

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation (IBM) v. Raja Somasundaram Case No. DCO2024-0001

1. The Parties

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

The Respondent is Raja Somasundaram, India.

2. The Domain Name and Registrar

The disputed domain name <ibmtech.co> is registered with Hosting Concepts B.V. d/b/a Registrar.eu (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 2, 2024. On January 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 4, 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 (Redacted for Privacy, Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 15, 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 an amendment to the Complaint on January 17, 2024.

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 January 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 21, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on February 28, 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 was incorporated in 1911 as an amalgamation of three previously existing companies and became International Business Machines in 1924. According to the Complainant, the Complainant is a leading innovator in the design and manufacture of a wide range of computers, computer hardware, software and accessories and has been offering products under the trademark IBM ever since.

The Complainant is the owner of several trademark registrations for IBM, including the following, as per trademark registration certificates submitted as annexes 4 to the Complaint:

- United States trademark registration No. 1694814 for IBM (word mark), filed on August 31, 1990, and registered on June 16, 1992, in international class 36;
- United States trademark registration No. 1243930 for IBM (word mark), filed on May 10, 1982, and registered on June 28, 1983, in international class 42.
- United States trademark registration No. 1058803 for IBM (word mark), filed on October 29, 1974, and registered on February 15, 1977, in international classes 1, 9, 16, 37, 41, and 42;
- United States trademark registration No. 640606 for IBM (word mark), filed on March 12, 1956, and registered on January 29, 1957, in international class 9;
- United States trademark registration No. 4181289 for IBM (figurative mark), filed on December 21, 2010, and registered on July 31, 2012, in international classes 9, 16, 18, 20, 21, 22, 24, 25, 28, 35, and 41;
- United States trademark registration No. 3002164 for IBM (figurative mark), filed on December 14, 1999, and registered on September 27, 2005, in international class 9;
- United States trademark registration No. 1696454 for IBM (figurative mark), filed on August 30, 1990, and registered on June 23, 1992, in international class 36.

The Complainant is also the owner of the domain name <ibm.com>, which was registered on March 19, 1986, and is used by the Complainant to promote its products and services under the trademark IBM.

The disputed domain name <ibmtech.co> was registered on July 3, 2023, and is pointed to a website displaying a logo “IBM Tech” at the top and the bottom of the homepage and promoting services related to the evaluation of building materials. The website also provides a contact form and reproduces, in the “About” section, the photographs of three models displayed also on several third-party websites, which are used to identify the alleged founders of the entity promoted on the Respondent’s website.

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 <ibmtech.co> is confusingly similar to the trademark IBM in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the generic term “tech” and the country code Top-Level Domain (“ccTLD”) “.co”.

Moreover, the Complainant submits that the nature of the Respondent's business could increase consumer confusion considering the Complainant has a history of providing products and services within the construction industry to improve efficiency, inspections, and communications.

With reference to the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Complainant states that i) it has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain name; ii) the Respondent is not commonly known by the disputed domain name; iii) the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use since the Respondent is misusing the Complainant's trademark IBM in the disputed domain name, has configured Mail Exchange (MX) records on the disputed domain name probably to use it for email communication purposes, and is using an IP address linked to the dissemination of botnet command and control servers and use of anonymization services. The Complainant therefore submits that such use is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while in fact no such relationship or endorsement exists.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering the disputed domain name comprises the world-famous IBM trademark and the descriptive term “tech” (abbreviation of “technology”) that is closely related to the Complainant's technology corporation, there is a presumption of bad faith against the Respondent. The Complainant also states that the Respondent was well aware of the Complainant's trademark as it registered the disputed domain name at least 64 years after the Complainant established registered trademark rights in the IBM mark. The Complainant further submits that Internet search engines yield results for the Complainant and its products and services when using “ibm” as a search term and, therefore, the Respondent either knew or should have known of the Complainant's IBM mark when registering the disputed domain name.

Moreover, the Complainant contends that the Respondent also acted in bad faith since: i) it registered the disputed domain name through a privacy shield, concealing its identity and contact information; ii) acted in opportunistic bad faith at the time of registering the disputed domain name; iii) failed to reply to the Complainant's cease-and-desist letter and to its subsequent follow up letter; iv) it configured the disputed domain name to a mail server responsible for sending and accepting email messages on behalf of the disputed domain name; v) the IP address of the disputed domain name is linked to the dissemination of botnet command and control servers and use of anonymization services.

