

**Domain Name Dispute Resolution Center (DNDRC)**

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Whatsapp Inc. v. Meraart**

**Case No. C2017-0001**

**Also in PDF C2017-0001**

**1. The Parties**

The Complainant is Whatsapp, having its office at 650 Castro Street, Suite 120 – 219, Mountain View, California 94041, United States of America.

The Complainant has initiated the Complaint vide their authorized representative, Mr. David Taylor of Hogan Lovells (Paris) LLP, located at 17, avenue Matignon 75008 Paris, France.

As per the PKNIC Whois database, the Respondent is Meraart and the contact details are [meraart@gmail.com](mailto:meraart@gmail.com) [provided by Registry].

**2. The Domain Names and Registrar**

The domain name in dispute is <whatsapp.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by Meraart since 04.10.2013.

**3. Procedural History**

Under the Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.2, which states that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these

proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply.

A complaint was received and accepted by the Domain Name Dispute Resolution Center (the “DNDRC”) with all completed formalities as on 20.12.2016.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], paragraphs 2(a) and 4(a), DNDRC formally notified the Respondent of the Complaint via email dated 10.01.2017 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response in accordance with the Rules, on the Response Form provided was not received within 10 days from the notification, the dispute would proceed *ex parte*. The Respondent failed to provide a response within the stipulated time period.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Ms. Zahra D’souza as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

## **Factual Background**

The domain name upon which the Complaint is based is <whatsapp.pk>.

PKNIC has confirmed via their email dated 09.01.2017 that the Disputed Domain Name has been registered by the Respondent Meraart and that their email address is [meraart@gmail.com](mailto:meraart@gmail.com).

### **4. Parties Contentions**

#### **A. Complainant**

*The Complainant, WhatsApp Inc., is a provider of one of the world’s most popular mobile messaging applications (or "app"). Founded in 2009 and acquired by Facebook, Inc. in 2014, WhatsApp allows users across the globe to exchange messages via smartphones without having to pay for SMS. Its main website available at [www.whatsapp.com](http://www.whatsapp.com) is the 94th most visited website in Pakistan and the 68th most visited website in the world, according to web information company Alexa (Annex 3).*

*Since its launch in 2009, WhatsApp has become one of the fastest growing and most popular mobile applications in the world, with over 1 million users by the end of 2009, 200*

*million users in April 2013, 500 million users in April 2014, 800 million users in April 2015 and 900 million users worldwide in September 2015. Today, WhatsApp has over 1 billion monthly active users worldwide (as of February 2016). It is available in over 50 languages, including Urdu since 2015.*

*Needless to say, WhatsApp has acquired considerable reputation and goodwill worldwide, including in Pakistan, as widely reported by the national and international press, and it has consistently ranked amongst Apple iTunes 25 most popular free mobile applications. See Annex 4 for information on the Complainant including company information and press articles on WhatsApp's explosive growth and popularity worldwide, including in Pakistan.*

*Reflecting its global reach, the Complainant is the owner of numerous domain names consisting of the WHATSAPP trademark, including, for instance, <whatsapp.com>, <whatsapp.net>, <whatsapp.org>, <whatsapp.biz>, <whatsapp.info> as well as under numerous country code extensions. See Annex 5 for copies of the WHOIS records of some of these domain names.*

*The Complainant also has a strong presence on the different social media forums available online and currently has approximately 24.6 million "likes" on its official Facebook page:*

- <https://www.facebook.com/WhatsApp>
- <https://twitter.com/whatsapp>
- <https://www.linkedin.com/company/whatsapp-inc>.

