

## **ADMINISTRATIVE PANEL DECISION**

WhatsApp LLC. v. Petar Ivanov

Case No. D2022-4656

### **1. The Parties**

The Complainant is WhatsApp LLC., United States of America, represented by Tucker Ellis, LLP, United States of America.

The Respondent is Petar Ivanov, Bulgaria.

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

The Domain Name <whatsappgroups.app> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 5, 2022. On December 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 6, 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 December 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 December 9, 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 December 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2023. The Respondent did not submit a Response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Jon Lang as the sole panelist in this matter on January 16, 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.

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

The Complainant operates the WhatsApp messaging and voice over IP service and mobile application. It is a global leader in messaging services for mobile devices, with over 2 billion people in over 180 countries using WhatsApp. In recent years, the WhatsApp mobile application has consistently ranked among the top apps in the market. WhatsApp provides a group feature that enables users to create and join group chats with other users. Users can create new groups within the WhatsApp mobile application, and can add over 250 participants to a WhatsApp group.

The Complainant owns the exclusive rights to the WHATSAPP trademarks and service marks (collectively, the "WHATSAPP Mark"), which it has used since 2009. It has made and continues to make a substantial investment of time, effort and expense in the promotion of its goods and services and the WHATSAPP Mark. As a result of the Complainant's efforts and use, the WHATSAPP Mark is inextricably linked with the products and services offered by the Complainant. In addition to its asserted common law rights in the WHATSAPP Mark, the Complainant owns numerous trademark registrations protecting the WHATSAPP Mark in the United States and around the world e.g. United States trademark registration No 3,939,463 with a registration date of April 5, 2011 and European Union trademark registration No 009986514 with a registration date of October 25, 2011.

In addition to the <whatsapp.com> domain name, the Complainant owns and operates 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 Domain Name was registered on September 5, 2021. It is being used to host a commercial parking page that offers the Domain Name for sale and features sponsored links relating to messaging services.

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

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

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; Policy ¶ 4(a)(i)

The WHATSAPP Mark is recognized around the world as signifying high-quality, authentic goods and services provided by the Complainant.

The Complainant's extensive common law trademark and service mark rights derived from its extensive use of the WHATSAPP Mark satisfies the requirements of the Policy, as does its multiple trademark registrations.

The Domain Name adds the term "groups" to the WHATSAPP Mark (which is its dominant element) and is confusingly similar to it. The addition of a descriptive term to a complainant's mark in a domain name fails to distinguish the domain name from the mark.

The Domain Name misappropriates all of the textual components of the WHATSAPP Mark, such that an ordinary Internet user who is familiar with the WHATSAPP Mark would, upon seeing the Domain Name, think an affiliation exists between the Domain Name and the Complainant and/or the WHATSAPP Mark. The term "groups" does not serve sufficiently to distinguish or differentiate the Domain Name from the WHATSAPP Mark. In fact, the addition of "groups" likely increases confusion since the term is descriptive of and relevant to the Complainant's mobile application and services.

The generic Top-Level Domain ("gTLD") also has no distinguishing value for the purposes of the Policy.

The Respondent has no Rights or Legitimate Interest in respect of the Domain Name; Policy ¶ 4(a)(ii)

Once a complainant makes out a *prima facie* case against a respondent that it has no rights or legitimate interest in the domain name, the respondent bears the burden of production to provide evidence demonstrating that it does in fact have such rights or legitimate interests. If the respondent fails to come forward with such evidence, the complainant is deemed to have satisfied this element of the Policy. A complainant establishes a *prima facie* case by showing that a respondent is not authorized to use the mark in question and is not known by a complainant's mark.

Here, the Complainant has not licensed or authorized the Respondent to use the Complainant's WHATSAPP Mark, and there is no legal relationship between the Respondent and Complainant that would entitle the former to do so.

The Respondent cannot demonstrate any of the factors that would support rights or a legitimate interest in the Domain Name under the Policy, e.g. use of, or demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. The Complainant's brand guidelines (available at "https://whatsappbrand.com/") in fact expressly prohibit the use of the WHATSAPP Mark in this manner.

Further, the Whois data for the Domain Name does not support any suggestion that the Respondent is known by the Domain Name and the Complainant, which monitors use of its WHATSAPP Mark, is not aware of the Respondent being known by the Domain Name.

Moreover, the Respondent is not making 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 Domain Name is being used to host a commercial parking page that offers the Domain Name for sale and features sponsored links relating to messaging services. Such use is not a legitimate noncommercial or fair use under the Policy.

