

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Saint Nicholas
Case No. D2022-1260

1. The Parties

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

The Respondent is Saint Nicholas, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <insta-stories.net> 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 April 8, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 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 April 13, 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 April 15, 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 April 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 12, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on May 16, 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 a United States company, founded in 2010 and acquired by Facebook, Inc. in 2012. It operates globally under the trademark INSTAGRAM or abbreviations of this trademark like the mark INSTA, providing an online mobile photo and video sharing social networking application (“app”) that allows users across the globe to edit and share photos/videos and exchange messages in an online social network. The Complainant’s social media platform is available in over 31 languages, being ranked the fifth most visited website in the world, according to web information company Alexa, and the most downloaded app for iOS phones worldwide, according to Data.ai’s (formerly App Annie) Top Apps Worldwide Rankings in February 2022. The nature of the Complainant’s business is exclusively online, being its main website “www.instagram.com”.

The Complainant holds registered trademark rights in the marks INSTAGRAM and INSTA in many jurisdictions, being the owner of a substantial trademark portfolio, of which the following are sufficient representative for the present proceeding:

- United States Trademark No. 4,146,057, INSTAGRAM, word mark, registered on May 22, 2012, in class 9;
- International Trademark No. 1129314, INSTAGRAM, word mark, registered on March 15, 2012, in classes 9 and 42;
- European Union Trade Mark No. 14493886, INSTAGRAM, word mark, registered on December 24, 2015, in classes 25, 35, 38, 41, and 45;
- United States Trademark No. 5,061,916, INSTA, word mark, registered on October 18, 2016, in class 9; and
- European Union Trade Mark No. 014810535, INSTA, word mark, registered on May 23, 2018, in class 9, (collectively the “INSTAGRAM mark” and the “INSTA mark”).

Prior decisions under the Policy have recognized the worldwide renown of the trademark INSTAGRAM.¹

The Complainant further owns numerous domain names comprising its trademarks, under various generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”), which are linked to its corporate websites in connection with its services, including <instagram.com> (registered on June 4, 2004), <instagram.net> (registered on November 6, 2010), and <instagram.us> (registered on March 9, 2012).

The disputed domain name was registered on November 22, 2020, and it currently resolves to a website in English language allegedly offering a tool to anonymously download content from Instagram, indicating “Many create Instagram Stories every day and millions of people watch them. There is one drawback, however. As soon as you watch a story, whoever posted the story knows who all watched his story. With the help of the Insta Story Downloader, you can view and download the stories from all public profiles completely anonymously. With this IG Story Viewer you can stalk various people without you knowing it.” This website includes a textbox entitled “Enter IG Username” and a button “Get stories”, however, upon inserting any

¹ See *Instagram, LLC v. lu xixi, PRIVATE*, WIPO Case No. [D2015-1168](#); *Instagram, LLC v. Sedat Das, Arda, Domain Admin, whoisprotection biz, Domain Admin Domain Admin, whoisprotection biz*, WIPO Case No. [D2016-2382](#); *Instagram, LLC v. Ozgur Kalyoncu, Seo Master and Huseyin Erdem*, WIPO Case No. [D2016-1710](#); *Instagram, LLC v. Omer Ulku*, WIPO Case No. [D2018-1700](#); *Instagram, LLC v. Ellie Walker*, WIPO Case No. [D2018-0669](#); *Instagram, LLC v. Orhan Uzdu*, WIPO Case No. [D2019-2806](#); *Instagram, LLC v. Saddam Hussain*, WIPO Case No. [D2018-0078](#); and *Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / Zayed*, WIPO Case No. [D2019-2897](#).

Instagram username data and pressing the indicated button, appears a message indicating, “We are sorry. We couldn't find a story.” Upon entering into the site, there is a welcome message that request the user to give its consent to use its personal data. This website includes various advertisement banners prominently displayed horizontally at the top of the site, and a disclaimer note at the very bottom of the site, after the copyright notice “Copyright © 2022. All rights reserved”. The disclaimer indicates, “Instagram Story Downloader is not affiliated with Instagram. We do not host any of the Instagram Stories on our servers, all rights belong to their respective owners.” This website do not include any specific information about its provider, including only email address as contact information.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The Complainant's app and its trademarks have been continuously and extensively used since its launch in 2010, being worldwide renowned, having received numerous awards, and being widely reported by major international publications. The Complainant has also developed strong presence on social media platforms, having over 60 million likes on Facebook, and over 34 million followers on Twitter.

