

DISPUTE RESOLUTION SERVICE

D00021499

Decision of Independent Expert

WhatsApp, Inc.

and

SHOUT marketing SL

1. The Parties:

Complainant: WhatsApp, Inc.
1601 Willow Road
Menlo Park
California
94025
United States

Respondent: SHOUT marketing SL
Avda. Alcalde Clemente Ruiz Diaz, 8
Fuengirola
Málaga
29640
Spain

2. The Domain Name(s):

whatsappmarketing.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

13 June 2019 17:46 Dispute received
18 June 2019 16:03 Complaint validated
18 June 2019 16:09 Notification of complaint sent to parties
05 July 2019 02:30 Response reminder sent
10 July 2019 17:12 No Response received
10 July 2019 17:12 Notification of no response sent to parties
19 July 2019 14:51 Expert decision payment received

4. Factual Background

The Complainant

The Complainant, **WhatsApp, Inc.**, is a provider of one of the world's most popular mobile messaging applications (or "apps") and allows users across the globe to exchange messages via smartphones, including iPhone, BlackBerry and Android. It was founded in 2009 and acquired by Facebook, Inc. in 2014.

The Complainant is the owner of numerous domain names consisting of the WHATSAPP trade mark ('the **Trade Mark**') under various generic Top-Level Domains (gTLDs) as well as under numerous country code Top Level Domains (ccTLDs). It also owns numerous trade mark registrations in the Trade Mark in many jurisdictions throughout the world.

The domain name <whatsappmarketing.uk> ('the **Domain Name**') was registered on 19 March 2018. The Domain Name does not resolve to an active website and does not seem to have been actively used by the Respondent since its creation.

On 22 September 2017, before the Domain Name was registered, the Complainant's lawyers in France sent a cease and desist letter by post and by email to the Respondent asserting the Complainant's trade mark rights and asking the Respondent to transfer to the Complainant 18 other domain names which consisted of the Trade Mark with additions/variations which were both generic Top-Level Domains (gTLDs) as well as under numerous country code Top Level Domains (ccTLDs).

No transfer was made and the Complainant filed a complaint under the Uniform Domain Name Dispute Resolution Policy (UDRP) against the Respondent in respect of ten domain names. The Panel ordered the transfer of these domain names to the Complainant in the following decision 28/8/18: *WhatsApp, Inc. v. Domain Manager, SHOUT marketing SL, and Gonzalo Gomez Rufino, River Plate Argentina, and Gonzalo Gomez Rufino, SHOUT Marketing SL*, WIPO Case No. D2018-1581.

The Respondent has also registered eight additional domain names including the Trade Mark or close variations of it. The Complainant filed this Complaint on 13 June 2019.

The Respondent

The Respondent did not file a Response and the Complainant paid the fee for a full decision on 19 July 2019.

5. Parties Contentions

The Complainant's Background and Rights

The Complainant relies on the above facts and contends as follows:

Since its launch, WhatsApp has become one of the fastest growing and most popular mobile applications in the world, with over 1.5 billion monthly active users worldwide (as of October 2018). WhatsApp has acquired considerable reputation and goodwill worldwide, including in the United Kingdom, as well as in Spain where the Respondent is based. It is also the 3rd most downloaded app for Google Play phones in the United-Kingdom and Spain, according to applications information company App Annie. Annexes are provided to demonstrate this.

The Complainant has also made substantial investments to develop a strong presence on the different social media forums available online. For instance, WhatsApp currently has over 29 million "likes" on its official Facebook page.

Its valuable reputation offline and online is not only crucial to maintain the value and distinctiveness of its brand, but also vital to the success, integrity and protection of its business and consumers. Accordingly, the Complainant devotes significant resources to protect the Trade Mark and goodwill in forums such as this administrative proceeding.

Some of the 18 domain names dealt with in the Complainant's lawyer's letter of 22 September 2017 were pointing to websites offering an application that allowed bulk messaging campaigns to be sent via WhatsApp as well as technical assistance for WhatsApp users, and prominently displayed, without authorisation, the Trade Mark as well as recoloured versions of WhatsApp's telephone logo. No response was received. However, the Complainant's lawyers' cease and desist letter by post was returned undelivered.

On 27 October 2017, the Complainant's lawyers in Spain sent a Spanish translation of the cease and desist letter to the Respondent by post and by email. On 24 November 2017, Gonzalo Gomez Rufino called the Complainant's lawyers in Spain and indicated that he would change the design of the websites associated with the above-mentioned domain names and use non-abusive domain names to point to such websites in order to avoid any conflict with the Trade Mark by 15 January 2018.

There was no compliance and so a successful UDRP Complaint was filed against the Respondent with the decision in *WhatsApp, Inc. v. Domain Manager, SHOUT marketing SL, and Gonzalo Gomez Rufino, River Plate Argentina, and Gonzalo Gomez Rufino, SHOUT Marketing SL*, WIPO Case No. D2018-1581, *whatsappmarketing.com.co* > *et al.* being issued on 28 September 2018. It should be noted that the Respondent registered the Domain Name after the Complainant's lawyer first contacted him and even registered another domain name, namely <*whatsappmarketing.africa*>, after this WIPO decision was issued.

