

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc., Instagram LLC v. Nicolas Picard
Case No. D2022-2063

1. The Parties

The Complainants are Meta Platforms, Inc., and Instagram, LLC, United States of America (“United States”), represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Nicolas Picard, Canada.

2. The Domain Name and Registrar

The disputed domain names <metainstagram.com> and <mymetainstagram.com> (“Disputed Domain Names”) are 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 7, 2022. On June 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On June 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 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 17, 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 June 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 14, 2022. Although no official response was filed with the Center, several emails were received from the Respondent.

The Center appointed Nicholas Weston as the sole panelist in this matter on July 25, 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.

A general query was received by the Center by telephone on August 1, 2022, from the Respondent reiterating statements he had made in numerous brief email communications throughout the proceeding.

4. Factual Background

The Complainant, Meta Platforms, Inc., (“Meta”) is a United States social technology company that operates a number of businesses including Facebook, Instagram, Meta Quest (formerly Oculus), Novi, Portal, and WhatsApp. The Complainant, Instagram, LLC (“Instagram”), is a wholly owned subsidiary of Meta, and a well-known online photo and video-sharing social-networking application. Each Complainant holds a portfolio of registrations for their respective trademarks, and variations of them, in numerous countries. An example provided by Meta includes United States Registration No. 5548121 for the mark META, assigned to that Complainant on October 28, 2021. An example provided by Instagram includes United States Registration No. 4,146,057 for the mark INSTAGRAM, registered by that Complainant on May 22, 2012.

The Complainants owns numerous domain names that comprise or contain the trademarks META and INSTAGRAM, respectively, including the domain name <meta.com>, and the domain name <instagram.com>.

The Disputed Domain Names <metainstagram.com> and <mymetainstagram.com> were both registered on October 28, 2021. The Disputed Domain Names are inactive.

5. Parties’ Contentions

A. Complainant

The Complainants requests to consolidate the Complainant parties in this proceeding on the basis that the Complainant parties have a sufficient common legal interest in the META and INSTAGRAM trademarks included in the Disputed Domain Names to file a joint Complaint.

The Complainant, Meta, cites its trademark registrations including Andorran Trademark Registration No. 43626, registered on January 3, 2022, and other registrations around the world, for the mark META, as *prima facie* evidence of ownership. The Complainant, Instagram, cites its trademark registrations including European Union Trade Mark No. 14493886, registered on December 24, 2015, and other registrations around the world, for the mark INSTAGRAM, as *prima facie* evidence of ownership.

The Complainants submit that the marks META and INSTAGRAM are well known and that their rights in those marks predate the Respondent’s registration of the Disputed Domain Names. The Complainants submit that the Disputed Domain Names are confusingly similar to its trademarks, for the reason that:

- the Disputed Domain Name <metainstagram.com> incorporates in its entirety the META trademark and the INSTAGRAM trademark with the additional letter “s”, and that the confusing similarity is not removed by the letter “s”, or the generic Top-Level Domain (“gTLD”) “.com”.
- the Disputed Domain Name <mymetainstagram.com> incorporates in its entirety the META trademark and the INSTAGRAM trademark preceded by the word “my”, and that the confusing similarity is not removed by the word “my”, or the generic gTLD “.com”.

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, “The Respondent is not a licensee of the Complainant. The Respondent

is not affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of its META or INSTAGRAM trade marks, in a domain name or otherwise” and none of the circumstances set out in paragraph 4(c) of the Policy apply. The Complainants also contend that the “the Domain Names do not resolve to active websites. Such use of the Domain Names amounts to passive holding. Prior UDRP panels have found that the non-use of a domain name does not amount to use of the domain name in connection with any *bona fide* offering of goods or services”.

Finally, the Complainants allege that the registration and use of the Disputed Domain Names were, and currently are, in bad faith, contrary to the Policy and the Rules having regard to the prior use and fame of the Complainants’ trademarks, and, it submits, “the Complainant cannot conceive of any good faith use to which the Domain Names could be put by the Respondent that would not carry with it an inherent risk of confusion. As such, the Complainants submit that the presence of the Disputed Domain Names in the hands of the Respondent represents an abusive threat hanging over the head of the Complainants (*i.e.*, an abuse capable of being triggered by the Respondent at any time) and therefore a continuing abusive use.”

B. Respondent

No formal response has been filed, however, the Panel will in its discretion take into account the Respondent’s email communications sent to the Center that read as follows:

On June 17, 2022, an email from the Respondent to the Center stated: “I reached out to godaddy asking them they wanted us to do. We got an email a while back to drop the domains which we did immediately. Let us know what is required from us.”

On June 23, 2022, an email from the Respondent to the Center stated: “I’ve asked a few times without any response, what do you need me to do on this? I released the domains the minute I was asked to do so.”

On June 24, 2022, an email from the Respondent to the Center stated: “Of course we want this, i was asked to release the domains which i did immediately upon receiving the request. I bought these did absolutely nothing with them, received your email and released them immediately. What do you want me to do else?.”

On June 28, 2022, an email from the Respondent to the Center stated: “Respectfully, i reached out to godaddy multiple Times to get this resolved and they told me although i released the domains they told me they will keep it under me for year or until complainant is resolved. But i can assure you that they have been released as requested by your party as soon as I received an email to do so, furthermore I did absolutely nothing with this domain. I can send print screens of my account showing i no longer have it...Again i dont know what you need from me or want from me, i have requested this several times always never getting a response back....”

The Center informed the Panel that on August 1, 2022, the Respondent contacted the Center unilaterally via telephone, reiterating the contentions above.

