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2020

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प्रधान मुद्रांक कार्यालय, मुंबई
प.म.वि.क. ८०००००९
30 JUN 2020
सक्षम अधिकारी

BEFORE THE SOLE ARBITRATOR DIPAK G. PARMAR
.IN REGISTRY
(C/o NATIONAL INTERNET EXCHANGE OF INDIA)

WhatsApp Inc.

v/s

...Complainant

प्रा. टी. टी. आबेक

Warrick Mulder

...Respondent

In the matter of Disputed Domain Name <whatsapp.in>

1 The Parties

The Complainant is WhatsApp Inc. 1601 Willow Road, Menlo Park, California, 94025, United States of America represented by Hogan Lovells (Paris) LLP.

The Respondent is Warrick Mulder, Fish e Marketing (Pty) Ltd, Lancaster Street, Cape Town, Western Province 8000, South Africa.

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2 Procedural History

- 2.1 A Complaint dated May 8, 2020 has been filed with the National Internet Exchange of India (hereinafter referred to as the "Exchange"). The Complainant has made the registrar verification in connection with the domain name at issue. It is confirmed that presently the Respondent is listed as the registrant and provided the contact details for the administrative, billing and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (hereinafter referred to as the "INDRP") and the Rules framed thereunder.
- 2.2 The Exchange appointed Dipak G. Parmar, Advocate as the sole arbitrator in this matter. The Arbitrator finds that he was properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- 2.3 On June 24, 2020, the Arbitrator had directed the Respondent to file his reply to the Complaint on or before July 8, 2020. On July 9, 2020, the Arbitrator had extended the deadline for submission of reply to July 15, 2020. The Respondent has not filed any reply to the Complaint. Therefore, the matter has to proceed ex-parte.
- 2.4 Email is the mode of communication of this arbitration and each email is copied to the Complainant, the Respondent and the Exchange.

3 Factual Background

From the Complaint and its annexures, the Arbitrator has found the following facts:

- 3.1 The Complainant is a provider of one of the world's most popular mobile messaging applications ("WhatsApp"). The Complainant was founded in 2009 and acquired by Facebook, Inc. in 2014. WhatsApp users across the globe to exchange messages via smartphones, including iPhone, BlackBerry and Android without having to pay for SMS. WhatsApp's main website available at www.whatsapp.com also allows Internet users to access its messaging platform.
- 3.2 Since its launch in 2009, WhatsApp has become one of the fastest growing and most popular mobile applications in the world, with 2 billion active users worldwide (as of February 2020). WhatsApp has acquired considerable reputation and goodwill worldwide, including in India and South Africa (where the Respondent is based).
- 3.3 The Complainant is the registrant of numerous domain names consisting of the WHATSAPP trade mark, for instance, <whatsapp.com>, <whatsapp.net>, <whatsapp.org>, <whatsapp.biz>, as well as under numerous country code extensions, such as <whatsapp.in>, <whatsapp.co.in> (India), <whatsapp.co.za> (South Africa), <whatsapp.us> (United States), <whatsapp.de> (Germany), <whatsapp.do> and <whatsapp.com.do> (Dominican Republic), <whatsapp.eu>



(European Union), <whatsapp.be> (Belgium), <whatsapp.cl> (Chile), <whatsapp.hk> (Hong Kong), <whatsapp.ly> and <whatsapp.com.ly> (Libya), <whatsapp.mx> (Mexico), <whatsapp.ru> (Russia), <whatsapp.rs> (Serbia), <whatsapp.me> (Montenegro), <whatsapp.es> (Spain), <whatsapp.tw> (Taiwan), <whatsapp.uk> and <whatsapp.co.uk> (United Kingdom).

- 3.4 The Disputed Domain Name <whatsap.in> was registered by the Respondent on May 23, 2013.
- 3.5 The Respondent also registered a large number of domain names consisting of a variation of the Complainant's WHATSAPP trade mark, such as <whatsap.mobi>, <whatsupp.mobi>, <whatsap.co>, <whatsupp.co>, <whatsap.co.uk>, <whatsapps.co.uk>, <whatsupp.co.uk> and <whatzapp.co.uk>.

4 Parties' Contentions

4.1 Complainants

The Complainants contends that the Disputed Domain Name is identical to its trademark 'WHATSAPP'; the Respondent has no rights or legitimate interests in the Disputed Domain Name; and the Disputed Domain Name has been registered and is being used in bad faith.

4.2 Respondent

The Respondent did not file reply to the Complaint.

5. Discussion and Findings

5.1 Discussion and Findings

- 5.1 In view of the default and the absence of any reply to the Complaint by Respondent, the Arbitrator has decided the Complaint on the basis of the statements and documents submitted to him in accordance with the INDRP, the Arbitration and Conciliation Act, 1996, the Rules and other applicable rules and principles of law.
- 5.2 According to the INDRP, the Complainant must prove that:
- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
 - (ii) the Respondent has no rights or legitimate interests in the Disputed Domain Name; and
 - (iii) the Disputed Domain Name has been registered or is being used in bad faith.

