

## **ADMINISTRATIVE PANEL DECISION**

Bytedance Ltd. v. el hadji habib ndiaye  
Case No. D2023-0912

### **1. The Parties**

The Complainant is Bytedance Ltd., Cayman Islands, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is el hadji habib ndiaye, Senegal.

### **2. The Domain Name and Registrar**

The disputed domain name <senegaltiktokawards.com> is registered with Ligne Web Services SARL (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 1, 2023. On March 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 2, 2023, 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 (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 6, 2023 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 March 8, 2023.

The Registrar also indicated that the language of the Registration Agreement was French. The Complaint was filed in English. The Center sent an email communication to the Complainant on March 6, 2023, inviting the Complainant to provide sufficient evidence of an agreement between the Parties for English to be the language of proceeding, a Complaint translated into French, or a request for English to be the language of proceedings. The Complainant filed a request for English to be the language of proceedings on March 8, 2023. The Respondent did not submit any arguments regarding the language.

On March 11, 2023, the Respondent sent informal emails. On March 23, 2023, the Complainant submitted that it did not wish to suspend proceedings.

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 March 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondent did not submit any formal response. Accordingly, the Center notified the Parties that the Center will proceed to Panel Appointment.

From April 18 to April 26, 2023, the Respondent further sent informal emails. On April 21, 2023, it sent an email explaining that it understood that it had done a mistake when registering and using the disputed domain name. It offered to transfer this domain name to the Complainant.

On April 27, 2023, the Complainant submitted that it did not wish to suspend proceedings.

The Center appointed Marie-Emmanuelle Haas as the sole panelist in this matter on May 4, 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.

A Panel order was sent to the Complainant and to the Respondent on June 7, 2023, asking the Complainant to provide further explanation regarding its rights on the TIK TOK trademarks, since the status of the ownership of the TIK TOK trademarks that were cited in the Complaint was considered as not clear.

- It asked the Complainant to provide further explanation regarding its rights on the TIK TOK trademarks and/or
- Its relationship with Tik Tok Information Technology limited UK, and/or
- Relevant evidence of authorization to file a UDRP complaint granted by the holder of the registrations for the TIK TOK trademarks

The Complainant answered on June 9, 2023, providing the copy of 3 additional TIK TOK trademarks in the name of the Complainant.

It also provided a letter of authorization in the name of Tik Tok Information Technologies UK Ltd, a list of TIK TOK trademarks and a chart explaining the organization of the group and the link between the Complainant and Tik Tok Information Technology limited UK.

#### **4. Factual Background**

The Complainant is filed by Bytedance Ltd., Cayman Islands. This company is an Internet technology company that enables users to access creative content platforms. The Complainant owns a series of content platforms that enable people to connect with consuming and creating content through machine learning technology, including TikTok, Helo and Resso. TikTok platform was launched in May 2017 and became the most downloaded application in the world in both 2020 and 2022. TikTok enables users to create and upload short videos. TikTok is available in more than 150 different markets, in 75 languages and has global offices including Los Angeles, New York, London, Paris, Berlin, Dubai, Mumbai, Singapore, Jakarta, Seoul, and Tokyo.

According to the produced pieces of evidence, this company owns the following TIK TOK trademarks:

- Hong Kong national TIK TOK trademark No 304921939 filed on May 10, 2019 in classes 9, 14, 16, 18, 19, 20, 24, 25, 35 and 45, registered,

- Singapore national TIK TOK trademark No 40202017332W filed on August 20, 2020 in classes 6, 11, 14, 16, 18, 20, 24, 25, 26 and 28, registered,
- Singapore national TIK TOK trademark No 40201924683W filed on November 13, 2019 in classes 9, 35, 38, 41, 42 and 45, registered.

The disputed domain name <senegaltiktokawards.com> was registered on June 23, 2022 and resolved to a website dedicated to Tik Tok awards in Senegal when the case started. The Respondent is located in Dakar (Senegal).

The disputed domain name currently appears to be inactive. The Complainant notes nevertheless that it has been set up with mail exchanger (MX) records.

## **5. Parties' Contentions**

### **A. Complainant**

Language of the proceedings

The Complaint has been submitted in English and the Complainant asks that the language of the proceedings be English.