*Screen captures of the Complainant's social media websites are available at Annex 6.*

*The fame of the Complainant's trademark is also evidenced by the number of cybersquatters who have sought to unfairly and illegally exploit the very significant consumer recognition and goodwill attached to its trademarks. Prior domain name dispute panels have recognized the strength and renown of the Complainant's WHATSAPP trademark, and have ordered infringing respondents to transfer the disputed domain names to the Complainant, including but not limited to in the following decisions:*

- a) *WhatsApp Inc. v. Abdallah Almqbali, WIPO Case No. D2016-128 (<watsabsplus.com>, <whatsapp-plus.ws> et al);*
- b) *WhatsApp Inc. v. Nasser Bahaj, WIPO Case No. D2016-0581 (<ogwhatsapp.org> and <whatsapp-plus.org>)(*"the trademark WHATSAPP is well-known"*.);*

- c) *Facebook, Inc. and WhatsApp Inc. v. Domain Manager, NA, WIPO Case No. D2016-0394 (<whatsapp.com> et al);*
- d) *WhatsApp Inc. v. Francisco Costa, WIPO Case No. D2015-1708 (<webwazzup.com>);*
- e) *WhatsApp Inc. v. Francisco Costa, WIPO Case No. D2015-0909 (<webwhatsapp.com>) (finding that the WHATSAPP trademark had acquired "worldwide renown... amongst mobile applications" and an "impressive number of users... since the launch of the WhatsApp services in 2009"); and*
- f) *WhatsApp Inc. v. Private Whois whatsappandroid.com, Private Whois whatsappipad.com and Private Whois whatsappiphone.com, WIPO Case No. D2012-0674 (<whatsappandroid.com>, <whatsappipad.com> and <whatsappiphone.com>).*

*See Annex 7 for copies of domain name dispute decisions involving the Complainant.*

*The term WHATSAPP is exclusively associated with the Complainant. All search results obtained by typing the term WHATSAPP in Google's search engine available at [www.google.com](http://www.google.com) refer to the Complainant (see Annex 8).*

*In addition to its strong presence online, the Complainant has secured ownership of numerous trademark registrations in the term WHATSAPP in many jurisdictions throughout the world, including in Pakistan, as detailed above.*

*The Complainant's 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 its trademark rights and goodwill in forums such as this administrative proceeding.*

### **The Respondent, the Domain Name and the associated website**

*The Complainant was recently alerted to the fact that the Complainant's WHATSAPP trademark had been registered under the .PK Top-Level Domain (TLD) for Pakistan by the Respondent.*

*The Domain Name was registered on 4 October 2013 by the Respondent (see Annex 1 for a copy of the WHOIS record), on the same day it was announced that the Sindh government had decided to temporarily ban WhatsApp in Pakistan, as widely reported by the national and international press. Copies of press articles are attached at Annex 4.*

*The Domain Name is, at the time of filing, not resolving. However, on 13 May 2016, the Domain Name was pointing to a website displaying the Complainant's logo and falsely appearing to offer WhatsApp in Urdu for download, although in actual fact the links*

*redirected to other websites. The website associated with the Domain Name also contained commercial banners. On 10 June 2016, prompted by the Complainant's cease and desist letter (as explained in more detail below), the Respondent changed the pointing of the Domain Name to a website displaying the following message: "We are selling this domain for \$10,000 USD + Transfer fees if you are intrested (sic) please contact [DomainsBuySell@yandex.com](mailto:DomainsBuySell@yandex.com)". See Annex 9 for screen captures of the websites currently and previously associated with the Domain Name.*

*A search carried out by the Complainant has revealed that the Respondent is also the registrant of another domain name infringing the Complainant's WHATSAPP trademark, namely <whatsappyellowpages.org>, as well as many domain names infringing third party trademarks, such as <applemusic.pk>, <pepsimobilephone.com>, <pepismobilephones.com>, <skype.com.pk>, and <skype.pk>. Copies of sample WHOIS records are attached at Annex 10.*

*On 13 May 2016, the Complainant's lawyers in Paris sent a cease and desist letter to the Respondent by email requesting the Respondent to, inter alia, transfer the Domain Name as well as the domain name <whatsappyellowpages.org>, to the Complainant at no cost and refrain from using the Complainant's trademark in a domain name or otherwise.*

