

ADMINISTRATIVE PANEL DECISION

International Business Machines Corporation v. Domain Manager,
Webviously Inc
Case No. DIO2022-0004

1. The Parties

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

Respondent is Domain Manager, Webviously Inc, US, represented by Dan Brendtro, US.

2. The Domain Name and Registrar

The disputed domain name <ibmpc.io> (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 11, 2022. On February 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .IO Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .IO Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on February 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2022.

Further to Respondent's Request for extension to answer dated March 9, 2022, Respondent was granted the automatic four calendar day extension for response under paragraph 5(b) of the Rules. The Response was filed with the Center on March 14, 2022.

The Center appointed Christopher Gibson, Steven Fox, and Nathalie Dreyfus as panelists in this matter on May 6, 2022. The Panel finds that it was properly constituted. Each member of 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

Complainant has been an innovator in the design and manufacture of a wide array of products that record, process, communicate, store, and retrieve information, including computers and computer hardware, software, and accessories. Incorporated on June 16, 1911, as a combination of three previously existing companies, Complainant officially became International Business Machines on February 14, 1924. Complainant has been offering products under the IBM trademark ever since. In the early days, these products included office and research equipment such as punch machines, calculating machines, clocks, and scales. Complainant introduced its first large vacuum tube computer under the name IBM 710 in 1952, and since then has continuously used the trademark IBM in association with computers and computer hardware, software, and accessories.

In 1961, IBM introduced the IBM Selectric typewriter. This was an innovation in the business sector, and the United States Postal Service issued a 2011 postage stamp featuring the IBM typewriter, commemorating the industrial designer as part of its Pioneer of American Design series of stamps. In 1981, IBM introduced the 5150 personal computer, or IBM PC. It became the first computer to be recognized as a valuable tool for businesses, homes, and schools. Over the next two decades, IBM expanded its line of personal computers, climaxing with the ThinkPad at the turn of the 21st century. Complainant sold its personal computer division to China-based Lenovo group in 2005.

Complainant has owned trademark registrations for the IBM mark in 170 countries around the world for several decades, and for a broad range of goods and services. Complainant owns, among others, the following trademarks in the US:

- US Reg. No. 4,181,289 in International Classes 6, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 30, 35, and 41, registered on July 31, 2012;
- US Reg. No. 3,002,164 in International Class 9, registered on Sep. 27, 2005;
- US Reg. No. 1,205,090 in International Classes 1, 2, 7, 9, 10, 16, 37, 41, and 42, registered on August 17, 1982;
- US Reg. No. 1,058,803 in International Classes 1, 2, 3, 4, 7, 9, 10, 16, 37, 41, and 42, registered on February 15, 1977;
- US Reg. No. 640,606 in International Class 9, registered on January 29, 1957;
- US Reg. No. 6436503 in International Class 9, registered on August 03, 2021;
- US Reg. No. 1,696,454 in International Class 36, registered on June 23, 1992;
- US Reg. No. 1,694,814 in International Class 36, registered on June 23, 1992; and
- US Reg. No. 1,243,930 in International Class 42, registered on June 28, 1983.

These trademarks cover a wide variety of information technology related goods and services, such as:

- US Reg. No. 4,181,289, International Class 9 – covering “operating system software”; “software for providing access to a global computer network”; “computer software for managing databases”; “computer software for analyzing data”, registered on July 31, 2012;
- US Reg. No. 1,058,803, International Class 9 – covering “data processing machines, memories”; “computer programs in the form of punched cards, paper tape, magnetic tape, magnetic disks and microfiche”, registered on February 15, 1977;
- US Reg. No. 1,205,090, International Class 9 – covering “computer systems, data processing machines, memories, terminals, controllers and combinations of data processing machines and programs”, registered

on August 17, 1982;

- US Reg. No. 4,181,289, International Class 38 – “provision of Internet access to private and secured electronic communications in real time within a computer network; provision of Internet access to technical support services concerning use of communication equipment”, registered on July 31, 2012; and
- US Reg. No. 1,243,930, International Class 42 – “computer time sharing services”, registered on June 28, 1983.

The Panel also has taken notice of Complainant’s US Reg. No. 6,436,503 in International Class 9, with a filing date of July 21, 2020, and registration date of August 3, 2021. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)),¹ section 4.8 (“Noting...the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record.... This may include...accessing trademark registration databases”). This trademark registration covers, among other things, “[c]omputer hardware and recorded and downloadable computer software for information technology analysis and database management”; “computer hardware and recorded and downloadable computer software for application development”; “computer hardware and recorded and downloadable computer software for managing and verifying cryptocurrency transactions using blockchain technology”; “computer hardware and recorded and downloadable computer software for quantum computing and quantum programming”; “computers”; “computer servers”; “recorded and downloadable computer software for controlling the operations and execution of computer systems, programs, and computer networks”; “recorded and downloadable computer software for connecting disparate computer networks and systems, servers and storage devices”; “recorded and downloadable computer operating system software”; “recorded and downloadable computer software for linking together computers and for enabling computing across a global computer network”; “recorded and downloadable computer system-management software; recorded and downloadable computer software for managing hardware, software and processes that exist within an information technology environment”; and “recorded and downloadable computer software for developing, building and operating blockchain technology applications”.

