

ADMINISTRATIVE PANEL DECISION

WhatsApp LLC. v. Sanjay kumar
Case No. D2022-3045

1. The Parties

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

The Respondent is Sanjay kumar, India.

2. The Domain Name and Registrar

The disputed domain name, <whatsapp-status-video.com> (the “Domain Name”), 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 August 18, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 19, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 23, 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 24, 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 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2022. Aside from an informal communication, the Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on September 19, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on September 22, 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.

The invitation to the Complainant to file an amended Complaint stemmed from the fact that the Domain Name was registered in the name of a privacy service. In response to the Center's registrar verification request, the Registrar disclosed the name and address of the entity in whose name the Domain Name is currently registered. The amended Complaint names the underlying registrant as the Respondent.

4. Factual Background

The Complainant, a Delaware limited liability company, operates messaging and voice-over-IP services under and by reference to the name "WhatsApp", a name that it has used since 2009. The Complainant is the registered proprietor of numerous trade mark registrations covering the "WhatsApp" name. One such registration is United States Registration No.3,939,463 WHATSAPP (standard character mark) registered on April 5, 2011 (application filed on April 1, 2009) for a variety of services in class 42.

The Complainant also makes use of a telephone device in the provision of its service offerings. That device is covered by various trade mark registrations held by the Complainant including, by way of example, United States Registration No.4,359,872 a device mark described on the register as "[consisting] of a green speech bubble outlined in white, with a telephone in the center" registered on July 2, 2013 (application filed on December 9, 2011) for downloadable software and other goods in class 9 and telecommunication services in class 38 (the "telephone logo").

That the Complainant's WHATSAPP trade mark is very well known internationally is clear from the evidence before the Panel and as repeatedly recognised in previous decisions under the Policy. In *WhatsApp Inc. v. Donald Huen*, WIPO Case No. [D2020-2331](#) the panel stated:

"The global recognition of the Complainant's trademark is well evidenced in prior UDRP decisions, repeatedly maintaining that "Complainant's trademark WHATSAPP has become well known around the world"; that it is "composed of a coined term that confers to it certain distinctiveness" and that "Respondents must have been aware of the existence of Complainant's trademark WHATSAPP at the time of registration of each disputed domain name." See *WhatsApp, Inc. v. Domain Manager, SHOUT marketing SL, and Gonzalo Gomez Rufino, River Plate Argentina, and Gonzalo Gomez Rufino, SHOUT Marketing SL*, WIPO Case No. [D2018-1581](#).

The Domain Name was registered on October 15, 2018 and is currently connected to a webpage bearing the message: "This site is not a part of the WhatsApp website or Whatsapp LLC. Additionally, this site is NOT endorsed by WhatsApp in ANY WAY. WhatsApp is a trademark of Whatsapp LLC."

The unchallenged evidence of the Complainant, supported by screen shots, shows to the satisfaction of the Panel that prior to the filing of the Complaint the Domain Name connected to a multilingual website purportedly suggesting statuses and videos for use with the Complainant's WhatsApp application, while directing users to commercial webpages featuring sponsored advertisements and links that download files directly to a user's computer. The website made liberal use of the WHATSAPP trade mark and the Complainant's telephone logo

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent registered the Domain Name with knowledge of the Complainant's trade marks and with a view to impersonating the Complainant. Further, the Complainant cites other cases in which domain names registered by the Respondent have been directed to be transferred to the complainants, including *Bharti Airtel Limited v. Domain Admin, c/o ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org / Sanjay Kumar, North Infra Tel India Ltd*, WIPO Case No. [D2017-0928](#); and *Grundfos Holding A/S v. Sanjay Kumar, Flowguards/ Sanjay K. Wighmal, Grund Fosseals/Sanjay/Sanjayk Wighmal*, WIPO Case No. [D2012-2355](#). The Complainant contends that this is evidence of bad faith registration and use within the meaning of paragraph 4(b)(ii) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

B. Identical or Confusingly Similar

The Domain Name comprises the Complainant's WHATSAPP trade mark followed by a hyphen, the dictionary word "status", another hyphen, the dictionary word "video" and the ".com" generic Top-Level Domain identifier.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The Complainant's WHATSAPP trademark is readily recognizable in its entirety in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights.

C. Rights or Legitimate Interests

The Complainant asserts that it has no connection with the Respondent and has given the Respondent no permission to use its WHATSAPP trade mark.

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, and contends that none of them is applicable. The Respondent contends that the use being made of the Domain Name cannot constitute a *bona fide* offering of goods or services for the purposes of paragraph 4(c)(i) of the Policy; self evidently from the Registrar's Whois record, the Respondent is not commonly known by the Domain Name, rendering paragraph 4(c)(ii) of the Policy inapplicable; finally, the Complainant contends that the use being made of the Domain Name is a commercial use, is not fair and is not covered by paragraph 4(c)(iii) of the Policy.

The Panel is satisfied that the Complainant has made out a *prima facie* case under this element of the Policy; in other words, a case calling for an answer from the Respondent. The Respondent has not responded to the Complainant's contentions. While respondents may fail to respond for a variety of reasons, in this case the Panel is satisfied on the balance of probabilities that the Respondent has failed to respond because he has no satisfactory answer to the Complainant's contentions.

The original use of the Domain Name to which the Complainant objected has now been replaced by a parking page featuring a message reading: "This site is not a part of the WhatsApp website or Whatsapp LLC. Additionally, this site is NOT endorsed by WhatsApp in ANY WAY. WhatsApp is a trademark of Whatsapp LLC." The Panel does not know who is responsible for this message, but the fact that it was thought necessary to post it, confirms what, in the view of the Panel is obvious, namely that the nature of the Domain Name is such that it is calculated to give rise to confusion.

The Panel can conceive of no basis upon which the Respondent could be said to have acquired rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered and Used in Bad Faith

The Complainant's primary contention is that the Respondent registered the Domain Name with knowledge of the Complainant's WhatsApp trade mark and intending to use it for the purpose for which it has until recently been used, namely to impersonate the Complainant and to divert traffic to his website for commercial gain. In the view of the Panel the evidence filed by the Complainant amply supports that contention. The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

While it is true that the Respondent is currently making no active use of the Domain Name, he could do so at any moment and, on the Panel's findings thus far, it is more likely than not that any such use will be damaging to the Complainant's reputation and goodwill. On the evidence before him and in the absence of anything to the contrary from the Respondent, the Panel cannot conceive of any use that the Respondent could make of the Domain Name without unfairly targeting the Complainant's trade mark rights. As such, this non-use or so-called "passive use" constitutes in the view of the Panel an unjustified threat hanging over the head of the Complainant and, as such, a continuing abusive use of the Domain Name.

The Complainant has also produced evidence of several other cases in which domain names registered by the Respondent have been directed to be transferred to the complainants in those cases (see section 5A) and refers to paragraph 4(b)(ii) of the Policy, which provides: "you have 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 you have engaged in a pattern of such conduct."

The Panel accepts that the evidence of other similar cases involving the Respondent as identified in section 5A is strongly suggestive of a pattern, but the Panel doubts that the Respondent had any thought of preventing the Complainant from registering the Domain Name and there is nothing before the Panel to show that the Complainant might have had any interest in registering such a domain name. In the view of the Panel the Respondent's sole aim was to generate commercial income through impersonation of the Complainant (paragraph 4(b)(iv) of the Policy). Nonetheless, if there had been any doubt as to the Respondent's bad faith intent, this evidence would have removed it.

The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(iv) 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 Domain Name, <whatsapp-status-video.com>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: September 28, 2022