The disputed domain name is confusingly similar to the Complainant's trademarks. The disputed domain name incorporates the INSTA mark in its entirety, with the addition of the term “stories” and a hyphen, which do not prevent a finding of confusing similarity. The INSTA mark is immediately recognizable in the disputed domain name, as well as the INSTAGRAM mark (as “insta” is a distinctive abbreviation of this reputed trademark), and the generic Top-Level Domain (“gTLD”) “.net” may be disregarded for the purposes of assessing confusing similarity, as it is a standard requirement of registration.

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name or holds any trademark rights in the terms “insta” or “insta stories.” The Respondent is not a licensee of or affiliated with the Complainant, not being authorized to use the Complainant's trademarks, and is not using the disputed domain name in connection with any *bona fide* offering of goods or services. According to Instagram's Terms of Use, access to any content on Instagram is conditional upon the provision of accurate registration information, being prohibited to attempt to create accounts or access or collect information in unauthorized ways, including creating accounts or collecting information in an automated way without Instagram's express permission. The Respondent's tool violates these terms of use, placing the security and privacy of Instagram users at risk, and the disclaimer included in the Respondent's site does not render these activities *bona fide*.

The disputed domain name was registered and is being used in bad faith. The Complainant's trademarks are globally well-known, and the term “instagram” is highly distinctive, being exclusively associated with the Complainant. The Respondent could not credibly argue that it did not have knowledge of the Complainant's trademarks when registering the disputed domain name in 2020, by which time the Complainant's platform had amassed over 1 billion monthly active users. The content of the Respondent's website corroborates its intent to target the Complainant's trademarks, and the use of an obviously false name (“Saint Nicholas”) in the Whols of the disputed domain name is a further evidence of bad faith. The 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 the Complainant's trademarks. Prior UDRP panels have held that the unauthorized automated accessing and downloading of content from social networks amounts to bad faith.² The Respondent's use of the disputed domain name is intended for financial gain, displaying commercial banners on its website, from which the Respondent is likely obtaining financial gain.

² The Complainant cites *Facebook, Inc. v. Registration Private, Domains By Proxy, LLC / Giap Nguyen Van and Giao Tran Ngoc*, WIPO Case No. [D2018-2762](#); and *Instagram, LLC v. WhoisGuard, Inc. / Name Redacted, Senol Sahin, thepicdeer.com, Ekrem Gueltekin and Ekrem Gultekin*, WIPO Case [D2020-2826](#).

The Complainant has cited previous decisions under the Policy as well as various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)") that it considers supportive of its position, and requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

The Complainant indisputably has rights in the registered trademarks INSTAGRAM and INSTA, both by virtue of its trademark registrations and as a result of its global goodwill and reputation.

The disputed domain name incorporates the INSTA mark in its entirety, which is a commonly known abbreviation of the reputed trademark INSTAGRAM, adding the term "stories" separated by a hyphen, which does not prevent the finding of confusing similarity. The Complainant's trademarks are recognizable in the disputed domain name, and the gTLD ".net" is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, 1.8, 1.9 and 1.11 of the [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

B. Rights or Legitimate Interests

Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests.

The Complainant's above-noted assertions and evidence in this case effectively shift the burden of production to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case.

The Respondent has not replied to the Complainant's contentions, not providing any explanation or evidence of rights or legitimate interests in the disputed domain name.

A core factor in assessing fair use of a domain name is that it does not falsely suggest affiliation with the Complainant's trademark. See section 2.5, [WIPO Overview 3.0](#). The disputed domain name incorporates the INSTA mark in its entirety, which is also a commonly known abbreviation of the reputed INSTAGRAM mark, adding a term "stories" referring to one of the features of the Complainant's platform, separated by a hyphen. The Instagram platform allows users across the globe to edit and share photos/videos and

exchange messages in an online social network, generating stories of their respective lives and opinions about any matter, so the disputed domain name may be misleadingly considered related to the Complainant and/or its platform denoting a risk of implied affiliation and confusion.