The Respondent registered eight additional domain names which included the Trade Mark / variations of it which the Complainant is pursuing separately.

The Complainant states that given the blatantly abusive registration and use of the Domain Name, it had no choice but to file the Complaint in order to request the transfer of the Domain Name under the Nominet UK Dispute Resolution Service Policy ('the Policy') to protect its legitimate business interests and rights and to protect Internet users from confusion.

The Complainant further asserts under paragraph 2.1 of the Policy that it has Rights based on its registered trade marks for the term WHATSAPP in many jurisdictions throughout the world, including the United Kingdom. These include but are not limited to the following:

- United States trade mark No. 3939463, WHATSAPP, registered on 5 April 2011 (first use in commerce 24 February 2009);
- European Union trade mark No. 009986514, WHATSAPP, registered on 23 May 2011;
- European Union trade mark No. 014988844, WHATSAPP, registered on 5 September 2016; and
- International trade mark No. 1085539, WHATSAPP, registered on 24 May 2011.

In addition, the Domain Name is similar to a name in which it has Rights as it identically reproduces the Complainant's WHATSAPP distinctive and famous trade mark in conjunction with the generic term "marketing" under the .UK country-code Top Level Domain (ccTLD). The addition of such a descriptive term does not prevent a finding of similarity with the Trade Mark. It points to paragraph 2.3 of the Expert's Overview:

"Additional elements rarely trouble experts. For example, in DRS 06973 veluxblind.co.uk the expert commented 'The Domain Name consists of the Complainant's distinctive trademark and the descriptive word "blind", which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant's blinds.'"

It is generally accepted practice under the DRS Policy to discount the .UK suffix as it is a functional element.

It therefore asserts that it has Rights in respect of a name or mark which is identical or similar to the Domain Name, in accordance with paragraph 2.1.1 of the DRS Policy.

Abusive Registration

Under Paragraph 1 of the Policy the Complainant submits that the Domain Name was both registered and has been used in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights.

Unfair registration

The Complainant submits that the Respondent registered the Domain Name in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights, in accordance with paragraph 1(i) of the Policy. It relies on paragraph 5.1.3 of the Policy as of particular relevance. It has not authorised, licensed or otherwise allowed the Respondent to use the Trade Mark in a domain name or otherwise and is not connected to the Complainant in any manner.

The Complainant points to prior domain name dispute panels repeatedly recognizing the strength and renown of the Trade Mark, and ordering the transfer of disputed domain names to the Complainant including, for instance, the above WIPO UDRP decision.

Given the global fame and distinctiveness of the Trade Mark and considerable goodwill, the Complainant submits that it would be inconceivable for the Respondent to argue that it did not have knowledge of the Complainant's WHATSAPP trade mark at the time of registration of the Domain Name. The Respondent thus registered the Domain Name with prior knowledge of the Complainant's rights. As above, the Respondent has been the registrant of other domain names that include the Trade Mark under several generic or specific country extensions and has engaged in a pattern of conduct by registering at least nineteen domain names corresponding to a well-known trade mark in which the Respondent has no apparent rights, and the Domain Name is part of that pattern, in accordance with paragraph 5.1.3 of the Policy.

It refers to *The Commissioners For HM Revenue And Customs v. Whois Foundation*, DRS D00019551, <hmrcsubmitareturn.co.uk>, <hmrc-tx.co.uk>, <hmrc-onlInes.co.uk> and <hdmrc.co.uk>:

"Trading in Domain Names for profit and/or holding a large portfolio of domain names, is not, of itself, objectionable under the DRS or at law (Policy, paragraph 8.4). However, in this case, it is plain from the evidence provided by the Complainant that the Respondent is in (sic.) engaged in large scale registration of domain names which appear to infringe the rights of third parties, because they are identical to the names or marks of those third parties, because they are deliberate mis-spellings of the third party name or mark, or because they include a third party name or mark and an appendage (often mis-spelled). Moreover, the four Domain Names all also

fall into the latter two categories."

Thus the Complainant argues that the Domain Name was registered in a manner which took unfair advantage of, and was unfairly detrimental to, the Complainant's rights, in accordance with paragraph 1(i) of the Policy.

Unfair use

The Complainant asserts that the Respondent is also using the Domain Name in an abusive manner, in accordance with paragraph 1(ii) of the Policy.

It relies on paragraph 5.1.2 of the Policy as of particular relevance. It appears that the Domain Name has not yet been used by the Respondent. However it incorporates the Trade Mark with an added generic term associated with the Respondent's business activity, and in addition given the Respondent's history of and current use of similar domain names, mere passive holding indicates that the Respondent is threatening to use it a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, in accordance with paragraph 5.1.2 of the DRS Policy. In any case, the Complainant submits that such use of the Domain Name by the Respondent would not be permitted. It refers to paragraph 1.3 of the Expert's Overview:

"[...] some Experts have found that in certain circumstances, e.g. where the name is a known brand and the Respondent has no obvious justification for having adopted the name and has given no explanation, the non-use itself can constitute a threatened abuse hanging over the head of the Complainant."

