



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2001337
Complainant:	Bytedance Ltd.
Respondent:	MOHIT JAIN
Disputed Domain Name(s):	<tik-tok-videos.com>

1. The Parties and Contested Domain Name

Complainant is Bytedance Ltd., of P.O. Box 31119 Grand Pavilion, Hibiscus Way, 802 West Bay Road, Grand Cayman, KY1 - 1205 Cayman Islands.

Respondent is MOHIT JAIN, of 56, railway station road, khachrod, UJJAIN, Madhya Pradesh 456224 IN.

The domain name at issue is <tik-tok-videos.com>, registered by Respondent with GoDaddy.com, LLC, of 14455 North Hayden Rd, Suite 219, Scottsdale AZ 85260, United States.

2. Procedural History

Complainant has filed the complaint on April 9, 2020.

Respondent has responded to the complaint on April 21, 2020.

Complainant has not initiated other legal proceedings in respect of the Disputed domain name.

3. Factual background

Complainant is Bytedance Ltd., an Internet technology company which owned a series of content platforms including TikTok, that is a video-sharing social network. TikTok was launched outside China in May 2017 and, since then, has become famous all around the world including United-States and India.

TikTok allows users to create videos running for 15 seconds before looping to restart, and connect clips together to create videos up to 60 seconds long. It is available in 75 languages in more than 150 different markets and has several offices, including the ones in Los Angeles, New York, London, Paris, Berlin, Dubai, Mumbai, Singapore, Jakarta, Seoul, and Tokyo.

TikTok app has been downloaded more than 500 million times and is one of the most downloaded social network app at this day.

Complainant owned several domain names using TikTok sign, as its official website <tiktok.com>, created on July 20, 1996.

Complainant also owned several TIKTOK and TIK TOK trademarks, including :

- Indian TIKTOK trademark n°3960172, of September 29, 2018, registered in classes 16, 18, 20, 26, 41, 45 ;
- Hong-Kong TIK TOK trademark n°304569373, of June 20, 2018, registered in classes 9, 38, 41, 42 ;
- Japanese TIK TOK trademark n°6064328, of July 20, 2018, registered in classes 25, 35, 41, 42, 45 ;
- Australian TIK TOK trademark n°1949117, of August 17, 2018, registered on classes 9, 38, 41 ;
- US TIK TOK trademark n°5653614, of January 15, 2019, registered in classes 9, 38, 41, 42.

Respondent is a computer science student who registered the Disputed domain name on December 18, 2019.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights :

Complainant alleges that it has trademark rights in the TIKTOK and TIK TOK signs and that the extension <.com> has not to be taken into account in the confusing similarity test.

Complainant also argues that the addition of the generic term "videos" to the TikTok sign is creating a risk of confusion with Complainant since the term is closely linked and associated with Complainant's field of activity. In fact, TikTok app has been developed to share video contents.

Complainant adds that the addition of the hyphen between "Tik" and "Tok" does not distinguish the disputed domain name from Complainant's trademarks and does not diminish the risk of confusion, therefore it should be disregarded.

Finally, Complainant alleges that the Respondent's use of the disputed domain name contributes to the confusion since it resolves to a website allowing users to download TikTok videos free of charge.

ii. The Respondent has no rights or legitimate interests in respect of the domain name:

Complainant alleges that its rights in TIK TOK and TIKTOK trademarks is a *prima facie* case of its exclusive rights to use it, so Respondent is not supposed to use them. Respondent is not affiliated to Complainant and has not received any license or authorization from Complainant to use TIKTOK sign.

Complainant adds that Respondent is not commonly known under the disputed domain name and therefore lacks the rights or legitimate interests.

Complainant also alleges that Respondent is not making a *bona fide* offering of goods and services or legitimate, noncommercial fair use of the Disputed Domain Name. It uses TIKTOK trademark to take advantage of Complainant's reputation by including the sign in the disputed domain name and referring to Complainant in his website. All these elements create an illegitimate appearance of affiliation between the disputed domain name and Complainant.

