

## ADMINISTRATIVE PANEL DECISION

WhatsApp LLC v. Registration Private, Domains By Proxy, LLC / shalih irshad  
Case No. D2022-2236

### 1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC,<sup>1</sup> United States / shalih irshad, India.

### 2. The Domain Name and Registrar

The disputed domain name <whatsappbusiness.online> 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 June 20, 2022. On June 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 22, 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. The Center sent an email communication to the Complainant on June 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 June 28, 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”).

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<sup>1</sup> The Registrar submitted an email to the Center stating that Domains by Proxy LLC is only a privacy service and that it should not be listed as a respondent. While the Panel understands the intention behind the Registrar’s request, it is noted that a standard UDRP practice (flowing from the definition of “Respondent” in the Rules, paragraph 1) has been to record the named privacy or proxy service in the case caption, with the substantive merits being addressed to the underlying registrant, assuming one exists and has been identified by the concerned registrar. Moreover, as discussed below, the Panel finds the retention of a privacy service relevant in the present case.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 22, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on July 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 is in the business of mobile messaging applications. Founded in 2009, it was acquired by Meta Platforms Inc. (then named Facebook, Inc.) in 2014. It is the owner, amongst several others, of the following trademark registrations and applications (Annex 10 to the Complaint):

- Indian trademark registration No. 2149059 for the for the word mark WHATSAPP, registered on May 24, 2011, in international class 9 and 38;
- European Union Trademark Registration No. 009986514 for the word mark WHATSAPP, filed on May 23, 2011 and registered on October 25, 2011, in international classes 9, 38, and 42;
- United States Trademark Registration No. 3939463 for the word mark WHATSAPP, registered on April 5, 2011, in international class 42;
- International Trademark Registration No. 1085539 for the word mark WHATSAPP registered on May 24, 2011, in international classes 9 and 38; and
- International Trademark Registration No. 1109890 for the  figurative trademark registered on January 10, 2012, in international classes 9 and 38.

The disputed domain name was registered on May 21, 2021, and presently does not resolve to an active webpage. It has been used in connection with a webpage advertising services and depicting the Complainant's logo (Annex 11 to the Complaint).

On March 21, 2022, the Complainant's lawyers sent a cease-and-desist letter to the operator of the website available at the disputed domain name, Vimptech, in an attempt to resolve the matter amicably. On April 1, 2022, the Complainant's lawyers sent a follow up email. No response was received. (Annex 12 to the Complaint).

#### **5. Parties' Contentions**

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

The Complainant claims to be the provider of one of the world's most popular mobile messaging applications ("apps"), having over 2 billion monthly active users worldwide, having acquired considerable reputation and goodwill on a global scale.

Furthermore, the Complainant points out that previous UDRP decisions have already recognized that the WHATSAPP trademark is well known and has "acquired worldwide renown".

The Complainant asserts that the Respondent has used the disputed domain name in connection with a website entitled "whatsappbusiness", which provided a system for placing restaurant orders via WhatsApp,

displaying the Complainant's trademark and logo and indicating that the website had been designed by Vimptech (Annex 11 to the Complaint) and that it attempted to solve the matter amicably having sent a cease-and-desist letter to the operator of the website on March 21, 2022, followed up by a reminder on April 1, 2022 (Annex 12 to the Complaint), but no response was received and the original registrant for the disputed domain name chose to retain a privacy protection service (Annex 16 to the Complaint).

According to the Complainant, the disputed domain name incorporates the WHATSAPP trademark with the addition of the descriptive term "business", what does not prevent a finding of confusing similarity with the Complainant's trademark which remains clearly recognizable in the disputed domain name. Furthermore, the Complainant sustains that the disputed domain name corresponds to the name of the Complainant's message application "WhatsApp Business" (Annex 9 to the Complaint), what can only reinforce confusion.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- (i) the Respondent is not a licensee of the Complainant and has not been authorized or allowed by the Complainant to make any use of the WHATSAPP trademark in a domain name or otherwise;
- (ii) the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services given that the disputed domain name does not conform to the Complainant's Brand Guidelines which expressly forbid the use of trademarks, logos or other content that could be confused with the Complainant's app;
- (iii) the Respondent's use of the Complainant's trademarks and logo on the webpage that resolved from the disputed domain name to provide a system for placing restaurant orders via WhatsApp qualifies as unauthorized use of the Complainant's trademark given that the Respondent does not meet the criteria established in the *Oki Data* test (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#):
  - i. the Respondent must actually be offering the goods or services at issue;
  - ii. the Respondent must use the site to sell only the trade marked goods or services;
  - iii. the site must accurately and prominently disclose the registrant's relationship with the trademark holder;
  - and iv. the Respondent must not try to "corner the market" in domain names that reflect the trade mark);
- (iv) the Respondent is not commonly known by the disputed domain name; and
- (v) the present passive holding of the disputed domain name does not give rise to any rights or legitimate interests in the disputed domain name.

