

## **ADMINISTRATIVE PANEL DECISION**

### **Bitly, Inc. v. Sandro Shepard, Intus7, and Thuy Cuong Case No. D2023-1299**

#### **1. The Parties**

The Complainant is Bitly, Inc., United States of America (“United States”), represented by IPLA, United States.

The Respondents are Sandro Shepard, Intus7, Brazil and Thuy Cuong, Viet Nam.

#### **2. The Domain Names and Registrar**

The disputed domain name <bitlylink.com> is registered with Name.com, Inc.

The disputed domain names <bityli.com> and <bitylink.com> are registered with Dynadot, LLC.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 25, 2023. On March 27, 2023, the Center transmitted by email to Dynadot, LLC a request for registrar verification in connection with the disputed domain names <bityli.com> and <bitylink.com>. On March 28, 2023, Dynadot, LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names (Sandro Shepard, Intus7, referred to hereinafter as the “First Respondent”) which differed from the named Respondent (Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 2, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed a first amended Complaint on April 5, 2023.

The Center received email communications from the First Respondent on March 29 and March 31, and April 2, 2023. The Complainant filed a second amended Complaint on April 8, 2023, adding the disputed domain name <bitlylink.com>. On April 16, 2023, the Center transmitted by email to Name.com, Inc. a request for registrar verification in connection with the disputed domain name <bitlylink.com>. On April 18, 2023, Name.com, Inc transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name (Thuy Cuong, referred to hereinafter as the “Second Respondent”) which differed from the named Respondent (Whois Agent, Domain Protection Services, Inc.) and contact information in the amended Complaint. The Center sent an email communication to the Complainant on April 20, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed a third amended Complaint on April 21, 2023. The Center received email communications from the First Respondent on April 20, April 21, and May 3, 2023.

The Center verified that the Complaint together with the amended Complaints 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 Respondents of the Complaint, and the proceedings commenced on May 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 24, 2023. The First Respondent filed a response on May 17, 2023, while the Second Respondent did not file any response.

The Center appointed Edoardo Fano as the sole panelist in this matter on June 6, 2023. 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 has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is Bitly, Inc., a United States company operating in the fields of URL shortening services, link management, software, software services, mobile applications, and platforms related thereto, owning several trademark registrations for BITLY, among which:

- United States Trademark Registration No. 3,701,551 for BITLY, registered on October 27, 2009;
- Brazilian Trademark Registration No. 919397808 for BITLY, registered on November 24, 2020.

The Complainant also operates on the Internet, being "www.bitly.com" its website, and the domain name <bitly.com> was registered on November 12, 2003.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates: <bitlylink.com> on January 27, 2019, <bitlylink.com> on March 6, 2019, and <bityli.com> on August 23, 2019. When the Complaint was filed, the disputed domain name <bityli.com> was resolving to a website in Portuguese and English in which the same services as the Complainant, namely URL shortening services, were offered; the disputed domain name <bitlylink.com> was resolving to a website in English in which the same services as the Complainant, namely URL shortening services, were offered; finally, the disputed domain name <bitlylink.com> was redirecting to the website "www.bityli.com".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain names are confusingly similar to its trademark BITLY, as the latter is visually and phonetically recognizable in all three disputed domain names, the only differences being the addition/deletion/substitution of letters, in an intent of deliberate typosquatting, and, in two of the disputed domain names, the addition of the term "link".

The Complainant asserts that the Respondents have no rights or legitimate interests in respect of the disputed domain names since they have not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, they are not commonly known by the disputed domain names and they are not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names: the disputed domain names are resolving to websites offering the same URL shortening services provided by the Complainant under the trademark BITLY, with the aim to divert consumers and/or to capitalize on the Complainant's notoriety.

The Complainant submits that the Respondents have registered the disputed domain names in bad faith, since the Complainant's trademark BITLY is distinctive and well known in the field of URL shortening services. Therefore, the Respondents targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark, attempting to capitalize on consumer recognition of the Complainant's trademark, qualifies as bad faith registration and use.

## **B. Respondent**

The First Respondent, registrant of the disputed domain names <bityli.com> and <bitylink.com>, states that there are several websites still active on Internet using names similar to the Complainant's trademark BITLY, namely "bitily" and "bityli".

The First Respondent submits that his website "www.bityli.com" created in 2019 and having millions of shortened links, has currently no association with the Complainant's trademark BITLY, it was never used to harm or deceive anyone, and any Internet user accessing it is aware that it is not the Complainant's website.

The First Respondent is willing to transfer the disputed domain names to the Complainant, although he would like to keep the disputed domain name <bityli.com> pointed to his server, so that the links that are already shortened with the domain do not stop working, promising that the disputed domain name <bityli.com> will not be used for any other purpose.

The First Respondent asserts that the disputed domain name <bitylink.com> does not belong to him, as he already stated in several previous email communications.

The Second Respondent, registrant of the disputed domain name <bitylink.com>, has made no reply to the Complainant's contentions and is in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

## **6. Discussion and Findings**

### **6.1 Consolidation of Multiple Respondents**

The Complainant has requested consolidation of multiple Respondents and stated that all the disputed domain names belong to the same person or organization. No objection to this request was made by the Second Respondent, while the First Respondent has denied to be related to the disputed domain name <bitylink.com>, registered by the Second Respondent.

Pursuant to the [WIPO Overview 3.0](#), section 4.11.2, "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also

underpin panel consideration of such a consolidation scenario". The Panel may consider a range of factors to determine whether consolidation is appropriate, such as examining relevant registrant contact information, and any naming patterns in the disputed domain names, or other evidence of respondent affiliation that indicate common control of the disputed domain names.

