

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Whois Agent, Domain Protection Services, Inc. / Ahmad Butto

Case No. D2022-3203

1. The Parties

The Complainant is Instagram, LLC, United States of America, represented by Tucker Ellis, LLP, United States of America.

The Respondent is Whois Agent, Domain Protection Services, Inc., United States of America / Ahmad Butto, Israel.

2. The Domain Name and Registrar

The disputed domain name <instagrām.com> (<xn--instagrm-n7a.com>) is registered with Name.com, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 30, 2022. On August 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 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 September 13, 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 Respondent of the Complaint, and the proceedings commenced on September 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 11, 2022.

The Center appointed Taras Kyslyy as the sole panelist in this matter on October 19, 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 Complainant is an online photo and video sharing social networking application. Since its launch in 2010, it became a fast growing photo/video sharing and editing software and online social network, with more than 1 billion monthly active accounts worldwide.

The Complainant owns numerous trademark registrations for INSTAGRAM in many jurisdictions around the world, including, for instance, International trademark registration No. 1129314, registered on March 15, 2012.

The disputed domain name <instagrām.com> (<xn--instagrm-n7a.com>) was registered on September 11, 2018 and does not resolve to any active website.

The Respondent has registered the disputed domain name as internationalized domain name using Punycode translation. It has been established in UDRP decisions that internationalized domain names and their Punycode translations are equivalents (See, e.g., *Facebook, Inc. v. Registration Private, Domains By Proxy LLC/ Serhii Pronin*, WIPO Case No. [D2020-0172](#)).

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name is the internationalized domain name <instagrām.com>, which translates as <xn--instagrm-n7a.com> in Punycode. Internationalized domain names and their Punycode translations are equivalent. The disputed domain name features the Complainant's trademark and merely replaces the letter "a" in the mark with the character "ā," which closely resembles the letter "a." Such use of internationalized characters constitutes typosquatting. The addition of a generic Top Level Domain ("gTLD") has no distinguishing value.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not licensed nor authorized the Respondent to use the Complainant's trademark, nor does the Respondent have any legal relationship with the Complainant that would entitle the Respondent to use the Complainant's trademark. Neither the registration data for the disputed domain name nor the corresponding website available at the disputed domain name supports that the Respondent is known by the disputed domain name. The Complainant is not aware of the Respondent being known by the disputed domain name in any other way. The Respondent has no legitimate reason for using the Complainant's trademark within the disputed domain name, and instead, the Respondent is using the disputed domain name in connection with its passive holding in an inactive state. Non-use or "passive holding" of a domain name is not a use in connection with a *bona fide* offering of goods or services. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent's registration and use of the disputed domain name is a violation of the Complainant's brand guidelines.

The disputed domain name was registered and is being used in bad faith. The non-use of the disputed domain name that is confusingly similar to the Complainant's trademark constitutes use in bad faith. The Respondent's bad faith is evidenced by the Respondent's registration of other domain names which infringed the rights of the Complainant and the rights of its parent company Meta Platforms, Inc. In addition to the disputed domain name the Respondent has targeted other trademarks owned by the Complainant and Meta

Platforms, Inc., and has been the respondent in other UDRP proceedings which ordered the transfer of infringing domain names, such as *Instagram, LLC v. Whois Agent, Domain Protection Services, Inc. / 12565630 Ahmad Butto*, WIPO Case No. [D2021-0754](#), *Meta Platforms, Inc. v. Whois Agent, Domain Protection Services, Inc. / Ahmad Butto*, WIPO Case No. [D2022-0471](#). The Respondent has registered the disputed domain name that is confusingly similar to the Complainant's trademark on September 11, 2018, which postdates the registration and use of the Complainant's trademark. Because the Complainant's trademark is so obviously connected with the Complainant and its well-publicized mobile application, and the disputed domain name clearly references this trademark, the registration and passive holding of the disputed domain name by the Respondent, who has no connection with the Complainant, supports a finding of bad faith. Given the fame of the Complainant's trademark, and the Respondent's unauthorized incorporation of the Complainant's trademark into the disputed domain name, there are no circumstances under which the Respondent's use of the disputed domain name could plausibly be in good faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test.

The disputed domain name practically contains the whole of the Complainant's trademark. The disputed domain name was registered using Punycode and is therefore not composed entirely of ASCII English script. Using Punycode, the browser application will "translate" the Punycode text into the non-ASCII characters (see, e.g., *The Coca-Cola Company v. ICU Agency*, WIPO Case No. [D2008-1851](#)). In the present case, <xn--instagrm-n7a.com> will be displayed as <instagrām.com> containing the visually similar letter "ā" instead of "a" at the corresponding the Complainant's famous trademark. This difference is almost imperceptible and the use of Punycode to create a domain name that is visually identical to a trademark does not prevent a finding of identity or confusing similarity (see, e.g. *WhatsApp Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2018-1654](#)).

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence show that the Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could

be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The Respondent has no rights or legitimate interests in the disputed domain name resolving to inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

Noting the risk of Internet user confusion between the disputed domain name and the well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant (see, e.g., *Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / Zayed*, WIPO Case No. [D2019-2897](#)).

Considering the above the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to section 3.1.4 of the [WIPO Overview 3.0](#) the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in the United States of America and internationally. Thus, the Panel finds that the disputed domain name, confusingly similar to the Complainant's trademark, was registered in bad faith.

According to section 3.3 of the [WIPO Overview 3.0](#) from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. In this regard the Panel takes into account (i) the high degree of distinctiveness and reputation of the Complainant's trademark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the implausibility of any good faith use to which the disputed domain name may be put.

Considering the above the Panel finds the disputed domain name was registered and used in bad faith. Therefore, the Complainant has established its case under paragraph 4(a)(iii) 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, <instagrām.com> (<xn--instagrm-n7a.com>), be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: November 2, 2022