

ADMINISTRATIVE PANEL DECISION

**International Business Machines Corporation v. Domains By Proxy, LLC /
Steven Schachtner, Applesoft
Case No. D2022-1073**

1. The Parties

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

Respondent is Domains By Proxy, LLC, United States / Steven Schachtner, Applesoft, United States.

2. The Domain Name and Registrar

The disputed domain name <ibmapplemicrosoftatandtverizontmobil.com> (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 March 29, 2022. On March 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 31, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on April 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 5, 2022.

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 Respondent of the Complaint, and the proceedings commenced on April 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 28, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 13, 2022. On the same day, Respondent sent an informal email to the Center, enquiring who he can communicate with. The Center responded on May 25, 2022, acknowledging receipt of Respondent’s informal email communication dated May 13, 2022. The Center also indicated that

the specified due date for submission of a response has passed, and that it will be at the discretion of the appointed Panel to consider Respondent's request.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on May 25, 2022. 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.

The Panel issued Procedural Order Number 1 on June 1, 2022, providing Respondent until June 4, 2022 by which to submit its response to the Center. On June 2, 2022, Respondent responded by email to the Center's May 25, 2022 email (which indicated that time of response for Respondent has passed), with a reference to contact himself or a third party. On the same day, June 2, 2022, Respondent also replied to Procedural Order Number 1, with a vague reference to a third party's possible involvement. Neither informal email communications dated June 2, 2022 constitute a response to the Complaint.

4. Factual Background

Complainant, International Business Machines Corporation ("IBM"), is a technology company involved in the design and manufacture of products that record, process, communicate, store and retrieve information, including computers and computer hardware, software and accessories. Incorporated on June 16, 1911 as an amalgamation of three previously existing companies, Complainant officially became International Business Machines on February 14, 1924 and has since been offering products under the trademark IBM. Complainant spent more than USD 6 billion on advanced research in 2021, over 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.

Complainant owns trademark registrations for IBM in numerous countries worldwide for a range of goods and services, including information technology related goods and services. These include the following trademarks in the United States, where Respondent is located:

- United States trademark registration no. 4,181,289 for an IBM figurative mark, 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. 3,002,164 for an IBM figurative mark, registered on September 27, 2005 in International Class 9;
- United States trademark registration no. 1,696,454 for an IBM figurative mark, registered on June 23, 1992 in International Class 36;
- United States trademark registration no. 1,694,814 for an IBM word mark, registered on June 16, 1992 in International Class 36;
- United States trademark registration no. 1,243,930 for an IBM word mark, registered on June 28, 1983 in International Class 42;
- United States trademark registration no. 1,205,090 for an IBM word mark, registered on August 17, 1982 in International Classes 1, 7, 9, 16, 37, and 41;
- United States trademark registration no. 1,058,803 for an IBM word mark, registered on Feb 15, 1977 in International Classes 1, 9, 16, 37, 41, and 42; and
- United States trademark registration no. 640,606 for an IBM word mark, registered on Jan 29, 1957 in International Class 9.

The Domain Name was registered on January 8, 2022, and resolves to a web page with pay-per-click ("PPC") links containing references to technology and telecommunications-related products and services. For example, at the time of filing the Complaint, these PPC links include: "Att Service", "Wireless Phone Plan" and "Business Cell Phone Plan". At the time of the Decision, these PPC links include: "Mobile Phones", "Online Phone Systems for Business" and "Wifi Plan". The web page also prominently features a link displaying "Get This Domain", which redirects to a page offering the Domain Name for sale.

On Jan 10, 2022, Complainant sent a cease and desist letter to Respondent at the email address listed on the Whois records, setting forth Complainant's trademark rights and requesting Respondent to disable and transfer the Domain Name back to Complainant. Complainant also sent a follow up letter to Respondent on January 24, 2022. Respondent did not reply to Complainant's letters.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith. In particular, Complainant contends that it has trademark rights in the registrations for IBM. Complainant contends that Respondent registered and is using the Domain Name to confuse Internet users looking for *bona fide* and well-known IBM products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use domain names, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring the Domain Name and setting up the corresponding website, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not submit a formal Response and did not reply to Complainant's contentions in his informal emails sent after the Notification of Default (as described in section 3 of this Decision).

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the trademarks, as noted above. Complainant has also submitted evidence, which supports that the IBM trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the

IBM trademarks.

With Complainant's rights in the IBM trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level-Domain ("TLD") in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademarks. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. D2010-0842.

