

ADMINISTRATIVE PANEL DECISION

WhatsApp, LLC v. Host Master, 1337 Services LLC
Case No. D2023-1147

1. The Parties

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

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Name and Registrar

The disputed domain name <whatsappchannel.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On March 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2023, 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 March 16, 2023 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 March 21, 2023.

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 March 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on April 21, 2023. 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 one of the world's most popular mobile messaging applications (or "app"). Founded in 2009 and acquired by Meta Platforms Inc. (formerly Facebook Inc.) in 2014, WhatsApp allows users across the globe to exchange messages for free via smartphones.

The Complainant owns several trademark registrations for WHATSAPP in various jurisdictions, including the following:

- European Union Trade Mark No. 009986514, registered on October 25, 2011
- International registration No. 1085539, registered on May 24, 2011
- United States Trademark Registration No. 3930463, registered on April 5, 2011 and

The Complainant is the registrant of numerous domain names consisting of the WHATSAPP trademark under various generic Top-Level Domains ("gTLDs") (among others: <whatsapp.com>, <whatsapp.net>, and <whatsapp.org>), as well as under many country code Top Level Domains ("ccTLDs").

The Complainant is active on various social media and has developed a strong presence online.

The disputed domain name <whatsappchannel.com> was registered on May 4, 2021.

According to the evidence submitted with the Complaint, the disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

- Since its launch in 2009, WhatsApp has become one of the fastest growing and most popular mobile applications in the world, with 2 billion monthly active users worldwide (as of October 2023). WhatsApp has consistently being ranked amongst Google Play and Apple iTunes' 25 most popular free mobile applications and is the 4th most downloaded application worldwide as per App Annie's Top Apps Worldwide Ranking in 2023.
- The Complainant is the owner of numerous WHATSAPP trademark registrations in many jurisdictions throughout the world.
- The Complainant owns several domain names and has a strong presence on the different social media available online, having, for instance, approximately 33 million "likes" on its official Facebook page.
- The Complainant's WHATSAPP trademark has acquired considerable reputation and goodwill worldwide.
- The disputed domain name is confusingly similar to the Complainant's trademark WHATSAPP. The addition of the dictionary term "channel" does not prevent a finding of confusing similarity.
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent (i) has not been authorized or allowed by the Complainant to make any use of its WHATSAPP trademark, (ii) is not commonly known by the disputed domain name and (iii) is not using the disputed domain name in connection with a *bona fide* offering of goods or services, and there is no evidence of the Respondent having made any demonstrable preparations to use the disputed domain name. The

Complainant further submits that the disputed domain name does not resolve to an active website. The passive holding of a domain name cannot amount to any legitimate noncommercial or fair use.

- The disputed domain name was registered in bad faith. Given the renown and popularity of the Complainant's WHATSAPP trademark worldwide, the Respondent registered the disputed domain name with an intent to target the Complainant and its trademark.
- Non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

Based on the above, 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

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) The disputed 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 disputed domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a) (iii), shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the Respondent, shall be evidence of the Respondent's rights to or legitimate interests in the disputed domain names for the purpose of paragraph 4(a)(ii) above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the WHATSAPP trademark based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark with the addition of the generic term "channel", followed by the gTLD ".com".

As highlighted in section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the addition of a gTLD such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test.

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity 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.

The disputed domain name entirely incorporates the Complainant's WHATSAPP trademark and this is sufficient to establish the first element, as held by previous UDRP panels (e.g., *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that the Complainant has established element 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the registered and well-known WHATSAPP trademark, (b) the Respondent has not been authorized to use the Complainant's mark in any way, and (c) the Respondent cannot demonstrate any legitimate non-commercial or fair use of the disputed domain name. In this connection, the Complainant has provided evidence that the disputed domain name does not resolve to an active website.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests to the Respondent. Moreover, the disputed domain name is confusingly similar to the Complainant's WHATSAPP trademark and carries a high risk of implied affiliation with the Complainant. Such a high risk for implied affiliation cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds that the Complainant has established 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 establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, which includes: “(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

Given the reputation of the Complainant’s WHATSAPP trademark - registration and use of which precede by far the registration of the disputed domain name - it is not conceivable that the Respondent did not have in mind the Complainant’s trademark when registering the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith (see [WIPO Overview 3.0](#), section 3.2.2).

As to bad faith use, the evidence submitted with the Complaint shows that the disputed domain name does not resolve to an active website. The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. As stressed by many previous UDRP decisions, “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the implausibility of any good faith use to which the domain name may be put.” (See section 3.3 of the [WIPO Overview 3.0](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Each of these considerations points to the Respondent’s passive holding of the disputed domain name being in bad faith. Specifically: (i) the Complainant’s trademark is distinctive and well established; (ii) the Respondent has failed to submit a response to the Complaint or provide any evidence of good-faith use; (iii) the absence of any relationship between the Respondent and the Complainant; and, (iv) given the confusing similarity to the Complainant’s trademark, there is no conceivable good faith use to which the disputed domain name could be put by the Respondent, that would not result in creating a misleading impression of association with the Complainant.

For all the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith by the Respondent.

Therefore, the Complainant has established also 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 name, <whatsappchannel.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: May 5, 2023