*On 27 May 2016, the Respondent replied in English to the Complainant's lawyers in Pakistan that he wished to sell the Domain Name to the Complainant.*

*On 10 June 2016, the Complainant's lawyers in Paris replied that the Complainant would not agree to purchase the Domain Name (or <whatsappyellowpages.org>) from the Respondent but that it was prepared to refund him his registration and renewal expenses (capped at USD 100).*

*On 13 June 2016, the Respondent replied by email in Urdu stating that he would only sell the Domain Name (and the domain name <whatsappyellowpages.org>) for 10,000 USD. The Respondent also changed the pointing of the Domain Name to reflect the offer for sale (as described above and shown at Annex 9). The Respondent also called the Complainant's lawyers in Pakistan to reiterate his intentions.*

*On the same day, the Complainant's lawyers in Paris reiterated that the Complainant would not purchase the Domain Name from the Respondent and would only reimburse his registration and renewal expenses.*

*The Respondent did not reply to the Complainant's lawyers last email, although he contacted the Complainant's lawyers in Pakistan over the telephone to reiterate his intention of selling the Domain Name for not less than USD 5,000. The Respondent also underlined that he was in the business of acquiring and selling domain names.*

*A copy of the correspondence between the Complainant and the Respondent is attached at Annex 11.*

*Given the blatantly abusive registration and use of the Domain Name, and the Respondent's unwillingness to cooperate despite the Complainant's best efforts, the Complainant had no choice but to file the present Complaint in order to request the transfer of the Domain Name under the Policy to protect its legitimate business interests and rights and to protect consumers from confusion.*

The Complainant's legal contentions in brief are reproduced below:

- A. The Domain Name is identical or confusingly similar to the Complainant's trademark.*
- B. The Respondent has no rights or legitimate interests in respect of the Domain Name.*
- C. The Domain Name was registered and is being used in bad faith.*

Therefore, the Complainant seeks the following remedy:

*In accordance with Paragraph 4(b)(i) of the Policy, the Complainant requests that the Administrative Panel appointed in this administrative proceeding transfer the Domain Name to the Complainant.*

## **B. Respondent**

The Respondent has not submitted any response to DNDRC.

Under section 5(e) of the UDRP, in the absence of a response, the Panel has the authority to commence the proceedings in default and to determine the matter based upon the Complaint.

## **5. Jurisdiction**

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC

and its arbitration decisions.

## **6. Discussion and Findings**

It is well-established that the Panel considers four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

Thus, the decision of the dispute shall be addressed with respect to the following aspects:

- I. *Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 criteria).*
- II. *Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).*
- III. *Legitimate interest in the Disputed Domain Name (a UDRP criteria).*
- IV. *Registration and use of the Disputed Domain Name in bad faith (a UDRP criteria).*

### **I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration**

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*

*e. in the opinion of PKNIC is not appropriate for registration.*

As per the PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2,

*If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.*

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code, 1860 (the "Penal Code") or any applicable criminal law?

The Panel will deal with each of these sub-issues sequentially below.

**i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

Complaint is based upon trade mark registrations in the mark WHATSAPP in different jurisdictions, including Pakistan.

The Complainant has annexed a copy of a certificate of registration of the trade mark issued by the Trade Mark Registry Karachi, Government of Pakistan dated 27<sup>th</sup> May 2011 which confirms that the Complainant has a trade mark registration of the mark WHATSAPP in Class 38 in Pakistan. The Complainant also has trademark registrations in the mark WHATSAPP in Class 9, 38 and 42 in the United States, and International Trademark registrations in the mark WHATSAPP in Class 9 and 38.

The registered trademark of the Complainant appears to be incorporated in its entirety in the Disputed Domain Name <www.whatsapp.pk> and is an obvious derivation of the same.

The Respondent has not provided any information whatsoever with respect to the Disputed Domain Name and as such, no data is available to the Panel to consider on the part of the Respondent.

