

ADMINISTRATIVE PANEL DECISION

Tubi, Inc. c/o Fox Corporation v. Registration Private, Domains By Proxy, LLC
/ Nguyen Hoang
Case No. DBZ2022-0002

1. The Parties

The Complainant is Tubi, Inc. c/o Fox Corporation, United States of America (“United States”), represented by Winterfeldt IP Group PLLC, United States.

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Nguyen Hoang, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <tubi.bz> 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 June 3, 2022. On June 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 10, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 10, 2022.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on June 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2022.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on July 20, 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.

4. Factual Background

The factual findings pertinent to the decision in this case are that:

- (1) the Complainant provides ad supported video-on-demand services by reference to the trademark, TUBI (the "Trade Mark");
- (2) the Complainant is the owner of, *inter alia*, United States Patent & Trademark Office ("USPTO") Reg. No. 5,414,516 from February 27, 2018, for the Trade Mark;
- (3) the disputed domain name was registered on February 22, 2022 and resolves to a website which streams ad supported videos-on-demand and which uses the Trade Mark, another of the Complainant's registered trade marks, TUBI TV, and which generally replicates the look and feel of the Complainant's own website; and
- (4) there is no commercial or other relationship between the Parties and the Complainant has not authorized the Respondent to use the Trade Mark or to register any domain name incorporating the Trade Mark.

5. Parties' Contentions

A. Complainant

The Complainant asserts trade mark rights in TUBI. It holds national registrations for the Trade Mark and submits that the disputed domain name is identical to the Trade Mark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name because it has no trade mark rights of its own; is not known by the disputed domain name; and the disputed domain name has been used to offer services competitive with those provided by the Complainant under the Trade Mark.

The Complainant alleges that the Respondent registered the disputed domain name in bad faith having targeted the Complainant's business.

The Complainant accordingly requests the Panel to order transfer of the disputed domain name.

B. Respondent

The Respondent did not submit a Response.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;

- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

It is the responsibility of the Panel to consider whether the requirements of the Policy have been met, regardless of the fact that the Respondent failed to submit a response. Having considered the Complaint and the available evidence, the Panel finds the following:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trade mark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to the trade mark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trade mark rights. It is accepted that a trade mark registered with a national authority is evidence of trade mark rights for the purposes of the Policy.¹ The Complainant provides evidence of its USPTO registration of the Trade Mark and so the Panel finds that the Complainant has trade mark rights.

The disputed domain name takes the Trade Mark and merely adds the country code Top-Level Domain (“ccTLD”), “.bz”, which can be disregarded for the purposes of comparing the disputed domain name with the Trade Mark.² The Panel finds that the disputed domain name is identical to the Trade Mark and so finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.³

B. Rights or Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the disputed domain name. Nevertheless, it is well settled that the Complainant need only make out a *prima facie* case, after which the onus shifts to the Respondent to rebut such *prima facie* case by providing evidence demonstrating rights or legitimate interests in the disputed domain name.⁴

Notwithstanding the lack of a response to the Complaint, paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

- “(i) before any notice to you of the dispute, your 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial 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”.

¹ See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

² See section 1.11.1 of the [WIPO Overview 3.0](#).

³ See, for example, *Vodafone Group PLC v. Yasin Kardas*, WIPO Case No. [DBZ2014-0001](#) (“The mere fact that the Respondent has added to the VODAFONE mark the country code Top-Level Domain (ccTLD) suffix “.bz” does not to this Panel affect the essence of the matter: the disputed domain name is identical to the trademark of the Complainant and, in the circumstances of this case, it is by itself sufficient to establish the criterion of identity or confusing similarity for purposes of the Policy, as many previous UDRP panels have found.”).

⁴ See, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

In consequence of these administrative proceedings, the Registrar confirmed the name of the domain name registrant as “Nguyen Hoang”, which does not provide any suggestion that the Respondent is commonly known by the disputed domain name. The Panel finds no other evidence that the Respondent might be commonly known by the disputed domain name.

Further, the Complainant states that there is no association between the Parties and there is nothing to contradict that claim. There is no evidence that the Respondent has any trade mark rights. The evidence is that the disputed domain name resolves to a website which offers video-on-demand, shows the Trade Mark and generally replicates the look and feel of the Complainant’s own website.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.⁵ By failing to reply to the Complainant’s contentions the Respondent has not rebutted that *prima facie* case.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and so the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

“(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 paragraph 4(b)(iv) has direct application to the facts. The Panel has already found the disputed domain name to be identical to the Trade Mark. Confusion is inevitable. The resolving website exists for commercial gain and so in terms of the Policy the Panel finds that the Respondent has used the disputed domain name intending to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Trade Mark as to the source, sponsorship, affiliation, or endorsement of that website.⁶

⁵ See section 2.5.3 of the [WIPO Overview 3.0](#) (“[A] respondent’s use of a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests.”); see also, for example, *Cable News Network, Inc. (CNN) v. Vinko Peric / CNN RTV*, WIPO Case No. [D2015-1434](#) finding no rights or legitimate interest by the respondent in disputed domain name <cnns.com> where the domain name was used to provide a news and information related website with links to third party sites and advertisements, precisely the services provided by the complainant under its CNN marks); *Twentieth Century Fox Film Corporation v. Domains By Proxy, Inc. / Samina Rahman*, WIPO Case No. [D2009-1121](#) finding no legitimate interest by respondent in disputed domain name <livefoxsports.info> where the domain name was used to offer online sports coverage, including live games, matches, and tournaments, services that are identical to those offered by the complainant under the complainant’s FOX SPORTS mark.

⁶ See, for example, *Cable News Network, Inc. (CNN) v. Vinko Peric / CNN RTV*, op. cit. finding that the complainant met the

The Panel finds that the Complainant has satisfied the third and final 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 finds that the Complaint has been established. Accordingly, the Panel orders that the disputed domain name <tubi.bz> be transferred to the Complainant.

/Debrett G. Lyons/

Debrett G. Lyons

Sole Panelist

Date: August 3, 2022

requirements of Paragraph 4(b)(iv) of the Policy where the respondent used the disputed domain name to divert Internet users to its own news and information website, in direct competition with the complainant's services, and monetized such web traffic.