Complainant also owns the following United Kingdom (“UK”) trademark registrations for the IBM mark:

- UK Reg. No. WO0000001556374, in International Classes 9, 16, 35, 36, 37, 38, 41, and 42, registered on July 21, 2020; and
- UK Reg. No. 737699, in International Classes 9 and 16, registered on December 31, 1954.

The IBM trademark is a world-famous mark, as recognized by prior UDRP panels. See *International Business Machines Corporation v. Le Van Hai*, WIPO Case No. [D2019-3000](#) (“Complainant’s IBM trademark has been recognized as famous in many earlier decisions (e.g., *International Business Machines Corporation v. Sadaqat Khan*, WIPO Case No. [D2018-2476](#); *International Business Machines v. Niculescu Aron Razvan Nicolae*, WIPO Case No. [DRO2010-0003](#); *International Business Machines Corporation v. Linux Security Systems srl*, WIPO Case No. [DRO2010-0004](#)”); see also *Physik Instrumente GmbH. & Co. v. Stefan Kerner and Jeremy Kerner and Magic Moments Design Limited*, WIPO Case No. [D2000-1001](#) (“the ‘IBM’...letter trademark[] [is] used by [one] of the world’s largest industrial corporations and without doubt [is] ‘well-known’ within the meaning of Article 6^{bis} of the Paris Convention”).

In 2021, Complainant was ranked the 15th most valuable global brand by BrandZ, the 18th best global brand by Interbrand, the 42nd largest company on the Fortune U.S. 500 list, and the 121st largest company on the Fortune Global 500 list. In 2020, Complainant was ranked the 14th most valuable global brand by BrandZ, the 14th best global brand by Interbrand, the 38th largest company on the Fortune U.S. 500 list, and the

¹ In view of the fact that the Policy is largely based on the Uniform Domain Name Dispute Resolution Policy (“UDRP”), it is well established that both cases decided under the Policy and cases decided under the UDRP, and therefore [WIPO Overview 3.0](#), are relevant to this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

118th largest company on the Fortune Global 500 list. The IBM trademark was valued by BrandZ as worth over USD 91 billion in 2021, USD 83 billion in 2020, USD 86 billion in 2019, and USD 96 billion in 2018. Complainant abandoned a US federal trademark application for the word mark IBM-PC on April 7, 1995.

Complainant spent more than USD 6 billion on advanced research in 2020 and more than USD 5 billion on advanced research in 2019. Complainant spends over USD 1 billion annually marketing its goods and services globally using the IBM trademark and has undertaken extensive efforts to protect its name and enforce the IBM mark. Complainant exerts control over use of the IBM mark and imposes strict quality control measures over goods and services offered in connection with the mark.

Respondent registered the Domain Name on May 12, 2021. Respondent launched a website linked to the Domain Name to market and sell collectible, electronic artwork that marks the 40th anniversary of the creation of the world's first personal computer, the IBM 5150 computer. Respondent's commercial artwork features high-resolution, vector-art images of the original IBM 5150 desktop computer, its monitor, and accessories. The images are presented as digital, collectible trading cards sold as limited edition "NFTs" (*i.e.*, non-fungible tokens). NFTs are cryptographically unique tokens that are linked to digital (and sometimes physical) content, providing proof of ownership. They are recorded in a blockchain that is used to certify authenticity and ownership.

Respondent has included a notice at the bottom of the homepage of the website linked to the Domain Name, which provides as follows:

"Copyright 2021 Webviously Inc. and The IBM PC NFT Experience, a Fan-Art Project | Not affiliated with International Business Machines Corp., we're just really huge fans."

5. Parties' Contentions

A. Complainant

(i) Identical or confusingly

Complainant relies on its extensive range of registered IBM trademarks as well as the status of its IBM mark as a well-known mark. Complainant states that because of the high quality of goods and services provided to its customers for over 100 years, and its reputation as one of the premier manufacturers of computer and computer related goods and services throughout the world, Complainant's name and the IBM trademark are famous and valuable assets. Complainant has devoted substantial resources toward maintaining and building these assets. Complainant protects its brand and the IBM mark by pursuing infringers

Complainant submits that the Domain Name is identical or confusingly similar to Complainant's registered trademarks. The Domain Name consists of the usual "www" prefix, the letters "ibm," followed by the acronym "pc," and the country code top-level domain ".io". The letters "ibm" contained in the domain name are the same as the IBM trademark. Complainant states the Domain Name differs from Complainant's IBM mark through the addition of the acronym "pc," which stands for "personal computer." Complainant claims this addition does not avoid a finding of confusing similarity. Complainant's famous trademark is recognizable and entirely contained in the Domain Name.

Complainant contends that where a trademark is recognizable within a domain name, as here, the addition of other terms does not prevent a finding of confusing similarity under the first element of the Policy. As such, the variation in the Domain Name does not obviate the confusing similarity between it and the IBM trademark. Complainant argues that the addition of the generic term "pc" does not reduce confusion, and in fact may increase the potential for confusion. IBM being famous for the development and commercialization of personal computers in the 1980s through early 2000s, the term "pc" associated with IBM increases the likelihood of confusion.

Therefore, Complainant states the Domain Name is identical or confusingly similar to Complainant's registered trademarks.

