

## **ADMINISTRATIVE PANEL DECISION**

International Business Machines Corporation v. Colin Sun  
Case No. D2024-4396

### **1. The Parties**

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

The Respondent is Colin Sun, China.

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

The disputed domain name <ibm.app> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2024. On October 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 28, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 29, 2024, 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 October 29, 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 Respondent of the Complaint, and the proceedings commenced on October 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2024. The Respondent sent email communications to the Center on November 8, 2024.

On November 12, 2024, following the Respondent's communication, the Center sent a Possible Settlement email to the Parties to which the Complainant responded requesting Suspension of the proceeding to explore settlement options. The Center suspended the proceedings from November 13, 2024, until December 13, 2024. On December 12, 2024, the Complainant sent an email to the Center informing that the Parties were unable to agree on a reasonable settlement and requesting that the proceeding be continued. The Center reinstated the proceeding on December 13, 2024, and informed the Parties that the new Response due date was December 20, 2024. The Respondent sent further communication to the Center on December 15, 2024, and December 17, 2024, mainly seeking clarification on the time zone considered in submitting the response, if there are alternative submission methods, and requesting for specific annexes submitted by the Complainant. The Center replied accordingly on December 17, 2024.

The Response was filed with the Center on December 19, 2024.

On December 31, 2024, the Complainant submitted a Supplemental filing in response to Response from the Respondent. On January 2, 2025, the Responded submitted a Supplemental Response to Complainant's Supplemental filing.

The Center appointed Gregor Vos as the sole panelist in this matter on January 2, 2025. 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 manufacturer of inter alia computer and computer-related goods and services and was incorporated in 1911. From 1924 the Complainant is formally known as International Business Machines ("IBM").

The Complainant is the owner of inter alia the following trademark registration (hereinafter referred to as: the "Trademarks"):

- US Trademark registration No. 1696454 for IBM registered on June 23, 1992; and
- US Trademark registration No. 3002164 for IBM registered on September 27, 2005; and
- US Trademark registration No. 4181289 for IBM registered on July 31, 2012.

The Domain Name was registered on May 2, 2018. Currently, and at the time of filing of the Complaint, the Domain Name does not resolve to an active webpage.

#### **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 Domain Name. The Complainant's contentions from the Complaint and the Supplemental filing are discussed together.

Notably, the Complainant contends that the Domain Name is identical or confusingly similar to the Trademarks of the Complainant, that the Respondent has no rights or legitimate interests in the Domain Name, and that the Domain Name has been registered and is being used in bad faith.

Firstly, according to the Complainant, the Domain Name is confusingly similar to its well-known Trademarks. The Domain Name incorporates the Trademarks in their entirety with the mere addition of the generic Top-Level Domain ("gTLD") ".app", which does not prevent a likelihood of confusion.

Secondly, according to the Complainant, the Respondent has no rights or legitimate interests in the Domain Name. The Respondent has never received a license or any other form of authorization from the Complainant to use the Trademarks, has no prior rights to the Domain Name and is not commonly known by the Domain Name.

Finally, according to the Complainant, the Respondent has registered and is using the Domain Name in bad faith. In light of the well-known character of the Complainant's Trademarks, it is inconceivable that the Respondent registered the Domain Name without knowledge of the Complainant and its Trademarks and attributing to a finding of opportunistic bad faith. Also, according to the Complainant, the Domain Name is being used in bad faith, pursuant to the doctrine of passive holding, as the Domain Name has not been used in connection with any bona fide and legitimate purpose since its registration date.

## **B. Respondent**

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the Domain Name. The Respondent's contentions from the Response and the Supplemental Response are discussed together.

Notably, the Respondent contends that the Domain Name is not identical or confusingly similar to the Trademarks of the Complainant, that the Respondent has a legitimate interest in the Domain Name, and that the Domain Name does not show evidence of bad faith registration and use.

Firstly, according to the Respondent, the Domain Name is not confusingly similar to the Complainant's Trademarks. Even though the Complainant's Trademarks are widely recognized, the three-letter combination "IBM" itself is not inherently exclusive to a single entity, and neither is the gTLD ".app".

Secondly, according to the Respondent, the Respondent has a legitimate interest in the Domain Name. The legitimate interests in the Domain Name are evidenced by the neutral, noncommercial motivation for its registration. In light of the abundance of generic meanings for "IBM" and the Respondent's culturally oriented motive, the Respondent claims to have a legitimate interest in the Domain Name that is wholly independent of the Complainant.

Finally, according to the Respondent, the Respondent's actions show no evidence of bad faith in the registration or use of the Domain Name. At the time of registration of the Domain Name, the Respondent had no intention to trade on the Complainant's reputation, nor to confuse or mislead Internet users. Also, according to the Respondent, the passive holding of a domain name in itself does not constitute bad faith.

## **6. Discussion and Findings**

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

- i. the Domain Name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights;
- 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.

Only if all three elements have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. The Panel will deal with each of the requirements in turn.

### **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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. Also, the gTLD, here ".app", is generally disregarded under the first element, but may be relevant under the second and third element.

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 entirety of the Trademarks is reproduced within the Domain Name. Accordingly, the Domain Name is identical to the Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

The Complainant has substantiated that none of the circumstances of paragraph 4(c) of the Policy apply to the present case. 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 Domain Name. In the Response and the Supplemental Response, the Respondent has not come forward with any substantive evidence, other than statements of the Respondent itself, that could demonstrate rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

This is not altered by the fact that the Respondent claims legitimate interests in the Domain Name on the basis of the allegedly, and unsubstantiated neutral, noncommercial motivation for registration of the Domain Name or different potential meanings of the Domain Name.

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 Complainant's globally famous Trademarks had been registered well before the registration of the Domain Name. Based on the record before it, the Panel finds that the Trademarks enjoy a

strong reputation worldwide. The reputation of the Trademarks of the Complainant has been confirmed by earlier UDRP panels (see e.g., *International Business Machines Corporation v. Jian Liu*, WIPO Case No. [D2021-0248](#); *International Business Machines Corporation v. Sadaqat Khan*, WIPO Case No. [D2018-2476](#); *International Business Machines v. Niculescu Aron Razvan Nicolae*, WIPO Case No. [DRO2010-0003](#)). In light of the reputation of the Complainant and its Trademarks, the Panel finds that it is not conceivable that the Respondent chose the Domain Name without knowledge of the Complainant's activities and its Trademarks under which the Complainant is doing business.

Section 3.1.4 of the [WIPO Overview 3.0](#) states that “mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith”. In this case, the Domain Name incorporates the Complainant's Trademarks with a reputation which creates a presumption of bad faith. This presumption has not been substantively rebutted by the Respondent in the Response or the Supplemental Response. This is further reinforced by the fact that the gTLD “.app” of the Domain Name is generally understood in the meaning of “application” in the field of computers. Even though the gTLD is not decisive for a finding of bad faith, this may lead Internet users to mistakenly believe that they are visiting a legitimate website of the Complainant, who is active in the field of computer-related goods and services.

Panels have further found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes reputation of the Complainant's Trademarks, and the composition of the Domain Name which is identical to the Trademarks, and finds that in the circumstances of this case the passive holding of the Domain Name does not prevent a finding of bad faith under the Policy.

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 Domain Name <ibm.app> be transferred to the Complainant.

/Gregor Vos/

**Gregor Vos**

Sole Panelist

Date: January 16, 2025