The Respondent's website displays a disclaimer indicating its lack of relationship with Instagram. However, this disclaimer is not prominently displayed in the site, being located at the very bottom of the landing page, after the copyright notice, in very small letters. The Panel therefore considers that this disclaimer may easily go unnoticed by any Internet user or potential customer visiting the site, and in any case would not be sufficient to avoid the risk of confusion and/or implied affiliation arising from the composition of the disputed domain name.

The Panel further considers that the Complainant has made out a strong *prima facie* case that the Respondent could not have rights or legitimate interests in the disputed domain name, not being authorized to use the Complainant's trademarks; and there is no evidence that suggests that the Respondent is commonly known by the terms corresponding to the disputed domain name. In this respect, the Panel notes that the Respondent's name provided in the registration of the disputed domain name has no resemblance with the term "insta" or "insta stories", being the name of a saint, possibly a nickname or an alias, but not a proper name ("Saint Nicholas").

The Panel notes that the Respondent's website prominently displays commercial banners (from which the Respondent is likely obtaining financial gain), not being possible to consider that the use of the disputed domain name is related to a noncommercial or fair use.

The Panel further notes that the disputed domain name is used in connection to a business of questionable legality. The Respondent's website allegedly offers a tool for downloading content anonymously from the Instagram platform, without the need of registration in this platform and without the need of complying with the Complainant's platform terms of use, or the privacy and data protection regulations. Such tool may place the privacy and security of Instagram users at risk, as content scraped from Instagram's platform may be stored and later used for unauthorized purposes by anonymous third parties. In any case, the Panel finds that the use of the disputed domain name is not susceptible to give rise to rights or legitimate interests on it under the Policy.

It is further remarkable that the Respondent has chosen not to reply to the Complaint, not providing any information or evidence in connection to any rights or legitimate interests in the disputed domain name.

All the above-mentioned circumstances lead the Panel to conclude that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has failed to rebut this. Nothing in the record gives reason to believe that the Respondent has or has had any rights or legitimate interests in respect of the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel notes the continuous extensive use of the INSTAGRAM mark and presence over the Internet since its launch in 2010, as well as the well-known character of this trademark worldwide, being the INSTA mark also its notorious abbreviation, as has been recognized by previous decisions under the Policy.³

³ See footnote No. 1, *supra*.

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain name:

(i) the disputed domain name incorporates the INSTA mark in its entirety (common abbreviation of the INSTAGRAM mark), adding a term “stories”, separated by a hyphen, that refers to the Complainant or its platform, which reinforces the intrinsic likelihood of affiliation;

(ii) the Complainant’s trademarks are well-known worldwide and the Complainant operates online, being its social media platform available in over 31 languages;⁴

(iii) the disputed domain name is used in a business of questionable legality that may be placing the privacy and security of Instagram users at risk;

(iv) the Respondent indicated false or erroneous information in the Whols of the disputed domain name, particularly a nickname or *alias*, instead of a real name, as well as an erroneous postal code;⁵

(v) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name and has not come forward to deny the Complainant’s assertions of bad faith, choosing not to reply to the Complaint; and

(vi) The Panel further notes that, according to the Complainant’s allegations, the downloading tool offered in the Respondent’s website does not seem to be operative. This circumstance may indicate, in the Panel’s view that this tool may be a pretext.

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel considers that the disputed domain name was registered and is being used for targeting the Complainant’s platform and its trademarks, in bad faith, with the intention of obtaining any type of benefit from the established reputation of the Complainant and its trademarks, seeking to mislead Internet users to believe that there is a connection between the disputed domain name and the Complainant’s platform, to increase the traffic of the Respondent’s website for a commercial gain, which constitutes bad faith.

The Panel further finds that the disputed domain name is capable of being used in any type of phishing, online scam, or other fraudulent schemes targeting the Complainant’s users.

Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain name has been registered and is being used 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 disputed domain name <insta-stories.net> be transferred to the Complainant.

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Sole Panelist

Date: May 30, 2022

⁴ The Panel, under its general powers, articulated *inter alia* in paragraph 10 of the Rules, has consulted the Complainant’s platform website “www.instagram.com”.

⁵ In the Whols of the disputed domain name, the Respondent indicated the name of a saint (“Saint Nicholas”) and a postal code that do not correspond to the location indicated.