

## **ADMINISTRATIVE PANEL DECISION**

WhatsApp, LLC v. Edmunds Gaidis

Case No. D2022-3467

### **1. The Parties**

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

The Respondent is Edmunds Gaidis, Latvia.

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

The disputed domain names <whatsapp.com> (“the disputed domain name 1”) and <wwatsapp.com> (“the disputed domain name 2”) are registered with DropCatch.com LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2022. On September 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 26, 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 29, 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 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 20, 2022. The Center received an email from the Respondent on October 4, 2022. The Center notified the commencement of Panel appointment process on October 21, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on October 31, 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 is a provider of a popular mobile messaging application named “WhatsApp” and specializes in messaging services for mobile devices. The Complainant was founded in 2009 and acquired by Facebook in 2014.

The WhatsApp application is available and active in many countries. Its system enables 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. It is one of the most downloaded applications worldwide.

The Complainant owns the exclusive rights to the WHATSAPP trademarks and service marks including:

(i) United States Trademark Registration No. 3,939,463 registered on April 5, 2011;

(ii) International Trademark Registration No. 1085539 registered on May 24, 2011 (which covers China among other countries);

(iii) European Union Trade Mark No. 009986514 registered on October 25, 2011.

The Complainant also owns numerous domain names consisting of or including its WHATSAPP trademark, including <whatsapp.com>.

The disputed domain name 1 was registered on May 19, 2022 and the disputed domain name 2 was registered on September 10, 2019.

Depending on which web browser is used, the disputed domain name 1 is associated with either a warning webpage stating that its associated website has been reported for containing phishing threats or a parking page with pay-per-click links.

The disputed domain name 2 resolves to a parking page displaying pay-per-click links and also a link redirecting to a webpage stating that this disputed domain name may be for sale and inviting to make an offer.

The Respondent was previously involved as the respondent in other domain name proceedings, where the panels ordered the transfer of all disputed domain names to the complainants.

On July 25, 2022, the Complainant’s legal representatives sent a cease and desist letter to the Respondent, asserting the Complainant’s trademark rights and requesting the transfer of the disputed domain names. In the absence of a response, a follow up letter was sent on August 23, 2022. No reply was received.

#### **5. Parties’ Contentions**

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

The Complaint asserts to own numerous trademark registrations for WHATSAPP in jurisdictions worldwide and to have established these rights for the purposes of paragraph 4(a)(i) of the Policy. The disputed domain names incorporate the WHATSAPP trademark in entirety with the addition of a single letter “s” in the

disputed domain name 1 and “w” in the disputed domain name 2. The addition of these single letters does not prevent a finding of confusing similarity as the WHATSAPP trademark remains clearly recognizable in the disputed domain names. Therefore, the disputed domain names are confusingly similar to the Complainant’s WHATSAPP trademark.

The Complainant further asserts that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent would indeed be unable to invoke any circumstances set out in paragraph 4(c) of the Policy that would demonstrate its rights or legitimate interests in the disputed domain names as the Respondent is not using the disputed domain names in connection with any *bona fide* offering of goods or services:

- The Respondent is not a licensee of the Complainant.
- The disputed domain names are associated with a parking page displaying pay-per-click advertising from which the Respondent or a third party presumably derives revenue.
- The disputed domain name 1 is associated with a warning page which is self-explanatory.

Additionally, the Complainant sustains that the Respondent:

- is not commonly known by the disputed domain names (the Complainant in particular refers to the Respondent’s name and the fact that the Respondent does not own any trademark rights in WHATSAPP);
- is not making a legitimate noncommercial or fair use of the disputed domain names (the Complainant refers to the pay-per-click links displayed on the parking pages associated with the dispute domain names).

The Complainant finally alleges that the disputed domain names were registered and are being used in bad faith. In this context, the Complainant underlines that its WHATSAPP trademark which has been continuously used since 2009 is highly distinctive and well-known throughout the world, including in Europe where the Respondent is based. It is thus inconceivable that the Respondent did not have knowledge of the Complainant’s WHATSAPP trademark when registering the disputed domain names. The Complainant further submits that the Respondent has engaged in a pattern of conduct within the meaning of paragraph 4(b)(ii) by registering the disputed domain names and other numerous domain names incorporating the Complainant’s trademarks or third-party trademarks for the purpose of preventing trademark owners from reflecting their trademarks in corresponding domain names.

The Respondent is using the disputed domain names to intentionally attract, for commercial gain, Internet users to his websites by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of the websites in accordance with paragraph 4(b)(iv) of the Policy. In this regard, the Complainant refers to the pay-per-click links inserted in the webpages associated with the disputed domain names and reminds that it is not necessary for the Respondent to have directly profited himself from this system. Furthermore, the Complainant also reminds that a warning page is associated with the disputed domain name 1. The Respondent’s failure to reply to the cease and desist letters and to the Complaint is also indicative of the Respondent’s bad faith.

## **B. Respondent**

The Respondent did not formally reply to the Complainant’s contentions. The Respondent sent an informal email stating “I want suspend the present dispute to explore settlement talks”. The Complainant requested to continue with the procedure.

## **6. Discussion and Findings**

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in 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 showed trademark rights in WHATSAPP through several trademark registrations worldwide.

According to section 1.7, of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. 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 disputed domain names contain the WHATSAPP trademark in entirety. The mere addition of the single letter “s” in the disputed domain name 1 (“whatsapps.com”) and “w” in the disputed domain name 2 (“~~w~~whatsapp.com”) does not prevent a finding of confusing similarity. Indeed, the Complainant’s WHATSAPP trademark remains clearly recognizable.

Under these circumstances, the Panel concludes that the disputed domain names are confusingly similar to the Complainant’s mark.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1, [WIPO Overview 3.0](#).

The Complainant made sufficient statements in order to demonstrate that the Respondent would have no rights or legitimate interests in the disputed domain names.

In particular, the Panel notes that the case file does not show that the Respondent would be known as “Whatsapp” or that a legitimate business would be run by the Respondent under the disputed domain names.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case and the burden of production shifts to the Respondent who has chosen not to reply.

As already stated before, nothing is contained in the case file which would show that the disputed domain names have been legitimately used by the Respondent or that that the Respondent would have any rights or legitimate interests in the disputed domain names.

More specifically, the use of a domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see section 2.9., [WIPO Overview 3.0](#)).

Furthermore, the nature of the disputed domain names, incorporating the Complainant's well-known trademark with the addition of a single letter, carries a risk of Internet user confusion <https://www.wipo.int/amc/en/domains/search/overview3.0/>.

Consequently, the Panel finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

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

The Complainant has shown that its WHATSAPP trademark has been registered and used since several years in many countries, before the registration of the disputed domain names. It is undisputed that the WHATSAPP trademark is extremely popular and well-known particularly in Europe where the Respondent is based.

Hence, the Panel finds that the Respondent thus knew or should have known about the Complainant's WHATSAPP trademark and deliberately registered the confusingly similar disputed domain names (see section 3.2.2, [WIPO Overview 3.0](#)).

The disputed domain names resolve to a webpage with pay-per-click links to third party websites which is an indication that the Respondent holds the disputed domain names aiming at a potential commercial gain.

The Panel further notes that the Respondent is known for having unduly registered other domain names containing trademarks owned by the Complainant or third parties which is an additional indication of bad faith in the present circumstances.

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain names in bad faith and that the Complainant has established its case 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 names <whatsapp.com> and <wwatsapp.com> be transferred to the Complainant.

*/Theda König Horowicz/*

**Theda König Horowicz**

Sole Panelist

Date: November 21, 2022