The Panel therefore finds that the Disputed Domain Name <www.whatsapp.pk> incorporates the registered trade mark of the Complainant WHATSAPP in its entirety, and that such an infringement constitutes an infringement of the trademark registrations of the word WHATSAPP that are held by the Complainant.

As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2, if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid.

Hence, the Panel may well determine, on this criteria alone, that the Disputed Domain Name should be transferred to the Complainant. However, for the purpose of completeness, but not to create any binding precedent requiring the same to be followed in the future, the Panel will also assess and determine the remaining sub-issues as identified above.

**ii. Whether the application and/or registration of Disputed Domain Name is bona fide?**

The Complainant has been offering its services using the trademark “WHATSAPP” across the world for a long period of time, well before the Respondent registered the Disputed Domain Name. The Respondent has failed to rebut the assertion that the registration of the Disputed Domain Name was not bona fide. As such, the Panel is unable to reasonably assume/infer bona fide on part of the Respondent, based on any documentary evidence of any kind, even more so in the absence of any information with respect to the Respondent’s intentions/reasons for using the word “whatsapp” to register a domain name.

Therefore, the Panel finds that the Respondent has failed to demonstrate that the registration of the Disputed Domain Name is bona fide.

**iii. Whether the application and/or registration of the Disputed Domain Name contravene the Penal Code or any applicable criminal law?**

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC’s jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007

version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in the landmark decision of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001).

#### Trade Marks Ordinance, 2001

##### **40. Infringement of registered trade mark.-**

*(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.*

**4. Domain name not to be misleading as to character or significance.-** *(1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

#### Electronic Transactions Ordinance, 2002 (“ETO”)

##### **3. Legal recognition of electronic forms.—**

*No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”*

#### Penal Code

##### *Of Trade, Property and Other Marks*

##### **478. Trade mark.**

*A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)*

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

Moreover, according to Section 3 of ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or in printed form. The Penal Code, therefore, by the operation of Section

3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the registrant would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences under Pakistan Penal Code.

#### Pakistan Penal Code

##### **479. Property mark.**

*A mark used for denoting that movable property belongs to a particular person is called a property mark.*

##### **480. Using a false trade mark.**

*Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.*

As such, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

##### **481. Using a false property mark.**

*Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.*

##### **482. Punishment for using a false trade-mark or property mark.**

*Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.*

As decided in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*, the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation

that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

## **II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights**

The Complainant has contended that the Disputed Domain Name identically reproduces a trademark in which the Complainant has rights.

The Complainant has referred to decisions of prior panels which have found that “*when a domain name wholly incorporates a complainant's registered mark that is sufficient to establish identity or confusing similarity for purposes of the Policy*”.

The Respondent has not provided any information, and has not refuted the contention put forth by the Complainant with respect to its trademark “whatsapp”. The Panel finds that it is well-established that the incorporation of a Complainant's mark in full within a disputed domain name, may be sufficient to establish confusing similarity between the mark and the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, WIPO Case No. D2002-0782, *The Ritz Hotel Ltd v. Damir Kruzicevic*, WIPO Case No. D2005-1137, *See Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525, *Facebook, Inc.v. Instra Proxy Service*, WIPO Case No. C2009-0004).

It is also a well-established principle that the mere addition of a gTLD suffix “.com” or its equivalent is not relevant to the consideration of confusing similarity as it is an integral part of a domain name (*Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, WIPO Case No. D2006-1643, *Facebook, Inc.v. Instra Proxy Service, supra*).

It is apparent that the Disputed Domain Name reproduces the trademark owned by the Complainant in its entirety, thereby rendering the Disputed Domain Name confusingly similar to the trademark of the Complainant.

The Complainant has provided sufficient information, including annexing evidence of the same, that the Complainant has rights in the trademark WHATSAPP.

