

ADMINISTRATIVE PANEL DECISION

TikTok Ltd. v. Nguyen Thanh Tung
Case No. D2023-2391

1. The Parties

The Complainant is TikTok Ltd., United Kingdom, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Nguyen Thanh Tung, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <tiktokcambodia.com> is registered with Nhan Hoa Software Company Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 2, 2023. On June 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 2023, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On June 9, 2023, the Center transmitted an email communication to the Parties in both English and Vietnamese regarding the language of the proceeding. On June 12, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the 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, both in English and Vietnamese, and the proceedings commenced on June 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 13, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on August 7, 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 an Internet technology company that runs the internationally well-known video-sharing platform TIKTOK.

TIKTOK was launched in May 2017 and became the most downloaded application in the United States of America (“United States”) in October 2018, reaching over a billion users worldwide in September 2021 and over 1.5 billion users as of April 2023.

The TIKTOK application is available in more than 150 different markets and 75 languages. Since its launch in the Google Play Store, more than 1 billion users have downloaded the TIKTOK application. In the Apple App Store, the TIKTOK app is ranked “#1 in Entertainment” and #1 among all categories of free iPad apps. It is also one of Apple’s featured “Editors’ Choice” apps.

The Complainant is the owner, amongst others, of the United States trademark registration no. 5653614 for TIK TOK (word mark), filed on April 23, 2018 and registered on January 15, 2019, in international classes 9, 38, 41 and 42; and the United States trademark registration no. 5974902 for TIKTOK (stylized characters), filed on August 31, 2018 and registered on February 4, 2020 in international classes 9, 38, 41 and 42, collectively the “TIKTOK mark”.

The Complainant’s primary domain name incorporating its TIKTOK mark is <tiktok.com>, which was registered on July 21, 1996 and resolves to the Complainant’s official website at “www.tiktok.com”, through which the Complainant runs its video-sharing platform.

The disputed domain name was registered on June 3, 2021 and is currently not pointed to an active website. However, according to the screenshots submitted by the Complainant – which have not been contested by the Respondent – the disputed domain name was previously pointed to a website featuring the Complainant’s marks and promoting alleged advertising services for businesses on the TIKTOK platform, displaying amongst others the indications “TIKTOK. For Business”, “WE ARE AGENCY OF TIKTOK” and “TIKTOK CAMBODIA”. It was also indicated that users had to pay at least \$ 200 per month to avail of such marketing services on TIKTOK and that they would have been charged 15% for account creation and for consulting and advertising services.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its TIKTOK mark.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is in no way sponsored by or affiliated with the Complainant nor is he licensed, authorized or permitted to use the Complainant’s mark in any way, including in domain names.

The Complainant states that the Respondent is also not commonly known by the disputed domain name, and that it is highly unlikely that he would have been unaware of the Complainant at the time of registering the disputed domain name since the name and content of the website strongly suggest an attempt on the Respondent’s part to create an illusion of affiliation with the Complainant, exploiting the reputation of the Complainant’s mark to attract traffic to his website and to ultimately pass himself off as the Complainant.

The Complainant therefore submits that the Respondent has no rights or legitimate interests in the disputed domain name and that he is not using the disputed domain name either for a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent, who has no connection with the Complainant, intentionally registered the disputed domain name with the sole purpose of attempting to attract Internet users for commercial gain, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website corresponding to the disputed domain name. The Complainant also points out that the Respondent is using the fame of the Complainant's trademarks to improperly increase traffic to the website at the disputed domain name for his own commercial gain.

The Complainant further contends that the Respondent, by using the Complainant's famous TIKTOK mark, has clearly acted in opportunistic bad faith.

The Complainant also informs the Panel that the Respondent has failed to respond to the Complainant's cease and desist letter before the commencement of the present proceeding, which further denotes the Respondent's bad faith registration and use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural Issue – Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

In the case at hand, the language of the Registration Agreement of the disputed domain name is Vietnamese. The Complaint was filed in English. On June 9, 2023, the Center sent an email communication to the Parties about the language of the proceeding requesting them to comment on the issue.

