

Bond



Indian-Non Judicial Stamp Haryana Government



Date : 12/10/2016

Certificate No. G0L2016J2404



GRN No. 21035812



Stamp Duty Paid : ₹ 100

(Rs. Hundred Only)

Penalty : ₹ 0

(Rs. Zero Only)

Deponent

Name : Rachna Narula

H.No/Floor : Na

Sector/Ward : 65

Landmark : Na

City/Village : Gurgaon

District : Gurgaon

State : Haryana

Phone : 9818345046



Purpose : OTHER to be submitted at Other

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RACHNA BAKHRU

ARBITRATOR

Appointed by the .IN Registry – National Internet Exchange of India

In the matter of:

International Business Machines Corporation,
1, New Orchard Road, Armonk,
New York 10504-1722
United States of America

....Complainant

Pakki Rama Krishna Patnaik
7-69, Visakhapatnam
Andhra Pradesh – 530047
e-mail: pakki00033@gmail.com

.....Respondent

Disputed Domain Name: < **ibmfinance.in** >

AWARD

1) The Parties:

The Complainant in this arbitration proceeding is International Business Machines Corporation, a company incorporated under the laws of USA and headquartered at 1, New Orchard Road, Armonk, New York 10504-1722, United States of America. The Complainant is represented by its authorized representatives K & S Partners, 109, Sector 44, Gurgaon 122 003.

The Respondent in this arbitration proceeding is Mr. Pakki Rama Krishna Patnaik of 7-69, Visakhapatnam, Andhra Pradesh – 530047 India as per the details available in the whois database maintained by National Internet Exchange of India (NIXI).

2) The Domain Name, Registrar & Registrant:

The disputed domain name is <ibmfinance.in>. The Registrar is Wild West Domains, LLC (R102-AF IN).

The Registrant is Pakki Rama Krishna Patnaik of 7-69, Visakhapatnam, Andhra Pradesh – 530047 India

3) Procedural History:

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of Procedure (the Rules) were approved by NIXI on 28th June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

As per the information received from NIXI, the history of the proceedings is as follows:

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed Rachna Bakhru as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of impartiality and independence, as required by NIXI.

- The complaint was produced before the Arbitrator on January 6, 2017 and the notice was issued to the Respondent at his email address with a deadline of 10 days and not later than January 22, 2017 to submit his reply to the arbitrator.
- The Arbitrator issued another electronic notice to the Respondent on January 30, 2017 via email granting another opportunity to the Respondent to submit its response on or before February 9, 2017.



- The Arbitrator received no response from the Respondent within the said timeline and the Complainant's authorized representative notified that no settlement has been reached between the parties.

In view of the above, the complaint is being decided based on materials and evidence submitted by the Complainant and contentions put forth by them.

Grounds for administrative proceedings:

- A. The disputed domain name is identical with or similar to a trade mark or service mark in which the Complainant has rights;
- B. The Respondent has no rights or legitimate interests in respect of the domain name;
- C. The domain name has been registered and is being used in bad faith.

4) Summary of the Complainant's contentions:

The Complainant in support of its case has made the following submissions:

- a) The Complainant was incorporated in the State of New York, USA on June 16, 1911 as Computing-Tabulating-Recording Co. (C-T-R). In 1924, C-T-R changed its name to "International Business Machines Corporation", which led to the birth of the mark IBM as an acronym for "International Business Machines".
- b) The Complainant is one of the world's leading technology and consulting organizations with presence in over 175 countries through its wholly owned subsidiaries with over 3,70,000 employees worldwide. The Complainant has been using the trademark IBM in relation to its products and services atleast since 1924. In the early days, these products included office and research equipment such as punch machines, calculating machines, clocks and scales. The year 1952 witnessed the launch of the Complainant's first large vacuum tube computer under the name "IBM 710". Over the years, the complainant has continuously used the trademark "IBM" in relation to hosts of products and services including but not limited to computers and computer hardware, software and accessories.
- c) The products and services offered by the Complainant as of today can broadly be categorized into five segments- Global Technology Services (GTS), Global Business Services (GBS), Software, Systems Hardware and Global Financing.
- d) The Complainant's revenue from its worldwide operations for the year ending 2015 was USD 81.741 billion and its Net income for the said year was USD 13.190 billion. The advertising and promotional expenses incurred by the Complainant in the year ending 2015 were USD 1,290 million.
- e) The Complainant owns trademark registrations for its mark/logo IBM for a broad range of goods and services, including, although not limited to, information technology related goods and services, in over 170 countries across the world including Argentina, Brazil, Cambodia, Canada, Hong Kong, Israel, Lao People's Democratic Republic, Philippines, Singapore, Taiwan, Thailand, United Kingdom, Chile, Finland, India, Ireland, Italy, Japan, Latvia, Philippines, Russian Federation, Slovakia, Sweden, Tonga, Turkey, United States of America and Vietnam.



