

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Jan Everno
Case No. D2023-0778

1. The Parties

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

The Respondent is Jan Everno, United States.

2. The Domain Name and Registrar

The disputed domain name <ibmbpnetwork.com> (the “Domain Name”) is registered with Riptide Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2023. On February 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name that differed from the named Respondent (John Doe / Perfect Privacy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 27, 2023, 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 March 1, 2023.

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 March 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2023. The Respondent did not submit a response. Accordingly, the Center notified the Respondent’s default on March 23, 2023.

The Center appointed A. Justin Ourso III as the Panelist in this matter on March 29, 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, a publicly-held American corporation, among the largest in the United States and the world, has been a leading innovator since 1924 in the design and manufacture of business machines, computing, and communications products, including hardware, software, and accessories, under its IBM trademarks and related marks, with a worldwide reputation.

The Complainant owns a United States trademark registration issued on January 29, 1957, No. 640,606, for its IBM mark in Class 9 for magnetic recording tape; another United States registration issued on February 15, 1977, No. 1,058,803, for its in Class 9 for data processing machines and other business machine and computer products, and for numerous other products and services in other classes; and other United States registrations. The Complainant also owns a United Registration issued on December 19, 2017, No. 5,357,173, for its figurative mark, IBM BUSINESS PARTNER + design, in Class 9 for computer hardware products, in Class 35 for business consulting and related services, and in Class 42 for computer consultation and related services, as well as registrations for this mark in France, Australia, and other countries around the world.

The Respondent registered the Domain Name on July 4, 2022, through a privacy service, without any authorization from the Complainant. The Domain Name does not resolve to a functioning web site. At the time of filing, the Respondent had configured mail exchanger (“MX”) records for the Domain Name, which were active.¹ Complainants have filed fifteen prior complaints under the Policy against the Respondent with the Center, in all of which, except for one, panels have transferred the domain name to the complainant.

5. Parties’ Contentions

A. Complainant

In addition to facts set forth in the Factual Background in Part 4 above, the Complainant contends the following.

Regarding the element of confusing similarity with a trademark in which it has rights, the Complainant contends that the Domain Name is confusingly similar to its world-famous trademark IBM, in which it has longstanding rights, because the Domain Name contains the trademark in its entirety, and the addition of the letters “bp,” which could reasonably be understood as an abbreviation of “business partner,” and the descriptive word “network,” do not dispel the confusing similarity, but enhance it.

Regarding the element of no rights or legitimate interests in the Domain Name, the Complainant contends that it has not authorized the Respondent to register the Domain Name; no evidence exists that the Respondent is using the Domain Name, or has made preparations to use it, for a *bona fide* offering of goods or services; no evidence exists of any legitimate noncommercial or fair use of the Domain Name; the Respondent is passively holding the Domain Name, which does not resolve to a website; the Respondent has configured the Domain Name for email communications for deceptive purposes; consumers will be deceived into believing that the Complainant is affiliated with the Respondent or endorses the Respondent, when no relationship exists between them; and the Respondent has not been commonly known by the Domain Name.

¹ An MX record is a resource in the Domain Name System that specifies the mail server(s) responsible for receiving email messages for a domain name. An active MX record enables the owner of a domain name to use it for email and email addresses. It is not necessary to assign MX records to a domain name if a registrant does not intend to use the domain name for email.

Regarding the element of bad faith registration and use of the Domain Name, among other contentions, the Complainant contends that the registration of a domain name that is confusingly similar to a famous or well-known trademark is presumptively in bad faith; registration of the Domain Name over sixty years after the Complainant established rights in the mark is proof of bad faith at the time of registration; the Respondent concealed its identity and contact information by using a privacy service; the Respondent knew or should have known of the Complainant's mark, or exercised willful blindness, when it registered the Domain Name; the Respondent failed to respond to its demand letters; the Respondent is passively holding the Domain Name, which does not resolve to an active website, but has configured MX records for the Domain Name, suggesting an intention to use the Domain Name for illegal purposes, such as phishing; the IP address for the Domain Name is linked to the dissemination of malware; the Respondent is using the Domain Name for dynamic redirection to third-party websites associated with malware and viruses; these uses are not a *bona fide* offering of goods or services or a legitimate noncommercial use; it is implausible that the Domain Name might be put to any good faith use; and, for all these reasons, the Respondent registered and is using the Domain Name in bad faith.

The Complainant requested transfer of the Domain Name.

B. Respondent

The Respondent did not submit a response to the Complaint.

6. Discussion and Findings

A. The Effect of the Respondent's Default

If a respondent does not submit a response to a complaint, a panel decides the dispute based upon the complaint. Rules, paragraphs 5(f) and 14(a). Because the Complainant has the burden of proof, Policy, paragraph 4(a), the Complainant must still prove the elements of a claim to obtain the requested relief, notwithstanding the Respondent's default. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

In the absence of exceptional circumstances, a respondent's failure to respond to a complaint requires that a panel draw the inferences from this failure that it considers proper. Rules, paragraph 14(b). The Panel finds that no exceptional circumstances exist for the failure of the Respondent to submit a response. Accordingly, the Panel infers that the Respondent does not deny the facts alleged and the contentions urged by the Complainant based upon these facts and will draw all reasonable inferences that are proper from the evidence and the facts found by the Panel. *Id.*

Although the Panel may draw negative inferences from the Respondent's default, the Complainant may not rely on conclusory allegations and must support its allegations with evidence to prove the three elements. *Id.*

B. Elements of a Claim

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a).

(i). Identical or Confusingly Similar

On the first element, the Complainant must prove that (1) it has rights in a trademark, and (2) the Domain Name is identical or confusingly similar to this trademark. Policy, paragraph 4(a)(i).