(ii) Rights or legitimate interests

Complainant states that Respondent has not been authorized, licensed, contracted, or otherwise permitted by Complainant to use the IBM trademark or to apply for any domain name incorporating the mark, nor has Complainant acquiesced to use of the mark by Respondent. Additionally, Complainant asserts there is no evidence that IBM is the name of Respondent's corporate entity, nor is there any evidence of fair use. Furthermore, Complainant states there is no evidence that Respondent is using or plans to use the IBM trademark or the Domain Name incorporating the mark for a *bona fide* offering of goods or services.

Complainant contends that Respondent, instead, has been using the IBM trademark in the Domain Name to promote Respondent's website for commercial gain. Respondent has intentionally attempted to create a likelihood of confusion by using the Domain Name containing the IBM mark to increase Internet user traffic to Respondent's site, where it advertises for sale NFT sticker pack series related to IBM personal computers. The increased Internet traffic will boost sales of the NFT sticker pack series and allows Respondent to capitalize on the fame associated with the IBM mark. NFTs can be used for artwork, digital collectibles, music, or items in video games. They have unique properties and are not interchangeable for other items. In this case, Complainant states the NFTs are virtual stickers created by Respondent to mark the 40th anniversary of the IBM 5150, without the consent of Complainant.

Complainant contends that such unauthorized use of the IBM trademark is likely to cause consumers to erroneously believe that Complainant is somehow affiliated with Respondent or endorsing its commercial activities, while in fact no such relationship exists. Therefore, Complainant states it can affirm with good faith that:

- There is no evidence of Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to it in connection with any *bona fide* offering of goods or services;
- Respondent has not been commonly known by the Domain Name; and
- Respondent is not making a legitimate non-commercial or fair use of the Domain Name.

Complainant observes that Respondent includes a notice at the bottom of the homepage of the website linked to the Domain Name, as noted in section 4 above. Complainant maintains that irrespective of the veracity of Respondent's characterization of the website as a fan site, previous UDRP panels have found that a general right to operate a fan site does not necessarily extend to registering or using a domain name that is identical to a complainant's trademark, particularly as the domain name may be misunderstood by Internet users as being somehow sponsored or endorsed by the trademark owner. In such cases, panels have also noted that use of a domain name which is identical to a trademark prevents the trademark holder from exercising its rights in the trademark and managing its presence on the Internet.

Complainant claims Respondent cannot be considered as a not-for-profit fan club entity, but instead appears to do business in the Internet community. The website linked to the Domain Name mentions that the NFT cards "can be easily bought, sold, traded and even auctioned on the WAX blockchain." The value of the packs depends on their size (number of cards) and is estimated between 35 and 250 WAX cryptocurrency. It is also mentioned that the "three-finger salute pack is priced at 256 usd". Complainant argues Respondent did not choose an obvious domain name for identifying a fan site (if it is considered as such). Instead, Respondent chose the Domain Name that is confusingly similar to the IBM mark, which may misleadingly divert Internet users seeking an official IBM website. Respondent's disclaimer would in any case be seen by Internet users only when access to the website is made, and even then, would not be readily apparent due to the placement of the notice at the bottom of the homepage, as well as the small font size in which it appears.

Complainant asserts that Respondent could have expressed support for Complainant's products in alternative ways without taking unfair advantage of Complainants' reputation and goodwill and without incorporating Complainant's registered trademark in the Domain Name. Therefore, Complainant submits

that Respondent has no rights or legitimate interests in respect of the Domain Name.

(iii) Registered and used in bad faith

Complainant maintains that the Domain Name is identical or confusingly similar to Complainant's famous IBM trademark and that, as such, a presumption of bad faith must be found against Respondent. Complainant states that a presumption of bad faith may be created solely through the registration of a domain name that is identical or confusingly similar to a famous or widely known trademark. Complainant claims Respondent was aware of Complainant's mark at the time Respondent registered the Domain Name in May 2021. Complainant's trademarks are well-known around the world. Respondent describes itself as a "fan" of the IBM PC. It is unlikely that an entity with a great interest in the IBM PC would have no knowledge of Complainant's registered marks. Here, Respondent has registered the Domain Name, which comprises Complainant's distinctive trademark and principal element of Complainant's business name, namely, IBM. Respondent deliberately registered the Domain Name to create confusion and attract Internet users to its website for commercial gain. Therefore, Respondent registered the Domain Name in bad faith.

Complainant submits that Respondent has been using the Domain Name containing the IBM trademark for commercial gain. Respondent has intentionally created a likelihood of confusion by using the Domain Name to attract visitors to its website, where Respondent sells NFTs, thus generating revenue through unauthorized use of the IBM mark. The IBM mark has specifically been targeted by Respondent for selling its artwork project named "IBM PC NFT sticker pack series" on the website linked to the Domain Name. Therefore, Complainant asserts Respondent is capitalizing on the fame associated with the IBM mark to realize financial gain.

Complainant states "IBMpc" is not descriptive of the products sold by Respondent, which are NFT stickers as opposed to computers. Complainant contends that the IBM mark is highly distinctive for computer products. The use of "ibmpc" by Respondent is deceptive by misdescribing the products in connection with which it is offered and misleads consumers about the products sold. The Domain Name is being used in bad faith as Respondent is attempting to attract Internet users to its site for commercial gain by creating a likelihood of confusion with Complainant's mark. Further, Respondent has intentionally created a likelihood of confusion as to the relationship between Complainant and Respondent, as well as the source, sponsorship, or endorsement of Respondent's website and/or goods and services. Internet users may think that Complainant is the creator of the products "IBM PC NFT sticker pack series" or that a collaboration exists with Respondent. Or a significant number of consumers may be confused by the presence of IBM and PC in the Domain Name and may think Complainant is selling personal computers. Complainant claims the potential for this type of consumer confusion is likely, as Complainant conducted business in the field of personal computers for decades until selling its PC division to Lenovo in 2005.

