

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc., Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Saint Nicholas, and Host Master, 1337 Services LLC
Case No. D2022-2184

1. The Parties

The Complainants are Meta Platforms, Inc. (“the first Complainant”) and Instagram, LLC, LLC (“the second Complainant”), United States of America (“United States”), represented by Hogan Lovells (Paris) LLP, France.

The Respondents are Registration Private, Domains By Proxy, LLC,¹ United States / Saint Nicholas, Pakistan, and Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Names and Registrars

The disputed domain name <fbvideodownloader.org> is registered with GoDaddy.com, LLC (“Registrar 1”). The disputed domain name <instadownloader.org> is registered with Tucows Inc. (“Registrar 2”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 15, 2022. On June 16, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On June 16, 2022, Registrar 2 transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <instadownloader.org>, which differed from the named Respondent and contact information in the Complaint. On June 21, 2022, Registrar 1 transmitted by email to the Center its verification response, once again disclosing registrant and contact information for the disputed domain name <fbvideodownloader.org>.

¹ The Panel notes an email from the Registrar stating that Domains by Proxy LLC is only a privacy service and that the same should not be listed as a respondent. In reply the Complainant noted that Domains by Proxy LLC appeared in the publicly-available Whois as the registrant of the disputed domain name <fbvideodownloader.org> at the time the Complaint was filed, and that its practice is to name both the privacy service and the underlying registrant in such circumstances – an approach applied across a substantial body of UDRP cases – and cites several UDRP decisions in support of such statement. While the Panel understands the intention behind the Registrar’s request, it is noted that a standard UDRP practice (flowing from the definition of “Respondent” in the Rules, paragraph 1) has been to record the named privacy or proxy service in the case caption, with the substantive merits being addressed to the underlying registrant, assuming one exists and has been identified by the concerned registrar. Moreover, as discussed below, the Panel finds the retention of a privacy service relevant in the present case.

which also differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 22, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 27, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on June 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2022. Accordingly, the Center notified the Respondents’ default on July 19, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on July 22, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainants are leading providers of online social networking and mobile messaging applications having its <facebook.com> and <Instagram.com> websites ranked as the 3rd and 5th top websites in the world.

The first Complainant is the owner, amongst others, of the trademark FB registered in the United States under No. 4659777, on December 23, 2014, and the second Complainant is the owner of the trademark INSTA registered in the United States under No. 5061916, on October 18, 2016.

The disputed domain names <fbvideodownloader.org> and <instadownloader.org> were registered on April 12, 2018 and April 23, 2018, respectively. The disputed domain names resolve to active webpages offering free “Facebook Video Downloader” and free “Instagram Photo Video Downloader”. Third parties’ banners (commercial advertisements) are displayed at these webpages.

The Complainants’ representatives sent a cease-and-desist letter to the Respondent regarding the second disputed domain name <instadownloader.org> but did not receive a reply to the request concerning the transfer of that disputed domain name.

5. Parties’ Contentions

A. Complainant

The Complainants assert to be the world’s leading providers of online social networking services and mobile messaging applications, actively promoting and using their FACEBOOK and INSTAGRAM trademarks, as well as the abridged versions thereof FB and INSTA, throughout the world.

The Complainants submit that the disputed domain names are subject to common control by either the same person or connected parties and for reasons of fairness, equity, and efficiency, the Complainants request consolidation of the multiple Respondents to the same Complaint, given that both disputed domain names: i) were registered with the same Registrar, using the same privacy service and showing the same registrant details (at the time of registration); ii) were registered under the “.org” generic Top-Level-Domain (“gTLD”); iii) comprise similar terms “videodownloader” and “downloader”, together with the Complainants’ trademarks;

iv) resolve to websites which purport to provide tools to download content from the Facebook and Instagram platforms belonging to the Complainants; and v) the website at the disputed domain name <instadownloader.org> contains a link that redirects Internet users to the website at the disputed domain name <fbvideodownloader.org> and *vice versa*.