6. Discussion and Findings

6.1 Preliminary Matter – Consolidation and common control

A complaint is allowed to proceed with multiple complainants against a single respondent where the parties each have standing to file a UDRP complaint. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.1 states: “Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in

common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.”

The Panel accordingly concludes that it is fair and equitable for the Complaint to proceed in the name of both Complainants since both Complainants have a common legal interest in the trademark rights on which the Complaint is based and it is procedurally efficient to proceed in a single Complaint. Hereinafter, the Complainants will collectively be referred to as the “Complainant” unless otherwise indicated.

6.2 Preliminary Matter – Consent to Remedy

In instances where a respondent has given its unilateral and genuine consent to the requested remedy sought by a complainant, some panels will order the requested remedy solely on the basis of such consent. [WIPO Overview 3.0](#), section 4.10. However, a panel in its discretion may still find it appropriate to proceed to a substantive decision on the merits. Here, the Panel notes that the Complainant explicitly responded to the Respondent’s settlement offers by requesting that the Center proceed with panel appointment and a decision on the merits. Together with the broader interests in recording a substantive decision on the merits, the Panel will proceed with a decision on the substantive matters.

6.3 Substantive Matters

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the marks META and INSTAGRAM in numerous countries, including the United States. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country (see [WIPO Overview 3.0](#), section 1.2.1).

Turning to whether the Disputed Domain Names are identical or confusingly similar to the META and INSTAGRAM trademarks, the Panel observes that:

- the Disputed Domain Name <metainstagram.com> incorporates in its entirety the META trademark and the INSTAGRAM trademark with the additional letter “s”, and that the confusing similarity is not removed by the letter “s”, or the gTLD “.com”.
- the Disputed Domain Name <mymetainstagram.com> incorporates in its entirety the META trademark and the INSTAGRAM trademark preceded by the word “my”, and that the confusing similarity is not removed by the word “my”, or the generic gTLD “.com”.

It is well established that the gTLD used as part of a domain name is generally disregarded unless the gTLD takes on special significance where it has relevance to the analysis (see *Autodesk v. MumbaiDomains*, WIPO Case No. [D2012-0286](#); *Alstom v. WhoisGuard Protected, WhoisGuard, Inc. / Richard Lopez, Marines Supply Inc*, WIPO Case No. [D2021-0859](#)). The gTLD chosen appears to have no special significance in this proceeding. The relevant comparison to be made is with the second-level portion of each Disputed Domain Name, specifically: “metainstagram” and “mymetainstagram”, respectively.

As the relevant marks are incorporated in their entirety and/or sufficiently recognizable in the Disputed Domain Names, in line with previous UDRP decisions, this Panel finds the Disputed Domain Names are confusingly similar to the Complainant's META and INSTAGRAM trademarks for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Names. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Names. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Panel finds that the combined terms "metainstagram" and "mymetainstagram" have no ordinary meaning other than in connection with the Complainant. Furthermore, there is no indication that the Respondent was commonly known by the terms "metainstagram" or "mymetainstagram" prior to registration of the Disputed Domain Names and the Complainant also contends that it has not licensed, permitted, or authorized the Respondent to use the trademarks.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names and its passive holding of the Disputed Domain Names does not amount to a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

While the Respondent did not submit a formal Response and has not come forward with any claims or evidence of rights or legitimate interests in the Disputed Domain Names, its emails to the Center indicate that the Respondent appears to have repeatedly consented to transfer the Disputed Domain Names to the Complainant, but has not filed evidence or submissions to resist this point.

This Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names and, in the absence of any submissions or evidence to the contrary from the Respondent, the Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Names have been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Names in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Names, the Panel is satisfied that the Respondent knew of the Complainant's trademarks META and INSTAGRAM when it registered the Disputed Domain Names (see *Meta Platforms, Inc., Instagram, LLC v. Domains By Proxy, LLC / Tim Ordonez*, WIPO Case No. [D2022-1789](#) ("the Complainants' famous and well-known Marks")).

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Names other than to trade off the reputation and goodwill of the Complainant's well-known trademarks (see *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#) (which held that the domain name in question was "so obviously connected with the Complainant and its products that its very use by someone with no connection with Complainant suggests opportunistic bad faith").

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a domain name (containing the trademark) can indicate bad faith registration (see *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Respondent registered the Disputed Domain Name about 10 years after the Complainant established trademark rights in the INSTAGRAM mark.

On the issue of use, the evidence is that the Disputed Domain Names are inactive which, numerous previous UDRP panels have found, would not prevent a finding of bad faith under the doctrine of passive holding. "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the 'passive holding' doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put" (see [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that all of these factors are present in this proceeding.

This Panel also views the provision of false contact information as an additional and separate indication of bad faith (see [WIPO Overview 3.0](#), section 3.6). While the Respondent engaged in email communications with the Center, the Panel notes that the courier was unable to deliver the Center's written communication to the physical contact details disclosed for the Respondent, raising the question of the authenticity of the information provided by the Respondent.

The Respondent's emails to the Center do not amount to a formal Response and appear to give its consent on the record to the transfer remedy sought by the Complainant, possibly to avoid a substantive decision on the merits, but in any event it has failed to supply any evidence or submissions to resist the Complaint (see [WIPO Overview 3.0](#), section 4.10). In the circumstances, this Panel accepts the Complainant's evidence and finds that the Respondent has taken the Complainant's trademarks META and INSTAGRAM and incorporated them into the Disputed Domain Names, without the Complainant's consent or authorization, for the likely purpose of capitalizing on the reputation of the trademarks to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 Names, <metainstagram.com> and <mymetainstagram.com>, be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: August 8, 2022