Complainant argues that notwithstanding Respondent's legal notice on the website, the use of Complainant's distinctive IBM mark in the Domain Name is confusing for most Internet users. The IBM mark is highly distinctive for computers and computer-related products. The more distinctive a mark is, the more likely consumer confusion exists. The disclaimer would in any case be seen by Internet users only when access to the website is made. There is no doubt that Internet users will pay less attention when a legal notice is written in small characters at the bottom of a web page. It is well established that the existence of a disclaimer cannot cure bad faith when bad faith has been shown by other factors. In the present case, Complainant urges that the inclusion of a disclaimer does not insulate Respondent from a finding of bad faith, as other factors demonstrate bad faith: the Respondent's intentions are commercial (selling NFTs); and Respondent has intended to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's site. Therefore, Respondent has registered and used the Domain Name in bad faith to profit from the fame of Complainant's brand fame and trademark.

Complainant states that if Respondent wanted to avoid any risk of confusion, it would have demonstrated that the nature of the project is a fan club celebrating the 40th anniversary of the release of the IBM PC, by registering a domain name that clearly identifies Respondent as a fan and does not prominently include

Complainant's IBM trademark.

Complainant states it first sent a cease-and-desist letter to the Registrar on May 21, 2021, at the email address listed in the Whois information, asking to disable and transfer the Domain Name to Complainant. Complainant also sent a cease-and-desist letter to the hosting company on August 13, 2021. Complainant sent follow-up emails to both the Registrar and the hosting company on September 10, 2021. The correspondence was unanswered. Complainant contends that failure to respond to Complainant's email is additional evidence of bad faith. Further, Respondent continued to use the Domain Name for illegitimate commercial gains even some months after cease-and-desist letters were received and this has been found to constitute bad faith.

In response to the infringement notices sent by Complainant through the BSA.org | The Software Alliance (the "BSA") related to "The IBM PC NFT Experience," Complainant states that Respondent indicated "we will be turning this very letter into its own NFT, to be sold and circulated. Proceeds from the sales of this NFT will be used to secure the future of our project, and if need be, fund the cost of legal action." In addition, Respondent reacted on its website by stating "we will contribute to celebrate the now notorious IBM PC with contraband NFTs," showing it intends to continue infringing Complainant's trademarks rights.

In sum, Complainant asserts that Respondent has in bad faith tried to obtain financial gain by registering and using the Domain Name in which it has no rights or legitimate interests to generate revenue from promoting its NFT business. The confusing similarity between the Domain Name and Complainant's IBM mark, the malicious intent in Respondent's response to the take down notices, and the statement on the website by Respondent about the promotion of contraband NFTs are all conclusive proof that the Domain Name was registered and is being used in bad faith.

B. Respondent

Respondent states that it chose the Domain Name to market its digital artwork and that the phrase "IBM PC" became a generic mark in the 1980s. Thus, Respondent contends that Complainant has no rights to the IBM PC mark, and that Complainant's framed this dispute narrowly to avoid any mention of the inconvenient truth that Complainant allowed its IBM PC mark to become generic and unprotected. Respondent asserts the phrase IBM PC is world-famous, generic, and does not belong to Complainant.

Further, Respondent states that Complainant no longer makes personal computers, and has been out of that field for many years. The phrase IBM PC has a specific, historical connotation that web users associate solely with early personal computing (including IBM's competitors), and not with any modern product line of Complainant. Respondent argues there is no risk that purchasers of the collectible artwork will be confused by the provenance or sponsorship of the NFT trading cards.

Respondent explains that, although beyond the immediate scope of this case, the content of Respondent's website constitutes permissible fair use of Complainant's logo and trade dress because Respondent's product line promotes original artwork created to celebrate the 40th anniversary of the first IBM PC and the movement that followed. Respondent contends that due to this fair use, Respondent has a legitimate claim to the Domain Name, a *bona fide* business interest, and the absence of bad faith. In short, Respondent asserts it is neither a squatter nor a thief. Instead, Respondent has created an original, electronic art product within the bounds of fair use, and Respondent markets this artwork via the Domain Name, which uses a generic phrase.

(i) Identical or confusingly similar

Respondent contends that while Complainant may own dozens of trademarks in many countries, it does not have any rights in the phrase IBM PC, and this is fatal to the Complaint. Respondent asserts that IBM PC is a world-famous generic mark, as it refers to the class of computers launched in 1981. PCs were sold by dozens of competitors, who ultimately dwarfed Complainant's market share and drove Complainant out of the market it created. Respondent asserts that along the way, the phrase IBM PC became synonymous with

the type of computer, rather than the specific Complainant-branded computer.

Respondent states a generic (or genericized) trademark is one which becomes synonymous with a general class of products, regardless of the intent of the trademark owner. In the early 1980s, Respondent contends IBM PC became synonymous with an entire class of personal computing products. These clones flooded the market and overwhelmed Complainant's market share. Respondent states that 13 years after the launch of its first machine, Complainant attempted to obtain trademark protection in the US for the phrase IBM PC. However, after initiating its filing there, Respondent asserts that Complainant discovered protection was unavailable for the phrase. Complainant abandoned its US claim for the term IBM PC, and thus Respondent submits the word mark IBM-PC has been dead since April 7, 1995.

