

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
RESOLUTION POLICY**

Domain Name: ibmgroup.ca

Complainant: International Business
 Machines Corporation

Registrant: IBM Canada

Registrar: Tucows.com Co.

Panellist: Sharon Groom

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. International Business Machines Corporation. (the “**Complainant**”), is a company located in New York, United States.
2. The registrant for the domain name is IBM Canada (the “**Registrant**”) which is located in Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is ibmgroup.ca (the “**Domain Name**”). The registrar for this domain name is Tucows.com Co. (the “**Registrar**”). The disputed Domain Name was registered on July 21, 2021 by the Registrant.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“**CIRA**”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “**Policy**”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “**Rules**”).
5. The history of the proceeding as provided by the dispute resolution service provider,

Resolution Canada, Inc. (“**Resolution Canada**”), is that the Complainant filed a complaint on July 14, 2022 against the Registrant with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. Resolution Canada served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules to the email address provided by CIRA. The email was returned to sender.
7. The Registrant was given 20 days to file a response and as no response was forthcoming the panel was appointed on August 19, 2022.

D. Panel Impartiality and Independence

8. As required by paragraph 7 of the Rules, the panel has submitted to Resolution Canada a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant is a company located in the United States. However, it is the registered owner of the Canadian trademark registration for the mark IBM, reg. no. UCA38407 (the “**Trademark**”) which was registered in 1950. The Domain Name includes the exact word component of this Trademark, with the addition of only the generic word GROUP. Therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

10. The Complainant is a multinational company which has been offering technology products and services for over 100 years. Its Canadian subsidiary International Business Machines Company, Ltd., of Canada was set up in 1917. By 1937 the Complainant had operations in the US, Canada and other regions. As of 2021 the Complainant’s team included about 300 thousand employees globally, and revenues reached \$57.4 billion. It is the owner of over 900 active marks containing the formative IBM globally. In Canada it owns 97 pending and registered IBM-formative marks.
11. The Complainant’s flagship website is located at ibm.com. The Complainant also owns hundreds of IBM formative domain names including ibm.ca. In the Complaint the Complainant notes that the Domain Name redirects to the Complainant’s actual website ibm.com/ca-en. This apparently is the same result that occurs if one goes to the Complainant’s domain name ibm.ca. The Registrant has also used a business name IBM Group when registering the domain name that is very similar to the name of the Complainant’s current Canadian subsidiary IBM Canada Limited. In addition, the WHOIS information for the Domain Name lists the address of the Registrant as being the

same as that of the Complainant's Canadian subsidiary, and the phone number provided by the Registrant is the same as the Complainant's general telephone number 1-800-IBM-4YOU (800-426-4968).

12. The Complainant attempted to contact the Registrant and the technical contact listed in the WHOIS record for the Domain Name in August and September 2021, but no response was received.

G. *CIRA Domain Name Dispute Resolution Policy*

13. Paragraph 4.1 of the Policy requires that the Complainant establish that:
 - a) the Registrant's dot ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights;
 - b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
 - c) the Registrant has no legitimate interest in the domain name as described in section 3.4.
14. The Complainant must prove points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in section 3.4 of the Policy.

H. *Analysis*

Rights to a Mark

15. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.
16. The Domain Name was registered on July 21, 2021, therefore this is the earliest possible relevant date for this analysis.
17. A "Mark" is defined in paragraph 3.2(c) of the Policy as:
 - (a) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

18. The Complainant has submitted evidence of its registration of the Trademark IBM that was still active at the time of submitting the complaint. This registration was obtained in 1950 but use of the mark IBM had occurred in Canada many years before that with the earliest date of first use as listed in the Trademark registration being 1930. Therefore the panel finds that the Complainant has established that it had rights in the mark IBM prior to the date of registration of the Domain Name, and continues to have these rights.
19. The Domain Name (apart from the generic term GROUP and the .ca component) consists solely of the term IBM, which is the same as the Complainant's Trademark. Therefore, pursuant to paragraph 3.3 of the Policy, the panel finds that the Domain Name is confusingly similar to the mark IBM as it so nearly resembles the Trademark in appearance, sound and in the idea suggested by the Trademark as to be likely to be mistaken for the Trademark.

Bad Faith

20. The Complainant also has to prove, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute bad faith and these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.
21. The Complainant argues that the Registrant's conduct constitutes bad faith pursuant to paragraph 3.5(d) of the Policy which states:
 - (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.
22. With regard to paragraph 3.5(d) of the Policy, the Complainant asserts that the Registrant has intentionally registered a domain name that is confusingly similar with the Complainant's Mark IBM, and used contact information that is confusingly similar to that of the Complainant, so as to enable the Registrant to send emails using @ibmgroup which will be mistakenly interpreted by their recipients as coming from the Complainant or one of its subsidiaries. This suggests that the Domain Name may have been registered for the purpose of spam, phishing or other activities intended to mislead the recipient into thinking that they were dealing with the Complainant.
23. The Complainant also points out that the use of fake contact details in the registration of the Domain Name is potentially a breach of paragraphs 4.1(a) and 6.1(b) of the Registration Agreement between the Registrant and CIRA, which is an additional factor supporting a finding of bad faith.

24. The panel agrees that the registration of a domain name which: i) has as its only distinctive component the well-known trademark IBM, ii) resolves to a website owned by the Complainant, iii) was done using a business name as the name of the Registrant which is very similar to that of the Complainant's Canadian subsidiary, and iv) falsely uses that subsidiary's contact information, indicates that the registration was obtained in bad faith.
25. Therefore, the panel finds that the Complainant has proven, on the balance of probabilities, that the registration of the Domain Name was done in bad faith, as set out in paragraph 3.5(d) of the Policy.

Legitimate Interest

26. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the Domain Name. Paragraph 3.4 of the Policy lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:
 - (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
 - (b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
 - (c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
 - (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
 - (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
 - (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

27. The Complainant has established that it has rights in the mark IBM, which essentially comprises the Domain Name, and the Registrant has not shown that it had any interest in this Trademark. Therefore there can be no legitimate interest under subsection (a). The term IBM has not been used in good faith by the Registrant in association with any wares, services or business and the term is not clearly descriptive as referred to in subsection (b) as it is an acronym for “International Business Machines”, nor is it a generic term, therefore subsection (c) does not apply either. There is no evidence that the Registrant has used the term in good faith for a non-commercial activity including, criticism, review or news reporting, so subsection (d) is not applicable. Finally, the Domain Name is not the legitimate name of the Registrant as the Complainant has shown through a NUANS report that there is no entity in Canada called IBM Group, nor is it the name of a geographic place, therefore neither subsections (e) or (f) apply.
28. The onus is on the Complainant to show “some evidence” that there is no legitimate interest. In this case, the Complainant has demonstrated that none of the criteria set out in paragraph 3.4 are applicable here. Therefore, the panel finds that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the Domain Name.
29. The Registrant has not rebutted the Complainant’s evidence with any evidence of its own, therefore it has not proven, on the balance of probabilities, that it has a legitimate interest in the Domain Name.

I. Conclusion and Decision

30. In conclusion, the panel finds that the Complainant has rights in the mark IBM which predate the registration of the Domain Name. The panel also finds that the Domain Name is confusingly similar to the Complainant’s Trademark, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.
31. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name *ibmgroup.ca* be transferred to the Complainant.

Dated: August 24, 2022



By: Sharon Groom (Sole Panellist)