It also refers to *Compagnie Générale Des Etablissements Michelin v restaurant Network*, DRS D00019973 <michelinlinen.co.uk>:

"While there is no evidence of any actual use of the Domain Name, or of any "threat" to use the Domain Name, still less of any actual confusion by businesses or members of the public, the fact that the Respondent at one stage was indicating that a web site would be established using the Domain Name is sufficient to my mind to show a likelihood, in that eventuality, that businesses or people would be confused into thinking that there was some sort of connection between the Complainant and the Domain Name, whether by owning the Domain Name or in some way licensing or authorising use of it. The circumstance which is most important is, in my opinion, that there is no other conceivable reason for using "MICHELIN", as it is so very distinctive of the Complainant and its business. It is not an English word or an English name. I therefore find that paragraph 5.1.2 of the DRS Policy is satisfied.

The Complainant therefore asserts that the Domain Name has been used in a manner which has taken unfair advantage of, and has been unfairly detrimental to, the Complainant's rights, in accordance with paragraph 1(ii) of the Policy.

The Complainant also deals with paragraph 8 of the Policy which provides a non-exhaustive list of the factors which may be evidence that the Domain Name is not an Abusive Registration and submits that the Respondent is not able to invoke any of

the circumstances set out in it.

6. Discussions and Findings

Complainant's Rights

6.1 Under paragraph 2.1 of the Policy the Complainant must prove on the balance of probabilities that:

*'2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.'*

Under paragraph 1 of the Policy:

'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;'

6.2 In the Expert's view the Complainant has uncontested Rights in the Trade Mark both by virtue of its trade mark registrations and as a result of the goodwill and reputation acquired through its use of the Trade Mark over many years. Ignoring the ccTLD suffix "uk" for this purpose, the Domain Name differs from the Mark only by the use of a generic word 'Marketing' which is an activity in which the Complainant engages. In the Expert's view, these differences do not detract from the similarity between the Trade Mark and the Domain Name. Accordingly, the Expert finds that the Complainant has Rights in a mark or name that is identical or similar to the Domain Name.

Abusive Registration

6.3 Under paragraph 1 of the Policy *'Abusive Registration means a Domain Name which either:*

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

6.4 The Domain Name comprises the Trade Mark together with the word "marketing", as a primary activity of the Complainant. Given the global fame and distinctiveness of the Trade Mark and considerable goodwill, already established by the date of registration, it would simply be inconceivable for the Respondent not to have had knowledge of the Trade Mark at the time of registration of the Domain Name. Accordingly, the Expert is in no doubt that

the Respondent registered the Domain Name in full knowledge of the Complainant and its Rights in the Mark. In the absence of any explanation to the contrary from the Respondent, the only credible reason for its registration was with a view to taking unfair advantage of the Complainant's Rights in the Trade Mark and/or to profit from the sale of the Domain Name and/or to use it as a monetised parked domain. In addition, the Respondent is clearly engaged in a deliberate pattern of registrations where it is the registrant of domain names which correspond to well known trade marks in which it has no apparent rights in accordance with paragraph 5.1.3 of the Policy. The Domain Name was therefore registered in a manner which took unfair advantage of, and was unfairly detrimental to, the Complainant's rights, in accordance with paragraph 1(i) of the DRS Policy.

- 6.6 Although the Domain Name does not yet seem to have been used by the Respondent, its nature and the Respondent's history of and current use of similar domain names suggests that the Respondent is threatening to use it in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, in accordance with paragraph 5.1.2 of the Policy. The Expert considers it to be the clear case here that should the Respondent start to use the Domain Name this would confuse or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The above history of the Respondent using other domain names incorporating the Trade Mark to point to websites offering an application that allowed bulk messaging campaigns to be sent via WhatsApp etc provides a precedent for similar behaviour in this case and adds strength to the inference of a threat of confusing use. Furthermore the Trade Mark has such a high level of global fame and reputation that there can be no justification for its use in the Domain Name and in any event no explanation has been provided.
- 6.7 The Complainant also deals with paragraph 8 of the Policy which provides a non-exhaustive list of the factors which may be evidence that the Domain Name is not an Abusive Registration and submits that the Respondent is not able to invoke any of the circumstances set out in it. In particular the Respondent cannot rely on any of paragraphs 8.1.1.1 8.1.1.1.2 and 8.1.1.3 and 8.1.2 of the Policy. The Expert agrees and in any event the Respondent has chosen not to file a Response and make any such arguments or dispute the facts as asserted.
- 6.8 The Expert accordingly, in all of the circumstances, finds that the Domain Name has both been registered and used in a manner which takes advantage of and is detrimental to the Rights of the Complainant and is an Abusive Registration in accordance with both limbs of the Policy definition. Thus, the Expert finds that the Domain Name is an Abusive Registration in accordance with paragraphs 1(i) and 1(ii) of the Policy.

7. Decision

Having found that the Complainant has Rights in respect of a mark which is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert orders that the Domain Name be transferred to the Complainant.

Signed

Dated