

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Jung Bong-Jo
Case No. D2024-4775

1. The Parties

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

The Respondent is Jung Bong-Jo, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <ibm-pc.com> is registered with Gabia, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on November 19, 2024. On November 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 22, 2024, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 26, 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 the first amendment to the Complaint in English on November 26, 2024 and the final amendment to the Complaint in English on January 9, 2025.

On November 26, 2024, the Center informed the Parties in Korean and English, that the language of the Registration Agreement for the disputed domain name is Korean. On December 27, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

The Center verified that the Complaint together with the amendments 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 in English and Korean of the Complaint, and the proceedings commenced on January 14, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 3, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 7, 2025.

The Center appointed Ik-Hyun Seo as the sole panelist in this matter on February 17, 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 technology company which offers a wide array of products that record, process, communicate, store and retrieve information, including computers and computer hardware, software, and accessories under the trademark IBM since 1924. The Complainant has received recognition for the strength of its IBM trademark, among them, the 16th most valuable global brand by BrandZ and the 19th best global brand by Interbrand in 2024. The Complainant owns a number of trademark registrations for the IBM trademark, including the following:

- International Trademark Registration Number 1556374 registered on July 21, 2020, designating various jurisdictions including the Republic of Korea;
- United States Trademark Registration Number 1,243,930, registered on June 28, 1983; and
- United States Trademark Registration Number 1,696,454, registered on June 23, 1993.

The Respondent appears to be an individual with an address in the Republic of Korea.

The disputed domain name was registered on May 3, 2001. As of the filing of the Complaint, the disputed domain name did not resolve to any active website, and at one point, the disputed domain name resolved to a webpage displaying a "This Site is under construction" notice.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the marks in which the Complainant has rights since the disputed domain name consists of the letters "ibm" which is identical to the Complainant's mark, followed by a dash and then letters "pc" which is an abbreviation for "personal computer" which is the product closely associated with the Complainant.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. The Complainant further contends that there is no evidence of the Respondent's use of, or demonstrable preparations to use the disputed domain name in providing any bona fide offering of goods or services, nor any evidence that the Respondent has been commonly known by the disputed domain name, or legitimate noncommercial or fair use of the disputed domain name by the Respondent.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant contends that there is a presumption of bad faith created solely through the registration of the disputed domain name that is identical or confusingly similar to the Complainant's famous IBM trademark. The Complainant also contends that given the fame of the IBM marks, the Respondent was surely well aware of the marks at the time of registration of the disputed domain name. The Complainant

further contends that the Complainant sent a cease and desist letter to the Respondent which went unanswered, which is further evidence of the Respondent's bad faith. Lastly, the Complainant contends that the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding, and contends that bad faith is established based on the fame and distinctiveness of the IBM mark, the Respondent's failure to respond to the Complaint or provide any evidence of good faith use, the Respondent's concealment of its identity through the use of a privacy service, and the lack of any conceivable good faith use which the Respondent may have for the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Korean. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is a company based in the United States and does not know Korean, and submitting the Complaint in Korean would create an undue burden and delay, as well significant expense in providing a translation of the Complaint.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1). Here, both Parties were given the opportunity to submit arguments in the language of their preference, and the Respondent neither raised an objection as to the language of the proceeding nor submitted any arguments whatsoever in these proceedings.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is 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, “-pc” – may bear on assessment of the second and third elements, the Panel finds the addition of such term 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 name. 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 name such as those enumerated in the Policy or otherwise.

Moreover, “UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.” [WIPO Overview 3.0](#), section 2.5.1. Here, the additional term “pc” suggests sponsorship or endorsement by the Complainant whose business is closely connected with personal computers.

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 notes that the disputed domain name is composed of the Complainant’s famous IBM trademark and the term “pc” refers to the very product of the Complainant. Given the fame of the Complainant and its trademark, the composition of the disputed domain name cannot have been mere coincidence.

The disputed domain name does not resolve to any active website. Panels have found that the non-use of a domain name (including a blank or “coming soon” 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 the distinctiveness or reputation of the Complainant’s trademark, the composition of the disputed domain name, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, the Respondent’s use of false or incomplete contact details, and the implausibility of any good faith use to which the disputed domain name may be put, and finds that in the

circumstances of this case the passive holding of the disputed 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 disputed domain name <ibm-pc.com> be transferred to the Complainant.

/Ik-Hyun Seo/

Ik-Hyun Seo

Sole Panelist

Date: March 4, 2025