, 2024, for the disputed domain name <ethereum-ibm.app>. The Respondent did not reply to it.

Finally, the undisputed evidence provided by the Complainant proves that the Complainant also sent a cease-and-desist letter to the related Respondent, through the Registrar, at the email address listed on the Whois records on February 8, 2024, for the disputed domain names <ethereum-ibm.vip>, <ethereumibm.com> and <cryptocurrencyibm.xyz>. The Respondent did not reply to it.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademark since they contain its trademark IBM entirely.

Seven of the disputed domain names are comprised of the word "ethereum," which is the name of a cryptocurrency, followed by a hyphen "-", the letters "ibm", and ending with a generic Top-Level Domain suffix. The letters "ibm" contained in the dispute domain names are identical to the Complainant's IBM trademark. The only difference is the addition of the word "ethereum" and the hyphen between "ibm" and "ethereum," which visually distinguish the Complainant's IBM mark from the rest of the related domain name.

Three of the disputed domain names, namely <ethereumibm.com>, <cryptocurrencyibm.xyz> and <ibmethereum.com> alter this pattern slightly by removing the hyphen "-". <cryptocurrencyibm.xyz> replaces "ethereum" with the nearly synonymous word "cryptocurrency", and <ibmethereum.com> reverses the order of terms by placing "ibm" ahead of "ethereum." Despite these slight differences, all of the disputed domain names give the same impression of a website operated by IBM offering cryptocurrency or cryptocurrency-related services. The disputed domain names' minor variations do not obviate the confusing similarity between the disputed domain names and the Complainant's IBM trademark.

The Complainant further contends that the Respondents have no rights or legitimate interests in the disputed domain names. According to the Complainant, it has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain names. Furthermore, there is no evidence that the Respondents are using the disputed domain names incorporating the IBM trademark for a bona fide offering of goods or services. On the contrary, the Respondents have been intentionally attempting to create a likelihood of confusion by using the IBM trademark in the disputed domain names to redirect visitors to a different website. Namely all disputed domain names, with the exception of <ibmethereum.com>, redirect to the website at "www.coinbase.com/wallet". Such unauthorized 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.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, the Respondents were well aware of the Complainant's trademarks at the time it registered the disputed domain names, since the Complainant's trademarks are well known around the world. The disputed domain names comprise the world-famous IBM mark. The only differences

between the disputed domain names and the IBM mark are the mere addition of the word “ethereum” or “cryptocurrency”. Hence, a presumption of bad faith must be found against the Respondents.

Moreover, the Complainant sent a cease-and-desist letter to the related Respondent, through the Registrar GoDaddy, at the email address listed on the Whois records on September 15, 2023 for one of the disputed domain names, namely <ibmethereum.com>, asking the Respondent to disable and transfer the disputed domain name back to the Complainant. On November 1, 2023, the Respondent replied stating “The domain is up for grabs...grab it or get lost.” This shows the Respondent’s bad faith intent to engage in domain squatting by acquiring a domain name which incorporates the Complainant’s trademark and waiting for the Complainant or other bad faith actors to purchase it. Furthermore, the registrant of this domain falsely identified themselves as “Jose” in an email to the Complainant, evincing a clear intent to engage in bad faith.

B. Respondents

The Respondents did not reply to the Complainant’s contentions.

6. Discussion and Findings

6.1. Procedural issues

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant’s request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant’s request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.11.2.

As regards common control, the Panel notes that the Complainant submitted sufficient evidence to justify the consolidation in terms of common control of the domain names or corresponding websites.

As set forth in section 4.11.2 of [WIPO Overview 3.0](#): “Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).”

The Panel considers the consolidation as appropriate, taking into consideration the following factors: in particular 1) all ten disputed domain names follow the same naming pattern by incorporating the Complainant's trademark IBM preceded or followed by a "descriptive term" relating to the cryptocurrencies (i.e. "ethereum" or "cryptocurrency"); 2) all ten disputed domain names (but <ibmethereum.com>) redirect to the same website advertising cryptocurrency; 3) all the disputed domain names (but <ibmethereum.com>) have the same ASN (Autonomous System Number) and use the same name servers; 3) Additionally, all the disputed domain names are in Latin script; 4) The email address used when registering the disputed domain names <ethereum-ibm.app>, <ethereum-ibm.vip> and <ethereumibm.com>, <cryptocurrencyibm.xyz> are the same. All these elements give evidence of a common control of the disputed domain names.

On the balance of probabilities and taking into account the above circumstances of the present case, the Panel finds that the disputed domain names are under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.2 Substantive issues

Paragraph 15(a) of the Rules instructs this Panel to "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". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or 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.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the use of hyphens, the terms "ethereum" and "cryptocurrency") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Moreover, the Panel notes that the disputed domain names contain the Complainant’s registered and well-known trademark IBM, and that more likely than not, this trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain names with the intention to take advantage of the Complainant’s reputation by registering domain names containing the Complainant’s trademark with the intent to mislead Internet users.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel shares the view of other UDRP panels and finds that the Complainant’s trademark IBM is well known. Therefore, this Panel has no doubt that the Respondent positively knew or should have known the Complainant’s trademark when registering the disputed domain names. This is underlined by the fact that the disputed domain names are clearly constituted by the Complainant’s trademark followed or preceded by the terms “ethereum” and “cryptocurrency” (and hyphens). Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names 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, [WIPO Overview 3.0](#) section 3.1.4. The Panel shares this view.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Finally, the further circumstances surrounding the disputed domain names’ registration and use confirm the findings that the Respondent has registered and is using the disputed domain names in bad faith:

(i) the nature of the disputed domain names (a domain name incorporating the Complainant’s well-known IBM mark plus additional terms related to cryptocurrencies);

(ii) the content of any website to which the almost all domain names redirect (i.e. cryptocurrency websites at “www.coinbase.com/wallet”, an e-commerce platform for buying, selling, and trading cryptocurrency);

(iii) a clear absence of rights or legitimate interests coupled with no response for the Respondent’s choice of the disputed domain names.

(iv) the Respondent did not reply to cease-and-desist letters sent for almost the disputed domain names. In case of the cease-and-desist letter sent for <ibmethereum.com>, the Respondent replied stating “The domain is up for grabs...grab it or get lost.”

The Panel finds that the Complainant has established the third element 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, <cryptocurrencyibm.xyz>, <ethereum-ibm.app>, <ethereum-ibm.com>, <ethereumibm.com>, <ethereum-ibm.info>, <ethereum-ibm.net>, <ethereum-ibm.org>, <ethereum-ibm.vip>, <ethereum-ibm.xyz>, <ibmethereum.com>, be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: July 22, 2024