

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

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Whatsapp Inc. v. WCL**

**Case No. C2017-0007**

**Also in PDF C2017-0007**

**1. The Parties**

The Complainant is WhatsApp, Inc. 1601 Willow Road Menlo Park, California United States of America 94025. The Complainant has initiated the Complaint vide their authorized representative, Mr. David Taylor of Hogan/ Jane Seager Lovells (Paris) LLP, located at 17, avenue Matignon 75008 Paris, France.

The Respondent's name is WCL with its address at 17 Tariq Road Karachi Pakistan.

**2. The Domain Names and Registrar**

The domain name in dispute is <**whatsapp.com.pk**>, hereinafter referred to as the Disputed Domain Name. Vide email dated Wednesday 19 July 2017, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is WCL with its address at 173-p Tariq Road, Karachi, Pakistan and its Create Date was 2015-11-30 with an Expire Date of 2017-11-30.

**3. Procedural History**

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 5 July 2017.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 19 July 2017 informing the Respondent that if a Response was not received 7 days from the notification, the dispute would be proceeded ex parte. DNDRC awaited the

submission by the Respondent of the Response as per the prescribed forms also available at [www.dndrc.com/downloads](http://www.dndrc.com/downloads).

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Abbas Lotia 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.com.pk**>

PKNIC has confirmed via their email dated 19 July 2017 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is [leon@digite.co.uk](mailto:leon@digite.co.uk).

## **4. Parties Contentions**

### **A. Complainant**

The Complainant's brief contentions are reproduced below:

*The Complainant, WhatsApp Inc., is a provider of one of the world's most popular mobile messaging applications (or "apps"). 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 49th most visited website in Pakistan and the 71th 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) in 180 countries. It is available in over 50 languages, including Urdu since August 2015.*

*Needless to say, WhatsApp has acquired considerable reputation and goodwill worldwide, including in Pakistan where the Respondent is based, as widely reported by the national and international press, and it has consistently ranked amongst Apple iTunes*

*25 most popular free mobile applications. Furthermore, the Complainant's official website available at [www.whatsapp.com](http://www.whatsapp.com) is regularly amongst the Top 100 most visited websites in the world, according to web information company Alexa.*

*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 trade mark, including, for instance, <whatsapp.com>, <whatsapp.net>, <whatsapp.org>, <whatsapp.info> as well as under numerous country code extensions such as <whatsapp.eu> (European Union), <whatsapp.am> (Armenia), <whatsapp.cl> (Chile), <whatsapp.de> (Germany), <whatsapp.hk> (Hong Kong), <whatsapp.in> and <whatsapp.co.in> (India), <whatsapp.ly> and <whatsapp.com.ly> (Libya), <whatsapp.nl> (the Netherlands), <whatsapp.nz> (New Zealand), <whatsapp.pk> (Pakistan), <whatsapp.tw> (Taiwan), <whatsapp.uk> and <whatsapp.co.uk> (United Kingdom), and <whatsapp.us> (United States). See Annex 5 for copies of the WHOIS records of some of these domain names.*

*The Complainant also has also made substantial investments to develop a strong presence on the different social media forums available online and currently has approximately 27.4 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 trade mark 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 trade marks. Prior domain name dispute panels have recognized the strength and renown of the Complainant's WHATSAPP trade mark, 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. Meraart](#), DNDRC Case No. C2017-0001, (<whatsapp.pk>);*

- b) *WhatsApp, Inc. v. Abdallah Almqbali, WIPO Case No. D2016-1287 (<watsabsplus.com>, <whatsapp-plus.ws> et al);*
- c) *WhatsApp, Inc. v. Nasser Bahaj, WIPO Case No. D2016-0581 (<ogwhatsapp.org> and <whatsapp-plus.org>)(*"the trademark WHATSAPP is well-known"*.);*
- d) *Facebook, Inc. and WhatsApp, Inc. v. Domain Manager, NA, WIPO Case No. D2016-0394 (<whatsapp.com> et al);*
- e) *WhatsApp Inc. v. Francisco Costa, WIPO Case No. D2015-1708 (<webwazzup.com>);*
- f) *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*
- g) *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) or [www.google.com.pk](http://www.google.com.pk) refer to the Complainant (see Annex 8).*

*In addition to its strong presence online, the Complainant has secured ownership of numerous trade mark 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 trade mark rights and goodwill in forums such as this administrative proceeding.*

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

*The Domain Name was registered on 30 November 2015 by the Respondent (see **Annex 1** for a copy of the WHOIS record), a few months after the release of Whatsapp in Urdu in Pakistan. Copies of press articles are attached at **Annex 4**.*