The Domain Name consists of the letters "ibm", followed by the terms "apple", "microsoft", "atandt", "verizon", "tmobil", and the generic suffix ".com." The letters "ibm" contained in the domain name are exactly the same as the IBM trademarks. The only difference is the addition of the terms "apple," "microsoft," "atandt," "verizon," and "tmobil," which identify five major technology and telecommunication companies that operate in similar or related fields of business as Complainant. The presence of these five additional terms in the domain name does not obviate the confusing similarity between the Domain Name and the IBM trademarks.

Section 1.12 of the [WIPO Overview 3.0](#) states "[w]here the complaint's trademark is recognizable within the disputed domain name, the addition of other third-party marks [here, "apple," "microsoft," "atandt," "verizon," and "tmobil,"] is insufficient in itself to avoid a finding of confusing similarity to the complainant's mark under the first element". The IBM mark appears first in the Domain Name and is clearly recognizable. See *F. Hoffman-La Roche AG v. A Broek, AFM ENTERPRISE / NET4INDIA/ NET4INDIA*, WIPO Case No. [D2013-1967](#) (holding the disputed domain name, reducetileacompli Xenical.com, was confusingly similar to the XENICAL trademark and the addition of the third-party trademarks REDUCTIL and ACOMPLIA in the domain name did not eliminate the similarity between the XENCIAL mark and the disputed domain name). See also *International Business Machines Corporation v. Leslie Rubin*, WIPO Case No. [D2021-3766](#) (holding that the disputed domain name, micorsoftractorleibm.com, was confusingly similar to the trademark IBM, and the addition of other third-party trademarks in the domain name did not dispel the confusing similarity between the mark and the domain name).

As stated in Section 1.8 of the [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." See, for example, *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (transferring <ge-recruiting.com>); *Inter Ikea Systems B.V. v. Polanski*, WIPO Case No. [D2000-1614](#) (transferring ikeausa.com); *Microsoft Corporation v. Step-Web*, WIPO Case No. [D2000-1500](#) (transferring <microsofthome.com>); *CBS Broadcasting, Inc. v. Y2K Concepts Corp.*, WIPO Case No. [D2000-1065](#) (transferring <cbsone.com>).

Here, the Domain Name is confusingly similar to Complainant's IBM trademarks. These trademarks, which are fanciful and inherently distinctive, are recognizable in the Domain Name. In particular, the Domain Name includes Complainant's trademark IBM in its entirety, and the addition of the terms "applemicrosoftatandtverizontmobil" in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the IBM trademarks. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and the IBM trademarks, and does not have any rights or legitimate interests in the Domain Name.

Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the IBM trademark or to seek registration of any domain name incorporating the trademark. Respondent is also not known to be associated with or commonly known by the IBM trademark.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, the evidence demonstrates the Domain Name included advertising links that resolved to PPC websites containing references to technology and telecommunications-related products and services, which are in the same market or industry as Complainant's products and services.

The [WIPO Overview 3.0](#), section 2.9 notes that: "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users." Furthermore, an abundance of other UDRP panels have recognized that no rights or legitimate interests derive from using another's trademark to divert Internet users to websites displaying sponsored links, see, e.g., *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#), in which the panel held: "The consensus view of previous UDRP panels is that use of a domain name to post parking and landing pages or pay-per-click links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a '*bona fide* offering of goods or services' or from 'legitimate noncommercial or fair use' of the domain name."

Thus, such use by Respondent does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name.

Accordingly, Complainant has established its *prima facie* case that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have 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 complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The Panel finds that Complainant provided ample evidence to show that registration and use of the IBM trademarks predate the registration of the Domain Name. Complainant's reputation is also well established and known. Indeed, the record shows that Complainant's IBM trademarks and related services are widely known and recognized. Therefore, Respondent was likely aware of the IBM trademarks when it registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's IBM trademarks suggests Respondent's actual knowledge of Complainant's rights in the IBM trademarks at the time of registration of the Domain Name and its effort to opportunistically capitalize on the reputation of Complainant's trademarks.

Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, as noted in Section 6.B above, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The Panel finds that the use of the Domain Name indicates the obvious purpose of generating click-through revenues from the PPC links displayed at the websites to which the Domain Names resolve, which is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own websites by creating a likelihood of confusion with Complainant's IBM trademark as to the source, sponsorship, affiliation or endorsement of these websites.

Additionally, the Domain Name was listed for sell on a third-party website for sale, which clearly indicates that Respondent registered or acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to Complainant or to a competitor of Complainant, for valuable consideration.

Lastly, in the present circumstances, including the distinctiveness and reputation of the IBM trademarks, the failure of Respondent to submit a response addressing Complainant's contentions or to provide any evidence of actual or contemplated good-faith use of the Domain Name, and the implausibility of any good-faith use to which the Domain Name may be put, support a finding of bad faith. Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 <ibmapplemicrosoftatandtverizontmobil.com> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: June 8, 2022