On June 12, 2023, the Complainant submitted a request that English be the language of the proceeding for the following main reasons:

- 1) the Complainant is unable to communicate in Vietnamese and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceeding and adjudication of this matter;
- 2) The disputed domain name is comprised of Latin characters;
- 3) The website at the disputed domain name features various phrases in English including "WE ARE AGENCY OF TIKTOK", "About TIK TOK BUSINESSE" and "TIKTOK CAMBODIA";
- 4) The term "TikTok", which is the dominant portion of the disputed domain name, does not carry any specific meaning in the Vietnamese language;
- 5) the Complainant previously sent a cease-and-desist letter to the Respondent, and the Respondent had ample time and opportunity to respond to such letter and to request that communications continue in Vietnamese. The Respondent neither issued such a request nor responded to the Complainant. To allow the Respondent to dictate the course of this matter and further burden the Complainant at this juncture would contravene the spirit of the UDRP and disadvantage the Complainant.

The Respondent did not submit any comment with regard to the language of the proceeding and did not file a Response in either English or Vietnamese.

The Panel further notes that the Center's communications to the Parties have been sent in English and Vietnamese.

In view of the circumstances of the case, the Panel finds that English is the appropriate language of this proceeding and will thus proceed to render the Decision in English.

6.2 Substantive Issues

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1. Indeed, the Complainant has demonstrated ownership of trademark registrations for TIK TOK / TIKTOK, as per trademark registration details provided as annex 1 to the Complaint.

The Panel finds the entirety of the Complainant's mark is reproduced within the disputed domain name with the sole addition of the geographical term "Cambodia" and the generic Top-Level Domain ("gTLD") ".com". Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

While the addition of the other term "Cambodia" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 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. WIPO Overview 3.0, section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's mark.

According to the evidence on record, the disputed domain name is currently not pointed to an active website, prior to the present proceeding it was pointed to a website displaying the Complainant's marks promoting paid advertising services on Tik Tok, displaying indications such as "TIKTOK. For Business", "WE ARE AGENCY OF TIKTOK" and "TIKTOK CAMBODIA". Moreover, no disclaimer of non-affiliation with the Complainant was available on the website. The Panel finds that such use of the disputed domain name was apt to confuse and mislead users into believing that the Respondent's website was operated by a Complainant's affiliated company or authorized agency, which is not the case.

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's mark.

Moreover, the Panel finds that the disputed domain name is inherently misleading. Even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. WIPO Overview 3.0, section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. WIPO Overview 3.0, section 3.2.1.

As to the bad faith at the time of the registration, the Panel notes that, in light of the widespread reputation and high degree of recognition of the Complainant's TIKTOK mark, used in connection with the Complainant's globally known video-sharing platform since 2017, the Respondent could not ignore the existence of the Complainant's mark when registering the disputed domain name.

Moreover, the circumstance that the disputed domain name was pointed to a website featuring the Complainant's marks demonstrates that the Respondent was indeed well aware of the Complainant and its marks.

Furthermore, in view of the notoriety of the Complainant's TIKTOK mark, the Panel finds that the Respondent acted in opportunistic bad faith at the time of registration, since the disputed domain name is so obviously connected with the Complainant that its very selection by the Respondent, who has no connection with the Complainant, suggests the disputed domain name was registered with a deliberate intent to create an impression of an association with the Complainant.

The Panel also finds that, by pointing the disputed domain name to a website featuring the Complainant's marks and promoting paid advertising services on the TIKTOK platform without accurately and prominently disclosing the lack of relationship with the Complainant, the Respondent has intentionally attempted to attract Internet users to his website for commercial gain, by causing a likelihood of confusion with the TIKTOK mark as to the source, sponsorship, affiliation or endorsement of his website and the services promoted therein according to paragraph 4(b)(iv) of the Policy.

The disputed domain name is currently not pointed to an active website. UDRP Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. The Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While UDRP 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. WIPO Overview 3.0, section 3.3. Having reviewed the record, the Panel finds that, in view of i) the well-known character of the Complainant's TIKTOK mark; ii) the confusing similarity of the disputed domain name with the Complainant's prior mark; iii) the evidence of the Respondent's prior use of the disputed domain name provided by the Complainant and the failure of the Respondent to submit a Response or to provide any evidence of actual or contemplated good faith use; the current passive holding of the disputed domain name by the Respondent does not prevent a finding of bad faith under the Policy.

Based on the available records, the Panel finds the third element of the Policy has been established.

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 <tiktokcambodia.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: August 21, 2023