

ADMINISTRATIVE PANEL DECISION

Bitly, Inc. v. Hung Tran
Case No. D2024-1782

1. The Parties

The Complainant is Bitly, Inc., United States of America, represented by IPLA, LLP, United States of America.

The Respondent is Hung Tran, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <bitly.mobi> 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 April 27, 2024. On April 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 29, 2024, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 30, 2024 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 amendment to the Complaint on April 30, 2024.

The Center verified that the Complaint together with the amendment to the 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 May 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 4, 2024.

The Center appointed Torsten Bettinger as the sole panelist in this matter on June 11, 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

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. It is the registered proprietor of inter alia the following trademark registrations:

- United States Trademark Registration No. 3,701,551 for BITLY, registered on October 27, 2009 for goods and services in classes 35 and 38;
- United States Trademark Registration No. 6,220,001 for BITLY, registered on December 15, 2020 for goods and services in classes 9, 35, 38 and 42.

The Complainant operates its online presence at the domain name <bitly.com>.

According to the Whois records, the disputed domain name was registered on May 18, 2023.

The Complainant provided a screenshot that shows that on April 24, 2024 the disputed domain name resolved to a website offering URL shortening services and displaying the Complainant's stylized trademark BITLY.

5. Parties' Contentions

A. Complainant

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

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that the disputed domain name is visually and phonetically identical to the Complainant's BITLY Marks.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the disputed domain name has not been utilized in connection with a bona fide offering of goods or services as it was used for URL shortening services competing with those of the Complainant;
- the Complainant is not aware of any trademark rights, domain name rights, or other rights that correspond with the disputed domain name;
- the Complainant has not authorized the Respondent to use its BITLY trademark in connection with any goods or services; and
- there is no evidence that the Respondent is commonly known by the disputed domain name.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant asserts that:

- it has been substantially, exclusively, and continuously used the BITLY Marks worldwide long before the Respondent purchased or registered the disputed domain name;
- by registering an identical domain name and using it to offer URL shortening services competing with those of the Complainant the Respondent registered and used the disputed domain name with the intent to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's BITLY Marks as to the source, sponsorship, affiliation, or endorsement of the website and the products offered therein;
- the Respondent knew of the Complainant's prior trademark rights as it has used the Complainant's stylized BITLY mark, on the website to which the disputed domain name resolved.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

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

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 the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 the 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 the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the record, the Complainant asserts without contradiction by the Respondent that the Respondent has used the disputed domain name for a website displaying the Complainant's stylized BITLY trademark in order to deceive the public into thinking the content of the website is created or authorized by the Complainant and is offering URL shortening services competing with those of the Complainant. Panels have held that the use of a domain name for illegal activity, here impersonating the Complainant for fraudulent

purposes, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel therefore 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 the Complainant provided evidence of multiple trademark registrations for the BITLY mark that predate the registration of the disputed domain name.

In light of the extensive use of the Complainant's BITLY trademark and the fact that the disputed domain name resolved to a website that apparently attempts to impersonate the Complainant by displaying the Complainant's stylized BITLY mark, the Panel has no doubt that the Respondent was aware of the Complainant and the Complainant's trademark rights when registering the disputed domain name.

The Panel therefore concludes that the Respondent registered the disputed domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Respondent registered the disputed domain name with the bad faith intent to attract Internet users, for commercial gain, by creating a likelihood confusion with the Complainant. Moreover, the website has deceived consumers by using the Complainant's stylized BITLY trademark with the intent to deceive the public into thinking the content of the website is created or authorized by the Complainant.

Panels have held that the use of a domain name for illegal activity, here impersonating the Complainant for fraudulent purposes, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel therefore finds the Respondent's registration and use of the disputed domain name constitutes bad faith under 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 name <bitly.mobi> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: June 25, 2024