Complainant further argues that Respondent allows users to download famous TikTok videos, which is contrary to Complainant's Terms of Service and therefore does not constitute a *bona fide* offering of goods and services. .

iii. The disputed domain name has been registered and is being used in bad faith:

Complainant alleges that its TIK TOK and TIKTOK trademarks are internationally known and are registered in numerous countries. Furthermore, it started using its trademarks in 2017, which is prior to the disputed domain name's registration.

By registering the disputed domain name using Complainant's trademarks with the addition of the term "videos", Respondent has created a risk of confusion with Complainant. Furthermore, Complainant alleges that Respondent has created a website which features Complainant's trademarks and offers the free downloading of TikTok videos. Regarding those elements, Complainant considers that it is impossible to conceive that Respondent was unaware of Complainant's rights and existence.

Furthermore, Complainant adds that Respondent included a statement "*This website is not a property of TikTok API*". This shows that Respondent knew about Complainant when registering the disputed domain name. It also shows that Respondent is using the disputed domain name in bad faith, only to intentionally confuse unsuspecting users and redirect Complainant's users to its website.

Complainant argues that Respondent created a risk of confusion by displaying Complainant's trademark on its website and enables users to download TikTok content, which is in violation with Complainant's Policy.

Complainant alleges that Respondent knew about its existence and targeted Complainant when registering and using the Disputed domain name, which constitutes acting in bad faith.

B. Respondent

The Respondent's contentions may be summarized as follows:

Respondent has answered to Complainant's contentions. He alleges that there is no resemblance between Complainant's domain name and the disputed domain name but that there are several differences that can be understood by Internet users.

Respondent alleges that he registered the disputed domain name that would not have been sold by GoDaddy to Respondent, since it is similar to a famous trademark.

Respondent adds that the addition of hyphens between the terms of the disputed domain name differs from Complainant's one.

He also alleges that he clearly mentioned in the footer that the website was not the property of TikTok.

Respondent argues that he had no bad intention in registering the disputed domain name but that he would be ready to transfer the domain name if the Panel found a risk of confusion between him and Complainant.

Respondent finally argues that he is not getting money thanks to the disputed domain name and that there is poor traffic on this one.

5. Findings

Paragraph 15(a) of the Rules provides that the "Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraphs 10(b) and 10(d) of the Rules provides that: "In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "The Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of these three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Panel finds that Complainant has duly shown its rights in the TIK TOK and TIKTOK trademarks.

Indeed, the disputed domain name is using the "TikTok" sign with the mere addition of the generic term "videos". Panel finds that the addition of this term increases the risk of confusion since it directly refers to Complainant's activity and to TikTok social network that consists of sharing videos.

Furthermore, the addition of the hyphens between the terms of the disputed domain name does not dispel the risk of confusion and has to be disregarded.

Otherwise, it appears to be generally considered that the extension of a domain name is not to be taken into account in the evaluation of the risk of confusion. In fact, the addition of the extension “.com” is purely technical and is irrelevant in the confusing similarity analysis. See for example WIPO Case No. D2019-2672, *Blue Green v. Guan Hui Hua* : “*The only other element of the disputed domain name is a generic Top-Level Domain (“gTLD”) suffix, i.e. “.com”. As a technical requirement of registration, a gTLD suffix is disregarded in the comparison between a domain name and a trademark for the purposes of the first element of the Policy unless it has some impact beyond its technical function, which is not the case here*”.

Therefore, Panel finds that the disputed domain name is confusingly similar to Complainant’s trademark and the addition of the term “videos” does not dismiss the risk of confusion but increases it.

In accordance with Paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Names are confusingly similar to Complainant’s trademark.

B) Rights and Legitimate Interests

Complainant must first make a prima facie case that Respondent lacks the rights and legitimate interests in the disputed domain name under Paragraph 4(a)(ii).

Complainant has duly established its exclusive rights in the TIKTOK and TIK TOK signs. Therefore, those registered rights prevent someone else to use these signs for an identical or similar activity.

Here, Complainant has duly shown that it had no link or affiliation with Respondent and that it did not give any license or authorization to use its trademarks nor to register the disputed domain name.

Respondent has responded to Complainant’s contentions but only argues that he did not register it with bad intention, nor to benefit from Complainant’s reputation. However, Panel finds that he did not give sufficient evidence to prove he has rights or legitimate interests in the disputed domain name.

