

## ADMINISTRATIVE PANEL DECISION

First Citizens Bancshares, Inc. v. Chauncey McPufferson, Bitly  
Case No. D2023-5122

### 1. The Parties

Complainant is First Citizens Bancshares, Inc., United States of America (“United States” or “U.S.”), represented by Safenames Ltd., United Kingdom.

Respondent is Chauncey McPufferson, Bitly, United States.

### 2. The Domain Names and Registrar

The disputed domain names <firstcitizenonlinesupport.com> and <firstcitizens.wiki> (the “Disputed Domain Names”) are registered with Wild West Domains, LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 7, 2023. On December 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On December 11, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on December 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 17, 2023.

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 Respondent of the Complaint, and the proceedings commenced on December 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 19, 2024.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on January 31, 2024. 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

Complainant states that it “is a banking company” that “traces its routes to 1898” and “began using the FIRST CITIZENS term in 1929.” Complainant further states that it “now has over 500 branches across the United States, with over USD 200 billion in total assets” and is listed on the Nasdaq stock exchange (symbol: FCNCA). Complainant further states that it acquired Silicon Valley Bank on March 27, 2023, “which specialised in banking for the tech industry in the San Francisco Bay Area” and “suffered a widely-publicised bank run in early 2023.”

Complainant states, and provides evidence to support, that it owns a number of federal trademark registrations in the United States for marks that consist of or include “FIRST CITIZENS,” including the following (the “FIRST CITIZENS Trademark”):

- U.S. Reg. No. 1,728,084 for FIRST CITIZENS (registered October 27, 1992)
- U.S. Reg. No. 2,490,378 for FIRSTCITIZENS.COM (registered September 18, 2001)
- U.S. Reg. No. 3,398,286 for FIRST CITIZENS DIRECT (registered March 18, 2008)

The Disputed Domain Names were created on April 10, 2023 (<firstcitizensonlinesupport.com>) and July 20, 2023 (<firstcitizens.wiki>). Complainant states that they are used to “redirect to a placeholder page of Bitly” and “essentially advertise the services of this company,” which, according to screen recordings provided by Complainant, provide “custom branded links.”

#### 5. Parties’ Contentions

##### A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, Complainant contends that:

- Complainant has rights in the FIRST CITIZENS Trademark as a result of the registrations cited above, and the Disputed Domain Names are identical or confusingly similar to the FIRST CITIZENS Trademark because the Disputed Domain Name <firstcitizens.wiki> is identical to the FIRST CITIZENS Trademark, and the Disputed Domain Name <firstcitizensonlinesupport.com> contains the FIRST CITIZENS Trademark plus “generic words” that “would typically be associated with banking, given this is a common service in the industry, and is a service offered by the Complainant itself.”

- Respondent has no rights or legitimate interests in the Disputed Domain Names because, inter alia, Respondent has no trademark rights for the term FIRST CITIZENS; Respondent “is not known, nor has ever been known, by FIRST CITIZENS or anything similar”; Complainant has not granted a license to Respondent to use the Disputed Domain Names; “online users expecting to land on webpages operated by the Complainant are automatically redirected to an unrelated website,” which does not constitute a *bona fide* use; and Respondent’s redirection of the Disputed Domain Names is not a fair use because “[a]n online user landing on the webpage would believe the Complainant’s online presence or services to be inoperable, as users would associate the Domain Names with the Complainant given its use of the FIRST CITIZENS brand.”

- The Disputed Domain Names were registered and are being used in bad faith because, inter alia, Respondent has failed to reply to Complainant's cease and desist letters; "Respondent registered the Disputed Domain Name <firstcitizensonlinesupport.com> at a time when the Complainant had recently completed a high-profile acquisition of Silicon Valley Bank," which "further suggests that the Respondent must have known of the FIRST CITIZENS trademark when registering <firstcitizensonlinesupport.com>, and later <firstcitizens.wiki>"; "Respondent appears to have submitted fake details when registering the Disputed Domain Names" because "Chauncey McPufferson" "is the name of an office pet"; to the extent that the websites to which the Disputed Domain Names redirect are considered "'placeholders' caused by a lack of active use by the Respondent," the passive holding doctrine applies; "mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith"; and Respondent has engaged in a pattern of conduct by registering 10 other domain names that contain third-party trademarks, some of which are in the financial sector.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The entirety of the mark is reproduced within each of the Disputed Domain Names. Accordingly, the Disputed Domain Names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Further, the Panel finds the mark is recognizable within the Disputed Domain Names. Although the addition of other terms to the Disputed Domain Name <firstcitizensonlinesupport.com> here, "online" and "support," may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between that Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Disputed Domain Names. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

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

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

In the present case, the Panel notes that Respondent, who is located in the United States, has registered and used domain names that contain a trademark protected by multiple registrations, the oldest of which was issued about 31 years before creation of the first of the Disputed Domain Names, and that Complainant is a public company with more than 500 branches in the United States and more than USD 200 billion in total assets. Therefore, the Panel agrees with section 3.1.4 of [WIPO Overview 3.0](#), which states that “the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

The Disputed Domain Names redirect to “www.bitly.com”. The Panel finds that, on the balance of probabilities, and noting the lack of response, the Disputed Domain Names were registered and are being used in bad faith.

The Panel finds that Complainant has established the third 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 orders that the Disputed Domain Names <firstcitizenonline.com> and <firstcitizens.wiki> be transferred to the Complainant.

*/Douglas M. Isenberg/*

**Douglas M. Isenberg**

Sole Panelist

Date: February 8, 2024