The Respondent has no legitimate reason for using the WhatsApp Mark within the Domain Name.

The Respondent has Registered and is using the Domain Name in Bad Faith; Policy ¶ 4(a)(iii)

One of the stated circumstances sufficient to establish bad faith set out in the Policy is a respondent using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its web site 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 its web site or location, or of a product or service on its web site or location.

It is well established that use of a domain name that is identical or confusingly similar to a complainant's mark to host sponsored links or advertisements, is evidence of bad faith. It is similarly well established that use of a domain name to point to a landing page that offers the domain name for sale, is evidence of bad faith.

Further, the registration of a confusingly similar domain name that is obviously connected with a particular trademark owner (as is the case here), by someone with no connection with the trademark owner, suggests bad faith.

Registration of the Domain Name postdates the registration and use of the WHATSAPP Mark by many years.

In addition to the Domain Name, the Respondent has targeted another famous and distinctive mark, and has been the respondent in another UDRP proceeding which ordered the transfer of the domain name in question (see *International Business Machines Corporation v. Petar Ivanov [BG]8011123228*, WIPO Case No. [DNU2020-0003](#)).

Given the fame of the Complainant's WHATSAPP Mark and the Respondent's unauthorized incorporation of it into the Domain Name, there are no circumstances in which the Respondent's use of the Domain Name could plausibly be in good faith under the Policy.

The Respondent is engaged in cybersquatting in violation of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires a complainant to prove: (i) that a respondent has registered a domain name which is identical or confusingly similar to a trademark or service mark in which a complainant has rights; (ii) that the respondent has no rights or legitimate interests in respect of the domain name; (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

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

The Complainant is the owner of the WHATSAPP Mark and thus clearly has rights for the purposes of the Policy.

Ignoring the gTLD ".app" (as the Panel may do for comparison purposes), the Domain Name comprises the WHATSAPP Mark followed by the word "groups". Accordingly, the WHATSAPP Mark and Domain Name are not identical and thus the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves "a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name." (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide "...in cases where a domain name incorporates the entirety of a trademark, .... the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The WHATSAPP Mark is incorporated in its entirety within the Domain Name. It is clearly recognizable within the Domain Name. The addition of the word "groups" does not prevent a finding of confusing similarity.

The Panel finds that the Domain Name is confusingly similar to the WhatsApp Mark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

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

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complaint, however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights or legitimate interests in a domain name in various ways even where, as is the case here, it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is 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 here is not commonly known by the Domain Name. Further, given the use to which the Domain Name has been put, namely to resolve to a web page that offers the Domain Name for sale and features sponsored links relating to messaging services, it would be difficult to conclude that there is anything noncommercial or, given that the Domain Name is confusingly similar to the WHATSAPP Mark (and the nature of the links *i.e.* relating to messaging services being the Complainant's field of activity), fair about the Respondent's use. As to an absence of an intent to mislead (for commercial gain), the Respondent's choice of Domain Name, the dominant element being the Complainant's WHATSAPP Mark with the addition of a descriptive word likely only to increase the risk of confusion, suggests the very opposite.

A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services. However, it seems clear that the Respondent set out to acquire a domain name that would create a misleading impression of association with the Complainant, which has then been used to resolve to a commercial parking page that offers the Domain Name for sale and features sponsored links relating to the Complainant's field of activity. These circumstances cannot amount to a *bona fide* offering of goods or services for the purposes of the Policy.

The Respondent has sought to create an impression of association with the Complainant and has chosen not to attempt to justify his actions. That, perhaps, is not surprising given that it appears to the Panel that there is very little the Respondent could say to challenge the Complainant's assertion that the Respondent lacks rights or legitimate interests in the Domain Name.

The Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy describes a number of non-exclusive scenarios, which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name (provided that a respondent has engaged in a pattern of such conduct). A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it. The Panel finds that this latter scenario encapsulates the circumstances of this Complaint and so finds that the Respondent has registered and used the Domain Name in bad faith.

Despite this finding, it should be noted that a complainant does not have to demonstrate a precise literal application of any of the paragraph 4(b) scenarios. They are non-exclusive and illustrative only, and as long as there is evidence demonstrating that a respondent is seeking to take unfair advantage of, or to abuse a complainant's trademark, such behaviour would satisfy the general principle underlying the bad faith requirement of the Policy. In this proceeding, there is no doubt that the Respondent sought to take unfair advantage of and/or abuse the Complainant's WHATSAPP Mark.

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <whatsappgroups.app> be transferred to the Complainant.

/Jon Lang/

**Jon Lang**

Sole Panelist

Date: January 30, 2023