

## **ADMINISTRATIVE PANEL DECISION**

WhatsApp LLC v. Domain Administrator, See PrivacyGuardian.org / Cao Zhou

Case No. D2022-3043

### **1. The Parties**

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

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / Cao Zhou, China.

### **2. The Domain Name and Registrar**

The disputed domain name <iwhatsappmarketing.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 August 18, 2022. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 18, 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 19, 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 22, 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 September 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2022. The Respondent sent three email communications on September 13, 14, and 15, 2022, mentioning that he was the owner of the disputed domain name and requesting the extension of the response due date. The Center granted the extension to

submit a response until October 3, 2022. The Respondent did not submit any formal Response. Accordingly, the Center sent the Commencement of Panel Appointment Process email on October 6, 2022. In addition, the Respondent sent an informal communication on October 21, 2022 indicating that he has closed the website.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on October 11, 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 WhatsApp messaging and voice over IP service and mobile application. Its WHATSAPP trademark has been used since 2009 and is registered in various countries, such as in the United States under Reg. No. 3939463 as of April 5, 2011.

The disputed domain name was registered on October 12, 2020 and was used to impersonate the Complainant as well as provided a commercial website containing advertising and links to unrelated third-party websites. Currently it does not resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant is a global leader in messaging services for mobile devices, with over 2 billion people in over 180 countries using the Complainant's services.

The disputed domain name incorporates the Complainant's trademark exactly with the letter "i" as a prefix and the word "marketing" as a suffix. This is not sufficient to distinguish the disputed domain name from the Complainant's trademark.

The Respondent has not been authorized to use the Complainant's trademark or the disputed domain name and there is no relationship between the parties. The Respondent is not known by the disputed domain name in any way. The Respondent has no right and legitimate interest to use the Complainant's trademark in the disputed domain name, and instead, is using it to impersonate the Complainant and to provide a commercial website containing advertising and links to unrelated third-party websites.

The registration and commercial use of a similar disputed domain name to create confusion and thereby taking advantage of the Complainant's mark supports a finding of bad faith under the Policy. The website to which the disputed domain name resolved features also the Complainant's logo. The disputed domain name has been registered to impersonate the Complainant and to provide a commercial website containing links to third-party websites diverting Internet users to a website where they can download an alternative social chat application.

##### **B. Respondent**

The Respondent did not substantially reply to the Complainant's contentions, but on October, 21 2022 sent an informal email to the Center that he has closed the website. Also, the Respondent sent informal email communications on September 13, 14, and 15, 2022, indicating that he was the owner of the disputed domain name.

## 6. Discussion and Findings

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain names are identical or confusingly similar to this trademark.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test".

Furthermore, "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements". See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain name is confusingly similar to the Complainant's trademark as it includes the Complainant's trademark entirely combined with the letter "i" and the term "marketing". This does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain names.

This means that the disputed domain name is confusingly similar with the Complainant's trademark and hence the first element of the Policy has been fulfilled.

### B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain name.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* showing indicating the absence of the respondent's rights or legitimate interests in a disputed domain name the burden of production shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant's trademark. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Considering the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain name. Therefore, the Panel finds that the second element of the Policy is fulfilled.

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

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or

(iv) by using the domain name, [the 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 the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.”

The Panel agrees that the Complainant's trademark is a well-known trademark. Hence the Respondent must have been aware of the Complainant and its trademark when registering the disputed domain name. See section 3.1.4 of the [WIPO Overview 3.0](#).

The disputed domain name is currently not in use, but the Complainant has shown that it has been used to offer links to third-party websites offering competing chat applications. The Respondent's use of Complainant's WhatsApp Mark and telephone logo clearly evidences the Respondent's awareness of Complainant and its marks at the time of registration.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. This is particularly so with domain names incorporating the mark plus a descriptive term, as in this case. See section 3.1.4 of the [WIPO Overview 3.0](#).

The disputed domain name currently resolves to an error page. Accordingly, the disputed domain name is not in active use, see *e.g.*, *Accenture Global Services Limited v. Domain eRegistration*, WIPO Case No. [D2018-1994](#).

This, however, does not prevent the finding of bad faith under the doctrine of passive holding. See section 3.3 of [WIPO Overview 3.0](#).

Considering that the Panel has found that the Complainant's trademark is well known, that the disputed domain name is confusingly similar to it, the Respondent has not responded to the Complainant's contentions, the Respondent has used a privacy protection service to conceal its identity, there are no obvious good faith or legitimate uses to which the disputed domain name may be put, the Panel considers, on balance, that the disputed domain name has been registered and is being used in bad faith.

Therefore, the Panel finds that the third element of the Policy is fulfilled.

## **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 <iwhatsappmarketing.com> be transferred to the Complainant.

*/Tuukka Airaksinen/*

**Tuukka Airaksinen**

Sole Panelist

Date: October 26, 2022