

ADMINISTRATIVE PANEL DECISION

WhatsApp, LLC v. Host Master, 1337 Services LLC
Case No. D2022-3522

1. The Parties

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

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

2. The Domain Names and Registrar

The disputed domain names <whatsappbusinessapi.co>, <whatsappcampaign.com>, <whatsappmarketing.co>, <whatsappmarketing.xyz>, <whatsappsolutions.com> are registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 23, 2022. On September 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 26, 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 (Data Protected). 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 October 10, 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 October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 1, 2022.

The Center appointed Peter Burgstaller as the sole panelist in this matter on November 4, 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 Respondent registered the disputed domain names:

- <whatsappbusinessapi.co> on September 14, 2021,
- <whatsappcampaign.com> on July 26, 2017,
- <whatsappmarketing.co> on October 14, 2020,
- <whatsappmarketing.xyz> on September 1, 2015, and
- <whatsappsolutions.com> on July 26, 2017 (Annex 2 to the Complaint).

The Complainant operates the world-famous WhatsApp messaging and voice-over-IP service and mobile application in various languages (Annexes 7 to the Complaint).

The Complainant owns various trademark registrations for the mark WHATSAPP in many jurisdictions around the world, including:

- United States of America Registration No. 3,939,463, registered April 5, 2011;
- European Union Registration No. 9986514, registered October 25, 2011;
- International Registration No. 1085539, registered May 24, 2011, designated for various countries around the world; and
- Canadian Registration No. TMA838338, registered December 12, 2012, (Annexes 9 to the Complaint).

Moreover, the Complainant owns a number of domain names, containing the mark WHATSAPP, *inter alia* <whatsapp.com>, <whatsapp.net>, <whatsapp.org>, <whatsapp.eu>, <whatsapp.us>, and <whatsapp.uk> (Annex 8 to the Complaint).

All the disputed domain names previously pointed or redirected to the same website at the disputed domain name <whatsappbusinessapi.co>, which had a similar “look and feel” to the Complainant’s official website and promoted a purported “WhatsApp Business API”, which was described as “the most powerful WhatsApp script to automate your marketing campaigns at a one-time cost” by allowing its users, *inter alia*, to send “millions of automated messages via WhatsApp”. (Annex 3 to the Complaint).

5. Parties’ Contentions

A. Complainant

The Complainant owns numerous trademark registrations for WHATSAPP in jurisdictions throughout the world. The disputed domain names incorporate the Complainant’s WHATSAPP trademark in its entirety with the addition of various terms, *i.e.*, “business”, “API” (acronym for “Application Programming Interface”), “solutions”, “marketing”, and “campaign”, under either the generic Top-Level Domain (“gTLD”) “.com” and “.xyz” or the country code Top-Level Domain (“ccTLD”) “.co” for Colombia.

The disputed domain names are confusingly similar to the Complainant’s trademark in accordance with the Policy.

The Respondent has registered the disputed domain names. However, the Respondent has no rights or legitimate interests in the disputed domain names: The Complainant has not licensed nor authorized the Respondent to use the Complainant’s WHATSAPP mark, nor does the Respondent have any legal

relationship with the Complainant that would entitle the Respondent to use the WHATSAPP mark. Moreover, the Respondent is not commonly known by the disputed domain names and does not make a legitimate noncommercial or fair use of the disputed domain names. Hence, the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Finally, the Respondent has registered and is using the disputed domain names in bad faith:

The disputed domain names were registered in bad faith since the Respondent knew or should have known about the existence of the well-known WHATSAPP mark when registering the disputed domain names.

Moreover, the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Respondent used the disputed domain names to redirect Internet users to its website promoting WhatsApp marketing software. Such use of the disputed domain names to intentionally attract Internet users to a website supposedly providing paid marketing software via WhatsApp services, obviously for commercial gain, constitutes use in bad faith.

Furthermore, the disputed domain names were used in connection with a website promoting marketing software for the bulk sending of WhatsApp messages. There is an appreciable risk that such software may be used to send unsolicited electronic communications (spam), for phishing, or for other unauthorized activities. Such use places the security of WhatsApp users at risk, and violates the Complainant's Business Terms of Service.

Finally, the Respondent's failure to reply to the Complainant's cease and desist letter sent via the Registrar's registrant contact forms prior to the filing of this Complaint is also indicative of the Respondent's bad faith.

Accordingly, the Respondent registered and is using the disputed domain names in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain names are 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 with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the trademark WHATSAPP.

The disputed domain names are confusingly similar to the Complainant's registered trademark WHATSAPP since they entirely contain this famous and distinctive mark and only add the words "businessapi" (API is the acronym for "Application Programming Interface"), "solutions", "marketing", and "campaign" after the Complainant's WHATSAPP mark.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Finally, it has also long been held that gTLDs or ccTLDs are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Hence, the disputed domain names are confusingly similar to the Complainant's trademark WHATSAPP; the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

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 (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain names, comprising the Complainant's famous and distinctive mark in its entirety together with the terms "businessapi", "solutions", "marketing", and "campaign", cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Also, the fact that the disputed domain names previously pointed or redirected to the same commercial website at <whatsappbusinessapi.co>, which had a similar "look and feel" to the Complainant's official website and promoted a purported "WhatsApp Business API", without any visible disclaimer regarding the website owner's relationship (or absence thereof) with the Complainant, does not constitute a use in connection with a *bona fide* offering of goods or services within the meaning of the Policy.

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated. Consequently, the Complainant must show that:

- the disputed domain names were registered by the Respondent in bad faith, and
- the disputed domain names are being used by the Respondent in bad faith.

(i) The Complainant has rights and is the owner of the well-known, famous, and highly distinctive registered trademark WHATSAPP, which is registered and used in many jurisdictions around the world. Moreover, the Complainant registered and is using various domain names containing the WHATSAPP trademark, e.g. <whatsapp.com>, <whatsapp.org>, <whatsapp.net>, and <whatsapp.us>, among others.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain names without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This

finding is supported by the fact that the disputed domain names incorporate the Complainant's distinctive trademark WHATSAPP entirely.

Therefore, the Panel is convinced that the disputed domain names were registered in bad faith by the Respondent.

(ii) The disputed domain names were previously actively used: The Respondent intentionally attracted Internet users to a website supposedly providing paid marketing software via WhatsApp services, obviously for commercial gain. Furthermore, the disputed domain names were used in connection with a website promoting marketing software for the bulk sending of WhatsApp messages.

Moreover, Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). This finding is supported by the fact that the Respondent not only registered one domain name containing the Complainant's famous trademark WHATSAPP with a descriptive term, but five domain names.

Furthermore, this Panel also finds bad faith use, putting emphasis on the following:

- the Complainant's trademark WHATSAPP is famous with a high distinctiveness and is well-known globally;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain names;
- the disputed domain names incorporate the Complainant's trademark in its entirety, and is thus suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant's site);
- the disputed domain names previously were used by the Respondent for making unauthorized use of the Complainant's trademark to market its own ancillary services;
- the Respondent did not reply to the Complainant's cease and desist letter sent via the Registrar's registrant contact forms prior to the filing of the Complaint; and
- there is no conceivable plausible good faith use with regard to the disputed domain names.

Taking all these facts and evidence into consideration this Panel finds that the disputed domain names have been registered and used in bad faith 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, <whatsappbusinessapi.co>, <whatsappcampaign.com>, <whatsappmarketing.co>, <whatsappmarketing.xyz>, and <whatsappsolutions.com>, be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: November 18, 2022