Dispute Number: DCA - 1904 - CIRA
Domain Names: whatsapp.ca
Complainant: WhatsApp Inc.
Registrant: Hiba Alnatour
Panel: Melvyn J. Simburg, David Wotherspoon and Elizabeth Cuddihy (Chair)
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. The complainant is WhatsApp Inc. of 1601 Willow Road, Menlo Park, California 94025, United States of America, (the Complainant).

2. The Registrant is Hiba Alnatour of 286 Verdun Street, #102, Beirut, Lebanon, 0000, (the Registrant).

The Disputed Domain Name and Registrar

3. The Domain Name at issue is whatsapp.ca, (the Disputed Domain Name).

4. The Registrar of record for the Disputed Domain Name is MyID.ca (Creative Pixels Inc.).

5. The Disputed Domain Name was registered on January 15, 2015.

Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (the Policy) and the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).
7. The Complainant filed a complaint on August 23, 2017, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules and forwarded copy of the Complaint to the Registrant in accordance with the Rules.

9. The Registrant did not provide a response within the timeframe required by the Rules; namely, September 13, 2017. On September 21, 2017, the Registrant requested an extension to provide a Response. On September 22, 2017, the BCICAC advised the Registrant that in accordance with Paragraph 5.4, the extension could not be granted as the request was made outside the timeframe required to provide the Response. The BCICAC further advised that the Registrant could forward to the BCICAC a written request to accept a late response which the BCICAC would forward to the appointed arbitration panel. In accordance with the Rules, the acceptance of a late response is in the sole discretion of the appointed arbitration panel. The Registrant did not provide a Response.

10. The Complainant elected not to convert to a single arbitrator as permitted by Rule 6.5 and the BCICAC named Melvyn J. Simburg, David Wotherspoon and Elizabeth Cuddihy to act as the three-person Panel arbitrator to determine the matter. Elizabeth Cuddihy was appointed as Chair of the Panel.

11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.

12. As there was no Response to the Complaint, the Panel shall, in accordance with Rule 5.8, decide the Proceeding on the basis of the Complaint.

**Canadian Presence Requirements**

13. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot-ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

14. The Complainant is the owner of Canadian trade-mark registration for WHATSAPP, registered in the Canadian Intellectual Property Office (CIPO) on December 12, 2012, Registration Number TMA838338, (the Complainant’s Mark).

15. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word component of the Complainant’s Mark registered in CIPO, accordingly, the Presence Requirements are satisfied.
The Position of the Parties

The Position of the Complainant

16. The Complainant is a provider of one of the world’s most popular mobile messaging applications or (“apps”). Founded in 2009 and acquired by Facebook in 2014, the Complainant allows users across the globe to exchange messages via smartphones, including IPhone, Blackberry and Android without having to pay for SMS. Its main website is available at www.whatsapp.com. Since its launch, the Complainant’s WhatsApp applications have become one of the most popular mobile applications in the world, with over one million users by the end of 2009, two hundred million users in April 2013, five hundred million in April 2014, eight hundred million in April 2015 and nine hundred million users worldwide in September 2015. As of February 2016, the Complainant has over one billion monthly active users worldwide.

17. The Complainant has acquired considerable reputation and goodwill worldwide including Canada. The Complainant has a strong presence on the different social media forums available online. Reflecting its global reach, the Complainant is the owner of numerous domain names consisting of the Complainant’s Mark, including, for instance, whatsapp.com, whatsapp.net, whatsapp.org, whatsapp.biz as well as under numerous country code extensions, such as, whatsapp.am (Armenia), whatsapp.be (Belgium), whatsapp.eu (European Union), whatsapp.de (Germany), whatsapp.us (United States) to name a few. In addition to its strong presence online, the Complainant has secured ownership of numerous trade-mark registrations in the term WHATSAPP in many countries throughout the world, including in Canada as noted in 14 above.

18. In order to maintain the value and distinctiveness of its brand, the Complainant devotes significant resources to protect its valuable reputation offline and online and its trade-mark rights and goodwill.

19. The Complainant submits that the Disputed Domain Name was registered on January 15, 2015, is confusingly similar to the Complainant’s Mark in which the Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

20. Accordingly, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

The Position of the Registrant

21. The Registrant did not file a Response.
Analysis and Findings

22. The purpose of the Policy as stated in paragraph 1.1 is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

23. Paragraph 4.1 of the Policy provides:

**4.1 Onus.** To succeed in a Proceeding, the Complainant must prove, on a balance of probabilities, that:
(a) the Registrant’s dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had rights prior to the date of registration of the domain name and continues to have such rights; and
(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;
and the Complainant must provide some evidence that:
(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.
Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

24. Paragraph 3.2 of the Policy provides in part:

**3.2 Mark.** A “Mark” is
(a) a trade-mark, including the word elements of a design mark, or a tradename that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;
(b) a certification mark, including the word elements of a design mark that has been used in Canada by a person or that person’s predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;
(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
(d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the Trade-marks Act (Canada).

25. Paragraph 3.3 provides:
3.3 **Confusingly Similar:** In determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

26. Paragraph 3.4 provides:

**3.4 Legitimate Interest:** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:
(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
(b) the Registrant registered the domain name in Canada in good faith in association with wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
(c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
(d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
(e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
(f) the domain name was the geographical name of the location of the Registrant’s non-commercial activity or place of business.

In paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a website.

27. Paragraph 3.5 provides:

**3.5 Registration in Bad Faith.** For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:
(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant’s licensor or licensee of the Mark, or to a competitor of the Complainant, or the licensor or licensee for valuable consideration in excess of the Registrant’s actual costs in registering the domain name or acquiring the Registration;
(b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant’s licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone in concert with one or more additional persons has engaged in
a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant’s licensor or licensee of the Mark, who is a competitor of the Registrant; or
(d) the Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant’s website or other location, by creating a likelihood of confusion with the Complainant’s Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s website or location or of a product or service on the Registrant’s website or location.

28. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:
   1. The dot-ca domain name is confusingly similar to a Mark in which the Complainant had Rights prior to the registration of the Disputed Domain Name and continues to have such Rights;
   2. The Registrant has registered the Disputed Domain Name in bad faith; and
   3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.
   4. Notwithstanding the evidence presented that the Registrant has no legitimate interest in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Name.

Confusingly Similar to a Mark

29. Evidence shows that the Complainant is the owner of the Complainant’s Mark, and the Complainant’s Mark was registered in CIPO as No TMA838338 on December 12, 2012.

30. In accordance with paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

31. The Disputed Domain Name incorporates the entire word of the Complainant’s Mark, without adornment. The only difference between the Disputed Domain Name and the Complainant’s Mark is the .ca extension. The Complainant submits that prior panels deciding under the Policy have held that where a domain name identically reproduces a Complainant’s Mark, excluding the dot-ca suffix, is sufficient to establish that the domain name is Confusingly Similar to a Complainant’s Mark. The Complainant referred to the case of Zevia LLC v. Cook Creative, DCA-1693-CIRA [<zevia.ca>] where the Disputed Domain Name consisted of the entirety of the ZEVIA mark and nothing else. The Panel held that if the trade-mark is included in a disputed domain name, as it is in the present case, a Registrant cannot avoid a finding of confusion by appropriating another’s entire mark in a domain name.
32. Accordingly for the reason stated above, the Disputed Domain Name is confusingly similar to the Complainant’s Mark.

**Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights**

33. The Disputed Domain Name was registered on January 15, 2015.

34. As noted in paragraph 29 above, the Complainant’s Mark was registered in Canada in CIPO on December 12, 2012. In addition, evidence shows that the Complainant’s common law rights and statutory rights to the Complainant’s Mark based on use and registered rights worldwide date back to 2009, years prior to the registration of the Disputed Domain Name and continues to have such rights.

36. The Panel is satisfied that the Complainant’s Mark was registered well before the registration of the Disputed Domain Name and accordingly had Rights in the Complainant’s Mark well before the registration of the Disputed Domain Name and as the evidence shows that the Complainant’s rights are active, the Complainant continues to have such Rights.

**Was the Disputed Domain Name registered in bad faith?**

37. The Complainant relies on paragraphs (a), (b) and (d) of 3.5 of the Policy in support of bad faith registration of the Disputed Domain Name by the Registrant. The Panel notes that the Policy provides that “if any of the circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith”.

38. The Complainant alleges that the Registrant registered the Disputed Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Disputed Domain Name to the Complainant, the Complainant’s licensor or licensee, or to a competitor of the Complainant for valuable consideration in excess of the Registrant’s actual cost in registering the Disputed Domain Name or acquiring the disputed Domain Name.

39. Further, the Complainant submits that the Registrant has never been licensed to, nor has it ever authorized the use of, the Complainant’s Mark in any manner, in Canada or otherwise, including in, or as part of a domain name or the Disputed Domain Name, nor has the Complainant provided consent to the use or display of the Complainant’s Mark at the website of the Disputed Domain Name. Further, the Complainant submits that based on the online presence of the Complainant’s Mark, the Registrant could not plausibly assert that the Complainant’s Mark was unknown to the Registrant when the Registrant registered the Disputed Domain Name.

40. Evidence shows that further to written notification to the Registrant to cease and desist from the infringement of the Complainant’s Mark, the Registrant offered to sell the disputed Domain Name to the Complainant for a price in excess of the actual cost of registering
41. The Complainant further submits that the Registrant, registered the Disputed Domain Name in order to prevent the Complainant from registering the Complainant’s Mark as a domain name and that the Registrant has engaged in a pattern of such conduct. Given the distinctiveness of the Complainant’s Mark and the fact that the Registrant was undoubtedly aware of the Complainant’s renown and goodwill, the Complainant submits that the Registrant anticipated that the Complainant would be interested in reflecting the Complainant’s Mark under the .ca extension for Canada and, accordingly deliberately registered the Disputed Domain Name to deny the Complainant and misappropriate for the Registrant the benefit of the goodwill and reputation established by the Complainant. Evidence shows that the Disputed Domain Name was registered shortly after it was widely publicized that Facebook had acquired WhatsApp.

42. Evidence further shows that the Registrant has engaged in a pattern of registering domain names which contain third party trade-marks to which the Registrant does not appear to be entitled. Registration of well-known third party trade-marks include <singaporeairlines.ca>, <victoriasecret.ca>, <nordstorm.ca>, <celinedion.ca>, to name a few. As noted in Zevia LLC v. Cook Creative, DCA-1693-CIRA where it was found that unchallenged evidence of registering domain names reflecting other parties’ trade-marks are clear attempts to register domain names to prevent the respective trade-mark owners from registering their trade-marks as domain names.

43. Based on all the circumstances demonstrated in the material and all the evidence provided by the Complainant, the Panel is satisfied that the Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

**Legitimate Interest of the Registrant**

44. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide “some evidence” that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although “some evidence” is not defined, it imposes, in the Panel’s view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide “some evidence” of a negative.

45. The Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name. The Registrant did not provide a Response and accordingly the Complainant’s evidence is not refuted.

46. Based on the evidence provided which is not refuted by the Registrant, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.
Decision

45. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer forthwith of the Disputed Domain Name to the Complainant.

Dated October 13, 2017

The Panel
Melvyn J. Simburg, David Wotherspoon and Elizabeth Cuddihy

Per: [Signature]

Elizabeth Cuddihy (Chair)