

ADMINISTRATIVE PANEL DECISION

WhatsApp LLC v. Domain Administrator, See PrivacyGuardian.org / chen ying-zhen

Case No. D2022-2675

1. The Parties

The Complainant is WhatsApp LLC, United States of America (“United States”), represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / chen ying-zhen, Taiwan Province of China.

2. The Domain Name and Registrar

The disputed domain name <whatsappdownload.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 July 28, 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 July 29, 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 August 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 5, 2022.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on September 9, 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 Complainant operates the world-famous WhatsApp messaging and voice-over-IP service and mobile application in various languages.

The Complainant owns various trademark registrations for the mark WHATSAPP in many jurisdictions around the world, including:

- United States Trademark No. 3939463 for WHATSAPP, registered on April 5, 2011;
- International Trademark Registration No. 1085539 for WHATSAPP, registered on May 24, 2011;
- International Trademark Registration No. 1095940 for a green WHATSAPP figurative mark, registered on October 6, 2011;
- European Union Trademark No. 010496602 for a green and white figurative mark (the “WhatsApp logo”), registered on May 18, 2012.

Moreover, the Complainant owns a number of domain names, containing the mark WHATSAPP.

The Respondent registered the disputed domain name on November 13, 2017.

On November 30, 2020 the disputed domain name was pointing to a website in English which provided information on WhatsApp and offered active or inactive links to various WhatsApp downloads for different devices, as well as a commercial banner for a YouTube account and a disclaimer at the bottom stating that the website was not associated with WhatsApp. The website previously associated with the disputed domain name made prominent use of the Complainant’s trademarks and logo.

On January 21, 2021, the Complainant sent a cease and desist letter to the Respondent in an attempt to resolve the matter amicably. No response was received.

On February 5, 2021, following the Complainant’s notice, the disputed domain name started to resolve to a web page offering the disputed domain name for sale.

On February 8, 2021, the Complainant sent an email to the Respondent acknowledging the change of use of the disputed domain name and restating its wish to have the disputed domain name transferred to the Complainant. No response was received.

At the time of filing of the Complaint, the disputed domain name redirected to the website of BitYard.com (“www.bityard.com”) which is a well-known cryptocurrency exchange.

For the time of consideration of this Complaint, the disputed domain name does not resolve to an active web page.

5. Parties’ Contentions

A. Complainant

The Complainant relies on its rights in its WHATSAPP trademark. It states that the disputed domain name incorporates its WHATSAPP trademark in its entirety with the addition of the letter “s” and the descriptive term “download” under the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant asserts its WHATSAPP trademark is clearly recognizable as the leading element of the disputed domain name.

The Complainant's assertion is that it has established that the disputed domain name is confusingly similar to its WHATSAPP trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard, the Complainant states that:

(i) the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent is neither a licensee of the Complainant nor has the Respondent been authorised to make any use of the Complainant's WHATSAPP trademark in a domain name or otherwise;

(ii) the Respondent cannot legitimately claim to be commonly known by the disputed domain name;

(iii) the Respondent is not currently making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers.

The Complainant also claims that the disputed domain name was registered and is being used in bad faith. It formerly resolved to a website including the Complainant's figurative trademarks and commercial banners. The Complainant submits that by using the disputed domain name the Respondent attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name resolved, by creating a likelihood of confusion with the Complainant's WHATSAPP trademark as to the source, sponsorship, affiliation, or endorsement of that web page and the goods and services advertised therein, in bad faith.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

(i) the disputed domain name is identical or confusingly similar to the trademarks or service marks 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.

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistently with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

It is the Panel's view that the Complainant has clearly and sufficiently demonstrated its rights in the WHATSAPP trademark. The Panel is satisfied that the Complainant is well-known by its WHATSAPP trademark as one of the world's most popular messaging services.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy. See [WIPO Overview 3.0](#), section 1.8.

The Panel, therefore, finds that the Complainant's WHATSAPP trademark is clearly recognizable in the disputed domain name, and the addition of the letter "s" and the descriptive term "download" does not prevent a finding of confusing similarity.

Finally, it has also long been held that the gTLDs, such as ".com", are generally disregarded when evaluating the confusing similarity of a disputed domain name. See [WIPO Overview 3.0](#), section 1.11.1.

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

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of "proving a negative", in particular as the evidence needed to show the Respondent's rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

The Panel notes that there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization. There is no evidence of the Respondent having acquired or applied for any trademark registrations for "whatsapp" or any variation thereof, as reflected in the disputed domain name.