Respondent states that Complainant fails to address this critical issue. Instead, Complainant attempts to parse out the pieces of the Domain Name. In Complainant's view, the relevant mark is IBM, which it asserts is recognizable within the Domain Name. However, Respondent urges the relevant mark is not IBM, but instead IBM PC. The entirety of that generic mark is the Domain Name, and Complainant cannot assert confusion due to its own mark's presence within an unprotected, generic mark. Respondent argues that Complainant provides no authority for its proposition, while citing to inapposite misuse cases.

Respondent acknowledges that a party may not avoid likely confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it. But Respondent submits that this is not the situation here. Respondent did not "add" descriptive or nondistinctive elements to the IBM mark, but instead chose an existing, generic mark for the Domain Name.

Respondent also observes that Complainant cannot assert any current usage of the phrase IBM PC, because there is no such thing in today's world as an IBM PC. Complainant sold its personal computing division to Lenovo. Respondent states that the world has long since stopped referring to that class of personal computers as IBM PCs. As a result, the concept of an IBM PC now refers solely to an antique class of computers. Respondent claims that Google's search engine provides evidence of the historical (rather than ongoing commercial) nature of the phrase IBM PC. Searching for the term "IBM PC" and "IBMP" yields numerous websites that discuss or relate to the launch of the personal computing revolution in 1981. Respondent states it was unable to find any other topic within the first ten pages of search results other than those that address the historical nature of the term. It should be noted that within these search results a web user would also find <ibm-pc.org>, which utilizes a nostalgic, retro style to deliver archival information about the IBM PC.

In sum, Respondent contends the phrase IBM PC is a generic term, which web users associate with a specific class of historical products, rather than with Complainant's current product offerings. Complainant did not seek to protect the mark until after it had become genericized. Respondent argues that Complainant is unable to prevent a third-party from using a generic mark as a domain name, even if its own mark is found as a part of it.

(ii) Rights or legitimate interests

Respondent states it does not seek to sell the Domain Name to Complainant, nor is Respondent attempting to prevent Complainant from reflecting its mark in a corresponding domain name. Respondent submits it is not seeking to disrupt Complainant's present business, and instead seeks to honor a narrow aspect of Complainant's historical business. There is no known overlap between Complainant's current business model and Respondent's creation and marketing of artwork in celebration of the first personal computer. Respondent states its website is laudatory of Complainant, rather than critical or disruptive.

Regarding the Policy, paragraph 4(b) (Evidence of Registration and Use in Bad Faith) and in particular, paragraphs 4(b)(i), (ii), and (iv), Respondent asserts that each element contain a predicate requirement, namely, that Complainant must actually hold an existing trademark that is at issue. Respondent states that, as explained above, Complainant does not hold trademark rights in the generic mark, IBM PC. Thus, it is not possible for a party to use a generic trademark in a manner that creates confusion with the protected mark.

Respondent also observes that Complainant concedes Respondent has a disclaimer (referenced above) on Respondent's website, explaining that its artwork is not sponsored by Complainant. Respondent's site also explains the historical nature of the PC product, which has been out of production for decades. Respondent argues there is no reasonable possibility that the Domain Name will be confused with Complainant's ownership or endorsement, and Respondent has intentionally attempted to avoid an appearance of endorsement.

Respondent maintains that the underlying efforts to celebrate the IBM PC with commercial artwork constitutes fair use. Respondent maintains that its website and the NFT project constitute permissible, fair use. Respondent states that the nature of its project is like a fan club, celebrating the 40th anniversary of the release of the IBM PC. The fan club project centers upon original and collectible fan art. These are akin to trading cards or limited print posters, with the only difference being that they are an intangible digital vehicle by which to transmit the artistic images. Respondent provided extensive discussion on these points in its submission, while recognizing that the question of fair use in relation to the content on Respondent's website and the NFTs is "outside the scope of this Panel's decision."

Respondent concludes that it meets the second element of the Policy because Respondent is using the Domain Name that incorporates a long-genericized term to advance a legitimate purpose.

(iii) Registered and used in bad faith

Respondent contends it did not register the Domain Name in bad faith, nor is Respondent using it in bad faith. Respondent states that it has made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods and services: upon purchasing the Domain Name, Respondent put it to use to display and promote its artwork, which was officially launched in connection with the celebration of the 40th anniversary of the IBM PC on August 12, 2021 (three months after registration). After the kick-off event, Respondent continued to use and promote content on its site linked to the Domain Name through social media channels. Thus, Respondent intended from the outset to continue using the Domain Name for ongoing purposes connected with such use.

Respondent contends that the Complaint contains several assertions about confusion that have no factual basis. While Complainant asserts that use of its IBM mark in the Domain Name is confusing for Internet users, Respondent argues this assertion is the opposite of what the Google search results demonstrate. Instead, according to Respondent, Internet users confronted with the term IBM PC are almost universally intending to find websites about that era of computing, rather than any computer-related products associated with Complainant.

While the Complaint also asserts that the disclaimer on Respondent's site is not large enough and should weigh against Respondent as proof of bad faith, Respondent believes the disclaimer is sufficiently obvious, but the more important point is that the Panel should not be in the business of policing website content. Complainant's concerns about the size of a disclaimer are misplaced in a Complaint about the Domain Name.