*The Domain Name is, at the time of filing, pointing to a website displaying the Complainant's trade mark and falsely appearing to offer WhatsApp and other services for download, although in actual fact the links redirect to other websites. See **Annex 9** for screen captures of the website associated with the Domain Name.*

*A search carried out by the Complainant has revealed that the Respondent is also the registrant of two other domain names infringing third party trademarks: <googke.com.pk> and <waptric.com.pk>. Copies of WHOIS records are attached at **Annex 10**.*

*It is worth noting that the Domain Name Dispute Resolution Center (DNDRC) has recently ordered the transfer of the domain name <whatsapp.pk>, which was used by the registrant to resolve to a website appearing to offer WhatsApp in Urdu for download while this was not the case. See **Annex 7** for a copy of this domain name dispute decision.*

*On 17 March 2017, the Complainant's lawyers in Paris sent a disclosure request letter to the .PK registry, PKNIC, for the full WHOIS details for the Domain Name to be revealed in order to contact the registrant of the Domain Name. On 21 March 2017, PKNIC indicated the formalities to file a complaint and further noted that the registrant's contact details could not be disclosed due to privacy reasons.*

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

*Given the blatantly abusive registration and use of the Domain Name, and the Complainant's inability to contact the Respondent in the absence of any contact details, the Complainant had no choice but to file the present Complaint under the Policy to protect its legitimate business interests and rights and to protect consumers from confusion.*

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**

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website ([http://www.dndrc.com/cases\\_resolved/pdf/c2007-0001.pdf](http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf)), the Panel laid down the following 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)*

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 domain name (a UDRP criteria).
- iv. Registration and use of the 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?**

The Complainant has stated:

*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 27th 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 Complainant is the owner of numerous domain names consisting of the WHATSAPP trade mark, including, for instance, <whatsapp.com>, <whatsapp.net>, <whatsapp.org>, <whatsapp.info> as well as under numerous country code extensions such as <whatsapp.eu> (European Union), <whatsapp.am> (Armenia), <whatsapp.cl> (Chile), <whatsapp.de> (Germany), <whatsapp.hk> (Hong Kong), <whatsapp.in> and <whatsapp.co.in> (India), <whatsapp.ly> and <whatsapp.com.ly> (Libya), <whatsapp.nl> (the Netherlands), <whatsapp.nz> (New Zealand), <whatsapp.pk> (Pakistan), <whatsapp.tw> (Taiwan), <whatsapp.uk> and <whatsapp.co.uk> (United Kingdom), and <whatsapp.us> (United States). See Annex 5 for copies of the WHOIS records of some of these domain names.*

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 finds that the Disputed Domain Name 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 in Pakistan and a number of other countries.

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 Complaint has submitted:

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 provide any information to rebut the assertion and information provided by the Complainant suggesting 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 term “WHATSAPP” to register a domain name.

Thus, the Panel finds that the registration of the Disputed Domain Name by the Respondent was not 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 *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 the 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.

***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 the following:

*The Complainant submits that the Domain Name identically reproduces the Complainant's WHATSAPP trade mark without adornment under the .PK country code extension for Pakistan (Annex 2). Prior panels deciding under the Policy have held 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." See *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525, at Annex 12. See also Facebook, Inc.v. Instra Proxy Service, DNDRC Case No. C2009-0004, <facebook.pk> ("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"), at Annex 13.**

*It is well accepted that the suffix .COM.PK is generally irrelevant when assessing whether a domain name is identical or confusingly similar to a trade mark as it is a functional element. See *Facebook, Inc.v. Instra Proxy Service, supra, at Annex 13.**

*Therefore, the Domain Name is identical to the Complainant's trade mark in accordance with paragraph 4(a)(i) 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 apparent that the Disputed Domain Name reproduces the trademark owned by the Complainant in its entirety. The Complainant has also correctly stated that the mere addition of the “.com.pk” suffix does not differentiate the Disputed Domain Name from the registered mark 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 that the Disputed Domain Name is identical to 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 trade mark, 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 resolving to a website displaying the Complainant's trade mark and falsely appearing to offer WhatsApp and other services for download, although in actual fact the links redirect to other websites, including some that refer to the Complainant's trade mark or offer instant messaging apps for download. The Domain Name is used to earn pay-per-click (PPC) revenue by redirecting Internet users to third parties' websites and thus capitalizing on the Complainant's trade mark. Such use of the Domain Name cannot possibly be considered a bona fide offering of goods or services as the Respondent is clearly seeking to take advantage of the Complainant's goodwill and renowned for his own financial gain. See Legacy Health System v. Nijat Hassanov, WIPO Case No. D2008-1708 ("The evidence provided by the Complainant demonstrates that the sole purpose of the disputed domain name is to resolve to pay-per-click advertising websites and collect click through revenue from advertising links. Such use demonstrates that the Respondent has used the disputed domain name to derive a commercial benefit."), at Annex 14.*

