

.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainant: WhatsApp Inc.
Respondent: GOIP Holdings Limited
Case Number: DHK-1300095
Contested Domain Name: <whatsapp.com.hk>
Panel Member: Ike Ehiribe

1. Parties and Contested Domain Name

1.1 The Complainant is WhatsApp Inc. a corporation incorporated in the United States of America with its registered office at 3561 Homestead Road, 416 Santa Clara, CA 95051 USA (the “Complainant”) and represented by Rouse Legal in Hong Kong.

1.2 The Respondent is GOIP Holdings Limited is a limited liability company with its registered office at Unit 2A, Universal Industrial Centre, 19-25 Shan Mei Street, Fotan, Shatin, Hong Kong (the “Respondent”) and unrepresented.

1.3 The disputed domain name is <whatsapp.com.hk> (the “disputed Domain Name”), which was registered by the Respondent with the Hong Kong Domain Name Registration Company Limited (the “Registrar”).

2. Procedural History

2.1 The Complaint was filed with the Hong Kong International Arbitration Centre (the “HKIAC”) on 11 June 2013. On 11 June, 2013, the HKIAC transmitted by email to the Hong Kong Domain Name Registration Company Ltd a request for registrar verification in connection with the disputed Domain Name. On 13 June, 2013, the Hong Kong Domain Name Registration Company Ltd transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

2.2 The HKIAC formally notified the Respondent of the Complaint and the attached exhibits by email of 17 June, 2013 and advised the Respondent of

the prescribed fifteen business days deadline within which to file a response; being on or before 09 July, 2013. The Respondent did not file a response.

2.3 By email of 24 July, 2013 the HKIAC advised the parties that Ike Ehiribe had been appointed as a sole panelist in this matter.

3. Factual Background

For_the_Complainant

3.1 The Complainant is a corporation incorporated in the United States of America with its registered office at 3561 Homestead Road, 41 Santa Clara, CA 95051, United States. The Complainant an information technology developing company specializes in the provision of mobile applications, which includes cross-platform mobile messaging. Apart from text messaging, users can send each other images, video, and audio messages through the Complainant's mobile application. The Complainant's mobile application is provided under the trademark "WHATSAPP" which has been downloaded by millions of mobile phone users around the world and used to send more than 1 billion messages per day. The Complainant holds trademark rights in the "WHATSAPP" trademark in numerous countries as detailed in exhibits 'B' and 'C' attached to these proceedings including the U.S.A., Hong Kong, China and in the European Union. The Complainant has exhibited a list of twenty-one domain names containing the registered trademark "WHATSAPP" as part of the said domain names registered by the Complainant.

For_the_Respondent

3.2 The Respondent is a company with its registered office at Unit 2A Universal Industrial Centre, 19 -25 Shan Mei Street, Fotan, Shatin in Hong Kong. The Respondent registered the disputed Domain Name <whatsapp.com.hk> on 29 November, 2012 according to the WHOIS search result attached to these proceedings. By letter of 16 April, 2013 the Complainant wrote to the Respondent to demand, *inter alia* the transfer of the disputed Domain Name to the Complainant but the Respondent did not respond.

4. Parties' Contentions

The Complainant

4.1 The Complainant asserts that the disputed Domain Name <whatsapp.com.hk> is identical or confusingly similar to the Complainant's "WHATSAPP" trademark in line with paragraph 4(a) (i) of the "hk" Domain Name Dispute Resolution Policy. In this regard, the Complainant refers to two schedules of registered trademarks in numerous countries marked exhibits 'B' and 'C', including the registration certificate of the Complainant's trademark in Hong Kong since 25 May, 2011 in classes 9 and 38.

4.2 The Complainant further asserts that the Respondent has no rights or legitimate interests in the disputed Domain Name in accordance with paragraph 4(a)(ii) of the Policy in that the Respondent has never been authorized to register the disputed Domain Name and or that the Respondent is not making a legitimate non-commercial or fair use of the disputed Domain Name. The Complainant further contends that the Respondent has no connection of affiliation with the Complainant and has not received any license or consent, express or implied, from the Complainant to use its mark in a domain name or in any other manner.

4.3 The Complainant also submits that the Respondent has engaged in bad faith use and registration as provided for in paragraph 4(a)(iii) of the Policy. In support of this contention, the Complainant refers to the fact that the Respondent has misled the public into the mistaken belief that the Respondent's website is the official website of the Complainant by registering the disputed Domain Name <whatsapp.com.hk> and using the email address info@whatsapp.com.hk which also incorporates the Complainant's "WHATSAPP" trademark.

4.4 As further evidence of bad faith use and registration, the Complainant contends that despite receiving the Complainant's letter of 16 April, 2013 demanding the transfer of the disputed Domain Name, the Respondent has failed to transfer the disputed Domain Name as demanded. Furthermore, it is submitted that the Respondent has for commercial gain attempted to attract Internet users to the website to which the disputed Domain Name resolves, by exploiting the Complainant's goodwill in its trademark and thereby creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, endorsement of the website as well as the services offered on the website.

The Respondent

4.5 The Respondent did not file any response within the stipulated time.

5. Findings

According to Paragraph 4a of the HKDNR Domain Name Dispute Resolution Policy (the "Policy"), which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered and is being used in bad faith; and
- (iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.