Respondent emphasizes that all of this begs the question that remains at the center of the case, which is what rights does Complainant have in a generic mark? Respondent urges it is difficult to imagine how a party can commit bad faith by registering a generic mark, let alone in these circumstances where the mark became generic by Complainant's own business practices, which culminated in its failed trademark filing in 1994. Respondent states there is no UDRP case comparable to this one, the facts here are unique. Respondent submits Complainant allowed one of its marks to become generic and now attempts to rectify its oversight 30 years later.

Further, while Complainant asserts that it sent several cease-and-desist letters beginning in May 2021, Respondent states that it received none of them. The Domain Name ownership information was "locked" (and thus anonymous) by the Registrar until recently, when the Complaint was filed. All Complainant's attempts at communication were sent to the Registrar and the hosting company, but not to Respondent.

According to Respondent, none of the communications to the Registrar and hosting company were forwarded to Respondent. Thus, a failure to answer these communications, which Respondent did not receive, is not evidence of bad faith.

Moreover, Respondent's states its website includes contact information, yet Complainant did not attempt to make direct contact with Respondent. Later, Complainant's agent, BSA, contacted third parties who were hosting the blockchain portion of Respondent's digital artwork. Yet even then, neither BSA nor Complainant attempted direct contact with Respondent. Instead, Respondent states it discovered this indirectly, and had to demand copies of whatever had been sent to third parties to see what communications had taken place. At that point, Respondent discovered that BSA was involved. When Respondent learned this, Respondent asserts it reached out to BSA, but obtaining a response proved difficult. When communications finally did occur, Respondent states the nature of the communications were not a demand to cease and desist usage of the Domain Name, but instead inquiries by BSA asking Respondent to explain its rationale for use. The first time that Respondent received any information about a demand to stop using the Domain Name was in the Complaint. Thus, none of the prior attempts is evidence of bad faith.

Respondent states that when BSA requested an explanation about Respondent's claim for use, Respondent replied. Respondent states it has approached this matter in good faith. While Complainant asserts that Respondent's bad faith can be demonstrated by the plan to turn its responsive letter to BSA into an NFT, Respondent states this is nonsense. The real thrust of the BSA communication was about the content of the website itself, not the Domain Name. Respondent was dumbfounded that BSA did not understand that the contents of the website were artistic, commercial fair use. Respondent asserts that BSA's take-down notices issued to third parties had a chilling effect on Respondent's business relationships. BSA's take-down notices appeared to be automated, rather than the product of any human discretion, and they interfered with Respondent's attempt to sell artwork. Respondent states it spent considerable time and effort to contact someone at BSA. Faced with BSA's intransigence, Respondent sent a letter to lay out its position, and added the language about turning the letter into an NFT to demonstrate the seriousness of the situation, and that Respondent believed in good faith to have a defensible position.

In conclusion, Respondent asserts there is no intentional conduct to mislead and little or no risk of confusion. It is unlikely anyone will perceive that Complainant is implicitly endorsing Respondent's product. Respondent states is not attempting to harm or denigrate the IBM brand. Further, Respondent notes that it is not selling any product or service that competes with or dilutes the IBM brand. Instead, Respondent is selling a collectible artwork experience – an ultra-modern version of an electronic trading card that depicts an obsolete (though revered) product – and not selling computers, computer accessories, or cloud data services. Respondent did not merely choose random letters and add them to Complainant's name. Instead, Respondent chose the Domain Name, which uses a phrase over which nobody can assert ownership. The presence of Complainant's name within the Domain Name is not dispositive, in this rare case, because the Domain Name itself reflects a generic mark that is synonymous with the movement celebrated by Respondent's website. Complainant is not entitled to transfer of the mark.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights to or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered or is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

The Panel determines that Complainant has established registered and common law rights in its globally well-known IBM trademark, based on its trademark registrations and extensive global use of the mark in the US, the UK, and elsewhere for many years.

Further, the Panel determines that the Domain Name is confusingly similar to the IBM mark, as the Domain Name incorporates the mark in its entirety, while adding the acronym “pc,” which has been commonly used as an abbreviation for the phrase “personal computer.” The addition of this term does not prevent a finding of confusing similarity under the Policy; instead, Complainant’s IBM mark is the dominant element in the Domain Name. UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name.” See *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#); *International Business Machines Corporation v. Adam Stevenson, Global Domain Services*, WIPO Case No. [D2016-1695](#) (held that the domain name, <ibmresearchgroup.com>, was confusingly similar to the IBM mark and the addition of the descriptive phrase “researchgroup” did not avoid confusing similarity); see also [WIPO Overview 3.0](#), section 1.8. Indeed, Respondent has acknowledged that “a user of a mark may not avoid likely confusion by appropriating another’s entire mark and adding descriptive or non-distinctive matter to it” (quoting *Lilly ICOS LLC v. John Hopking / Neo net Ltd.*, WIPO Case No. [D2005-0694](#)).

However, Respondent does not address directly whether the Domain Name is confusingly similar to Complainant’s IBM mark. Instead, the lynchpin of Respondent’s case is its contention that the phrase “IBM PC” contained in the Domain Name has become a generic mark, and therefore Complainant’s IBM trademark affords Complainant no protection and provides no basis for Complainant to assert its claim.