*The Respondent cannot conceivably claim that he is commonly known by the Complainant's trade mark, in accordance with paragraph 4(c)(ii) of the Policy, given the notoriety surrounding the WHATSAPP trade mark and the fact that it is exclusively associated with the Complainant.*

*Neither can the Respondent assert that he has made or is currently making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue, pursuant to paragraph 4(c)(iii) of the Policy. As described above, the Domain Name is resolving to a website redirecting to other websites displaying commercial banners from which the Respondent (or a third party) is undoubtedly obtaining financial gain. 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 trade mark 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 overwhelming renown and explosive popularity of the Complainant's WHATSAPP trade mark worldwide, and the nature of the Domain Name itself, which consists of an exact match of the Complainant's trade mark, 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.*

On the other hand, 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**

The Complainant has provided:

*The Complainant asserts that the Domain Name was registered and is being used in bad faith.*

*Paragraph 4(b) of the Policy lists four factors which, in particular but without limitation, may be evidence of registration and use of a domain name in bad faith for the purposes of paragraph 4(a)(iii) of the Policy.*

*It is submitted that paragraph 4(b)(iv) of the Policy is of particular relevance in the present case, although there are other factors not listed in paragraph 4(b) of the Policy that also strongly indicate bad faith.*

*The Complainant's WHATSAPP trade mark is highly distinctive and well known throughout the world. It has been continuously and extensively used since 2009 in connection with an instant messaging "app" for mobile devices, and has rapidly acquired considerable goodwill and renown worldwide. See Annex 4 for press articles on WhatsApp's explosive growth and popularity.*

*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 trade mark at the time of registration of the Domain Name in 2015, 6 years after the Complainant had launched its "app" and 4 years after the Complainant had registered its trade mark in Pakistan. See, for instance, WhatsApp Inc. v. Francisco Costa, WIPO Case No. D2015-0909 (<webwhatsapp.com>, registered on 16 October 2012) ("it is likely improbable that Respondent did not know about Complainant's WHATSAPP trademark at the time it registered the Disputed Domain Name considering the worldwide renown it has acquired amongst mobile applications, and the impressive number of users it has gathered since the launch of the WhatsApp services in 2009"), at Annex 7. Furthermore, the Respondent's use of the Domain Name to resolve to a website which is pointing to a parking page containing sponsored links*

*that make direct reference to the Complainant's trade mark 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 trade mark without adornment, to prevent the Complainant from reflecting its trade mark in the corresponding domain name under the .COM.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 therefore submits that the Respondent registered the Domain Name in bad faith.*

*It is submitted that the Respondent is 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 trade mark under the .COM.PK extension. Thus the Respondent is 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 use of the Domain Name to resolve to a website displaying pay-per click links further exacerbates the confusion created by the Domain Name itself. Such use of the Domain Name is clearly in bad faith as the Respondent is 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 Respondent or a third party is undoubtedly obtaining financial gain). It should be noted that this argument was also accepted by the panel in a recent decision revoking the registration of the domain name <whatsapp.pk>, which used to resolve to a website falsely appearing to offer WhatsApp in Urdu for download. See Annex 7 for a copy of this domain name dispute decision ("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") and Annex 18 for the screen captures of the website associated with the domain name <whatsapp.pk>).*

*Finally, it should be noted that the fact that the Respondent deliberately did not provide full contact information in the WHOIS so the Complainant was unable to contact him is additional evidence of bad faith. See Association Robert Mazars v. INTEG Kumaran, WIPO Case No. D2009-1679, <mazargroup.com> ("Providing false or inaccurate contact information when registering a domain name can be evidence of bad faith registration and use in the sense of the Policy") at Annex 19.*

*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.*

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 overwhelming popularity of the Complainant's trademark is well-supported by the annexures to the Complaint. The Complainant has correctly pointed out that the mark of the Complainant which is incorporated in its entirety in the Disputed Domain Name is highly distinctive, and there is no information available to suggest that the Respondent is known by this mark. The Panel also finds in light of the information provided by the Complainant that it is unlikely that the Respondent was not aware of the mark of the Complainant.

The Panel therefore finds that the Disputed Domain Name was registered and is being used in bad faith by the Respondent.

**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 the following WIPO Administrative Panel Decisions in addition to those mentioned in the decision:

- 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 has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name.

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 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 was registered and being used in bad faith.

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 < <**whatsapp.com.pk**>>, 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: Mr. Abbas Lotia**

**Sole Panelist**

**Date: 6<sup>th</sup> November 2017**