

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Domain Administrator,
NameSilo, LLC
Case No. DCC2023-0019

1. The Parties

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

The Respondent is Domain Administrator, NameSilo, LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <hkibm.cc> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 22, 2023. On December 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 26, 2023, 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 December 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 December 27, 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 December 28, 2023. In accordance with the Rules, paragraph 5, the due

date for Response was January 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 18, 2024.

The Center appointed Andrew J. Park as the sole panelist in this matter on January 23, 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

The Complainant, International Business Machines Corporation, is a renowned American multinational technology corporation, well-established since its inception in 1911 as an amalgamation of three previously existing companies. It registered the trademark IBM in 1924 and has consistently provided high-quality products and services in over 175 countries under this mark. The Complainant's diverse range of products include computers, computer hardware, software, and accessories for recording, processing, communicating, storing, and retrieving information. As one of the world's largest industrial research organizations, the Complainant has established an exceptional reputation, and its globally recognized IBM trademarks have become valuable assets for the company.

With a network of 19 research facilities spanning multiple countries, the Complainant has diligently delivered superior goods and services to a broad customer base. Furthermore, the Complainant has achieved the remarkable feat of holding the record for the highest number with innovations in artificial intelligence, hybrid cloud, quantum computing and cyber-security of annual U.S. patents generated by a business for an impressive 29 consecutive years, from 1993 to 2021. Over the course of several decades, the Complainant has obtained and maintained trademark registrations for the mark IBM in 131 countries worldwide, covering a wide range of goods and services, particularly in the domain of information technology and related fields.

The Complainant has trademark registrations for IBM in numerous countries, including the following subsisting United States and Australian registrations:

United States Trademark Registrations		Australian Trademark Registrations	
Registration Number	International Class	Registration Number	International Class
4181289	9, 16, 18, 20, 21, 22, 25, 28, 35, and 41	158109	9
3002164	9	213400	16
1696454	36	326639	35
1694814	36	326640	37
1243930	42	326641	41
1205090	1, 9, 16, 37 and 41	326642	42

The disputed domain name <hkibm.cc> was registered on June 26, 2023 which resolved to a pay-per-click parking page with advertisement links referencing technology-related products. According to the International Organization for Standardization ("ISO"), the country code Top-Level Domain ("ccTLD") ".cc" is Cocos (Keeling) Islands.

The Complainant sent cease-and-desist letters several times to the Respondent, and the Respondent did not respond.

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 because:

(a) The disputed domain name is identical or confusingly similar to the Complainant's trademark IBM in which the Complainant has rights and the Complainant relies on the extensive range of registered trademarks for IBM. The Complainant owns registrations for the trademark IBM in many jurisdictions and has a strong reputation in the United States, where the Respondent is located, and also in Australia.

The Complainant contends that the disputed domain name incorporates the Complainant's trademark IBM in its entirety, together with the addition of the letters "hk" which are recognized and understood by the ISO and consumers as the country code for Hong Kong, China. Since the Complainant operates and maintains office space in Hong Kong, China, the inclusion of the letters "hk" is descriptive as an indication of the origin, which adds to the confusion as to the relationship between the Complainant and the Respondent and would not prevent a finding of confusing similarity and identity with the Complainant's trademark and the disputed domain name, rather it reinforces the risk of confusion.

Furthermore, the addition of the ccTLD ".cc" in the disputed domain name does not obviate the confusing similarity between the Complainant's trademark and the disputed domain name since the Complainant's trademark is clearly predominant in the disputed domain name. Thus, the Respondent's use of the Complainant's trademark in the disputed domain name leads the public to believe that the disputed domain name still belongs to the Complainant.

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant contends that it has never licensed, contracted, or otherwise permitted the Respondent to apply to register the disputed domain name. The Complainant also insists that (i) there is no evidence that "IBM" is the name of the Respondent's corporate entity, nor is there any evidence of fair use of the disputed domain name by the Respondent; (ii) there is no evidence of any Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with any bona fide offering of goods or services; (iii) there is no evidence that the Respondent has been commonly known by the disputed domain name; and (iv) there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name. Furthermore, the Complainant confirmed that the Respondent has been actively using the Complainant's IBM trademark in the disputed domain name to derive illegitimate commercial gain in a multitude of illegitimate ways, which can never confer rights or legitimate interests on the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent must have had actual knowledge of the Complainant, its trademark, and business activities when it registered the disputed domain name because the Complainant's trademark is well known around the world and the Respondent incorporated the Complainant's trademark IBM in its entirety.

The Complainant also claims that the Respondent is using the disputed domain name in bad faith. The Respondent registered and has been using the disputed domain name with the aim of taking advantage of the reputation and goodwill of the Complainant's well-known IBM trademark and creating confusion between the disputed domain name and the Complainant's trademark, which can be clearly evidenced by the Respondent's infringing and counterfeit use of the IBM mark in the disputed domain name that leads to a pay-per-click parking page with advertisement links referencing technology related products.

