WIPO
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ADMINISTRATIVE PANEL DECISION
International Business Machines Corporation v. Carolina Rodrigues, Fundacion Comercio Electronico
Case No. DCO2023-0014

1. The Parties

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <ibmclassic.co> (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 February 10, 2023. On February 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 14, 2023, 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 February 17, 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 February 28, 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 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 3, 2023.

The Center appointed Jeremy Speres as the sole panelist in this matter on April 6, 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 is a leading global manufacturer of computer hardware, software and IT services which has been trading under the IBM mark for almost 100 years. The global fame of the Complainant's mark cannot sensibly be contested, and the Panel takes judicial notice of it (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") at section 4.8; *Société des Produits Nestlé S.A. v. Sonia de Ferrero*, WIPO Case No. D2016-1300).

The Complainant owns trade mark registrations for its IBM mark in many jurisdictions, including United States trade mark registration no. 1,694,814 IBM in class 36 with registration date June 16, 1992.

The Domain Name was registered on July 15, 2022 and currently does not resolve to an active website. The Complainant's evidence establishes that the Domain Name previously resolved to a parked page displaying pay-per-click ("PPC") advertising relating to technology products and services relevant to the Complainant's business. The Complainant's evidence also establishes that the Domain Name previously resolved to a website that triggered various security alerts and was associated with IP addresses flagged by security vendors for distribution of malware and botnet administration.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its well-known IBM mark, that the Respondent has no rights or legitimate interests in the Domain Name, and the Domain Name was registered and used in bad faith given that it has been used for PPC advertisements for the Respondent's commercial gain, taking advantage of the Complainant's reputation to attract users, and to distribute malware.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant's registered IBM mark is wholly contained within the Domain Name as its first element with the addition of the dictionary term "classic". Where the trade mark is recognisable within the disputed domain name (as in this case), the addition of other terms (including descriptive terms) does not prevent a finding of confusing similarity (WIPO Overview 3.0 at section 1.8). The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant's mark was registered and well-known for many years prior to registration of the Domain Name. The Domain Name is confusingly similar to the Complainant's mark and the Complainant has certified that the Domain Name is unauthorised by it.

Use of a domain name to host PPC links does not represent a *bona fide* offering where such links compete with or capitalise on the reputation of the complainant's mark, as in this case (WIPO Overview 3.0 at section 2.9). Use of the Domain Name for malicious software also cannot be considered *bona fide*. There is thus no evidence that any of the circumstances set out in paragraph 4(c) of the Policy pertain, nor any others which may confer rights or legitimate interests on the Respondent. The Complainant has satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an unrebutted *prima facie* case (WIPO Overview 3.0 at section 2.1).

C. Registered and Used in Bad Faith

UDRP panels have consistently found that the registration of a domain name that is confusingly similar to a well-known trade mark, for example those incorporating a well-known mark plus a descriptive term as in this case, can by itself create a presumption of bad faith (WIPO Overview 3.0 at sections 3.1.4 and 3.2.1).

The Domain Name has been used to advertise services relating to and competitive with those of the Complainant, which, coupled with the renown of the Complainant's mark, is a clear indicator of targeting for commercial gain under paragraph 4(b)(iv) of the Policy. See *Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service*, WIPO Case No. D2011-1753. Although the advertisements may be served programmatically by a third party, the Respondent cannot disclaim responsibility for them (WIPO Overview 3.0 at section 3.5).

The Panel has independently established that the Domain Name is listed for sale on a prominent domain name marketplace with a minimum offer set at USD 899, which is likely, without evidence from the Respondent to the contrary, in excess of the Respondent's out-of-pocket expenses relating directly to the Domain Name. Thus, paragraph 4(b)(i) of the Policy is also applicable.

The Complainant's evidence shows that the Domain Name has been associated with malicious software. The Panel has also independently established that at least one security vendor has flagged the Domain Name for phishing, which is an indicator of bad faith (*The Commissioners for HM Revenue and Customs v. WhoisGuard Protected, WhoisGuard, Inc. / Hoshyar Marshall*, WIPO Case No. D2021-0344).

The Panel notes that the Respondent is a notorious cybersquatter, having lost hundreds of UDRP cases in circumstances where the *modus operandi* exhibited in this case was identical or highly similar. This case would appear to be a continuation of this pattern.

The Complainant has satisfied paragraph 4(a)(iii) 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, <ibmclassic.co>, be transferred to the Complainant.

/Jeremy Speres/
Jeremy Speres
Sole Panelist
Date: April 20, 2023