In the absence of any information or evidence provided by the Respondent, the Panel is unable to infer that the Respondent is commonly known by the Disputed Domain Name. The Panel therefore finds confusing similarity between the Disputed Domain Name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

### **III. Legitimate interests in a domain name**

As per paragraph 4(c), the UDRP requires the Respondent's claim to be of legitimate interest and shall be:

*“proved based on ..... all evidence presented” that “shall demonstrate” the Respondent's “rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii).”*

Paragraph 4(a)(ii) states that:

*“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or*

*(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or*

*(iii) you are 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 Complainant has contended:

*The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy, in order to demonstrate rights or legitimate interests in the Domain Name.*

*The Respondent is not a licensee of the Complainant, nor has he been otherwise authorised or allowed by the Complainant to make any use of its WHATSAPP trademark, in a domain name or otherwise.*

*The Respondent cannot assert that, prior to any notice of this dispute, he was using, or had made demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. As described above, the Domain Name is currently not resolving but until very recently it was resolving to a website displaying the Complainant's logo as well as commercial banners and falsely appearing to offer WhatsApp in Urdu for download, although in actual fact the links redirected to other websites. In addition, further to the Complainant's cease and desist letter, the Respondent changed the pointing of the Domain Name to a website offering the Domain Name for sale for 10,000 USD (plus transfer fees). Such use of the Domain Name cannot possibly be considered a bona fide offering of goods or services as the Respondent was clearly seeking to take advantage of the Complainant's goodwill and renown for his own financial gain. See, for instance, WhatsApp Inc. v. Nasser Bahaj, WIPO Case No. D2016-0581 (<ogwhatsapp.org> et al)("The Respondent is not making a bona fide offering of goods or services via the disputed domain names but is rather offering unauthorized and unlicensed versions of the Complainant's application."), at Annex 7. See also Educational Testing Service v. TOEFL, WIPO Case No. D2000-0044 ("the mere offering of the domain name for sale to any party does not constitute a right or legitimate interest in that name"), at Annex 14.*

*The Respondent cannot conceivably claim that he is commonly known by the Complainant's trademark, in accordance with paragraph 4(c)(ii) of the Policy, given the notoriety surrounding the WHATSAPP trademark and the fact that it is exclusively associated with the Complainant. Furthermore, a search carried out by the Complainant has revealed that the Respondent has not secured nor even sought to secure any trademark rights in the term WHATSAPP.*

*Neither can the Respondent assert that he has made or is currently 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, pursuant to paragraph 4(c)(iii) of the Policy. As described above, the Domain Name was resolving to a website displaying commercial banners from which the Respondent (or a third party) was undoubtedly obtaining financial gain and more recently was offered for sale on the associated website. Such use of the Domain Name leaves no doubt as to the fact that the Respondent's intention is primarily not to use the Domain*

*Name in a fair manner but to unfairly exploit the goodwill of the Complainant's trademark for his own profit. See WhatsApp Inc. v. Nasser Bahaj, [WIPO Case No. D2016-0581](#) ("The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names as these websites display commercial banners and compete with the Complainant." ) at **Annex 7**.*

*Finally, given the renown and explosive popularity of the Complainant's WHATSAPP trademark worldwide, and the nature of the Domain Name itself, which consists of an exact*

*match of the Complainant's trademark, it is simply not possible to conceive of any plausible actual or contemplated active use of the Domain Name by the Respondent (or a third party) that would not be illegitimate. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 at Annex 15.*

*The Complainant therefore asserts that the Respondent has no rights or legitimate interests in the Domain Name, in accordance with paragraph 4(a)(ii) of the Policy.*

The Respondent has not submitted a Response, nor has it provided any information to support its registration of the Disputed Domain Name and in particular assert a legitimate interest in the Disputed Domain Name.

As has been previously adopted by the discussions and findings in WIPO Authorities, it is for the Respondent to rebut the allegations put forth by the Complainant. Also, with respect to proving rights or legitimate interests in disputed domain name(s), it is for the Respondent to submit evidence pertaining to the same as it would be almost impossible, if not extremely difficult for the Complainant to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Name, the Respondent was obliged to submit evidence with respect to the same.