Those arguments are not sufficient to demonstrate he had rights or legitimate interests in the disputed domain name.

Furthermore, even if Respondent is not making any profit from the disputed domain name and mentioned that the disputed website was not Complainant’s property, he did not make any *bona fide* offering of goods and services. In fact, Panel considers that offering and allowing users to download TikTok videos, which is contrary to Complainant’s Policy does not constitute neither rights or legitimate interests, nor a *bona fide* offering of goods and services.

Previous Panel considered that using a disputed domain name for the same activity as Complainant was not constitutive of legitimate interests. See for example WIPO Case D2019-2686, *Scopus Soluções Em Ti LTDA v. Registration Private, Domains By Proxy, LLC. / Leonam Antunes* : “*The uncontested evidence shows that the Complainant has prior trademark rights*

related to the SHOPFÁCIL mark at the time of the Respondent's registration of the disputed domain name and that the Respondent nevertheless registered the disputed domain name to redirect Internet users to a website that offers similar services as the Complainant. These circumstances do not create rights or legitimate interests in the disputed domain name by the Respondent". In fact, this is even worse since Respondent directly refers to Complainant's videos.

Therefore, Panel finds that Complainant has demonstrated that Respondent has no rights or legitimate interests in the Disputed Domain Names pursuant to Paragraph 4(a)(ii) of the Policy and that Respondent did not give sufficient evidence to demonstrate the contrary.

C) Bad Faith

Paragraph 4(a)(iii) of the Policy requires Complainant to demonstrate that the Disputed Domain Names were registered and are being used in bad faith.

Firstly, regarding the evidences that have been given by Complainant and the global reputation of TikTok, it is not conceivable to consider that Respondent could have registered the domain name in good faith or without knowing Complainant's existence.

In fact, Panel finds that Respondent obviously registered the disputed domain name in bad faith. The use of Complainant's trademark in association with the generic term "videos" could not be a coincidence. It directly reflects Complainant's field of activity that developed TikTok App for sharing videos.

Respondent argued that GoDaddy should not sell such a domain name since it is similar to a famous trademark. However, this argument is irrelevant and does not justify Respondent's registration of the said disputed domain name.

Therefore, Panel finds that Respondent registered the disputed domain name in bad faith.

Secondly, Complainant argues that Respondent is using the disputed domain name in bad faith.

In fact, Respondent is using TikTok content, such as famous videos from Complainant's social network as well as the TikTok logo. Obviously, while he is not supposed nor authorized to.

Furthermore, even if Respondent has mentioned on its website that it was not TikTok property, it is necessary to consider that Respondent is making a fraudulent use of the disputed domain name. As a matter of fact, it allows Internet users to download some TikTok videos for free while he has not been authorized to and despite the fact that this is contrary to TikTok's Terms of Service.

Panel finds here that Respondent is making fraudulent use of the disputed domain name, which is obviously constitutive of bad faith. This has already been considered by previous Panel as WIPO Case D2019-3173, *Wenger S.A. v. Phaphimon Surasang, Blisstwenties Co. Ltd.* : *"The Panel also finds credible Complainant's claim that Respondent has registered and used the disputed domain name to conduct a counterfeiting operation, and such per se illegal activity is manifestly evidence of bad faith"*.

Therefore, Respondent knew about Complainant's existence since he directly refers to its activity and its TikTok social network. To make matters worse, it displayed Complainant's content mentioning that the disputed domain name was not owned by it. It seems that any reasonable person could not have ignored that it was forbidden to give access to content that is normally forbidden by its owner.

Therefore, Panel finds that Respondent is using the disputed domain name in bad faith, notwithstanding Respondent's arguments that do not seem to provide sufficient evidence of good faith.

Complainant has therefore satisfied the requirements of Paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Disputed Domain Names must be transferred to the Complainant.

Nathalie Dreyfus
Sole Panelist

Dated: May 7, 2020

A handwritten signature in black ink, consisting of a horizontal line on the left, a vertical line in the middle, and a horizontal line on the right, with a small dot at the end of the right line.