

ADMINISTRATIVE PANEL DECISION

Kyndryl, Inc. v. Hubert Kohler
Case No. D2022-4488

1. The Parties

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

The Respondent is Hubert Kohler, Germany.

2. The Domain Names and Registrar

The disputed domain names <kyndryl.global>, <kyndryl.group>, and <kyndryl.network> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 24, 2022. On November 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 24, 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 November 30, 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 December 1, 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 December 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent filed an online submission on December 21, 2022. The proceeding was suspended on December 24, 2022. The Complainant and the Respondent each submitted a supplemental filing on January 10, 2023. The proceeding was reinstituted on January 12, 2023, and the Response due date was recalculated as January

17, 2023. The Center received an email communication from the Respondent on January 18, 2023. The Center notified the commencement of Panel appointment process on January 19, 2023.

The Center appointed Andrea Mondini as the sole panelist in this matter on January 24, 2023. 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 belongs to a United States group operating under the name Kyndryl Holdings Inc. The Complainant was IBM's former Global Technology Services infrastructure services business. It is now traded on the New York Stock Exchange and employs more than 88,000 people in 63 countries, and is one of the largest IT service providers in the world.

The Complainant owns numerous trademark registrations for the mark KYNDRYL, *inter alia*, in Mauritius (Registration No. 30047/2021 of March 1, 2021) and in France (Registration No. 4754262 of April 12, 2021).

The Complainant also holds several domain names, including the domain name <kyndryl.com>.

The disputed domain names were registered on April 12, 2021.

The disputed domain names resolve to a pay-per-click advertising site with links directing to websites operated by competitors of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends as follows:

The Complainant's first registration for the mark KYNDRYL predates the registration of the disputed domain names by 42 days. The disputed domain names are confusingly similar to the KYNDRYL trademark in which the Complainant has rights, because they incorporate this trademark in its entirety, and the addition of the Top-Level Domain ("TLD") is required for technical reasons and can be ignored for the purposes of assessing confusing similarity.

The Respondent is not commonly known by the name "Kyndryl" and has no rights or legitimate interests in respect of the disputed domain names. The mark KYNDRYL is highly distinctive. The Respondent has not been authorized by the Complainant to use this trademark and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain names in connection with a *bona fide* offering of goods and services.

The disputed domain names were registered and are being used in bad faith because they were registered on the same date the Complainant's name, "Kyndryl", was publicly announced, and because the Respondent intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's highly distinctive KYNDRYL mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website

On January 10, 2023, the Complainant submitted a supplemental filing stating that the Respondent listed two of the disputed domain names for sale on a domain name marketplace after the filing of the Complaint.

B. Respondent

With regard to the language of the proceedings, the Respondent contended that his native language is German and requested that the communication be continued in German.

On the substance, the Respondent literally contends as follows:

“On 08 October 2020, IBM announced its intention to spin off its outsourcing businesses. The name of the new company ‘Kyndryl’ had not yet been announced at that time and was referred to as ‘NewCo’ until the final announcement. On April 12, 2021, the name ‘Kyndryl’ was announced in the press. The registration of the domain ‘kyndryl.com’ was completed on 26 February 2021, as a further domain the registration of ‘kyndryl.ch’ was made on 6 April 2021. The registration of the domains that are the subject of this complaint has not yet been registered, nor has a request been made to the respondent for transfer, although kyndryl.global (representing the other domains in this case) has all the necessary contact details of the are publicly available to defendants (see Annex 1). It must therefore be assumed that Kyndryl was not and does not have any interest in registering this domain. For comparison, the company IBM, from which the spin-off originated, had registered the domain ‘ibm.global’ on 11 June 2015 via the company IONOS. For a company of a considerable size, domain management is an essential part of being able to present itself digitally in business. The respondent could and can therefore assume that the registration of the disputed domains, in particular ‘kyndryl.global’, had no technical, political or business relevance for the complainant, otherwise they would have been registered before the name was announced. At no time were trademark rights infringed by the respondent. The disputed domains were never used for business or other purposes. The connected websites when the disputed domains are accessed were created by GoDaddy and are obviously used to advertise websites. The control of these websites, outside the respondent's sphere of influence, lies exclusively with Godaddy. The respondent expressly acknowledges the trademark rights of the complainant. The respondent never intended to infringe existing trademark rights. The disputed domains have so far been parked exclusively at the registrar Godaddy. The motivation for registering the disputed domains lies in long-term, later use. At the time of registration, the respondent assumed that the complainant would give up the trademark rights after a certain period of time and that these would be available after a detailed legal examination. The registration of the disputed domain names must therefore be regarded as an investment for the future of a new business model. The naming of the disputed domain consisted of the following terms: The plaintext name is ‘Kubernetes Drill’ and is intended to describe an IT service that creates, analyzes and operates IT container technology services. The derivation to kyndryl is easy to understand: ‘Kubernetes’ = ‘Kybernetes’ = > abbreviation ‘Kyn’. ‘Drill’ => ‘dryl’ The respondent emphasizes that he will not or has not infringed trademark rights. The use of the disputed domains will only take place after thorough legal examination and after deletion of the existing trademark rights of the names within the disputed domains.”