In the absence of any information provided by the Respondent in support of his legitimate interest in the Disputed Domain Name, the Panel based on the information provided by the Complainant finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

#### **IV. Registration and use in bad faith**

With respect to registration in bad faith, the Complainant has made the following submission:

*The Complainant's WHATSAPP trademark is highly distinctive and well known throughout the world, having been continuously and extensively used since 2009 in connection with an instant messaging "app" for mobile devices. Given the Complainant's renown and goodwill worldwide, it would be inconceivable for the Respondent to argue that he did not have knowledge of the Complainant's WHATSAPP trademark at the time of registration of the Domain Name in 2013, 4 years after the Complainant had launched its "app" and 2 years after the Complainant had registered its trademark in Pakistan. Furthermore, as described above, the Domain Name was registered on 4 October 2013 by the Respondent, precisely on the same day it was announced that the Sindh government had decided to temporarily*

*ban WhatsApp in Pakistan, as widely reported by the national and international press (Annex 4). The Respondent's subsequent use of the Domain Name to resolve to a website with the "look and feel" of the Complainant's website, including the Complainant's logo, and purporting to offer an unauthorised version of the Complainant's "app" leaves no doubt as to the Respondent's awareness of the Complainant's rights at the time of registration.*

*The Complainant therefore submits that the Respondent registered the Domain Name in full knowledge of the Complainant's rights in the name WHATSAPP. Prior panels deciding under the Policy have held that actual and constructive knowledge of a complainant's rights at the time of registration of a domain name constitutes strong evidence of bad faith. See eBay Inc. v. Sunho Hong, WIPO Case No. D2000-1633 and E. & J. Gallo Winery v. Oak Investment Group WIPO Case No. D2000-1213, at Annex 16.*

*The Complainant further submits that the Respondent registered the Domain Name, which identically reproduces the Complainant's trademark without adornment, to prevent the Complainant from reflecting its trademark in the corresponding domain name under the .PK extension for Pakistan, and has engaged in a pattern of such conduct, in accordance with paragraph 4(b)(ii) of the Policy, as described above and shown at **Annex 10**. See Telenor v. Mohammad Tahir, [DNDRC Case No. C2008-0001](#) ("The Respondent has... prevented the Complainant from getting it registered and using it for their own purposes, or provision of services."), at **Annex 17**.*

*The Complainant further submits that the Respondent registered the Domain Name primarily for the purpose of selling or otherwise transferring it to the Complainant, for valuable consideration in excess of his documented out-of-pocket costs related to the Domain Name, in accordance with paragraph 4(b)(i) of the Policy. This is demonstrated by the Respondent's offer to sell the Domain Name during his exchanges with the Complainant's lawyers and on the associated website. See Educational Testing Service v. TOEFL, [WIPO Case No. D2000-0044](#) ("The value which Respondent seeks to secure from sale of the domain name is based on the underlying value of Complainant's trademark... the Panel concludes that the Respondent did in fact register and use the "toefl.com" domain name in bad faith"), at **Annex 14**.*

*The Complainant therefore submits that the Respondent registered the Domain Name in bad faith.*

With respect to use in bad faith, the Complainant has submitted:

*It is submitted that the Respondent was until very recently using the Domain Name to intentionally attract, for commercial gain, internet users to his website by creating a*

*likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website, in accordance with paragraph 4(b)(iv) of the Policy.*

*There is no doubt that internet users would expect to find the Complainant's official website dedicated to users in Pakistan at a domain name incorporating the Complainant's exact WHATSAPP trademark under the .PK extension. Thus the Respondent was deliberately using the Domain Name seeking to mislead internet users searching for the Complainant's official website for users in Pakistan and divert them to his own website.*