- f) The Complainant holds trademark registrations for the mark/logo IBM in India in various classes including classes 09, 16, 18, 35, 36, 37, 38, 41, and 42. All these registrations are valid and subsisting.
- g) The Complainant contends that expression IBM also forms an integral part of the corporate/trading names of various wholly owned subsidiaries of the Complainant in different countries across the world. In India, the Complainant's wholly owned subsidiary "IBM Global Services India Private Limited" was incorporated in the year 1997. In the year 2006, the name of the said company was changed to "IBM India Private Limited". The revenue from operations of IBM India Private Limited for the financial year 2015-2016 was INR 230,048 Million.
- h) The Complainant owns hundreds of domain names incorporating its mark IBM, including <ibm.com>, which was created on 19.03.1986. The Complainant hosts an active website www.ibm.com under the domain name <ibm.com>. The Complainant also owns the domain name <ibm.in>, which was created on 14.02.2005. The said domain name redirects to the Complainant's website www.ibm.com.
- i) Forbes listed IBM at 5th position in its "The World's Most Valuable Brands" rankings for the year 2015. In the 2016 list of Forbes "The World's Most Valuable Brands" IBM featured at 7th position. BrandZ listed IBM at 3rd position in its list of "Top 100 Most Valuable Global Brands" for the year 2014. In the 2015 list of BrandZ's "Top 100 Most Valuable Global Brands", IBM featured at 4th position. Interbrand listed IBM at 6th position in its list of "Best Global Brands" for the year 2016. In the 2015 list of Interbrand's "Best Global Brands", IBM featured at 5th position. Fortune listed IBM at 32nd position in its list of "World's most Admired Companies" for the year 2016.
- j) The Complainant states that it actively enforces its rights in its well-known mark IBM and has succeeded in several complaints filed by it before the WIPO Arbitration and Mediation Center against third parties concerning adoption of the mark "IBM" or variations thereof as part of domain names. In July 9, 2010, domain name dispute between International Business Machines Corporation and Niculescu Aron Razvan Nicolae, Case No. DRO02010-0003, the panel concluded that the Complainant's trademark is well-known around the world.
- k) The Complainant also has a prominent social media presence, including accounts on Facebook with over 8,40,000 "likes", Twitter with over 3,30,000 followers and Instagram with over 1,07,000 followers.
- l) The Complainant in September 2016 learnt that the disputed domain name <ibmfinance.in> was registered in the name of the Respondent. It is stated that the Respondent was not hosting any active website under the said domain name and was rather using and continues to use the same to redirect the internet users to <http://ibmfiance.zohosites.com/>. This page except from providing some abstract information about certain financial services, does not contain any other information, details, exact nature and extent of party's business activities or address/contact details of such party.
- m) On September 23, 2016, the Complainant addressed an email to the Respondent, informing him of the Complainant's rights in the mark IBM and calling upon the Respondent to transfer the domain name <ibmfinance.in> to the Complainant. Another e-mail dated October 10, 2016 was sent to the Respondent, asking to let the Complainant know of its intention with respect to the domain name in contention. The Complainant did not receive any response from the Respondent to the aforesaid emails.



