

ADMINISTRATIVE PANEL DECISION

WhatsApp LLC v. Knock Knock WHOIS Not There, LLC / Chaitanya Wanjare
Case No. D2022-1879

1. The Parties

The Complainant is WhatsApp LLC, United States of America (“United States” or “USA”), represented by Tucker Ellis, LLP, USA.

The Respondent is Knock Knock WHOIS Not There, LLC, USA / Chaitanya Wanjare, India.

2. The Domain Name and Registrar

The disputed domain name <songwhatsappstatus.com> is registered with Automattic Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2022. On May 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 26, 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 May 27, 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 1, 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 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 23, 2022.

The Center appointed Peter Burgstaller as the sole panelist in this matter on July 6, 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 Respondent registered the disputed domain name on May 25, 2020 (amended Annex 2 to the Complaint).

The Complainant operates the world-famous WhatsApp messaging and voice-over-IP service and mobile application in various languages (Annexes 5, 6, 7, 8, and 9 to the Complaint).

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

- USA Registrations No. 3,939,463, registered April 5, 2011, and No. 4,083,272, registered January 10, 2012;
- European Union Registrations No. 14814347, registered April 26, 2016, and No. 14988844, registered September 5, 2016;
- International Registrations No. 1396913, registered December 21, 2017, and No. 1491341, registered October 16, 2018, designated for various countries around the world (Annexes 11, and 12-01 – 12-07 to the Complaint).

Moreover, the Complainant owns a number of domain names, containing the mark WHATSAPP (Annex 10 to the Complaint).

The disputed domain name redirects Internet users to a WordPress template webpage indicating that the site is private (Annexes 13, and 14). Moreover, the disputed domain name previously addressed a website displaying different status-categories for the Complainant's mobile application, and using the Complainant's trademark (Annex 15 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant operates the WhatsApp messaging and voice-over-IP service and mobile application. The Complainant is a global leader in messaging services for mobile devices, with over 2 billion people in over 180 countries now using the WhatsApp messaging and voice-over IP service to stay in touch with friends and family via free messages and calling. The Complainant enables its users to send text messages and voice messages, make voice and video calls, and share images, documents, user locations, and other content with one another. The Complainant's messaging and voice-over-IP service is available in 60 different languages.

The Complainant owns the exclusive rights to the WHATSAPP mark, which it has used for over twelve years. Besides its extensive common law rights in the WHATSAPP mark, the Complainant owns numerous registrations protecting the WHATSAPP mark in the United States and around the world.

The Complainant's use of the WHATSAPP mark, in the United States and throughout the world, has been extensive, continuous, and substantially exclusive. The Complainant has made and continues to make a substantial investment of time, effort, and expense in the promotion of its goods and services, and the WHATSAPP mark. As a result of the Complainant's efforts and use, the WHATSAPP mark is inextricably linked with the products and services offered by the Complainant. The WHATSAPP mark is unquestionably recognized around the world as signifying high-quality, authentic goods and services provided by the Complainant.

In addition to the <whatsapp.com> domain name, the Complainant owns and operates numerous other domain names consisting of the WHATSAPP mark in combination with various generic and country code Top-Level-Domain extensions, including <whatsapp.net>, <whatsapp.org>, and <whatsapp.us>.

The disputed domain name, which adds the term “song” before and the term “status” after the Complainant’s WHATSAPP mark, is confusingly similar to the Complainant’s WHATSAPP mark.

The Respondent has registered the disputed domain name. However, the Respondent has no rights or legitimate interests in the disputed domain name: The Complainant has not licensed nor authorized the Respondent to use the Complainant’s WHATSAPP mark, nor does the Respondent have any legal relationship with the Complainant that would entitle the Respondent to use the WHATSAPP mark. Further, neither the Whois data for the disputed domain name nor the corresponding website available at the disputed domain name supports that the Respondent is known by the disputed domain name. Moreover, the Respondent does not make a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark of the Complainant.

The Respondent currently uses the disputed domain name to redirect Internet users to a WordPress template webpage indicating that the site is private. Such use is not a legitimate noncommercial or fair use.

Finally, the Respondent has registered and is using the disputed domain name in bad faith:

The disputed domain name was registered in bad faith since the Respondent knew or should have known about the existence of the well-known WHATSAPP mark when registering the disputed domain name.

Moreover, the 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.

The use of a disputed domain name to host a WordPress template page with no substantive content constitutes passive holding of the disputed domain name which is within the scope of bad faith use.

Accordingly, the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

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 trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to 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

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the trademark WHATSAPP.

The disputed domain name is confusingly similar to the Complainant's registered trademark WHATSAPP since it entirely contains this famous and distinctive mark and only adds the word "song" before and the word "status" after the Complainant's WHATSAPP mark.

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 section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)").

Finally, it has also long been held that the generic Top-Level-Domains ("gTLDs") are generally disregarded when evaluating the confusing similarity of a disputed domain name.

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

B. Rights or Legitimate Interests

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's famous and distinctive mark in its entirety together with the terms "song" and "status", cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Also, the fact that the disputed domain name redirects to a WordPress webpage indicating that the site is private, does not constitute a use in connection with a *bona fide* offering of goods or services within the meaning of the Policy; the same is in particularly true with regard to the previous use of the disputed domain name to address a website displaying different status-categories for the Complainant's mobile application.

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has rights and is the owner of the well-known, famous and highly distinctive registered trademark WHATSAPP, which is registered and used in many jurisdictions around the world. Moreover, the Complainant registered and is using various domain names containing the WHATSAPP trademark, e.g. <whatsapp.com>, <whatsapp.org>, <whatsapp.net> and <whatsapp.us>, among others.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive trademark WHATSAPP entirely.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The disputed domain name is actively used since the Respondent redirects Internet users to a WordPress website showing that the site is private without further substantive content; this constitutes active usage without *bona fide* offering of goods or services. Moreover, Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names 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 (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Furthermore, this Panel also finds bad faith use, putting emphasis on the following:

- the Complainant's trademark WHATSAPP is famous with a high distinctiveness and is well-known globally;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;
- the disputed domain name incorporates the Complainant's trademark in its entirety, and is thus suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant's site);
- the disputed domain name previously was used to address a website displaying status-categories for the Complainant's mobile application; and
- there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

Taking all these facts and evidence into consideration this Panel finds that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) 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 name <songwhatsappstatus.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: July 18, 2022