*The Respondent's prior use of the Domain Name to resolve to a website displaying the Complainant's logo and with the "look and feel" of the Complainant's website to purportedly offer an unauthorised version of the Complainant's "app" in Urdu for download further exacerbated the confusion created by the Domain Name itself. Such use of the Domain Name was clearly in bad faith as the Respondent was seeking to cause confusion as to the source of the website in order to take advantage of the Complainant's rights (as explained above, the website was displaying commercial banners from which the Respondent or a third party was undoubtedly financial gain). The Respondent's subsequent use of the Domain Name to resolve to a website offering the Domain Name for sale is also a strong indication of his intent to take advantage of the Complainant's rights and constitutes additional strong evidence of bad faith.*

*Finally, the fact that the Domain Name is currently not resolving does not cure the Respondent's bad faith, given the overall circumstances of this case. Furthermore, given the overwhelming renown and explosive popularity of the Complainant's trademark worldwide and the nature of the Domain Name itself, there simply cannot be any actual or contemplated good faith use of the Domain Name as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, at Annex 15.*

*In view of the above, the Complainant asserts that the Domain Name was registered and is being used in bad faith, in accordance with paragraph 4(a)(iii) of the Policy.*

Paragraph 4(b) of the UDRP states that:

*“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 you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or*

*(ii) you have 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 you have engaged in a pattern of such conduct; or*

*(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or*

*(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location."*

Paragraph 15(a) of the Rules instructs the Panel to *"decide a complaint on the basis of the statements and documents submitted in accordance with the policy, these rules and any rules and principles of law that it deems applicable"*.

The Respondent has not provided any information or evidence to demonstrate lack of bad faith with respect to registration and use of the Domain Name.

The Complainant's submission includes documentation suggesting that the WHATSAPP trademark belonging to the Complainant is highly distinctive and well known throughout the world. Since its registration, the Disputed Domain Name resolved to a website with the logo of the Complainant. This suggests that the Respondent was fully aware of the Complainant and its services at the time of registration.

Moreover, the Complainant has provided documentation that suggests that the Respondent has used the Disputed Domain Name for commercial benefit and to redirect visitors to the Respondent's own website, The Complainant has correctly pointed out that the fact that the Disputed Domain Name is not currently resolving does not mean that the Respondent is using the Disputed Domain Name in good faith. Given the overwhelming popularity of the Complainant's trademark as supported by the annexures to the Complaint, and in the absence of any response from the Respondent, the Panel infers that the use of the Disputed Domain Name by the Respondent is also in bad faith.

### **WIPO Authorities:**

The Panel, for the purpose of assessing the matter and this Decision, has taken into account, reviewed and made use of the Discussions & Findings in the WIPO Authorities mentioned and relied upon by the Complainant.

Furthermore, the Panel has also relied upon the Discussions & Findings in several WIPO Administrative Panel Decisions, inter alia:

- Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Universal City Studios, Inc., supra
- CBS Broadcasting, Inc. v. Gaddoor Saidi, WIPO Case No. D2000-0243,
- Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525
- Nokia Group v. Mr. Giannattasio Mario, WIPO Case No. D2002-0782
- The Ritz Hotel Ltd v. Damir Kruzicevic, WIPO Case No. D2005-1137
- Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge, WIPO Case No. D2006-1643
- NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A., WIPO Case No. D2008-1984
- The South African Football Association (SAFA) v. Fairfield Tours (Pty) Ltd, WIPO Case No. D2009-0998

### **7. Decision**

Analyzing the details provided by the Complainant, the Panel perceives that the WHATSAPP mark belongs to the Complainant hence the Complainant reserves crucial interest in them. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining.

Taking all of the case law and discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no rights or legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.

4. The Disputed Domain Name has been registered and is being used in bad faith by the Respondent.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section (i) of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <www.whatsapp.pk> to the Complainant, as prayed within 48 hours of receipt of this decision by email or its being uploaded on to DNDRC's website [www.dndrc.com/cases\\_resolved/](http://www.dndrc.com/cases_resolved/), whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

**Arbitrator: Ms. Zahra D'souza**

**Sole Panelist**

**Date: 16<sup>th</sup> February 2017**