- n) The Complainant submits that the disputed domain name <ibmfinance.in> subsumes the Complainant's registered mark "IBM" and is thus identical and the expression "finance" being of a generic nature has no significance. Apart from Statutory rights, the Complainant also enjoys common law rights in its coveted and well-known mark "IBM". Pursuant to the long, continuous and extensive use of the IBM mark both internationally and in India, the mark IBM has come to be associated exclusively with the Complainant and its business activities.
- o) The Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent is not connected with the Complainant in any manner and the Complainant has not authorized or permitted the Respondent to apply for, register, or use the disputed domain name. Also, the Respondent is not hosting any active website under the said domain name and is using the disputed domain name merely as a tool to redirect the internet users to another page. Hence there is no bonafide offering of goods or services.
- p) The disputed domain name was registered and is being used in bad faith. The Respondent cannot possibly have any justification whatsoever for the adoption and use of the Complainant's well-known mark "IBM", which is an arbitrary mark. The Respondent has registered the disputed domain name with an intent to commercially gain and take undue advantage of the reputation and goodwill enjoyed by the Complainant in its world famous and well-known mark IBM, more so considering that fact that the Complainant also offers financing services under its coveted and well-known mark "IBM".

5) Respondent

The Respondent has not filed any official response dealing with contents of the Complaint. In the absence of any response to the allegations and submissions of the Complainant and considering two opportunities were granted, the complaint had to be decided based on submissions on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 4 of the INDRP policy.

6) Discussion and Findings:

The submissions and documents provided by the Complainant in support of use and registration of the mark IBM shows that the Complainant has been using the trademark IBM in relation to its products and services since 1924. Further, the Complainant has filed evidence in support of its ownership of trademark rights in the mark/logo IBM for a broad range of goods and services in over 170 countries across the world including USA, India and others.

In India, the Complainant has superior and prior rights in the mark IBM and filed its first trademark application IBM mark under registration no. 170687 in class 16 on September 03, 1955. It has been well established by the Complainant that its name and mark, IBM, is known all across the globe including India based on business rankings, trademark registrations, domain name registrations, several subsidiaries around various countries and recognitions. The Complainant has produced evidence dating back to the year 1924 in terms of incorporation certificate in United States of America and for the year 1997 for incorporation in India, registration certificates, various other business rankings by prestigious magazines, brand organizations and WIPO panel decisions which has been produced/annexed/discussed/referred.



Thus it can be said that:

- a) The Complainant has been delivering its products and services as world's leading technology and consulting organizations under the name and mark IBM with its presence in over 175 countries through its wholly owned subsidiaries. It is clear that the incorporation of the Complainant's predecessor dates back to the year 1911 as Computing-Tabulating-Recording Co. (C-T-R) which changed its name to "International Business Machines Corporation" in the year 1924 leading to birth of the mark IBM as an acronym.
- b) Based on the evidence placed on record, in India, the earliest registration for the mark IBM dates back to September 1995 secured in class 16 under Registration No. 170687 which has been filed in Annexure 6. Apart from the other registrations, the Complainant is also the registered proprietor of the mark/device IBM in class 36 under no. 1303262 covering financing service of computer hardware and software, computer solutions, loan services, lease purchase financing.
- c) The Complainant has secured various domain registrations for IBM as early as the year 1986 and the domain www.ibm.in was registered on February 14, 2005.
- d) The Complainant's name and mark IBM is considered as one of the most reputed and iconic brands worldwide and has been adjudged as "well-known" around the world as notified in annexed WIPO panel decision.
- e) The Complainant has lakhs of followers/fans for their various social media accounts like Facebook, Twitter, Instagram.

Based on the elaborate submissions and documents submitted by the Complainant, I now deal with the three requisite conditions laid in paragraph 4 of the .IN Domain Name Dispute Resolution Policy which is listed below. Further the Respondent has not contested the claims, therefore deemed to have admitted the contentions of the Complainant.