The Complainant states that the First Respondent, registrant of the disputed domain names <bityli.com> and <bitylink.com>, admitted in his email communication of April 5, 2023 to own also the disputed domain name <bitylink.com>, and the Complainant submits that all the disputed domain names were registered in a short span of 5 months, they have very similar naming patterns, and they all redirects to very similar websites offering the same services as the Complainant, namely URL shortening services.

The First Respondent, registrant of the disputed domain names <bityli.com> and <bitylink.com>, denies to be related to the disputed domain name <bitylink.com>, registered by the Second Respondent, and states that his assertion to be the owner of the disputed domain name <bitylink.com> was due to a typo, as at the end of the same email of April 5, 2023, the First Respondent was clearly stating to be the owner of the disputed domain names <bityli.com> and <bitylink.com> only.

The Panel notes that all the disputed domain names have been registered in the same short period of time, namely between January 27, 2019 and August 23, 2019, they follow a very similar naming pattern and two of them, namely <bityli.com> and <bitylink.com>, resolved to rather different websites, in which the same URL shortening services as the Complainant's were offered, while the third one, <bitylink.com>, was redirecting to the website "www.bityli.com". The Panel finds that there is not plausible evidence that the disputed domain names <bityli.com> and <bitylink.com>, on the one side, and the disputed domain name <bitylink.com>, on the other side, are subject to common control, and that it would not be fair and equitable to all Parties to accept the Complainant's consolidation request. The Panel's finding is not only based on the fact that two of the disputed domain names, namely <bityli.com> and <bitylink.com>, resolved to rather different websites, but also because unrebutted surface evidence suggests that the First and the Second Respondents are two separate registrants, with different registrant information and contact details, and they have used different registrars. The Panel further notes that the First Respondent objected to the consolidation request, submitting in several email communications to be the owner of the disputed domain names <bityli.com> and <bitylink.com> only, while his assertion to be also the owner of the disputed domain name <bitylink.com> in the email communication of April 5, 2023, is considered by the Panel as a plausible typo, as repeatedly stated by the First Respondent. The Panel therefore rejects the Complainant's consolidation request and will deal only with the disputed domain names <bityli.com> and <bitylink.com>. It is, of course, open to the Complainant to file a separate Complaint in respect of the domain name <bitylink.com>.

Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, "the Respondent", meaning the First Respondent, registrant of the disputed domain names <bityli.com> and <bitylink.com>.

## **6.2 Substantive Issues**

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant is the owner of the trademark BITLY and that the disputed domain names are confusingly similar to the trademark BITLY, by adding/deleting/substituting letters and, in one of the disputed domain names, by adding the term "link".

The Panel notes that this is a typical case of a deliberate misspelling of a mark (so-called “typosquatting”), by adding, deleting, substituting or reversing the order of letters in a mark, where numerous UDRP panels in the past have found confusing similarity to be present. See [WIPO Overview 3.0](#), section 1.9.

Regarding the addition of the term “link”, the Panel notes that it is now well established that the addition of other terms (whether descriptive, geographical terms, letters, or otherwise) to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark. The additional term “link” does not therefore prevent the disputed domain name <bitylink.com> from being confusingly similar to the Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain, in this case “.com”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

## **B. Rights or Legitimate Interests**

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent may establish rights or legitimate interests in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you [the respondent] of the dispute, [the respondent’s] your use of, or demonstrable preparations to use, the domain names or a name corresponding to the domain names in connection with a *bona fide* offering of goods or services; or  
(ii) [the respondent] you (as an individual, business, or other organization) have been commonly known by the domain names, even if you have acquired no trademark or service mark rights; or  
(iii) [the respondent] you are making a legitimate noncommercial or fair use of the domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is generally more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names in order to shift the burden of production to the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in his Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services. The disputed domain name <bityli.com> was resolving to a website in Portuguese and English in which the same services as the Complainant, namely URL shortening services, were offered, while the disputed domain name <bitylink.com> was redirecting to the website “www.bityli.com”.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that he has rights or legitimate interests in the disputed domain names. The Respondent submits that his website “www.bityli.com”, to which the other disputed domain name

<bitylink.com> redirects, was created in 2019 and has millions of shortened links, has currently no association with the Complainant's trademark BITLY, it was never used to harm or deceive anyone and any user accessing it is aware that it is not the Complainant's website. The Respondent, although willing to transfer the disputed domain names to the Complainant, would like to keep the disputed domain name <bityli.com> pointed to his server, so that the links that are already shortened with the domain do not stop working, promising that this domain will not be used for any other purpose.

The Panel notes that the Respondent operates in the same field of the Complainant, namely providing competing URL shortening services, and finds that the Respondent's use of the disputed domain names to resolve and redirect users to a competing website does not support a claim to rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.3.

The Panel therefore concludes that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that "for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has 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 the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that [the respondent 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 respondent has] engaged in a pattern of such conduct; or
- (iii) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent'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 respondent's] web site or location or of a product or service on [the respondent's] web site or location".

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark BITLY in the field of URL shortening services is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the confusingly similar disputed domain names, especially because the disputed domain names, both being misspelled versions of the Complainant's trademark BITLY, resolved to a website in which the same services provided by the Complainant, namely URL shortening services, were offered, and the term "bityli" was reproduced in a very similar typography to the one used by the Complainant for its trademark BITLY as it appears in the Complainant's official website "www.bitly.com".

The Panel further notes that the disputed domain names are also being used in bad faith since the Respondent is trying to attract Internet users to his website by creating likelihood of confusion with the Complainant's trademark as to the disputed domain names' source, sponsorship, affiliation or endorsement.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain names in order both to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to his website in accordance with paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain names in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

## **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 disputed domain names <bityli.com> and <bitylink.com> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: June 14, 2023