The Panel disagrees with Respondent’s assessment. The Panel considers that Respondent’s argument – that the phrase IBM PC became a generic mark regarding personal computers in the 1980s – is irrelevant both because the phrase IBM PC is arguably generic only as to personal computers, which Respondent does not sell, and because Complainant asserts rights in its well-known IBM trademark, not in the mark IBM PC. Moreover, there is absolutely no evidence in the record to indicate that the trademark IBM has become generic. Indeed, to the contrary, Complainant has submitted evidence to demonstrate the strength of its IBM name and mark as one of the most valuable and well-known brands in the world.

As discussed in section 4 above, Complainant owns trademark rights in the distinctive IBM trademark covering a wide variety of goods and services, including “data processing machines”; “computer programs”; “computer time sharing services”; “computer hardware and recorded and downloadable computer software for information technology analysis and database management”; “provision of Internet access to private and secured electronic communications in real time within a computer network”; “computer hardware and recorded and downloadable computer software for managing and verifying cryptocurrency transactions using blockchain technology”; “recorded and downloadable computer software for controlling the operations and execution of computer systems, programs, and computer networks”; “recorded and downloadable computer software for connecting disparate computer networks and systems, servers and storage devices”; and “recorded and downloadable computer software for developing, building and operating blockchain technology applications”.

While Complainant continues to own its distinctive IBM marks with coverage in these technical areas of goods and services, Respondent has adduced no evidence that it owns any trademark rights in the IBM mark or the IBM PC mark, let alone in regard to the NFTs that are offered for sale on its site. Respondent’s goods are NFTs, which are digital goods that exist in blockchains. Blockchains are digital ledgers of transactions created by computers and distributed by computer systems. The technical systems and services used for creating and selling Respondent’s NFTs require Internet access, data processing machines, and computer hardware, programs, software, and networks for developing, operating, managing, verifying, and operating blockchain applications and cryptocurrency transactions – all of which fall within the coverage of Complainant’s registrations for its IBM trademarks. Respondent therefore cannot sell its NFT’s

while using the IBM mark in Respondent's confusingly similar Domain Name. Moreover, as noted above, Respondent is not using the phrase IBM PC to sell personal computers, the area regarding which it argues that mark has become generic (which again, the Panel does not find to be the case). Instead, Respondent is selling NFTs at the website linked to the Domain Name.

Accordingly, the Panel finds that that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Regarding the second element of the Policy, [WIPO Overview 3.0](#), section 2.1, states that “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.

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to adequately rebut Complainant's contentions. The Panel finds that Complainant has not authorized Respondent to use its IBM trademark; that Respondent is not affiliated with Complainant, nor is Respondent commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services – instead, the Domain Name has been used for commercial purposes: it is linked to a website where Respondent advertises and sells its NFTs sticker pack series related to the early IBM 5150 computer, without the consent of Complainant. Thus, the Panel determines that Respondent is not making a legitimate noncommercial or a fair use of the Domain Name, and its arguments and reasoning do not justify or excuse its use of Complainant's IBM trademark.

To the extent Respondent argues that its website linked to the Domain Name is a fan site, the content of Respondent's site contradicts this assertion. The Panel finds that the website linked to the Domain Name is not a not-for-profit fan site: Respondent's website is a commercial site designed to market and sell Respondent's NFTs, even if these NFTs are claimed to be “fan art”. Respondent emphasizes its NFT project was launched in connection with the celebration of the 40th anniversary of the IBM PC. However, Respondent's website does not “celebrate” the IBM PC, nor does Respondent extol the virtues of IBM or provide a means for visitors to communicate with each other (and with Respondent) about the IBM PC on a non-commercial basis. Respondent's site simply sells its NFTs products, as described above. And as Respondent's website states, these NFTs can be “bought, sold, traded and even auctioned on the WAX blockchain.” *Daimler Chrysler Corp. v. Brad Bargman*, WIPO Case No. [D2000-0222](#) (commercial use); *Hero Honda Motors Limited v. Rao Tella*, WIPO Case No. [D2000-0365](#) (failure to organize fan club); *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case No. [D2000-0299](#) (indirectly offering products for sale).

In support of its argument for legitimate use of the Domain Name, Respondent has contended that the content of Respondent's website and the NFT's themselves makes artistic fair use of Complainant's IBM logos, names, product images and other content, even as this content is incorporated into the NFTs. However – and critically, Respondent's fair use arguments in this regard are all in reference to certain content on the website and the NFTs themselves, and do not pertain to Respondent's registration and use of the Domain Name for a commercial website where it markets and sells NFTs.

Respondent acknowledges that questions regarding whether its commercial artwork constitutes fair use are beyond the scope of this case. Moreover, the Panel observes that Complainant, while relying on the trademark rights in its IBM trademark, has not attempted to argue any copyright infringement claims in this case. The Panel agrees that questions of fair use concerning certain content on Respondent's website and the NFTs do not need to be decided in this case. However, the Panel also observes that Respondent's arguments concerning fair use are less than convincing. First, the website has numerous references to Complainant's IBM word and logo mark standing alone, without including the allegedly generic phrase “IBM PC.” Respondent argues a balancing test should be applied between the protection of a trademark for commercial use versus the artistic protections of free expression afforded by the US First Amendment.