Also, the Complainant claims that the Respondent has been intentionally misusing the disputed domain name by redirecting Internet users who visited the website to which the disputed domain name resolved to another website that creates a cybersecurity threat to users' computer systems through the distribution of malware, a software designed to disrupt, damage or gain unauthorized access to computer systems or networks for nefarious or criminal use. Furthermore, the IP address associated with the disputed domain name is linked to the botnet command and control servers which is a network of infected devices centrally controlled by a single source that has the capacity to carry out coordinated cyberattacks.

The Respondent's use of the disputed domain name in this manner is per se illegal and the use of disputed domain name to conduct illegal activities can never confer rights or legitimate interests on the Respondent and therefore such use is manifestly considered evidence of bad faith. These are clear indications of bad faith and the purpose of the Respondent in registering the disputed domain name was definitely to mislead, confuse and divert consumers or to tarnish the Complainant's well-known IBM trademark and thereby illegitimately capitalizing on the Complainant's name and reputation.

Lastly, the Complainant sent cease-and-desist letters to the Respondent several times and the Respondent did not respond.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the IBM trademark and that the disputed domain name is confusingly similar to the Complainant's trademark. The disputed domain name incorporates the Complainant's trademark in its entirety. Further, the mere addition of "hk" does not prevent a finding of confusing similarity with the Complainant's trademark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, the ccTLD ".cc" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a prima facie case is made, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

Here, the Panel finds that the Complainant has made out a prima facie case.

The Complainant has asserted that the Respondent has no relationship with or authorization from the Complainant to use its trademarks. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name.

The Respondent was deliberately engaged in conduct intended to cause confusion by directing the disputed domain name to a pay-per-click parking page featuring advertisements links that references technology-related products which are related to those of the Complainant. In addition, based on the undisputed evidence provided by the Complainant, the IP address associated with the disputed domain name is linked to the dissemination of malware, anonymization services, and the botnet command and control servers. This possible distribution of malicious software may be further evidence of the Respondent's bad faith.

All of these facts demonstrate that the Respondent has never had an intention to use the disputed domain name in connection with a bona fide offering of goods and/or services. The Respondent's use of the disputed domain name does qualify as a bona fide offering of goods or services, nor could any rights or legitimate interests be attributed to the Respondent.

These facts may be taken as true in the circumstances of this case and in view of the use of the disputed domain name. The Panel is unable to find any reasonable basis upon which the Respondent could be said to have any rights or legitimate interests in respect of the disputed domain name, and the Respondent has not filed a Response.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark, or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent has violated the Policy, paragraph 4(b)(iv) by registering the disputed domain name in order to attempt to attract, for commercial gain, Internet users to the Respondent's website which the disputed domain name resolves to by creating a likelihood of confusion with the Complainant's trademark.

As stated previously, the Respondent did not file any response to the Complaint, failing thereby to rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain name.

Nevertheless, the Panel still has the responsibility of determining which of the Complainant's assertions are established as facts and whether the conclusions asserted by the Complainant can be drawn from the established facts (see *Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

First, the Panel finds the Respondent intentionally registered the disputed domain name in bad faith. The Respondent registered the disputed domain name, which is confusingly similar to the Complainant's trademark, IBM. The Complainant has been engaged in commercial operations under this designation since 1924 and since 1925, the Complainant has consistently used its registered trademark IBM as a unique identifier for the purpose of distinguishing its goods and services. The Complainant's business history reveals the extensive global recognition of its registered IBM mark and the registration of the Complainant's trademark well predates the Respondent's registration of the disputed domain name, all of which demonstrates that the Respondent had full knowledge of the Complainant's trademark and its reputation when the Respondent registered the disputed domain name and tried to show that there was a business relationship between the disputed domain name and the Complainant to benefit from the likelihood of confusion with the Complainant's trademark.

Secondly, the Panel finds that the Respondent has been using the disputed domain name in bad faith. The Respondent intentionally engaged in activities intended to deceive and cause confusion between the disputed domain name and the Complainant by associating the disputed domain name with a pay-per-click parking page containing advertisements links related to the Complainant's technology-related products. Accordingly, the evidence shows that the Respondent knew of and had sought to take unfair advantage of the confusing similarity between the disputed domain name and the Complainant's trademarks for commercial gain. Such conduct described above falls squarely within paragraph 4(b)(iv) of the Policy. Therefore, the Respondent registered and is using the disputed domain name in bad faith.

Furthermore, based on the undisputed evidence provided by the Complainant, the IP address associated with the disputed domain name is linked to dissemination of malware, anonymization services, and the botnet command and control servers. This unlawful action aimed to possibly expose Internet users to malware, posing a significant cybersecurity threat. The Respondent's possible dissemination of malicious software, coupled with the use of anonymization services and connection to botnet command and control servers may further demonstrate the Respondent's use of the disputed domain name in bad faith. Panels have held that the use of the disputed domain name by the Respondent for illegal activities such as phishing, distributing malware, and cybersecurity threats constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. Therefore, the Complainant has established the third element under the Policy, paragraph 4(a)(iii).

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 <hkibm.cc> be transferred to the Complainant.

/Andrew J. Park/

Andrew J. Park

Sole Panelist

Date: February 7, 2024