

ADMINISTRATIVE PANEL DECISION

Whatsapp LLC v. elie galam
Case No. D2022-3684

1. The Parties

The Complainant is Whatsapp LLC,¹ United States of America (“United States”), represented by Tucker Ellis, LLP, United States.

The Respondent is elie galam, United States.

2. The Domain Name and Registrar

The disputed domain name <whatsappgroup.org> (the “Disputed Domain Name”) 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 October 4, 2022. On October 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 5, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 7, 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 11, 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 Center received email communications from the

¹ The Complainant, previously known as “WhatsApp Inc.”, has undergone a change in corporate structure from a corporation to a limited liability company, effective January 1, 2021.

Respondent on October 19, 20, and 23, 2022, stating that it had submitted a signed domain transfer to the Complainant via the Center. The Center notified the commencement of Panel appointment on November 9, 2022.

The Center appointed Lynda M. Braun 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 operates the WhatsApp messaging and voice-over-IP service and mobile application and is a global leader in messaging services for mobile devices, with over two billion people in over 180 countries now using the service to stay in touch with friends and family via free messages and calling. The Complainant is available in 60 different languages with the mobile application having been ranked among the top applications in the market in recent years.

The Complainant owns the exclusive rights to the WHATSAPP trademark, which it has used for over 13 years. The Complainant's use of the trademark in the United States and throughout the world has been extensive, continuous, and substantially exclusive. The WHATSAPP trademark is recognized around the world as signifying high-quality, authentic goods and services provided by the Complainant.

In addition to its extensive common law rights in the WHATSAPP trademark, the Complainant owns numerous trademark registrations in the United States and in jurisdictions worldwide. Several of the Complainant's registrations for the WHATSAPP trademark in the United States include: WHATSAPP, United States Registration No. 3,939,463, registered on April 5, 2011; WHATSAPP, United States Registration No. 4,083,272, registered on January 10, 2012; WHATSAPP, United States Registration No. 6,142,062, registered on September 1, 2020; WHATSAPP, United States Registration No. 5,492,738, registered on June 12, 2018; and WHATSAPP, United States Registration No. 5,520,108, registered on July 17, 2018.

The Complainant also owns several International trademark registrations, designating various jurisdictions, and European Union Trade Mark registrations for the WHATSAPP trademark.

The foregoing United States and other worldwide trademarks will hereinafter collectively be referred to as the "WHATSAPP Mark".

In addition to the <whatsapp.com> domain name, the Complainant owns the domain name <whatsappgroup.com> as well as numerous other domain names consisting of the WHATSAPP Mark in combination with various generic and country code Top-Level Domain extensions, including <whatsapp.net>, <whatsapp.org>, and <whatsapp.us>.

The Disputed Domain Name was registered on August 2, 2019, and resolves to a commercial website that impersonates the Complainant and trades on the goodwill of the WHATSAPP Mark. Specifically, the Respondent uses the Disputed Domain Name to redirect to a website that passes off as the Complainant by prominently and repeatedly featuring the WHATSAPP Mark and the Complainant's registered telephone logo design. Moreover, the Respondent uses the Complainant's teal green color scheme throughout the resolving website. Finally, the Respondent is using the Disputed Domain Name to attract consumers to an unrelated commercial website featuring various advertisements and offering links to WhatsApp groups and downloadable files that potentially pose security risks for users.

5. Parties' Contentions

A. Complainant

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's WHATSAPP Mark;
 - the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
 - the Disputed Domain Name was registered and is being used in bad faith.
- The Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not submit a formal response to the Complaint. The Center received email communications from the Respondent stating that it had submitted a signed domain transfer to the Complainant via the Center.

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraphs 4(a)(i)-(iii)):

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the WHATSAPP Mark as explained below.

It is uncontroverted that the Complainant has established rights in the WHATSAPP Mark based on its years of use as well as its registered trademarks for the WHATSAPP Mark in the United States and jurisdictions worldwide. The registration of a mark satisfies the requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case". Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the WHATSAPP Mark.

The Disputed Domain Name consists of the WHATSAPP Mark in its entirety followed by the term "group", and then followed by the generic Top-Level Domain ("gTLD") ".org". Where the trademark is recognizable in the Disputed Domain Name, the addition of a term, such as "group" does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 ("where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element").

Finally, the addition of a gTLD such as “.org” in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#), and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant’s WHATSAPP Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its WHATSAPP Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar names, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c).

As the Disputed Domain Name resolves to a website that impersonates the Complainant and its official website, such conduct misleads consumers into thinking that the website is one belonging to the Complainant. Such use demonstrates neither a *bona fide* offering of goods or services nor does it confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”). Moreover, the construction of the Disputed Domain Name, incorporating the Complainant’s WHATSAPP Mark entirely, affirms the Respondent’s intention to confuse Internet users believing there to be an affiliation to the Complainant, contrary to the fact.

Thus, the Panel concludes that nothing on the record before it would support a finding that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. Rather, the Panel finds that the Respondent is using the Disputed Domain Name for commercial gain with the intent to mislead by defrauding the Complainant’s customers. Such use cannot conceivably constitute a *bona fide* offering of a product/service within the meaning of paragraph 4(c)(i) of the Policy.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith pursuant to paragraph 4(b) of the Policy.

First, as demonstrated above, the Respondent used the Disputed Domain Name to impersonate the Complainant and perpetrate a fraudulent scheme by attempting to pass off as the Complainant, a strong indication of bad faith. In addition, the Respondent is using the Disputed Domain Name to attract consumers to a commercial website featuring various advertisements and offering links to WhatsApp groups and

downloadable files that potentially pose security risks for users. Such conduct by the Respondent evidences a clear intent to disrupt the Complainant's business, deceive individuals, and trade off the Complainant's goodwill by creating an unauthorized association between the Respondent and the Complainant's WHATSAPP Mark. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). Such conduct is emblematic of the Respondent's bad faith registration and use of the Disputed Domain Name.

Second, the Panel finds that the Respondent had actual knowledge of the Complainant's WHATSAPP Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the widespread use of the WHATSAPP Mark worldwide, it strains credulity to believe that the Respondent had not known of the Complainant or its WHATSAPP Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its WHATSAPP Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name was intended to cause confusion with the Complainant's WHATSAPP Mark and to disrupt the Complainant's business. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith.

Third, the Panel concludes that the Respondent registered and used the Disputed Domain Name in bad faith in an attempt to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's WHATSAPP Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name's resolving website. The Respondent's registration and use of the Disputed Domain Name indicate that such registration and use had been done for the specific purpose of trading on the name and reputation of the Complainant and its WHATSAPP Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain"). In addition, the Disputed Domain Name is nearly identical, save for the gTLD, to the Complainant's domain name <whatsappgroup.com>.

Finally, the registration of a domain name that is confusingly similar to a trademark by an entity that has no relationship to that mark can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Accordingly, the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 <whatsappgroup.org> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: November 22, 2022