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5.3 Identical or Confusingly Similar

The Complainant's trademark "WHATSAPP" is a registered trademark in India, South Africa and other countries. The Complainant has provided evidence of its registered trademarks, based on which, it is found that the Complainant has established its rights in the trademark. It is well accepted that submitting proof of trademark registration is considered *prima facie* evidence of enforceable rights in a mark.¹ The Disputed Domain Name consists of a typosquatted version of the Complainant's WHATSAPP trade mark (the last letter "p" is missing) and merely adds the generic top-level domain, ".in". Prior panels deciding under the Uniform Domain Name Dispute Resolution Policy (UDRP) have held that such visually minimal and aurally irrelevant omission is insufficient to distinguish a domain name from a complainant's trade mark.² It is well-established in various decisions under the UDRP and INDRP that the presence or absence of spaces, punctuation marks between words or indicators for top-level domains, such as .com, .us, .in, co.in etc., are irrelevant to the consideration of identity or confusing similarity between a trademark and a disputed domain name.³ The ".in" suffixes should not be taken into account while comparing the Complainant's trademark and the Disputed Domain Name. Therefore, the Arbitrator finds that the Disputed Domain Name <whatsap.in> is confusingly similar to the Complainant's trademark "WHATSAPP".

5.4. Rights or Legitimate Interests

The Respondent is not commonly known by the Disputed Domain Name nor conducted legitimate business under such name. The Complainant asserts that it has not licensed, authorized, or permitted the Respondent to use the trademark "WHATSAPP". The Respondent's use of the Disputed Domain Name is merely intended to divert customers to Respondent's website, which provides multiple pay-per-click (PPC) links.⁴ Hence, it cannot be considered a bona fide offering of goods and services nor a legitimate non-commercial or fair use. The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and as such the burden of proof shifts to the Respondent.⁵ The Respondent has chosen not to challenge the Complainant's allegations.⁶ There is no evidence before the Arbitrator to support any position contrary to these allegations, and therefore the Arbitrator accepts these arguments. Consequently, the Arbitrator concludes that the Respondent has no rights or legitimate interests in the Disputed Domain Name <whatsap.in>.

1 In the matter of Perfetti Van Melle Benelux BV v. Lopuhin Ivan, IPHOSTER WIPO Case No. D2010-0858 it was held that trademark registration constitutes *prima facie* evidence of the validity of trademark rights. See Backstreet Productions, Inc. v. John Zuccarini, CupcakeParty, Cupcake Real Video, Cupcake-Show and Cupcakes-First Patrol, WIPO Case no. D2001-0654.

2 See section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"): "A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element." See also WhatsApp Inc. v. Cavin Dace, WIPO Case No. DPW2019-0003 <whatsapeurope.pw> et al.: "The Panel notes that in the disputed domain names, Complainant's trademark WHATSAPP is incorporated in its entirety except for the disputed domain name, where the second instance of the letter 'p' of the mark is missing. This omission is visually minimal and aurally irrelevant."

3 See AB Electrolux v. GaoGou of YERECT, INDRP case no. 630 <Zanussi.in>: "The expressions .in and .com need to be discarded while comparing the marks with the domain names".

4 See WIPO Overview 3.0, section 2.9: "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users."

5 See Altria Group, Inc. v. Steven Company, WIPO Case No. D2010-1762.


6 In the matter of Pavillion Agency, Inc., Cliff Greenhouse and Keith Greenhouse v. Greenhouse Agency Ltd., and Glenn Greenhouse, WIPO Case No. D2000-1221, it was held that Respondents' failure to respond can be construed as an admission that they have no legitimate interest in the Domain Names.

5.5 Registered and Used in Bad Faith

The Respondent's failure to reply to the Complainant's clear and explicit cease and desist letter prior to the filing of this Complaint is indicative of the Respondent's bad faith.⁷ This is evidenced by the presence of multiple PPC links posted to Respondent's website. At the time of registration of the Disputed Domain Name, the Complainant was using the registered trademark "WHATSAPP" and the Respondent knew, or at least should have known, of the existence of the Complainant's trademark "WHATSAPP". The Respondent has incorporated a typosquatted version of the Complainant's WHATSAPP trade mark to attract Internet users to the Disputed Domain Name by creating a likelihood of confusion with the Complainant's trademark with an intent of trading on the goodwill and reputation associated with the Complainant's trademark "WHATSAPP" for illegal profits.⁸ These facts supports the inference that the Respondent deliberately registered the Disputed Domain Name using the Complainant's trademark with the intention to exploit it. This proves beyond reasonable doubt his malafide intent behind registration of the Disputed Domain Name. Accordingly, the Arbitrator finds on balance that the Disputed Domain Name has been registered and is being used in bad faith.

6. Decision

In light of the foregoing reasons, the Arbitrator orders that the Disputed Domain Name <whatsap.in> be transferred to the Complainant.



Dipak G. Parmar
Sole Arbitrator

Date: 22 July, 2020

⁷ See Samsung Electronics Co., Ltd. v. EAO Digital Solutions, WIPO Case No. D2012-0693: "The Respondent's failure to reply to a particularly clear and explicit cease and desist letter explaining the Policy is further indicia of bad faith."

⁸ See Weny's LLC v. Apex Limited, INDRP Case no. 737. In this case the domain name <wendys.co.in> was found to be registered with the intention of trading on the goodwill and reputation associated with Wendy's trademark and was held to be registered and use of domain name in bad faith. Also see BASF SE v. Zhang Xiao, WIPO Case No. D2017-2200 <basf.sale>, at Annex 18: "Given the widespread reputation of the BASF marks and the identical domain name, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to fact. Through either displaying a PPC parking page or using a dynamic redirection scheme on the website at the disputed domain name, Respondent is likely to have made substantive commercial gain by 'freeriding' on the reputation of Complainant and its trademarks, which is indicative of Respondent's bad faith use of the disputed domain name."