

ADMINISTRATIVE PANEL DECISION

WhatsApp, LLC v. MATSHIYA CILIAS WONDER, BLUE LOGO TRADING AND PROJECTS

Case No. D2022-3645

1. The Parties

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

The Respondent is MATSHIYA CILIAS WONDER, BLUE LOGO TRADING AND PROJECTS, South Africa.

2. The Domain Name and Registrar

The disputed domain name <whatsapphost.com> (the “Domain Name”) is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 11, 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 13, 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 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on November 15, 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 California-based company, founded in 2009 and acquired by Facebook, Inc. in 2014. The Complainant provides, under the trade mark WhatsApp (“WHATSAPP Mark”) one of the world’s most popular mobile messaging applications. The Complainant’s WhatsApp app is available on iPhone, Blackberry and Android products and as of 2022 had 2.44 billion monthly users worldwide. The WhatsApp app is the 4th most downloaded mobile application worldwide.

The Complainant holds a registered trade mark in various jurisdictions for the WHATSAPP Mark including in the United States (registration No.3939463) for services in Class 42, registered on April 5, 2011 with a first use in commerce of February 24, 2009.

The Domain Name was registered on June 8, 2022. It is presently inactive, however prior to the commencement of the proceeding briefly resolved to a WhatsApp page where users were invited to chat with a third party. Following the receipt of a cease-and-desist letter from the Complainant, the Domain Name later resolved to a website (the “Respondent’s Website”) that purported to promote a third-party non-profit Linux distribution system known as CentOS.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant’s WHATSAPP Mark;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the WHATSAPP Mark, having registered the WHATSAPP Mark in the United States and other jurisdictions. The Domain Name is confusingly similar to the WHATSAPP Mark, merely adding the word “host” to the wholly incorporated WHATSAPP Mark.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known as the Domain Name nor has the Complainant provided a licence or authorization to register the Domain Name or any domain name incorporating the WHATSAPP Mark. There is no evidence, since the Respondent registered the Domain Name, of the Respondent’s use of, or demonstrable preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial purpose. Rather the Domain Name is presently inactive and neither of the prior uses of the Domain Name, appear in any way to be associated with a *bona fide* offering of goods or services or for a legitimate noncommercial purpose. In particular, the use of a domain name corresponding to the Complainant’s WHATSAPP Mark for a website promoting a non-profit software product unconnected to the Complainant is not fair use or an otherwise legitimate noncommercial purpose, as the change of use came after the Respondent was put on notice of the dispute via a cease-and-desist letter.

The Domain Name was registered and is being used in bad faith. Given the reputation of the Complainant and the nature of the Domain Name, it is likely that the Respondent had knowledge of the WHATSAPP Mark at the time of registration. The Domain Name is being held pending use that will undoubtedly take advantage of any confusion between the Domain Name and the Complainant's WHATSAPP Mark.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the WHATSAPP Mark, having registrations for the WHATSAPP Mark as a trade mark in the United States and numerous other jurisdictions around the world.

The Domain Name consists of the WHATSAPP Mark with the addition of the word "host". Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's WHATSAPP Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the WHATSAPP Mark or a mark similar to the WHATSAPP Mark. There is no evidence that

the Respondent is commonly known by the Domain Name or any similar name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods and services. The Domain Name is presently inactive. Neither the of the Respondent's previous uses of the Domain Name amount to a legitimate noncommercial fair use or a *bona fide* offering of goods and services. Specifically the use of the Domain Name to link to a particular individual third party WhatsApp site does not involve the offering of goods or services, nor is there any evidence before the Panel to suggest it is fair use in any way.

The use of the Domain Name for the Respondent's Website is also not a legitimate noncommercial fair use or a *bona fide* offering of goods and services. The Panel notes that this website was created after the Respondent received a cease and desist letter, and there is no explanation as to why a party would register a domain name corresponding to the well-known WHATSAPP mark for the purpose of (temporarily) creating a page promoting a third party service unconnected to the Respondent and the Complainant. In the absence of any explanation by the Respondent for its actions, the Panel on the balance of probabilities accepts the submission by the Complainant that the Respondent's Website was not genuine, rather it was created to give the false impression of legitimacy to the Respondent's actions in registering a confusingly similar Domain Name. The Panel finds that the Respondent's conduct does not, absent further explanation, amount to use for a *bona fide* offering of goods and services or a legitimate noncommercial fair use.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has failed to rebut that *prima facie* case and establish that it has rights or legitimate interests in the Domain Name under the Policy. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location. (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainant and its reputation in the WHATSAPP Mark at the time the Respondent registered the Domain Name. The Complainant's WHATSAPP Mark is extraordinarily well known, with 2.24 billion monthly users. Furthermore, the Domain Name initially redirected to a specific account on the WhatsApp app. The Respondent has provided no explanation, and none is immediately obvious, why an entity would register the Domain Name that wholly incorporates the

WHATSAPP Mark and the word “host”, unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its WHATSAPP Mark. In these circumstances, the Respondent’s conduct in registering the Domain Name when it was aware of the Complainant’s rights and lacked rights or legitimate interests of its own amounts to registration in bad faith.

As discussed under the heading “Rights and Legitimate Interests” the Panel is unpersuaded that the Respondent’s Website, or any other aspect of the Respondent’s conduct, provides a basis to conclude that the Respondent has registered or used the Domain Name in good faith. Rather, the Panel is prepared to infer, based on the nature of the Domain Name, the fame of the WHATSAPP mark, the lack of legitimate use by the Respondent thus far and the failure by the Respondent to participate in this proceeding or otherwise provide any explanation of its conduct, that the Domain Name is most likely presently being held pending use as website or email address that will make reference to the Complainant in an illicit or unapproved manner for the Respondent’s commercial gain. As such, the Panel finds that neither the previous use of the Domain Name for the Respondent’s Website or a WhatsApp page, nor the present inactive use of the Domain Name, prevents a finding of use in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name 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 Domain Name <whatsapphost.com> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: November 21, 2022