The Panel finds that the Domain Name is confusingly similar to the Complainant's IBM trademark, in which it has longstanding rights. The Domain Name incorporates the entire trademark, and the trademark is readily recognizable within the Domain Name, notwithstanding the addition of the letters "bp" and the word "network." [WIPO Overview 3.0](#), sections 1.7 and 1.8.

Accordingly, the Panel concludes that the Complainant has proven the first element: the Domain Name is confusingly similar to a trademark in which it has rights.

(ii). Rights or Legitimate Interests

The Respondent has not claimed the existence of any circumstance under the Policy, paragraph 4(c), that demonstrates that a respondent has rights to, or legitimate interests in, a domain name. The Complainant, on the other hand, has made *prima facie* a showing that the Respondent lacks any rights or legitimate interests in the Domain Name under the Policy, paragraph 4(a)(ii), shifting the burden of production on this second element to the Respondent to come forward with relevant evidence proving rights or legitimate interests in the domain name. [WIPO Overview 3.0](#), section 2.1. The Respondent has not submitted any evidence to rebut the *prima facie* showing.

Additionally, the Panel finds that the Complainant's trademark rights precede the registration of the Domain Name; the Registrar identified the Respondent as "Jan Everno" and provided an email address for the Respondent of janeverno@[. . .], neither of which resemble the Domain Name, and which corroborate that the Respondent is not known by the Domain Name; the Domain Name does not, at the time of this Decision, resolve to a functioning web site on which the Respondent is conducting a business, thereby providing no evidence of a *bona fide* commercial, noncommercial, or fair use of the Domain Name; and no evidence exists of a *bona fide* commercial, noncommercial, or fair use of the Domain Name.

Accordingly, the Panel concludes that the Complainant has proven the second element: the Respondent lacks rights or legitimate interests in the Domain Name.

The Complainant has also alleged, in support of its contention that the Respondent lacks rights or legitimate interests in the Domain Name, that the Respondent has configured MX records for the Domain Name, suggesting an intention to use the Domain Name for illegal purposes, such as phishing; the IP address for the Domain Name is linked to the dissemination of malware; the Respondent is using the Domain Name for dynamic redirection to third-party websites associated with malware and viruses. The use of a domain name for illegal purposes cannot confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13. Because the Panel has already concluded that the Complainant has proven the second element, the Panel will defer a discussion of these contentions to Part 6(B)(iii) below. Cf. [WIPO Overview 3.0](#), section 2.15.

(iii). Registered and Used in Bad Faith

"[T]he mere registration of a domain name that is identical or confusingly similar . . . 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 Respondent has not rebutted this presumption. Because of its fame, the Panel finds that the Respondent was aware of the Complainant's trademark when the Respondent registered the Domain Name and chose the Domain Name deliberately.

The Complainant has alleged that the IP address for the Domain Name is linked to the dissemination of malware and botnet command and control servers. The report submitted as evidence of these allegations does not support them. Under the heading "malware," the report states "None found." Without explanation, the reference in the report to "botnet command and control server," is not helpful and does not sufficiently support a favorable finding on this allegation.

The Complainant has also alleged that the Respondent is using the Domain Name for dynamic redirection to third-party websites associated with malware and viruses. Because the Domain Name does not resolve to a

functioning site and because browsers notify visitors attempting to access the site that access is blocked because it falls in the category of “spyware/malicious sites” or that “The connection for this site is not secure,” the Panel finds that the Respondent is using the site for deceptive purposes and that this is detrimental to the reputation of the Complainant and its trademark. Additionally, “redirecting a domain name . . . can establish bad faith insofar as the respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant.” [WIPO Overview 3.0](#), section 3.1.4.

The Complainant has also alleged that the Respondent is passively holding the Domain Name, which does not resolve to an active website, but has configured MX records for the Domain Name, suggesting an intention to use the Domain Name for illegal purposes, such as phishing. Panels have consistently found that “given that the use of a domain name for per se illegitimate activity such as [...] phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith.” [WIPO Overview 3.0](#), sections 3.1.4.

The record in this case contains no evidence of phishing, but the configuration of MX records presents the potential for an email phishing scheme impersonating the Complainant. It is common knowledge that owners of websites customarily use email addresses containing the domain name of a web site in electronic mail communications. The use of a domain name that is confusingly similar to a trademark in emails that do not originate with the trademark owner presents a risk to the reputation of a trademark and its owner. The Respondent has not rebutted that it engages in this practice, which is noteworthy given the configuration of MX records for the Domain Name. Moreover, with evidence of dynamic redirection to unsafe websites, the risk of other deceptive conduct, such as deceptive or abusive emails, is real and continuing, supporting the Panel’s finding of bad faith registration and use.

After the Complainant’s second demand letter, the Registrar responded that the Respondent had moved the Domain Name to another hosting provider, presumably to evade deactivation, which is further evidence supporting the Panel’s finding of bad faith registration and use.

The Panel also finds that the Respondent registered the Domain Name through a privacy service; gave a false address; did not respond to two demand letters; and failed even to attempt to rebut any of the allegations, all of which is evidence supporting the Panel’s findings that the Respondent was aware of the Complainant’s trademark when it registered the Domain Name and chose the Domain Name deliberately.

The findings set forth above support the Panel’s conclusion that the Respondent (1) intentionally registered the Domain Name in bad faith and (2) is using it in bad faith, taking unfair advantage of the Complainant’s trademark. [WIPO Overview 3.0](#), sections 3.1, 3.1.4, and 3.4.

Accordingly, the Panel concludes that the Complainant has proven the third element: the Respondent registered and is using the Domain Name in bad faith.

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, <ibmbpnetwork.com>, be transferred to the Complainant.

/A. Justin Ourso III

A. Justin Ourso III

Panelist

Date: April 12, 2023