The first disputed domain name, <fbvideodownloader.org>, is, according to the Complainants, confusingly similar to the first Complainant's trademark, given that its trademark is reproduced in it with the addition of the terms "video" and "downloader" which is insufficient to distinguish the disputed domain name from the first Complainant's trademark. In addition to that, the first disputed domain name resolves to a website which purports to provide a tool to download content from the Facebook platform, having thus the Respondents targeted the first Complainant's trademark. Moreover, the Complainants point out that exactly the same details used to register the <fbvideodownloader.org> disputed domain name were previously used to register another domain name targeting the second Complainant, <insta-stories.net>. This domain name also used to point to a website offering a tool to anonymously download content from Instagram and was recently ordered to be transferred to the second Complainant (*Instagram, LLC v. Saint Nicholas*, WIPO Case No. [D2022-1260](#)).

The second disputed domain name, <instadownloader.org>, is, according to the Complainants, confusingly similar to the second Complainant's trademark, given that its trademark is reproduced in it with the addition of the term "downloader" which is insufficient to distinguish the disputed domain name from the second Complainant's trademark. In addition to that, the second disputed domain name resolves to a website which purports to provide a tool to download content from the Instagram platform, despite containing a small disclaimer stating that the website is not associated with Instagram, what clearly indicates that the Respondents sought to target the second Complainant's trademark through the disputed domain name.

Moreover, the Complainants assert that the Respondents have no rights or legitimate interests in respect of the disputed domain names given that:

- (a) the Respondents are not licensees of the Complainants, nor have they been otherwise allowed by the Complainants to make any use of the FB and INSTA trademarks, in domain names or otherwise;
- (b) the Respondents cannot assert that they are using, or have made demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, given that the tools offered on the Respondents' websites are in breach of the Complainants' Developer Policies, as the creation of such tools that facilitates the downloading of content from the Facebook or Instagram platforms goes beyond the limits that the Complainants have placed on the functionality of their own products;
- (c) the disclaimer at the bottom of the website associated with the second disputed domain name <instadownloader.org> stating that it is not associated with Instagram does not render the Respondents' activities *bona fide*, as the Complainants would never consent to their trademarks being used in order to market a product that violates their Developer Policies;
- (d) the Respondents are not commonly known by the disputed domain names nor have they acquired any rights over the such terms; and
- (e) the Respondents' websites contain commercial banners from which the Respondents presumably derive click-through revenue, which indicates that the Respondents' use of the disputed domain names appears to be commercially motivated.

As to the registration of the disputed domain names in bad faith the Complainants assert that the Respondents knew or should have known of the Complainants' trademark rights at the time of the registration of the disputed domain names considering that the FB and INSTA trademarks are well known throughout the world in relation with the Complainants' social networks and messaging applications. In fact, the Complainants argue that the Respondents' intent to target the Complainants when registering the

disputed domain names may be inferred from the contents of the websites to which the disputed domain names resolve, which make explicit reference to the Facebook and Instagram platforms and make prominent use of the Complainants' trademarks.

The Complainants further submit that the Respondents have taken steps to set up websites providing tools for downloading content from the Facebook and Instagram platforms, in violation of the Complainants' Developer Policies, also failing to reply to the Complainants' follow up emails sent after the remittance of the cease-and-desist letter aforementioned, also having retained a privacy protection service which are further indicatives of the Respondents' bad faith.

Thus, according to the Complainants, the Respondents are unfairly seeking to capitalize on the goodwill and fame of the Complainants' trademarks by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its website, making Internet users believe that the websites are associated, endorsed, or recommended by the Complainants, which is not true.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Consolidation of Multiple Complainants and Respondents in a Single Administrative Proceeding

The Complainants request under paragraph 3(c) and 10(e) of the Rules that this Panel accept multiple complainants and respondents in a single proceeding in view of the facts enumerated at section 5.A. above.

Regarding the multiple Complainants in this case, the Panel notes that the Second Complainant is a wholly-owned subsidiary of the First Complainant. As such, the two Complainants have a sufficient common legal interest in the FB and INSTA trademarks included in the disputed domain names to file a joint Complaint. Further, they have been the target of common conduct by the Respondents who have engaged in bad faith registration and use of the disputed domain names comprising their trademarks as discussed in details below. Therefore, it would be equitable and procedurally efficient to permit the consolidation of multiple Complainants.

Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) establishes that "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario."

All of the aforementioned criteria are present in this case and therefore this Panel accepts such request considering that it would be more procedurally efficient to have the two disputed domain names dealt with at the same procedure, given that both disputed domain names: i) were registered within two weeks and through the same Registrar, using the same privacy service and showing the same registrant details (at the time of registration); ii) sharing a similar naming pattern (under the ".org" gTLD and comprising similar terms "videodownloader" and "downloader", together with the Complainants' trademarks); iii) resolve to similar websites which purport to provide tools to download content from the Facebook and Instagram platforms belonging to the Complainants; and iv) the website at the disputed domain name <instadownloader.org> contains a link that redirects Internet users to the website at the disputed domain name <fbvideodownloader.org> and *vice versa*.

This Panel is satisfied, in view of the evidence submitted and on balance that the disputed domain names are indeed subject to a common control and that consolidation would be fair and equitable to all Parties.

Now, in what it relates to the merits of the case, the Panel will analyze the three requisite elements under paragraph 4(a) of the Policy which have to be met for this Panel to order the transfer of the disputed domain names to the Complainants:

- (i) the disputed domain names are identical or confusingly similar to the trademarks or service marks in which the Complainants have rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainants must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain names transferred to them, according to paragraph 4(a) of the Policy.

B. Identical or Confusingly Similar

The Complainants have established their rights in the FB and INSTA trademarks.

The addition of the terms “video” and “downloader” is not sufficient to escape a finding of confusing similarity. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. ([WIPO Overview 3.0](#), section 1.7).

Furthermore, the uses of the disputed domain names in connection with webpages purportedly offering free “Facebook Video Downloader” and free “Instagram Photo Video Downloader” affirm a finding of confusing similarity between the disputed domain names and the Complainants’ trademarks. See [WIPO Overview 3.0](#), section 1.15.

For the reasons above, the Panel finds that the disputed domain names are confusingly similar to the Complainants’ trademarks.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondents rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice to the Respondents of the dispute, the Respondents’ use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondents (as individuals, businesses, or other organizations) have been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondents are making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In the present case, the Respondents use the disputed domain names offering services in connection with the Complainants platforms, without any explanation of the lack of relationship between the Parties, depicting several commercial advertisements in their webpages, which clearly cannot be considered a *bona fide* offering of goods or services.

In addition to that, the absence of any indication that the Respondents have been commonly known by the disputed domain names, or that they have acquired any registered trademarks or trade names corresponding to the disputed domain names, as well as the Complainants' statement that no authorization, license or permission had been given for the Respondents to register and use the disputed domain names corroborate the indication of the Respondents' lack of rights or legitimate interests in the disputed domain names.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondents do not have rights or legitimate interests with respect to the disputed domain names.

D. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

In this case, the use made of the disputed domain names characterizes the Respondents' intent of commercial gain by misleadingly diverting the Complainants' consumers or merely earning revenues from commercial advertisements (banners) that solely exist in view of the association with the Complainants' trademarks.

Such use, in this Panel's view, constitute an attempt to profit from the fame and goodwill associated with the Complainants' trademarks, thus unfairly capitalizing on the FB and INSTA trademarks by creating a likelihood of confusion in Internet users who are likely to believe that the disputed domain names are either connected, endorsed, or authorized by the Complainants.

Two other relevant factors corroborate the finding of the Respondents' bad faith conduct in this case, at least in respect of the disputed domain name <fbvideodownloader.org>: the retention of a privacy protection service as well as the use of an apparently false physical address in the underlying Whois data.

For the reasons above, the Panel finds that the Respondents' conduct amounts to bad faith registration and use of the disputed domain names pursuant to paragraph 4(b)(iv) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <fbvideodownloader.org> be transferred to the first Complainant, Meta Platforms, Inc., and <instadownloader.org> be transferred to the second Complainant, Instagram, LLC.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: August 2, 2022