

DISPUTE RESOLUTION SERVICE

D00019755

Decision of Independent Expert

IBM UNITED KINGDOM LIMITED

and

Qual Ltd

1. The Parties:

Complainant: IBM UNITED KINGDOM LIMITED  
IBM United Kingdom Limited  
Hursley Park  
Winchester  
Hampshire  
SO212JN  
United Kingdom

Respondent: Qual Ltd  
Unit 10 Gatwick Metro Centre  
Balcombe Road  
Horley  
RH6 9GA  
United Kingdom

2. The Domain Name(s):

ibm-servers-storage.co.uk  
ibm-system-storage.co.uk  
ibm-systemx.co.uk

### 3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

26 February 2018 14:06 Dispute received

27 February 2018 12:32 Complaint validated

27 February 2018 12:43 Notification of complaint sent to parties

16 March 2018 01:30 Response reminder sent

21 March 2018 08:47 No Response Received

21 March 2018 08:47 Notification of no response sent to parties

03 April 2018 09:37 Expert decision payment received

### 4. Factual Background

The Complainant owns many registrations for IBM around the world for information technology related goods and services dating back to at least the year 2000. IBM is a well known mark.

The Domain Names are being used to point to a site with prominent use of the IBM official logo in the masthead.

### 5. Parties' Contentions

The Complainant's contentions can be summarised as follows:

The Complainant owns many registrations for IBM around the world for information technology related goods and services. IBM is a well known mark.

The Domain Names are confusingly similar to the Complainant's mark. They consist of the IBM mark, followed by generic terms 'system', 'servers' or 'storage' and/or the letter 'x', hyphens and '.co.uk'.

System X was an IBM business sold to Lenovo in 2014. Lenovo are in agreement with suspension rather than transfer of ibm-systems.co.uk to the Complainant.

IBM-systemx.co.uk and ibm-system-storage.co.uk both re-direct to ibm-servers-storage.co.uk. The Domain Names are Abusive Registrations.

The Respondent registered with the Complainant as a business partner in 2004 and signed the Complainant's 'PartnerWorld Agreement'. As a result of misuse of the Complainant's trade mark the Complainant terminated this Agreement and any authority for the

Respondent to use the Complainant's marks on May 17, 2017. The Respondent is using the Domain Names in a way likely to confuse Internet users into believing the Domain Names are associated with the Complainant.

The Respondent did not file a Response.

## 6. Discussions and Findings

The Complainant is the owner of many trade mark registrations for IBM for information technology related goods and services dating back to at least the year 2000.

The Domain Names consist of the Complainant's IBM mark combined with the generic terms 'system', 'storage' or 'servers', hyphens and/or the letter 'x' and 'co.uk'.

The Expert agrees with the Complainant that the Domain Names are similar to the Complainant's trade mark as the additions to the Complainant's mark in the Domain Names are insufficient to distinguish the Domain Name from the Complainant's trade mark which is still recognisable in the Domain Names.

The Respondent entered into an agreement with the Complainant for use of the Complainant's trade marks. Following misuse of the Complainant's trade marks the Complainant terminated the agreement on May 17, 2017. The agreement provided that upon termination the Respondent would stop using the Complainant's trade marks.

The Domain Names are attached to a web page with such prominent use of the IBM official logo in its masthead that it appears to be an official site connected with the Complainant. This usage is not necessary for the Respondent to carry on business offering its services and amounts to passing off. As such the Domain Names have been used in a manner which has taken unfair advantage of and has been detrimental to the Complainant's rights. The Domain Names are, therefore, Abusive Registrations under the Nominet DRS Policy.

## 7. Decision

The Expert orders that [ibm-system-storage.co.uk](http://ibm-system-storage.co.uk) and [ibm-servers-storage.co.uk](http://ibm-servers-storage.co.uk) be transferred to the Complainant and [ibm-systemx.co.uk](http://ibm-systemx.co.uk) be suspended.

Signed .....

Dated .....