

ADMINISTRATIVE PANEL DECISION

WhatsApp LLC v. Vikrant Bajaj
Case No. D2022-3423

1. The Parties

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

The Respondent is Vikrant Bajaj, India.

2. The Domain Name and Registrar

The disputed domain name <videowhatsappstatus.com> 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 September 15, 2022. On September 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 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 (Domains By Proxy, LLC). The Center sent an email communication to the Complainant on September 16, 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 September 20, 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 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 18, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on October 27, 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 a messaging and voice over IP service and mobile application and owns the trademarks and service marks for WHATSAPP, in which it also claims common law rights. The Complainant has numerous registrations for the WHATSAPP mark in the United States and around the world, including in the European Union ("EU"), *inter alia* WHATSAPP U.S. trademark, registered April 5, 2011, No. 3,939,463; WHATSAPP U.S. trademark registered January 10, 2012, No. 4,083,272; and WHATSAPP EU trademark registered April 26, 2016, No. 014814347; WHATSAPP EU trademark registered September 5, 2016, No. 014988844; and WHATSAPP EU trademark registered October 25, 2011, No. 009986514.

The Complainant also owns and operates the <whatsapp.com> domain name and other domain names consisting of the WHATSAPP mark in combination with various generic and country code Top-Level Domains, including <whatsapp.net>, <whatsapp.org>, and <whatsapp.us>.

The Respondent uses the disputed domain name to resolve to a website purporting to provide statuses and videos for use with the Complainant's WhatsApp application.

The disputed domain name was registered on August 12, 2019.

5. Parties' Contentions

A. Complainant

The Complainant offers messaging services for mobile devices. The Complainant says that over 2 billion people in over 180 countries use WhatsApp for communications. WhatsApp enables its users to send text messages and voice messages, make voice and video calls, and share images, documents, user locations, and other content, and it is available in 60 different languages. The WhatsApp mobile application has consistently ranked among the top apps in the market in recent years.

WhatsApp has a "status" feature which allows users to share text, photo, video, and GIF updates for other users to view and interact with. The Complainant contends that in this matter, the disputed domain name misappropriates all the textual components of the Complainant's WHATSAPP mark, such that an ordinary Internet user who is familiar with it would think an affiliation exists between the disputed domain name and the Complainant.

The Complainant points out that numerous prior panels have held that the addition of descriptive terms to a complainant's mark in a domain name fails to distinguish the domain name from the mark. Here the disputed domain name incorporates the Complainant's WHATSAPP mark in its entirety as a dominant element. The Complainant says that the additional terms "status" and "video" do not sufficiently distinguish or differentiate the disputed domain name from its trademark. Both terms are descriptive of and relevant to the Complainant's services.

The Complainant says that it establishes a *prima facie* case by showing that a respondent (1) is not authorized to use the marks, and (2) is not known by a complainant's mark and points out that it has not licensed nor authorized the Respondent's use of its mark. The Complainant has no legal relationship with the Respondent that would entitle the latter to use the WHATSAPP trademark. The Complainant says that neither WhoIs nor the website to which the disputed domain name resolves indicate that the Respondent is known by the disputed domain name.

The Respondent has no legitimate reason for using the WHATSAPP trademark within the disputed domain name, according to the Complainant. Instead, the Respondent is using it to provide a website purportedly suggesting statuses and videos for use with the Complainant's WhatsApp application while featuring sponsored advertisements that redirects Internet users to a commercial website and displaying links that download files directly to a user's computer.

The Complainant points out that the Respondent also prominently and repeatedly uses the WHATSAPP trademark throughout its website. The Respondent also uses the FACEBOOK and INSTAGRAM trademarks on the website and claims that its status suggestions can be used with Facebook and Instagram applications. Both the Complainant and Instagram, LLC are owned by Meta Platforms, Inc., and so the Complainant says that consumers may associate the Respondent's use of the FACEBOOK and INSTAGRAM marks with the Complainant and its WHATSAPP trademark.

The Complainant maintains that the Respondent's use of the disputed domain name tricks prospective consumers into believing that they are accessing a website affiliated or associated with the Complainant, and then navigating its website (likely generating click-through revenue for the Respondent) and downloading files directly to their computers.