It contends that it is unable to communicate in French and that translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter.

It would also unduly lengthen the procedure and putting Complainant and Internet users at risk for a longer period.

The disputed domain name is comprised of Latin characters, and the term TIKTOK, which is the dominant portion of the disputed domain name, does not carry any specific meaning in the French language.

Moreover, the disputed domain name also comprises the English language term "awards", which does not carry any meaning in the French language.

Pursuant to Paragraph 11(a) of the Rules, the Panel may determine the language of the proceedings having regard to all circumstances, and to help ensure fairness, and maintain an inexpensive and expeditious avenue for resolving domain name disputes. Here, in light of the Respondent's use of the disputed domain name and the Respondent's decision to register a domain name that misappropriates the famous TIK TOK trademark, it would unduly burden the Complainant to have to arrange and pay for translation where the Respondent has demonstrated behavior that disrupts the Complainant's business and has already required the Complainant to devote significant time and resources to addressing this instance of abuse.

### **Identical or Confusingly Similar**

The TIK TOK trademark is worldwide well-known.

The Complainant requests trademark rights as owner of the TIK TOK trademarks.

The disputed domain name can be considered as capturing, in its entirety, the Complainant's TIK TOK trademark and simply adding the geographical term "Senegal" and the term "Awards" to the beginning and end of the trademark.

The conjunction of these terms with the Complainant's trademark would cause Internet users to reasonably believe the disputed domain name is connected to a Senegalese Tik Tok awards, authorized by the

Complainant, and the disputed domain name must be considered confusingly similar to the Complainant's trademark.

Nevertheless, it is well established that the addition of descriptive terms is not sufficient to overcome a finding of confusing similarity pursuant to Policy, paragraph 4(a)(i).

In light of the aforementioned submissions, the Complainant requests that the Panel concurs and classifies the disputed domain name as confusingly similar to the Complainant's mark for the purpose of paragraph 4(a)(i).

### **Rights or Legitimate Interests**

The Respondent is not sponsored by or affiliated with the Complainant in any way.

The Complainant has not given the Respondent permission to use the Complainant's trademarks in any manner, including in domain names.

The Respondent is not commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests.

There is no evidence, including the Whois record for the disputed domain name, that suggests that Respondent is commonly known by the disputed domain name.

Furthermore, at the time of filing the complaint, the Respondent was using a privacy Whois service, which past panels have also found to equate to a lack of legitimate interest.

The Respondent has not made a *bona fide* offering of goods or services or legitimate, noncommercial fair use of the disputed domain name.

The Respondent's prior use of the disputed domain name incorporated the Complainant's logo on the disputed domain name's website, in a direct effort to take advantage of the fame and goodwill that the Complainant has built in its brand, and the Respondent has not only used the confusingly similar disputed domain name but has also imitated the Complainant by displaying the Complainant's logo.

It is clear the Respondent's primary intention was to profit from the false association with the Complainant's brand.

Nothing on the website hosted on the domain name indicates to online users that the disputed domain name is not affiliated with the Complainant. Therefore, the Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name.

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

The Complainant and its TIK TOK trademarks are known internationally, with trademark registrations across numerous countries. The Complainant has marketed and sold its goods and services using this trademark since 2017, which is well before the Respondent's registration of the disputed domain name on June 23, 2022.

By registering a domain name that comprises the Complainant's TIK TOK trademark with the addition of the geographical term "Senegal" and term "Awards", the Respondent has created a domain name that is confusingly similar to the Complainant's trademark, as well as its <tiktok.com> domain.

As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. Moreover, the content on the disputed domain name directly refers to the Complainant's brand, claiming to be directly endorsed by the Complainant in a "Senegal Tik Tok Awards".

In light of the facts set forth within this Complaint, it is “not possible to conceive of a plausible situation in which the Respondent would have been unaware of” the Complainant’s brands at the time the disputed domain name was registered.

The Respondent’s use of the Complainant’s logo, trademark and blue and pink color scheme aimed at creating an affiliation with the Complainant.

The above-mentioned use “would invariably result in misleading diversion and taking unfair advantage of the Complainant’s rights” and amounts to bad faith use for the purposes of the Policy.