On January 10, 2023, the Respondent submitted a supplemental filing confirming that two of the three disputed domain names had been listed for sale, but rejecting all other accusations by the Complainant.

6. Discussion and Findings

6.1. Language of the Proceeding

In the present case, English is the language of the registration agreements. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.

Paragraph 10 of the Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

The Complainant filed the Complaint in English. The Respondent filed his submissions in English but requested that the communication be continued in German.

Considering that English is the language of the registration agreement, that the Respondent used a Registrar located in the United States and that the Respondent filed his submissions in English, the Panel determines that the language of the proceeding is English.

6.2 Substantive Issues

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the 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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trademark registrations for its KYNDRYL trademark.

The Panel notes that the disputed domain names incorporate the KYNDRYL trademark in its entirety. The addition of the TLDs “.global”, “.group”, and “.network” in the disputed domain names is a standard registration requirement and as such is disregarded under the confusing similarity test under Policy, paragraph 4(a)(i). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.11.

For these reasons, the Panel concludes that the disputed domain names are identical to the Complainant’s mark KYNDRYL.

The first element of paragraph 4(a) of the Policy has been met.

B. Rights or Legitimate Interests

The Complainant states that the Respondent is not commonly known by the name “Kyndryl”, that the Complainant has not authorized the Respondent to use the trademark KYNDRYL, and that before notice of the dispute, there is no evidence of the Respondent’s use, or demonstrable preparation to use, the disputed domain names in connection with a *bona fide* offering of goods or services.

The Respondent’s allegations that at the time of registration it “assumed that the Complainant would give up the trademark rights after a certain period of time”, obviously do not demonstrate any rights or legitimate interests of the Respondent in the disputed domain names. Nor do the Respondent’s explanations that the disputed domain names consist of a combination of “kybernetes” and “drill” and that their registration is “to be regarded as an investment for the future of a new business model” suffice to demonstrate any rights or legitimate interests of the Respondent, because before notice of the dispute, there is no evidence of the Respondent’s use, or demonstrable preparation to use, the disputed domain names in connection with a *bona fide* offering of goods or services. Moreover, following notice of the Complaint, the Respondent has offered two of the disputed domain names for sale, rather than offer any evidence of its preparations to use the disputed domain names. Accordingly, the Respondent’s alleged explanation seems more likely than not a pretext for the profit-driven intent of registering the disputed domain names identical to the Complainant’s trademark and hosting sponsored links at the disputed domain names or reselling them.

In the view of the Panel, the Complainant has thus succeeded in raising a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. For its part, the Respondent failed to provide convincing explanations as to any rights or legitimate interests. Therefore, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain names.

The second element of paragraph 4(a) of the Policy has been met.

C. Registered and Used in Bad Faith

The Complainant has shown to the satisfaction of the Panel that its KYNDRYL trademark is distinctive. The Complainant has also demonstrated that the disputed domain names were registered on the same date the Complainant's name, "Kyndryl", was publicly announced. In the view of the Panel, it is therefore inconceivable that the Respondent could have registered the disputed domain names without knowledge of the Complainant's trademark. Rather, it would seem the Respondent intentionally sought to target the Complainant's nascent (as of then unregistered) rights in the trademark. In the circumstances of this case, this is evidence of registration in bad faith.

The Respondent argues that when registering the disputed domain names he had assumed that the Complainant had no interest in registering these domain names because the Complainant had already registered <kyndryl.com> but not the disputed domain names. However, the fact that the Complainant had not registered the disputed domain names did not allow the Respondent to assume that he would be entitled to register the disputed domain names although they incorporate the Complainant's trademark in its entirety.

The disputed domain names resolve to a pay-per-click advertising site with links directing to websites operated by competitors of the Complainant. The Panel thus finds that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion as to the source, sponsorship or affiliation of its website in the sense of paragraph 4(b) (iiv) of the Policy.

The Panel thus finds that the disputed domain names were registered and are being used in bad faith.

The third element of paragraph 4(a) of the Policy has been met.

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, <kyndryl.global>, <kyndryl.group>, and <kyndryl.network> be transferred to the Complainant.

/Andrea Mondini/

Andrea Mondini

Sole Panelist

Date: February 7, 2023