

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Olutosin Oduwole, Conglomerate Holdings Group
Case No. D2022-3216

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Olutosin Oduwole, Conglomerate Holdings Group, United States.

2. The Domain Name and Registrar

The disputed domain name <theinstagrammetaverse.com> (the “Disputed 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 August 31, 2022. On August 31, 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 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 1, 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 8, 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 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 29, 2022. The Respondent sent informal communications to the Center on August 31, 2022 and September 2 and 9, 2022, but did not submit a formal response. Accordingly, the Center proceeded to Panel Appointment on September 30, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on October 4, 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 world-renowned online photo and video sharing social networking application. Since its launch in 2010, the Complainant has rapidly acquired and developed considerable goodwill and renown worldwide. Acquired by Meta Platforms, Inc. (formerly known as Facebook, Inc.) in 2012, the Complainant today is the world's fastest growing photo and video sharing and editing software and online social network, with more than one billion monthly active accounts worldwide. Given the exclusive online nature of the Complainant's business, the Complainant's domain names incorporating its trademark are not only the heart of its business but also a primary way for its millions of users to avail themselves of its services.

The Complainant owns numerous trademarks in many jurisdictions worldwide, including but not limited to the following: INSTAGRAM, United States Registration No. 4,146,057, registered on May 22, 2012, in international class 9; INSTAGRAM, European Union Trade Mark No. 014493886, registered on December 24, 2015; in international classes 25, 35, 38, 41, and 45; and INSTAGRAM, International Trademark No. 1129314, registered on March 15, 2015, in international classes 9 and 42 (hereinafter collectively referred to as the "INSTAGRAM Mark").

The Disputed Domain Name was registered on November 27, 2021 and resolves to a blank landing page.

In response to a cease-and-desist letter from the Complainant, on September 8 and 9, 2021, the Respondent replied that he legally owns the Disputed Domain Name and would only transfer it for a sum offered by the Complainant. The Respondent later informed the Complainant that it would sell the Disputed Domain Name for USD two million.

5. Parties' Contentions

A. Complainant

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's INSTAGRAM Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- the Disputed Domain Name was registered and is being used in bad faith.

The Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent sent informal communications to the Center on August 31, 2022, and September 2 and 9, 2022, but did not submit a formal response.

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry, a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the INSTAGRAM Mark.

It is uncontroverted that the Complainant has established rights in the INSTAGRAM Mark based on its fame as well as its registered trademarks for the INSTAGRAM Mark in the United States and other jurisdictions worldwide. The registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case". Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the INSTAGRAM Mark.

The Disputed Domain Name consists of the INSTAGRAM Mark in its entirety, preceded by the term "the", and followed by the term "metaverse", and then followed by the generic Top-Level Domain ("gTLD") ".com". The Disputed Domain Name is confusingly similar to the INSTAGRAM Mark since the trademark is incorporated in its entirety in the Disputed Domain Name. It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms {...} would not prevent a finding of confusing similarity under the first element". For example, numerous UDRP decisions have reiterated that the addition of a term to a trademark does not prevent a finding of confusing similarity. See *Instagram, LLC v. Laremy Wade*, WIPO Case No. [D2022-1710](#) (holding that the disputed domain name incorporates the INSTAGRAM mark in its entirety followed by the letter "s" and the term "metaverse", and thus, remains sufficiently recognizable for a showing of confusing similarity under the Policy).

Finally, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#), and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant's INSTAGRAM Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent

carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant's INSTAGRAM Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name nor has the Respondent made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

Moreover, the Complainant does not have any business relationship with the Respondent and based on the passive use made of the Disputed Domain Name to resolve to a blank landing page with no substantive content, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name.

Further, the Respondent offered the Disputed Domain Name for sale to the Complainant for USD two million, far in excess of the Respondent's documented out-of-pocket costs related to the Disputed Domain Name. Such an offer does not constitute a *bona fide* sale of goods or services or a legitimate noncommercial or fair use of the Disputed Domain Name. See *Turner Network Television, Inc. v. Expired Domain Resource****Maybe For Sale on Dynadot Marketplace**** c/o Dynadot*, WIPO Case No. [D2018-1036](#) ("The offering of the Domain Name for sale does not constitute a *bona fide* sale of goods or services or a legitimate noncommercial or fair use").

In sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, based on the circumstances here, the Panel concludes that the Respondent's registration and use of the Disputed Domain Name had been done for the specific purpose of trading on the name and reputation of the Complainant and its INSTAGRAM Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Second, with respect to the use of the Disputed Domain Name, passive holding does not prevent a finding of bad faith. By holding the Disputed Domain Name passively, the Respondent registered and is using the Disputed Domain Name in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). "The lack of use [of a domain name] by itself does not indicate anything. Nevertheless, the lack of use of a domain name that is not backed up by any trademark and that coincides with a known, well-known or renowned trademark owned by someone else, does not indicate other than bad faith in the sense of paragraph 4(b) of the Policy." See *El Bebe Productions Ltd v. Rachid Zouad*, WIPO Case No. [D2018-0469](#) (citing *Itaú Unibanco Holding S.A. v. Valdey Dos Santos Decorações ME*, WIPO Case No. [D2009-1335](#)).

Third, the Panel finds that the Respondent had actual knowledge of the Complainant's INSTAGRAM Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the use made by the Complainant of the INSTAGRAM Mark worldwide, it

strains credulity to believe that the Respondent had not known of the Complainant or its INSTAGRAM Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its INSTAGRAM Mark additionally suggests that the Respondent's objective in registering the Disputed Domain Name was to cause confusion with the Complainant's INSTAGRAM Mark. Moreover, the Complainant submits that the Respondent could not credibly argue that it did not have knowledge of the Complainant or its INSTAGRAM Mark when registering the Disputed Domain Name in 2021, by which time Instagram had amassed over two billion monthly active users. See *Instagram, LLC v. Bozulma Artik, hayat*, WIPO Case No. [D2021-4121](#) ("Given the popularity of the products and services offered by the Complainant and the reputation of the Complainant's INSTAGRAM trademark, it would be inconceivable that the Respondent registered the disputed domain name without knowledge of the INSTAGRAM trademark at the time of the registration.").

Fourth, the Respondent's offer to sell the Disputed Domain Name to the Complainant for valuable consideration far in excess of its documented out-of-pocket costs directly related to the Disputed Domain Name is also evidence of the Respondent's bad faith registration and use under paragraph 4(b) of the Policy.

Finally, the Respondent has established a pattern of cybersquatting, demonstrating bad faith registration and use.¹ See [WIPO Overview 3.0](#), at 3.1.2; see also *Autodesk, Inc. v. Bayram Fatih Aksoy*, WIPO Case No. [D2016-2000](#). Such pattern of cybersquatting is strong evidence of bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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, <theinstagrammetaverse.com>, be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: October 18, 2022

¹ For example, the Respondent has registered the following domain names that infringe the trademarks of well-known third parties: <hsbcbankcorp.com>, <jpmorganchasemetaverse.com>, <microsoftmetaverse.live>, <theredditmetaverse.com>, and <wellsfargometaverse.com>.