1) **The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;**

According to consensus view of WIPO Panellists, if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

Based on evidence filed by the Complainant, it is clear that the Complainant had prior and subsisting rights in the mark IBM world over with its earliest adoption dating back to year 1924 in United States of America. Further, it had secured several trademark registrations for the mark/logo IBM in several classes including class 36 in India. The earliest trademark registration for the mark IBM dates back to the year 1955. Further, the Complainant had also registered and incorporated its wholly owned subsidiary under the name "IBM Global Services India Private Limited" in India in the year 1997 which was further changed to "IBM India Private Limited" in the year 2006.

The Complainant has successfully established its statutory and common law trademark rights in the mark IBM worldwide including in India. As a next step, it has



to be ascertained if the domain name <ibmfinance.in> is identical to or confusingly similar with Complainant's mark.

The threshold test for confusing similarity under the domain name dispute involves a comparison between the Complainant's trademark and the domain name itself to determine likelihood of Internet user confusion. For this test to be resultantly positive, it is important that the Complainant's trademark stands out or is easily recognised within the domain name and/or its contents. Such contents of the disputed domain name may be common or suggestive or dictionary or descriptive terms. Addition of these aforementioned terms is generally perceived as one to be insufficient to prevent threshold Internet user confusion. Therefore, for undertaking such test, the disputed domain name should be compared visually and aurally or phonetically with the Complainant's trademark. Any domain name which demarcates the Complainant's mark from other common term or phrase used in domain name is essentially confusingly similar to the Complainant's relied-upon mark.

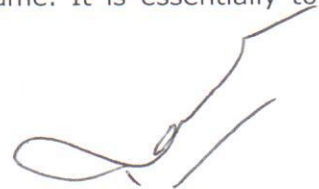
In the present case, the disputed domain name <ibmfinance.in> is essentially pronounced and meant to be stated as IBM+FINANCE. It is clear that use of the common term like finance will make any Internet users to believe that there is a real connection between the domain name and the Complainant in respect of its financing services. It is safe to assume that use of such common term do not add onto any distinctive character or value to the disputed domain name. In such scenario, the Complainant's trademark definitely constitutes the dominant or principal component of the domain name.

In ***Advance Magazine Publishers Inc. v. Arena International Inc. Case No. D2011-0203*** where the Respondent had registered <buyvogue.com> domain name, the panel observed that, *"when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity."* In this case, inclusion of the word "buy" does not distinguish the word "vogue" in the Disputed Domain Name from the VOGUE Trademarks given that luxury goods associated with the VOGUE Trademarks are, obviously, something that people "buy".. The VOGUE trademark is the dominant, recognizable portion of the Disputed Domain Name. The panel directed that the disputed domain be transferred in favour of the Complainant.

It is therefore concluded that domain name <ibmfinance.in> contains the Complainant's mark IBM entirely as one part alongwith common term FINANCE. Therefore, any internet user visiting the redirected website of the disputed domain owner will be confused by the legality of its contents and will assume that the domain name is affiliated or sponsored by the Complainant. Therefore, I find that disputed domain name is confusingly similar to the Complainant's mark IBM and to its score of services provided under the mark IBM. Therefore, the requirement of the INDRP Policy paragraph 4(i) is satisfied.

2) **The Registrant has no rights or legitimate interests in respect of the domain name;**

In primarily all domain name disputes, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. On making such *prima facie* case, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence to demonstrate rights or legitimate interests in the domain name. It is essentially to



note that if the Respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally adjudged based on the evidence produced by the Complainant to satisfy the substantive ground incorporated in paragraph 4(ii) of the INDRP Policy.

Paragraph 7 of INDRP Policy lists three non-exhaustive factors by which the Respondent may show that it has rights or legitimate interests in the Disputed Domain Names which includes

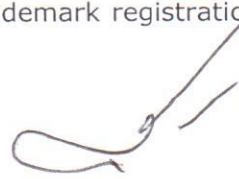
- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- (ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant has contended that the Respondent, an individual located in Visakhapatnam is not connected with the Complainant in any manner and the Complainant has not authorized or permitted the Respondent to apply for or register or use the disputed domain name.