(1). Identical/confusing similarity

This Panel is satisfied that the Complainant has long established rights in the trademark “ WHATSAPP” in numerous jurisdictions including in Hong Kong where the Respondent is based. The Panel is also satisfied that on a careful comparison of the disputed Domain Name <whatsapp.com.hk> with the Complainant’s trademark, it is undoubtedly obvious that the disputed Domain Name is identical or confusingly similar to the Complainant’s trademark and indeed the Complainant’s other domain names listed in Exhibit ‘D’ attached to these proceedings. In support, see in particular, a recent and consolidated UDRP decision involving the Complainant in *WhatsApp Inc. v. Private Whois whatsappandroid.com, Private Whois whatsappipad.com and Private Whois whatsappiphone.com*, WIPO Case No. D2012-0674, where the disputed domain names namely:(i) <whatsappandroid.com>; (ii) <whatsappipad.com>; and (iii) <whatsappiphone.com> were all found to be confusingly similar and identical to the complainant’s trademark.

The Panel finds that the disputed Domain Name wholly incorporates the Complainant’s trademark and the fact that the disputed Domain Name includes the generic top level domain “. com” and the country abbreviation “hk” does not preclude a finding of identical or confusing similarity. See in this regard a number of previous UDRP and recent .HK DNDR decisions, namely: *Dell Computer Corporation v. MTO C.A. and Diabetes Education Long Life*, WIPO Case No: D2002-0363; *Etude Corporation v. New Town Cosmetics Trading Company*, HKIAC Case No.DHK-1300088 and *Tommy Bahama Group Inc., v. Xiaole Shen*, HKIAC Case No. DHK-1300090.

In the circumstances the Panel finds that the requirements of paragraph 4 (a)(i) of the Policy have been satisfied by the Complainant.

(2). Rights or Legitimate Interests of Respondent

The Panel accepts, as is contended by the Complainant that the Respondent is not a licensee of, or is it affiliated with the Complainant in any manner to suggest that it is authorized by the Complainant to use the Complainant's trademark. The Respondent has failed to provide any evidence to establish that it has been commonly known by, or has been making a *bona fide* use of the disputed Domain Name in connection with the offering of goods or services or has been making a legitimate noncommercial or fair use of the disputed Domain Name. Accordingly, this Panel is satisfied from the adduced evidence in the form of website printouts which demonstrates unauthorized usage on the part of the Respondent, that the Respondent has no rights or legitimate interests in the disputed Domain Name. As such unauthorized usage can never be described as a *bona fide* offering of goods and services nor a legitimate non-commercial or fair use of the disputed Domain Name See generally in this regard, *Oki Data Americas Inc. v. ASD Inc.*, WIPO Case No.D2001-0903.

In the circumstances and considering the Respondent's failure to furnish a defence in these proceedings, the Panel finds that the Complainant has satisfied the requirements of paragraph 4 (a)(ii) of the Policy.

(3). Bad faith

On the question of bad faith use and registration, the Panel finds that the Respondent undoubtedly registered the disputed Domain Name in bad faith and engaged in bad faith use. In arriving at this conclusion, the Panel has taken into account a number of irrefutable factors. In the first instance, the Panel finds that the Respondent must have known or ought to have known of the Complainant's extensive exclusive rights in the "WHATSAPP" trademark in numerous countries and in Hong Kong where the Respondent is located. Clearly, the Respondent elected to register the disputed Domain Name on 29 November 2012, well after the Complainant had obtained trademark registration of its trademark in Hong Kong on 25 May 2011, with the bad faith intention to exploit the Complainant's goodwill in the said trademark. In this regard again see, *WhatsApp Inc. v. Private Whois whatsappandroid.com, Private Whois whatsappipad.com and Private Whois whatsappiphone.com, supra*. Secondly, the Panel finds that the Respondent

has made use of the disputed Domain Name to mislead the public into believing that the Respondent's website is an official website of the Complainant by using the Complainant's trademark and an email address info@whatsapp.com.hk which incorporates entirely the said Complainant's trademark. Thirdly, the Respondent has attempted to use the disputed Domain name to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship affiliation or endorsement of that website. Fourthly, the Panel finds the Respondent's failure to respond to the Complainant's letter of 16 April, 2013 and or transferring the disputed Domain Name as demanded, is further evidence of bad faith use, see in this regard *Bayerische MotorenWerke AG v. Joshuathan Investments, Inc.*, WIPO Case No.D2002-0787. In any event the Panel has drawn adverse inferences from the Respondent's failure and or refusal to respond to this letter and the evidence and submissions presented by the Complainant in these proceedings.

The Panel therefore finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

6. Conclusions

At paragraph 7 of the complaint, titled " Remedies Sought" the Complainant has requested that the Panel transfer the disputed Domain Name to their Solicitors in Hong Kong, namely Rouse Legal. Normally, in the event of a successful complaint, the disputed domain name would be transferred to the Complainant. However, Article 3.6 of the Domain Name Registration Policies, Procedures and Guidelines, effective 22 February 2011, stipulates that Commercial entities registered in HKSAR are eligible to register a .com.hk English Domain Name. Therefore as the Complainant is not a commercial entity registered in Hong Kong, the Complainant has correctly requested that the disputed Domain Name be transferred to Rouse Legal the Complainant's solicitors and agents in Hong Kong. Therefore, following recent previous .hk DNDR decisions such as *Golla Oy v. Yica International Group Co., Limited*, HKIAC Case No. DHK-1200075 and *Etude Corporation v. New Town Cosmetics Trading Company, supra*, on this question, of transferring a disputed Domain Name to a Hong Kong agent nominated by a complainant registered out of Hong Kong, the Panel accepts the Complainant's nomination of Rouse Legal and orders the disputed Domain Name to be transferred to Rouse Legal.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the disputed Domain Name <whatsapp.com.hk> be transferred to the Complainant's solicitors and agents in Hong Kong being Rouse Legal.

Dated: 14 August 2013

Ike Ehiribe
Sole Panelist