The impression given by the disputed domain name and its website would cause consumers to believe the Respondent is somehow associated with the Complainant when, in fact, it is not. The Respondent’s actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the disputed domain name, and the Respondent is thus using the fame of the Complainant’s trademarks to improperly increase traffic to the website listed at the disputed domain name for the Respondent’s own commercial gain.

Additionally, although the disputed domain name currently appears to be inactive. The Complainant notes that it has been set up with mail exchanger (MX) records. This shows that the disputed domain name may be actively used for email purposes. Emails emanating from the disputed domain name could not reasonably be used for any good faith purpose given the close similarity to the Complainant’s trademark. Instead, it is likely that the domain name may be actively used to facilitate fraudulent activities such as phishing, impersonating or passing off as the Complainant.

Previous panel decisions have considered the presents of MX records to be indicative of bad faith registration and use. See, for example, *Alain Afflelou Franchiseur v. Lihongbo, Lihongbo*, WIPO Case No. [D2020-2075](#), which noted “the disputed domain names indicate that the Respondent has connected the disputed domain names to email servers, which creates a serious risk that the Respondent may be using the disputed domain names, which are confusingly similar to the Complainant’s trademark, for misrepresentations and/or phishing and spamming activities”.

## **B. Respondent**

The Respondent did not formally reply to the Complainant’s contentions. However, the Respondent submitted several emails in which it indicated its willingness to transfer the disputed domain name to the Complainant.

## **6. Discussion and Findings**

### **A. Language of the proceedings**

While the registration agreement was in French, the Complainant asks that English be the language of the proceedings.

Given the fact that the Respondent sent an email drafted in French to propose to transfer the disputed domain name, it is proved that the Respondent perfectly understood the complaint that was drafted in English.

The Respondent did not react to the issue of the language of the proceedings.

Pursuant to Paragraph 11(a) of the Rules, the Panel may determine the language of the proceedings having regard to all circumstances, and to help ensure fairness, and maintain an inexpensive and expeditious avenue for resolving domain disputes.

Therefore, it accepts that the language of the proceedings be English.

### **B. Identical or Confusingly Similar**

In this case, the Complainant is the company Bytedance Ltd.

It does not rely on the British company Tik Tok Information Technology limited UK in the Complaint.

The Complainant has proved its prior rights on the hereabove cited TIK TOK trademarks.

The disputed domain name incorporates the TIK TOK trademark.

The addition of the terms “Senegal” and “awards” does not avoid the confusing similarity.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, within the meaning of paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it 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 has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial 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 Complainant asserts that the Respondent is not related in any way with the Complainant.

There is no indication that the Respondent is commonly known by “senegaltiktokawards”.

There is no evidence of any *bona fide* use of the disputed domain name.

The Respondent did not respond to the Complainant to rebut its *prima facie* case. It did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name. On the contrary, it recognized in its email dated April 21, 2023, that it had made a mistake when registering and using the disputed domain name.

Therefore, the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

For the purposes of paragraph 4(a)(iii), 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 the Respondent 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's 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 trademark 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 your website or other on-line 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.

Given the Complainant's reputation and the initial use of the disputed domain name, it is reasonable to consider that the Respondent was aware of the TIK TOK trademark when it registered the disputed domain name.

The initial use of the disputed domain name was dedicated to awards given to TIK TOK subscribers in Senegal.

The Respondent recognized that this use was damaging the TIK TOK trademarks.

Even if the disputed domain name does not resolve any more to an active website, it is proven that the Registrant recorded MX servers, in order to be able to create emails composed with the TIK TOK trademark and to use these email addresses to send emails, with the likely purpose to impersonate the Complainant.

This is bad faith use in the meaning of paragraph 4(b)(iv) of the Policy, which states that: " by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line 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".

Under the circumstances of the case, the Panel finds that the disputed domain name has been registered and is being used in bad faith, within the meaning of paragraph 4(b)(iv) and 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 name, <senegaltiktokawards.com>, be transferred to the Complainant.

*/Marie-Emmanuelle Haas/*

**Marie-Emmanuelle Haas**

Sole Panelist

Date: July 4, 2023