

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. Privacy service provided by Withheld for Privacy ehf / Fan Reap

Case No. D2022-1225

### **1. The Parties**

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

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Fan Reap, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <instavast.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2022. On April 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on April 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 28, 2022. Respondent did not submit any response. Accordingly, the Center notified the Parties of Respondent’s default on April 29, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on May 12, 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

Complainant operates an online photo- and video-sharing social-networking application that was launched in 2010. It is the proprietor of numerous trademarks for its INSTA and INSTAGRAM marks, including the following:

- United States Registration No. 5061916 for INSTA (word mark), registered on October 18, 2016, for goods in class 9;
- European Union Trade Mark No. 014810535, for INSTA (word mark), registered on May 23, 2018, for goods in class 9;
- United States Registration No. 4146057 for INSTAGRAM (word mark), registered on May 22, 2012, for goods in class 9;
- European Union Trade Mark No. 14493886 for INSTAGRAM (word mark), registered on December 24, 2015, for goods and services in classes 25, 35, 38, 41, and 45;
- International Registration No. 1129314, for INSTAGRAM (word mark), registered on March 15, 2012; for goods and services in classes 9 and 42.

Complainant has registered a number of domain names containing its INSTAGRAM mark, including <instagram.com>, and is active on various social media platforms.

The disputed domain name was registered on August 3, 2017. It resolves to a website through which Respondent offers various tools to users of Complainant's Instagram app.

#### 5. Parties' Contentions

##### A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that, since its launch in 2010, its Instagram platform, commonly known as "Insta", has rapidly acquired and developed considerable goodwill and renown worldwide. Acquired by Meta Platforms, Inc. (formerly known as Facebook, Inc.) in 2012, today Instagram is the world's fastest growing photo- and video-sharing and editing software and online social network, with more than 1 billion monthly active accounts worldwide. Complainant's website at "www.instagram.com" is ranked the 5th most visited website in the world. The disputed domain name incorporates Complainant's INSTA trademark in its entirety with the addition of the descriptive term "vast" under the generic Top-Level Domain ("gTLD") ".com". The disputed domain name also comprises "insta", which is a distinctive abbreviation of Complainant's INSTAGRAM mark. It is confusingly similar to Complainant's INSTA and INSTAGRAM marks.

Under the second element, Complainant states that Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Respondent is not a licensee of Complainant. Respondent is not affiliated with Complainant in any way. Complainant has not granted any authorization for Respondent to make use of its INSTA or INSTAGRAM trademarks in a domain name or otherwise. Respondent's website purports to provide a range of paid and unpaid services, including tools for the downloading of content from the Instagram platform and tools for the automated buying of Instagram likes and views. Respondent is therefore not a service provider using a domain name containing a third-party trademark that is making a *bona fide* offering of goods or services. Respondent is making unauthorized use of Complainant's INSTAGRAM and INSTA trademarks to market its own ancillary services. Respondent is not commonly known by the disputed domain name and is not making a legitimate noncommercial use of it.

Respondent has no legitimate interest in the disputed domain name.

Under the third element, Complainant states that Complainant's trademarks are inherently distinctive and well known throughout the world in connection with its online photo-sharing social network. Furthermore, Complainant's INSTA and INSTAGRAM trademarks were continuously and extensively used well before the disputed domain name was registered in 2017, and have rapidly acquired considerable reputation and goodwill worldwide. Respondent's intention to target Complainant is evidenced by the content of Respondent's website, which explicitly references Complainant. Respondent is using the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the website. The disputed domain name resolves to a website that offers free tools for the unauthorized downloading of content from Instagram, as well as paid subscriptions for automated services to ultimately increase user visibility on the Instagram platform. They may place the privacy and security of Instagram users at risk, given that such content scraped from the Instagram platform may be stored and later used for unauthorized purposes by third parties. Respondent's website displays modified versions of Complainant's mark, creating a misleading impression of endorsement by Complainant, without any disclaimer indicating that Respondent is unaffiliated with Complainant.

Complainant requests transfer of the disputed domain name.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

(i) the disputed 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 disputed domain name; and

(iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] 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".

### **A. Identical or Confusingly Similar**

Complainant has provided evidence establishing that it has trademark rights in the INSTA and INSTAGRAM marks through registrations in several jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.

In comparing Complainant's marks with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to the INSTA mark as the trademark is clearly recognizable within the disputed domain name. It is the consensus view of UDRP panels that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), section 1.8.

It is the well-established view of UDRP panels that a gTLD, such as “.com”, is viewed as a standard registration requirement and as such may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

## **B. Rights or Legitimate Interests**

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no rights in the INSTA or INSTAGRAM marks. The disputed domain name clearly contains Complainant’s distinctive INSTA mark and is clearly intended to, and does, play on the Complainant’s trademarks.

Respondent is using the disputed domain name to offer additional services to Complainant’s customers. Under certain circumstances, resellers, distributors, or service providers using a domain name containing the complainant’s trademark 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. To meet these circumstances, pursuant to the test outlined in *Okidata Americas, Inc. v. ASD, Inc.* WIPO Case No. [D2001-0903](#), the following four conditions must be met:

- (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 trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

Complainant submits that Respondent’s use of the disputed domain name cannot constitute a *bona fide* offering of goods and services because Respondent is not offering sales or repairs, but rather unauthorized ancillary services to users of the Instagram service. Respondent’s services artificially boost users’ visibility on the Instagram platform through the purchase of automated “likes” and views. According to Complainant, such use cannot form the basis of any legitimate right in the disputed domain name.

The Panel finds that Respondent lacks rights or legitimate interests in the disputed domain name. The circumstances do not indicate that Respondent’s use of the disputed domain name satisfies the *Okidata* test. In particular, the Panel notes that nowhere does Respondent’s website disclose the lack of any relationship with Complainant. Instead, the website repeatedly mentions Complainant’s Instagram service and mentions the INSTAGRAM mark. Further, the Panel finds that the nature of the services precludes a finding of rights or legitimate interests, as Respondent is taking unfair advantage of the Complainant’s marks to offer competing services.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not provided any rebuttal of Complainant’s *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name. There is no evidence that Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish that Respondent is making legitimate noncommercial use of the disputed domain name.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant provides uncontroverted evidence that its rights in the INSTA and INSTAGRAM marks significantly predate the registration of the disputed domain name. The disputed domain name is confusingly similar to Complainant's distinctive INSTA mark. Under such circumstances, UDRP panels have consistently found that the registration of a domain name that is identical or confusingly similar to a distinctive trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4. Respondent has not provided any information that would rebut this presumption.

The evidence provided by Complainant indicates that the disputed domain name resolves to a website through which Respondent prominently references Complainant and offers services, for a fee, to users of Complainant's Instagram service. There is no information that would allow the Panel to conclude that Respondent's intent in registering the disputed domain name was for any purpose other than attracting users to its website by creating a likelihood of confusion with the Complainant's marks in order to sell competing services to users of Complainant's services. Such use is clearly in violation of the Policy. See, for example, *Instagram, LLC v. Whois privacy protection service / Olga Sergeeva / Ivan Ivanov / Privacy Protect, LLC (Privacy Protect.org)*, WIPO Case No. [D2020-0521](#).

The Panel, therefore, finds that Complainant has established the third element under paragraph 4(a) 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 <instavast.com> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: May 26, 2022