

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Yashavantha Yashu, indiangovtjob
Case No. D2023-1327

1. The Parties

The Complainant is Instagram, LLC, United States of America ("United States"), represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Yashavantha Yashu, indiangovtjob, India.

2. The Domain Name and Registrar

The disputed domain name <gbinstagram.club> (the "Domain Name") is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 28, 2023. On March 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 29, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 30, 2023, 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 April 1, 2023.

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 April 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 28, 2023.

The Center appointed Karen Fong as the sole panelist in this matter on May 3, 2023. 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 operates the Instagram online photo and video sharing social networking application. Since its launch in 2010, Instagram has become one of the world's fastest growing photo and video sharing and editing software and online social network with more than 2 billion monthly active accounts worldwide.

The Complainant has used the INSTAGRAM trade mark for over 12 years. It also owns trade mark registrations for INSTAGRAM all over the world including in India where the Respondent is based. The earliest trade mark registration submitted in evidence is International Trade Mark Registration No. 1129314 with a registration date of March 15, 2012 (individually and collectively, the "Trade Mark"). The Complainant also owns trade mark registration for its logo (the "Logo"). The Complainant has a portfolio of domain names comprising the Trade Mark including <instagram.com>.

The Domain Name was registered on March 29, 2022. The Domain Name previously resolved to a website titled "GB Instagram" (the "Website") which prominently displayed the Logo. The Website promoted and offered downloads of modified versions of the Complainant's Instagram app. These modified applications developed by third parties without the Complainant's permission, purport to provide users with additional features that are not supported by the official Instagram app, such as downloading third party images and videos from Instagram. The Website also displayed pay-per-click ("PPC") advertising. The Website did not provide contact details other than an email address and contained no information as to the relationship between the Complainant and the Respondent or those operating the Website. The Complainant's lawyers sent a cease and desist letter to the Respondent. No response was received but the Website ceased to be active.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name was registered and is being used in bad faith. The Complainant requests transfer of the Domain Name.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) The Domain Name is identical or confusingly similar to the trade marks or service marks in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) The Domain Name was registered and is being used in bad faith.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established that it has registered and unregistered rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Name contains the Trade Mark in its entirety with the addition of two letters “gb”, which may refer to the acronym for Great Britain. The addition of these two letters do not prevent a finding of confusing similarity. For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain (“gTLD”), which in this case is “.club”, since it is viewed as a standard registration requirement (section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such a *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with some allegations of evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not commonly known by the Domain Name. It has not authorised, licensed, or otherwise permitted the Respondent to use the Trade Mark in the Domain Name or for any other purpose. The Respondent is not an authorised dealer, licensee, or distributor of the Complainant.

Section 2.8.1 of [WIPO Overview 3.0](#) says this:

“Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trade mark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the ‘Ok! Data test’, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;

- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trade mark holder; and
- (iv) the respondent must not try to 'corner the market' in domain names that reflect the trade mark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trade mark." See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

In this case, whilst the Respondent is not providing sales or repairs in relation to a product by the Complainant, he/she purports to be licensed, authorised, or somehow connected to the Complainant by using the Trade Mark and Logo to promote and offer modified versions of Instagram. There is nothing on the Website explaining the relationship between the Complainant and the Respondent. Instead, the Website appears designed to cause Internet users to falsely believe the Domain Name is endorsed and/or operated by the Complainant. The Panel finds the Oki Data principles are not satisfied in this case and therefore not a *bona fide* offering of goods and services. Further, the display of PPC links does not constitute a *bona fide* offering of goods or services or legitimate noncommercial or fair use of the Domain Name given the revenue the Respondent derives from Internet users misled by the confusingly similar Domain Name.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered and Used in Bad Faith

To succeed under the Policy, the Complainant must show that the Domain Name has been both registered and used in bad faith. It is a double requirement.

The Panel is satisfied that the Respondent must have been aware of the Trade Mark when he/she registered the Domain Name given the reputation of the Trade Mark which has no other meaning other than being the Complainant's well known company name and Trade Mark, both of which have been used and registered long before the Domain Name. Further, the Website is promoting and offering modified versions of the Complainant's Instagram app and prominently displays the Trade Mark and Logo. It is therefore implausible that the Respondent was unaware of the Complainant when he/she registered the Domain Name.

In the [WIPO Overview 3.0](#), section 3.2.2 states as follows:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

There is a clear absence of rights or legitimate interests coupled with no explanation for the Respondent's choice of the Domain Name are also significant factors to consider (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). In light of the above, the Panel finds that the Respondent deliberately registered the Domain Name in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The Respondent employs the reputation of the Trade Mark to mislead users into visiting the Domain Name instead of the Complainant's. The Website has been set up for the commercial benefit of the Respondent. It is highly likely that Internet users when typing the Domain Name into their browser, or finding them through a search engine would have been looking for a site operated by the Complainant rather than the Respondent. The Domain Name is likely to confuse Internet users trying to find the Complainant's website. Such confusion will inevitably result due to the fact that the Domain Name contains the entirety of the Complainant's distinctive Trade Mark together with the letters "gb". The Complainant contends that the modified Instagram apps promoted through the Website may be used to harvest data or steal Instagram users, accounts credential, for phishing or for other unauthorised or illegal activities. The Panel accepts that there is a likelihood of such an intention and such activities amount to bad faith use.

From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Respondent's Website is that of or authorized or endorsed by the Complainant. The Panel therefore concludes that the Domain Name was registered and is being used in bad faith under paragraph 4(b)(iv) of the Policy.

The Panel finds that the Respondent has registered and used the Domain Name in bad faith.

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 Domain Name <gbinstagram.club> be transferred to the Complainant.

/Karen Fong/

Karen Fong

Sole Panelist

Date: May 25, 2023