

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Pankaj Sharma

Case No. D2022-2301

### **1. The Parties**

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Pankaj Sharma, India.

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

The disputed domain name <instagramreels.online> 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 June 24, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 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 June 28, 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 30, 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 July 1, 2022.

On June 28 and July 1, 2022, the Respondent sent two informal email communications. On July 1, 2022, the Complainant indicated that it did not wish to explore settlement at this time.

In accordance with the Rules, paragraph 5, the due date for Response was July 21, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it will proceed to Panel Appointment on July 22, 2022.

On July 23, 2022, the Respondent sent a third email informal communication to the Center.

The Center appointed Edoardo Fano as the sole panelist in this matter on July 28, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to the Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a formal response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is Instagram, LLC, a U.S. company providing a world-famous online photo and video sharing social networking application, founded in 2010 and acquired by Meta Platforms, Inc. (formerly known as Facebook, Inc.) in 2012. On August 5, 2020, the Complainant launched a new feature called "Instagram Reels", enabling users to create and discover short, entertaining videos on Instagram. The Complainant owns several trademark registrations for INSTAGRAM and REELS, among which:

- International Trademark Registration No. 1129314 for INSTAGRAM, registered on March 15, 2012;
- United States Registration No. 4146057 for INSTAGRAM, registered on May 22, 2012;
- European Union Trade Mark No. 014493886 for INSTAGRAM, registered on December 24, 2015;
- Indian Trademark Registration No. 4750300 for REELS, registered on November 20, 2020;
- European Union Trade Mark No. 018342099 for REELS, registered on May 14, 2021.

The Complainant operates on the Internet at the main website "www.instagram.com", as well as with many other generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs") including the trademark INSTAGRAM.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on January 17, 2022, and when the Complaint was filed it resolved to a blog-style website prominently referring to the Complainant's trademarks INSTAGRAM and REELS and featuring nude or sexually suggestive pictures of female celebrities or models.

## 5. Parties' Contentions

### A. Complainant

The Complainant states that the disputed domain name is identical to its trademarks INSTAGRAM and REELS, as the disputed domain name consists of the Complainant's trademarks in their entirety.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademarks within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademarks INSTAGRAM and REELS are distinctive and internationally known. Therefore, the Respondent targeted the Complainant's trademarks at the time of registration of the disputed domain name and the Complainant contends that the use of the disputed domain name with the purpose of intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademarks as to the disputed domain name's source, sponsorship, affiliation or endorsement, qualifies as bad faith registration and use.

### B. Respondent

The Respondent has made no formal reply to the Complainant's contentions.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#); *SSL International PLC v. Mark Freeman*, WIPO Case No. [D2000-1080](#); *Altavista Company v. Grandtotal Finances Limited et. al.*, WIPO Case No. [D2000-0848](#); *Confédération Nationale du Crédit Mutuel, Caisse Fédérale du Crédit Mutuel Nord Europe v. Marketing Total S.A.*, WIPO Case No. [D2007-0288](#)).

In this case, the Respondent submitted three informal email communications on June 28, July 1 and July 23, 2022, stating the following:

"Hi, I didn't understand this. I have bought the domain name from godaddy.com and I don't know how it is something objectionable. Also, the communication received didn't make a precise point." (June 28, 2022);

"Hello Sir/Madam, I've purchased the domain from a website and whatever I have posted is in the public domain with due credits. But, still I am deleting the website." (July 1, 2022);

"Hello Sir/Ma'am, I don't why are you bothering me with these mails. I had purchased the domain name from godaddy. So, it's there responsibility to not offer domains that have legal issues. But still I deleted the domain and all the data that I had created with hard labor. So please stop harassing me. It won't help you in anyway. Deleting the mail was all I could do but if you are still not satisfied put me in jail. I won't mind because I am not in any condition to pay you anything, not even a lawyer to bail me. So please go ahead and take the extreme step you can take. OK." (July 23, 2022).

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademarks INSTAGRAM and REELS both by registration and acquired reputation and that the disputed domain name is identical to the trademarks INSTAGRAM and REELS.

It is also well accepted that a gTLD, in this case “.online”, is typically ignored when assessing the similarity between a trademark and a domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is identical to the Complainant’s trademarks, pursuant to the Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

- “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is always more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the

Respondent is not currently associated with the Complainant in any way, is not commonly known by the disputed domain name and is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name: the Respondent, in the website at the disputed domain name, is offering paid promotions services by referring to the Complainant's trademarks INSTAGRAM and REELS and featuring nude or sexually suggestive pictures of female celebrities or models, an activity capitalizing on the Complainant's trademarks and reputation.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has failed to file a formal response in accordance with the Rules, paragraph 5, and has not rebutted the Complainant's *prima facie* case. The Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

Moreover, the Panel finds that the composition of the disputed domain name carries a high risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

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

Paragraph 4(b) of the Policy provides that "[...] for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the Respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [the Respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent has] engaged in a pattern of such conduct; or

(iii) that [the Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] website or other online location, by creating a likelihood of confusion with the 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 [the Respondent's] website or location".

Regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademarks INSTAGRAM and REELS in the field of online photo and video sharing social networking application is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the disputed domain name, especially because the disputed domain name resolved to a website where the Complainant's trademarks are reproduced and explicit reference to the Complainant is made.

The Panel further notes that the disputed domain name is also used in bad faith since on the relevant website the Complainant's trademarks were displayed, with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademarks as to the disputed domain name's source, sponsorship, affiliation, or endorsement.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order to create confusion with the Complainant's trademarks and attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

Furthermore, the Panel considers that the nature of the disputed domain name, which is identical to the Complainant's trademarks, further supports a finding of bad faith. See, [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

## **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 <instagramreels.online> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: August 5, 2022