Furthermore, the Complainant notes that the website to which the disputed domain name resolves does not provide valid contact information for potential clients to reach the owners of the site or inquire about their services but only a contact form, which may simply be a means for collecting personal information in furtherance of the scams linked to their high-risk IP activity. The Complainant further points out that the links to social media accounts provided on the Respondent's website are not attached to, nor do they redirect to, any specific profile owned by the construction company, instead, they redirect to the homepages of the social media. The Complainant also asserts that the Respondent's website provides images of three team members who are allegedly founders of the company operating the website, but who do not appear to exist since a reverse Google Image search provided that the images of the founders are stock photographs of models that are currently being used in several different websites promoting various goods and services.

The Complainant concludes that, based on the nature of the use of the disputed domain name, one could reasonably infer that the Respondent is not a legitimate construction company that is providing legitimate contracting services, and the Respondent is using the IBM trademark in the disputed domain name to create legitimacy and attract Internet users to its website to collect their personal information.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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. Indeed, the Complainant has provided evidence of ownership of valid trademark registrations for IBM (Annex 4 to the Complaint).

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 the term "tech" 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.

In addition, the ccTLD ".co" can be disregarded under the first element confusing similarity test, being a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

Therefore, 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.

According to the evidence on record, there is no relationship between the Complainant and the Respondent, and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name.

Moreover, there is no element from which the Panel could infer the Respondent's right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website displaying a "IBM tech" logo and promoting services related to the evaluation of building materials. The Panel notes that, in view of the contents of the website and the lack of any accurate or prominent disclaimer of non-affiliation with the Complainant, Internet users visiting the Respondent's website may believe that it is operated by the Complainant or one of its affiliated entities, which is not the case here.

Therefore, the Panel finds that the Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Furthermore, the disputed domain name, incorporating the Complainant's trademark IBM in combination with the descriptive term "tech" (abbreviation of "technology"), undoubtedly suggest sponsorship or endorsement by the Complainant. Even where a domain name consists of a trademark plus additional terms, 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.

Therefore, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In view of the prior registration and widespread use of the Complainant's trademark IBM in connection with the Complainant's computers, computer hardware, software and accessories and considering the well-known character of the trademark IBM worldwide, the Panel finds that the Respondent likely knew the Complainant and its trademark at the time of registration of the disputed domain name. The 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.

Moreover, considering the composition of the disputed domain name, combining the trademark IBM with the term "tech" (a shortened form of the word "technology", which is undoubtedly descriptive of the Complainant's field of activity), the Panel finds that the Respondent very likely registered the disputed domain name having the Complainant and its trademark in mind and intended to target the Complainant and its trademark at the time of registration of the disputed domain name.

The Panel further finds that, in view of the use of the disputed domain name in connection with the website described above, publishing a "IBM tech" logo and promoting evaluation services of building materials without providing any accurate information about the website operator nor any disclaimer of non-affiliation with the Complainant, the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source,

sponsorship, affiliation or endorsement of its website and the services promoted therein according to paragraph 4(b)(iv) of the Policy.

The Panel notes that the content of the Respondent's website described above, including the use of stock photographs of models taken from third-party websites (as shown in Annex 9.3 to the Complaint) to depict the founders, the provision of vague information about the services promoted on the website, the lack of reliable contact details and the provision of a contact form requiring Internet users to insert their name and email address, the activation of the MX records, suggest that the Respondent may not be using the disputed domain name to promote a genuine, existing business but, as claimed by the Complainant, may be acting with the intent to obtain personal information, and contacts, from Internet users interested in the services described on the website of the disputed domain name and potentially misled into believing that the "IBM tech" business advertised therein is affiliated with the Complainant's renowned company.

The Panel also finds that the Respondent's failure to reply to the Complainant's cease-and-desist letter and to the Complaint further supports the conclusion that the Respondent acted in bad faith.

Therefore, the Panel finds that the Complainant has also 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 <ibmtech.co> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: March 13, 2024