

ADMINISTRATIVE PANEL DECISION

WhatsApp LLC v. Gustavo Ceccato
Case No. D2022-2786

1. The Parties

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

The Respondent is Gustavo Ceccato¹, Brazil.

2. The Domain Name and Registrar

The disputed domain name <whatsappbusiness.site> 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 July 27, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 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 August 1, 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 August 3, 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”).

¹ At the time of the filing of the Complaint, the Respondent’s identity was masked by a privacy service.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 28, 2022.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on September 5, 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:

- Brazilian Trademark No. 831031522, WHATSAPP, registered on October 14, 2014;
- United States Trademark No. 3939463, WHATSAPP, registered on April 5, 2011; and
- International Registrations No. 1085539, WHATSAPP, registered on May 24, 2011.

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

The Respondent registered the disputed domain name on November 3, 2021. In December 2021, the disputed domain name resolved to a website under construction in Portuguese stating "WhatsApp course for small business. A complete course for you who are a local business entrepreneur". At the time of filing of the Complaint and considering this case, the disputed domain name does not resolve to an active web page.

On June 29, 2022, the Complainant submitted the registrar's registrant contact form to reach out to the Respondent. No response was received.

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 term "business". The Complainant asserts its WHATSAPP trademark is clearly recognisable as the leading element of the disputed domain name.

The Complainant notes that it provides a messaging application specifically designed for business under the name "WhatsApp Business". This was launched on January 18, 2018.

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 relies on the doctrine of passive holding.

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 consistent 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 section 1.8 of [WIPO Overview 3.0](#)).

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

Moreover, the Panel notes that previous UDRP panels have found that similarly-constructed domain names were confusingly similar to the Complainant's WHATSAPP trademark. See *WhatsApp LLC v. Cetin Etem Sezgin*, WIPO Case No. [D2021-2275](#) (<whatsappbusiness.com>); *WhatsApp LLC v. Ercan Balci, Mahallem*, WIPO Case No. [D2022-0889](#) (<whatsappbusiness.net> et al.); and *WhatsApp LLC v. Registration Private, Domains By Proxy, LLC / shalih Irshad*, WIPO Case No. [D2022-2236](#) (<whatsappbusiness.online>).

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

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 without any license or authorization from the Complainant, which is a strong evidence of the lack of rights or legitimate interest.

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 under the Policy. In this regard, prior UDRP panels have found that the non-use of a domain name does not amount to use of the domain name in connection with any *bona fide* offering of goods or services. See *WhatsApp Inc. v. Whois Privacy Service / Raj Lakkaraju, Ptechpeople*, WIPO Case No. [D2020-1291](#) (<whatsappdeals.com>).

Furthermore, prior UDRP panels have held that unauthorized service providers using a domain name containing a third-party trademark to provide services in relation to the trade marked goods or services may be making a *bona fide* offering of goods or services and thus have a legitimate interest in such domain name. Whether this is the case is typically measured against the so-called *Oki Data* criteria (see [WIPO Overview 3.0](#), section 2.8):

- (i) The respondent must actually be offering the goods or services at issue;
- (ii) The respondent must use the site to sell only the trade marked goods or services;
- (iii) The site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) The respondent must not try to “corner the market” in domain names that reflect the trademark.

Having duly considered the case, the Panel established the fact that the Respondent failed to fulfil the *Okidata* criteria, at least para (i) and (iii) of the above.

In addition, prior UDRP panels have found that certain domain names consisting of a complainant’s trademark together with an additional term, tend to suggest sponsorship or endorsement by the trademark owner, see [WIPO Overview 3.0](#), section 2.5.1. In the present case, the Panel has found that the disputed domain name itself, comprising the Complainant’s WHATSAPP trademark together with a reference to the Complainant’s “WhatsApp Business” product, carries with it a high risk of implied affiliation with the Complainant and therefore cannot give rise to any legitimate claim of fair use.

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.

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 in connection with a website in Portuguese purportedly offering “WhatsApp course for small businesses” and displaying the same colour scheme as the Complainant’s official website. Under the Panel’s view this clearly demonstrates actual knowledge of the Complainant and its trademark, and leaves no doubt as to the Respondent’s awareness of the Complainant at the time of registration and intent to profit from misleading Internet users to its website.

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. Relevant factors under this doctrine, which apply in this case, are:

(i) the Complainant’s WHATSAPP trademark is well-known internationally and has become exclusively associated with the Complainant. When confronted with the disputed domain name, many Internet users would be confused and wrongly assume that the disputed domain name is owned by or otherwise endorsed by the Complainant;

(ii) there is no evidence of the Respondent’s actual contemplated *bona fide* use of the disputed domain name. Despite the Complainant’s efforts to contact the Respondent, the Respondent has not come forward with any response or evidence of *bona fide* intent;

(iii) the combination of the Complainant’s WHATSAPP trademark together with the term “business” carries a risk of implied affiliation with the Complainant, which leads the Panel to find it implausible that the disputed domain name could be put to any good faith use by the Respondent.

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, <whatsappbusiness.site> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: September 11, 2022