As to the registration and use of the disputed domain name in bad faith, the Complainant states that:

- (i) the Complainant's trademark is inherently distinctive and well known throughout the world, being inconceivable for the Respondent to argue that he did not have knowledge of the Complainant's WHATSAPP trademark when he registered the disputed domain name;
- (ii) the Respondent's use of the disputed domain name in connection with a webpage that demonstrates actual knowledge of the Complainant and its trademark, where multiple times references are made to the Complainant and the reproduction of the Complainant's logo, leaves no doubt as to the Respondent's awareness of the Complainant at the time of registration;
- (iii) the Respondent, by registering and using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's WHATSAPP trademark as to the source, sponsorship, affiliation, or endorsement of its website, pursuant to paragraph 4(b)(iv) of the Policy so as to promote its own services unrelated to the Complainant;
- (iv) the lack of any clear and prominent disclaimer at the website to which the disputed domain name used to point indicating that the Respondent's website was not affiliated to or sponsored by the Complainant

further added to the confusion and constitutes an additional indication of bad faith use on the Respondent's part; and

(v) the Respondent's failure to reply to the Complainant's cease-and-desist letter sent prior to this procedure may also be considered an additional indicator of the Respondent's bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant has established rights over the WHATSAPP trademark, entirely reproduced in the disputed domain name. The addition of the "business" term does not prevent a finding of confusing similarity with the Complainant's trademark, which remains clearly recognizable in the disputed domain name.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

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

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, nor to the cease-and-desist letter sent by the Complainant prior to the beginning of this procedure, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules.

In that sense, the Complainant has indeed stated that the Respondent has not been authorized or allowed by the Complainant to make any use of the WHATSAPP trademark, nor has he been commonly known by the disputed domain name.

Furthermore, and according to the evidence submitted by the Complainant, the Respondent has indeed not used the disputed domain name in connection with a *bona fide* offering of goods or services given the webpage that previously resolved from the disputed domain name offered services and depicted the Complainant's logo, not making however a single disclaimer or indication that the Respondent's website is not operated by or affiliated with the Complainant, thus creating a misleading impression of association with the Complainant. The current inactive nature of the disputed domain name does not alter the Panel's finding, considering that non-use does not amount to a *bona fide* offering and, given the composition of the

disputed domain name, any use is not likely to be considered “fair” due to the risk of implied affiliation to the Complainant.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

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

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other online location, by creating a likelihood of confusion with a complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy paragraph 4(b)(iv) in view of the Respondent’s past use of the disputed domain name in connection with a webpage that demonstrates actual knowledge of the Complainant and its trademark, where multiple references are made to the Complainant, leaves no doubt as to the Respondent’s awareness of the Complainant at the time of registration and intent to profit from misleading Internet users to its website.

Other factors corroborate a finding of bad faith:

- a. the use of the Complainant’s distinctive logo at the webpage that resolved from the disputed domain name without a single disclaimer or indication that the Respondent’s website is not operated by or affiliated with the Complainant, thus creating a misleading impression of association with the Complainant;
- b. the Respondent’s failure to reply to the Complainant’s cease-and-desist letter sent prior to this procedure; and
- c. the Respondent’s choice to retain a privacy protection service after having received the cease-and-desist letter, in a probable attempt to make it more difficult for the Complainant to take actions against him.

While the disputed domain name may no longer resolve to an active website, given the totality of circumstances found above and in light of the passive holding doctrine found in section 3.3 of the [WIPO Overview 3.0](#), the current inactive status of the disputed domain name does not prevent a finding of bad faith.

For the reasons above, the Panel finds that the Respondent has registered and is using the disputed domain name 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 <whatsappbusiness.online> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*  
**Wilson Pinheiro Jabur**  
Sole Panelist  
Date: August 2, 2022