Moreover, the Respondent reproduces the Complainant's earlier registered trademarks in the disputed domain name (and, previously, on the website associated with the disputed domain name) without any license or authorization from the Complainant, which suggests lack of rights or legitimate interest.

This Panel also finds that the Respondent's former use of the disputed domain name, containing the Complainant's trademark, to point to a website including hyperlinks purportedly enabling the downloading of WhatsApp application and including the Complainant's figurative trademarks, does not represent use of the disputed domain name in connection with a *bona fide* offering of goods or services. The Panel notes that the nature of the disputed domain name itself carries a risk of implied affiliation, especially when considering the impersonating nature of the content that used to be exhibited at the relevant website (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Panel finds that use of the disputed domain name to host an impersonating website offering the Complainant's application for download cannot be qualified as a *bona fide* offering of goods or services or legitimate noncommercial or fair use (see section 2.13.1 of the [WIPO Overview 3.0](#)). Same as the Respondent's further use of the disputed domain name to resolve to a website offering the disputed domain name for sale does not represent use of the disputed domain name in connection with a *bona fide* offering of goods or services.

Finally, the Respondent's use of the disputed domain name to redirect to a third-party currency exchange website, does not represent use of the disputed domain name in connection with a *bona fide* offering of goods or services. See *Tommy Bahama Group, Inc. v. Zhong Qing Ma*, WIPO Case No. [D2022-1428](#).

At the time of consideration of the Complaint, the disputed domain name does not resolve to an active web page. Such passive holding of the disputed domain name does not constitute a *bona fide* offering of goods and services either. See *WhatsApp Inc. v. Whois Privacy Service / Raj Lakkaraju, Ptechpeople*, WIPO Case No. [D2020-1291](#).

In the absence of a Response, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c), or provide any other evidence of rights or legitimate interests in the disputed domain name.

Noting the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

According to the Complainant, the Respondent could not credibly claim not to have had knowledge of the Complainant's WHATSAPP trademark at the time of registration of the disputed domain name in 2017, by which time WhatsApp had amassed over 1 billion monthly active users. Having considered renown status of the Complainant and its goodwill worldwide, the Panel agrees. Moreover, the Panel is of the opinion that the Respondent, having no relationship with the Complainant or authorization to make use of its trademark in a domain name or otherwise, proceeded to register the disputed domain name, which is confusingly similar to the Complainant's trademark, in full knowledge of the Complainant's rights, in bad faith.

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy paragraph 4(b)(iv) in view of the Respondent's past use of the disputed domain name. As it was established by the Panel, formerly the disputed domain name resolved to a website offering the Complainant's WhatsApp application for download and displaying the Complainant's figurative trademarks and commercial banners. The presence of a disclaimer at the bottom of the website associated with the disputed domain name in November 2020 did not serve to render the Respondent's activities *bona fide*, as the Respondent's website clearly created a misleading impression of endorsement by the Complainant. See *Instagram, LLC v. Protection of Private Person / Mehmet Azat Metin*, WIPO Case No. D2019- 2553.

As it was found by the Panel, after sending the cease-and-desist letter by the Complainant the disputed domain name was used to resolve to a website offering the disputed domain name for sale. According to the Panel, such use of the disputed domain name to capitalize upon the Complainant's reputation and goodwill clearly constitutes bad faith use under the Policy. See *Oculus VR, LLC v. PrivacyGuardian.org / Vildan Erdogan*, WIPO Case No. [D2018-0464](#).

At the time of filing of the Complaint, the disputed domain name redirected to a currency exchange website. The Panel finds that by using the disputed domain name in such a way, the Respondent was intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's WHATSAPP trademark as to the source, sponsorship, affiliation, or endorsement of its website and the services offered therein, in bad faith pursuant to paragraph 4(b)(iv) of the Policy. Prior UDRP panels have held that using a domain name in such a way constitutes use in bad faith. See, *Artemis Marketing Corp. v. ICS INC., ORM LTD*, WIPO Case No. [D2018-1590](#).

While the disputed domain name may no longer resolve to an active website, given the totality of circumstances found above and in light of the passive holding doctrine found in section 3.3 of the

[WIPO Overview 3.0](#), the current inactive status of the disputed domain name does not prevent a finding of bad faith.

In light of these particular circumstances, the Panel concludes that the Complainant has succeeded in proving the requirement of paragraph 4(a)(iii) that the disputed domain name was registered and is being used in bad faith by the Respondent.

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, <whatsappdownload.com>, be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: September 18, 2022