Based on Complainant's contentions and evidence placed before me, it is not disputed that despite the Complainant's September 23, 2016 and October 10, 2016 dated emails, the Respondent hasn't come forward with any claims in respect of the disputed domain name which is corroborated by the fact that no response was received to the Arbitrator's emails dated January 16, 2017 and January 30, 2017. Such inaction on part of the Respondent suggests that he does not have any legitimate rights in the disputed domain name. Further, there is no active website under the said domain name and the same is redirecting to another webpage with different address. Such use and redirection does not constitute use of the disputed domain name with a bona fide offering of goods or services.

The Arbitrator has taken liberty to visit the disputed domain name which redirects to the website under the address <http://ibmfiance.zohosites.com/> wherein the owner seems to have mentioned IBM **FIANCE** (misspelt finance) on its webpage. Based on contents of the website, it is clear that domain owner seems to be providing financing solutions. Not only such financing services as claimed by the domain owner sneaks into the sphere of services covered by the Complainant's registered trademark IBM in class 36 in India, it also does not constitute making a legitimate non-commercial or fair use of the domain name. It is clear that the Respondent seems to be making illegitimate use of the domain name with dishonest intention for commercial gain by posing as sponsored website of the Complainant to the consumers to sell off its unauthorised financing services.

It is undisputed that the Complainant's mark IBM was used on worldwide basis since the year 1924. The Complainant has definite presence in India and has acquired both statutory and common law rights in the mark IBM owing to trademark registrations,



company registrations and extensive prior use in Indian jurisdiction. The Respondent's name is shown as Pakki Rama Krishna Patnaik. Since no response was filed by the Respondent, it is difficult to decipher that the Respondent has been commonly known by the domain name.

It is the Complainant's case that it has not authorised the Respondent to register or use the 'IBMFINANCE' domain name. The Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to show his interest in protecting his own rights and interest in the domain name.

Based on the above, I find that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3) **The Registrant's domain name has been registered or is being used in bad faith.**

Paragraph 6 of the INDRP policy explains "**Evidence of Registration and use of Domain Name in Bad Faith**:- For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

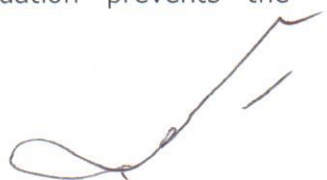
(i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

(ii) the Registrant has 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 the Registrant has engaged in a pattern of such conduct; or

(iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or 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.

Based on prior adoption, international and domestic use and various trademark and domain name registrations of IBM, it is believed that the Respondent was well aware of the Complainant's business, its products and services, its reputation and rights in the trade mark IBM on worldwide basis including in India. It is known fact that the disputed domain name redirects to the website under the address <http://ibmfiance.zohosites.com/> wherein the owner seems to be providing financing solutions under the name and mark IBM Fiance. Such actions prove that the Respondent has been actively suggesting its business as an off-shoot of the Complainant's extended business related to financing services, thus attracting Internet users to the its website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark.

In such cases, it is clear that the circumstance provided in Paragraph 6 (iii) is present. Further, dishonest act of registering the disputed domain name constituting the Complainant's mark IBM in entirety and in continuation prevents the



Complainant from registering the domain in its name. Hence, the instance in Paragraph 6 (ii) is also covered.

In absence of any response from the Respondent, it cannot be deciphered that the disputed domain was bonafidely adopted with all honest intentions. The only valid explanation for registering such disputed domain name seems to show active association and affiliation with the Complainant's set of products and services.

Based on the above, it can be concluded that the disputed domain name **was registered and its redirection to another website to sell off its services has been done in bad faith.**

7. Decision:

In view of the foregoing, I am convinced that the Complainant has made its case and the complaint is accordingly allowed. The Complainant has satisfied all the three requisite conditions laid down in paragraph 4 of the INDRP policy.

In accordance with the Policy and Rules, it is directed that the disputed domain name www.ibmfinance.in be transferred to the Complainant.



**RACHNA BAKHRU
SOLE ARBITRATOR
NIXI
INDIA
February 21, 2017**