The Complainant points out that the disputed domain name is also on at least one black list in relation to spam, malware or other domain name abuse. The Respondent's use of the WHATSAPP trademark within the disputed domain name is also said to be a clear violation of the terms of use relating to the mark WHATSAPP.

The Complainant says that the Respondent does not appear to be commonly known by the disputed domain Name and the WhoIs data do not identify a person or company commonly known by the disputed domain name.

The Complainant maintains that the Respondent makes a plainly commercial use of the disputed domain name and does so by misleadingly diverting consumers searching for the Complainant. Despite including a disclaimer webpage on its relevant website the Respondent makes no effort to clarify that it has no legitimate connection or affiliation with the Complainant or its WHATSAPP trademark. The Complainant says that this further indicates an absence of rights or legitimate interests in the disputed domain name.

The Complainant points out that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights as evidenced by the former's use of the Complainant's WHATSAPP mark throughout the website to which the disputed domain name resolves. The Respondent registered the disputed domain name on August 12, 2019, which, the Complainant points out, postdates the registration and use of the WHATSAPP trademark by many years. The Respondent's bad faith is said to be indicated also by the fact that the disputed domain name is listed on one or more black lists concerned with spam, malware, or other domain name abuse.

In conclusion, the Complainant contends that given the fame of the Complainant's WHATSAPP trademark, and the Respondent's unauthorized incorporation of that trademark in the disputed domain name, there are no circumstances under which the Respondent's use of the disputed domain name could plausibly be in good faith under the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is not identical to the WHATSAPP registered trademark of the Complainant. However, that mark appears in its entirety in the disputed domain name, flanked by two other terms. The mark is immediately visible and recognizable. The additional terms do not prevent this conclusion and therefore the first element is satisfied.

Therefore, the Panel holds that the disputed domain name is confusingly similar to the WHATSAPP trademark of the Complainant.

B. Rights or Legitimate Interests

There is nothing before the Panel that indicates that the Respondent has rights or legitimate interests in the disputed domain name. The Respondent has not replied to any of the contentions of the Complainant in this regard, or in any way. The Respondent has not been authorized to use the very distinctive trademark WHATSAPP of the Complainant, which is also highly reputed in many jurisdictions. There is no indication that the Respondent is known by the disputed domain name or has any form of entitlement to use the Complainant's trademark. The Respondent's name, initially hidden by a privacy service, has no connection or similarity to the disputed domain name. The disputed domain name resolves to a website that makes unauthorized use of the Complainant's trademark. This is not the type of activity that results in the recognition of legitimate interests, or indeed of rights vested in the Respondent. Rather, the composition of the disputed domain name itself, consisting of the WHATSAPP trademark along with terms descriptive of certain features on the Complainant's services, carries a risk of implied affiliation that cannot constitute fair use. Moreover, given the presence of sponsored links redirecting Internet users to third party commercial websites, the use of the disputed domain name can hardly be considered a *bona fide* noncommercial offering.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

When the disputed domain name was registered in 2019, the WHATSAPP trademark already benefited from a strong reputation in many jurisdictions. It is unimaginable that the Respondent was unaware of the Complainant's registered mark, or of the fact that the Complainant had exclusive rights in it. In any case, the composition of the disputed domain clearly indicates that the Respondent was well aware of the registered mark and the service for which it is used, and indeed registered. Further, the Respondent has also replicated the Complainant's mark in the website to which the disputed domain name resolves, and that again without any authority to do so. The utilization of the mark in this manner, combined with its inclusion in the disputed domain name, constitutes an obvious attempt to mislead Internet users into thinking that they are dealing with an authorized or legitimate service offered by the Complainant or its associates. That is obviously not the case, since in fact the Respondent is making a bad faith attempt to benefit from the confusion he deliberately attempts to generate by registering and utilizing the confusingly similar disputed domain name.

Therefore, the Panel holds that the disputed domain name was registered and is used in bad faith.

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 <videowhatsappstatus.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: November 10, 2022.