However, the Panel finds that Respondent is using the IBM mark on Respondent's commercial website, where it sells its NFTs, and this is a commercial use independent of the commercial art content in the NFTs. Second, Respondent states that "IBM did not copyright its boot screen, nor did it copyright the name badges on the outside of its computers." However, the Panel observes that this statement reveals an incorrect understanding of US copyright law. Creators of a work of authorship own a copyright (*i.e.*, an intangible property right) in the work automatically by law as soon as an original expression is "fixed in any tangible medium of expression." See 17 USC § 102(a). Registration (or "copyrighting," as Respondent incorrectly puts it) is not required for a copyright to arise. Registration in the US provides the author with advantages, but is not required for the copyright to exist. See *e.g.*, 17 USC §§ 410(c), 411, 501– 505, 601, 602. As long as they are fixed in any tangible medium of expression, Complainant owns the copyright in its software, as well as in the boot screen, name badges and other items (assuming they comprise original expression and were created by IBM employees or were assigned to IBM by the creators). This observation does not fully answer the question of whether Respondent is making fair use of Complainant's works subject to copyright. In any event, Respondent's fair use and copyright arguments relate to the content of its NFTs, and not to the Domain Name.

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered or Used in Bad Faith

The third element of paragraph 4(a) of the .IO Policy requires that Complainant demonstrate that Respondent registered or is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark."

Here, the Panel determines that the Domain Name was registered and is being used in bad faith. Based on the evidence, there is little doubt that Respondent was aware of Complainant and its well-known IBM mark, and intentionally targeted that mark, when registering the Domain Name. The Panel observes that Respondent registered the Domain Name, which incorporates Complainant's distinctive IBM trademark in its entirety, along with the acronym "pc." By asserting it created a "Fan-Site" and acknowledging Complainant in its disclaimer, Respondent admits that it knew of Complainant, its history, and the products and services offered under the IBM marks.

Despite this knowledge, Respondent registered the Domain Name, arguing in this case that the phrase "IBM PC" represents a generic mark and that its website is akin to a fan site celebrating the 40th anniversary of the IBM PC. As discussed above, even if the phrase IBM PC arguably reflects a generic mark in the US (an issue the Panel does not decide), it would only be generic in relation to personal computers, which Respondent does not sell. Further, as discussed above, there is no evidence that Complainant's IBM mark fails to provide coverage for the technical goods and services related to NFTs. Respondent could be selling NFTs on its commercial website associated with any variety of items (*e.g.*, sports or music memorabilia), not just the IBM 5550 computer. If Respondent registered a domain name corresponding to the trademarked brand for any of those items, it would require the trademark owner's consent.

Complainant also benefits from the international renown of its IBM trademark. The Panel concludes that Respondent has registered the Domain Name to capitalize on the IBM mark for financial gain. Previous panels have found that "the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) 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; see also *International Business Machines Corporation v. Jian Liu*, WIPO Case No. [D2021-0248](#) (finding presumption of bad faith where the respondent had registered <ibmdn.com>, which incorporated the famous IBM mark followed by two letters, as here).

As noted in section 6.B above, the Panel has found that Respondent is not operating a fan site at the website linked to the Domain Name; instead, it is operating a commercial site where it markets and sells NFTs. See e.g., *Hero Honda Motors Limited v. Rao Tela*, WIPO Case No. [D2000-0365](#) (respondent acted in bad faith, even if it registered the domain name for the purposes of a fan club site, by choosing complainant's distinctive trademark and the principal element of complainant's business name as the domain name). On this point, it is important to note by way of analogy that a commercial art gallery cannot justify using the name of a famous third-party trademark for its own gallery name, merely because one or more of the paintings it sells makes artistic reference to that trademark. Similarly on the Internet, trademarks are entitled to protection.

Moreover, the Panel determines that Respondent has intentionally created a likelihood of confusion by using the Domain Name to attract visitors to its website, where Respondent sells NFTs, thus generating revenue through unauthorized use of the IBM mark. Respondent is purposefully creating a likelihood of confusion with the IBM trademark as to the source, sponsorship, affiliation, or endorsement of the site.

The Panel determines that Respondent's disclaimer on the homepage of its website does not cure Respondent's bad faith. It is well established that "where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In such cases, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused." [WIPO Overview 3.0](#), section 3.7. Moreover, Respondent's disclaimer is inconspicuously located at the bottom of the webpage and in small font. See *IKEA Systems B.V. v. James Acosta*, WIPO Case No. [D2013-2245](#) ("As to the disclaimer, that cannot of itself cure bad faith or provide a right or legitimate interest, when bad faith has been established by other factors. The facts in each case must be considered. Here, there is clearly the probability of Internet user "initial interest confusion" given the confusing similarity of the disputed domain name with Complainant's well-known IKEA mark. The existence of the disclaimer is also evidence of Respondent's awareness of that trade mark and consequent bad faith at the time of registration of the disputed domain name.").

The Panel has reviewed the parties' contentions concerning certain letters and communications that were exchanged preceding this case. The Panel places no reliance on these contentions in finding that Respondent registered and used the Domain Name in bad faith.

Accordingly, the Panel finds that Respondent registered and is using the Domain Name in bad faith. Complainant has satisfied 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 Domain Name <ibmpc.io> be transferred to Complainant.

/Christopher S. Gibson/
Christopher S. Gibson
Presiding Panelist

/Steven Fox/
Steven Fox
Panelist

/Nathalie Dreyfus/
Nathalie Dreyfus
Panelist
Date: May 31, 2022